

O-009-10

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

**APPLICATION No. 2477083 BY LAWRENCE DAVID ELLIS**

**TO REGISTER THE TRADE MARK TOMMY DILLINGER**

**IN CLASS 25**

**AND**

**OPPOSITION No. 97649**

**BY TOMMY HILFIGER LICENSING LLC**

**BASED ON EARLIER MARKS TOMMY AND TOMMY HILFIGER**

**AND OTHER ASSOCIATED GROUNDS**

## THE BACKGROUND

1. On 16 January 2008 Lawrence David Ellis applied to register a series of two trade marks consisting of:

TOMMY DILLINGER  
Tommy Dillinger.

2. The application was made in Class 25 and registration was sought in respect of:

“Articles of clothing; headgear; footwear”

3. The application was published on 25 April 2008. On 25 July 2008, Tommy Hilfiger Licensing, LLC of New York, USA, filed opposition to the proposed registration. The grounds of opposition are, in summary, that:

- i) The opposed marks are similar to the opponent’s earlier trade mark TOMMY HILFIGER, which is registered a) as a Community trade mark under No.131706, and b) as a UK trade mark under No.2129652D, and is protected in the UK for goods identical to those in the application.
- ii) The opposed marks are similar to the opponent’s earlier trade mark TOMMY, which is also registered in the UK for identical goods under No.2292693.
- iii) There is a likelihood of confusion between the opposed marks and earlier marks and registration should therefore be refused under s.5(2)(b) of the Act.
- iv) The opponent has used the marks TOMMY HILFIGER and TOMMY in the UK since 1997 and 1999, respectively. Use of the applicant’s mark would cause confusion and damage the opponent’s goodwill. Consequently, such use would be prevented under the law of passing off. Registration should therefore be refused under s.5(4)(a) of the Act.
- v) The application was made in bad faith, either because the applicant knew that the opposed marks belonged to the opponent because of their proximity to the marks mentioned above, or because the opposed marks are the same as one previously registered in the UK by the opponent under No. 2102242, which lapsed in June 2006.

4. The applicant filed a counterstatement denying the grounds of opposition and requesting proof of use of the earlier TOMMY HILFIGER (but not TOMMY) marks. The applicant also made these points:

- i) There are other trade marks registered in Class 25 beginning with the name TOMMY.
- ii) The applicant’s marks were fashioned after a famous American gangster called John Dillinger who was notorious for using a

- iii) Thompson (“Tommy”) sub-machine gun.
- iv) The public would see the link between the marks and the gangster.
- v) The applicant’s “predecessor”, a Cecil D Ellis, is the proprietor of the mark DILLINGER in Class 25.
- vi) It is irrelevant that the opponent was previously the proprietor of UK registration No. 2102242 – TOMMY DILLINGER. There is no evidence that the opponent ever used that mark in the UK or at all.
- vii) There is no likelihood of confusion or deception as a result of the applicant’s use of the opposed marks, or of any damage to the opponent.

5. Both sides ask for an award of costs.

6. Neither side asked to be heard. I have, however, had the benefit of written submissions from the opponent in lieu of a hearing.

## **THE EVIDENCE**

7. Both sides filed evidence in support of their cases. The opponent’s principal witness is Anouk von Meyenfeldt, who is the opponent’s Vice President and Counsel.

8. In her witness statement dated 11 February 2009, Ms Meyenfeldt provided the locations of 17 shops throughout the UK that the opponent had at that time. A photocopy of a picture of one of the shops is included in exhibit AVM2, which is dated 2003. It appears from this that the opponent’s shops are called TOMMY HILFIGER.

9. Ms Meyenfeldt provides approximate annual turnover figures for sales of goods bearing either the mark TOMMY, or the mark TOMMY HILFIGER, in the UK, in the period 2003-2008. These show that the company sold between 20 and 37 million euros worth of products per annum in his period. It spent around 1 million euros each year promoting its goods in the UK. Ms Meyenfeldt says that the marks have been used in respect of clothing, footwear and headgear “amongst other things” and that as a result of their use in the UK the marks in question “have become well known as a premier clothing brand”.

10. Exhibits AVM2-4 consist of (very poor quality) copies of extracts from the opponent’s web site, pictures of promotions, and samples of press clippings. In so far as I can see or read anything from these exhibits, I note that the mark used appears to be TOMMY HILFIGER and that the goods offered under that mark are various items of clothing. Curiously, (given the applicant’s challenge to the opponent’s statement of use of the TOMMY HILFIGER mark in the five year period leading up to the date of publication of the opposed marks) the dated (and legible)

pages either seem to be from 1999 or from dates after the publication of the opposed marks.

11. The opponent also filed a witness statement dated 12 February 2009 from Helene Michelle Whelbourn. Ms Whelbourn is a Trade Mark Attorney employed by J E Evans-Jackson & Co, which represents the opponent in these proceedings. Ms Whelbourn provides copies of pages from the opponent's web site, which she appears to have downloaded on the day that she completed her witness statement, i.e. over six months after the opposition was brought. The pages show that, at that time, the TOMMY HILFIGER on-line store was offering a wide range of clothing and footwear under that mark.

12. The applicant's evidence consists of a witness statement by Philip Cooper, who is a Trade Mark Attorney with Potts, Kerr & Co, who represent the applicant in these proceedings. Mr Cooper says that his evidence is based on the "...result of investigation and research made personally by myself". This includes evidence that other marks beginning with TOMMY have been registered in the UK in Class 25 and that, by mid 2009 when he did his research, certain other marks beginning with TOMMY were in use in the UK in relation to clothing. There is no need to record any more of the detail of this evidence because, for the reasons given below, I believe it to be irrelevant.

13. Mr Cooper also gives evidence of the fame and notoriety of John Dillinger, who was a gangster in the USA during the great depression. According to Mr Cooper's research, Mr Dillinger specialised in daring bank robberies. However, his career was short lived. He was shot dead by police in 1934. According to Mr Cooper's research, a film about Dillinger was made in 1973 and was shown in the UK on Channel 5 in 2003. Another film about Mr Dillinger's escapades was made in 2009. This was called 'Public Enemies' in which the central character (Dillinger) was played by the well known actor Johnny Depp. There are a number of articles in evidence about Mr Dillinger dating from 2009, which seem to have been inspired by the new film. According to Mr Cooper, an internet search he conducted against 'Dillinger Gangster' in May 2009 brought back over 8000 hits on UK web pages. A copy of the first page of the 'hits' is exhibited as PJC3d. Some of the hits obviously relate to the new film. Mr Cooper also conducted an internet search for 'Tommy Gun Dillinger'. This search was not limited to UK web pages. It produced over 7500 'hits'. The first page is exhibited as PJC3e. Two of the hits relate to the same report – that a US Sheriff wanted to melt down Dillinger's Tommy gun. None of the hits show use of Tommy Dillinger (in that order).

14. For the sake of completeness, I should mention that Ms Whelbourn filed a second witness statement in reply to the applicant's evidence. Apart from a print out showing that some of the registrations of other 'TOMMY plus' marks relied on by the applicant are in fact owned by the opponent, Ms Whelbourn's statement consists of argument rather than fact. I take this into account, but there is no need to say anything more about it under this heading.

## **SECTION 6A – PROOF OF USE**

15. Section 6A of the Act is as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

- (1) This section applies where -
  - (a) an application for registration of a trade mark has been published, (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if -
  - (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.
- (4) For these purposes -
  - (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

16. The opponent’s registrations of TOMMY HILFIGER had been on the relevant registers for more than five years at the date of the publication of the opposed marks. Section 6A therefore applies. Both the UK and Community registrations cover the broad terms “Clothing, footwear and headgear”. The first question I therefore have to decide is whether the evidence filed by the opponent shows genuine use of the trade mark in the UK or (in the case of the Community trade mark) in the Community, within the period 26 April 2003 and 25 April 2008 and, if so, for which goods. In reaching a view on the answer to this question I bear in mind that s.100 of the Act places the burden of proof on the opponent.

17. The case law relevant to the assessment of genuine use is well established and other than in one respect, is not really tested by the facts of this case. In my view, Ms Anouk von Meyenfeldt’s evidence clearly establishes that the opponent made genuine use of the mark TOMMY HILFIGER during the relevant five year period. I do not think that the fact that the visible dates on her exhibits fall outside this period prevents this conclusion. This is because 1) her statement says the mark was used throughout the period, 2) the applicant has not challenged that evidence, and 3)

examples of use of the mark which both pre and post date the relevant period, are consistent with the continuous use of the mark since 1999.

18. The only matter of any serious doubt is whether the use shown justifies protecting the earlier mark in respect of “Clothing, footwear and headgear” or whether the protection afforded to the TOMMY HILFIGER mark should be reduced to some narrower description of goods. My starting point is Ms Anouk von Meyenfeldt’s evidence that the mark has been used on clothing, footwear and headgear. Taken by itself this is little more than a bare assertion. However, it is clear from the evidence as a whole that 1) the opponent has made very substantial sales in the UK over the last 10 years, 2) the principal mark used in connection with those sales appears to have been TOMMY HILFIGER, 3) the opponent’s main product is a range of casual clothing.

19. Again, I bear in mind that none of this evidence is challenged.

20. In these circumstances I intend to accept Ms von Meyenfeldt’s evidence at face value. Consequently, I find that the opponent made genuine use of the TOMMY HILFER marks within the relevant five year period for all the goods for which they are registered. The earlier marks are therefore entitled to protection on this basis.

## **THE SECTION 5(2)(b) GROUND**

21. The relevant part of s.5(2)(b) is as follows.

“(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.”

22. The applicant’s marks share the same distinctive character and can therefore be treated the same. Consequently, references in the remainder of this decision to the ‘applicant’s mark’ should be taken as applying equally to both of the applicant’s marks. Similarly, I will refer to the opponent’s TOMMY HILFIGER registrations as the earlier mark.

23. On the basis of my findings so far, the opponent is entitled to rely upon the earlier mark TOMMY HILFIGER in respect of ‘clothing, footwear and headgear’. It is also entitled to rely upon the earlier mark TOMMY, which is protected in the UK for:

“Clothing, footwear, headgear; clothing for men, women and children; shirts, golf shirts, T-shirts, sweatshirts, tank tops, sweaters, jerseys, turtle-necks; shorts, sweatpants, warm-up suits, pants, trousers, jeans, skirts, suits, overalls; blazers, sport coats, vests, waistcoats, jackets, coats, parkas, ponchos; swimwear, bikinis, swim trunks; overcoats, rain wear, wind resistant jackets; sleepwear, pyjamas, robes, bathrobes; underwear, lingerie, hosiery, boxer shorts, socks; hats, wool hats, caps, visors, scarves, head bands, ear muffs; wristbands; shoes, boots, sneakers, beach shoes, sandals, slippers; gloves; cloth bibs; ties; belts; suspenders (braces).

Clothing, footwear, headgear; clothing for men, women and children; shirts, golf shirts, T-shirts, sweatshirts, tank tops, sweaters, jerseys, turtle-necks; shorts, sweatpants, warm-up suits, pants, trousers, jeans, skirts, suits, overalls; blazers, sport coats, vests, waistcoats, jackets, coats, parkas, ponchos; swimwear, bikinis, swim trunks; overcoats, rain wear, wind resistant jackets; sleepwear, pyjamas, robes, bathrobes; underwear, lingerie, hosiery, boxer shorts, socks; hats, wool hats, caps, visors, scarves, head bands, ear muffs; wristbands; shoes, boots, sneakers, beach shoes, sandals, slippers; gloves; cloth bibs; ties; belts; suspenders (braces).”

24. In my consideration of whether there is a likelihood of confusion between the earlier marks and applicant’s mark, I take into account the guidance from the settled case law of 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] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Matratzen Concord v OHIM C-3/03* [2004] ECR I-3657, and *Shaker di L. Laudato & C. Sas v OHIM C-334/05 P* (LIMONCELLO). 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 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 normally 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*; but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; *Shaker di L. Laudato & C. Sas v OHIM*

(e) nevertheless, the overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components; *Matratzen Concord v OHIM*,

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective services, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

(g) 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*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of s.5(2); *Sabel BV v Puma AG*,

(i) if the association between the marks causes the relevant 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.*

### **Identity between the Goods**

25. It is obvious that the respective goods are identical and I find accordingly.

### **The Distinctive Character of the Earlier Marks**

26. In my view, the mark TOMMY has a below average degree of inherent distinctive character for the goods at issue. This is because 'Tommy' is a very common forename in the UK and therefore, by itself, has only a moderate capacity to individualise the goods of one undertaking. It appears from the opponent's evidence that its principal mark is TOMMY HILFIGER. The opponent's evidence does not show that 1) the distinctive character of the mark TOMMY has been enhanced by the use of that mark as a trade mark, or 2) the distinctive character of TOMMY has been enhanced through its use as part of the mark TOMMY HILFIGER. In connection with the latter point, I remind myself that the average consumer normally perceives marks as a whole. It cannot therefore be assumed that use of TOMMY HILFIGER will necessarily enhance the distinctive character of TOMMY alone. I conclude that the mark TOMMY has a below average degree of distinctive character and the evidence filed does not improve this assessment from the opponent's perspective.

27. In reaching this conclusion I should make it clear that I have attached no weight to Mr Cooper's evidence that a number of other traders were actually trading in clothing under marks beginning with TOMMY in 2009. This is because the use shown by Mr Cooper occurred after the date that the opposed application was filed ("the relevant date") and there is no evidence that the use in question commenced before the relevant date.

28. I find that the mark TOMMY HILFIGER has an above average degree of inherent distinctive character. It follows from what I have already said that the distinctiveness of the mark is loaded in favour of the word HILFIGER, which is either a very unusual surname or else a coined word used in lieu of a real surname. On the basis of Ms von Meyenfeldt's evidence, I am prepared to accept that the distinctive character of that mark has been enhanced through the use made of it prior to the relevant date. I therefore find that by the relevant date the mark TOMMY HILFIGER was highly distinctive for the goods at issue.

### **The Average Consumer**

29. The average consumer in this case is the general public. Clothing and footwear are bought with varying degrees of attention depending on the cost of the goods. However, even at the lower end of the spectrum, there is no reason to suppose that



the consumer pays less than an average degree of attention when selecting the goods.

### **The Similarities between the Marks**

30. I first compare the applicant's mark to the opponent's TOMMY HILFIGER mark. The marks share the same first word – TOMMY – and this creates one point of visual and aural similarity between the marks as wholes. The second words in the respective marks – HILFIGER and DILLINGER are of roughly similar length ( 8 letters v 9 letters) and the final three letters are the same – GER. Both words also have a letter "i" as their second letter and a further letter "i" towards the middle of the words. However, viewed as wholes, there is, in my judgment, at most, only a passing degree of visual similarity between the words HILFIGER and DILLINGER. To the ear, the words are slightly more similar. The opponent says that the words have the sound "-IL-I-GER" in common. That approach - of picking out the letters in common - is too selective. The closest plausible pronunciation of the respective words as wholes is 'HIL-FI-GER' and 'DILL-IN-GER'. The only plausible alternative pronunciations that I can envisage are 'HIL-FIG-ER' and 'DILL-ING-ER', which sound less alike to me. Considered alone, I doubt whether the words HILFIGER and DILLINGER should be considered similar at all. However, the correct test is, of course, to compare the marks as wholes. Considered as wholes, I find that there is a small degree of visual similarity between TOMMY HILFIGER and TOMMY DILLINGER and a higher (but still quite modest) degree of aural similarity.

31. As far as the opponent's other mark is concerned – the word TOMMY alone – I find that the visual and aural similarity to TOMMY DILLINGER is, if anything, less. This is because the visual and aural differences brought about by the inclusion of the second word DILLINGER in the applicant's mark simply cannot be missed.

32. There is no suggestion that TOMMY or TOMMY HILFIGER have any conceptual significance other than as actual or fancy names. The applicant suggests that, by contrast, TOMMY DILLINGER is likely to bring to mind a machine gun wielding gangster from the USA in the 1930s. However, to my mind the evidence on this point is wholly unconvincing. The main point is that although there is some evidence from which it may be inferred that a section of the UK film watching public would have been aware of a US gangster by the name of (John) Dillinger (there is some doubt in my mind as to whether even this would have been true before the film Public Enemies was released after the relevant date) there is no evidence that this character has ever been known as TOMMY DILLINGER. Consequently, I reject the argument that the applicant's mark has a conceptual meaning that would help to distinguish it from the earlier marks.

### **Likelihood of Confusion**

33. I find that there is no likelihood of direct or indirect confusion between the marks TOMMY and TOMMY DILLINGER. In reaching this conclusion I have given due weight to the identity of the respective goods. Despite this there is, in my view, no possibility of direct confusion. This is because the impact of the word DILLINGER in the applicant's mark is such that there is no possibility of TOMMY DILLINGER being

imperfectly heard as, seen as, or otherwise approximated to, TOMMY. Further, I note that:

- i) the word TOMMY is less distinctive than the word DILLINGER,
- ii) TOMMY DILLINGER forms a complete name and is therefore relatively resistant to dissection, and
- iii) if the whole name were to be shortened to a single word, it would be more natural to reduce it to the surname element – DILLINGER – rather than to the forename element TOMMY.

34. I therefore consider it unlikely that the relevant public will take one mark as a derivative of the other or be caused to believe that there is any other kind of economic connection between the undertakings responsible for the use of these marks.

35. I note that the Court of First Instance of the European Communities (“CFI”) came to a similar conclusion for broadly similar reasons in case T-228/06, *Giorgio Beverly Hills Inc. v OHIM*, [2009] ETMR 600. That case concerned the similarity between the marks GIORGIO and GIORGIO BEVERLY HILLS. The relevant finding of the court is recorded (at headnote 8 of the report of the case) like this:

“In a business sector such as that of clothing, in which it is common to use signs consisting of forenames and surnames, and in particular Italian forenames and surnames, it may be assumed, as a general rule, that very common forenames and surnames will be used more frequently in the course of trade than unusual forenames and surnames. Accordingly, and in the absence of any enhanced distinctiveness through use of the earlier mark, the consumer will not infer from the use of the forename Giorgio the existence of an economic link between all the proprietors of marks containing that forename”.

36. The ground of opposition based on this mark therefore fails.

37. I turn next to the opposition based on the earlier TOMMY HILFIGER mark. I remind myself that the respective goods are identical and that TOMMY HILFIGER is a highly distinctive mark. Comparing the marks as wholes, I give due weight to the fact that they share a common first word. However, I also take into account that the distinctiveness of the earlier mark (and the later mark) is loaded more on the non-common component – HILFIGER and DILLINGER – than on the common element – TOMMY. Despite a couple of superficial similarities, DILLINGER and HILFIGER are quite different names/words. I accept that the highly distinctive character of TOMMY HILFIGER makes it more likely that relevant consumers will approximate marks with some similarity to this mark to the mark they know and are accustomed to seeing. However, even allowing for this tendency, the identity of the goods and the possibility of imperfect recollection as a result of seeing the marks on separate occasions, I do not believe that a reasonably observant and circumspect average consumer, paying an average degree of attention to the selection of clothing etc., could fail to realise that TOMMY HILFIGER and TOMMY DILLINGER are different marks.

38. As I noted above, the marks are a little more similar to the ear than they are to the eye. This is therefore the highpoint of the opponent's case. Nevertheless, I do not believe that a reasonably observant and circumspect average consumer, paying an average degree of attention to the selection of clothing etc. would be liable to confuse TOMMY DILLINGER with TOMMY HILFIGER. Although the first words plainly sound the same the second words sound rather different. In particular, the first two syllables of the second words would have to be lost or slurred before the marks as a whole are liable to be confused. In my judgment, the beginnings of these words have strong and distinct sounds and are therefore less likely to be lost than the 'soft' –GER (or ER) endings. That conclusion is consistent with my everyday experience which tells me that where names (or apparent names) are concerned, the public is generally quite adept at distinguishing between names with more aural similarity than is evident here.

39. In reaching this view I bear in mind that a degree of aural similarity does not of itself create a likelihood of confusion. Rather as the ECJ stated in Case C-206/04, *Mühlens GmbH & Co KG v. OHIM* [2006] E.T.M.R. 57,

“21. It is conceivable that the marks' phonetic similarity alone could create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see, in respect of Directive 89/104, *Lloyd Schuhfabrik Meyer*, paragraph 28). However, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue. In that regard, the assessment of any aural similarity is but one of the relevant factors for the purpose of that global assessment. 22 Therefore, one cannot deduce from paragraph 28 of the judgment in *Lloyd Schuhfabrik Meyer* that there is necessarily a likelihood of confusion each time that mere phonetic similarity between two signs is established. 23 The Court of First Instance therefore correctly considered the overall impression created by the two signs at issue, as regards their possible conceptual, visual and aural similarities, for the purpose of the global assessment of the likelihood of confusion.”

40. In deciding what weight to attach to the small degree of aural similarity between these marks it is therefore also necessary to take account of the effect of the visual similarities and differences between them and to bear in mind how the goods at issue are generally bought and sold. Visual similarities and differences play an important role in the selection of clothing, headgear and footwear in Class 25 because the goods and the marks applied to them are likely to be seen as part of the selection process. Consequently, even if (contrary to my primary finding above) TOMMY DILLINGER were to be sometimes misheard as TOMMY HILFIGER, this is not likely to result in confusion in the goods or otherwise affect the economic behaviour of the consumers in question with regard to their selection of the parties' goods.

41. In this connection, I note that the average consumer would have no reason to expect the user of the TOMMY DILLINGER mark to be economically connected to the undertaking responsible for the TOMMY HILFIGER mark. I acknowledge that it is common in the clothing field for an undertaking to use variant marks for different ranges of clothing, but TOMMY DILLINGER is in no way a natural derivative or

extension of the TOMMY HILFIGER mark. I have not forgotten that the opponent had previously registered that very mark, but there is no evidence that it ever used it and the opponent has chosen not to explain its reasons for selecting and registering that mark. In these circumstances I attach no weight to the mere fact of its earlier registration by the opponent.

42. I therefore find that such visual and aural similarities as there are between the marks are unlikely to result in a likelihood of direct or indirect confusion

43. The opposition under s.5(2) based on this mark is therefore also rejected.

#### **THE SECTION 5(4)(a) GROUND**

44. Section 5(4)(a) of the Act states that a trade mark shall not be registered:

“.....if, or to the extent that, its use in the United Kingdom is liable to be prevented 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”

45. The requirements to succeed in a passing off action are well established and are summarised in *Halbury's Laws of England* 4th Ed at paragraph 165 as follows:

“1) that the claimant's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;  
2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods offered by the claimant are goods of the defendant;  
3) that the claimant has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.”

46. The opponent has established that it had a reputation and goodwill under the mark TOMMY HILFIGER by the relevant date. The first requirement is therefore established. The second requirement is for a misrepresentation. This requires confusion or deception (or the likelihood thereof) amongst a substantial number of persons. However, in my judgment, the opponent is no better off under this ground than it was with its s.5(2)(b) case based on the registration of the same mark. For the reasons given above, I find that use of the applicant's mark would not amount to a misrepresentation. Consequently, the s.5(4)(a) ground based on the earlier use of TOMMY HILFIGER fails.

47. The case based upon use of the mark TOMMY alone falls at the first hurdle because the opponent has not established that that mark is distinctive of its goods. In any event, my findings under s.5(2)(b) mean that there is no likelihood of a misrepresentation. Consequently, the s.5(4)(a) ground based on the earlier use of this mark also fails.

## **THE SECTION 3(6) GROUND**

48. I can deal with the grounds of opposition under s.3(6) quite briefly. My finding that there is no likelihood of confusion and misrepresentation as a result of the applicant's use of TOMMY DILLINGER in the light of the opponent's earlier use of the TOMMY HILFIGER mark, means that the applicant's adoption of the mark applied cannot present a prima facie case of bad faith.

49. The mere fact that the applicant applied to register a mark that the opponent had previously registered, but apparently never used and permitted to lapse, does not present a prima facie case of bad faith either.

50. Consequently, the absence of any evidence from the applicant himself answering the claims of bad faith is, on this occasion, of no consequence.

51. The s.3(6) grounds are therefore also rejected.

## **OUTCOME**

52. The opposition has failed.

## **COSTS**

53. The opposition having failed the applicant is entitled to a contribution towards his costs. I order the opponent to pay the applicant the sum of £800 made up of:

- i) £200 for considering the notice of opposition and filing a counterstatement.
- ii) £600 for filing evidence and considering the opponent's evidence.

54. The above sum to be paid within 7 days of the end of the period allowed for appeal.

**Dated this 15 Day of January 2010**

**Allan James  
For the Registrar**