

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

**IN THE MATTER OF APPLICATION No 2201928  
BY MILORDS INTERNATIONAL LIMITED  
TO REGISTER A TRADE MARK IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION No 50413 THERETO  
BY CANADELLE LIMITED PARTNERSHIP**

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**IN THE MATTER OF Application No 2201928  
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**IN THE MATTER OF Opposition No. 50413 thereto  
by Canadelle Limited Partnership**

**BACKGROUND**

1. On 2 July 1999 Milords International Limited of Leicester, applied to register the trade mark FUNDERBRA in Class 25 in respect of [brassiers] and lingerie. The application numbered 2201928 was accepted and published and on 18 November 1999 Canadelle Limited Partnership, Montreal, Canada filed notice of opposition against the application.

2. In summary the grounds of opposition are based upon Section 5(2)(b) because they allege that the trade mark in suit is similar to earlier protected trade marks in the ownership of Canadelle Limited Partnership and which are registered for identical or similar goods. Details of the earlier protected trade marks are shown below:

<u>Trademark</u>	<u>Number</u>	<u>Class</u>	<u>Specification</u>
WONDERBRA	998377	25	Brassieres
THE ONE AND ONLY WONDERBRA	1568080	25	Swimwear incorporating provision for bust support; brassieres; panties; briefs; bodies; all included in Class 25
WONDERBRA	2010010	25	Swimwear incorporating provision for bust support; brassieres; panties; briefs; bodies
WONDERBRA BLISS	2117879	25	Swimwear incorporating provision for bust support; brassieres; panties; briefs; bodies

WONDERBRA LIFESTYLE    2117880    25    Swimwear incorporating provision for bust support; brassieres; panties; briefs; bodies

The opponents are also the proprietors of Community Trademark No. 1047554 WONDERBRA BLISS, in Class 25, in respect of: “Brassiere, panties, girdles and underwear”.

3. Also, because of the extensive use and reputation the opponents claim to enjoy in respect of these earlier rights, they consider that they are in a position to prevent the use of the applicants’ trade mark by virtue of the law of passing off and therefore the registration would be contrary to the provisions of Section 5(4)(a) of the Act.

4. The applicants for registration accepted that the opponents are the owners of some of the earlier trade marks and that they are registered in respect of similar goods to those for which the applicants seek to register their trade mark. But they deny that their trade mark and the opponents trade marks are similar and they deny that the registration of the trade mark applied for would be contrary to the provisions of Section 5(4)(a) of the Act.

5. Both sides filed evidence in the proceedings, however, neither party responded to the Trade Mark Registry's request to let it know if they wished to be heard in the matter. After due consideration therefore, of the pleadings and evidence filed, I give this decision.

### **Opponents' Evidence**

6. This consists of a Statutory Declaration dated 11 July 2000 by Arthur J DeBaugh who is a Vice President and Assistant Secretary of Canadelle Limited Partnership. He provides details of the company's trade marks, referred to earlier, and states that the trade mark WONDERBRA has been used in the United Kingdom for over 30 years. This use has been by his company, its predecessors and by licensees and affiliates. Playtex UK Limited has used the WONDERBRA and the ONE AND ONLY WONDERBRA trade marks under licence since January 1994; WONDERBRA BLISS has been used by them since February 1998. Gossard were previous licensees of these trade marks.

7. Mr DeBaugh exhibits material which shows how WONDERBRA and the ONE AND ONLY WONDERBRA have been advertised and promoted by both Playtex UK Limited and Gossard. The bulk of these advertisements and promotions are in respect of brassieres.

8. In addition to the licensees own promotional material, Mr DeBaugh states that advertising and promotion of the above mentioned trade marks has been carried out through radio and television, newspapers and magazines. This has taken place in magazines such as Vogue, Cosmopolitan, Marie Clare, Company, Sugar, Elle, She, Red, Hello, More, Bliss, B, New Woman, and that there have been poster campaigns.

9. In the period January 1994 to June 1999 retail sales amounted to \$83.3 million and 6 million units (which I assume are individual brassieres) were sold. The advertising expenditure in the same period amounted to \$8.5 million.

10. Mr De Baugh goes on to express his opinion on the effect the registration of the applicants' trade mark might have in terms of damaging his company's business; on the similarity, in his view, of the applicants and the opponents' trade marks and the likelihood therefore of consumers assuming either that FUNDERBRA products are in fact WONDERBRA products or that FUNDERBRA products are part of or an extension to the WONDERBRA range.

11. Mr DeBaugh concludes by stating that his company's WONDERBRA trade mark has undoubtedly acquired distinctiveness in the United Kingdom as a result of the extensive use which has been made of it.

### **Applicants' Evidence**

12. This consists of a Statutory Declaration by Zubeir Ismail who is the Managing Director of Milords International Limited.

13. First of all, he states that the prefix FUN is one which is commonly used in trade marks in respect of items of clothing in Class 25. He provides details from the Trade Marks Register. Whilst he is not aware of how all of these trade marks are used, he believes they all convey a sense of jollity and amusement and provide a lighthearted jokey image. His company is the proprietor of the trade mark FUNDERWEAR in respect of underwear and lingerie; socks and hosiery; nightwear; sportswear and leisurewear in Class 25. This was registered with effect from 1 March 2000.

14. Though the trade mark FUNDERWEAR is not yet in use, Mr Zubier Ismail states that it was devised by the applicants as a play on the word "underwear" for a new range of novelty underwear for both men and women. The aim was to convey a fun theme through the style of the products themselves, their packaging and the trade mark. He exhibits copies of notes and examples of art work to support his statements. Having developed the concept of the FUNDERWEAR range of products they considered associated trade marks and decided to expand the range to include the trade mark FUNDERBRA for a similar line of novelty underwear. Again, in Mr Zubier Ismail's view, this conveys a jokey lighthearted image for items designed to amuse.

15. Mr Zubeir Ismail goes on to provide his opinion on the differences between the applicants' and the opponents' trade marks. In particular he refers to the dictionary meanings of the prefixes 'wonder' and 'fun'. He also expresses the view that because, as Mr DeBaugh asserts, the opponents' trade marks enjoy a very substantial reputation in the United Kingdom with a high brand awareness, then the reputation of the opponents in respect of the goods in question rests solely on the 'wonder' prefix and does not extend to any other. Also the WONDERBRA product provides a specific shaping effect and that it is for this effect that the products are known. Therefore, in his view, it would be immediately obvious to any member of the public encountering an item of lingerie marked with the word FUNDERBRA that the lighthearted jokey nature of the mark suggested a novelty product and not one designed to perform a serious shape enhancing function. Thus he believes that the conceptual differences between the trade marks are significant.

## **Opponents' Evidence in Reply**

16. This consists of a Statutory Declaration by Mr Arthur J DeBaugh dated 25 January 2001. Mr DeBaugh responds to Mr Zubier Ismails' declaration. In particular he comments that the earlier registrations mentioned by him which have the prefix 'fun' are not altogether relevant. In this particular case the trade mark which is the subject of the opposition has the prefix FUNDER as opposed to the prefix FUN ie. the trade mark which is the subject of the opposition is FUNDERBRA and not FUNBRA. In his opinion, the respective trade marks are phonetically similar.

17. Mr DeBaugh goes on to point out that while the trade mark FUNDERWEAR is a simple adaption of the word underwear this is not the case with FUNDERBRA; the combination of the FUNDER prefix with the term bra results in the applicants trade mark, which is phonetically and visually similar to his company's trade marks. Accordingly, he considers that whilst the applicants' registration for FUNDERWEAR is acceptable vis their trade marks, the application in respect of FUNDERBRA is not.

18. That concludes my review of the evidence by both sides, insofar as I consider it relevant to these proceedings.

## **DECISION**

19. The first ground of opposition is based on Section 5(2)(b) of the Act. This reads as follows:

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

(a) .....

(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."

20. An earlier right is defined in Section 6, the relevant parts of which state:

"6.-(1) .....

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,...."

21. Neither side have suggested that there are any differences in the nature of the goods covered by the application for registration and the opponents' registrations. That I think is

correct, and I proceed therefore on the basis that identical or similar goods are involved.

22. In respect of the comparison of trade marks in cases such as this I look to the guidance provided by the European Court of Justice (ECJ) in *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 *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

From these it can be deduced that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, 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*, 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.* 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*, 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*, 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*, 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*, 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*, 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; *Marca Mode CV v. Adidas AG*, 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*, paragraph 29.

23. I am satisfied, and I think the applicants too recognise, that the opponents have a significant reputation in the United Kingdom, as a result of sales and advertising and promotion generally in respect of the trade mark WONDERBRA when used in relation to brassieres. I am not convinced that the same reputation attaches to the other trade marks in the opponents' ownership and referred to in these proceedings or that the reputation extends to other goods. But suffice is to say that I am satisfied that this reputation is one which has enhanced the distinctive character of the WONDERBRA trade mark of the opponents and is a factor I should take into account here. Indeed, I will base my comparisons between the applicants' trade mark and the opponents' WONDERBRA trade mark because if they are unable to succeed in respect of that trade mark they are not likely to do so in respect of any of the others.

24. Though the average consumer normally perceives a trade mark as a whole I do not overlook the fact that in this particular case the prefixes of the two marks are different. On the one hand the applicants' trade mark consists of the prefix 'fun' (not funder as Mr DeBaugh suggests) whilst the opponents consists of the prefix "wonder". Both of these words are ordinary dictionary words with their own separate and distinct meanings. But, looking at the overall impression that the two marks are likely to create I consider that visually there are some similarities, they are the same length with only the first two letters of each trade mark differing; in both cases the suffix will be recognised as the goods (bra being a recognised abbreviation for brassiere). In aural use though the applicants trade mark consists of three syllables and the opponents only two they would be pronounced similarly and the sound of the hard 'f' and 'w' could be mis heard. And there are some, but limited, conceptual similarities between the word 'wonder' and the word 'fun' when associated with the goods (a bra). But do all of these things add up to the likelihood of confusion of the consumer if the two trade marks were in use alongside each other in the market place?

25. Given the reputation of the earlier trade mark WONDERBRA which has through use become a very distinctive trade mark, together with the similarities between the respective trade marks and the identity of the goods then I think that there is the likelihood of confusion. In this particular case the probability is that the relevant consumers (circumspect, aware and informed) will not see the jokey image that the applicants suggested would be attached to their trade mark FUNDERBRA. Also, the reputation of the opponents' trade mark in relation to brassieres is such that customers will, in my view, associate the applicants' trade mark with that of the opponents to the extent that they will wrongly believe, as Mr DeBaugh intimated, that the respective goods come from the same or economically linked undertakings. In particular, I have attached a significant amount of weight to the aural similarity between the respective trade marks. Though clothing is, by and large, purchased, by sight (and therefore it is the visual impact that is probably the more important aspect to assess in that area of commerce) in the case of underwear and brassieres in particular I cannot ignore personal recommendation and/or a customer asking for the product by name - one interested in, in Mr

Ismail's words, its serious shape enhancing function. I also note the ECJ's comments in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* where they said:

“... it is possible that mere aural similarity between trade marks may create a likelihood of confusion with the meaning of Article 5(1)(b) of the Directive. The more similar the goods or services covered and the more distinctive the earlier mark, the greater the likelihood of confusion.”

26. That is precisely the situation here. The goods involved are the same or similar and are likely to be asked for by name or be the subject of personal recommendation in view of the highly distinctive nature of the earlier trade mark. In the circumstances registration of the word FUNDERBRA in the face of the earlier trade mark WONDERBRA is likely to cause confusion. Even though I have held that the reputation in the trade mark is in relation only to brassieres I think that the association between it and other items of underwear is likely. The opposition under Section 5(2)(b) therefore succeeds in respect of all of the goods of the application.

27. Next I consider the ground of opposition under Section 5(4)(a) 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 -

- (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
- (b) .....

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.”

28. 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:

"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".

"A helpful summary of the elements of an action for passing off can be found in *Halsbury's Laws of England* 4<sup>th</sup> 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 *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:



"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;

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

(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."

29. I have already found that the opponents' goods have acquired a reputation in the market place and are known by the distinguishing feature, the trade mark WONDERBRA. I have also determined that there is the likelihood of confusion between the applicants' trade mark and the opponents' trade marks. In my view that is sufficient to suggest that that is likely to lead to the public believing that the goods offered by the applicants are the goods of the opponents. As a result, I believe that the opponents would suffer damage. In the circumstances, I am satisfied that the opponents have discharged the onus upon them to demonstrate that they would be likely to win an action against the applicants for registration on the basis of the common law tort of passing off. Therefore, the opposition under Section 5(4)(a) also succeeds.

30. As the opponents have been successful, they are entitled to a contribution towards their costs and I therefore order the applicants to pay to them the sum of £800. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of the case if any appeal against the decision is unsuccessful.

**Dated this 9<sup>TH</sup> day of August 2001**

**M KNIGHT  
For the Registrar  
The Comptroller-General**