

**IN THE MATTER OF APPLICATION NUMBER 2148918  
IN THE NAME OF THE LONDON TOBACCO COMPANY LIMITED  
TO REGISTER A TRADE MARK IN CLASSES 9, 16, 18, 41 and 42**

**And**

**IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 49416  
BY Benetton Group SpA**

**IN THE MATTER OF application number 2148918  
in the name of The London Tobacco Company Limited  
to register a trade mark in Classes 9, 16, 18, 41 and 42**

**And**

**In the matter of opposition thereto under number 49416  
by Benetton Group SpA**

**Background**

On 23 October 1997, The London Tobacco Company Limited filed an application to register a trade mark in Classes 9, 16, 18, 41 and 42 in respect of the following goods and services:

- Class 9**           Sunglasses, spectacles and cases therefor; binoculars; anti-theft warning apparatus; remote locking apparatus; personal security apparatus; encoded and magnetic cards; batteries; communications apparatus; receivers; satellite apparatus; video apparatus and cassettes; audio apparatus and cassettes; compact disc apparatus and discs; digital apparatus and digitising apparatus; books on discs and tapes; films; tapes; discs; hardware and software all bearing recordings; photographic apparatus; recording apparatus; computer apparatus and peripherals; computer software and hardware; anti-glare screens; computer discs; parts and fittings for all the aforesaid goods.
- Class 16**           Stationery; materials and printed matter for advertising signs; pictures; photographs; posters; stamps; book covers and bindings; portfolios; newspapers; magazines; comics; printed publications; manuals; catalogues; annuals; business papers; address books; albums; autograph books; diaries; scrap books; writing pads and blocks; binders; calendars; planners; organisers; greetings cards; computer manuals; stickers; stencils; transfers; bags; packaging, all either of paper, card, plastic; parts and fittings for all the aforesaid goods.
- Class 18**           Leather and imitation leather goods not included in other classes; luggage including trunks, holdalls, rucksacks and travel bags; umbrellas and parasols.

- Class 41** Leather and imitation leather goods not included in other classes; luggage including trunks, holdalls, rucksacks and travel bags; umbrellas and parasols.
- Class 42** Accommodation reservation, including hotel and motel reservation; hotels, restaurants, bars, cafes, snack bars, theme bars, bistros, cafeterias and canteens and catering services relating thereto; cocktail lounge services; providing facilities for exhibitions and conferences; as well as advisory services in respect of all the aforementioned services.

The mark applied for is as follows:



On 26 January 1999, Benetton Group SpA filed notice of opposition in which they say they are the proprietors of the trade marks shown as an annex to this decision. The grounds of their opposition are in summary:

- 1. Under Section 3(3)(b)** because the mark applied for is of such a nature as to deceive the public as to the origin of the goods.
- 2. Under Section 3(4)** because use of the mark applied for in respect of any of the goods and services of their application would be liable to be prohibited by an enactment of law.
- 3, Under Section 3(6)** because in view of the opponents' use and reputation in their trade mark, the application was made in bad faith.
- 4. Under Section 5(1)** because the mark applied for is identical to the earlier trade marks owned by the opponents and is sought to be registered for goods and services that are identical to those for which these earlier trade marks are protected.

- 5. Under Section 5(2)(a)** because the mark applied for is identical to the earlier trade marks owned by the opponents and is sought to be registered for goods and services that are identical or similar to those for which these earlier trade marks are protected.
- 6. Under Section 5(2)(b)** because the mark applied for is similar to the earlier trade marks owned by the opponents and is sought to be registered for goods and services that are identical or similar to those for which these earlier trade marks are protected.
- 7. Under Section 5(3)** because the mark applied for is identical or similar to the earlier trade marks owned by the opponents and is sought to be registered for goods and services that are not similar to those for which these earlier trade marks are protected and enjoy a reputation, such that use of the mark applied for would take unfair advantage or be detrimental to the distinctive character or repute of these earlier trade marks.
- 8. Under Section 5(4)(a)** by virtue of the law of passing off.
- 9. Under Section 5(4)(b)** because use of the mark applied for is liable to be prevented by virtue of an earlier right, in particular by virtue of Section 56(2) of the Act in that the opponents' trade marks are entitled to protection under the Paris Convention as well known trade marks.

The opponents also ask that the application be refused in the exercise of the Registrar's discretion, but as in my view the Act does not confer upon the Registrar any discretion to refuse a mark that is not contrary to the provisions of the Act or Rules I do not intend to give this matter any further consideration.

The applicants filed a counterstatement in which they deny all of the grounds on which the opposition is based. Both sides request that an award of costs be made in their favour.

Both sides filed evidence in these proceedings. The matter came to be heard on 8 January 2002, when the applicants were represented by Mr Andrew Much of Withers & Rogers, their trade mark attorneys, and the opponents by Mr Guy Tritton of Counsel.

## Opponents' evidence

This consists of an Affidavit dated 8 October 1999 and comes from Giovanni Tretti, General Counsel of Benetton Group S.p.A. Mr Tretti says that he has been with his company for one and a half years and in his present position since 1 January 1998. He confirms that he has full access to all documents and papers.

Mr Tretti says that his company owns shops and branch offices, inter alia, in the United Kingdom, and sells various products including clothing. He refers to exhibit A which consists of details of the trade marks owned by his company throughout the world, including the United Kingdom, saying that up to September 1998 his company had owned 900 trade marks incorporating the word COLORS and around 200 characterised by the word COLORS alone.

Mr Tretti says that his company has been using the word COLORS within its trade marks since 1986, details of the United Kingdom marks being shown as exhibit B, and to claim that the trade mark The United Colors of Benetton has been recognised throughout the world as a well known trade mark. He says that his company has used "COLORS" marks in connection with clothing and a range of other products, which he lists.

Mr Tretti says that there are 3935 shops worldwide that sell his company's products, and that the apparel and accessories bearing the mark UNITED COLORS OF BENETTON being available for sale at 138 outlets in the United Kingdom, details of which he gives as exhibit C. He goes on to list the global turnover for the years 1994 to 1998, and the United Kingdom turnover for the years 1993 to 1998, which are as follows:

1993	£20,845,795
1994	£17,191,474
1995	£15,535,250
1996	£23,385,467
1997	£26,199,511
1998	£17,923,388

He does not say if, or to what extent this trade has been under any of the COLORS trade marks he has referred to. He also appears to say that his company has traded within the United Kingdom since 29 October 1979, although given his earlier statement, not under the COLORS trade marks.

Mr Tretti says that goods bearing the trade mark The United Colors of Benetton are promoted in the media, and gives the expenditure in the United Kingdom between the years 1994 to 1998 as follows:

1994 Lit 1.546.000.000  
1995 Lit 1.589.000.000  
1996 Lit 2.011.000.000  
1997 Lit 1.744.000.000

He refers to exhibit E which consists of various items of promotional material, most of which cannot be identified as having been available within the United Kingdom. One part of the exhibit dating from 1993 appears likely to have been used with the United Kingdom to promote a range of stationery items under the trade mark The United Colors of Benetton. Mr Tretti next refers to exhibit F which consists of a collection of press articles relating to Benetton, none of which can be clearly said to have been published in the United Kingdom prior to the relevant date. One item from a publication entitled Shots makes reference to COLORS being first published in 1991 and makes several references to the United Kingdom although it would be going too far to infer that this substantiates use of COLORS solus in the United Kingdom from that date. Mr Tretti does, however, claim that through the use of the trade marks the consumers of every country in the world has become used to associating the word COLORS with his company's products.

Mr Tretti refers to his company having registered, or having applied to register the trade mark COLORS in many countries, including the United Kingdom, details of which he shows as exhibit G. He also refers to his company having used the trade mark in relation to perfumes, referring to exhibit H. This consists of advertisements for COLORS perfume although can not be dated prior to the relevant date, nor identified as having been used within the United Kingdom.

He next refers to exhibit I which consists of a copy of a magazine called COLORS which Mr Tretti says was distributed within the United Kingdom. The magazine is dated Dec 1998- Jan 1999 so post dates the relevant date. The cover is noted 29 which is an indication that it is the 29<sup>th</sup> edition. This can be ascertained from the page fronting the back inside page which contains a representation of 28 front covers for COLORS magazine and stating that subscriptions and back issues in eight bilingual editions (but not English) were available in various countries, although not the UK. The prices listed on the bottom of the front cover shows £4 for the United Kingdom edition, and the inside back cover lists a distributor in London, both of which are a reasonable indication that this edition of the magazine was available in the UK, but does not establish with any certainty that this was the case for earlier editions.

Mr Tretti goes on to say that his company is commercialising frames, eyeglasses and sunglasses and cameras under the trade mark COLORS and The United Colors of Benetton. He refers to exhibit J which consists of details of sunglasses available under both of these marks, and disposable cameras available under The United Colors of Benetton mark. There is nothing to say that this exhibit pre dates the relevant date or that any of it was available within the United Kingdom. The exhibit does show use of

COLORS on its own but there is a possibility that the manner of use may be taken as a reference to the fact that the eye wear comes in various colours. Mr Tretti gives details of the turnover in respect of these goods but does not say whether these relate to the United Kingdom, and consequently, are of little use in gauging the extent of any acquired reputation.

Mr Tretti goes on to refer to the application in suit, and to say that to protect its trade marks his company has filed more than 50 oppositions in various jurisdictions against COLORS (and similar) marks. Details of the oppositions are given in exhibit L. He goes on to say that the public would connect the mark applied for with his company which would cause deception and confusion.

### **Applicants' evidence**

This consists of a Witness Statement dated 11 January 2001 from Toe Su Aung, an authorised attorney of The London Tobacco Company Limited. Ms Aung says that her statement comes from her own knowledge or from the records of the applicants to which she has full access. Ms Aung says that where she has been advised of facts by someone else she believes the same to be true and accurate having specifically requested confirmation of the accuracy and truth of such facts from the source of the information.

Ms Aung refers to the Affidavit of Mr Tretti, commenting that the ownership of trade marks outside of the United Kingdom is irrelevant. She goes on to say that the mark applied for is distinct from the prior registrations set out in the statement of grounds, and although two were considered by the registrar to be in conflict these were waived on amendment of the specification. She notes that these registrations carry a disclaimer to exclusive rights in the word COLORS as are many of the others relied upon in the opposition. Details of the examination report, the amended specification and Journal advertisement relating to the application are shown as exhibit TSA1.

Ms Aung gives her opinion that the only area of conflict between the application and the opponents' registrations is to be found in number 2012826, but that there are clear differences between the marks, namely the "crest" device on a striped background, the triple line border, the stylisation of the opponent's mark and their American spelling COLORS, the combined effect of which will alert the averagely informed member of the public who is familiar with the opponents.

Ms Aung refers to the fact that the applicants are the proprietors of a number of registrations in Class 34, noting that they co-exist in the same class with the opponents' mark UNITED COLORS OF BENETTON. Details of these marks are shown as exhibits TSA2 and TSA3 respectively. Ms Aung says that if these can co-exist she cannot see why the marks cannot do so in other classes.

Ms Aung comments on the claim by Mr Tretti that the opponents have been using the trade marks UNITED COLORS OF BENETTON and UNITED COLORS on a wide variety of goods including sunglasses, stationery, leather goods, cigarette lighters and ashtrays. She says that whilst the evidence shows examples of Benetton trade marks being used in relation to school bags and stationery, the majority relate to the mark UNITED COLORS OF BENETTON which is clearly distinguishable, but in any event, there is no indication of the extent of sales nor whether there have been any within the United Kingdom.

Ms Aung comments on the United Kingdom turnover figures given by Mr Tretti, saying that those for 1998 are irrelevant because they post date the relevant date, that there is no indication of the proportion relating to clothing and/or other goods, noting exhibit D relates exclusively to clothing. She asserts that given the scale of the overall market the turnover given by Mr Tretti is not substantial. Ms Aung makes the same comments in relation to the opponent's advertising.

Ms Aung goes to exhibit F of Mr Tretti's Affidavit which consists of copies of articles from publications that refer to the opponents' goods, asserting that only those written in English or likely to be published in magazines and newspapers circulated in the United Kingdom are of relevance. She refers to the opponent's worldwide trade mark applications and registrations saying that other than those registered in the United Kingdom these are irrelevant.

Ms Aung goes to the opponents' own magazine entitled "COLORS" shown by Mr Tretti as exhibit I, noting that it post dates the relevant date, that Mr Tretti does not say whether the magazine was available within the United Kingdom, and if so, how many copies were sold. She says that exhibit F is a Benetton publication which under the heading "Look and Learn" states that the COLORS publication is produced six times each year and sells around 45,000 copies per issue, Ms Aung saying that as the circulation is stated to cover more than 80 countries this would indicate sales in the United Kingdom of no more than 5,500. She also notes that the article states that the editorial staff do not actively promote the association with Benetton.

Ms Aung says that in exhibit J Mr Tretti makes specific mention of use of COLORS in connection with sunglasses and cameras. Ms Aung says that although the exhibit shows use of COLORS in respect of sunglasses the same cannot be said of cameras. She accepts that the mark UNITED COLORS OF BENETTON has been used in connection with disposable cameras but that there is no indication that either of these goods were ever available in the United Kingdom, and if they were, the extent of any sales.

Ms Aung goes on to refer to Mr Tretti's statement that the opponents have taken action to protect the marks that they own throughout the world, describing this as irrelevant. Ms Aung summarises the case as she sees it, concluding that there is little evidence to



reinforce the opponents' claim that the mark COLORS is distinctive of them in the United Kingdom. She says that many of the marks relied upon in the opposition are distinguishable from the applicants' mark, and that with the exception of one registration, number 2012826, the opponents do not have exclusive rights to the word COLORS in the United Kingdom, and consequently, that any possible conflict must exist in the goods covered by that registration, namely Classes 9 and 18 alone. Ms Aung says that the opponents have provided little evidence of use of the word COLORS alone in relation to goods in these classes, and no evidence of use in respect of any goods prior to the relevant date, and consequently, cannot have acquired any goodwill.

### **Opponents' evidence in reply**

This consists of a Witness Statement dated 5 September 2001 from Pierluigi Bortolussi, Tax and Legal Affairs Director of Benetton Group S.p.A. Mr Bortolussi confirms that the facts set out in his Statement are from his own knowledge or from the company records to which he has full access.

He begins by referring to the Witness Statement of Toe Su Aung filed on behalf of the applicants. He refutes the suggestion that exhibit A to Mr Tretti's Statement is irrelevant because it shows that the opponents have a widespread presence throughout the world and that their trade marks are universally used and recognised, the language being immaterial. Mr Bortolussi says why he considers Toe Su Aung's claims, inter alia, relating to the distinctiveness of the mark applied for in relation to prior registrations, the examination report issued by the registrar and the necessity for a disclaimer to be mere opinion.

Mr Bortolussi reiterates his assertion that his company's trade marks transcend local languages and that it is apparent that the content of Exhibit B are perfectly clear to Ms Aung. He goes on to say that he disagrees with Ms Aung's assertion that the mark The United Colors of Benetton is clearly distinguishable from the mark applied for, noting that it is not claimed that UNITED COLORS is distinguishable.

Mr Bortolussi restates the date of first use of the mark COLORS in the United Kingdom as being 1994, referring to Exhibit 1 which consists of printed matter in the form of a catalogue relating to and depicting eye wear, and cases for such goods promoted under the trade marks The United Colors of Benetton and COLORS. Although some of the exhibit can be dated as originating prior to the relevant date, there is nothing that I can see that conclusively shows that any of this material was available within the United Kingdom.

He goes on to refer to exhibit 2 which consists of a selection of invoices from United Optical Trading, which can be seen from exhibit 1 to be the manufacturer of the opponents' range of eye wear. Some of the invoices date from 1995 to 2000, which is after the relevant date. Those prior to the relevant date are addressed to S.A.B. UK

Limited and Waterside Laboratories Limited and relate to the delivery of COLORS frames, sunglasses and cases. The product coding on the invoices relate to the goods mentioned in exhibit 1. Mr Bortolussi sets out the turnover for the years 1995 to 2000 in respect of the licensed use of COLORS in relation to the goods referred to in exhibit 1, which ranges from £14,500 in 1995 rising to £44,500 in 1997, the last full year prior to the relevant date.

He refers to exhibit 3 which consists of two pages depicting bags (not bearing the COLORS mark), belts (bearing the word COLORS on the buckle) and a baseball style cap (bearing the word COLORS on the back and possibly on the front). Each item is shown with a code number. The exhibit also consists of a selection of invoices, the earliest dating from January 1996 from Benetton to S.A.B. UK Limited. Although the invoices do not show the word COLORS in association with the products, some of the code numbers can be seen to be those shown alongside the items in the first two pages of the exhibit. Mr Bortolussi sets out the turnover for the years 1996 to 1999 relating to the licensed use of COLORS in relation to the goods referred to in exhibit 3, and which ranges from £35,107 in 1996 rising to £38,723 in 1997, the last full year prior to the relevant date.

Mr Bortolussi refers to exhibit 4 which consists of promotional materials, such as catalogues for Benetton products, primarily clothing but also eye wear, bags, belts and the like, some of which show the word COLORS used in association, or on sew-in labels. There is also a mention of disposable cameras available under The United Colors of Benetton. Although one page lists United Colors of Benetton stores in the United Kingdom, it is not possible to say that the exhibit shows use of COLORS solus prior to the relevant date. He sets out the turnover for the years 1992 to 1997 relating to use of the marks COLORS, UNDERCOLORS and UNITED COLORS OF BENETTON in relation to the goods referred to in exhibit 4, and which is as follows:

1992	£25,748,784.34
1993	£20,373,894.76
1994	£16,701,218.55
1995	£16,932,088.21
1996	£22,152,809.20
1997	£24,807,945.72

Mr Bortolussi again reiterates that the language in which his company's trade marks are expressed is immaterial, fashion being visual. He says that fashion and style magazines in every language are available in the United Kingdom. He asserts that exhibits F to H of Mr Tretti's Affidavit demonstrate that where the company's trade marks are concerned the language is global, and that since fashion is visual, language is unimportant to the reader, asserting that fashion magazines in every language are available in the United Kingdom.

Mr Bortolussi says that evidence of trade mark disputes outside of the United Kingdom

demonstrate the opponents' stewardship and protection of its marks. He refers to Exhibit 5 which consists of a publication entitled COLORS and is described as a merchandising book. The following page is endorsed 2000 which would seem to be an indication of its year of origin; there is nothing else by which to date it. The book gives details of point-of sale and other promotional materials such as posters, carrier bags, etc, that are available to promote the COLORS range. There is nothing to indicate that the book was available to UK retailers although this does seem likely to have been the case.

The remainder of Mr Bortolussi's Witness Statement is directed at refuting points or allegations made by Ms Aung and adds no material facts to this case. He concludes by saying why he considers the respective marks to be confusingly similar, namely, the assumption of normal and fair use, his company's use of the mark and acquired distinctiveness and reputation, and the similarity in identity of the respective marks.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

### **Decision**

At the hearing Mr Tritton said that the opponents were only relying on the grounds under Section 5(2), Section 5(3) and Section 5(4)(a) and that the remaining grounds could be ignored. With that in mind, I turn first to consider the grounds under Section 5(2). That section reads as follows:

**"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."

An earlier trade mark is defined in Section 6 of the Act as follows:

**"6.-(1)** In this Act an "earlier trade mark" means –

- (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,"

In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC117, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca 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*, 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 Schufabrik 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 224;
- (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.

The opponents rely on a large number of marks, of which two, nos 2155188 and 2183790 post date the relevant date and do not constitute earlier marks.

A further 18, nos, 1370498, 1459293, 1520542, 1431245, 1431246, 1431247, 1491663, 1362692, 1370496, 1320738, 1362693, 1370497, 1311771, 1320739, 1362694, 1370498, 1495901 and 1370499 have been registered with a disclaimer to the exclusive use of the word COLORS, albeit in one case separately but the effect is the same. One further mark, no. 1375324 has the words COLORS DE disclaimed which I would take to have the same effect as a disclaimer to rights in the word COLORS solus.

The reason for the disclaimer of the word COLORS is, I believe self-evident. It is the American English spelling of the word COLOURS, an ordinary descriptive word, the meaning of which would be known by any consumer familiar with the English language. In respect of any goods (or services) where colour could be a feature it must be regarded as prima facie devoid of any distinctive character.

In the case of *PACO v PACO LIFE IN COLOUR*, (2000) RPC 451 the Hearing Officer held that the entry of a disclaimer should be taken as admission by proprietor that the disclaimed matter is not to be regarded in itself as being distinctive of their goods or services. The hearing officer went on to say that use of disclaimed element by another party as a trade mark cannot, by itself, be sufficient to give rise to a likelihood of confusion and that once a disclaimer is entered the admission is made and the proprietor must live with the result. I see no reason to adopt a contrary view.

Another four marks, nos. 1274321, 2109699, 2012045 and 2109705 have the word COLORS in combination with another element, namely, COLORS DE BENNETON and UNITED COLORS OF BENETTON. There is nothing that I can see that distinguishes these registrations from those where the word COLORS has been disclaimed. I see no logical reason why that word solus should prima facie be considered distinctive of the goods covered by the registration and conclude that the acceptance of these marks was because some other element or the combination of elements made them so.

In any comparison regard must be paid to the distinctiveness and dominance of the component parts. I have already said that the word COLORS/COLOURS is likely to be regarded as being prima facie devoid of distinctive character for a wide range of goods and services and I would say that is the position in respect of most covered by the opponents' earlier marks.

One further mark, no. 2012828 is for the word UNDERCOLORS. The mark as a whole

has been accepted as having the capacity to distinguish and consequently must prima facie provide different rights to the word COLOR(S) on its own.

As all of the marks mentioned above have additional matter of some significance they are clearly not the same in appearance or sound as the mark applied for. That the marks share the word COLOR/COLOURS imparts some conceptual similarity, but by no means is this sufficient to say that the respective marks are similar.

The remaining mark relied upon by the opponents, no.2012826 is for the word COLORS. I note that this mark proceeded on the basis of evidence of acquired distinctiveness but I place no reliance on this fact other than to say that it reaffirms that the word COLORS (and COLOURS) is prima facie devoid of distinctive character in respect of the goods covered by that registration.

The applicants' mark consists of the word COLOURS with a small heraldic device placed within a border. It has long been accepted that in composite marks it is the word element by which the mark will be referred to, and I would say that it is this element that is the dominant, distinctive component of that mark. The word COLORS is visually very close to COLOURS and would be indistinguishable when spoken. That COLORS is the American English spelling of COLOURS would in my view be a fact well known to the public, and accordingly, the conceptual similarity is undeniable.

Turning to the respective goods and services. The opponents' earlier mark for the word COLORS is registered in Class 9 in respect of sunglasses and sunglass cases both of which are specifically mentioned in the corresponding class of the application, and also sunglass frames which would be covered by the term "parts" in the opponents' earlier mark. Class 18 of the opponents' earlier mark covers identical goods to the entirety of Class 18 of the application in suit, both in the specific terms and the general "Leather and imitations of leather and goods made of these materials.." As identical goods are involved and neither the opponents' earlier marks nor the application have been limited in any way, I must proceed on the basis that the channels of trade, relevant public and means of display and selection are one and the same.

On the criteria set out in the Treat case (1996 RPC 281) I would say that perhaps with the exception of "binoculars" the remaining goods and services of the application are not similar to those of the opponents' earlier mark.

A number of the opponents' earlier UNITED COLORS OF BENETTON marks are registered in Classes 9 and 16 for goods that are identical/similar to those of the application. They also have one registration for the same mark covering Class 42 but not in respect of the same or similar services to those of the application. Again using the guidance of Jacob J in the Treat case I would say that the remainder of their registrations would at best cover similar goods and/or services and do not, in my view, take the

opponents' case any further forward.

The opponents' evidence shows use of the word COLORS but primarily in conjunction with other matter such as BENETTON in the mark UNITED COLORS OF BENETTON, and not surprisingly centred around (but not exclusively) their core fashion business. But as successful as this trade may appear, there is nothing in the evidence to put the extent of the opponents' trade into the context of the overall market, nor that shows that use of COLORS as part of a larger mark has led to a reputation in, or recognition of the word solus as a badge of origin for the goods of the opponents. The use of COLORS in respect of the magazine is too inconclusive to add much to the claim to a reputation in that word. Accordingly I do not see that the evidence establishes that the opponents have a reputation in the word COLORS solus or that their earlier marks warrant exceptional protection.

In the Office Cleaning Services Ltd case, (1946) RPC 39, it was held that where a trader adopts a trading name containing words in common use, some risk of confusion may be inevitable, but that risk must be run unless the first trader is allowed an unfair monopoly, and in such cases the Court will accept comparatively small differences as sufficient to avert confusion. Many ordinary English words function perfectly well as trade marks and the guidance from this case must be applied with some regard as to the relevance of the word in relation to the goods in question.

On the evidence before me, and adopting the "global" approach advocated, I have no difficulty in coming to the view that in the similarities between the opponents' earlier mark COLORS (but not the other earlier marks) and the application are such, that use of the mark applied for in respect of sunglasses, sunglass cases, sunglass frames and binoculars (and similar goods, if any) covered by Class 9 of the application, and all goods covered by Class 18, that there is every likelihood that the relevant public will be confused into believing that the goods are those of the opponents or are in some way linked. Accordingly, the ground under Section 5(2)(b) succeeds in respect of these goods, but in respect of all other goods or services covered by the application the grounds are not made out.

I turn to the ground under Section 5(3). That section reads as follows:

**"5.-(3)** A trade mark which-

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a

reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

The opponents’ registrations cited in the notice of opposition are earlier trade marks within the meaning of Section 6(1) of the Act (set out earlier), but with the exception of the mark COLORS registered under number 2012826 these are neither the same nor similar. The earlier mark COLORS is clearly registered in respect of goods that are identical to some of those covered by Class 9 of the application, but also for a range of goods and services that are neither the same nor similar so at least in part meets the criteria for an objection under Section 5(3). In *Pfizer Ltd v Euro Food-Link (UK) Ltd* ((ChD) [1999] 22(4) IPD 22039) Mr Simon Thorley QC sitting as a Deputy High Court Judge said:

"What is necessary is that the trade mark proprietor should prove the required reputation and should then satisfy the Court that the defendants use of the sign is:

- (i) without due cause; and
- (ii) takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark."

Setting aside the question of due cause, the question I am posed is whether the opponents’ reputation is such, that if another trader were to use an all but identical mark in respect of dissimilar goods, would some benefit be derived by that trader because of the opponents’ established use and/or reputation, or alternatively, would the opponents’ mark be any less distinctive or their reputation diminished in some way.

In my consideration of the ground under Section 5(2)(b) I highlighted a number of weaknesses in the opponents’ claim to a reputation in the word COLORS solus. They may well have used the word but almost exclusively as part of a larger mark, more often in the mark UNITED COLORS OF BENNETON. I have no doubts that BENNETON will be a widely recognised, both on its own and as part of the mark THE UNITED COLORS OF BENNETON, but there is nothing that establishes this as having extended to the word COLORS any more than to UNITED. What use there is of the word on its own covers goods such as eyeglasses, eyeglass cases, etc, which does not take this action any further forward, or in connection with the magazine which I have already stated to be too inconclusive to establish use of COLORS prior to the relevant date. Accordingly I do not see what advantage or detriment would result from the applicants’ use of COLOURS in respect of the dissimilar goods of the application and this ground fails accordingly.

Finally there is the ground under Section 5(4)(a). That section reads as follows:



“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

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.”

40. Mr Geoffrey Hobbs QC sitting as the Appointed Person in the Wild Child case(1998 RPC 455) set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

- (a) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) 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
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

Section 5(4)(a) of the Act offers protection to the goodwill and reputation built up by a trader through the use of a sign. As with the ground under Section 5(3) the opponents find themselves in some difficulty in establishing that they have a reputation and/or goodwill in a sign such that use of COLOURS would amount to misrepresentation. This is because most of the marks that they use are dissimilar, and the one that is clearly similar has only been used in relation to a very limited range of goods, and even then cannot be established as having taken place in the United Kingdom or prior to the relevant date. Consequently, I do not see how I can find that they will suffer damage by the applicant’s use of the mark in respect of the goods they seek to protect, and the objection under Section 5(4)(a) fails.

As stated earlier I find the opposition succeeds on the ground under Section 5(2)(b). However, if the applicants file a Form TM21 within one month from the end of the appeal period requesting the deletion of Class 18 from the application and reducing their specification in Class 9 to:

Anti-theft warning apparatus; remote locking apparatus; personal security apparatus; encoded and magnetic cards; batteries; communications apparatus; receivers; satellite apparatus; video apparatus and cassettes; audio apparatus and cassettes; compact disc apparatus and discs; digital apparatus and digitising apparatus; books on discs and tapes; films; tapes; discs; hardware and software all

bearing recordings; photographic apparatus; recording apparatus; computer apparatus and peripherals; computer software and hardware; anti-glare screens; computer discs; parts and fittings for all the aforesaid goods.

I will, in the event of no appeal, allow this application to proceed to registration. If the applicants fail to file a TM21 within one month from the end of the appeal period the application will be refused.

The opposition having succeeded, albeit in part, I order the applicants to pay the opponents the sum of £835 as a contribution towards their costs. This sum 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 18 day of June 2002**

**Mike Foley  
for the Registrar  
The Comptroller General**

Annex A: Available as 'order a copy'