

TRADE MARKS ACT, 1963

Decision in Hearing under Section 26

IN THE MATTER OF an application for registration of Trade Mark No. 157500 and in the matter of an Opposition thereto.

BRANDWELL (IRL) LIMITED

Applicant

MARIE-CLAIRE ALBUM

Opponent

1. On 27 January, 1993, HARTSTONE IRELAND LIMITED, an Irish company of Unit 8/9 Bellevue Industrial Park, Finglas, Dublin 11, Republic of Ireland, predecessors in title of the Applicant, made application (No. 93/0327) to register the words "MARIE CLAIRE" as a Trade Mark in Part A of the Register in Class 25 in respect of a specification of goods that was amended in the course of the examination of the application to read as follows:

"hosiery; stockings; socks, pantyhose, tights and
underwear; lingerie; sleeping garments; knitted wear"

2. The Application was subsequently advertised as accepted for registration in Part A of the Register under No. 157500 in Journal No. 1753 on 8 February, 1995.
3. Notice of Opposition to the registration of the mark pursuant to Section 26 of the Act was filed on 10 July, 1995 by MARIE-CLAIRE ALBUM, a French Company of 11 bis rue Boissy d'Anglas, 75008 Paris, France. The Applicant filed a counter-statement on 14 March, 1996 and evidence was, in due course, filed by the parties under Rules 37, 38, 39 and 40 of the Trade Mark Rules, 1963.
4. The Opposition became the subject of a Hearing before me, acting for the Controller, on 27 June, 2002. The parties were notified on 13 January, 2003 that I had decided to uphold the Opposition and to refuse registration of the mark. I now state the grounds of my decision and the materials used in arriving thereat.

5. In its Notice of Opposition the Opponent stated as follows:

- (i) We have for many years and earlier than January 27, 1993, traded and have a substantial reputation under the Trade Mark MARIE CLAIRE.
- (ii) We are the Proprietor of a Trade Mark Registration with the following particulars:-

<u>T. Mark</u>	<u>Reg. No.</u>	<u>Date</u>	<u>Class</u>	<u>Journal</u>	<u>Page</u>
MARIE CLAIRE	126216	08/01/88	16	1590	671

- (iii) Our Trade Mark denotes and has long denoted both to the trade and the public, goods sold by us and distinguishes and has long distinguished such goods from the goods of other merchants and traders.
- (iv) The proposed use of the Trade Mark which the Applicant has applied to register is calculated to deceive and cause confusion and is otherwise disentitled to protection in a Court of law and in accordance with the provisions of Section 19 of the Trade Marks Act, 1963, should be refused registration.
- (v) The said Trade Mark which the Applicant has applied to register is identical or so nearly resembles our Trade Mark as to be likely to deceive or cause confusion to our Trade Mark which is already on the Register. In accordance with Section 20 of the Trade Marks Act, 1963, registration of the Trade Mark should be refused registration (*sic*).
- (vi) The said Trade Mark which the Applicant has applied to register is calculated to deceive and to lead to the Applicant's goods being passed-off or mistaken for goods sold by us and in which we trade as manufacturers and merchants.
- (vii) There exists a likelihood of confusion on the part of the public which includes the likelihood of association with our Trade Mark.
- (viii) Our Trade Mark has such a reputation in the State and the use of the **MARIE CLAIRE** Trade Mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of our Trade Mark.

- (ix) The Applicant does not use or propose to use the Trade Mark which it has applied to register for the purposes of indicating a connection in the course of trade between the Applicant and the goods and registration of the Trade Mark would therefore offend against the provisions of Sections 2 and 25 of the Trade Marks Act, 1963.
- (x) The said Trade Mark which the Applicant has applied to register is not adapted in relation to the goods in respect of which the Trade Mark is proposed to be registered, to distinguish the said goods from the goods of other traders and registration of the Trade Mark would therefore offend against the provisions of Section 17 of the Trade Marks Act, 1963.
- (xi) The said Trade mark which the Applicant has applied to register is not capable, in relation to the goods in respect of which it is proposed to be registered, of distinguishing the said goods from those of other traders and registration of the Trade Mark would therefore offend against the provisions of Section 18 of the Trade Marks Act, 1963.
- (xii) Registration of the said mark is contrary to Council Directive No. 89/104 EEC to approximate the laws of the Member States relating to Trade Marks.
- (xiii) The Application in respect of the Trade Mark which the Applicant has applied to register ought, in the discretion of the Controller, to be refused and costs awarded to the Opponents.

6. In its Counter-Statement the Applicant stated as follows:

- (i) The Applicant does not admit the statements made in paragraphs (i) and (iii) of the Notice of Opposition.
- (ii) The Applicant admits the statements made in paragraph (ii) of the Notice of Opposition.
- (iii) The allegations made in paragraphs (iv), (v), (vi), (vii), (viii), (ix), (x), (xi) and (xii) of the Notice of Opposition are emphatically denied.
- (iv) The Trade Mark MARIE CLAIRE (hereinafter referred to as the said Trade Mark), the subject of Trade Mark Application No. 157500 (hereinafter referred to as the said application) is qualified for registration under Sections 17 and 18 of the Trade Marks Act, 1963, and is a Trade

Mark within the definition contained in Section 2 of the Act. The Applicant has used or has a present and definite intention of using the said Trade Mark in respect of the goods set forth in the said Application and had such an intention at the date of filing of the said application. The said Application does not offend against the provisions of Section 25 of the Act.

- (v) Use by the Applicant of the said Trade Mark would not be likely to deceive and/or cause confusion, or to lead to Applicant's goods being passed off as or mistaken for goods of the Opponent, and registration of the said Trade Mark would not contravene Section 19 of the Trade Marks Act, 1963.
- (vi) Applicant denies that the Opponent has any reputation in the Trade Mark MARIE CLAIRE or that there is any likelihood of confusion or deception of the public or any likelihood that the Applicant's trade mark would be associated with the Opponent's Registered Trade Mark.
- (vii) Applicant denies that use of the said trade mark would take unfair advantage of or be detrimental to the distinctive character or repute of the Opponent's Registered Trade Mark
- (viii) The said Trade Mark does not so closely resemble Opponent's Trade Mark as to be calculated to deceive and/or cause confusion and registration of the said Trade Mark would not contravene Section 20 of the Trade Marks Act, 1963.
- (ix) Registration of the said trade mark would not be contrary to the provisions of the EC Harmonisation Directive (Council Directive 89/104/EEC)
- (x) There is no good reason why registration of the said Trade Mark should be refused at the discretion of the Controller.
- (xi) Accordingly, Applicant requests that the Opposition be rejected and that an award of costs be made in favour of the Applicant.

7. Evidence submitted by the Opponent under Rule 37 consisted of a Statutory Declaration (and Exhibits 1-14) of Evelyne Prouvost, General Manager of MARIE-CLAIRE ALBUM. In her Declaration, Ms. Prouvost states that the Opponent or its predecessors in title has been using the Trade Mark MARIE CLAIRE in relation to a women's magazine since 1937. In 1954 the magazine,

which was French, was distributed in the United Kingdom for the first time. In 1988 an English edition of the magazine was launched and this is sold in the United Kingdom and the Republic of Ireland. It is aimed at women in their mid 20's to 30's who are fashion conscious. Ms. Prouvost exhibits samples of the magazine front cover bearing the name "marie claire".

Ms. Prouvost then gives figures for sales of MARIE CLAIRE magazines in Ireland from 1989 to 1996, averaging approximately 16,500 copies per month. She explains that these figures are calculated on the basis that Irish sales represent approximately 5% of the circulation in the United Kingdom and she exhibits circulation figures for magazines sold under the mark in various countries including the United Kingdom. She also refers to registrations in respect of the mark throughout the world and exhibits a list of such registrations, which include a registration in Ireland in Class 16 under No. 126216 dated 8 January, 1988.

Ms Prouvost then gives evidence of the Trade Mark MARIE CLAIRE having become associated with goods other than a fashion magazine alone and, in particular, with clothing and fashion items themselves. This, she says, came about by the institution in the 1960's of a "shopping club" run through the pages of the magazine, which enabled readers to send away for items of fashion merchandise bearing the mark. The magazine that circulates in the United Kingdom and Ireland also features "MARIE CLAIRE SPECIAL OFFERS" whereby readers may purchase articles of clothing bearing the mark. A copy of an application form printed in the magazine relating to such a special offer is exhibited and it is pointed out that the form includes a statement to the effect that the offer is available to readers in the Republic of Ireland. Ms. Prouvost also mentions the introduction of the "MARIE CLAIRE PRIVILEGE SHOPPING CARD" which relates to a club that readers of the magazine may join and through which they may avail of discounts on a range of goods (including clothing) and services of companies that have joined the scheme. Ms. Prouvost points out that clothing manufacturers and retailers that wish to join the scheme must adhere to standards of quality and style associated with items of clothing sold by reference to the mark.

As further evidence of the connection between the mark and items of clothing, Ms. Prouvost refers to in-store promotions whereby the mark is applied to items of clothing by means of swing tickets, copies of which she exhibits and which bear the words “as seen in marie claire” and “marie claire supports British fashion”. Such promotions also involve the prominent display of posters bearing the mark in the vicinity of the items of clothing that are the subject of the promotions. The MARIE CLAIRE magazine also features so-called “advertorials”, which are set out to look like editorial fashion pages but are, in fact, advertisements for particular products or services. In addition, the mark has been used on t-shirts sold at an annual fashion exhibition “CLOTHES SHOW LIVE” and Ms. Prouvost exhibits a photocopy of the mark as illustrated on such a t-shirt. She also exhibits samples of promotional material used in the sale of clothing in the Far East and claims that the Trade Mark MARIE CLAIRE has become synonymous with fashion and women’s clothing in particular.

Ms. Prouvost also states that she believes that the Applicant for registration in this case is not the bona fide proprietor of the Trade Mark in Ireland. She questions whether the Applicant chose the mark independently and without being aware of the existence of the Opponent and/or its reputation in the mark. She refers to commercial agreements between her company and another entity, MONTAGUTE COMMERCIO E INDUSTRIA DE TEXTEIS LTD, (which has opposed the Applicant’s application for registration of the mark in co-pending proceedings before this Office) whereby the latter company uses the Trade Mark MARIE CLAIRE in respect of clothing as a means of exploiting the reputation enjoyed by the mark. She claims that the registration of the mark in the name of the Applicant would have serious repercussions for her company and would allow the Applicant to use the mark on goods that will be associated with the Opponent. Finally, she questions whether the Applicant intends to use the mark itself and states that she is not aware of any simultaneously filed Registered User application. In this regard, she exhibits a copy of a page taken from a published directory for the year 1996 entitled “KOMPASS” in which reference is made to the Applicant under the classification “leather and skin products” but which, she claims, makes no reference to the Applicant engaging in trade in the goods of the application.

8. Evidence submitted by the Applicant under Rule 38 consisted of a Statutory Declaration (and Exhibits HI1-HI9) of Sean Mahon, Managing Director of Hartstone Ireland Limited. In his Declaration, Mr. Mahon states that his company is a subsidiary of a British company, Hartstone Group PLC, which was incorporated in 1987 and which, he states, is a major manufacturer and distributor of hosiery products in the United Kingdom and Europe. Mr. Mahon explains that Hartstone Group PLC has pursued a policy of acquiring companies with well developed hosiery brands with the objective of expanding the Group's hosiery interests throughout Europe and, to this end, acquired a Spanish Group of Companies – the Aznar Group – in 1991. Aznar makes hosiery and socks in Spain and is, according to Mr. Mahon, the proprietor in Spain of the Trade Mark MARIE CLAIRE, which is used primarily in connection with hosiery. Mr. Mahon states that Aznar has registered the Trade Mark in Spain, Denmark, Turkey and the Lebanon and that, since adopting the mark in 1961, Aznar has built up a substantial reputation in it and has expended considerable sums (almost €2,000,000 per annum) promoting the mark.

Mr. Mahon then goes on to set out the way in which his company came to adopt the MARIE CLAIRE Trade Mark. He says that, following the acquisition of Aznar in 1991, it was decided to build on the strength of the Trade Mark in Spain by adopting it for use in other European countries, including Ireland where his company commenced sales of hosiery under the mark in 1992. Since then, he states, the mark has been used in relation to hosiery, which accounts for 90% of his company's trade and in relation to lingerie (since 1993) and ladies swimwear (since 1994).

Mr. Mahon exhibits samples of the three products, hosiery, lingerie and swimwear. Each sample bears on the packaging and/or on the swing ticket attached to the garment the word "AZNAR" and/or a statement to the effect that the product is made in Spain by Aznar S.A. or Aznar Industrial S.A. In the case of the article of lingerie, there is also in evidence on the packaging a logo in the form of a stylised combination of the letters "A" and "Z" enclosed in an ellipse, which I take to be a logo of Aznar. The packaging of the hosiery articles

exhibited also bears a statement to the effect that they are distributed in Ireland by Hartstone Ireland Limited, whose address is quoted. Mr. Mahon also exhibits a list of towns throughout Ireland where products which he refers to as “my company’s MARIE CLAIRE products” are on sale. The list is extensive and covers towns in each of the 26 counties of the State. He further exhibits a list of his company’s main customers to whom it supplies products bearing the Trade Mark; again, the list is extensive and includes some of the largest retailers and retail chains operating in the country.

Mr. Mahon gives figures for turnover in the State in respect of products bearing the Trade Mark for the years 1992-1996, totalling approximately €1,750,000 and for advertising of such products during the same period totalling approximately €20,000. In relation to advertising, Mr. Mahon states that this has taken place in a number of well-known publications, which he itemises, and he exhibits copies of the advertisements in question. These exhibits include copies of advertisements and features from magazines that appear to me to fall into two main categories, i.e., fashion and women’s magazines, such as IMAGE and WOMANS WAY, and trade publications such as RETAIL NEWS and CHECKOUT IRELAND. In the case of the former, the advertisements do not, in general, appear to create any link between the Trade Mark and the source or origin of the relevant goods; the goods are identified by reference to the mark but the advertisements do not make it clear that this mark signifies the goods of one or other undertaking. In the case of the trade publications, the advertisements and features make reference to MARIE CLAIRE products being “from Hartstone Ireland” or “launched by Hartstone Ireland” and, in at least one case, “distributed by Hartstone Ireland”.

Mr. Mahon also refers to promotion of the mark through point of sale displays, posters, consumer promotions and direct marketing. He exhibits 6 samples of promotional material featuring the mark, 2 of which mention his company as the information or contact point in respect of the relevant products. Mr. Mahon also states that his company has promoted the Trade Mark extensively through, *inter alia*, attendance at trade fairs, editorial and photo features in fashion magazines, “give-aways” on radio shows, etc. Mr. Mahon asserts that, as a result of all of

these activities, the Trade Mark MARIE CLAIRE exclusively denotes goods emanating from his company.

Mr. Mahon then goes on to address points made by Ms. Prouvost in her Statutory Declaration filed under Rule 37. He first addresses the claims made by Ms. Prouvost with regard to circulation of the Opponent's MARIE CLAIRE magazine in the Republic of Ireland. He points out that sales of the magazine in this jurisdiction since the date of filing of his company's application for registration should be disregarded as they are not relevant to the question of what reputation, if any, the Opponent had in the mark at the relevant date. He also asserts that the level of sales of the magazine in this jurisdiction at the relevant date appears to have been quite low and he questions the methodology used to estimate the volume of sales here. On the basis of figures published on the internet, copies of which he exhibits, Mr. Mahon states that, applying Ms. Prouvost's methodology, the estimated figures for sales of the magazine in the Republic of Ireland at the relevant date would be even lower than that averred by her in her Statutory Declaration.

Referring to Ms. Prouvost's evidence in respect of registrations of the Trade Mark MARIE CLAIRE held by the Opponent in various countries throughout the world, Mr. Mahon states that these do not mean that the Opponent enjoys a monopoly in the mark in all of the territories in question. He exhibits the results of a worldwide "screening search" which, he says, shows that the Opponent's registrations co-exist in numerous countries with registrations of the mark in the name of other, non-related, companies. He specifically refers to the situation in Ireland where there is a registration of the mark in Class 25 in the name of BATA SHOE COMPANY (IRELAND) LIMITED. The fact that this registration pre-dates that of the Opponent in Class 16 is taken by Mr. Mahon to prove that no conflict was perceived between the respective goods covered by the two marks at the time of the examination of the Opponent's application for registration; this, he asserts, supports the conclusion that there is no reason why the Opponent's registration for goods in Class 16 should be an obstacle to his company's application for registration of the mark in respect of goods in Class 25.

With regard to Ms. Prouvost's evidence relating to the "MARIE CLAIRE SHOPPING CLUB", "MARIE CLAIRE SPECIAL OFFERS" and "MARIE CLAIRE PRIVILEGE SHOPPING CARD", Mr. Mahon states that none of this establishes that there were any sales of clothing bearing the Trade Mark to customers in the Republic of Ireland; in fact, he states, the wording of the advertisement exhibited by Ms. Prouvost in relation to a specific special offer is such as would be likely to discourage readers in this country from seeking to avail of the offer, referring as it does to the fact that such persons must convert the Sterling price quoted to Irish punts and that they could be liable for duty in respect of the purchase. He also criticises the copies of swing tickets exhibited by Ms. Prouvost, which, he notes, are shown in isolation from any articles of clothing to which they were allegedly attached and which may have been used on clothing articles bearing trade marks of other traders. Again, he states that there is no evidence of any of the in-store promotions, viewings of clothing collections or attendance at trade fairs, referred to by Ms. Prouvost, having taken place in Ireland. He also points out that many of the exhibits filed by Ms. Prouvost are undated and, as a consequence, cannot be relied upon to establish reputation on a given date.

Mr. Mahon rejects the argument that appears to be advanced on behalf of the Opponent to the effect that its use of the Trade Mark MARIE CLAIRE in relation to a fashion magazine gives it a reputation under that mark in relation to articles of clothing. He states that he is unaware of any instances of confusion having arisen in this country between his company's goods and those of the Opponent bearing the same mark, nor has there been any such confusion in Spain where his "sister company" Aznar has used the mark and where the MARIE CLAIRE magazine is also sold. In fact, he states, Aznar advertised their MARIE CLAIRE range of hosiery in the Spanish edition of the MARIE CLAIRE magazine in 1991 and purchasers of the magazine received a free packet of the hosiery product.

Finally, Mr. Mahon refutes the allegation made by Ms. Prouvost regarding the lack of bona fides in his company's adoption of the Trade Mark MARIE CLAIRE. He refers to his explanation of the use of the mark by Aznar over a prolonged period and the commercial relationship between his company and Aznar which

resulted in the exploitation of the mark in this country by his company. He asserts that no evidence of use of the mark by the Opponent in relation to articles of clothing has been advanced and that there is no likelihood of confusion between his trade mark and that of the Opponent owing to the fact that their respective businesses are wholly unrelated.

9. Evidence submitted by the Opponent under Rule 39 consisted of a further Statutory Declaration (and Exhibits A-C) of Evelyne Prouvost. In this Declaration, Ms. Prouvost rebuts a number of the statements made by Mr. Mahon in his Declaration filed under Rule 38. Ms. Prouvost states that her company operates a policy of challenging third party applications for the registration of the Trade Mark MARIE CLAIRE and that, in pursuance of this policy, it has initiated action seeking cancellation of Aznar's registration of the mark in Turkey and has opposed Aznar's application for registration of a Community Trade Mark.

Ms. Prouvost goes on to state that evidence submitted in respect of Aznar's reputation and goodwill under the Trade Mark in Spain is irrelevant to the present application as Aznar is not the Applicant. With regard to Mr. Mahon's claim that the Spanish edition of the MARIE CLAIRE magazine carried advertising of Aznar's MARIE CLAIRE hosiery products, she points out that no exhibit was filed by way of supporting evidence in respect of this claim and states that the position in Spain is, in any event, exceptional and not relevant to these proceedings. She criticises the evidence submitted by Mr. Mahon and referred to as Exhibit HI2 in his Statutory Declaration, stating that the exhibits clearly state that the articles in question are made by Aznar in Spain and distributed by the Applicant. On this basis, she claims that the application for registration was wrongly made by the Applicant as it was neither the proprietor nor user of the mark.

Ms. Prouvost also takes issue with the figures and other evidence submitted by Mr. Mahon in respect of turnover and advertising. She claims that most of this evidence must be disregarded as it relates to a period subsequent to the making of the application. She also addresses the question raised by Mr. Mahon in relation to figures given in her earlier Statutory Declaration in respect of circulation of the

MARIE CLAIRE Magazine in Ireland. She acknowledges that the figures quoted included sales in Northern Ireland and she exhibits a summary sheet identifying and dividing wholesale sales figures between “Éire” and Ulster. She concedes that the accuracy of these figures for the period before 1993 cannot be guaranteed but avers that the figures are good approximations and not mere “guesstimates”. She also offers an explanation of the discrepancy between the figures given and those located by Mr. Mahon on the internet and exhibited with his Statutory Declaration under Rule 38; the latter, she says, would not have included subscription sales.

Referring to the registration in Ireland of the mark MARIE CLAIRE under No. 100763 in the name of BATA SHOE COMPANY (IRELAND) LIMITED, Ms. Prouvost explains that there was a mutual understanding between her company and that entity and she exhibits a copy of an Agreement relating to the United States which, she says, led to mutual understanding in a number of other countries. She further states that registrations of the Trade Mark throughout the world by entities other than the Opponent, which were cited by Mr. Mahon in his evidence, are almost all either registrations by companies associated with the Opponent or with which it has co-existence agreements. Ms. Prouvost states that, in the United Kingdom, the Opponent registered their mark in Class 25 in the face of opposition from Hartstone Hosiery Limited.

In response to Mr. Mahon’s criticism of the fact that several exhibits filed with her earlier evidence were undated, Ms. Prouvost exhibits front pages of the MARIE CLAIRE Magazine which are dated together with pages detailing special offers made prior to January, 1993. She states that it is not possible to determine from her company’s records how many customers in the Republic of Ireland availed of these offers. She argues against Mr. Mahon’s contention that her company’s reputation in the Trade Mark MARIE CLAIRE is limited to magazines, stating that this ignores the nature of the magazine itself and the fact that clothing bearing the mark has been sold to readers through offers contained in the magazine.

10. Evidence submitted by the Applicant under Rule 40 consisted of :

- a further Statutory Declaration of Sean Mahon of Hartstone Ireland Limited,
- a Statutory Declaration of John Julian Tristram Cronk of The Hartstone Group Plc,
- a Statutory Declaration of Jose Aznar Marin of Aznar, and
- a Statutory Declaration of Jose Aznar Marin of Aznar Industrial S.A.

In his Declaration, Mr. Mahon states that his company, Hartstone Ireland Limited, ceased to be subsidiary of the Hartstone Group Plc as a consequence of a management buy-out which resulted in the ownership of the company passing to him and his fellow directors. He refers to the Statutory Declaration of Ms. Prouvost filed under Rule 39 and states that the latter has failed to produce any evidence of sales of products under the disputed Trade Mark in this country. Mr. Mahon therefore denies that the Opponent has any reputation in the mark in Ireland. He states that, in his 14 years in the retail trade in Ireland, he has never encountered any clothing sold by the Opponent under the mark and nor has any of his company's representatives who travel throughout the country in the course of trade.

Referring to proceedings in other jurisdictions cited by Ms. Prouvost in which Aznar's registrations and applications for registration of the Trade Mark MARIE CLAIRE have been challenged, Mr. Mahon states his company's rights in the mark are limited to this jurisdiction and such proceedings are irrelevant to the situation obtaining in Ireland where, he asserts, the Opponent has no common-law or statutory rights in the mark. He does, however, contend that the fact that the Trade Mark MARIE CLAIRE is registered in Spain in the name of Aznar serves to undermine the Opponent's claim of geographically unlimited proprietary rights in the mark, particularly given that the Opponent has never challenged Aznar's rights to the mark in Spain.

With regard to the advertisement of Aznar's hosiery products under the mark in the Spanish edition of MARIE CLAIRE magazine, to which he referred in his

previous Declaration under Rule 38, Mr. Mahon states that such advertisements appeared in the magazine in October, 1989, February, 1991 and April, 1996. He exhibits copies of the advertisements in question.

Mr. Mahon then addresses the assertion of Ms. Prouvost to the effect that the Applicant is not the true proprietor of the Trade Mark. He reiterates that his company and Aznar were at one time subsidiaries of the Hartstone Group and that Aznar manufactured products for the other companies in the group, including for the Applicant. He avers that the goods sold by the Applicant under the Trade Mark were manufactured on its behalf by Aznar and that the Applicant assumes full responsibility for those goods, including for their marketing and promotion and for all “consumer related issues”. Mr. Mahon also defends the evidence previously submitted by him in respect of sales and advertising under the mark which, despite relating in part to periods after the application for registration was made, establishes that the mark has been used by the Applicant without causing confusion with the Opponent’s goods.

He again criticises Ms. Prouvost’s evidence in relation to circulation of the MARIE CLAIRE magazine in Ireland, noting that there is a significant discrepancy between the figures quoted by her in her two Statutory Declarations filed as evidence under Rules 37 and 39, respectively. He also questions whether the revised estimates given by Ms. Prouvost for the period 1989-1992 can be relied upon and states that, in any event, sales of the magazine would not have served to establish reputation in relation to clothing. The fact that there is no potential for confusion between the respective goods covered by the marks of the Applicant and the Opponent is, in Mr. Mahon’s opinion, reinforced by the co-existence of the Opponent’s registration in Class 16 and that of BATA SHOE COMPANY (IRELAND) LIMITED in Class 25. He also disputes Ms. Prouvost’s evidence relating to agreements between the Opponent and MONTAGUTE COMMERCIO E INDUSTRIA DE TEXTEIS, LDA for the exploitation of the Trade Mark MARIE CLAIRE, stating that neither entity has enforceable rights in the mark as applied to articles of clothing in this jurisdiction.

Turning to the Statutory Declaration of Mr. John Julian Tristram Cronk, the deponent in this case is Group Company Secretary of THE HARTSTONE GROUP PLC and a director of its subsidiary, HARSTONE HOSIERY LIMITED, both having registered addresses in England. Mr. Cronk's evidence relates to legal proceedings instituted by the present Opponent, Marie Claire Album S.A., in England (and referred to by Ms. Prouvost in her evidence under Rule 39), which resulted in Hartstone Hosiery Limited ceasing to use the Trade Mark MARIE CLAIRE. Mr. Cronk states that his company's agreement to a settlement of these proceedings in favour of the plaintiff, Marie Claire Album S.A., resulted from a strategic decision to focus on its non-hosiery interests and not from any acceptance of the merits of the other side's case. He states his belief that his company would have succeeded in defending the legal action taken against it if the matter had been fully tested before the courts and, in support of this, he avers that there were no instances of confusion between his company's products and those of the plaintiff during the 18 month period in which his company used the mark.

There are two Statutory Declarations of Mr. Jose Aznar Marin but they are both in the same terms and are made on behalf of AZNAR and AZNAR INDUSTRIAL S.A., respectively. Mr. Marin states that, until 8 April, 1998, his companies were sister companies of the Applicant in these proceedings. On that date, his companies ceased to be subsidiaries of the Hartstone Group Plc but continued thereafter to manufacture products on behalf of the other subsidiaries of that group, including the Applicant. He states that the revenue earned by his companies from MARIE CLAIRE products sold in Ireland is derived not from the direct sale of those goods but from the charges rendered by his companies to the Applicant in respect of the manufacture of the relevant goods; the goods are put on the market by the Applicant who assumes all responsibility for them and deals with any consumer complaints or other issues resulting from their sale in Ireland. On this basis, Mr. Marin concludes that it is the Applicant and not his companies that are the true proprietors of the Trade Mark MARIE CLAIRE in Ireland.

11. At the Hearing the Opponent was represented by Mr. Shane Smyth of FR Kelly & Co. and the Applicant by Ms. Bernadette Walsh of MacLachlan & Donaldson.

Mr. Smyth indicated at the Hearing that the Opponent would not pursue all of the grounds of opposition identified in the Notice of Opposition but only those under Sections 2 and 25, Section 19 and Section 20.

12. I look first at the objections based on Sections 2 and 25. The relevant parts of these two Sections are as follows:

Section 2

‘ “trade mark” means a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark’;

Section 25

“(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Controller in the prescribed manner for registration either in Part A or Part B of the register.”

In the present case, the question to be addressed is, who was the proprietor of the Trade Mark MARIE CLAIRE in respect of the relevant goods at the time of filing of the application for registration. If the Applicant was the proprietor, then the requirements of the foregoing Sections are met; if the Applicant was not the proprietor at that time, then the application was invalidly made and registration must be refused.

The evidence filed in relation to the Applicant’s claim to be the proprietor of the Trade Mark and the manner in which the Applicant came to adopt the mark establishes that the Applicant was part of a group of companies, which, at the time the application was made, included the Spanish companies, AZNAR and AZNAR INDUSTRIAL S.A. (hereinafter referred to collectively as “Aznar”). The evidence also shows that Aznar was the proprietor of the Trade Mark MARIE CLAIRE, which it had registered in Spain and elsewhere, in relation to hosiery and other clothing including lingerie, swimwear and sleeping garments. Products

made by Aznar and bearing their MARIE CLAIRE Trade Mark were sold in Ireland prior to the filing of the present application for registration. These products were put on the market in this country by the Applicant who appears, from its own evidence, to have acted as distributor of Aznar's products. No evidence has been adduced to show that the proprietorship in the Trade Mark MARIE CLAIRE passed from Aznar to the Applicant by way of an assignment or otherwise.

Applying the provisions of Section 2 of the Act, it seems to me that, at the time that the application for registration was filed, the use of the Trade Mark in relation to the goods served to indicate a connection in the course of trade between the goods and the entity which had the right as proprietor to use the mark, being Aznar. The Applicant has claimed that the mark denotes its goods on the basis that Aznar merely manufactures the goods on its behalf and that it (the Applicant) takes responsibility for the marketing and promotion of the goods and for any customer service issues arising thereafter. For this proposition to be believed requires an acceptance that Aznar applied the Trade Mark MARIE CLAIRE to the goods, not as their own mark but on the authority of the Applicant and for the purpose of identifying the Applicant as the source or origin of the goods. This was clearly not the case. There is no evidence of the Applicant having supplied Aznar with technical specifications of the design, construction or quality of manufacture of the products to be produced on its behalf by Aznar. Nor is there anything to show that the Applicant instructed Aznar as to the style and manner in which the Trade Mark was to be applied to the goods. On the basis of the evidence submitted, it appears that Aznar applied its mark, in which it had built a substantial reputation, to its products, which were subsequently sold in various countries, including Ireland. The Applicant was distributor in Ireland of products bearing the mark but that does not constitute a connection in the course of trade in the sense intended by Section 2 of the Act. Quality control appears always to have been in the hands of Aznar and I do not believe that the Applicant would have had any right to specify a different standard or quality of manufacture of the relevant goods or to influence any decision of Aznar's in that regard. Ms. Walsh, for the Applicant, stated at the Hearing that the Applicant was satisfied with the standard, etc. of the products produced by Aznar and exercised its claimed rights

as proprietor of the mark by selecting Aznar to manufacture their goods. I do not accept this proposition; it appears to me that the Applicant took what they were given by Aznar and what they were given were products bearing the MARIE CLAIRE Trade Mark, signifying Aznar as their source.

The evidence of the Applicant makes clear that the decision of the group of companies of which they were a part to adopt the Trade Mark was made in order “to build on the strength of the MARIE CLAIRE brand in Spain”, which strength is said to have stemmed from “the reputation which Aznar had established under that Trade Mark”. The business decision of a group of companies to build on the strength of a brand established by one of the companies in the group is a perfectly reasonable and understandable decision. However, the relationship that subsists between the various subsidiary companies within a group is not such as to vest in all of those companies jointly their collective assets so that the property of one becomes the property of all. Nor is the individual legal identity of each company within a group diminished in any way by virtue of its being part of a group. At the time of the filing of the application for registration, the Trade Mark MARIE CLAIRE was, in relation to the relevant goods, the property of Aznar and the fact that the Applicant company was part of the same group of companies as Aznar does not entitle it to claim proprietorship of the latter’s mark.

At the Hearing, Ms. Walsh for the Applicant made much of the fact that Mr. Jose Aznar Marin of Aznar had put in Statutory Declarations abjuring proprietorship of the Trade Mark *in Ireland*. These Declarations were made on 31 August, 1998. The statements made by the deponent to the effect that Aznar is not the proprietor of the Trade Mark in Ireland are, in my view, statements of opinion rather than fact. They are not consistent with the rest of the evidence filed in these proceedings. I must also have regard to the filing by Aznar of an application for registration of MARIE CLAIRE as a Community Trade Mark, to which reference was made by Ms. Prouvost for the Opponent in her evidence under Rule 39. I note that such an application was filed on 1 April, 1996 and I believe that that application would have been pending at the time that Mr. Aznar made the declarations referred to by Ms. Walsh. It would appear, therefore, that Mr. Aznar was claiming that the Trade Mark was owned by a company other than his own at

a time when his company had an application for registration of the mark pending before the Office for Harmonisation in the Internal Market. In my view, this casts further doubt on the reliability of Mr., Aznar's evidence.

Reference was made in the course of the Hearing to the decision of Mr. Justice Kenny in the FOCUS case (unreported), which addressed the question of the relationship between parent and subsidiary companies in the context of the use of a Trade Mark, as referred to in Section 25. For the reasons that I have set out, I believe that the use made of the Trade Mark MARIE CLAIRE in relation to the relevant goods was use by Aznar in so far as the use indicated a connection in the course of trade between the relevant goods and the proprietor of the mark, Aznar. I am satisfied that the correct interpretation of the FOCUS decision, if applied to the present case, is that the commercial relationship that existed between Aznar and the Applicant was not such as to make use of the Trade Mark by Aznar equivalent to use by the Applicant.

On the basis of the foregoing, I find that the Applicant was not the proprietor of the mark as required by Section 2 and did not use the mark as required by Section 25. Accordingly, I find that the Opposition under Sections 2 and 25 of the Act succeeds and the application for registration must be refused.

13. Having upheld the opposition under Sections 2 and 25, I am not required to go on to consider the opposition under Sections 19 and 20 of the Act. However, for the sake of completeness and having regard to the fact that the matter can go further, I think it appropriate that I should do so.

Section 19 of the Act reads as follows:

“19. – It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of law, or would be contrary to law or morality, or any scandalous design.”

The standard test for an objection under Section 19 is that set down in the *Smith Hayden & Coy Ltd.* application [1946] RPC 97, as adapted by Lord Upjohn in the *Bali* case [1969] RPC 472. In the present case, this would be applied as follows:

Having regard to the user of the Opponent's mark, is the Hearing Officer satisfied that the mark applied for, if used in a normal and fair manner in connection with any goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons.

On this interpretation, it is clear that, for an opposition based on Section 19 to succeed, it must first be established that there has been use of the Opponent's mark; whether that use has resulted in the mark having become known to a substantial number of persons, i.e., having acquired a reputation, must be judged by reference to the specific circumstances of each case. In this regard, Lord Upjohn in the *Bali* case, in further reference to Evershed, J.'s judgement in re *Smith Hayden & Coy Ltd.*, had this to say:

“It may also be said that the desiderata that the deception and confusion (in Evershed, J.'s statement) must be among a substantial number of people is a matter of judicial gloss. I do not object to this provided it is properly and sensibly applied. Here again, the *Transfermatic* case is a good illustration of the application of this condition to special circumstances.”

At the Hearing, Mr. Smyth for the Opponent addressed the question of the interpretation of Section 19 and cited two recent decisions, one of the Controller and one of the Court, in support of an assertion that it is not necessary for the Opponent's mark to be known to a substantial number of persons in order for Section 19 to apply. Firstly, he referred to the decision of the Controller in rectification proceedings between Dalgety Spillers Foods Limited (Applicants) and Tayto Limited (Registered Proprietors) in respect of the mark “GOLDEN WONDER”. Mr. Smyth quoted from a passage in that decision in which a written submission, submitted to the Hearing Officer by Counsel for the Applicant summarising its case, was reproduced. The passage in question contains the

statement that “*For Section 19 to apply, it is not necessary to prove goodwill or reputation in this country.*”. It is important to note that this statement was made on behalf of the Applicant in those proceedings (who was effectively in the same position as the Opponent in these proceedings) and the Hearing Officer did not indicate any agreement with it in his decision on the case; in fact, he decided the case on another, unrelated ground. I do not, therefore, accept that the decision in question stands as a precedent for a definitive interpretation of Section 19 in every case.

Mr. Smyth referred, secondly, to the Supreme Court decision in the DIESEL case, which, he asserted, supported the argument that the Opponent’s mark need not be known to a substantial number of people in order for Section 19 to apply; Mr. Smyth stated that the evidence in the DIESEL case showed that “*no party in fact had a reputation under the Trade Mark at the time of the application*”. I do not agree that the Supreme Court’s decision in the DIESEL case may be construed to this effect. The main finding of the Court was that Section 19 was to be given a normal or simple interpretation and that no additional element of, for example, blameworthiness was to be read into it, as had been argued by the Appellant. There was evidence of use of the mark by the Opponent before the Controller and the Court in the DIESEL case and I find nothing in its judgement to suggest that the Supreme Court disregarded that evidence or considered that the Opponent did not need to show use of, and reputation in, the mark. Accordingly, I consider that the first question to be addressed in relation to the Section 19 objection in this case is the use by the Opponent of the MARIE CLAIRE Trade Mark in Ireland and, secondly, if such use is established, the extent of the reputation acquired thereby.

I have summarised at paragraphs 7 and 9 above the evidence submitted on behalf of the Opponent. In so far as this evidence relates to circulation in Ireland of the MARIE CLAIRE magazine, the accuracy of the figures given is disputed by the Applicant. Indeed, the Opponent has acknowledged that the figures given for the period 1989-1993, i.e., before the date of the present application, do not represent certified actual sales of the magazine but have been calculated on the basis of an estimate and an extrapolation; firstly, the figures for sales in Ireland as a whole are

estimated as a percentage of total sales of the UK edition of the magazine and the proportion of these estimated sales in Ireland that is attributable to sales in the Republic of Ireland is then extrapolated from known figures for the period 1993-1997. In my view, the level of sales of the magazine in this jurisdiction in the relevant period claimed by the Opponent must be viewed with scepticism as the evidence submitted in support of that claim is very weak. The Applicant, in questioning the extent of the Opponent's magazine's circulation here, claims that this was not such as to imbue the mark with the reputation necessary to ground an objection under Section 19 of the Act. However, the fact that the mark was in use by the Opponent prior to the making of the present application is not disputed. The question, therefore, is the extent of the reputation acquired by that use.

In determining the reputation that the Opponent's mark is likely to have enjoyed at the time that this application was made, it is necessary to have regard, *inter alia*, to the goods to which the mark was applied, *viz.*, a monthly fashion and lifestyle magazine for women. Unlike many other products, a magazine is likely to impact not only on its immediate purchaser but also on the consumer public generally both before and after the instant of purchase. Shoppers browsing in the periodicals sections of newsagents and bookstores are likely to perceive the magazine although they may not subsequently choose to buy it. Similarly, friends, family members, work colleagues and, in some cases, customers or clients of purchasers of the magazine may be expected to also be exposed to it in the homes and places of business of those purchasers, despite the fact that such people did not themselves select the magazine for purchase. Such ancillary or extended reputation that a magazine may acquire is not reflected in a bare presentation of its sales statistics. In this case, it seems that there were sales in this country of at least some thousands of copies of this magazine each month over a period of 4 years prior to the present application. Having regard to the nature of the goods, I consider that sales of this volume would have been sufficient to ensure that the Opponent's mark was known to a substantial number of people at the time of the application for registration and, accordingly, I find that the Opponent has made out the basis of a case under Section 19.

The Opponent's reputation in the mark having been established, the onus of proof under Section 19 shifts to the Applicant who is required to show that, notwithstanding the Opponent's reputation, registration of the mark in the name of the Applicant would not be likely to deceive or cause confusion. In this regard, Ms. Walsh for the Applicant referred at the Hearing to the fact that the two marks have co-existed on the Irish market for almost 11 years and pointed out that no instance of confusion between the marks had been identified by the Opponent during all of that time. Quoting several authorities, she argued that, in determining the likelihood of confusion that existed at the date of filing of the present application, regard must be had to the actual position that has obtained in the market since that date and that, if it is shown that there has been no actual confusion, then it must follow that there was no likelihood of confusion.

It is accepted that the question of whether there is a likelihood of confusion between two marks involves a comparison both of the marks themselves and of the respective goods to which they are applied. In the present case, the marks are identical and, on that criterion, the likelihood of confusion between them is manifest. As to the respective goods, the Opponent's use of its mark has been in relation to a women's fashion and lifestyle magazine and the application for registration covers articles of clothing including hosiery, lingerie, sleeping garments and knitted wear. The Opponent has argued that it has also used its mark on or in relation to clothing. This contention is based on a number of facts, namely, (i) that viewings of new ready-to-wear clothing collections have been arranged and offered to readers of the MARIE CLAIRE magazine, (ii) that the mark is used in in-store promotions of clothing articles, (iii) that a "shopping club" is run through the magazine whereby readers may avail of discounts on a range of products including clothing and, (iv), that readers may avail of special offers whereby they purchase articles of clothing "designed exclusively for MARIE CLAIRE".

In relation to the first three of the grounds stated, I regard the use of the Trade Mark in the manner outlined to be in the nature of commercial endorsement by the Opponent of the products and services of other, unrelated entities for the purpose of mutual commercial gain. This is a normal commercial activity whereby

undertakings engaged in related fields of activity or interest agree to mutually endorse or promote each other's products or services with a view to attracting new customers and increasing their respective market shares. For example, a manufacturer of washing machines may recommend the use of a particular brand of washing powder in its machines and the washing powder itself may carry on its packaging a statement to the effect that it is "recommended by *Company X*". Exploitation and promotion of a brand identity in this manner, i.e. in relation to differently branded products, is, in my view, understood by the consumer public to be a marketing device and does not create in the minds of consumers a belief that the goods of one Trade Mark proprietor emanate from the other. In other words, there is no confusion caused by the use of a Trade Mark in this way because of the fact that the mark is not being used in a Trade Mark sense, i.e., as an indication of origin, but rather in a marketing or promotional way. For this reason, I do not consider such use to constitute use by the Opponent of its mark in relation to clothing for the purposes of considering the Section 19 objection.

With regard to item (iv) above, i.e., special offers to MARIE CLAIRE readers of clothing that has been "designed exclusively for MARIE CLAIRE" and bears the mark on a permanent label attached to each article, the question of whether this constitutes use of the mark on clothing is a more difficult one. On the face of it, the application of the mark directly onto articles of clothing that are offered for sale to persons in this country would appear compelling evidence of use. However, I believe that the manner in which the clothing is offered to readers of the magazine makes it clear to them that the articles in question are not items in which the Opponent carries on a trade but are offered in support of or ancillary to its fundamental commercial activity, viz. publishing. In these circumstances, and having regard to the fact that there is no evidence of any actual sales of garments bearing the mark, I find that the Trade Mark has not been used by the Opponent on or in relation to clothing.

The goods to be considered then are, in my view, a fashion and lifestyle magazine for women on the one hand and articles of clothing, including hosiery, lingerie, sleeping garments and knitted wear, on the other hand. The test for comparing goods as set down in *Jellinek* [(1946) 63 RPC 69] requires a comparison of (i) the

nature and composition of the goods, (ii) the uses of the goods and (iii) the trade channels through which the goods are sold. On all three criteria, clear differences between the respective goods of the Applicant and the Opponent are evident. While a connection or association between the goods may be asserted on the basis that they both fall within the general realm of “fashion”, I do not accept the Opponent’s contention that any such connection would be such that the use by the Applicant of the mark in relation to the goods of the application would cause confusion or deception. It has been observed that Section 19 serves a public interest in so far as it protects the public from being confused or deceived by the use of confusingly similar marks on similar or identical goods. In my assessment, there will be no confusion in the minds of the public on perceiving the Trade Marks of the Applicant and the Opponent used in relation to the respective goods and there will be no likelihood that consumers will believe that the goods of the Applicant originate from the Opponent or vice versa. Accordingly, I find that the objection under Section 19 of the Act is not supported and I would dismiss it.

14. Turning to the opposition under Section 20, the relevant part of subsection (1) of that Section provides as follows:

“(1) no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods.....

The Opponent’s mark is registered under No. 126216 in Class 16 in respect of a specification of goods that reads:

“Paper, cardboard, paper articles and cardboard articles, all included in Class 16; printed matter, newspapers, magazines (publications), books, bookbinding materials, photographs, stationery, artists’ materials, paint brushes, typewriters, office requisites (other than furniture) and instructional and teaching materials (other than apparatus).”

In considering the opposition under Section 19, I have already addressed the question of whether such goods are the same goods or the same description of goods as the goods of the present application. I have found that they are not. Accordingly, I find that the opposition under Section 20 cannot succeed.

Tim Cleary
Acting for the Controller

February, 2003