

O-301-06

**TRADE MARKS ACT 1994
and
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996
IN THE MATTER OF INTERNATIONAL REGISTRATION NO 450712
IN THE NAME OF NEWMAN
AND
IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 70582 IN THE NAME OF
NEW LOOK LIMITED**

**TRADE MARKS ACT 1994 and
The Trade Marks (International Registration) Order 1996**

**IN THE MATTER OF International registration No. 450712
in the name of Newman**

And

**IN THE MATTER OF opposition thereto under No 70582
in the name of New Look Limited.**

BACKGROUND

1. On 8 March 2000, Newman applied to extend the protection of their trade mark registered under the Madrid Protocol to the United Kingdom. The trade mark is as follows:



The letters are represented in blue and red letters, red with blue concentric broken circles on a white background. The applicants claims the colours blue, red and white as an element of the mark.

and is for the following specifications of goods:

Class 03: Cleaning preparations; soaps; perfumery, essential oils, cosmetics, hair lotions.

Class 09: Optical apparatus and instruments; glasses, sunglasses.

Class 18: Leather and imitation leather, articles made thereof, not included in other

classes; trunks and suitcases; umbrellas, parasols and walking sticks.

Class 22: Bags.

Class 25: Clothing, including boots, shoes and slippers.

Class 28: Games, toys; gymnastic and sporting articles (except clothing).

2. On 30 April 2001, New Look Limited filed notice of opposition against this designation, the ground being in summary:

Under Section 5(2)(b) because the mark applied for is similar to the opponents' earlier marks, and is sought to be registered in respect of goods that are either identical or similar to those for which these earlier marks are registered, such that there exists a likelihood of confusion.

3. Details of the earlier mark relied upon by the opponents can be found as an annex to this decision.

4. The applicants filed a Counterstatement, referring to marks in their ownership that they say pre-date the earlier marks relied upon, and accepting that some of the goods for which the opponents' earlier marks are registered are identical to those of their application. They otherwise deny the ground on which the opposition is based.

5. Both sides request that costs be awarded in their favour.

6. Both sides filed evidence in these proceedings. The matter came to be heard on 23 March 2006, when the opponents were represented by Mr Simon Malynicz of Counsel, instructed by Forrester Ketley & Co, their trade mark attorneys. The applicants were represented by Mr Ian Silcock of Counsel, instructed by Marks & Clerk, their trade mark attorneys.

Opponents' evidence

7. This consists of a Witness Statement from Alastair Miller, dated 22 October 2002. Mr Miller is the Group Finance Director of New Look Limited, a position he has held since January 2000.

8. Mr Miller says his company started trading under the NEW LOOK name in the UK in 1969. The device version shown as Exhibit AM1 is said to have been introduced in 1990, and is the mark of registration nos. 2043937, 2119088, CTM161141 and CTM1177153. He states that his company, New Look Limited, is a wholly owned subsidiary of New Look Group Plc, and that all companies within the group trade using the NEW LOOK trade marks. Mr Miller says that since its introduction the mark has been used on shop frontage, in advertising literature and on swing

tickets attached to goods which he specifies. Exhibit AM2 consists of examples of sew-in and swing tag labels. Whilst the tags themselves bear no dates, two accompanying documents refer to the device version being used on labels for clothing in June 200? (the last numeral was omitted during copying), and October 2000. Exhibit AM3 consists of the front cover page of the New Look Interim Results 1998/99, which shows the composite mark on signage, the device itself on a carrier bag. The composite mark also appears on the bottom of the page. Mr Miller says that in March 2000 his company had 479 retail outlets, and at the date of his Statement, 500 outlets.

9. Mr Miller goes on to give details of his company's UK turnover under the trade marks for the years 1990 to 2000, which are as follows:

Year	Turnover £
1990	16,346,000
1991	22,977,000
1992	31,505,000
1993	52,887,000
1994	83,425,000
1995	120,011,000
1996	178,444,000
1997	233,832,000
1998	312,044,000
1999	355,400,000
2000	407,400,000

10. He estimates that in March 2000 his company had a 2.8% market share, which currently stands at around 4.4%.

11. Mr Miller says that his company spends approximately £3.9 million (per annum?) in promoting and marketing activities in the UK, and receives significant press coverage in national papers and ladies fashion magazines. Exhibit AM4 consists of a table listing "NEW LOOK'S NATIONAL, TRADE AND CONSUMER PRESS COVERAGE" showing there to have been 1,897 instances for 1999. Exhibit AM5 consists of another table headed "REGULAR FEATURED MAGAZINE STATISTICS FOR NEW LOOK", which Mr Miller says is a summary of the typical UK circulation for UK publications in which advertisements and editorials for NEW LOOK have been featured, but it is not clear whether this means that features or advertisements appeared in each issue of the publications listed. Exhibit AM6 consists of various advertisements, articles and features dating from 1999 and 2000, involving NEW LOOK, in respect of ladies clothing. The exhibit also includes a table listing marketing spend in the years 1990 to 1999 amounting to over £14 million,

12. Exhibit AM7 consists of a Certificate of Incorporation showing New Look Holdings Limited to have been incorporated on 5 March 1986, and a Change of Name certificate to New Look

Limited effective from 20 September 1994.

Applicants' evidence

13. This consists of three Witness Statements, two from Stephanie Jenny Loeffler, a trade mark attorney employed by Marks & Clerk, the applicants' representatives in these proceedings, and one from Christian Iscovici.

14. The first of Ms Loeffler's Statements is dated 27 January 2003. In this she recounts conducting a search of the Marquesa database, for trade marks containing the word NEW or LOOK in Classes 3, 9, 18, 25 and 28, the results of which she shows as exhibits SJL1 and SJL2. Ms Loeffler says that these show that there are numerous marks containing the word NEW or LOOK co-existing in the same class for identical and/or similar goods.

15. Ms Loeffler's second Witness Statement is dated 1 February 2005. In this she refers to opposition proceedings launched by the applicants against the opponents' Community Trade Mark (CTM) application to register NEW GIRL and Design in classes 3, 14, 18 and 25, Exhibit SJL1 being a copy of the decision issued by OHIM. Ms Loeffler goes on to refer to another set of proceedings in which the opponents filed an opposition to the applicants' CTM application to register NEWMAN in classes 3, 18 and 25, a copy of the decision of the Board of Appeal being shown as Exhibit SJL2.

16. The Witness Statement from Christian Iscovici is dated 19 January 2005. Mr Iscovici is the General Manager of Newman, a position he has held since joining the company in May 1995.

17. Mr Iscovici recounts the incorporation of his company in September 1972 as Jaques Jaunet (UK) Limited, but with the centralisation of his company's invoicing and delivery at their head office in France, the company ceased wholesale activities in the UK on 1 January 1993, and its retail activity in 1997.

18. Mr Iscovici says that between 1991 and 1997, his company operated retail outlets at Golders Green, Duke Street and Kings Road, under the brand name NEWMAN. Exhibit CI 1 consists of two photographs of window displays, although no interiors as stated, of the Duke Street and Kings Road shops. The photographs show the exteriors of two clothing shops, the signage saying NEW MAN in a stylised font.

19. Exhibit CI 2 consists of a copy of the advertisement for the opposed mark that was published for opposition purposes in the Trade Mark Journal. Exhibits CI 3 to CI 5 consist of the certificate of registration and print case details for trade mark registrations owned by the applicants.

20. Mr Iscovici says that his company started using the trade mark NEWMAN in the UK in 1968 in the form registered under No. 1135791, NEW MAN in a stylised script, the use being continuous from that date, in relation to various items of clothing. The stylisation of the lettering

is the same as in the logo mark being considered here, but without the circular graphical element. Exhibit CI 6 contains a selection of catalogues that Mr Iscovici says illustrates the range of clothing sold by his company.

21. The cover of the first catalogue bears the inscription "Automne-Hiver 90" which places it towards the end of 1990. The stylised NEW MAN script is clearly shown. The catalogue is in French and although the final page lists two of the company's stores in the UK, there is nothing that actually places the catalogue as being available in the UK. The second catalogue bears the stylised NEW MAN, but there is nothing by which to date it or that shows that it was available in the UK. The third catalogue bears the stylised NEW MAN, and is dated Ete-Summer 1989, but again there is nothing that shows that it was available in the UK. The following three catalogues are marked "Automne-Hiver 92" which places it towards the end of 1992. The stylised NEW MAN script is clearly shown along with another version of the words in a stylised italicised script being used in relation to children's clothing, but there is nothing that shows that they were available in the UK. The remaining catalogues date from 1996-1998 and show NEW MAN in the stylised form and also in plain block script for the NEW MAN SPORT clothing. Some refer to branches in the UK but that is as far as it gets to establishing that these catalogues were available in the UK, and if so, how many and where?

22. Mr Iscovici referred to a large collection of invoices provided as exhibit CI 8. The earliest invoices that refer to NEW MAN date from January 1979, but these do not give details of the goods to which they relate. That some of the persons supplied are clearly in the clothing trade would suggest that the goods are clothing, but there is no way of telling what type. Reference numbers are quoted but there is nothing, such as a catalogue numbers that sheds light on their relevance. Some of the later invoices appear to list the goods by national clothing sizes, or refer to the goods by "men's" women's", "junior's" etc, but again this does nothing to establish the type of goods. The most that can be made of them is that the sales are likely to relate to goods of the type available in the catalogue current at the date of the invoice.

23. Mr Iscovici goes on to say that his company sold eau de toilette under the mark in the 1980s and 1990s, extending this use to watches, and goods made of artificial leather such as passport wallets, briefcases, holdalls, luggage, wallets and umbrellas. In support he refers to exhibit CI 7, a catalogue showing the stylised NEW MAN mark being used on a range of non-clothing goods. The catalogue is not dated and there is nothing that helps to establish this. Mr Iscovici goes on to give details of the annual UK turnover for goods sold under the NEW MAN mark in the years 1980 to 1999, which are as follows:

Year	Annual turnover £
1980	1,006,800
1981	997,400
1982	1,234,400
1983	1,431,400
1984	2,180,400
1985	3,527,900

1986	3,656,500
1987	4,057,800
1988	4,539,400
1989	3,829,900
1990	3,515,000
1991	3,737,900
1992	4,065,900
1993	1,972,000
1994	1,670,000
1995	1,457,000
1996	1,137,000
1997	1,128,000
1998	1,062,000
1999	859,807

24. Mr Iscovici explains that until 1996, his company sold products under the trade mark both wholesale and retail, but that after this date sales were only wholesale. He gives the average mark-up as being in the order of two and a half times the wholesale cost inclusive of VAT. He goes on to list the locations in the UK where the products have been on sale to the public, essentially throughout the UK. At Exhibit CI9 he provides a list of independent retailers and department stores that have sold the NEW MAN products with the caveat that the list is not exhaustive.

25. Mr Iscovici states that between 1979 and 2001 his company has spent in excess of £2.3 million in the UK in advertising and promoting products sold under the NEW MAN trade mark. He lists some of the publications in which his company's goods have been advertised or featured, and at exhibit CI 10, provides more specific details by year. The exhibit also includes copies of advertisements, which, where relevant, are as follows:

12 March 1989 edition of Observer in London referring to the NEW MAN Spring collection for men, women and children. The stylised NEW MAN trade mark is also shown.

The same advertisement in the 18 March 1989, 25 March 1989, 8 April 1989, 22 April 1989 and July 8 1989 editions of the Telegraph weekend magazine, the 26 March 1989 edition of the Sunday Telegraph magazine, and the 26 March 1989, 2 April 1989 and 30 April 1989 editions of the Observer magazine.

15 August 1996, March 2000, March 2001 and "2001 " editions of MENSWEAR magazine, containing an article referring to the re-launch of NEW MAN, referring to their 1997 collection, and an advertisement featuring the stylised NEW MAN mark, in relation to a collection of women's and/or men's clothing.

August 1996 edition of HE Lines magazine containing an advertisement for a NEW

MAN stand at the Premier Menswear exhibition in London. The same advertisement appears in the September 1996 edition of that magazine but without the reference to the exhibition.

October 1996, September 1999, March, June and September 2000, April and October 2001 and April and October 2002 editions of Esquire magazine, April and October 1998 editions of Maxim magazine, February 1998 and March and May 2001 editions of GQ magazine, October/November 1998 editions of Punch magazine showing the stylised NEW MAN mark being used in advertisements for women's and/or men's clothing.

cover page of the January 1999 edition of the Evening Post magazine, referring, inter alia, to a "navy fleece pull-on hat from the New Man's women's wear Winter collection 98".

February, June, August and September 1999, and the January and February 2000 editions of MWB Menswear Buyer magazine containing an advertisement featuring the stylised NEW MAN mark, in relation to a collection of women's and/or men's clothing, and a feature story dating from 2002 referring to the NEW MAN Autumn/Winter collection.

February 2000 Men's Health magazine and March and September 2000, and March, September and October 2001, and September 2002 editions of Men's Health magazine containing an advertisement featuring the NEW MAN mark, in relation to men's and women's clothing, and in the Men's Health Style guide published with the March 2001 edition, the name NEW MAN in relation to belts.

26. Mr Iscovici says that the trade mark features on clothes tags, labels, carrier bags, packaging, business cards, business papers, and point-of-sale materials, examples of which are shown as Exhibit CI11. These show the stylised NEW MAN trade mark, in some cases in conjunction with other matter such as an "NM" logo, or stitching. Mr Iscovici goes on to say that since at least the early 1990s, his company has undertaken joint advertising with private retailers throughout the UK, examples of which are also shown as part of exhibit CI 11. This consists of a window sticker of the stylised NEW MAN trade mark placed above the words "EUROPEAN WAY OF LIFE 2001", a letterhead said to date from 1999 showing the stylised NEW MAN mark on its own and as a series forming a border across the top in the same fashion as some of the invoices, an order slip stated to date from 2000 with the mark on the top, a poster showing the stylised NEW MAN mark beside a border of stars containing the numeral "98", the NM logo forming a background. The exhibit also includes a brochure relating to a collection of promotional materials such as pens, diaries, a sponge, etc, all marked as being from Autumn-Winter 1999, all bearing the stylised NEW MAN mark on the packaging. The prices are not in sterling so it is unclear whether they were available in the UK. Exhibit CI 11 contains other materials but these cannot be dated so it is not possible to say that they were available prior to the relevant date.

27. Mr Iscovici goes on to refer to his company's sponsorship of the yacht called Europe

1/NEWMAN STAR in the 2000 single-handed Transatlantic Yacht Race. He says that to coincide with this his company produced a limited range of outdoor and sportswear clothing. He also recounts that in the late 1990s-early 2000, his company sponsored the Prost/Peugeot Formula 1 team, who wore clothing branded with the trade mark. He also says that in 1986, a car that his company sponsored won the Lamont 24 hour race.

Mr Iscovici goes on to refer to trade shows and trade fairs attended by his company, in particular, the A-Z roadshows which take place in Birmingham, Dublin, Glasgow, London and Manchester, and the bi-annual shows entitled Level 2 and Forty Degrees held in London. He also refers to the Premier Menswear Show (previously mentioned) held in London and Birmingham from the 1980s. There is a reference to this in exhibit CI 11. He says that exhibit CI 13 consists of supporting evidence, including, an event guide for a women's wear show entitled PURE London, held in Earls Court in August 2000, Royal Western Yacht Club of England publications showing details of the yacht sponsored by Mr Iscovici's company, the cover of one showing the stylised NEW MAN mark, an extract from the June 2000 edition of Yachting World magazine referring, inter alia, to the sponsored yacht. Other materials forming part of the exhibit cannot be dated.

28. Mr Iscovici refers to his company's website which he says receives approximately 7000 hits each month from customers in the UK. He states that although some of the exhibits are in the French language, this evidence relates to use in the UK. He concludes his Statement by saying his company's products are sold at the middle and top end of the fashion market.

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

Decision

29. The opposition is based on Section 5(2)(b). That section 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.”

30. 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.”

31. 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] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723. It is clear from these cases that:

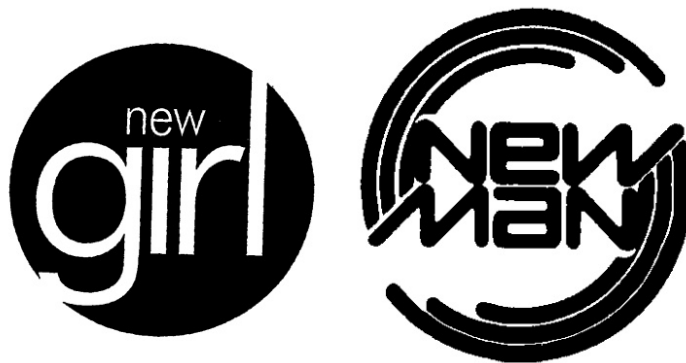
- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed 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.*,
- (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*,
- (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*,
- (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*,
- (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*,
- (g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) 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*,

- (i) 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*,
- (j) 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.*

32. The opponents rely on one earlier mark, for the words “NEW GIRL” represented in a circular logo. The applicants’ mark consists of the words NEW MAN, also in the form of a circular logo. Although the wording contained in both marks is, to differing degrees, represented in a stylized logo form, neither side argued that the words would not be easily recognisable.

33. In a visual comparison it is self-evident that the words NEW GIRL and NEW MAN are not identical, but what is just as plain to see is that both have the word “NEW” as the first element, so if only to that limited extent there must be a degree of similarity in appearance. However, the words MAN and GIRL have no visual features in common, and on a comparison of whether NEW GIRL and NEW MAN are similar in look, and absent any other factors, they are clearly not so. But the respective marks do not just consist of these words in a plain font; they have both been subjected to some degree of stylization and are represented with other graphical features.



34. In relation to the question of visual similarity Mr Malynicz referred me to the following paragraph from the decision of Geoffrey Hobbs QC sitting as the appointed person in *Xarocid* Trade Mark case SRIS 0/140/03 (unreported)

“Marks which converge upon a particular mode or element of expression may or may not

be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived in the context of the marks as a whole as origin specific or origin neutral.”

35. Mr Malynicz submitted that there is “a moderate degree of visual similarity in that they both are in a circular device and the word NEW is placed above the other word.” Mr. Malynicz is plainly correct, but what he did not address is whether these elements are individually or collectively, origin neutral or origin specific, or whether, and if so, to what extent they contribute to making the respective marks distinctively similar?

36. Mr. Silcock focused on more specific features of the marks, such as the difference in the case and fonts in which the verbal elements have been represented, that in the applicants’ mark the word NEW is relatively smaller in size than “GIRL”, and the stylization of letters in the opponents’ mark. He considered the opponents’ mark to be arranged in a “distinctive, memorable and visually appealing manner” (the lower element being the reverse upside-down mirror image of the upper element)”. Combined with the differences in the device element, the applicants’ being solid and the opponents’ being composed of lines, Mr. Silcock considered the visual impression left by the marks to be distinctively different.

37. In the case of the applicants’ mark the circularization and merging of the wording with the lines is quite striking and without doubt contributes to the distinctive make-up of the mark. Whilst the wording in the opponents’ mark extends to the perimeter of the circle, I consider it would be stretching things to take this to be a distinctive feature that, of itself, is origin specific, or is a sign that contributes much towards the distinctiveness of the mark. Nor do I consider the positioning of NEW above the other word to be particularly novel. Taken as a whole I have little difficulty in finding the respective marks to be visually dissimilar in monochrome, and even more so if the colours of the “broken circles” of the applicants’ mark are factored in. I do not consider the colours of the lettering to play any significant role.

38. Turning to the oral or aural similarity of the marks. In composite marks of this type it is most unlikely that when referring to the mark, that the consumer will embark upon a description of the graphical features; it will be the words that are the point of reference. Mr Silcock submitted that in actual usage there is no reason to suppose that the consumer’s emphasis would be on the word NEW, particularly given its lack of inherent distinctiveness. The distinctiveness (or otherwise) of the elements of the marks is something I shall address later. That both marks contain the word NEW will impart a similarity in how they sound when spoken, and if only by virtue of the fact that it is the first word the emphasis in speech is going to be on the word NEW. However, there is no similarity whatsoever in the way in which the words GIRL and MAN sound, no matter how they are pronounced, or in what accent they are spoken. That both marks are composed of ordinary English words, clearly separated, makes it likely that each word will be clearly enunciated to the extent that the positioning of the word NEW will have a lesser effect on how the marks sound as a whole; they are not aurally similar.

39. Mr Silcock submitted that the visual and aural differences between the marks are such that

the average consumer is likely to receive and retain a distinctly different conceptual impression of the two marks. He referred me to a decision of the First Board of Appeal in an opposition involving the same parties in which it was said that the words MAN and GIRL “are not conceptually similar”. I have no argument with this position; they clearly will not send out the same message to the consumer, but this ignores the fact that both are preceded by another and the same word. Adding the same element to two words with some “connected” meaning in common can slide the balance of conceptual similarity into the positive. In this case the words GIRL and MAN have an obvious connection in that both are gender indications, albeit also age-related, but this is a rather loose link and in my view one that is too tenuous for the addition of NEW to heighten. Graphical elements can contribute to the overall impression of a mark, and in this case there are some similarities. But there is a stark difference in the memorable appearance of the applicants mark and the rather ordinary representation in the opponents’ mark, which only serves to further separate. As a whole I consider the respective marks to be conceptually different.

40. Mr Silcock referred me to the following passage from the decision of Mr Simon Thorley QC, sitting as the Appointed Person in the *React* trade mark case [2000] R.P.C. 285:

“There is no evidence to support Ms Clark’s submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely primarily on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.

41. Referring me to the decisions in *Claudia Oberhauser v OHIM (Fifties)* [2003] E.T.M.R. 58, and *Criminal Clothing Ltd v Aytan’s Manufacturing (UK) Ltd*, [2005] EWHC 1303, Mr Malynicz submitted that I should reject the *React* argument that the “visual consideration, in a sense, trumps the other considerations of aural/conceptual similarity”. The circumstances in which the relevant goods and trade marks are encountered by the consumer, particularly at the point at which the purchase is made is an important consideration, but the matter must be assessed by applying an assessment of all relevant factors.

42. There can be little argument that the word GIRL has no distinctive character for the goods covered by the opponents’ registration, a fact (in part) acknowledged by Mr Malynicz, who, in his skeleton argument said “in relation to clothing, the words GIRL and MAN are as descriptive as it is possible to be...”. I would take this further to be the case in respect of most, if not all of the other goods for which the opponents’ have registered NEW GIRL. Insofar as the goods covered by the mark applied for are either for, or are capable of being for men, the position in respect of NEW MAN would be the same.

43. Other than arguing that the obvious descriptiveness of the word GIRL and MAN “...naturally draws attention to the first word, and referring me to the decision of Falconer J in the *Chelsea Man* trade mark case [1989] RPC 111, Mr Malynicz had no comment on the distinctiveness (or otherwise) of the word NEW. Mr Silcock submitted, that this is a word “lacking in distinctive character”, and that the average consumer would be likely to place less importance on this element as a distinguishing feature and more on the more distinctive elements and overall impression of the marks. In my view, the word NEW has no independent distinctive role and will be origin neutral when used in relation to almost any goods.

44. It follows, therefore, that if the marks NEW GIRL (and NEW MAN) possess a distinctive character, it must either be through the combination of the words, and/or the mode in which they are represented. Whilst the stylisation of the words in the opponents’ mark contributes something to its visual appeal, it does not, in my view do so to the extent that if the words were devoid of distinctive character it would carry the mark to a state of distinctiveness. In my opinion, there is no single distinctive element, dominant or otherwise, and any distinctiveness rests in the whole. The stylisation of the mark applied for is much stronger, and whilst in aural use it will undoubtedly be the words that command, in a visual appraisal the stylisation will make a significant contribution to the overall impression received and retained by the consumer.

45. The opponents say that they have been trading in the UK under NEW LOOK since 1969, the name being incorporated into two logo marks. The earliest has the words placed above a highly stylised female face drawn in white lines and contained within a black square. The second version, said to have been adopted in 1990, has the words NEW and LOOK placed either side of this logo. Mr Miller states that the mark is used by New Look Group Plc group companies and their 479 retail outlets, and has appeared on shop frontage, advertising and sales materials. The evidence shows the name to have been used in connection with clothing, primarily for females. The earliest example of NEW LOOK actually in use is found on the copy of the cover page of the 1998/1999 New Look Interim Results shown as exhibit AM3, which depicts a shop front with the signage showing the second version of the logo. This logo is also shown at the bottom of the page but with the black-white colours reversed.

46. The figures provided for turnover and promotional spend are substantial, and even without knowing the size of the market appear large enough to be consistent with Mr Miller’s claim to his company having a market share of 2.8%. However, whilst the evidence shows a consistent and widespread exposure of the mark NEW LOOK to the consumer, there is nothing that shows that the opponents have used any other trade marks incorporating the word NEW so as to build a link between such marks and the opponents in the minds of consumers. The mark NEW LOOK is substantially different from NEW GIRL (and even further away from NEW MAN) and I do not see any reason why the reputation that the opponents undoubtedly have in that mark, with or without the logo would spill over into, or contribute to the distinctive character of NEW GIRL.

47. Mr Malynicz referred me to the decision in *Jose Alejandro SL v OHIM (Budman)* [2004] E.T.M.R. 15, relating to the consumer perceptions about sub-brands:

“It must be observed that it is common in the clothing sector for the same mark to be configured in various different ways according to the type of product which it designates. It is also common for a single clothing manufacturer to use sub-brands (signs that derive from a principle mark and which share with it a common dominant element) in order to distinguish his various lines from one another (women’s, men’s, youth). In such circumstances it is conceivable that the relevant public may regard the clothing designated by the conflicting marks as belonging, admittedly, to two distinct ranges or products but as coming, none the less, from the same undertaking.”

48. Whilst I do not dispute that the use of sub-brands based around a central feature is common in many trades, there are some significant differences between BUDMEN and the marks before me. In BUDMEN the opponents’ relied upon an earlier registration for BUD which the Board of Appeal noted was “contained in its entirety” within the later mark. That is not the case here. The word MEN was considered ancillary to the element BUD because it occupied second place, but also that the suffix would be likely to carry the suggestive or even descriptive connotation that the goods were intended for male customers. Although they do not actually say so, the CFI appear to have been saying that BUD is individually distinctive and dominant, whereas in the minds of the consumer the word MEN is neither. In the case in hand, the textual difference also occupies second place, but unlike the BUDMEN case, NEW is not individually distinctive, and if dominant, was so only by virtue of being the first word; a marginal distinction.

49. In determining whether the goods covered by the opponents’ earlier mark are the same as, or similar to the applicants’ goods, I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 (pages 296, 297) as set out below:

“...the following factors must be relevant in considering whether there is or is not similarity:

- (a) the respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive.

This inquiry may take into account how those in the trade classify goods, for instance

whether market research companies, who of course act for the industry, put the goods or services in the same or different sectors.”

50. Whilst I acknowledge that in the view of the *Canon* judgement the *Treat* case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in *Treat*) are still relevant in respect of a comparison of goods. Mr Malynicz referred me to the specific paragraph from the *Canon* judgement:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, intended purpose and their end user and their method of use and whether they are in competition with each other or are complementary.”

51. As a starting point I must assume that as neither the opponents’ or the applicants’ specification are stated to be specialised in some way, they are of the type purchased by the public at large, and that the consumers of the respective goods are notionally the same. I appreciate that the opponents’ specification for Class 25 is limited to goods being for women and girls, but as the applicants’ specifications are not limited, they notionally also cover goods for the stated gender groups.

52. Mr Malynicz and Mr Silcock aimed their arguments mostly towards the clothing market, no doubt reflecting the fact that these are goods of most interest to their respective clients. Mr Malynicz referred me to the decision in *New Look Ltd v OHIM (NL Sport)* [2005] E.T.M.R. 35, a decision of the Court of First Instance (CFI), in which it had been held that it was wrong to regard the average consumer in the clothing market as displaying a particularly high level of attention at the point of purchase, for just as clothing varies in price, the attentiveness of the consumer will also vary, but went on to add the caveat that this could not be presumed in the absence of evidence with regard to all goods in that sector.

53. Whilst I have no argument with the contention that consumers may be careful when buying expensive goods, that does not mean that they will lack circumspection or observance when seeking out inexpensive items. But in any event, even though the goods covered by the respective marks are ordinary if not everyday items, as they are not limited to any particular market sector they notionally cover those from high-end designer labels costing hundreds if not thousands of pounds, to mass-market lines found in high street shops and supermarkets. When taken in conjunction with the guidance in *Lloyd* and *New Look*, this means that the degree to which the consumer will be circumspect and observant ranges from “reasonably” to “highly”.

54. The opponents’ earlier mark and the mark applied for have classes 3, 18 and 25 in common. In Class 3, both marks specifically list soaps, perfumery, essential oils and cosmetics, so there is clearly identity in respect of these goods. The application also mentions hair lotions, which must be the same and/or similar to the shampoos and conditioners for the care of the hair, and covered

by the expression “toiletries” contained within the opponents’ specification. This leaves the description “cleaning preparations”, which insofar as this covers soaps, skin cleansers and the like, must also be covered by the opponents’ specification, either in the terms specifically mentioned, or in the general terms “toiletries and cosmetics”.

55. The opponents’ earlier mark does not include goods in Class 9, so the question is whether it covers any in the other classes that should be considered similar. In this class the application covers optical goods, which would include items such as microscopes and magnifying glasses and lenses. I consider these to be different to any goods covered by the opponents’ earlier mark. The application also specifically mentions glasses and sunglasses which insofar as they may be considered “fashion items” have a loose connection as a “complementing” clothing accessory. That said, they are very different in nature and use to any goods covered by the opponents’ earlier mark. Mr Malynicz submitted that I could take judicial notice of the fact that it is common for clothing companies to produce sunglasses, naming Calvin Klein, Christian Dior and Gucci. I am aware that these are brands established on clothing that have subsequently extended, inter alia, into spectacles, and sunglasses in particular, but these are designer names and by no means reflect the general trade in such goods. Non-prescription sunglasses may be sold alongside clothing, bags, jewellery and the like, these goods would generally be retailed in different outlets, and in multi-product establishments such as department stores and supermarkets, in distinct areas. I consider the goods covered by Class 9 of the application to be different to any covered by the opponents’ earlier mark.

56. The goods covered by Class 18 of the application are either specifically mentioned (by the same or a similar name, e.g., canes/walking sticks) in the corresponding class of the opponents’ earlier mark, or would be encompassed by the description “Articles of leather or imitation leather”. Quite clearly the opponents’ earlier mark covers identical goods to all of those within Class 18 of the application.

57. With regard to the “bags” listed in Class 22 of the application. Whilst these goods are identical by name with the goods covered by Class 18 of the opponents’ earlier mark, that is as far as the similarity goes. Class 22 covers bags such as sacks, for packaging goods, or those of a textile type material for use in some task, e.g., containing laundry, whereas those in Class 18 are luggage. These are clearly not similar goods.

58. In Class 25, the opponents’ earlier mark covers clothing at large, albeit limited to being for women and girls. The application also covers clothing in general, and with no such qualification, notionally also clothing for women and girls. Adding a gender limitation, whether age related or not, does not change the nature of clothing, a fact acknowledged in the *Chelsea Man* trade mark case [1989] RPC 111 at page 117. Some items of clothing such as jeans, can be unisex, but even where clothing is specifically intended for females or males, the goods are either the same item or so closely related in use, nature, channels of trade, retail circumstances (although I recognise that there are specific shops for different sexes), that they must be considered, if not the same goods, to practically be so. All of the goods for Class 25 of the application are either the same, or all but the same as those listed in Class 25 of the opponents’

earlier mark.

59. With one exception the goods covered by class 28 of the application are very different to any of the goods covered by the opponents' earlier mark. The exception can be found in the description "gymnastic and sporting articles (except clothing)" which would include bags adapted for sporting articles. These goods can be the same in nature, purpose, channels of trade, retail circumstances and consumer to bags such as holdalls found in Class 18 of the opponents' specification, and are similar goods.

60. Considering all of the relevant facts and factors together, and adopting the "global" approach advocated, I come to the position that even taking the opponents' best case involving identical goods, that the surrounding circumstances, and particularly the differences in the respective marks are such that they outweigh any potential for confusion even where used in the same trade.

61. The opposition having failed, the applicants are entitled to an award of costs. I order the opponents to pay the applicants the sum of £3,250 as a contribution towards their costs. This 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 23rd day of October 2006

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



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Trade mark details as at 18 September 2006

DETAILS FOR COMMUNITY TRADE MARK E775544



Mark text:

new girl

UK case status:

Registered

Original language: English
Second language: Spanish

Classes: 03, 14, 18, 25

Relevant dates

Filing date: 18.03.1998
Publication date: 01.03.1999
Registration date: 26.06.2003

List of goods or services

Class 03:

Cosmetics and toiletries; soaps; perfumes, essential oils, shampoos and conditioners for the care of the hair; deodorants and dentifrices.

Class 14:

Jewellery; articles of precious metal or coated therewith; bracelets necklaces, brooches, rings and earrings; watches and clocks; watch straps, watch bracelets, and watch chains.

Class 18:

Articles made of leather or imitation leather; bags, handbags, rucksacks, shoulder bags, beach bags, travelling bags, wallets, purses, cheque book covers, briefcases, hip pouches, articles of luggage, parasols, umbrellas and canes, and belts.

Class 25:

Articles of clothing, footwear and headgear for women and girls.

Names and addresses

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Representative: MARKS & CLERK
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