

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION Nos 2144536 AND 2144538
BY dELiA*s INC TO REGISTER MARKS IN CLASS 3**

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITION THERETO
UNDER Nos 48567 AND 48568 BY BUTTRESS BV**

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**IN THE MATTER OF Application Nos 2144536
and 2144538 by dELiA*s Inc to register marks
in Class 3**

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**IN THE MATTER OF Consolidated opposition
thereto under Nos 48567 and 48568 by Buttress BV**

BACKGROUND

1. On 9 September 1997 dELIA*s Inc applied to register the trade marks dELiA*s and DELIA'S under application numbers 2144536 and 2144538 respectively. The specification for both applications read as follows:-

"Soaps, perfumes, colognes, toilet waters; cosmetics; non-medicated toilet preparations; non-medicated preparations for the care of the skin; preparations for the nails and hair; cotton wool and artificial cotton wool for cosmetic purposes; essential oils; preparations for perfuming the atmosphere; perfumed articles; anti-perspirants and deodorants for personal use; dentifrices."

2. On 18 May 1998 Buttress BV (the opponents) filed two identical notices of oppositions, one against each of the above applications. The oppositions were subsequently consolidated. The grounds of opposition were originally based on Sections 3(3), 3(6), 5(2)(b), 5(3) and 5(4). However, only the ground of opposition based upon Section 5(2)(b) is now pursued. The opponents say they are the proprietors of the following registrations in the United Kingdom:-

Mark	No	Class	Specification
DELIAL	764942	5	Sunburn ointment, medicated creams for the skin and medicated oils
DELIAL	765640	3	Non-medicated toilet preparations
DELIAL	1152568	3	Non-medicated toilet preparations; essential oils; cosmetics; non-medicated preparations for use in sun tanning and for protection against sun burn; non-medicated skin care preparations; non-medicated soaps; cleaning preparations
	1387596	3	Cosmetic preparations, soaps, perfumes

and perfumed non-medicated toilet preparations, essential oils; all included in Class 3.



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Cosmetic preparations, soaps, perfumery, essential oils, non-medicated toilet preparations, sun tan preparations; all included in Class 3.

3. The applicants filed a counterstatement denying the grounds of opposition. There was also reference to the exercise of discretion. It is now well established no such general power exists under the 1994 Act.

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

5. Both sides filed evidence. The matter came to be heard on 27 April 2001 when the applicants were represented by Ms Thomas-Peter of Wildbore & Gibbons and the opponents by Mr M Krause of Haseltine Lake Trademarks.

6. At the hearing Mr Krause stated that the evidence filed by the opponents was to address the issue of identity and similarity of the goods. However, as the applicants accept that identical goods are involved, I do not intend to summarise the evidence submitted by the opponents.

7. The applicants filed a statutory declaration by Mr Evan Guillemin who is the applicants' President. He explains that his company uses the marks applied for in relation to a range of clothing accessories and cosmetics aimed at young girls and teenagers. He provides at Exhibit IG1 a copy of their 1998 Spring catalogue showing how the marks are used in relation to the goods and at Exhibit IG2 a selection of printed pages from the applicants' website. Mr Guillemin goes on to say that his company's first UK sale was in October 1997 and as far as he is aware there have been no instances of confusion.

8. Section 5(2) of the Trade Marks Act 1994 provides:

"5.-(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

The correct approach to the matter has been set out in a number of decisions of the European Court of Justice (ECJ) in particular *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R 77 and *Marco Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 8, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 8, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 8, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 8, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 9, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marco Mode CV v. Adidas AG* page 732, paragraph 41.
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the

section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

9. The opponents are relying on a number of registrations. Three registrations are for the word DELIAL (presented in upper case) whilst another is also the word DELIAL (presented in lower case) with a device of two wavy lines appearing above the word. The final registration is purely a device and is not in my view material to these proceedings. Whilst the applicants' marks differ from one another to the extent that application no. 2144536 is slightly stylised, in my view nothing turns on this point.

10. The applicants do not dispute the existence of the opponents' earlier trade marks. They also accept that identical goods are involved. I therefore need only determine whether or not the respective trade marks are similar.

11. So far as the marks are concerned, Mr Krause argued that there was both aural and visual similarity between the marks, but mainly concentrated his argument on conceptual similarity. In Mr Krause's view the opponents' marks would be seen by some people as the female forename DELIA in variant form. For other consumers there would be no conceptual significance at all and therefore there would be nothing to distance the respective trade marks from each other. Mr Krause also pointed out that from the applicants' evidence it could be established that the goods were relatively low cost, aimed at the youth market and the name DELIA did not appear in very large print on many of the products. Mr Krause concluded that there was a significant risk that a number of people would simply confuse the respective marks and, even being aware and recalling the name correctly, they would think that there was a link between the marks. The care likely to be taken in the purchase of the products was unlikely to be high and the trade mark is not likely to be seen prominently displayed. Therefore, in Mr Krause's view, and making allowance for imperfect recollection, confusion was a significant likelihood.

12. For the applicants for registration Ms Thomas-Peter not surprisingly argued that her client's mark was clearly the possessive form of the female forename DELIA whereas the opponents' registrations were of an abstract invented word having nothing to do with the female forename. The overall impression of the respective marks was tangibly different. Ms Thomas-Peter went on to say that in this particular product area brand choice played a significant point in the purchasing process and therefore brand loyalty and brand recognition were of particular significance. She asked that I did not place too much reliance on the opponents' observations on the way in which her client's mark was used. Normal and fair use of the respective marks has to be considered.

13. It is of course possible to over-analyse marks and in doing so shift the focus away from the real test which is how marks will be perceived by customers in the normal course and circumstances of trade. There are self-evidently points of similarity between the words. They have the first five letters in common but they are relatively short words where small differences are more easily noticed. More importantly one is the possessive form of a recognised female forename, the other an invented word. I cannot accept the suggestion put forward by Mr Krause that the opponents' mark DELIAL would be seen by the average person as a variant of the female forename DELIA, and indeed there was no evidence before

me to support this view. Consequently, I have difficulty in accepting that the average consumer would make any conceptual link between the two marks or that there is any real risk of aural confusion.

14. The opponents' strongest case seems to me to be the visual similarity between the marks accepting, as I do, that most cosmetics are purchased on the basis of visual inspection. Marks may be presented or viewed in a variety of ways and I accept the point made by Mr Krause that on certain goods the mark would not be prominently displayed. I would hesitate to rule out entirely the possibility that a customer, perhaps viewing goods from a distance, might be mistakenly drawn to the wrong mark. However, I do not see it as being a likely rather than merely a possible occurrence. It would be a momentary confusion that would not survive the normal purchasing process where rather closer attention is likely to be paid to the brand name.

15. In short, given the difference between the marks and taking into account all the relevant factors, including imperfect recollection, I believe the possibility of confusion is significantly remote that it cannot be regarded as a likelihood. The opposition under Section 5(2)(b) fails.

16. In their skeleton argument the applicants requested an award of costs to reflect the inconvenience and expenses involved in dealing with an opposition which in their view appeared to have been brought without any serious intention to pursue the allegations made. However, having regard to the above, it is clear that I do not take the view that the opponents had an unarguable case and consequently I see no reason to depart from the Registrar's published scale of costs.

17. I order the opponents to pay the applicants sum of £770. The sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29TH day of June 2001

DAVID MORGAN
For the Registrar
the Comptroller-General