

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2165953  
BY AWEAR TO REGISTER A MARK  
IN CLASSES 16, 36, 41 AND 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No 49118  
BY A-WEAR LIMITED**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 2165953  
by awarear to register a mark in Classes 16, 36, 41 and 42**

**and**

**IN THE MATTER OF Opposition thereto under  
No 49118 by A-WEAR Limited**

**Background**

1. On 7 May 1998 awarear of Hucknall Nottinghamshire applied to register the following mark:

**awarear**

for goods and services in classes 9, 16, 36, 41 and 42. During the examination process Class 9 was dropped from the application and the mark was advertised for the following goods and services :

- |          |   |
|----------|---|
| Class 16 | printed publications.   |
| Class 36 | charitable fundraising, charitable collections.   |
| Class 41 | provision and development of training courses; all relating to fashion and clothing; arranging and conducting conferences; advisory services relating to all the aforesaid. |
| Class 42 | Inspection of buildings; accreditation services; all relating to the clothing and fashion industry  |

2. On 28 October 1998 A-Wear Limited of Dublin Ireland filed notice of opposition to this application. They state that they are the registered proprietors of the following marks registered in the UK:

No	Mark	Classes	Specification
1326354	A-WEAR	25	Articles of clothing, footwear and headgear.
1326355	A-WEAR & Device	25	Articles of clothing, footwear and headgear.
1509195	A-WEAR EQUIPT	25	Articles of clothing, footwear and headgear.

3. The opponents say that all three marks are currently in use in the UK and in the Statement of Grounds claimed that an objection was said to arise under Section 5(1)(b) of the Act. This was then clarified as Section 5(2)(b) by the opponents.
4. The applicants filed a counterstatement denying the above ground.
5. Both sides filed evidence and both were offered the opportunity to be heard. As neither party has requested to be heard, the decision can be taken from a careful study of the papers without the need for a hearing.
6. Acting on behalf of the Registrar I duly give the following decision.

### **Opponents' Evidence**

7. The opponents' evidence consists of a statutory declaration dated 14 May 1999 by Paul Kelly, who is the Managing Director of AWEAR Limited.
8. Mr Kelly states that his company sells a broad range of goods, in particular clothing, footwear, headgear, leather goods, bags, handbags, belts, jewellery and fashion accessories. The opponents' company is part of the Brown Thomas Group who are a retail department store with outlets in Ireland.
9. Mr Kelly advises that the opponents have used the mark AWEAR since the mid 1980s. They import products directly from the UK which have been branded with the AWEAR trade mark and exhibit A1 shows a breakdown of merchandise exported from the United Kingdom under the mark AWEAR for the last 10 years since 1991.
10. The full year figures quoted in Irish Punts are:

1991	1,850,007
1992	5,021,204
1993	4,380,526
1994	4,243,575
1995	4,240,206
1996	3,828,094
1997	3,505,799
1998	3,220,744

1999                      3,356,203  
(No sterling equivalent figures have been given)

11. Mr Kelly maintains that as a result of this use, the trade mark would be widely recognised within the industry and would enjoy an extensive reputation in respect of clothing and fashion goods and accessories in the UK.

12. Mr Kelly states that the marks have the same spelling and contain the same number of letters. Both marks are phonetically identical. Both marks are two syllable words with an identical prefix, the letter “A” and suffix “WEAR”. Therefore both marks would be pronounced identically.

13. Mr Kelly maintains that the services of “provision and development of training courses; all relating to fashion and clothing;” together with “accreditation services; all relating to the clothing and fashion industry”, clearly overlap with the goods of the opponents. As a result of the extensive use and reputation of the opponents’ mark within the clothing and fashion industries in the UK, it is claimed that there would be a likelihood of confusion.

14. Mr Kelly further claims that the applicants have only recently adopted the name “awear”, as previously the company name is referred to as “awear” with the reference “Nottinghamshire International Clothing Centre” forming part of the address. Further the applicants have been registered with the Charity Commission with the object of “...the provision of clothing....”.

#### **Applicants’ evidence**

15. The applicants have filed a statutory declaration dated 11 August 1999 by Sid Jurka. Mr Jurka is the Chief Executive of the applicants.

16. Mr Jurka claims that A-WEAR and not AWEAR is the trade mark used by the opponents, and that two of the earlier marks are not in the name of the opponents.

17. Mr Jurka contends that the marks are not phonetically identical. A-WEAR sounds like “Ay-ware” whereas “awear” sounds like “uh-ware” and that “awear” is a play on the word “aware”. He also contends that the services for which the applicants’ mark has been applied for do not overlap with the opponents’ goods in Class 25.

18. Mr Jurka also explains that the applicants have used the name “awear” since April 1996. He also points out that the applicants’ objectives are actually “.. Facilitating the provision of clothing..” which is quite different to what was stated by the opponents.

#### **Opponents’ evidence in reply**

19. The opponents have filed two statutory declarations from Paul Kelly dated 5 November 1999 and 28 November 2000, together with a further two declarations from Imelda Clifford dated 10

January 2000 and Adam Lee dated 8 January 2000.

20. Mr Kelly maintains that all of the merchandise referred to in his earlier declaration is branded with the A-WEAR mark and he includes some examples of such garments. He offers further observations on the issue of the comparison of the respective marks.

21. Mr Kelly reiterates the use and reputation of their mark and maintains that use of a virtually identical mark in the same industry would clearly lead to confusion and deception.

22. Imelda Clifford and Adam Lee both work for companies which manufacture clothing for the opponents. They confirm that their respective companies attach the mark to the goods prior to export (in each case the mark is shown to be a\*wear). They also maintain that there would be confusion between the two marks in the course of trade.

23. In Mr Kelly's further declaration he encloses a brochure from the applicants, which he claims shows the type face is almost identical, to that used by his company and it shows that the applicant is engaged in selling clothing branded with the "awear" mark.

24. That completes my review of the evidence. I now turn to the ground of opposition, which has been confirmed as arising under Section 5(2)(b). This reads :

(2) A trade mark shall not be registered if because –

(a) .....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

25. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

26. Taking the marks themselves first of all I am required to consider the visual, aural and conceptual similarities of the marks (*Sabel BV v Puma AG* paragraph 23). Part of that process must also involve consideration of the relative importance of each of these considerations in a trading context. It is generally acknowledged that visual considerations play an important and probably dominant part in the sale of clothing but not to the exclusion of, for instance, aural considerations where goods are being ordered over the telephone or are the subject of oral

recommendation. I am less clear (because the applicants have said little about the nature of their business) how customers will normally encounter their mark and, therefore, what the relative importance of visual, aural and conceptual considerations is likely to be in relation to their goods and services. I note that Mr Kelly says in paragraph 8 of his first declaration that "My Company's UK Trade Mark Attorney, Hulse & Co., have tried to contact the Applicants by phone on a number of occasions and each time have received a recorded message commencing with "This is aware"."

27. If initial contact with the applicants was mainly the result of telephone enquiries then customers' approach to the applicants' mark is likely to be conditioned by the above pronunciation. But I do not know if this is the case. Other parts of the opponents' evidence, the applicants' brochure at PK1 picked up at a trade fair for instance, suggest that initial contact with the applicants' mark may also be a visual one. I find the evidence to be inconclusive as to the relative importance of visual, aural and conceptual considerations in approaching the applicants' mark.

28. For comparison purposes I propose to base my consideration on the opponents' registration number 1326354 for the mark A-WEAR which must offer them a better prospect of success than the device mark of 1326355 or the mark A-WEAR EQUIPT, No 1509195. The applicants' mark consists of the same combination of letters in lower case (with a negligible degree of stylisation) and without the hyphen between the initial letter and WEAR.

29. There is in my view a close visual similarity between the respective marks. Further analysis would be largely otiose.

30. Aurally the position is more complicated as there is a suggestion that the applicants' mark is pronounced as if it were the word 'aware'. It appears from the limited evidence on the matter that the applicants offer or intend to offer various clothing related services for the benefit particularly of disabled people and that in this respect they will be a link between retailers and manufacturers (see exhibit PKI). I infer that the concept behind their business is awareness of the needs of the disabled and that the mark is intended to be allusive in this respect. The opponents' own evidence of attempts by their agents to contact the applicants by phone supports the claim that they refer to themselves/their mark as if it were the word 'aware'. If that is the case it suggests a point of oral/aural differentiation between the parties' marks which would carry through in part to consideration of their conceptual characteristics. But I emphasise that I have limited information before me on which to base firm conclusions and no guidance as to how customers for the applicants' goods/services refer to the mark.

31. It is rather easier to reach a view on how the opponents' mark is likely to be seen and pronounced. The initial letter is separated from the element WEAR by a hyphen. (I will come to use of their mark below but suffice to say at this point that the form in which it is actually used

further emphasises the separate elements of the mark). I have little doubt that the presentation lends itself to the mark being seen and referred to as the single letter A (long 'a' sound) coupled with the word WEAR.

32. In summary I find that there are strong visual similarities between the marks and possible aural similarities depending on what view one takes of how the applicants' mark is pronounced in use. In the absence of clear evidence on the latter point I must of course bear in mind notional use. Overall I conclude that the marks are similar.

33. It was held in the CANON case referred to above that:

"22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.

23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

24. In the light of the foregoing, the answer to be given to the first part of the question must be that, on a proper construction of Article 4(1)(b) of the Directive, the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion."

34. The opponents' evidence is, I assume, intended to establish that the distinctive character of their mark and in particular its reputation has been enhanced through use and that I should take account of that factor in reaching my decision bearing in mind that there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character either per se or because of the use that has been made of it (*Sabel v Puma* paragraph 24 and *Canon* above).

35. This is a somewhat unusual case in that the opponents are part of department store group in the Republic of Ireland and do not lay claim to any sale of goods or customers in the UK. They do, however, have goods manufactured in this country and exported to the Republic for sale there. The trade declarants, Ms Clifford and Mr Lee, have confirmed that the mark (it is used in the form a\*wear) is placed on the goods in the UK prior to export. I do not know whether that is true for all the UK suppliers but I am prepared to accept that these two declarants are typical.

36. The most significant piece of evidence in support of the opponents' claim, apart from the examples of clothing bearing the mark, is exhibit A1 to Mr Kelly's first declaration. This consists

of a print out of manufacturers/suppliers and the value of purchases from them over a 10 year period commencing in 1991. I have not counted the number of companies listed but there are 8 pages of printout and a not inconsiderable number of suppliers representing in excess of 30 million Irish pounds worth of business. Further interpretation of this particular piece of evidence is not without difficulty. The opponents say they sell a broad range of goods under the mark many of which are not or may not be clothing items (e.g. leather goods, bags, handbags, jewellery, fashion accessories). Whilst it is clear from some of the company names in the listing in exhibit A1 that they are likely to be suppliers of clothing, others give no clue as to the goods supplied and a further group are unlikely to be clothing suppliers (with names referring to Bags, Leathercraft, Cosmetics etc.).

37. However a more fundamental issue arises in respect of this evidence. Even if I accept that the opponents have some trade in this country in relation to clothing it is only through orders/purchases placed with UK suppliers/manufacturers. Goods under the mark a\*wear are not offered for sale to customers in this country. The question, therefore, arises as to whether dealings with or a reputation with such manufacturers and suppliers can be taken into account for the purposes of assessing the distinctive character/reputation of the mark at issue?

38. It is clear from the tenth recital to the First Council Directive 89/104 on which the Trade Marks Act 1994 is based that the function of a registered trade mark is "in particular to guarantee the trade mark as an indication of origin....". The specific issue of the reputation attaching to a mark has been considered in *General Motors Corporation v Yplon* reported at 1999 ETMR 122 (the Advocate General's Opinion) and 1999 ETMR 950 (the ECJ's decision). Although that case was concerned with Article 5(2) of the Directive (Section 5(3) of the 1994 Act) I see no reason why a fundamentally different approach to reputation should apply for Section 5(2) purposes. The guidance from the ECJ was as follows:

"24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it."



39. The guidance does not unduly limit the categories of people who can constitute the relevant public for the purposes of determining whether a reputation has been established though it is implicit, I think, from the criteria in paragraph 27 above that the matter is being looked at from a customer/consumer standpoint. The point is, of course, that not all traders sell to the general public and some, whose goods are intended ultimately for the general public, will sell to specialist distributors or intermediaries of various kinds. The guidance from the ECJ recognises this in the reference to the example of 'traders in a specific sector'. A similar issue arose in *Premier Luggage & Bags Ltd v Premier Co (UK) Ltd* 2000 IP & T 1229 where Mr Etherton QC sitting as a Deputy Judge considered the class comprising 'retailers, wholesalers and ultimate consumers' in relation to the distinctiveness of the claimant's mark (paragraphs 44 to 49 of the judgment refer).

40. References elsewhere in the ECJ cases are consistent with the approach that regard should be had to the average consumer in considering issue of distinctiveness and reputation (see paragraph 23 of *Sabel v Puma* and paragraph 27 of *Lloyd Schuhfabrik v Klijsen*). I conclude that reputation must be assessed by reference to the impression a mark has made on the public (whether at large or trade customers) but that the common denominator in each case is that the class of persons concerned must be purchasers or consumers of the goods or services for whom the mark serves as a guarantee of origin. I find nothing in the guidance from the ECJ to support the view that I should take into account whatever reputation a party may have with its manufacturers/suppliers where not supported by sales of goods in this country. I, therefore, approach this matter on the basis that the opponents have no customers in this country and that their sourcing of goods from UK suppliers for sale in Ireland does not result in any enhanced degree of distinctive character for their mark when it comes to assessing the likelihood of confusion.

41. The opponents do not have a registration covering the same Classes of goods and services as the application in suit. I must, therefore, consider whether the opponents' goods in Class 25 are similar to the applicants' goods and services in Classes 16, 36, 41 and 42. In doing so I have regard to the decision by Jacob J. in *British Sugar Plc v James Robertson & Sons* ["TREAT" 1996 RPC 281]. In that case the court stated:

"The following factors must be relevant in considering whether there is or is not similarity:

- a) The respective uses of the respective goods or services;
- b) The respective users of the respective goods or services;
- c) The physical nature of the goods or acts of service;
- d) The respective trade channels through which the goods or services reach the market;
- e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in the trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors".

42. Whilst I acknowledge that in view of the CANON case the TREAT case may no longer be wholly relied upon, the ECJ said that the factors identified by the UK government in its submissions (which are the factors listed in TREAT) are still relevant in determining the degree of similarity of the goods for the purposes of applying the composite test set out in paragraphs 23 and 24 of the ECJ's decision in Sabel v Puma.

43. Mr Kelly puts the opponents' position as follows:

"The services "provision and development of training courses; all relating to fashion and clothing;" together with "accreditation services; all relating to the clothing and fashion industry" for which the Applicants Trade Mark has been applied for, would clearly overlap with the goods of interest of my Company. The services provided by the Applicants are for use in the clothing and fashion industries and would be used in respect of the goods of interest of my Company. In view of the extensive use and reputation my Company enjoys in the Trade Mark "AWEAR" / "a\*wear" within the clothing and fashion industries in the United Kingdom, use by the Applicants of the identical or close similar Mark on the above services would lead to a likelihood of confusion on the part of public, which includes the likelihood of association of the later Trade Mark with my Company's earlier Trade Mark and further such use would take unfair advantage of or be detrimental to, the distinctive character or reputation of my Company's Trade Mark."

44. I cannot see that the opponents explain or comment in detail on the applicants' goods in Class 16, services in Class 36 and services in Classes 41 and 42 other than those referred to in the above passage. For my part I can see no objection in respect of these goods and services. I will concentrate my considerations on the balance of the Classes 41 and 42 services which appear to be the only (or certainly main) cause of concern to the opponents that is to say

"Provision and development of training courses; all relating to fashion and clothing"

and

"accreditation services; all relating to the clothing and fashion industry."

45. Taking the TREAT criteria in turn I find that the uses of the respective goods and services (a) are quite different. Training and accreditation services even if directed at the fashion and clothing industry must be wholly different to clothing itself.

46. The users (b) may at a high level of generality be the same but for practical purposes this is unlikely to be the case. I surmise that the users of training and accreditation services would be manufacturers and or retailers along with designers and possibly individuals wishing to enter the fashion/clothing field. It could, be the case that the opponents' UK suppliers might wish to avail themselves of the services in question. But for the reasons given above I doubt the relevance of such a potential occurrence as that would not be customer confusion in relation to the respective goods and services.

47. The physical nature of the opponent's goods (c) must be inherently different to the applicants' services and the trade channels (d) are hardly likely to meet. Criteria (e) is unlikely to be relevant. Even though clothing can be a self-serve consumer item the applicants' services would not be.

48. Finally the respective goods and services are not in competition with one another (f) in the sense that they represent alternative purchases. The CANON extract above nevertheless recognises that some goods/services though not in competition with one another can be closely complementary (cars and car servicing for instance or jewellery and jewellery repair) and confusion could arise if closely similar marks were used by different proprietors. Would there be any expectation that clothing companies would offer the sort of services in question here or vice versa? There is nothing before me to indicate how the trade operates. Any such connection is certainly not an obvious one and would require evidence to support any such claim.

49. As the CANON case indicates "even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered." I have come to the view that the opponents' goods and the applicants' goods and services are not similar and there is nothing in the opponents' evidence which leads me to a contrary view.

50. I therefore, conclude that there is no likelihood of confusion and the opposition fails on the only ground on which it was brought.

51. In reaching this decision I have not needed to address a point of dispute that has arisen as to whether the applicants actually supply clothing or, as Mr Jurka puts it, facilitate the provision of clothing meaning to encourage others to provide clothing to disabled people. The opponents point to exhibit PK1 as evidence that the applicants are selling clothing branded aware. I do not find that piece of evidence conclusive one way or the other. The brochure concerned describes the nature and purpose of the software that has been developed to create a clothing pattern using the measurements of an individual customer. Elsewhere the brochure refers to the "need to collaborate with a large retail organisation and a manufacturer to do a cost benefit analysis for the made to measure supply chain and to develop the software further". The brochure is not inconsistent with the applicants' role as the spider in the web providing training and accreditation services for scheme participants based around the provision of the core software. Nevertheless it has to be conceded that the brochure shows references to eg "aware accredited tailoring". My decision, however, relates only to the surviving goods and services of the application. If the

applicants use their mark in relation to clothing and tailoring or other services then they risk bringing themselves into conflict with the opponents. As matters stand I do not need to take a view on any such possibility.

52. The applicants have been successful and are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 30<sup>th</sup> day of July 2001**

**M REYNOLDS**  
**For the Registrar**  
**the Comptroller-General**