

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 44372

IN THE NAME OF J&J CROMBIE LTD

TO APPLICATION No. 2005458

TO REGISTER A TRADE MARK IN CLASS 25

IN THE NAME OF A&F TRADEMARK INC.

DECISION

Application No. 2005458

1. A&F Trademark Inc (“the Applicant”) applied on 23rd December 1994 to register the word ABERCROMBIE for use as a trade mark in relation to various goods in Class 25. The application proceeded to advertisement with the following specification of goods: “Articles of clothing for men and women; pants, sweatshirts, t-shirts, suits, trousers, shorts, shirts, skirts; blazers, coats, overcoats, raincoats; dresses, culottes, sweaters, blouses, jackets; stormcoats, trenchcoats; slickers, scarves, ties, hats, headbands and caps; hosiery; boots, shoes, slippers, sandals; belts; fishing vests, mufflers, gloves, helmets, ponchos, socks and braces; but not including any such goods bearing a tartan pattern”.

Opposition No. 44372

2. On 3rd April 1996 J&J Crombie Ltd (“the Opponent”) filed notice of opposition to the application for registration. The application was opposed on various grounds. For the purposes of this decision I need only refer to the objections raised under Sections 3(1)(a) and 3(1)(b) of the Trade Marks Act 1994. These were raised on the basis that the mark in question was not capable of distinguishing the specified goods of the Applicant from those of other undertakings and was devoid of any distinctive character because it was a surname that was common in Scotland. The Applicant joined issue with the Opponent on these objections.

The Opponent’s Evidence

3. Evidence was given on behalf of the Opponent to the effect that the population of Scotland as a whole is roughly equivalent to that of Greater London and that the surname ABERCROMBIE and its phonetic equivalent ABERCROMBY appeared with the following frequency in various Scottish telephone directories:

TOWN/CITY	ABERCROMBIE	ABERCROMBY
Aberdeen	4	1
Edinburgh	20	4
Glasgow	58	9
Clyde Valley	47	5
Clyde Coast	26	2
Lomond and Argyle	10	3
Central Scotland and Trossachs	51	9

TOWN/CITY	ABERCROMBIE	ABERCROMBY
Fife and Kinross	15	1
	231	34

On the basis of the extracts from the telephone directories exhibited as Exhibit AMM18 to a Statutory Declaration of Allen Murray dated 18th July 1996 it would appear that the listed telephone numbers were (with the exception of a few for ABERCROMBY) residential telephone numbers.

The Applicant's Evidence

4. In paragraphs 15 and 16 of a Statutory Declaration made by Seth Johnson on behalf of the Applicant on 15th May 1997 it was acknowledged that ABERCROMBIE is an established surname. The results of a search carried out on behalf of the Applicant indicated that the surname ABERCROMBIE and its phonetic equivalent ABERCROMBY appeared with the following frequency in various Scottish telephone directories published in 1995/96:

REGION IN SCOTLAND (Date of issue of telephone directory)	ABERCROMBIE	ABERCROMBY
North East Scotland (May 1996)	1	0
Aberdeen, Orkney & Shetland (March 1996)	5	0
Glasgow North (February 1995)	41	10

REGION IN SCOTLAND (Date of issue of telephone directory)	ABERCROMBIE	ABERCROMBY
Glasgow South (February 1995)	18	5
Clyde Coast (April 1996)	26	3
Fife & Kinross (February 1995)	16	1
Borders (June 1996)	3	0
Edinburgh & Lothians (May 1995)	23	2
South West Scotland (January 1995)	1	1
Central Scotland & Trossachs (November 1995)	58	8
Lomond & Argyll (September 1995)	8	6
Clyde Valley (March 1996)	8	4
Highlands & Islands (April 1996)	2	2
Tayside & North Fife (May 1996)	8	7
TOTAL	267	

These figures appear to have been taken from later editions of the telephone directories cited by the Opponent. They reinforce the Opponent's evidence to the effect that relatively few telephone subscribers in Scotland have the surname ABERCROMBIE or its phonetic equivalent ABERCROMBY.

The Principal Hearing Officer's Decision

5. The opposition proceeded to a hearing before Mr. Knight, Principal Hearing Officer acting on behalf of the Registrar of Trade Marks. In a written decision issued on 14th February 2000 he concluded that *“the name Abercrombie is a surname, but on the evidence before me it is not a common one”* and *“it is not one which is prevented from acceptance prima facie”*. He allowed the application to proceed to registration on the basis that ABERCROMBIE was a surname which possessed enough of a distinctive character to be registrable under the 1994 Act even in the absence of a claim to distinctiveness acquired through use in the United Kingdom.

The Appeal

6. In March 2000 the Opponent gave notice of appeal to an Appointed Person under Section 76 of the 1994 Act. In its grounds of appeal it contended that the application for registration ought to have been rejected under Section 3(1)(a) because the surnominal significance of the word ABERCROMBIE was sufficient, in the absence of distinctiveness acquired through use, to render it incapable of distinguishing the Class 25 goods of the Applicant from those of other undertakings.

7. It also maintained that the Principal Hearing Officer should not have allowed the application to proceed to registration under the 1994 Act in circumstances where he had determined (in a decision issued on the same day on the basis of essentially the same evidence in relation to substantially the same goods) that the surname ABERCROMBIE was not *“capable, in relation to the goods in respect of which it is ... proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or*

may be connected in the course of trade from goods in the case of which no such connection subsists” within the meaning of those words as used in Section 10 of the Trade Marks Act 1938 (as amended).

8. At the hearing the Opponent sought and obtained leave (without objection from the Applicant) to amend its grounds of appeal so as to raise the question whether the Principal Hearing Officer should in any event have rejected the application under Section 3(1)(b) of the Act on the ground that the surname ABERCROMBIE was devoid of any distinctive character at the date of the application for registration.

9. The Applicant submitted that the Opponent’s objection under Section 3(1)(a) could not succeed if (as the Opponent appeared to be conceding) the surname ABERCROMBIE was capable of acquiring a distinctive character through use in relation to the goods of interest to the Applicant. It maintained that the Principal Hearing Officer’s rejection of the objection under Section 3(1)(b) was right or at least not so clearly wrong as to be liable to be reversed on appeal. It further maintained that the refusal of registration under Section 10 of the 1938 Act (as amended) was neither inconsistent nor incompatible with the Principal Hearing Officer’s decision to allow registration under the 1994 Act.

The Territorial Coverage of the Application

10. Just as the Community must be taken as a whole when considering whether a mark qualifies for Community-wide protection under the Community trade mark regulation (Case T-91/99 Ford Motor Company v. OHIM 30 March 2000, paragraphs 23 and 24) and just as “*the Benelux territory must be treated like the territory of a Member State*”

when considering the scope of the protection conferred by a Benelux trade mark registration (Case C-375/97 General Motors Corporation v. Yplon SA [1999] ETMR 950, paragraphs 28 and 29), so must the constituent parts of the United Kingdom be taken to form a single integrated territory when assessing the validity of the application for nationwide registration in the present case.

The Territorial Coverage of the Evidence

11. The evidence of the parties is directed to the pleaded proposition that ABERCROMBIE is a common surname in Scotland. It seemed to me that limited sampling of directories of the kind in evidence might be inadequate for the purpose of assessing (in the context of an application for registration in the United Kingdom as a whole) the extent to which the surname ABERCROMBIE could be expected to communicate the fact that the goods with reference to which it was used recurrently were those of one and the same undertaking. I therefore suggested at the hearing that a direction might usefully be given under Rules 51 and 59(2) of the Trade Marks Rules 1994 (now Rules 57 and 65(2) of the Trade Marks Rules 2000) with a view to obtaining information as to the frequency with which the surname ABERCROMBIE and its phonetic equivalent ABERCROMBY appeared in residential and business listings covering not just Scotland, but the whole of the United Kingdom at the relevant point in time. However, both parties asked me to determine the opposition on the basis of the evidence that was before the Principal Hearing Officer. In view of their unanimity on this point I did not insist upon the production of further information.

12. As matters stand there is no evidence on file from which it could properly be concluded that ABERCROMBIE is a common surname in England, Wales or Northern Ireland. I do not think that ABERCROMBIE or its phonetic equivalent ABERCROMBY can be said to be a common surname in Scotland on the basis of the evidence I have noted above. I am left with the impression that in the United Kingdom as a whole ABERCROMBIE and ABERCROMBY are uncommon surnames.

The Objection under Section 3(1)(a) of the Act

13. Section 1(1) of the 1994 Act (implementing Article 2 of Council Directive 89/104/EEC of 21st December 1988) defines a “*trade mark*” as: “*any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.*”

14. Section 3(1)(a) of the Act (Article 3(1)(a) of the Directive) prevents the registration of “*signs which do not satisfy the requirements of section 1(1)*”. The exclusion from registration contained in Section 3(1)(a) of the Act must, so far as possible, be interpreted and applied in conformity with the provisions of Article 3(1)(a) of the Directive: see Case 106/89 Marleasing SA v. La Comercial Internacional de Alimentacion SA [1990] ECR I-4135 paragraph 8. Article 3(1)(a) of the Directive confirms that the prohibition in Section 3(1)(a) of the Act is directed at “*signs which cannot constitute a trade mark*”.

15. Section 1(1) of the Act confirms that “*a trade mark may, in particular, consist of words (including personal names)*” and thereby confirms that surnames are not liable to be regarded as unregistrable per se under Section 3(1)(a). It follows that the surname

ABERCROMBIE cannot be said to be unregistrable under Section 3(1)(a) merely because it is a surname.

16. The question raised by the Opponent's objection under Section 3(1)(a) is whether, as a matter of practical reality, the particular surname ABERCROMBIE "*cannot constitute a trade mark*" for the goods of interest to the Applicant. That, in substance, was the question asked and answered by the Court of Appeal when considering whether the particular surname BACH was validly or invalidly registered according to Section 3(1)(a) in Bach Flower Remedies Trade Marks [1999] IP&T 146 (CA).

17. The evidence on file does not persuade me that the surname ABERCROMBIE was at the relevant date (23rd December 1994) a sign "*which cannot constitute a trade mark*" for such goods. I see no reason to regard it as incapable of distinguishing the Applicant's goods from those of other suppliers. I am therefore unable to accept the Opponent's objection under Section 3(1)(a) of the Act.

The Objection under Section 3(1)(b) of the Act

18. Section 3(1)(b) of the Act (Article 3(1)(b) of the Directive) prevents the registration of "*trade marks*" (i.e. signs which are "*capable of being represented graphically*" and "*capable of distinguishing the goods or services of one undertaking from those of other undertakings*") which are "*devoid of any distinctive character*". In the light of the proviso to Section 3(1) of the Act (see Article 3(3) of the Directive) I understand the word "*devoid*" to be used in the sense of "*unpossessed*" in this connection. The proviso confirms that a trade mark is free of objection under section

3(1)(b) if “*before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it*”.

19. It is clear from paragraph 46 of the Judgment of the European Court of Justice in Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee Produktions – und Vertriebs v. Boots – und Segelzubehör Walter Huber and Franz Attenberger [1999] ETMR 585 that possession of a distinctive character “*is one of the general conditions for registering a trade mark under Article 3(1)(b)*” i.e. under Section 3(1)(b) of the 1994 Act. The distinctive character required by Section 3(1)(b) is “*a pre-requisite for its registration*” (paragraph 44).

20. Paragraphs 43 and 44 of the Opinion of Advocate General Ruiz-Jarabo Colomer in Case C-299/99 Philips Electronics NV v. Remington Consumer Products Ltd (23rd January 2001) appear to recognise that the difference between Section 3(1)(a) of the Act (Article 3(1)(a) of the Directive) and Section 3(1)(b) of the Act (Article 3(1)(b) of the Directive) is one of fact and degree, with signs which have the potential to be distinctive (because they are not incapable of distinguishing) being free of objection under the former provision and signs which actually are distinctive (whether by nature or by nurture) being free of objection under both provisions.

21. A sign does not have to be universally recognised as distinctive in order to be registrable: Bach Flower Remedies Trade Marks (above) paragraph 45 of the judgment of Morritt LJ. A surname, no less than any other sign, must possess enough of “*a distinctive character*” to be perceived as an indication of trade origin by “*the relevant class of persons or at least a significant proportion thereof*”: Windsurfing (above) paragraphs 44,

46 and 52. Paragraph 29 of the Judgment in the Windsurfing case further confirms that the “*relevant class of persons*” consists of “*the trade and ... average consumers of that category of goods in the territory in respect of which registration is applied for*”. The “*average consumer*” of the products concerned is to be regarded as “*reasonably well-informed and reasonably observant and circumspect*”: Case C-342/97 Lloyd Schuhfabrik Meyer GmbH v. Klijsen Handel BV [1999] ETMR 690 paragraph 26.

22. In the decision of the Registrar’s Hearing Officer (Mr. G.W. Salthouse) in the matter of Applications Nos 2051141A and 2051141B and Oppositions thereto under Nos. 46112 and 46113 (SRIS 0/398/00) 26th October 2000 it is noted that:

“A significant number of Member States, including major trading nations such as Germany, France and Italy, have long regarded personal names, including surnames, as inherently distinctive and therefore registrable without evidence of acquired distinctiveness through use. The Community Trade Mark Office adopts a similar practice under the identical legislation contained in Article 7(1) of Council Regulation 40/94”.

I am naturally concerned to find myself taking a less-expansive view of the applicable legislative provisions. However, I do not accept that surnames alone are apt in all cases and in all trading contexts to be regarded as single source specific. I therefore do not consider that surnames alone can always or necessarily be taken to be sufficiently distinctive in the United Kingdom as a whole to perform “*the essential function of a trade mark*” which “*according to the settled case-law of the Court ... is to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others*”

which have another origin”: Case C-39/97 Canon Kabushiki Kaisha v. Metro Goldwyn Mayer Inc [1998] ECR 1-5507, paragraph 28.

23. My approach to the registrability of surnames remains as stated in Mister Long TM [1999] ETMR 406 at 410.

“Section 1(1) of the Act (implementing Article of the Directive) confirms that personal names are eligible to be regarded as signs capable of registration. Different persons having the same name nevertheless share the right to use it in accordance with honest practices in industrial or commercial matters under Section 11(2)(a) of the Act (which gives effect to Article 6(1)(a) of the Directive). And Section 3(1)(b) of the Act (which implements Article 3(1)(b) of the Directive) prohibits the registration of trade marks which are devoid of any distinctive character. These provisions indicate to my mind that surnames are neither automatically eligible nor automatically ineligible for registration under the Act. In each case the question to be determined is whether the surname put forward for registration possesses the qualities identified in Section 1(1) of the Act and none of the defects identified in Section 3. For the reasons I gave at greater length in AD2000 TM [1997] RPC 168 I think that in order to be registrable a surname or any other sign must possess the capacity to communicate the fact that the goods or services with reference to which it is used recurrently by the applicant are those of one and the same undertaking. When assessing that capacity at the relevant date (the date of application) it is, of course, necessary to bear in mind that surnames, as such, are naturally adapted to identify all individuals so named.”

24. The Registrar’s practice in relation to applications for the registration of surnames takes account of those observations. Such applications are currently examined for registrability in accordance with the following guidance (published in Practice Amendment Circular PAC 6/00 on 3rd May 2000).

Surnames alone

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5. In judging the capacity of a surname to distinguish the goods or services of one undertaking the Registrar will consider:

- a) the commonness of the surname;
- b) the number of undertakings engaged in the trade and from whom the goods or services specified in the application can be said to originate.

6. For this purpose the number of relevant undertakings includes manufacturers, designers and *specialist* retailers of goods, and providers of services.

7. The Registrar will continue to have regard to the London Telephone Directory in assessing the commonness of a surname. However, with the continuing increase in the number of telephone users it is now possible for a name which appears a significant number of times in the London Telephone Director to be quite uncommon. Consequently, the Registrar will not regard a surname as “common” unless it appears 200 times in the London or other appropriate telephone directory.

8. Where the goods or services originate from a limited number of traders, e.g. agricultural chemicals or airline services, the average consumer may regard even more common surnames as distinguishing the goods or services of a particular undertaking. The fewer sources of origin there are, the more likely it is that a surname will, if used recurrently, distinguish the goods or services of a particular undertaking.

9. The converse is also true. The more sources of origin there are, the less likely it is that the public will regard a common surname as identifying the goods or services of a single undertaking. So, for example, given the number of sources of clothing and most food and drinks, the public are very unlikely to regard a common surname as identifying the goods/services of one undertaking – at least until such time as they have been educated to that perception. In the professions, such as the legal profession, the use of surnames is very common, which suggests that common surnames will not distinguish except where there are a relatively limited number of sources for the services (e.g. marine surveying). The inability of surnames to distinguish is self evident in some trades. For example, coach companies are often run under names such as “Davies of Monmouth.” One of the reasons for this practice is no doubt that whilst “Davies of Monmouth” is capable of distinguishing the services of one undertaking, “Davies” per se is not capable of distinguishing outside its immediate locality.

10. If, having regard to the above guidelines, the registrar considers that the surname has the capacity to identify the goods/services of a single undertaking, the application may be accepted. If this judgment extends

only to certain goods/services listed within the application, acceptance will be offered for those goods/services only.

Surnames with other meanings

11. Where a word, which is also a surname, is more likely to be taken as a fanciful allusion to the nature of the goods or services (as per MISTER LONG for elongated ice confections), the trade mark may be capable of distinguishing, even though it is also a common surname. However, a common surname should not be accepted simply because it has another meaning e.g. WALKER or READ.

12. Every case should be decided on its own merits taking account of the above guidance.

Phonetic equivalent of a surname

13. Where the mark applied for is merely the phonetic equivalent of a common surname (e.g. Dugglass) it may be accepted unless it is a recognised alternative spelling of the common surname.

Two or more surnames

14. Combinations of two or more surnames may be accepted prima facie.

Surnames – possessive and pluralised

15. If someone applies to register BROWN, account will be taken of entries appearing in the telephone directory in the possessive form (BROWN'S), the plural form (BROWNS) as well as any **obvious** alternative spellings of the same name (BROWNE).

Surnames with initials

16. Similar considerations apply as for surnames. However, a surname with initials may (leaving aside any other considerations) have a higher capacity to distinguish goods or services of a single undertaking, and may be acceptable even where the surname per se would not be.

.....

25. I agree with the general tenor of the guidance provided by this statement of Registry practice. I would nevertheless emphasise that the practice of counting entries in

selected telephone directories should not be taken to preclude the filing of evidence of facts and matters which are relevant to the determination of the question whether a particular surname does or does not satisfy the criteria for registration in relation to the particular goods or services for which registration has been requested: cf Al Bassam TM [1994] RPC 315 at 383 to 385 per Aldous J. (whose observations in this connection were not affected by the judgments on appeal reported at [1995] RPC 511).

26. As I have already said, the evidence on file in the present case leaves me with the impression that ABERCROMBIE and its phonetic equivalent ABERCROMBY are uncommon surnames. No circumstances rendering the surname ABERCROMBIE more or less likely to be perceived as an indication of trade origin in the context of dealings in Class 25 goods of the kind specified in the application for registration have been brought to my attention. I can quite readily conceive that if ABERCROMBIE was used recurrently by the Applicant as a trade mark for such goods, people in the world at large would be united in thinking that they were the goods of one and the same undertaking. It appears to me that the prospect of plural source identification in the course of trade in the relevant goods is more theoretical than real. I therefore uphold the Principal Hearing Officer's rejection of the objection under Section 3(1)(b) of the Act.

The Application Under the Old Law

27. In a decision issued on 14th February 2000 in relation to Application No. 1404289 in Class 25 the Principal Hearing Officer held that the surname ABERCROMBIE was not *“capable, in relation to the goods in respect of which it is ... proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be*

connected in the course of trade from goods in the case of which no such connection subsists” within the meaning of those words as used in Section 10 of the Trade Marks Act 1938 (as amended). His decision reflected the law and practice under the old Act i.e. that a word which was “*according to its ordinary signification*” a surname should generally be refused registration in the absence of evidence sufficient to establish that it had become distinctive of the applicant’s goods or services through use in the United Kingdom prior to the date of the application for registration.

28. For the reasons I have given above, I consider that an application to register a surname as a trade mark under the 1994 Act must be assessed on the basis that surnames are neither automatically eligible nor automatically ineligible for registration, it being a question of fact whether a particular surname is sufficiently distinctive to perform the essential function of a trade mark, in relation to the particular goods or services for which registration has been requested. That is not the same as the test for registrability applied to surnames under the old Act. The law and practice under the old Act perpetuated requirements “*contained (and perhaps to all except experts concealed) in the principle that ‘inherently capable of distinguishing’ in the 1938 Act meant capable in law, not capable in fact: see Re York Trailer [1982] 1 WLR 195 at 198-201*”: Re Procter & Gamble’s TM Application [1999] ETMR 375 (CA) at 381 per Robert Walker LJ. The Principal Hearing Officer’s decision to allow registration of the surname ABERCROMBIE under the 1994 Act was not, in my view, inconsistent or incompatible with his decision to reject it under the continuing provisions of the 1938 Act (as amended).

Conclusion

The appeal is dismissed. I direct the Opponent to pay the Applicant £700 as a contribution towards its costs of the proceedings before me. That sum is payable in addition to the sum awarded by the Principal Hearing Officer in respect of the proceedings below.

Geoffrey Hobbs Q.C.

21st March 2001

George Hamer instructed by Messrs William A. Shepherd & Son appeared as Counsel on behalf of the Opponent.

Richard Arnold Q.C. instructed by Messrs A.A. Thornton & Co appeared as Counsel on behalf of the Applicant.