

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 211780 and in the matter of an Opposition thereto.

O.D.C. ENTERPRISES LTD.¹

Applicant

TOMMY HILFIGER LICENSING INC.

Opponent

The application

1. On 5 March, 1999, Goodstock Ltd., of Unit 8 K.C.R. Industrial Estate, Kimmage, Dublin 12, predecessor in title of the Applicant, made application (No. 1999/00797) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the words TOMMY SPORTS as a Trade Mark 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:

“Clothing for men, women and children; Shoes, boots and trainers for men, women and children.”

2. The application was accepted for registration and advertised accordingly under No. 211780 in Journal No. 1878 on 1 December, 1999. The advertisement of the mark carried a noting to the effect that the Applicant disclaimed any right to the exclusive use of the word “sports”.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 29 February, 2000 by Tommy Hilfiger Licensing Inc., a corporation organised and existing under the laws of the State of Delaware, United States of America, of 913 N. Market Street, Wilmington, Delaware 19801, United States of America. The Applicant filed a counter-statement on 26 May

¹ of 42 Morehampton Road, Donnybrook, Dublin 4

2000 and evidence was, in due course, filed by the parties under Rules 20, 21, 22 and 23 of the Trade Marks Rules, 1996 (“the Rules”).

4. The Opposition became the subject of a Hearing before me, acting for the Controller, on 14 March, 2006. The parties were notified on 24 April, 2006 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.

Notice of Opposition

5. In its Notice of Opposition the Opponent says that it has, for many years, carried on business as manufacturer and merchant of, *inter alia*, clothing, footwear and headgear. It says that it is the proprietor of the Irish and Community Trade Marks listed in Appendix I, which it has extensively used in connection with the aforesaid goods. It then specifies its grounds of opposition against the present application, namely, that the application offends against the provisions of Sections 6, 8, 10 and 37 of the Act for the following reasons:

- that the mark is identical with the Opponent’s marks and is to be registered for goods that are identical with those for which the Opponent’s marks are protected;
- that the mark is identical with or similar to the Opponent’s marks and is to be registered for goods that are identical with or similar to those for which the Opponent’s marks are protected, such that there exists a likelihood of confusion on the part of the public;
- that the mark is identical with or similar to the Opponent’s marks and, even if it is to be registered for goods that are not similar to those for which the Opponent’s marks are protected, its use would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent’s marks;
- that the mark is not capable of distinguishing the Applicant’s goods from those of other undertakings;
- that the mark is devoid of any distinctive character and consists exclusively of a sign or indication that may serve to designate the kind, intended purpose or other characteristics of the relevant goods;

- that the use of the mark is prohibited in the State by an enactment or rule of law or by a provision of Community law;
- that the application for registration is made in bad faith by the Applicant;
- that the mark is not used or proposed to be used by the Applicant or with its consent; and
- that registration of the mark is contrary to the provisions of Council Directive 89/104 EEC to approximate the laws of the Member States relating to Trade Marks.

Counter-Statement

6. In its Counter-Statement the Applicant denies all of the grounds of opposition and admits only the Opponent's proprietorship of the registered trade marks listed in Appendix I, although it does not admit the validity of those registrations and nor does it accept or admit that the Opponent is the proprietor of the pending applications listed therein².

The evidence

Rule 20

7. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration (and Exhibits TH1-TH6), dated 12 September, 2000, of Steven R. Gursky, Secretary of the Opponent. He refers to the Opponent's proprietorship of the trade mark registrations referred to in the Notice of Opposition and of some further Community Trade Marks, which were not cited in the Notice of Opposition and which, in any event, post-date the present application and he then makes the following assertions with regard to matters of fact:

- (i) the "TOMMY family of trade marks" has been protected worldwide in at least 120 countries,
- (ii) the name and trade mark TOMMY is identified and recognised by the public and the fashion industry and press as synonymous with the Opponent (*copies of press articles and advertisements exhibited*),

² it appears that all of the applications that were pending at the time of the filing of the Notice of Opposition have since proceeded to registration.

- (iii) revenue derived from TOMMY branded products for the period 1993-1999 amounted to over \$4 billion (*figures for individual years provided*),
- (iv) the Opponent spent more than \$85 million in the period 1997-2000 advertising and promoting its products worldwide (*sample advertising material exhibited*),
- (v) sales throughout Europe, including Ireland, for the period 1997-2000 totalled almost €5 million (*figures for individual years and product lines provided*),
- (vi) the Opponent's advertising budget for the United Kingdom and Ireland for the year 2000 was €1 million and advertising has occurred in magazines circulating in Ireland (*sample advertisements and press clippings exhibited*),
- (vii) TOMMY branded products are sold through a number of retailers including Arnotts of Henry Street and Brown Thomas of Grafton Street (*sample invoice dated 18/07/1997 to Brown Thomas exhibited*),
- (viii) the Opponent has taken an assignment of an application for registration in the United Kingdom of the words TOMMY SPORT in Class 14 and has negotiated a settlement with an entity called BM Fashions whereby it is acquiring a number of TOMMY SPORTS applications and registrations in numerous jurisdictions, including the United Kingdom,
- (ix) the Applicant has adopted the trade mark TOMMY SPORTS in order to avail of the significant goodwill and reputation which the trade mark TOMMY enjoys.

Rule 21

8. Evidence submitted by the Applicant under Rule 21 consisted of a Statutory Declaration (and Exhibits G1-G6) dated 2 January, 2002 of Derek McGarry, a Director of Goodstock Ltd., the then Applicant. The relevant facts averred to by Mr. McGarry are as follows:

- (i) Goodstock Ltd. have been selling articles of outer clothing, including t-shirts and sweatshirts, in the State under the trade marks TOMMY SPORTS and TOMMY SPORT since February 1999, prior to which date

that clothing was sold by Goodstock Ltd.'s sister company, Life Jacket Limited,

- (ii) during the period February 1999 – November 2001, approximately £100,000 worth of clothing was sold in the State under the trade mark TOMMY SPORTS/TOMMY SPORT (*representations of clothing items bearing the marks and sample copy invoices bearing dates in 1999 exhibited*),
- (iii) during the period 1999-2001, Goodstock Ltd. spent approximately £7,000 promoting the TOMMY SPORTS/TOMMY SPORT range of clothing, primarily through the supply of in-store promotional material (*samples exhibited*),
- (iv) in March, 1999, the Opponent initiated interlocutory proceedings in the High Court to prevent the sale by Mr. McGarry's company of clothing bearing the trade marks TOMMY SPORTS and TOMMY SPORT but the Court refused the relief sought,
- (v) the Opponent does not have a monopoly in trade marks incorporating the word TOMMY, including in relation to goods in Class 25 (*results of searches of the Irish, Community and United Kingdom databases exhibited*).

Rule 22

9. Evidence submitted by the Opponent under Rule 22 consisted of a Statutory Declaration (and Exhibits TH1-TH5) dated 25 July, 2002 of Jade Huang, Vice President of the Opponent. She recites some factual information relating to the achievements of Mr. Tommy Hilfiger, which does not appear to constitute evidence that is strictly in reply to the Applicant's evidence (as required by Rule 22(2)) and which does not, in my opinion, bear significantly on the matters that I have to decide. She also refers to surveys conducted in other jurisdictions with regard to public recognition of the trade mark TOMMY, some details of which she exhibits. In reply to the Applicant's evidence, she states that the High Court did, in fact, grant an interlocutory injunction restraining Mr. McGarry's company from selling certain goods and that the substantive hearing of the matter had yet to be decided. With regard to the Opponent's allegation of bad faith in the adoption of the mark TOMMY SPORTS by the Applicant, she notes that Mr. McGarry's

first name is Derek, not Tommy, and that it can be seen from the Applicant's own evidence that it has used the trade mark in conjunction with devices signifying a connection with America, thereby reinforcing the association between the relevant goods and the Opponent's business. In response to the Applicant's criticisms of the Opponent's evidence under Rule 20, Ms. Huang provides details of turnover in clothing sold by the Opponent in the Irish market for the period 1997-2001 and of advertising of the Opponent's products in newspapers and periodicals circulating here.

Rule 23

10. Evidence submitted by the Applicant under Rule 23 consisted of a further Statutory Declaration (and Exhibit DMCG1) dated 27 February, 2004 of Derek McGarry. The only matters of fact that I regard as relevant in this Declaration relate to the Applicant's adoption of the trade mark TOMMY SPORTS and its use of that trade mark in conjunction with devices having an American flavour. As to the first of these, Mr. McGarry says that he has long been a fan of the rock group, The Who, and that he acquired the nickname "Tommy" because of the number of times he went to see the musical of that name when it was released in 1975. With regard to the use of "Americana" in conjunction with the mark on clothing sold by the Applicant, Mr. McGarry says that this reflects a fashion trend in vogue at the relevant time and he exhibits photographs of a garment which he says was purchased from the well-known clothing retailer, Dunnes Sores, in March 1999, on which similar use of American insignia is evident.

11. Evidence submitted by the Opponent under Rule 23 consisted of a further Statutory Declaration (and Exhibits TH1 and TH2) dated 26 May, 2004 of Jade Huang, which does not contain any additional facts that I regard as worthy of mention.

The hearing and issues for decision

12. At the hearing the Opponent was represented by Mr. Michael Howard, SC instructed by F.R. Kelly & Co., Trade Mark Agents and the Applicant by Mr. Paul Coughlan, BL instructed by MacLachlan & Donaldson, Trade Mark Agents. Mr. Howard confined his submissions to the grounds of opposition raised under

Section 8(3)(b) [*mark deceptive in nature*], Section 8(4)(b) [*application for registration made in bad faith*] and Section 10 [*conflict with Opponent's earlier trade marks*]. He also questioned the Applicant's proprietorship of the mark propounded for registration and its entitlement to prosecute the application in place of the original Applicant, Goodstock Limited. While the other grounds of opposition mentioned in the Notice of Opposition were not formally abandoned, the Opponent has given no evidence in support of them and, in the absence of any argument in support of them at the hearing, I regard it as sufficient to say that they are dismissed as unsubstantiated. As to the grounds of opposition mentioned above, I consider each in turn below. A decision in favour of the Opponent on any one of those grounds determines the matter and obviates the need for consideration of the others but I treat each separately so that, in the event of an appeal, any matter that could have been decided by the Controller will have been.

Applicant's proprietorship of the mark and entitlement to prosecute application

13. At the hearing Mr. Howard referred to the well established test of ownership of a mark³, whereby ownership vests in the party that first uses the mark within the jurisdiction, and he asserted that the Opponent had used the name TOMMY in relation to articles of clothing sold in the State before the Applicant had. The Applicant could not, therefore, claim to be the true proprietor of the mark put forward for registration. He also asserted that the entitlement of O.D.C. Enterprises Limited to prosecute the application in place of the original Applicant, Goodstock Limited, was not established as the former's proprietorship of the application or the means by which it acquired title to it had not been recorded on the Register or disclosed to the Opponent.

14. As regards the first matter, it appears to me that the Opponent is precluded from objecting to the present application on the basis of proprietorship, *per se*, of the mark in question. The Act does not specify that an applicant must be the proprietor of a mark propounded for registration⁴ and any objection that the Opponent wishes to make based on its claimed earlier use of the word TOMMY

³ as set out by Moritt L.J. in *Al Bassam Trade Mark* [1995] RPC 511 and followed by O'Sullivan J. in the High Court in *Montex Holdings Limited –v- The Controller and Diesel S.P.A.* [2000] 1 IR 577

⁴ as was required under the former Act, the Trade Marks Act, 1963

as a trade mark for clothing may only be considered in the context of its objection under Section 10 of the Act. There is no basis for a finding that the Opponent's earlier user of that word and its proprietorship of it as a trade mark, if proven, are sufficient, of themselves, to warrant refusal of the present application. Proprietorship alone is no longer a deciding factor in whether or not a mark may be registered and nor has any ground of opposition been cited in the Notice of Opposition on which an objection based on proprietorship alone may be sustained. It is therefore unnecessary for me to consider whether or not the Applicant can claim to be the proprietor of the mark put forward for registration and it is sufficient to say that the Opponent's objection in that regard is invalid.

15. With regard to the entitlement of O.D.C. Enterprises Limited to pursue the application in place of the original applicant, it was clear from Mr. Howard's submissions at the hearing that the Opponent accepted that an application for registration of a trade mark may be the subject of an assignment⁵ and that, if validly assigned, the further prosecution of the application may be undertaken by the assignee. The Opponent's objection on this point was advanced on the basis that it had not been permitted to inspect the instrument of assignment submitted to the Controller in support of the request by O.D.C. Enterprises Limited to be recorded as proprietor of the application, notwithstanding having made a request in that regard and having paid the prescribed fee. The Opponent also objected because it claimed that the assignment had not been "*recorded in the Register*".

16. Referring firstly to the latter issue, I indicated to the parties at the hearing (and now confirm) that there is no question of recordal *in the Register* of the details of an assignment of a pending application for registration. Unless and until such an application proceeds to registration, there is no entry whatsoever in respect of it in the Register. Rather, particulars of the application are entered in an electronic database which is available for public inspection but which is, in respect of a given application for registration, no more than a record created and maintained by the Office for administrative purposes, the contents of which cannot affect the validity of the application in question. I also informed the parties at the hearing

⁵ the combined effect of Sections 28 and 31 of the Act

that the Office had not permitted the Opponent to inspect the deed of assignment in question because the Applicant had not given its consent, as required by Rule 60(3)(h) of the Rules. In the event, the Applicant handed over a copy of the deed of assignment to the Opponent's representatives at the hearing and no further play was subsequently made of this objection by Counsel for the Opponent. For that reason, I have decided to treat the Opponent's objection to the prosecution of the application in the name of O.D.C. Enterprises Limited as abandoned.

Section 8(3)(b) – is the mark deceptive in nature?

17. Section 8(3)(b) of the Act provides that “*a trade mark shall not be registered if it is of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service (sic)*” in respect of which registration is sought. At the hearing, Mr. Howard asserted that deception of the kind referred to in this Section is, in substance, the same as the concept of confusion of the public as referred to in Section 10 of the Act in a case where the deception in question is deception as to the commercial origin of the marked goods and where such deception arises from the similarity between the trade mark propounded for registration and the trade mark of another undertaking. In this regard, he noted that many of the older cases make no distinction between the concepts of deception and confusion, which terms are often used together and interchangeably. In his response, Mr. Coughlan confined his submissions to the question of the likelihood of confusion within the meaning of Section 10, assuming, no doubt, that if I agree that there is no material difference between the concepts of deception and confusion, then it would be unnecessary to offer more than a single rebuttal of the Opponent's objection.

18. In my opinion, the concept of deception, as referred to in Section 8, may not be conflated with that of confusion, as referred to in Section 10, in the manner suggested. I say that because the prohibition on registration contained in Section 8 is confined to marks that are *of such a nature as to deceive*, from which I believe it follows that, for the Section to apply, the propensity of the mark to deceive must stem from something inherent in the mark itself rather than from some other circumstance, i.e., the existence of another similar mark. In other words, marks that are deceptive within the meaning of Section 8(3)(b) are marks

that, directly and by their nature, declare a falsehood as to the qualities or characteristics that the consumer may expect of the marked goods or services. Thus, any confusion that may arise in the minds of the consumer as to the commercial origin of goods or services owing to the similarity between a mark used on such goods or services and another mark with which the consumer is familiar does not constitute deception within the meaning of Section 8(3)(b) as it does not result solely or essentially from the nature of the one mark (that seeking registration) but, rather, from a concurrence of appearance, sound or meaning of the two marks. Of course, the concept of deception does not exclude deception as to commercial origin such as, for example, in the case of an application for registration of a trade mark “*BRAND A – from the makers of BRAND B*”, where, in fact, the two brand owners are unrelated. Such a mark would be deceptive in nature because it would cause consumers to be misled as to the commercial origin of the goods but that misleading would arise from the lie spoken by the mark (“of such a nature as to deceive”) rather than from any confusion, *per se*.

19. I am satisfied, therefore, that the Act has clearly decoupled the concepts of deception and confusion and that deception within the meaning of Section 8(3)(b) is not to be equated with confusion as to commercial origin within the meaning of Section 10(2). The Opponent’s objections to registration on those two grounds require separate consideration, each on its own merits. As it is, no evidence or argument has been put forward by the Opponent to suggest that the trade mark TOMMY SPORTS is, of its nature, in any way deceptive as to any characteristic of the goods covered by the application and the opposition under Section 8(3)(b) must therefore be dismissed.

Section 8(4)(b) – was the application for registration made in bad faith?

20. Section 8(4)(b) of the Act provides that “*a trade mark shall not be registered if or to the extent that the application for registration is made in bad faith by the applicant*”. Objection on this ground was raised at paragraph 11 of the Notice of Opposition and amplified upon by the statement of Mr. Gursky, referred to in paragraph 7(ix) above, in his Statutory Declaration filed under Rule 20. The point was returned to by Ms. Huang in her evidence for the Opponent under Rule 22 in which she referred to the Applicant’s use of American insignia in conjunction

with the trade mark TOMMY SPORTS. For its part, the Applicant has denied the allegation of bad faith throughout, including in its Counter-Statement and in the evidence of Mr. McGarry, particularly in his Statutory Declaration filed under Rule 23 in which he made averments directly in reply to Ms. Huang's evidence.

21. At the hearing, Mr. Howard argued that the adoption by the Applicant of the trade mark TOMMY SPORTS must have been an attempt to derive benefit from the Opponent's reputation in clothing sold under the name TOMMY and that the Applicant's evidence as to how it came to adopt the mark was both contradictory and incomplete. He asserted, in particular, that Mr. McGarry had explained the Applicant's adoption of the mark in his first Statutory Declaration by referring to the widespread use of personal names as trade marks for clothing but that, when challenged on that explanation, he had given the explanation of his having acquired the nickname "Tommy" in the 1970's and, even then, he had not explained how he came to adopt that nickname as a trade mark for clothing. The manner in which the Applicant had used the trade mark in conjunction with American insignia also suggested, in Mr. Howard's submission, that the adoption of the mark had been for the purpose of associating the Applicant's goods with those of the Opponent.
22. In reply, Mr. Coughlan asserted that the charge of bad faith had not been made out by the Opponent and required no rebuttal, by evidence or argument, on the part of the Applicant. He argued that the suggestion that the Applicant's adoption of a trade mark that bears some resemblance to marks owned by the Opponent must, of necessity, be an act of bad faith was unsupportable and that the onus was on the Opponent to adduce actual evidence of bad faith on the part of the Applicant and that, if it failed to do so, then the allegation must be rejected. In any event, he said, there was no contradiction in the Applicant's evidence as Mr. McGarry had not put forward the prevalence of the use of personal names as trade marks for clothing as some form of defence against the charge of bad faith but merely to illustrate the weakness of the Opponent's claim to proprietary rights in respect of the word TOMMY as a trade mark for clothing. The evidence given by Mr. McGarry on the bad faith issue was that "Tommy" is his nickname and that the use of American insignia in conjunction with the trade mark TOMMY SPORTS

was consistent with a fashion trend in vogue at the relevant time. In Mr. Coughlan's submission, if evidence was required to defeat the charge of bad faith, then that evidence was more than sufficient.

23. In considering this aspect of the case, I have first to decide whether a *prima facie* case has been made out by the Opponent such that the onus passes to the Applicant of proving that the application has not been made in bad faith. I have previously considered the factors affecting that question in my decisions in relation to Trade Mark No. 213120 *AFFEX*⁶ and Trade Mark No. 216722 *ZIMOCLONE*⁷ and I have held that, in order for bad faith to be established, the specific misconduct perpetrated by an applicant must either be shown by the evidence adduced or it must be the inescapable inference to be drawn from the circumstances of the case. It follows that, if there is neither any concrete evidence of bad faith or any appearance of it from the circumstances of the application, then the onus of disproving the charge cannot pass to the applicant and the opposition on that ground must be dismissed without further ado. I do not think that that assessment is at odds with the statement of O'Sullivan J in the High Court in *Montex Holdings Limited –v- Controller of Patents, Designs and Trade Marks and Diesel S.P.A., DIESEL* [2000] 1IR 577, to the effect that “*once a charge of lack of bona fides was made ... there could be no doubt that such a charge required refutation*”. I do not believe that, by that remark, the learned judge was suggesting that every allegation of bad faith against an applicant for registration of a trade mark, whether particularised and substantiated or not, must be disproved by the applicant, failing which the application must be refused. That would simply encourage the making of speculative allegations of bad faith leading to unnecessary delay and expense. If anything, *DIESEL* supports the proposition that, as regards an allegation of bad faith, every case turns on its particular facts and that reliance should be placed on the facts of the case under consideration rather than on general principles.

⁶ paragraphs 16-19 of decision dated 21 February, 2005 in the matter of an application by Fujisawa Deutschland GmbH and opposition thereto by Wyeth

⁷ paragraph 19 of decision dated 29 August, 2005 in the matter of an application by McDermott Laboratories Limited and opposition thereto by May & Baker Limited

24. In the present case, the Opponent has not brought forward any evidence tending to suggest that the application for registration was made in bad faith by the Applicant. There is evidence, albeit put in by the Applicant, that the Applicant has used the trade mark TOMMY SPORTS in conjunction with American-style insignia, which are similar to devices incorporated in the Opponent's registered trade marks. It also appears from the Order of the High Court (Kearns J) dated 25 March, 1999, which is exhibited to Ms. Huang's Statutory Declaration filed under Rule 23, that the present application for registration was made just two days after the institution by the Opponent of proceedings against Mr. McGarry arising from the use of the TOMMY SPORTS trade mark. Finally there is the matter of the trade mark itself, which is not an obvious name for use in relation to clothing⁸ and the adoption of which for that purpose may beg the question as to what the Applicant's motive was.

25. Having considered the matter carefully in light of the facts and the submissions made on behalf of the parties, I find that the available evidence and the circumstances of the application do not support the suggestion that the application for registration was made in bad faith to an extent sufficient to shift the burden of proving otherwise onto the Applicant. The fact of the Applicant having adopted a mark that resembles the Opponent's trade marks cannot, of itself, create the appearance of bad faith. If it did, then every case in which grounds for an objection under Section 10 existed would also present a *prima facie* objection under Section 8(4)(b); that cannot be the intention or effect of the Act. As to the Applicant's previous use of the mark in conjunction with American insignia, it must be recalled that no such insignia are included in the mark as propounded for registration and the use of such insignia in the past can hardly be said to support the contention that the present application is made in bad faith when all that the Applicant seeks to have registered is the word mark TOMMY SPORTS alone. Nor does the filing of the application immediately after the institution of proceedings by the Opponent necessarily suggest that the application was made in bad faith. The filing of the application for registration may equally be seen as a

⁸ just as DIESEL was not an obvious mark for clothing

prudent measure on the part of the Applicant in circumstances where its entitlement to use the mark was clearly being put in issue. Finally, with regard to the “non-obvious” nature of the mark itself, there is nothing unusual about the adoption as trade marks of words that bear no relation to the goods on which they are used; indeed, that is what gives most marks their distinctiveness and is often the basis on which registration is granted.

26. Of course, the Opponent would say that it is unreasonable to look at each of these various factors in isolation and that it is the cumulative or combined effect of them that creates the appearance of bad faith about the present application. Even when looked at from that perspective, however, I think that the facts of the present case do not support the inference that the application was made in bad faith. In my view, the combined effect of the factors identified is not substantially more indicative of the fact that the application was made in bad faith than is any one of those factors individually. Thus, the fact that the Applicant has applied to register a distinctive mark that resembles marks owned by the Opponent in respect of the same goods as those in respect of which the Opponent’s marks are registered and in circumstances where the Applicant was aware of the existence of the Opponent’s marks and had previously used devices resembling devices used by the Opponent does not necessarily lead to the conclusion that the application must have been made in bad faith. It is equally arguable that the Applicant adopted its mark independently and without the ulterior motive suggested by the Opponent and, even on the balance of probabilities, I think that the Opponent has not made out the case on bad faith such that there is any onus on the Applicant to prove otherwise.

27. If I am wrong on this point and there is an onus on the Applicant to show that the application for registration was not made in bad faith, then I think that the Applicant’s evidence answers the charge sufficiently. While the Opponent may regard Mr. McGarry’s evidence to the effect that his nickname is Tommy as suspiciously convenient, the fact is that he made that statement under oath in a Statutory Declaration and I feel obliged to accept it as true unless the contrary is shown. The fact of the nickname then establishes the independent provenance of the Applicant’s trade mark and provides an answer to the suggestion that it was

adopted to trade off the claimed reputation of the Opponent's marks. I also accept the plausibility of the Applicant's evidence with regard to the use of American insignia although I hardly think that requires explanation in the context of an application for registration of a mark that consists of words only. On balance, I think there is as much cause to believe that the Applicant happened to adopt a trade mark that is similar to those of the Opponent for its own independent reasons as there is for suggesting that the mark was adopted for the purpose of deriving benefit from an association with the Opponent's goods. In those circumstances, I could not find, on the balance of probabilities, that the application for registration was made in bad faith by the Applicant and I would dismiss the opposition on that ground also.

Section 10(1) – are the respective marks and the respective goods identical?

28. Section 10(1) of the Act provides that “*a trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected*”. The Opponent's trade marks listed in Appendix I constitute “earlier trade marks” within the meaning of Section 11 of the Act as against the present application and, as regards the marks registered in Class 25, the goods for which those trade marks are protected include the goods covered by the present application. There is no dispute as to these matters. The only question is whether the mark that the Applicant seeks to register is identical with any of the marks in question. At the hearing, Mr. Howard suggested that the Opponent's Registration No. 148793 TOMMY JEANS could be regarded as identical with the present mark, TOMMY SPORTS, as each mark was subject to a disclaimer in respect of the non-distinctive element, JEANS in one case and SPORTS in the other, and the essential and distinguishing feature of each was, therefore, the word TOMMY only. Mr. Coughlan rejected that argument on the basis that the marks must be viewed and compared in their totality and that the respective disclaimers served only to restrict the scope of protection claimed for the marks and did not have the effect of changing their identities.

29. The decision of the European Court of Justice (ECJ) in Case No. C-291/00, *LTJ Diffusion SA and Sadas Vertbaudet SA*, is directly relevant to this question. In

that case, the ECJ considered the question of when a sign, which displays some differences from a registered trade mark, may, nevertheless, be said to be identical with that trade mark for the purposes of the provisions of the Directive⁹ governing infringement. Having observed that its findings in the matter must apply equally as regards the provisions governing registrability under Article 4(1)(a) of the Directive¹⁰, the ECJ stated that,

“a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer”.

30. The application of that finding to the present case requires consideration of the question whether the average consumer would be likely not to notice the difference between the sign TOMMY SPORTS and the trade mark TOMMY JEANS, having regard to the fact that the average consumer rarely has the chance to make a direct comparison of marks but must rely on the imperfect picture of them that he has kept in his mind. While I have no doubt but that the dominant and distinctive element of each of the respective marks in this case is the word TOMMY, I am inclined to think that the other elements, and the clear difference between them, are not so insignificant in the context of the marks as a whole as to be likely to go entirely unnoticed by the average consumer. The words JEANS and SPORTS are given equal prominence in the respective marks as the word TOMMY and each serves to indicate something about the nature of the respective goods that must be assumed to impact to some degree on the mind of the average consumer. In those circumstances, I think it would be wrong to say that the criterion of identity, which is to be interpreted strictly¹¹, is satisfied in this case and I find, therefore, that the objection to registration under Section 10(1) of the Act does not apply and that the opposition under that Section must be dismissed.

⁹ First Council Directive 89/104/EEC of 21 December, 1988 to approximate the laws of the Member States relating to Trade Marks

¹⁰ equivalent to Section 10(1) of the Act

Section 10(2) – is there a likelihood of confusion on the part of the public?

31. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:

“A trade mark shall not be registered if because –

(a).....

(b) it is similar to an earlier trade mark and would be registered for goods 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 of the later trade mark with the earlier trade mark.”

32. As already noted in paragraph 28, the Opponent’s trade marks cited in the Notice of Opposition are “earlier trade marks” as against the present application and the goods for which certain of those marks are protected are the same as those in respect of which the Applicant seeks registration. As far as the objection under this Section of the Act is concerned, therefore, the question to be addressed is whether the mark propounded for registration is similar to any of the Opponent’s marks and whether there is, as a consequence, a likelihood of confusion on the part of the public. Again, it is convenient to look only at the Opponent’s Registration No. 148793 TOMMY JEANS in Class 25, which, quite plainly, is similar to the Applicant’s TOMMY SPORTS, a fact that Mr. Coughlan accepted at the hearing although he denied that there would be a likelihood of confusion between the two.

33. In considering this aspect of the case, I have taken guidance from a number of ECJ decisions¹² addressing the concept of likelihood of confusion between marks. Those decisions direct that the likelihood of confusion must be appreciated globally, having regard to all of the circumstances of the case including the degree

¹¹ paragraph 50 of ECJ decision in Case No. C-291/00

¹² Sabel BV –v- Puma AG and Rudolph Dassler Sport (Case C-251/95); Canon Kabushiki Kaisha –v- Metro-Goldwyn Mayer Inc. (Case C-39/97); Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV (Case C-342/97)

of similarity between the respective marks and the respective goods, the distinctiveness of the earlier mark and the likely perceptions of the average consumer of the category of goods concerned. Furthermore, a global appreciation of the likelihood of confusion must, as regards the visual, aural and conceptual similarity of the marks, be based on the overall impression created by them in the mind of the average consumer, having regard, in particular, to their dominant and distinctive components. In this regard, the average consumer is deemed to be reasonably well-informed, observant and circumspect but would rarely have a chance to make a direct comparison between marks and must rely on the imperfect picture of them that he has kept in his mind.

34. The principles of interpretation thus established by the ECJ underline the importance of judging the likelihood of confusion between trade marks within the context of the ordinary course of trade. To do that, one must assume a normal use of the registered trade mark in relation to goods for which it is protected and then ask what would be the likely outcome in practice if the mark seeking registration were to be used in a normal and fair manner in respect of the goods covered by the application. In the present case, the whole matter can be boiled down to a very simple question: *would the average consumer, who has seen the trade mark TOMMY JEANS used in relation to clothing and who then encounters the trade mark TOMMY SPORTS used in relation to clothing, be likely to think that the goods in question came from the same undertaking or from related undertakings?* For the reasons that I will set out, I have no doubt but that the answer to that question is most certainly yes.

35. At the hearing, Mr. Coughlan laid emphasis (as, of course, he had to) on the conceptual differences between the words “jeans” and “sports” and suggested that the average person could not be assumed to be likely to mistake those two words or to overlook the difference of meaning that they create between the respective marks. While that cannot be denied, the fact is that the dominant and distinctive component in each of the marks TOMMY JEANS and TOMMY SPORTS is the word “Tommy” and it is that word that gives each its primary identity. The overall impression created by each mark is of the brand “TOMMY”, one used in relation to jeanswear and the other in relation to casual clothing or sportswear.

The average consumer will receive and understand subconsciously the message that each mark conveys, namely that the marked goods are, in the one case, “Tommy” brand jeans and, in the other, “Tommy” brand sports clothing. As the primary identifier within the Opponent’s mark, it is the word “Tommy” that will stick in the mind of the average consumer and exposure to the Applicant’s mark (in which that word is also the primary identifier) used on clothing cannot but trigger the assumption that the goods have the same commercial origin.

36. That might not be the case if the word “Tommy”, notwithstanding its significance in creating the overall identity of each mark, was somehow descriptive or otherwise commonplace in the context of the branding of clothing. In my view, it is not. While personal names, *per se*, may often be used as trade marks for clothing, frequently to identify the designer of the relevant garments, there is no evidence to the effect that the name “Tommy” is lacking in inherent distinctiveness as a clothing brand. I regard it as a perfectly distinctive word for use as a trade mark for clothing and I believe that a trade mark incorporating that word as its primary identifier, such as the Opponent’s TOMMY JEANS, is perfectly apt to function as a distinctive trade mark. Given its distinctiveness, the use of another trade mark in which the primary identifier is also the word “Tommy”, in this case, the Applicant’s TOMMY SPORTS, is all the more likely to lead to confusion among consumers as to the commercial origin of the marked goods.

37. Nor is it the case that the circumstances of the trade in clothing reduces to any extent the likelihood of confusion between these particular marks. It is not the practice of the average consumer to do more than rely on the brand name presented to him for the purpose of identifying the manufacturer of the various different garments available for purchase. While choosing a particular garment will normally involve some level of care and attention, including consideration of matters such as style, colour, fit, etc., the average consumer still relies on the brand name to assure him that the garment selected is of the quality of manufacture that he has come to expect of goods put on the market by the undertaking that he identifies with that brand. In a case such as this, involving the use of two very similar trade marks, the dominant and distinctive element of each

of which is the word “Tommy”, it is inevitable that consumers would expect that garments marked with the respective marks are all from the “Tommy” range of goods, which is identified by that brand. Even for those consumers who may recall the presence of the word “jeans” in the trade mark identifying the Opponent’s goods and who notice that the word “sports” appears in its place in the Applicant’s mark (and I think it unlikely that the average consumer would be struck by that difference), the conclusion most likely to be drawn by such persons is that TOMMY SPORTS garments constitute a new line or range from the maker of TOMMY JEANS clothing. Such a conclusion would amount to more than mere association of the two marks and would, in fact, constitute the type of confusion that Section 10(2) of the Act seeks to avoid. For these reasons, I find that the application is precluded from registration by virtue of Section 10(2) of the Act and must be refused.

Section 10(3) – will the Applicant’s use of the mark take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent’s mark?

38. Section 10(3) of the Act provides as follows:

“A trade mark which –

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.

39. The effect of that provision is to give to marks that have a reputation a wider scope of protection than would otherwise be the case, such that they may stand as an obstacle to the later registration of similar marks even in respect of dissimilar goods or services. To sustain an objection under this Section, an opponent must first establish, by evidence, that its earlier mark has the requisite reputation. That fact must be properly established by reference to concrete evidence and not simply

assumed to be the case because of volumes of sales achieved outside of the jurisdiction, whether one is looking at the State, in the case of an earlier national registration or at the Community, in the case of an earlier Community registration. In the present case, the Opponent has given evidence of the registration of its marks in many countries throughout the world and of very substantial worldwide sales of goods under its “TOMMY family of trade marks”. It has not, however, specified the proportions of sales achieved within the State or the Community prior to the relevant date (5 March, 1999) that are attributable to goods marked with the various different trade marks that it relies on for its opposition to the present application. In those circumstances, it is not possible for me to conclude, on the balance of probabilities, that any one of those earlier trade marks has, itself, established the requisite reputation within the State or the Community such as would ground an objection under Section 10(3) of the Act and I must, therefore, dismiss the opposition under that Section.

Section 10(4) – is the use of the mark by the Applicant liable to be prevented by virtue of any rule of law, in particular the law of passing off?

40. The relevant part of Section 10(4) of the Act, as far as the present opposition is concerned, reads as follows:

“A trade mark shall not be registered if, or to the extent that, its use in the State 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,”

41. In assessing the objection to registration under this Section, I have not placed any weight on the fact that, prior to the filing of the present application, the Opponent did, in fact, institute proceedings against Mr. McGarry for passing off based, *inter alia*, on the sale of clothing bearing the trade mark TOMMY SPORTS and that those proceedings have since been determined by the High Court. The decision of the Court based on the facts presented in evidence in that case is a separate matter entirely from the consideration of the present objection under Section 10(4) of the Act. In this regard, it must be recalled that the Controller has a separate

jurisdiction and is not (and cannot) be asked to determine whether, in fact, there has been passing off but whether, on the basis of the materials in evidence before him, the use of the mark propounded for registration might be found to constitute passing off. In deciding that question, it is necessary to consider (i) whether the Opponent had a goodwill or reputation in a mark associated with clothing as of the relevant date, (ii) whether the use by the Applicant of the mark propounded for registration would have constituted a misrepresentation that the clothing so marked was that of the Opponent and, (iii) if so, whether that would have led to damage to the Opponent.

42. As regards the first matter, the Opponent's evidence is quite vague and unspecific as to precisely which, or which combination, of its trade marks were in use in this jurisdiction prior to the relevant date and as to which of those trade marks were used in relation to clothing. Nevertheless, the Opponent has given evidence of having sold more than €2 million worth of clothing in the State prior to the relevant date and, whatever trade marks those goods were sold under, it is not in question that those marks all contained the word "Tommy". In those circumstances, I think it is right for me to accept that the Opponent had a protectable goodwill in a number of trade marks containing the word "Tommy" associated with clothing as of the relevant date.

43. Whether the sale of clothing by the Applicant under the trade mark TOMMY SPORTS would then have constituted a misrepresentation that the goods in question were those of the Opponent is less certain, in my opinion. Certainly, if the Opponent's reputation in relation to the sale of clothing was established under its TOMMY JEANS mark, then I would have no doubt but that the Applicant's use of the mark propounded for registration would amount to a misrepresentation as to the origin of the goods. If, on the other hand, the Opponent's goods were known for the TOMMY HILFIGER mark, then I would be inclined to think that the use of TOMMY SPORTS, as presented in the application for registration (i.e., without additional insignia or devices), could not be said to be a misrepresentation that the marked goods were those of the Opponent. Because I cannot ascribe the Opponent's undoubted reputation in relation to clothing to any particular trade mark, I am unable to say whether the use of the Applicant's mark on clothing

would or would not have constituted a misrepresentation as to the origin of the goods. For that reason, I cannot conclude that the use of the mark would have been liable to be prevented by the law of passing off and I must dismiss the opposition under Section 10(4) of the Act accordingly.

Tim Cleary
Acting for the Controller

25 May, 2006

APPENDIX I

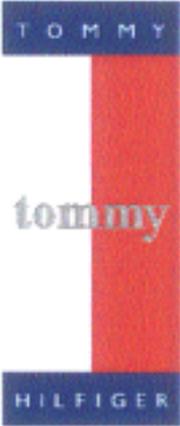
Trade Marks (registered and pending) referred to in Notice of Opposition

Number	Mark	Date of Filing	Class(es)
122464	TOMMY HILFIGER	24/03/1987	25
148793	TOMMY JEANS	20/08/1991	25
158581	TOMMY HILFIGER	03/11/1993	25
169836	TOMMY HILFIGER	02/08/1995	3
175636		10/01/1996	3
203170	TOMMY HILFIGER	30/08/1996	9
203456	TOMMY GIRL	30/08/1996	3
1999/03816 ¹³	TOMMY HILFIGER	01/11/1999	14, 18
131631 ¹⁴		01/04/1996	3, 18, 25
131706 ¹⁵	TOMMY HILFIGER	01/04/1996	3, 18, 25

¹³ since registered under No. 215141

¹⁴ Community Trade Mark

¹⁵ Community Trade Mark

Number	Mark	Date of Filing	Class(es)
131656 ¹⁶		01/04/1996	3, 18, 25
1051820 ¹⁷	TOMMY HILFIGER FREEDOM	22/01/1999	3

¹⁶ Community Trade Mark

¹⁷ Community Trade Mark