THE PATENT OFFICE

Harmsworth House
13 - 15 Bouverie Street
London, EC4Y 8DP.

Tuesday, 16th April 2002.

Before:

MR. SIMON THORLEY, Q.C.
(Sitting as the Appointed Person)

In the Matter of The Trade Marks Act 1994

and

In the Matter of Trade Mark Application No. 2198259
in the name of BUBBLES

and

In the Matter of an Opposition thereto by
TOMMY HILFIGER LICENSING INC. and
B.M. FASHIONS (LEICESTER) LIMITED

Appeal of the Appellant from the Decision of Mr. G. Salthouse

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(Computer-aided Transcript of the Stenograph Notes of
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THE APPELLANT/APPLICANT did not appear and was not represented.

MR. STEPHEN JONES, MR. JOSHI and MR. FLINTOFF (of Messrs. Baker & McKenzie) appeared on behalf of the Respondent/Opponent.

D E C I S I O N
(As Approved)

THE APPOINTED PERSON: This is an appeal to the Appointed Person from a decision of Mr. Salthouse acting on behalf of the Registrar dated 22nd November 2001.

The decision arose in opposition proceedings brought by TOMMY HILFIGER Licensing Inc. and B.M. Fashions (Leicester) Limited against the registration of Application No. 2198259 in class 25 by an entity known as "Bubbles".

The trade mark in question was applied for on 22nd May 1999 and consists of the word "TOMMY" in black capital letters against a white background in the middle of which there is a rectangular white box which contains, in smaller capital letters, the word "CASUAL".

The application was opposed on the basis of earlier trade mark rights within the meaning of section 6 of the Trade Marks Act 1994, both by TOMMY HILFIGER (relying on a number of trade marks registered or applied for in class 25 consisting or comprising the word "TOMMY" including, particularly, TOMMY JEANS, No. 1473971 claiming a priority from 20th August 1991) and by B.M. Fashions (relying on an application for the registration, again in class 25, of the mark TOMMY SPORT, No. 2119386, claiming priority from 3rd January 1997).

As matters turned out, by the date of the hearing B.M. Fashions had assigned their trade mark application to TOMMY HILFIGER and thus the opposition proceeded as a single

opposition with TOMMY HILFIGER as the sole opponent.

The matter came for a hearing before Mr. Salthouse on 30th August 2001. The opponent was represented by Mr. Jones of Baker & McKenzie. The applicant was not represented but submitted written observations. A number of grounds of opposition were relied upon but, in the event, Mr. Salthouse found it necessary only to consider the ground of objection based under section 5(2)(b) of the Act which states:

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

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

Mr. Salthouse concluded that, of all the marks before him, the best case from the point of view of the opponents was represented by the two registrations I have referred to, 2119386 and 1473971. As at the date of application, neither of these marks was in fact registered but, none the less, by virtue of section 6, which defines the meaning of "earlier trade mark", Mr. Salthouse -- correctly, in my view -- held that both these marks were "earlier trade marks" since they had earlier dates of application than the earliest priority

date of the mark applied for, which was 22nd May 1999, and were, by the date of adjudication, registered trade marks.

Mr. Salthouse directed himself as to the correct approach in law in paragraph 27 of his decision. I do not propose, in this judgment, to set it out in full, but he reminded himself of the guidance given by the European Court of Justice in the now well-known cases of Sabel BV v. Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v. Metro- Goldwyn-Meyer Inc. [1999] E.T.M.R. 1; Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV [2000] FSR 77 and Marca Mode CV v. Adidas AG [2000] E.T.M.R. 723.

He then went on to consider the facts of this case and considered, first, the mark applied for and concluded that the mark could be seen as either TOMMY CASUAL or CASUAL TOMMY but concluded that the TOMMY element was dominant. He then considered the two marks TOMMY SPORT and TOMMY JEANS and compared those with the mark opposed visually, phonetically and conceptually. In the end, he concluded that the trade marks were clearly similar; the marks of both parties have the name TOMMY as the dominant element; the other elements of the mark differ but they are all descriptive of the goods. He therefore came to the conclusion, considering all factors, that there was a realistic likelihood of confusion as at 22nd May 1999 and consequently held that the opposition under section 5(2)(b) succeeded.

Bubbles served notice of appeal which was received by the Registry on 24th December 2001. Since filing the grounds of appeal they have taken no further part in the proceedings and did not appear before me today. As indicated at the outset of the proceedings, I was satisfied that they had been informed of the date of the hearing by the Treasury Solicitor and therefore directed that the hearing should continue. I had received, in advance, a skeleton argument from Mr. Jones of Baker & McKenzie, who appeared before me, and he amplified in limited respects upon that skeleton at the oral hearing.

I should, at this stage, make it plain that there is no obligation on any appellant or indeed respondent to an appeal to appear on the oral hearing. It is quite sufficient that they should rely upon written documents; whether those be grounds of appeal or skeleton arguments.

However, parties who put in grounds of appeal and seek a hearing and do not withdraw the appeal prior to the hearing must face the consequence that, if the written material is insufficient to result in the appeal being allowed, the other party will be put to the cost and expense of turning up at a hearing. It cannot, therefore, be expected that, by not turning up, the party can escape any consequence with regard to costs. It is important, if a party wishes to withdraw an appeal, that they should do so at the earliest possible time.

It is for this reason that the appeal had to be heard.

Mr. Jones drew my attention to the decision of Pumfrey J. in South Cone Incorporated v. Jack Bessant & Ors. trading as "REEF" given on 25th July last year in which he considered, in the light of the change in practice with regard to appeals, the correct approach of an appellate tribunal to a decision of the Registry in inter partes proceedings. He concluded that the appeal should be by way of review, not rehearing, and that the procedure before the Court of Appeal, as set out in cases such as Designers Guild Ltd. v. Russell Williams (Textiles) Ltd. [2001] FSR 113, was equally applicable to appeals to the High Court from the Registry.

In my decision in the Royal Enfield case, which was given on 27th July 2001, I held that exactly the same applied to appeals to the Appointed Person. It is therefore necessary for any appellant to demonstrate, on an appeal, that the Registrar's Hearing Officer has fallen into an error of principle or was, in some other respect, plainly wrong.

Mr. Jones urged before me that the decision of Mr. Salthouse was thorough and careful, both in his review of the evidence and in his approach to the law and the application of the facts to the law.

In their grounds of appeal, Bubbles raised the following points. First, in paragraph 3, it is contended that the TOMMY SPORT and TOMMY JEANS mark were unregistered

marks at the time the application was made for the mark in issue in these proceedings. That is correct, but, as of the date of hearing, the marks were registered trade marks which had earlier priority and thus fell to be considered to be earlier trade marks within the meaning of section 6. The Hearing Officer fell into no error in this regard.

In paragraph 4 it was submitted that TOMMY was a common name and therefore should not be registered or be the property of any one person. That, I feel, whilst no doubt a genuinely held belief, is not relevant to the present case. There is no bar to the registration of forenames provided they fall within the category of distinctive marks within the meaning of section 3 of the Act. In any event, Bubbles' objection does not justify the registration of its mark. The most it might have done was to form the basis of an attack on the validity of earlier registrations.

In paragraph 5, there is a criticism of TOMMY HILFIGER's research data which were relied upon as part of the evidence. I do not see that the Hearing Officer placed any weight upon this evidence and it certainly cannot be said that his failure to do so was an error of principle.

In paragraphs 6 and 7, there is a suggestion that TOMMY HILFIGER acquired the TOMMY SPORT trade mark by some form of financial inducement. That, again, is wholly irrelevant to any question I have to decide.

In paragraph 8, it is stated that Bubbles intends to distance their clothing from any TOMMY HILFIGER clothing. Again, that is not a matter relevant to the present appeal. There is nothing to stop Bubbles using the trade mark TOMMY CASUAL subject, of course, to the laws of infringement of a registered trade mark and passing off.

Mr. Jones urged upon me that none of these objections constituted the sort of error of principle which would cause me to review the reasoning of Mr. Salthouse. I agree with Mr. Jones that Mr. Salthouse's decision was an exemplary and carefully reasoned decision. Not only do I think there is no error of principle, I entirely agree with it and, thus, this appeal will fall to be dismissed.

MR. JONES: Thank you, sir. You have already referred to costs and I think we would be entitled to an order on this appeal as well as the award that has already been made.

THE APPOINTED PERSON: You have already had £1870. That, as I understand it, was in relation to a number of grounds of, appeal and, I suspect, a hearing rather longer than this one. How long did the previous hearing last, do you think?

MR. JONES: Probably not much longer than this one, bearing in mind that you have given a decision, sir, which Mr. Salthouse reserved for some time. It was probably about 40 minutes or so.

THE APPOINTED PERSON: Perhaps not surprisingly, in the light of

the comments made in my decision, Mr. Jones has sought a contribution to the costs of the respondent in opposing this appeal and in attending at the hearing before me. This is perfectly proper. I can see no grounds for refusing that application.

I am conscious of the fact that the decision of Bubbles not to be represented has probably significantly shortened this hearing and it is plain, from Mr. Jones' skeleton, that the points he had to make were limited.

In all the circumstances, I believe it would be appropriate to order the appellant to pay the respondents a further sum of £1000 as a contribution towards the costs of the appeal. This sum should be paid within 14 days of the date of the order, since I have already indicated that I shall not sign that order for a period of time after it is supplied to Bubbles so that Bubbles may make any observations upon it they see fit. Of course, if any observations are made I shall direct that the Treasury Solicitor should serve a copy on Baker & McKenzie.

Is there anything else?

MR. JONES: I think that is it. Thank you, sir.

THE APPOINTED PERSON: Thank you very much indeed.

POSTSCRIPT

Subsequent to delivering this Decision, I was sent a copy of a letter dated 15th April 2002 from Mr. J.M. Chaudhary, a partner in Bubbles. This was faxed to the Treasury Solicitor early on 16th April 2002 -- the day of the hearing -- but, understandably, was not brought to my attention before the hearing.

It records that, due to unforeseen circumstances, Mr. Chaudhary was unable to attend the hearing, and asks that certain further considerations be taken into account. Obviously, I did not do so in reaching my Decision.

As previously indicated, Bubbles have 14 days to consider whether they wish to make an application for a further hearing before the Order is perfected. If they feel that there are further matters which should be considered, I would be minded to hear the application for a further hearing and any subsequent hearing at the same time. A separate costs order would be appropriate in respect of any such hearing.