

O-245-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATIONS NOS 2302605, 2302606 AND 2349038
BY THE ZOOLOGICAL SOCIETY OF LONDON TO REGISTER THE
TRADE MARKS ZSL IN CLASSES 16, 25, 28, 41, 42 AND 43**

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS NOS
91386, 91387 AND 92378
BY YVES SAINT LAURENT**

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by The Zoological Society of London to register the Trade Marks
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**IN THE MATTER OF Consolidated Opposition Nos 91386, 91387 and 92378
By Yves Saint Laurent**

BACKGROUND



1. On 12 June 2002 The Zoological Society of London applied to register the following mark:



2. On the same date the same applicant applied to register the plain mark **ZSL**.
3. On 14 November 2003 the same applicant applied to register the mark **ZSL-Living Conservation**.
4. The applications are numbered 2302605, 2302606 and 2349038 respectively.
5. In each case the specifications of goods and services are the same. In the light of the scope of this opposition I need only mention the Class 25 specification which reads "Articles of clothing for men, women and children; headgear".
6. On 2 January 2003 Yves Saint Laurent filed notice of opposition against application Nos. 2302605 and 2302606 and on 23 March 2004 the same opponent filed notice of opposition against No. 2349038.
7. It will be apparent from the above chronology that Nos. 2302605 and 2302606 (opposition Nos. 91386 and 91387) have always been running together. Consistent with that, and in response to a request by the applicant, the two cases were consolidated (confirmed by letter from the Registry dated 4 May 2004). Opposition No. 92378 was filed at a later date and there was no indication in the papers passed to me for the scheduled hearing that the question of consolidation had been considered. However, as the issues and evidence are in substance the same it seemed sensible to consolidate this action with the other two. Notice was given to the parties of the

Registry's intention in this respect. As no objection was made opposition No. 92378 has now been formally consolidated with the other two cases. In what follows I will treat the three proceedings as a single action save where circumstances require otherwise.

8. The opponent is the proprietor of the following registrations:

No	Mark	Class	Specification
2148825	YSL	25	Clothing, furs, belts, gloves, footwear and headgear
830090		25	Articles of clothing
991705		25	Articles of clothing made from fur, articles of clothing for men and women, scarves; belts and ties, all for wear, shoes

The opponent claims that the applied for marks are similar to these earlier trade marks and cover identical or similar goods such that there exists a likelihood of confusion. On that basis it is said that registration would be contrary to Section 5(2)(b) of the Act. Refusal of the application is sought in respect of the Class 25 goods of the applications.

9. The applicant filed counterstatements denying the above ground. I note that the counterstatements also ask the Registrar to exercise discretion in the applicant's favour. It is now well established that I have no such discretionary power. Either the objection is made out or it is not.

10. Both sides ask for an award of costs in their favour. The matter came to be heard on 10 August 2007 when the applicant was represented by Mr Guy Tritton of Counsel instructed by Marks & Clerk. The opponent was not represented at the hearing but relied on written submissions filed under cover of a letter from Ladas & Parry LLP dated 8 August 2007.

Opponent's evidence

11. Evidence in the case of oppositions Nos. 91386 and 91387 has been filed in the form of a witness statement by Marie-José Cabrolrier, General Counsel of Yves Saint Laurent. In the case of opposition No. 92378 evidence has been filed in the form of a witness statement by Mark Lee, President of Yves Saint Laurent. In substance the separate sets of evidence cover the same ground. The following summary deals with both.

12. Yves Saint Laurent is the owner of the trade mark YSL in the UK in respect of Class 25 goods. Details of the registrations relied on for the purpose of these proceedings are exhibited at MJC1 and ML1.

13. Yves Saint Laurent is said to have used the trade mark YSL in its various forms in the UK in relation to clothing for many years. The opponent has four agreements with Marchpole Holdings plc entered into on 1 January 1997 expiring on 31 December 2006 whereby Marchpole was licensed to sell men's belts and shoes, men's jeans, menswear and men's scarves, socks, men's underwear, bathing suits, bathrobes and boyswear. Earlier agreements, now expired, running from as early as 1988 covered men's jeans, menswear, men's socks, knitwear and jerseys, boyswear and ties for men. Details of Marchpole's turnover in the years 1997 to 2002 is given as follows (taken from Exhibits MJC2 and ML2):

YEAR	TURNOVER (£)	CONTRACTS
2002	12 451 589	Men's wear, underwear, belts & shoes, jeanswear
2001	17 870 000	Men's wear, underwear, belts & shoes, jeanswear, ties
2000	23 465 990	Men's wear, jeanswear, belts & shoes, underwear, SAINT LAURENT, ties
1999	24 879 566	Men's wear, jeanswear, belts & shoes, underwear, ties
1998	35 969 564	Men's wear, underwear, belts & shoes, jeanswear
1997	41 583 853	Men's wear, underwear, belts & shoes, jeanswear

14. As licensee Marchpole arranges for the sale of goods in the UK bearing the mark. A list of UK retailers between the years 1997 and 2002 is given at Exhibits MJC3 and ML3. I note that these are spread throughout the UK.

15. The opponent also operates two boutiques exclusively selling Yves Saint Laurent products. Exhibited at MJC4 and ML4 are details of sales turnover at these shops in Sloane Street and New Bond Street/Old Bond Street from 1999 to 2002. Sales turnover for the period of four years is shown to exceed £9 million.

16. Also exhibited at MJC5 and ML5 in support of the opponent's claims are a list of the UK magazines where Yves Saint Laurent advertisements have been published

between 1999 and 2002. I note that this includes (by way of example only) Elle, Esquire, Tatler, Vogue, Vanity Fair.

17. Finally, exhibited at MJC6 and ML6 is a selection of press articles referring to YSL marks including a number related to a collection produced by Tom Ford.

Applicant's evidence

18. This comes in the form of witness statements by Brian Oldman the Commercial Director of the Zoological Society of London. *Mutatis mutandis* the witness statements are the same. The first part of Mr Oldman's witness statements is devoted to giving background information on the Zoological Society of London and its operating divisions. I do not need to record this for present purposes.

19. ZSL has been used for a considerable time as an identifier for the organisation. Since February 2002 it has also been used in publications, promotional literature, merchandise etc. Exhibit BO3 includes a list of specific goods along with date of first use of the ZSL mark. I note that this includes some clothing items. At present the Society operates from two sites in the UK (London and Dunstable) and goods are only sold on the two zoo sites.

20. Mr Oldman goes on to give turnover figures for a variety of goods and services. In relation specifically to clothing, turnover in 2002/3 was £138,243 and in 2004 it was £126,898. The following clothing items have been sold – accessories, T-shirts, sweatshirts, polo shirts, outerwear, caps, hats, headbands, headwear, slippers, socks and babywear. Examples are exhibited at BO4. Non clothing items are exhibited at BO5. Photographs of exhibition stands are exhibited at BO6.

21. The final exhibit, BO7, consists of the responses to e-mail enquiries directed at a number of Society personnel asking them to say whether they had encountered any unprompted instances of confusion with YSL. None had.

22. The remainder of Mr Oldman's witness statements is directed primarily at demonstrating that the Society's activities and aspirations are commercially well separated from the opponent's trade as an haute couture brand. He points to the fact that the Society has no separate regional outlets; has no intention of setting up a fashion house; uses its mark as a promotional mark; and that any future expansion would be clearly linked to the Society itself. I will return to these submissions in the body of my decision below.

23. That completes my review of the evidence.

Preliminary point

24. On 7 August 2007, Marks & Clerk, the applicant's professional representatives, sought leave to file a further witness statement by Brian Oldman. The opponent's written submissions filed in lieu of attending the hearing and received on 8 August, indicated that Yves Saint Laurent had no comment to make on the content of the witness statement. The opponent was content to leave it to the Hearing Officer to decide whether to admit the evidence into the proceedings at this stage.

25. Mr Tritton's skeleton argument and submissions indicated the purpose of the evidence was to update the tribunal as to recent usage because of the amount of time that had elapsed since Mr Oldman's first witness statement was filed (on 10 February 2005). The evidence in question provides trading figures for 2005 and 2006 and updates the enquiries previously made of various persons within the applicant's organisation as to whether they had encountered instances of confusion in the interim period. In respect of the latter the previous material is that contained in Exhibit BO7 to Mr Oldman's evidence in chief.

26. Mr Tritton submitted that this was useful evidence of continuing side by side trade without evidence of confusion. Although it related to the period after the relevant dates it was considered to be relevant in shedding light retrospectively as it were on what the position would have been at that time. The updating nature of the evidence meant that it was unavoidable that it would come in at a late stage. The issue of possible prejudice to the other side was acknowledged to be important. But there was none here. Furthermore, the opponent's written submissions suggested a position of neutrality rather than resistance to the proposed further evidence.

27. The guiding principles in considering further evidence issues was set out in *Label Rouge Trade Mark* [2003] F.S.R. 2 by reference in turn to earlier cases.

28. Lawrence Collins J concluded as follows:

“**18** The continued applicability of the *SWISS MISS* criteria in the light of these developments was considered by Pumfrey J. in the [WUNDERKIND](#) case. Pumfrey J. said that what Laddie J. had said (and also what Sir Richard Scott V.-C. had said in [Julian Higgins' Trade Mark Application \[2000\] R.P.C. 321](#)) had been overtaken by the CPR provisions on appeals, but he accepted that in a trade mark appeal other factors outside the [Ladd v Marshall](#) criteria may continue to be relevant provided that it was remembered that the [Ladd v Marshall](#) factors were basic to the exercise of the discretion to admit fresh evidence and that those factors had peculiar weight when considering whether or not the overriding objective was to be furthered.”

29. The relevant passage from *Ladd v Marshall* referred to in paragraph 9 of the above case is as follows:

“... three conditions must be fulfilled: first, it must be shown that the evidence could not have been obtained with reasonable diligence for use at the trial; secondly, the evidence must be such that, if given, it would probably have an important influence on the result of the case, although it need not be decisive; third, the evidence must be such as is presumably to be believed, or in other words, it must be apparently credible, though it need not be incontrovertible.”

30. The criteria from *Hunt Wesson Inc's Trade Mark Application (SWISS MISS)* [1996] RPC 233 are:

- “1. Whether the evidence could have been filed earlier and, if so, how much earlier.
2. If it could have been, what explanation for the late filing has been offered to explain the delay.
3. The nature of the mark.
4. The nature of the objections to it.
5. The potential significance of the new evidence.
6. Whether or not the other side will be significantly prejudiced by the admission of the evidence in a way which cannot be compensated, eg by an order for costs.
7. The desirability of avoiding multiplicity of proceedings.
8. The public interest in not admitting onto the register invalid marks.”

31. Although the above guidance relates to the position on appeal it is generally accepted that it is also relevant to the exercise of discretion at first instance.

32. Clearly it is very late in the day in this case for evidence of this kind to be introduced into the proceedings. It is not in any sense evidence that needed to be left to this very late stage. If I accept Mr Tritton’s point that it is merely updating evidence then on that basis such evidence will always be capable of being admitted on the basis either that it could not by its nature have been obtained with reasonable diligence at an earlier stage or that it needed to be done as close to the hearing date as possible. I doubt that the first of the *Ladd v Marshall* criteria was intended to open the door for further evidence in quite this way.

33. However, my main concern about the proposed further evidence is its relevance to the proceedings. The material date of these actions is 12 June 2002 and 14 November 2003 (in the case of application No. 2349038). Turnover figures for 2005 and 2006 are scarcely likely to be of assistance to the tribunal, a factor that is compounded by the fact that much of it relates to catering (the relevance of which is not explained) and the clothing figures (which are potentially relevant) have continued to be at modest levels. Mr Tritton did, however, wish to draw support for his client’s position from the internal evidence of absence of instances of confusion. For reasons that I will explain in greater detail below I regard this part of the applicant’s original evidence (and hence the attempt to update it) as being of tangential (if any) relevance to the outcome of the case. It also follows that even if the third of the *Ladd v Marshall* criteria is satisfied (ie the evidence is to be believed in terms of the content) it does not avail if it leads nowhere in terms of relevance.

34. The other significant consideration is prejudice to the other side. As I have said the opponent appears to have adopted a position of neutrality. Does it do any harm to admit the evidence if the other party is not objecting? Firstly, neutrality is not the same as acceptance. The opponent is entitled to expect the tribunal to reach a decision based on the well established guidance set out above. Secondly, I do not think it would be right to clutter a case with further evidence, however brief, if that evidence really served no useful purpose.

35. As regards the other *Swiss Miss* criteria, the applicant’s original evidence on turnover and absence of confusion still stands and will be considered on its merits. There is, in my view, no significant prejudice to the applicant in not admitting the

updating material. No particular issues appear to arise in terms of avoiding multiplicity of proceedings and the public interest in not admitting on to the register invalid marks.

36. In all the circumstances I declined to admit the applicant's further evidence.

Section 5(2)(b)

37. The relevant part of the statute reads:

“(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.”

Proof of use

38. The opponent's written submissions suggest that there is no issue with regard to proof of use based on No. 2148825 as the mark had not been entered on the register for five years at the date of filing of the oppositions nos. 91386 and 91387. On the other hand it is said that use needed to be shown in respect of its other two (earlier) registrations (Nos. 830090 and 991705). In fact the opponent has wrongly taken a point against itself.

39. Opposition Nos. 91386 and 91387 were filed on 2 January 2003. Opposition No. 92378 was filed on 23 March 2004. The Trade Marks (Proof of Use, etc) Regulations 2004 came into force on 5 May 2004. It follows that those provisions do not apply to any of these consolidated opposition cases as the applications to which they relate were published for opposition purposes before the Regulations came into force.

The principal authorities

40. An objection under Section 5(2)(b) requires me to consider whether there are similarities in the marks and similarities in the goods and services that, cumulatively, lead to a likelihood of confusion. The leading guidance from the European Court of Justice is contained in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723.

General approach to the issues

41. These consolidated oppositions involve three separate marks consisting of, or incorporating, the letters ZSL. The opponent's statement of grounds in each case relies on three registrations, two of which are for the letters YSL in monogrammed form. The third is for the letters YSL in plain block capitals. In theory the parties are entitled to have each of the applied for marks tested against each of the marks ranged against them. Not surprisingly, submissions have largely focussed on the plain form marks ZSL and YSL, that is to say application No. 2302606 and earlier trade mark No. 2148825. If the applicant succeeds on the basis of its ZSL mark it is also likely to succeed in respect of its other marks which benefit from additional matter in terms of styling or other words. On the other hand if the opponent succeeded on the basis of my consideration of Nos. 2302606 and 2148825 I would still need to consider the applicant's position in relation to its other two marks. I, therefore, take as my starting point the opponent's best case, that is YSL against ZSL.

Comparison of goods

42. The respective sets of goods are "clothing, furs, belts, gloves, footwear and headgear" (opponent's) and "articles of clothing for men, women and children; headgear" (applicant's). As the opponent's clothing is unrestricted in scope it must be taken to include articles for all potential categories of purchasers. Headgear also appears in both specifications. Hence, identical goods are in play.

Similarities of marks

43. The opponent's written submissions note that the competing marks are each of three letters and coincide in the last two letters. Whilst it is conceded that visually they would not be confused in direct comparison with one another, there is nevertheless some visual similarity because of the identity of the last two letters.

44. Phonetically, it is submitted that the letters do not make up pronounceable words. Rather the letters would be spoken individually. The first letters are distinguishable but the phonetic differences between marks are said to be not especially noticeable because of the common S and L elements.

45. In relation to conceptual considerations it is submitted that the marks would be seen as having a link to one another because the letter Y and the letter Z appear next to one another in the English alphabet.

46. Mr Tritton's skeleton argument and submissions for the applicant pointed me to the following passage from OHIM's draft guidelines:

"4.2 Length of signs

The length of the signs may influence the effect of differences between the signs. The shorter a sign, the more easily the public is able to perceive all its single elements. Thus small differences may frequently lead in short words to a different overall impression. In contrast, the public is less aware of differences between long signs.

In many relevant markets it is a common practice to use short marks which are abbreviations of the name of the company or refer to the relevant goods or services. In these cases the public is aware of this practice and is generally used to distinguishing between many abbreviations and will not be easily confused.”

47. He also supported the reasoning of the Opposition Division in a Decision 2962/2000 of 30 November 2000 where Yves Saint Laurent Couture was unsuccessful in opposing the mark GSL on the basis of its mark YSL. The goods at issue in that case, as here, were clothing and headgear. The Opposition Division noted the one letter difference in the marks but held the difference to be material in a short mark.

48. As Mr Tritton very properly acknowledged I am not bound by a decision of the OHIM Opposition Division. Nevertheless I find the Division’s reasoning to be persuasive in many respects. Small differences can indeed make a difference in short marks. That process is aided in this case by the fact that the difference occurs at the start of the three letter combination. The letters Y and Z are not ones that are likely to be confused visually.

49. I note that, when it came to a phonetic comparison, the OHIM Opposition Division considered that the marks in that case could be distinguished no matter whether the mark was read as a word or as three separate letters. I do not think it is at all likely that YSL would be read as a (pronounceable) word and ZSL certainly would not be. Assuming, as I do, that both marks would be articulated as three letters the initial letters are very different in sound, the second two are, of course, identical in sound.

50. Neither mark has any meaning save in so far as they come to be identified as abbreviations standing for the names of the underlying organisations. There is no conceptual similarity.

51. In overall terms it cannot be denied that there are certain similarities. It is equally apparent that the different initial letters point to a significant distinguishing feature. In *esure Insurance Limited and Direct Line Insurance plc* [2007] EWHC 1557 (Ch) Mr Justice Lindsay has said:

“..... I would hold there to be some form of threshold, albeit a low one. In a case such as the one before me, the threshold, in my judgment, is arrived at as follows. First, overall impressions of the rival marks are formed, paying full regard to all the requirements of the autonomous concept of 4(1)(b) similarity. Next one has to have in mind the types of confusion which are then relevant, namely (as I shall come on to below) those identified in *Sabel* supra at its para 16. Then the threshold question arises: are those overall impressions such that one can reasonably say that a likelihood of confusion could not thereby be created?” (paragraph 46)

and

“Once that low threshold test I have described is passed then the fact-finder is, in my judgment, obliged to go on to consider whether, in consequence, there is a likelihood of confusion – see *Soffass* para 31. That is not to say that any party can safely decide to assert no more, as to similarity, than that so low a threshold has been exceeded because similarity and the likelihood of confusion are so inter-related that proof of a higher degree of similarity may conduce to a greater willingness in the fact-finder to hold that there is, on the facts, a likelihood of confusion.” (paragraph 48).

52. The threshold referred to by Mr Justice Lindsay has been crossed here. However, the moderate degree of similarity exhibited by the marks does not in itself determine the matter. It does, however, have the effect that I must go on to consider the interaction of the elements that make up the test and whether there is a likelihood of confusion.

Distinctive character of the earlier trade mark

53. In his initial submissions Mr Tritton was inclined to suggest that YSL was a mark that was very close to the borderline of what is registrable absent use and that cogent evidence was needed for it to rise above that low level. He eventually conceded that it was a mark that had at least a low level of distinctiveness. He drew support for this view of the matter from the OHIM Opposition Division finding that YSL was “not particularly distinctive” and that as a result of the low degree of distinctiveness of both marks in that case “any minor difference between them may be sufficient to avoid a likelihood of confusion”.

54. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)* [2002] ETMR 91). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585).

55. There is no evidence before me as to the prevalence of three letter trade marks in the clothing trade. As the OHIM guidelines suggest it is not uncommon for short marks to be used as the abbreviation of company names. I would agree that the public is well used to that practice and is generally alert to differences in three letter combinations. There is also a limited range of letters available. In the *prima facie* case three letter marks do not seem to me to exhibit a particularly high degree of invention. I regard the earlier trade mark, YSL, as being of no more than moderate distinctive character considered as an unused mark.

56. That brings me to the opponent’s use which was commented on at some length by Mr Tritton. In essence his submission was that the evidence fails to differentiate

between use of Yves Saint Laurent, YSL and other brands of the opponent; that YSL is used more as a journalistic abbreviation rather than a distinct brand; and that accordingly there is no basis for a claim of enhanced distinctiveness.

57. Before I consider these submissions there is a preparatory point to consider. The opponent's pleaded case made no mention of a claim to enhanced distinctive character. Moreover, the opponent's written submissions make it clear that the evidence filed in the three actions was intended to deal with a requirement for proof of use (which I have found did not exist).

58. In *Julian Higgins' Trade Mark Application* [2000] R.P.C. 321 the Vice Chancellor said:

“If the pleadings do not identify the right issues, the issues the parties propose to argue about, then it cannot be expected that with any consistency the right evidence will be adduced at the hearing. The pleadings are supposed to identify the issues to which evidence will be directed. If the pleadings do not properly identify the issues someone, sooner or later, is going to be taken by surprise.”

59. It may be said that the requirement on a Court or Tribunal to take into account both inherent and acquired distinctiveness is simply part of the standard test laid down in *Sabel v Puma* (paragraph 24 thereof). On that basis does it need to be pleaded as a separate matter?

60. I am not aware that an appeal body has dealt with this particular point though there has been judicial comment generally on the need for clarity of pleadings as exemplified by the above passage from the *Julian Higgins* case. There is no obligation or requirement on an opponent to make a claim to distinctiveness acquired through use if it does not think such a claim is sustainable. The corollary would appear to be that if it thinks it has such a claim it should say so at the outset and not leave it to the applicant to guess at a key parameter of the opponent's case. Applying that reasoning here would mean that I have no need to consider the opponent's use insofar as it is intended to address enhanced distinctiveness because it was not pleaded in the first place.

61. However, as I note that the opponent's written submissions invite me to conclude that there has been substantial use indicating a “heightened awareness amongst the general public for that mark”, I will comment briefly on the material supplied.

62. The evidence comes from Ms Cabrolier and Mr Lee. Mr Lee's evidence in the later proceedings (Opposition No. 92378) is in essentially the same terms as that of Ms Cabrolier.

63. Mr Tritton drew my attention to the fact that both witnesses refer to the fact that “Yves Saint Laurent has used the trade mark YSL in its various forms ...”. Subsequent references refer to use of “its trade marks including the YSL marks” under licence to Marchpole and sales through Yves Saint Laurent boutiques “which include the goods bearing the YSL mark” (my emphasis in each case).

64. A number of points arise from these statements. The trade marks referred to include the plain block capital form and the monogrammed form. The latter has a distinct character of its own. The evidence does not differentiate between the various forms of the mark or indicate the circumstances when each is used or whether they invariably appear together. There is in addition some doubt as to whether the information that has been supplied relates only to the earlier trade marks that form the basis of the oppositions or whether it includes use of the sign Yves Saint Laurent as well. As Mr Tritton pointed out exhibit MJC2 refers at one point to SAINT LAURENT. I have also assumed in the opponent's favour that MJC2 only includes Marchpole turnover under its licensing agreements with Yves Saint Laurent (the way it is put is simply that it is Marchpole's turnover). Exhibits MJC3 to 5 provide further information on where goods are sold and advertised but do not shed light on the actual marks used.

65. MJC6 contains a variety of press articles some of which show use of YSL but not always in the context of clothing (see for instance, the articles featuring Jodie Kidd at the opening of the Yves Saint Laurent room at the National Gallery). This and other press articles also use YSL as journalistic shorthand in circumstances where the full name has previously been presented to the reader. There are a few references to YSL in the context of clothing collections in MJC6 but also references to the full name and other composite brands (Yves Saint Laurent Rive Gauche and YSL Rive Gauche).

66. I find this evidence taken as a whole to be inconclusive as to the extent of use and recognition of YSL. The evidence conflates use of various brands (Yves Saint Laurent, YSL, YSL logo, Yves Saint Laurent Rive Gauche, YSL Rive Gauche) but provides limited material to demonstrate how the goods themselves are generally advertised and branded and what marks consumers recognise. Even if the opponent is entitled to have a claim to enhanced distinctiveness of the mark YSL considered then it is not made out on the evidence before me.

The average consumer and the purchasing process

67. The applicant's evidence and to an extent Mr Tritton's submissions have sought to argue the case on the basis of the parties' current trade. Thus, it is said the applicant's trade is essentially a merchandising spin-off associated with the business of running its zoos compared to the opponent's "haute couture" mark. However, neither specification is restricted so as to reflect the actual trade that is being conducted by the parties at the present time. In *Croom's Trade Mark Application*, Geoffrey Hobbs QC, sitting as the Appointed Person said that:

"31. When assessing the objections to registration in the present case, it is necessary to assume normal and fair use of the marks for which registered trade mark protection has been claimed. The context and manner in which the marks have actually been used by the Applicant and Opponent in relation to goods of the kind specified may be treated as illustrative (not definitive) of the normal and fair use that must be taken into account."

68. The average consumer must, therefore, be taken to be the public at large rather than purely the sub-groups that reflect the parties' actual trade. He or she is assumed to have the qualities and characteristics identified in *Lloyd Schuhfabrik*, that is to say

being reasonably well informed and reasonably circumspect and observant. Selecting clothing items usually involves decisions as to size, fit, style, colour, price etc and is likely to command a reasonable level of attention. There will, however, be ranges of behaviour. Purchasing a low price largely functional item such as a pair of socks will involve less deliberation and care than purchasing an haute couture dress say. It is generally accepted that the selection and purchase of clothing is primarily a visual process though oral requests and recommendations may also play a part.

Likelihood of confusion

69. The factors that I have considered above are part of what is sometimes referred to as the multi-factorial test that needs to be applied. It is well established that likelihood of confusion must be appreciated globally taking account of all relevant factors. The standard of the test has recently been considered by Mr Justice Lindsay in *esure Insurance Limited and Direct Line Insurance plc* (supra). He said:

“A “likelihood” is not a probability; the requirement is less stringent than that. Learning from a quite different area of the law suggests that where “likelihood” is unqualified by other words (e.g. “more likely than not”) then it requires no more than that there is a real prospect that the material consequence – here confusion – should exist – consider *In re Harris Simons Construction Ltd* [1989] 1 WLR 368 per Hoffmann J. and the cases cited in the 2007 White Book at note 24.2.3. Such a view would seem also to accord with the fact that in its German form the corresponding requirement of the Directive is that there need be only a “risk” of confusion – see the Advocate General in *Sabel* at p I-6195.” (paragraph 56).

70. It is part of the applicant’s case that the parties’ marks have co-existed for some time and that this supports the view that there is no likelihood of confusion. Mr Oldman’s evidence explains in some detail the promotional nature of the mark in support of the Zoological Society of London’s animal conservation work and charitable activities. There is, he says, no intention to become a fashion brand. He adds that “the Opponent’s reputation in the YSL brand is very antithetical to my organisation’s ethos”. The public will in his view readily distinguish between a mark used on clothing as a promotional mark for an animal charity and an “haute couture” mark.

71. The Courts have traditionally adopted a cautious approach in treating absence of instances of confusion as being determinative unless there are persuasive reasons for supposing that the nature of concurrent trade has meant that the matter has been properly tested. In *The European Limited v The Economist Newspaper Limited* [1998] F.S.R. 283 Millett LJ said:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark”.

72. In *Compass Publishing BV v Compass Logistics Ltd* [2004] R.P.C. 41 Laddie J noted that:

“To date the claimant and the defendant trade in different parts of the market. This does not come close to imitating the notional world used for determining likelihood of confusion under Art 9.1(b).”

73. In *Phones4u Ltd & Anor v Phone4u.Co.UK & Ors* [2007] R.P.C. 5 Jacob LJ said:

“I quite agree that evidence of substantial side-by-side trade without significant confusion or deception gives rise to a powerful inference that there is no such confusion or deception.”

and

“But if one has no idea of the extent of side by side user, then the inference of no deception cannot be drawn. You have to show there is a dog who could have barked.” (Counsel for the defendants/respondents had contended that this was the case of the dog which did not bark.)

74. I am aware that the Deputy Judge in *Fiorelli Trade Mark*, [2007] R.P.C. 18 accepted a submission based on parallel trading without evidence of confusion. However, it would seem that he was not referred to the Court of Appeal judgments. In any case on the facts of the case before him he was of the view that there had been parallel trading for very many years in the designer clothes and accessories market.

75. It is clear on the facts of the case before me that there has never been parallel trading in any meaningful sense. Mr Oldman is quite specific as to his organisation’s trade:

“As my Organisation presently has two sites in the United Kingdom, one in London and one in Dunstable, goods and services provided under the ZSL mark are only sold on the two Zoo sites.”

76. He goes on to refer to use of ZSL at overseas field projects but I cannot see the relevance of that.

77. The applicant’s use is, therefore, in stark contrast to the nature of the opponent’s trade set out by Ms Cabroler and Mr Lee.

78. Mr Tritton made a number of submissions in an effort to support the “no confusion in trade” point. He pointed out that visitors to the applicant’s zoos are not necessarily thinking of the name of the organisation. Other brands are on display in on-site shops etc. He also took the view that I was entitled to consider current trade as paradigm use.

79. I do not accept these submissions. The applicant’s use has been in just two outlets and in circumstances where visitors to the zoos can be expected to appreciate the association between the brand and the organisation running the zoo. This is nothing like the notional trading circumstance that must be allowed for. Furthermore, I note that Mr Oldman refers to the possible extension of the brand beyond the current limited geographical area of trade:

“Although my Organisation may, in future, look carefully at expanding into selling its ZSL branded goods off site my Organisation would clearly promote this expansion in a way to emphasise the goods’ connection with the Zoological Society of London.”

80. Marketing plans can change over time as is hinted at above with the result that goods that at one time had their own distinct and well separated trade channels are drawn closer together. As matters stand I reject the applicant’s claim that the ability of the marks to co-exist has been properly tested.

81. The decision on whether there is a likelihood of confusion rests on an assessment of the interaction of the elements of the test set out earlier. In reaching my decision I must also bear in mind that consumers rarely have the chance to compare marks side by side and instead react on the basis of the possibly imperfect recollection of the mark they first encountered. Taking all relevant factors into account I see no likelihood of confusion arising on the basis of normal and fair use of the marks. The opponent’s written submissions refer to the fact that Y and Z are next to one another in the alphabet and appear to suggest that this may create a link. I infer that what is being suggested is some form of indirect confusion. Proximity of letters in the alphabet is not in itself a reason for thinking that it will be a contributing factor to confusion. Z is not, of course, a very commonly used letter but, if anything, that makes its presence at the start of a short three letter mark more striking and unusual. If a link is made between the competing mark it is likely to be a tenuous and inconsequential one. The opposition to the mark ZSL under Section 5(2)(b) fails.

82. There remain the other two applications, that is to say the stylised **ZSL** mark and the mark **ZSL-Living Conservation**. For the reasons already given the opponent cannot succeed against these marks having failed against the plain block capital mark, YSL.

COSTS

83. The consolidated oppositions have failed. The applicant is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £1750. This is a single composite award covering the three oppositions. It takes account of the fact that separate actions had to be launched but that, thereafter the evidence has been common to all three and the matter was dealt with by single set of submissions at the hearing. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of August 2007

M REYNOLDS
For the Registrar
The Comptroller-General