

O-216-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3160233 BY

MICHAEL JAMES PEACHEY

TO REGISTER:

DOUGLAS & WEST

AS A TRADE MARK IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 407122 BY DOUGLAS & GRAHAME LIMITED

BACKGROUND & PLEADINGS

1. On 18 April 2016, Michael James Peachey (“the applicant”) applied to register **DOUGLAS & WEST** as a trade mark for: “Clothing; Footwear; Headgear for wear” in class 25. The application was published for opposition purposes on 6 May 2016.

2. On 8 August 2016, the application was opposed by Douglas & Grahame Ltd (“the opponent”) under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”); the opposition is directed against all of the goods in the application. Under section 5(2)(b) the opponent relies upon the goods and services (shown in the annex to this decision) in the following United Kingdom and European Union Trade Mark (“EUTM”) registrations:

(1) UK no. 2020233 for the trade mark: **DOUGLAS** which was applied for on 10 May 1995 and entered in the register on 23 August 1996.

(2) EUTM no. 13582465 for the trade mark: **DOUGLAS & GRAHAME** which was applied for on 17 December 2014 and entered in the register on 13 July 2016.

(3) EUTM no. 2573673 for the trade mark: **DOUGLAS “the business”** which was applied for on 12 February 2002 (claiming an International Convention priority date of 1 September 2001 from an earlier filing in the UK) and which was entered in the register on 18 August 2005.

(4) EUTM no. 4780151 for the trade mark: **DOUGLAS “the business”** which was applied for on 13 December 2005 and entered in the register on 12 November 2007.

3. Under section 5(4)(a) of the Act, the opponent relies upon use throughout the UK of (i) **DOUGLAS** (since 1990) in relation to “clothing for males” and (ii) “**DOUGLAS & GRAHAME**” (since 1924) in relation to “clothing, footwear and headgear for males, retail services in relation to clothing for males, headgear and footwear, wholesale services in

relation to clothing, headgear and footwear, fashion show exhibitions for commercial purposes; organization of fashion shows for commercial and for promotional purposes; all in respect of goods for males” and “design and manufacture of clothing, footwear and headgear, tailoring services”.

4. The applicant filed a counterstatement in which the basis of the opposition is denied.

5. In these proceedings, the opponent is represented by Ansons; the applicant has represented himself. Only the opponent filed evidence; it also filed written submissions during the evidence rounds. Neither party elected to attend a hearing nor did they file written submissions in lieu of attendance.

The opponent’s evidence

6. This consists of a witness statement from Donald Finlay, the opponent’s Managing Director. Mr Finlay explains that Douglas & Grahame was founded in 1924, incorporated in 1951 as Douglas & Grahame (Belfast) Limited and later became Douglas & Grahame Limited. He states that Douglas & Grahame Limited is a manufacturer, wholesaler and retailer of menswear which it sells under a number of trade marks including “DOUGLAS, DOUGLAS – the business, WELLINGTON, CRUISE, DANIEL GRAHAME and REMUS UOMO.” Headquartered in Northern Ireland, it has “premium showrooms” in London, Manchester and Dublin, retail outlets under the trade mark REMUS UOMO in Belfast, Glasgow and Dublin and franchises in Ballymena and Galway. In addition it has, states Mr Finlay, “concessions in major retail chains in the UK including Browns of York and Psyche in Middlesbrough”.

7. Mr Finlay states that goods are sold wholesale to in excess of 400 independent retailers throughout the UK. Exhibit DF2 consists of what Mr Finlay describes as “a list of some of the stockists of DOUGLAS, DOUGLAS & GRAHAME and DOUGLAS the business” branded clothing. Other than the date it was printed i.e. 19 December 2016,

the list appears to be undated. It specifically identifies, inter alia, a range of undertakings based in England, Scotland and Northern Ireland.

8. Mr Finlay states that (i) use of the DOUGLAS trade mark began in 1990 and that it has been used in “connection with a range of menswear” continuously since that time and (ii) that use of the “DOUGLAS – the business” trade mark began in 2001 in respect of menswear.

9. Exhibit DF3 is described by Mr Finlay as consisting of “images of labels and website extracts showing use of the trade marks “DOUGLAS, DOUGLAS & GRAHAME and DOUGLAS – the business.” Once again, the pages provided were printed on 19 December 2016; other than that date, a number of the pages appear to be undated. I say appear, because the quality of a number of the pages provided is poor and it is, as a consequence, very difficult for one to discern if any other dates appear. The pages provided are as follows:

Page 19 – consists of what appears to be a page taken from the “BRANDS” section of the opponent’s website. At the top of the page there appears “DOUGLAS & GRAHAME”. Other text is only partially visible. It refers to “Our brands host premium...London, Manchester & Dublin...stores in Glasgow, Belfast, Ballymena & Galway and concessions across the UK and Europe.” Below this text, there appears to be references to “REMUS UOMO”, I infer, “DOUGLAS” and what I further infer is a reference to “DANIEL GRAHAME”. The bottom of the page contains a reference to “© Copyright 20...Douglas & Grahame Ltd”. Although the year cannot be identified it is, in my view, most likely to be either 2000 or 2010;

Page 20 - consists of an undated photograph of what I infer is the inside of a jacket bearing a label bearing the following “DOUGLAS® – the business”;

Page 21 – consists of what appears to be an undated page taken from the website of “Allan Hughes Quality Menswear” which contains a photograph of a man’s formal jacket which is described in the following terms “Douglas & Grahame Cruise – Light Blue” – the jacket has been reduced in price from £149 to £95;

Page 22 – a further undated page taken from the website mentioned above featuring a photograph of a man’s formal jacket which, save for the references to “Navy Stripe” and a different price, bears the same description mentioned above;

Page 23 – is dated 18 July 2016 i.e. after the date of the application. It consists of a page taken from www.davidbellinghammenswearhire.co.uk (based in Ballymena) and which refers to “Drifter features...” and “a more formal look Drifter from Daniel Grahame...”. The page indicates it was obtained from “Douglas & Grahame Archives – David Bellingham”;

Page 24 – appears to date from 16 April 2015. It consists of a further page from the website mentioned above and contains references to “Drifter by Douglas & Graham at David Bellingham Menswear”. The page contains the following: “One of our favourite brands which we stock is the Drifter range from Daniel Grahame. They make a great range of contemporary menswear”;

Page 25 – is dated 20 July 2016 i.e. after the date of the application. It consists of a page taken from www.suitsmen.co.uk and contains a reference to “Douglas Business trouser - £75. A high class business trouser from Douglas in Ireland. A vast range of colours in a comfort fit”;

Page 26 – is also dated 20 July 2016 and consists of a further page from the website mentioned above. It contains a photograph of the trousers mentioned;

Pages 27-30 are also dated 20 July 2016. They consist of further pages from the website mentioned above. They contain references to “DOUGLAS® “the business” and “Douglas Business trouser” and contain feedback on the trousers mentioned. The earliest review dates from 15 March 2012. On page 28 under the heading “Matching Accessories” there are references to “Douglas & Grahame 2 button Blazer” and “Daniel Grahame Prestige Men’s Trousers.”

10. Mr Finlay explains that exhibit DF4 consists of the results of Google® searches “limited to the UK”. It appears the searches were conducted on 19 December 2016 and the search terms entered were “douglas clothes”, “douglas & west clothes” and “douglas & grahame clothes”. Although none of the hits have been expanded, it appears that of the 31 hits retrieved, 14 can be positively identified as relating to the opponent; unsurprisingly, 9 of these hits were retrieved by the search for “douglas & grahame clothes”.

11. Finally, Mr Finlay states that the opponent “has won numerous awards throughout the years”, including the Menswear Brand of the Year for their “REMUS UOMO” brand at the Drapers Independent Awards 2016. In addition, the opponent’s former Managing Director, Richard Finlay, received a Lifetime Achievement Award in the Independent sector at the same event in recognition of “his and his companies’ contribution to fashion” (exhibit DF5 refers).

12. That concludes my review of the evidence to the extent I consider it necessary.

DECISION

13. The opposition is based upon sections 5(2)(b) and 5(4)(a) of the Act which read as follows:

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

(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.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration. “

14. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

15. Under section 5(2)(b) of the Act, the opponent is relying upon the trade marks shown in paragraph 2 above, all of which qualify as earlier trade marks under the above provisions. As trade marks (1), (3) and (4) had been registered for more than five years at the date when the application was published, they are, in principle, subject to proof of use, as per section 6A of the Act. Trade mark (2) is not subject to proof of use. However, in his counterstatement, the applicant elected not to ask the opponent to provide proof of use. As a consequence, the opponent is entitled to rely upon all of the goods and services it has identified, details of which can be found in the annex to this decision.

16. I shall deal first with the opposition based upon section 5(2)(b) of the Act.

Section 5(2)(b) – case law

17. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(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, 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;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The opponent's strongest case

18. Under section 5(2)(b), the opponent relies upon four earlier trade marks. Registrations (3) and (4) are for identical trade marks registered for goods in class 25 and services in class 35 respectively. As both of these registrations include the additional words "the business", they offer the opponent no better prospect of success than its registration of the word "DOUGLAS" alone and, for reasons which I will explain later in this decision, of its registration of the words "DOUGLAS & GRAHAME". I will, as a consequence, confine my comparison to registrations (1) and (2).

Comparison of goods and services

19. In view of my conclusions above, the competing goods and services are as follows:

The opponent's goods and services	The applicant's goods
(1) No. 2020233 Class 25 - Articles of outerclothing, none being footwear, for men, youths and boys.	Class 25 - Clothing; Footwear; Headgear for wear.

(2) No. 13582465

Class 35 - The bringing together for the benefit of others of a selection of men's, male youths' and boys clothing, headgear, footwear, bags, clothing accessories and fashion accessories enabling customers to conveniently view and purchase those goods in retail outlets, by means of a catalogue or through a retail website; wholesale services in relation to men's, male youths' and boys' clothing, headgear, footwear, bags, clothing accessories and fashion accessories; fashion show exhibitions for commercial purposes; organisation of fashion shows for commercial purposes; organisation of fashion shows for promotional purposes; all the aforesaid services solely relating to goods for men, male youths and boys.

Class 40 - Tailoring; cobbler services; millinery services; manufacture of clothing, footwear, headgear, bags, clothing accessories and fashion accessories.

Class 42 - Design of clothing, headgear, footwear, clothing accessories, fashion accessories and bags.

The opponent's trade mark No. 1

20. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court ("GC") stated:

"29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)."

21. As the term "clothing" in the applicant's trade mark would include "articles of outerclothing" in the opponent's trade mark, these goods are identical on the principles outlined in *Meric*. As the term "articles of outerclothing" in the opponent's trade mark is, in my view, broad enough to include "headgear for wear" in the application, these goods are also to be regarded as identical on the *Meric* principle. However, even if that is thought to be going too far, if one considers, inter alia, the users, nature, intended purpose, method of use, trade channels and likely complementary nature of the competing goods I have identified, if not identical, they are, in my view, similar to a high degree. That leaves "footwear" in the applicant's trade mark to consider. Even though the opponent's trade mark excludes "footwear, for men, youths and boys", it would still include, for example, footwear for women. As such goods would be included within the broad term "footwear" in the applicant's trade mark, the competing goods are, once again following *Meric*, to be regarded as identical.

The opponent's trade mark No. 2

22. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, distributed through the same trade channels, and therefore similar to a degree. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

23. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*², upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*³, Mr Hobbs concluded that:

¹ Case C-411/13P

² Case T-105/05, at paragraphs [30] to [35] of the judgment

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered)."

24. Although the opponent's registration includes a range of services in classes 35, 40 and 42 relating to clothing, footwear and headgear, it specifically includes the following in class 35:

"The bringing together for the benefit of others of a selection of men's, male youths' and boys clothing, headgear, footwear...enabling customers to conveniently view and purchase those goods in retail outlets, by means of a catalogue or through a retail website".

25. The well-established relationship between undertakings who conduct a trade in clothing, footwear and headgear and also provide retail services in relation to such

³ Case C-398/07P

goods would be well-known to the average consumer. The applicant's specification is unlimited and the services I have identified above are limited to retail services in relation to articles of clothing, footwear and headgear for, inter alia, men. However, as the applicant's goods would encompass clothing, footwear and headgear for, inter alia, men, the opponent's retail services I have identified are complementary to the applicant's goods and, as a consequence, similar to a medium degree.

The average consumer and the nature of the purchasing act

26. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services; I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

27. In its decision in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff.

Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

28. The average consumer of both the goods at issue and the retailing of those goods is a member of the general public. As such goods will, for the most part, be obtained by self-selection i.e. from the shelves of a bricks and mortar retail outlet or from the equivalent pages of a website or catalogue, visual considerations are likely to dominate the selection process. That said, as such goods may also be the subject of, for example, word-of-mouth recommendations or oral requests to sales assistants, aural considerations must not be forgotten. Similar considerations apply in relation to the selection of retail services in class 35 which are most likely to be selected having considered, inter alia, websites, advertisements and signage on the high street but may also, for example, be the subject of word-of-mouth recommendations.

29. I go on to consider the degree of care the average consumer will display when selecting such goods and services. The cost of the goods can vary considerably. However, as the average consumer will be alive to factors such as cost, size, colour, material and compatibility with other items of clothing, they will, in my view, pay at least a normal degree of attention to their selection. In relation to the selection of the retail services at issue, the average consumer is likely to be mindful of a range of considerations such as the breadth of goods/brands stocked, customer reviews, delivery times/costs and in relation to a bricks and mortar outlet, proximity to their home, opening times, parking etc. all of which, once again, suggests at least a normal degree of attention will be paid to the selection of such services.

Comparison of trade marks

30. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

31. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create.

32. Based upon my earlier conclusions, the trade marks to be compared are:

The opponent's trade marks	The applicant's trade mark
DOUGLAS	DOUGLAS & WEST
DOUGLAS & GRAHAME	

33. The first trade mark upon which the opponent relies consists of the word “DOUGLAS” presented in block capital letters; the overall impression it conveys and its distinctiveness lying in the totality. Its second trade mark also contains this word presented in the same manner. However, in its second trade mark, the word “DOUGLAS” is followed by an ampersand symbol and the word “GRAHAME”, the latter presented in block capital letters. Although the word “DOUGLAS” appears first, the overall impression conveyed stems, in my view, from the combination of components of which it is made up; that too is where, in my view, its distinctiveness lies.

34. Like the opponent’s second trade mark, the applicant’s trade mark also consists of two components presented in block capital letters and separated by an ampersand symbol. Also like the opponent’s second trade mark, the overall impression conveyed and distinctiveness stems from the combination of components of which it is made up.

The visual, aural and conceptual comparison

35. When compared from a visual perspective, the fact that the opponent’s first trade mark appears as the first component of the applicant’s trade mark but in which the second component in the applicant’s trade mark i.e. “WEST” is alien to the opponent’s first trade mark, results in a medium degree of visual similarity between them. As the opponent’s second trade mark and the applicant’s trade mark both begin with the formulation “DOUGLAS &” and despite the fact that the components which follow this formulation are very different i.e. “GRAHAME” and “WEST”, there is, in my view, a somewhat higher than medium (but not high) degree of visual similarity between these trade marks.

36. As all of the components of which the competing trade marks are made up will be very well-known to the average consumer, their pronunciation is entirely predictable. The opponent’s first trade mark and the first component of both the opponent’s second trade mark and the applicant’s trade mark will be articulated as the two syllable word “DOUG-LAS”. The formulation “DOUGLAS &” in the opponent’s second trade mark and

the applicant's trade mark will be articulated in exactly the same manner i.e. as the three syllable combination "DOUG-LAS and" and the final component of each trade mark as the two syllable word "GRA-HAME" and one syllable word "WEST" respectively i.e. as totalities they will be articulated as the five and four syllable combinations "DOUG-LAS and GRA-HAME" and "DOUG-LAS and WEST" respectively. Once again there is, in my view, a medium degree of aural similarity between the first of the opponent's trade marks and the applicant's trade mark and, given the inclusion of the word "and" and the overall similarity in length and rhythm, a somewhat higher than medium (but not high) degree of aural similarity between the opponent's second trade mark and the applicant's trade mark.

37. Finally, the conceptual comparison. In his counterstatement, the applicant states in relation to the opponent's second trade mark:

"6. Conceptually, there is a similarity between the two marks, however such a concept – of two names separated by an ampersand – is incredibly common in trade marks, especially in sectors relating to clothing."

38. As I mentioned earlier, the components of which the competing trade marks are made up will be very well-known to the average consumer; that also applies to the meanings the various components are likely to convey. The opponent's first trade mark is likely to be construed as either as male forename or surname. When considered alone, the same may also be said of the word "GRAHAME" which constitutes the second component in the opponent's second trade mark. However, as presented, the conceptual message likely to be conveyed to the average consumer is of an undertaking operating under two names (most likely surnames) i.e. "DOUGLAS" and "GRAHAME". I reach the same conclusion in relation to the applicant's trade mark i.e. it is most likely to be understood as relating to an undertaking operating under two surnames i.e. "DOUGLAS" and "WEST". Like the visual and aural comparison, I pitch the degree of conceptual similarity between the opponent's first trade mark and the applicant's trade mark as medium. However, as both the opponent's second trade mark

and the applicant's trade mark are most likely to convey a message indicating undertakings operating under two surnames the first of which is identical, I think there is a somewhat higher than medium (but not high) degree of conceptual similarity between these trade marks.

Distinctive character of the earlier trade mark

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

40. In its submissions, the opponent states (by reference to the witness statement of Mr Finlay) that it evidences:

“...that the marks DOUGLAS & GRAHAME and DOUGLAS have both been used for a substantial amount of time within the UK and as a result of that use have acquired distinctiveness over and above the inherent distinctiveness already present with the marks.”

41. In his counterstatement, the applicant states:

“7. The use of forenames and surnames is enormously common in classification 25, and therefore the opponent's trade mark cannot be considered to have a highly distinctive character.”

42. In my experience, “DOUGLAS” and “GRAHAME” are both fairly common forenames and surnames. Although the applicant has provided no evidence in support of his submission that forenames and surnames are commonly used as indicators of origin in the clothing sector, that reflects my own experience of the matter. The more common the forename or surname is, the less inherently distinctive it is likely to be. Absent evidence to point me in a contrary direction, I conclude that the opponent’s “DOUGLAS” trade mark is possessed of, at best, a fairly modest degree of inherent distinctive character. As to its second trade mark, consisting as it does of two components, the combination “DOUGLAS & GRAHAME” is, in my view, likely to possess a higher degree of inherent distinctive character, a degree which I would pitch as average.

43. In its submissions, the opponent claims that these trade marks have acquired enhanced distinctiveness by virtue of the use that has been made of them and has filed the evidence of Mr Finlay in support of this claim; evidence which I remind myself stands unchallenged. It is stated that the “DOUGLAS & GRAHAME” trade mark has been used since 1924 in relation to, inter alia, retail services in relation to clothing, footwear and headgear for men and the “DOUGLAS” trade mark since 1990 in relation to menswear. Taking the evidence as a totality, it would, I think, be unrealistic for me not to accept that the opponent has been trading in, broadly speaking, the menswear sector for some time and has done so under a number of trade marks. On the balance of probabilities, it is more likely than not that this use will have built upon the inherent distinctiveness of the trade marks relied upon. However, as the opponent has not provided, for example, even estimates of the turnover it has achieved under or amounts it has spent promoting the trade marks upon which it relies, I am simply not in a position, on the basis of the evidence provided, to judge whether the inherent credentials of those trade marks have been enhanced and, if so, to what extent.

Likelihood of confusion

44. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade marks as the more distinctive they are, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- the opponent's best case lies with its "DOUGLAS" and "DOUGLAS & GRAHAME" trade marks;
- the opponent's goods are either identical to the applicant's goods or if not identical, similar to a high degree;
- the opponent's retail services are complementary and, as a consequence, similar to the applicant's goods to a medium degree;
- the average consumer of the goods and services at issue is a member of the general public;
- while the average consumer will select the goods and services at issue using predominately visual means, aural considerations will also play their part;
- the average consumer will pay at least a normal degree of attention to the selection of the goods and services at issue;
- the applicant's trade mark is visually, aurally and conceptually similar to the opponent's first trade mark to a medium degree and similar to the opponent's second trade mark to a somewhat higher than medium (but not high) degree;

- absent evidence of use, the opponent's first trade mark is possessed of, at best, a relatively modest degree of inherent distinctive character and its second trade mark an average degree;
- on the basis of the evidence provided it is not possible to determine to what extent the inherent characteristics of the opponent's trade marks may have been enhanced.

45. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks/goods and services down to the responsible undertakings being the same or related. In his counterstatement, the applicant states:

“10...it can reasonably be concluded that although there is a degree of similarity between the marks, they are by no means confusingly similar. An average consumer who was reasonably well informed, circumspect and observant, would not buy a product under one of the marks, believing it to be from the other.”

46. In its submissions, the opponent reminds me that as a general rule of thumb, the first part of a trade mark is generally the most important for the purposes of comparison; I accept that is a good starting point. However, notwithstanding that the opponent's first trade mark consists exclusively of the word “DOUGLAS” and that this word appears as the first component in the applicant's trade mark, there is, in my view, no likelihood of either direct or indirect confusion. I reach this view because, as I mentioned earlier, the word “DOUGLAS” is a common forename and surname in the UK and has, at best, a relatively modest degree of inherent distinctive character. I also agree with the applicant that it is not unusual for forenames and surnames to function as trade marks in the clothing sector. Given what, in my experience, is the commonality of “DOUGLAS” as either a forename or surname (a fact of which the average consumer will also be well

aware) and as the applicant's trade mark also includes the word "WEST", I see no reason why the mere presence of the word "DOUGLAS" in the applicant's trade mark (even as the first component) would, given its inherently modest distinctive character, result in the average consumer mistaking the trade marks at issue for one another nor, in my view, is its presence in the applicant's trade mark likely to lead the average consumer into thinking that the undertakings using the competing trade marks are the same or economically linked.

47 As for the opponent's second trade mark, I have, inter alia, concluded that this is visually, aurally and conceptually more similar to the applicant's trade mark than its trade mark for the word "DOUGLAS" alone; I have also concluded that this trade mark is inherently more distinctive than the opponent's first trade mark. Whilst I accept that both trade marks will (most likely) be recalled as two surnames, the first of which is identical, the second surnames are visually and aurally quite different. Once again, in view of the commonality of the components of which both trade marks are made-up, I see no reason why the average consumer would mistake the trade marks for one another or think that the undertakings using them are the same or related.

48. Finally, in its submissions, the opponent states:

"The fact that the opponent has a number of trade marks beginning with the element DOUGLAS may indicate that the trade mark DOUGLAS will be seen as being used by the opponent in a series of marks, the applicant's trade mark DOUGLAS & WEST being yet another variation of the opponent's mark."

49. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the CJEU stated that:

"62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered,

the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a 'family' or 'series' of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a 'family' or 'series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to

disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

50. As far as I can tell, the series or family of trade marks argument relied upon by the opponent in its submissions was never originally pleaded; if that is correct, then without an amendment to the pleadings, it is not an argument upon which the opponent is entitled to rely. However, proceeding on the basis that I am wrong in that regard, it is generally accepted that to constitute a family of trade marks, the party wishing to rely upon that claim needs to demonstrate that it has used at least three trade marks having a common feature. In the context of these proceedings, that would be: "DOUGLAS & GRAHAME" (from 1924) "DOUGLAS" (from 1990) and "DOUGLAS – the business" (from 2001). Although the opponent's evidence indicates that it has used all of these trade marks in the context of the men's clothing sector from the dates indicated, as I mentioned earlier, there is, for example, no evidence going to either the quantum of its use in relation to any of them or the amounts it has spent on making any of these trade marks known. In those circumstances, I am unable to conclude that the opponent has exposed the average consumer to the trade marks mentioned with sufficient intensity that the average consumer will assume that a further trade mark which merely contains the word "DOUGLAS" will be assumed to originate from them. However, even if such evidence had been provided, when one considers the commonality of the word "DOUGLAS", establishing a position based upon a family of trade marks would, in my view, have been an uphill struggle.

Conclusion under section 5(2)(b)

51. The opposition based upon section 5(2)(b) of the Act fails.

The opposition based upon section 5(4)(a) of the Act

52. Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd*

v. Borden Inc. [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townsend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

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

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

53. Under this section of the Act, the opponent relies under the use it has made of its “DOUGLAS & GRAHAME” and “DOUGLAS” trade marks from the dates mentioned in relation to the goods and services identified in paragraph 3 above. These are the same trade marks I identified as representing its strongest case under section 5(2)(b) of the Act. Even were I to assume the opponent had the necessary goodwill it claims in the

goods and services it has identified sufficient to get an objection under this section off the ground (which on the basis of the evidence provided I do not) having already explained why, in my view, there will be no likelihood of confusion in relation to either trade mark, I see no reason why there would be any misrepresentation and the objection under section 5(4)(a) fails accordingly.

Conclusion under section 5(4)(a) of the Act

54. The opposition based upon section 5(4)(a) of the Act fails.

Overall conclusion

55. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

Costs

56. As the applicant has been successful, he is entitled to a contribution towards his costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice 2 of 2016. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited him to indicate if he intended to make a request for an award of costs, and if so, to complete a pro-forma indicating a breakdown of his actual costs, including providing accurate estimates of the number of hours spent on a range of activities relating to the prosecution of the opposition. He did so.

57. In his pro-forma, the applicant indicated that he spent a total of ten hours dealing with the matter. This was split as follows: "Notice of Defence" eight hours and "Considering forms filed by the other party" two hours. He claims £250 in respect of these activities. The only other claim is for £20 in respect of "Other Expenses" in relation to which he states "Printing, postage etc."

58. As an unrepresented party, it would have been necessary for the applicant to familiarise himself with the Notice of Opposition and having done so, to research the position and to formulate an appropriate response. The Notice of Opposition ran to some twenty three pages with the opponent relying upon four earlier trade marks under section 5(2)(b) of the Act and two earlier rights under section 5(4)(a) of the Act. In his counterstatement, the applicant responded to the claims made by reference to the individual trade marks/earlier rights relied upon. Although his responses contained (often by necessity) a good deal of repetition, it is clear that he turned his mind to the individual earlier trade marks/earlier rights being relied upon. I have no doubt this is likely to have taken the applicant some time; as a consequence, a claim in respect of a total of ten hours is not, in my view, unreasonable. The applicant's request for an award of costs of £250 in respect of the ten hours claimed amounts to an hourly rate of £25; the applicant has, however, provided no explanation of how he arrived at this figure and, absent such an explanation, I am simply not in a position to determine if it can be justified. The TPN mentioned above indicates that in the context of these proceedings, in respect of its consideration of a Notice of Opposition and the filing of its defence, a professionally represented party is likely, depending on the nature of the statements, for example, their complexity and relevance, to be entitled to an award between £200 and £650.

59. Bearing the above in mind and given the lack of explanation of (i) an hourly rate of £25 and (ii) to what exactly the £20 claimed in relation to "printing, postage etc." related, I award costs to the applicant in the amount of £180 i.e. 10hrs x £18, the latter being the minimum level of compensation for litigants in person in The Litigants in Person (Costs and Expenses) Act 1975.

60. I order Douglas & Grahame Limited to pay to Michael James Peachey the sum of £180. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5TH day of May 2017

C J BOWEN

For the Registrar

The Comptroller-General

The opponent's goods and services

No. 2020233

Class 25 - Articles of outerclothing, none being footwear, for men, youths and boys.

No. 13582465

Class 35 - The bringing together for the benefit of others of a selection of men's, male youths' and boys clothing, headgear, footwear, bags, clothing accessories and fashion accessories enabling customers to conveniently view and purchase those goods in retail outlets, by means of a catalogue or through a retail website; wholesale services in relation to men's, male youths' and boys' clothing, headgear, footwear, bags, clothing accessories and fashion accessories; fashion show exhibitions for commercial purposes; organisation of fashion shows for commercial purposes; organisation of fashion shows for promotional purposes; all the aforesaid services solely relating to goods for men, male youths and boys.

Class 40 - Tailoring; cobbler services; millinery services; manufacture of clothing, footwear, headgear, bags, clothing accessories and fashion accessories.

Class 42 - Design of clothing, headgear, footwear, clothing accessories, fashion accessories and bags.

No. 2573673

Class 25 - Articles of outer clothing (for men).

No. 4780151

Class 35 - The bringing together for the benefit of others a selection of mens', youths' and boys' clothing enabling customers to conveniently view and purchase the goods in retail outlets, and by means of a catalogue, by means of electronic communication and by web pages through the Internet.