

O-039-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NOS 2380724B AND 2380724A  
IN THE NAME OF AGATHA DIFFUSION  
IN CLASSES 3, 14, 18 AND 25**

**AND**

**THE CONSOLIDATED APPLICATIONS  
FOR DECLARATIONS  
OF INVALIDITY THERETO  
UNDER NOS 83064 AND 83065  
BY  
MONSOON ACCESSORIZE LIMITED**

## Trade Marks Act 1994

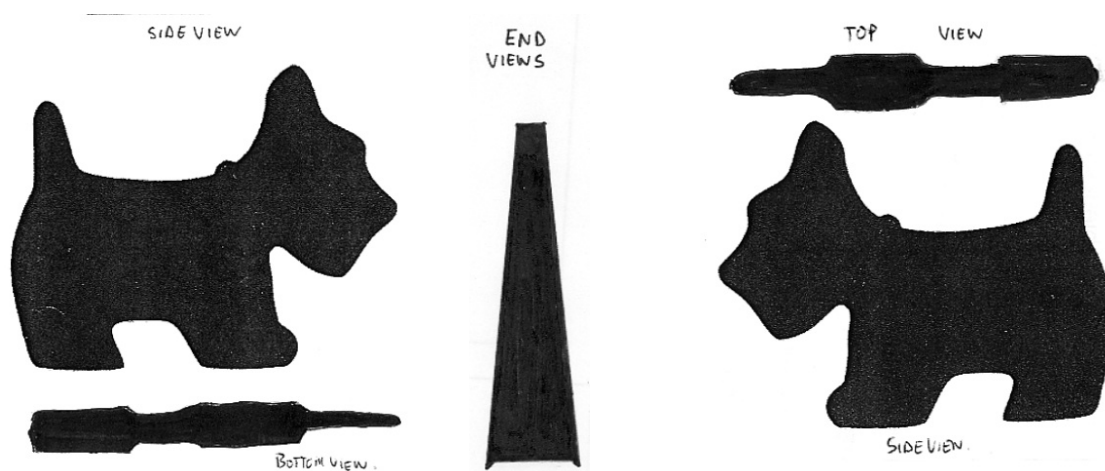
**In the matter of registration nos 2380724B and A  
in the name of Agatha Diffusion  
in classes 3, 14, 18 and 25  
and the consolidated applications for declarations of invalidity  
thereto under nos 83064 and 83065 respectively  
by Monsoon Accessorize Limited**

### Background and evidence

1) On 30 November 2004 Agatha Diffusion (Agatha) filed an application for the registration of a series of four trade marks. Consequent upon an objection in relation to the series by the Trade Marks Registry (TMR), the application was divided into two. Registration no 2380724A is for a series of three **two dimensional** trade marks:



Registration no 2380724B is for a shape mark:



Owing to an error by the TMR, 2380724A was published as being a shape trade mark. The registration procedure was completed on 2 June 2006. The

registrations still stand in the name of Agatha. They are both registered for the following goods:

*perfumery, essential oils, cosmetics, hair lotions; dentifrices;*

*precious metals and their alloys and goods in precious metals or coated therewith; jewellery, not including charm bracelets and charm necklaces, precious stones; horological and chronometric instruments;*

*leather and imitations of leather, and goods made of these materials; hides; trunks and travelling bags; umbrellas and parasols; handbags, make-up bags, wallets, backpacks not including novelty backpacks, garment bags, briefcases, attaché cases, card cases, haversacks not including novelty haversacks, key cases, purses, school bags, travelling trunks and vanity cases;*

*clothing, footwear and headgear.*

The above goods are in classes 3, 14, 18 and 25 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) Monsoon Accessorize Limited (Monsoon) has filed applications to have the registrations declared invalid under sections 3(1)(b), (c) and (d) and 3(2)(c) of the Trade Marks Act 1994 (the Act). Applications for the invalidation of a trade mark registration are governed by section 47 of the Act.

3) Section 47(1)<sup>1</sup> of the Act allows an application for invalidation to be based upon sections 3(1)(b), (c) and (d) and 3(2)(c) of the Act. Section 3(1) of the Act reads:

“3.-(1) The following shall not be registered -

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,

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<sup>1</sup> “47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

Section 3(2)(c) of the Act reads:

“(2) A sign shall not be registered as a trade mark if it consists exclusively of-

.....

(c) the shape which gives substantial value to the goods.”

4) Monsoon states that Agatha is the proprietor of United Kingdom trade mark registration no 1557995 for the trade mark:



The trade mark is registered for a variety of goods in classes 3, 14, 18 and 25. The specifications of the registration have the following limitations:

- ❖ Class 3 – “but not including soap in the form of dogs”.
- ❖ Class 14 – “but not including any such goods in the form of, or bearing representations of dogs”.
- ❖ Class 18 – “but not including clothing for animals and not including bags in the form of dogs”.
- ❖ Class 25 – “but not including any such goods in the form of, or being decorated with dogs”.

Monsoon claims that in order to obtain the above registration Agatha limited its specifications, enabling third parties to continue with the widespread and

legitimate use of goods in the shape of a dog or goods decorated with the shape of a dog.

5) Monsoon claims that the trade marks are devoid of any distinctive character as they consist of the silhouette of a Scottish terrier which is commonly used for goods produced in the shape of a Scottish terrier, or for goods that are decorated with the shape of a Scottish terrier. Consequently, the registrations should be declared invalid as per section 3(1)(b) of the Act.

6) Monsoon claims that the trade marks consist exclusively of signs or indications which may serve in trade to designate the characteristics of the goods, in that goods are commonly produced in the shape of a Scottish terrier, or goods are produced that are decorated with the shape of a Scottish terrier. Consequently, the registrations should be declared invalid as per section 3(1)(c) of the Act.

7) Monsoon claims that the trade marks consist exclusively of signs or indications which have become customary in the current language of in the bona fide and established practices of the trade. Consequently, the registrations should be declared invalid as per section 3(1)(d) of the Act.

8) Monsoon claims that the shapes give substantial value to the goods as the shape of a Scottish terrier is attractive to the public.

9) Monsoon claims that the public of the United Kingdom has not been educated to see the trade marks as being indicators of origin.

10) Agatha filed counterstatements in which it denied the grounds of invalidation.

11) Both parties filed evidence.

12) A hearing was held on 21 January 2009. Agatha was represented by Mr Nigel Hackney of Mewburn Ellis LLP. Monsoon was represented by Mr Steven Jennings of Lewis Silkin LLP.

## **Evidence**

### *Evidence of Monsoon*

13) This consists of a witness statement made by Ms Rosalynde Harrison. Ms Harrison is the company secretary for Monsoon.

14) Ms Harrison explains that Monsoon is a well-known retailer which commenced trading in 1973. It has operations in over fifty countries. Monsoon operates under two brands: Monsoon and Accessorize; there are over 400 of these shops in the United Kingdom and over 800 worldwide. Monsoon sells a wide range of goods, including those covered by Agatha's trade marks.

15) Ms Harrison believes that products have been made in the shape of, or decorated with, a Scottish terrier since the 1950s. She states that this dog has a particular mass appeal that she believes is unrivalled by any other pet. Ms Harrison states that this appeal arises from the following:

- ❖ The dogs are generally very good natured, make affectionate pets and are known for their loyalty.
- ❖ “They have an easy to define characteristic shape.”
- ❖ “They are frequently used particularly as a shape appealing to children.”

16) Ms Harrison refers to trade mark registration no 1557995 (see above). She states that it is impossible to reproduce a Scottish terrier which would not look similar to Agatha’s trade marks, which are in the form of the basic silhouette of a Scottish terrier.

17) Exhibited at RH2 are examples of uses of Scottish terrier designs found on Internet searches conducted on 16 and 17 January 2008. Very little detail is given in relation to the uses. The uses shown are as follows:

- ❖ Radley – “use Scottie dog shape on everything they sell”. A picture of a bag is shown, attached to the handle of the bag is a representation of a dog.
- ❖ “Scottie dog Boot scraper, early 20<sup>th</sup> C” – this emanates from oldgardentools.co.uk.
- ❖ “Scottie dog slippers” – this emanates from littleangelsscotland.co.uk.
- ❖ “Scottie dog charm Debenhams”.
- ❖ “Scottie Dog Jeans Jems” – this emanates from fungiftsforgirls.co.uk.
- ❖ “Scottie Dog Cushion” – this emanates from objects-of –design.com.
- ❖ “Scottie dog earrings” – this emanates from scotlandshopdirect.com.
- ❖ “Scottie dog pyjamas” – this emanates from crazibonkas.co.uk.
- ❖ “Vintage Scottie dog braces” – this emanates from riceandbeansvintage.com.
- ❖ “Personalised Scottie dog labels” – this emanates from wdrake.com. The label that can be seen has a Colorado address.
- ❖ “Scottie Dog Chocolate Mould” – this emanates from cakescookiesandcraftsshop.co.uk.
- ❖ “Juicy Couture – Scottie dogs a part of their trade mark and so appear on various items – clothing/bags etc”. The label displayed states that the product is made in the USA.
- ❖ “Scottie Dog Pendant” - this emanates from kiltmakers.co.uk.
- ❖ “Scottie Dog bag by Smith and Canova” - this emanates from prooz.com.
- ❖ “Scottie Dog Tea set” - this emanates from allteapots.com.
- ❖ “Scottie Dog Hoodie” - this emanates from mybonnieandclyde.com.
- ❖ “Scottie Dog Fabric – in various designs” - this emanates from scottiegifts.com.
- ❖ “Topshop – Scottie dog skirt”.

- ❖ “Scottie Dog scarf”.
- ❖ “Scotty Dog nightshirt – Simply Be”.
- ❖ “Scotty Dog T-Shirt”.
- ❖ “Scotty Dog Silk Tie – Liberty”.
- ❖ “Scotty Dog Soap” – amara.co.uk.

18) Exhibited at RH3 are pictures of items that Monsoon has sold in the United Kingdom in the shape of or decorated with Scottish terriers. The following goods can be seen: five types of socks, women’s briefs, umbrella, “bag charm”, four types of key ring, hair grip and purses. Various handwritten annotations appear with the pictures. The socks bear the annotations AW05, AW04, AW05, AW06, AW07 – this could refer to autumn/winter and the year. The women’s briefs bear the annotation Feb SS07, which could refer to spring/summer 2007. The umbrella bears the annotation 17/10/05. The “bag charm” bears the annotation AW05. The key rings bear the annotations AW03, SS07 and AW06. The hair grip bears the annotation AW07. The purses bear the annotations SS03, SS04 and AW07.

19) Ms Harrison states that she has visited the website agatha.fr and that Agatha makes no reference on the site to the shape mark. She states that it appears to her that Agatha is the only trade mark used on the site.

#### *Evidence of Agatha*

20) This consists of a witness statement by Mr Alastair John Rawlence. Mr Rawlence is a trade mark attorney who is acting for Agatha.

21) Mr Rawlence refers to an ex parte hearing that took place at the examination stage of the application for registration (before the division of the application). A copy of the hearing notes is exhibited at AJR1. Mr Rawlence states that it is clear that the hearing officer correctly applied TMR practice in relation to the application; in order to overcome a distinctiveness objection soap was deleted from the class 3 specification, charm bracelets and necklaces were excluded from the class 14 specification, novelty backpacks and novelty haversacks were excluded from the class 18 specification, the class 25 objection was waived in its entirety. Much of the rest of the witness statement is submission rather than evidence of fact; I will say no more about it here.

22) Mr Rawlence states that two of the examples provided as evidence by Ms Harrison are the subjects of Community trade mark registrations. Exhibited at AJR5 are the details of two Juicy Couture registrations, both of which contain representations of Scottish terriers. Mr Rawlence also refers to exhibiting details of a Radley registration but this has not been included.

23) Mr Rawlence exhibits at AJR6 examples of United Kingdom trade mark registrations for trade marks consisting of animal shapes in classes 3, 14, 18 and

25. International registration no 636220 is for a Scottish terrier dog, it is registered for a variety of goods in classes 14, 18, 24 and 25; see below:



24) Mr Rawlence exhibits at AJR7 copies of extracts from the database of Cabinet Weinstein showing countries where Agatha's "Scotty Dog" trade marks are registered. Mr Rawlence states that these registrations themselves are of no real value as precedents in this case but that they do indicate the investment in the protection of its brand to which Agatha is committed. All of the printouts refer to "Logo (chien)". Neither the representations nor the actual specifications are reproduced.

*Evidence in reply of Monsoon*

25) This consists of a witness statement by Mr Steven John Jennings. Mr Jennings is a trade mark attorney who is acting for Monsoon. Mr Jennings exhibits at SJJ1 a copy of judgment of 7 November 2007 of the Tribunal de Grande Instance de Paris. The judgment relates to an action brought by SARL Agatha Diffusion against SARL Monsoon Accessorize. The case was brought by Agatha on the basis of two French registrations of the figurative mark of a Scottish terrier. Agatha complained about the use by Monsoon of the design of a Scottish terrier for key rings and self-adhesive stickers ( to wit a packet of six self adhesive stickers for children, one of which is a blue Scottish terrier with yellow spots, wearing a red collar around its neck). Agatha's claim for infringement was upheld. Mr Jennings states that Monsoon is concerned that Agatha will seek to exercise its rights in the same way in the United Kingdom. Mr Jennings exhibits at SJJ4 a copy of the details of Radley's Community trade mark registration. This is for the trade mark:





The trade mark is registered for a large number of goods in, inter alia, classes 3, 18 and 25. The trade mark did not proceed to registration upon the basis of acquired distinctiveness through use.

### ***Decision***

#### *Relevant public*

26) The goods of the registration are bought by the public at large and so the relevant public is the public at large.

#### *Material date*

27) Agatha has furnished no evidence of use of its trade marks in the United Kingdom, consequently, there is no issue as to the trade mark having acquired a distinctive character after registration. Consequently, the matters before me must be judged as of the date of the filing of the original application, 30 November 2004.

#### *Section 3(2)(c) of the Act*

28) This objection can only apply to registration no 2380724B, as it is the only shape mark. In *Julius Sämann Ltd and others v Tetrosyl Limited* [2006] EWHC 529 (Ch) Kitchin J stated:

“100 Two important points emerge from this passage. First, the mark may have a large goodwill associated with it derived from sales and advertising. This will no doubt have a substantial value. But it is not relevant. It is the shape itself which must add substantial value. Secondly, it is relevant to make a comparison with the shapes of equivalent articles. It is only if the shape in issue has a high value relative to such other shapes that it will be excluded from registration.”

There is no evidence to show that the shape in issue has a high value relative to other shapes. **Owing to the absence of relevant evidence, this ground must be dismissed.**

#### *Evidence after the material date*

29) There is a paucity of evidence emanating from prior to the material date. If I am correct in my understanding of the handwritten references AW and SS, it would appear that Monsoon produced key rings in the shape of a Scottish terrier for Autumn/Winter 2003 and purses in the shape of a Scottish terrier for Spring/Summer 2003 and Spring/Summer 2004. However, this is not clarified by Ms Harrison. (There is also nothing to show that any such use was in the United Kingdom.) Monsoon must rely upon evidence which emanates from after the

material date; or at least cannot be pinned down to being before the material date. The European Court of Justice (ECJ) in *Alcon Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-192/03 P held that use after the date of the application could be used to draw conclusions as to the position at the date of application<sup>2</sup>. The ECJ maintained a similar view in *L & D SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-488/06 P<sup>3</sup>. In *Telefon & Buch Verlagsgesellschaft mbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-322/03 the Court of First Instance (CFI) took into account documents emanating from four years after the date of application<sup>4</sup>. Use after the date of application can also go to the issue of foreseeability in relation to the use of the term<sup>5</sup>. The application of the principle has to be based on the facts of an individual case and the evidence that was furnished in each case. The evidence considered by the CFI, for instance, in *Alcon Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* (T-237/01) included clear and authoritative proof of use of the offending sign as a generic term prior to the date of the application<sup>6</sup>.

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<sup>2</sup> “41. Moreover, the Court of First Instance could without inconsistency in its reasoning or error of law take account of material which, although subsequent to the date of filing the application, enabled the drawing of conclusions on the situation as it was on that date (see, by analogy, the order in Case C-259/02 La Mer Technology [2004] E.C.R. I-0000 , [31]).”

<sup>3</sup> “70 First, the Court of First Instance did not err in law in holding that the Board of Appeal was able to rely on data concerning a period subsequent to the application for registration of the Aire Limpio mark.

71 In fact, as the Court of First Instance correctly recalled in paragraph 81 of the judgment under appeal, the case-law of the Court of Justice shows that account may be taken of evidence which, although subsequent to the date of filing the application, enables the drawing of conclusions on the situation as it was on that date (see order in Case C-192/03 P *Alcon v OHIM* [2004] ECR I-8993, paragraph 41).”

<sup>4</sup> “62 Even though those documents were gathered four years after the application for registration of the mark WEISSE SEITEN had been lodged, they confirm the linguistic development which took place and the conclusions which result from the documents concerning the period prior to the lodging of the application.”

<sup>5</sup> *Wm Wrigley Jr Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* Case C-191/01 P:

“32 In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

<sup>6</sup> “44. Thus, it is to be observed that, as the Board of Appeal pointed out at paragraph 17 of the contested decision, the dictionaries produced by the intervener before the Cancellation Division

*Section 3(1)(d) of the Act*

30) In *Telefon & Buch Verlagsgesellschaft mbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-322/03* the CFI stated:

“49 Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50 With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51 Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52 Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not

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(*Dictionary of Chemistry and Chemical Technology* by Helmut Gross, Elsevier 1989; *Lexicon medizinwissenschaftlicher Abkürzungen* by Dr Rolf Heister, F.K. Schattauer Verlag 1985; *Medical and Pharmaceutical Dictionary* by Werner E. Bunjes, Georg Thieme Verlag 1981; *MASA Medical Acronyms, Symbols & Abbreviations* by Betty Hamilton and Barbara Guidos, Neal Schuman Publishers Inc. 1984 and *Abbreviations* by Ralph De Sola, Elsevier 1986) and the articles submitted to the Board of Appeal, of which it cites those published by Winterlude (1995 edition) and the New England Eye Center (1996 edition), mention the term BSS as a generic designation for balanced salt solution or buffered saline solution.”

therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

31) The evidence furnished by Monsoon does not cast a light back into the position in the trade at the material date; the nature of the evidence is not such that it is possible to say that the trade marks had become customary in the *bona fide* and established practices of the trade at the date of the application. **Consequently, the ground under section 3(1)(d) of the Act is dismissed in relation to both registrations.** (As these are not word marks the trade marks cannot be “customary in the current language”<sup>7</sup>.)

*The shape mark and section 3(1)(b) of the Act*

32) In *Henkel KGaA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-144/06 P the ECJ stated:

“33 Under Article 7(1)(b) of Regulation No 40/94, trade marks which are devoid of any distinctive character may not be registered.

34 According to consistent case-law, for a trade mark to possess distinctive character within the meaning of that article, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* [2004] ECR I-5173, paragraph 32, and Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 42).

35 That distinctive character must be assessed, first, by reference to the products or services in respect of which registration has been applied for and, second, by reference to the perception of the relevant public (see Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM*, paragraph 33, and Case C-25/05 P *Storck v OHIM* [2006] ECR I-5719, paragraph 25).

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<sup>7</sup> of the judgment of Kitchin J in *Julius Sämann Ltd and others v Tetrosyl Limited* [2006] EWHC 529 (Ch):

“113 Although I accept the first two propositions, the argument must be rejected. First, there must be considerable doubt as to whether this provision could ever apply to device marks such as the Tree marks. They are not word marks and do not contain words. Nor are they marks which have come to be referred to by words which are common in the trade. On the contrary, the evidence showed that the products of the claimants are referred to, if anything, by the name Magic Tree and there is no suggestion that this has become common in the trade.”

36 According to equally consistent case-law, the criteria for assessing the distinctive character of three-dimensional trade marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade mark. However, when those criteria are applied, account must be taken of the fact that the perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (Case C-136/02 P *Mag Instrument v OHIM* [2004] ECR I-9165, paragraph 30, and *Storck v OHIM*, paragraphs 26 and 27).

37 In those circumstances, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94 (Case C-173/04 P *Deutsche SiSi-Werke v OHIM* [2006] ECR I-551, paragraph 31, and *Storck v OHIM*, paragraph 28).

38 That case-law, which was developed in relation to three-dimensional trade marks consisting of the appearance of the product itself, also applies where, as in the present case, the trade mark applied for is a figurative mark consisting of the two-dimensional representation of that product. In such a case, the mark likewise does not consist of a sign unrelated to the appearance of the products it covers (*Storck v OHIM*, paragraph 29).

39 It must be recalled that, in order to assess whether or not a trade mark has any distinctive character, the overall impression given by it must be considered. That does not mean, however, that there is no need, first of all, to carry out a successive examination of the different presentational features used by this mark. It may be useful, in the course of the overall assessment, to examine each of the constituent features of the trade mark (see, in this respect, Case C-286/04 P *Eurocermex v OHIM* [2005] ECR I-5797, paragraphs 22 and 23, and the case-law cited there).

33) The evidence of Monsoon, as commented upon above, does not establish, the position as to the use of the device or the shape of a Scottish Terrier at the date of application. However, with all of its many failings, the evidence does show that goods are made in the shape of a Scottish terrier, for instance cufflinks, or have the Scottish terrier in a decorative manner. Even if no such goods were made at the date of application, their current existence shows that it

was not unreasonable at the date of application to have considered that goods would have been made in such a form. It is to be noted that at ex parte examination stage there was a limitation of the specification to remove certain goods that could be made in this form. Goods in the form of a Scottish terrier would not be perceived by the average consumer as indicating the origin of the goods; they are after all the goods and the average consumer would look to some sign to indicate the origin of the goods. I consider that the following goods in class 14 could be or could include goods in the shape of a Scottish terrier:

*goods in precious metals or coated therewith and jewellery:* these would include such things as ornaments, cufflinks, earrings and tie pins in the form of a Scottish terrier.

With the exception of ornaments, the goods given above as examples would include some form of mechanism to function, such as a clasp. However, this would still be use of the shape, if in conjunction with a mechanism.

34) The evidence shows that purses are made in the shape of a Scottish terrier. This evidence relates to Monsoon's own use but this of itself does not gainsay the effects of the use on my considerations. There is nothing to suggest that novelty purses are the unique creation of Monsoon. Novelty purses could be in many forms, the evidence shows that one form is that of a Scottish terrier. The use is by Monsoon but this is use as the goods and not as a trade mark and so is simply a representation of what has happened in trade and what can be expected to happen in trade. The following goods in the class 18 could be or could include goods in the shape of a Scottish terrier:

*goods made of leather and imitations of leather, purses.*

Again the goods would need some form of mechanism to function but this would still be use of the shape, if with a mechanism. Agatha has accepted a specification that excludes goods that might be in the shape of a Scottish terrier novelty backpacks. In *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* Case C-363/99 the ECJ stated

“114. By contrast, where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.”

The exclusions in the specification are in the following terms:

*backpacks not including novelty backpacks, haversacks not including novelty haversacks.*

'Novelty' is a characteristic of the goods, it is also a term that is open to a number of interpretations. I do not consider that this term is compliant with the judgment of the ECJ in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau*. The exclusion is a de facto acceptance that the backpacks and haversacks could be in the form of a Scottish terrier, and so subject to objection under section 3(1)(b) of the Act and must be removed from the specification in their entirety.

**35) So in relation to the shape mark being a representation of the goods it is devoid of any distinctive character in respect of:**

***goods in precious metals or coated therewith; jewellery, not including charm bracelets and charm necklaces;***

***goods made of leather and imitations of leather; backpacks not including novelty backpacks, haversacks not including novelty haversacks, purses.***

It may be that there are other goods which could be in the shape of a Scottish terrier but there is no evidence to support such a hypothesis.

36) As stated above the shape mark could also be attached to the goods. In *Vibe Technologies Ltd's Application* [2009] ETMR 12 Mr Richard Arnold QC, sitting as the appointed person stated:

"61 It is convenient to begin consideration of this ground with five propositions of law which are now well settled. First, for a trade mark to possess distinctive character, it must serve to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish the goods or services from those of other undertakings.....

62 Secondly, the distinctive character of a mark must be assessed by reference to: (i) the goods or services in respect of which registration is applied for; and (ii) the perception of the average consumer of those goods or services, who is deemed to be reasonably well informed and reasonably observant and circumspect.....

63 Thirdly, the criteria for assessment of distinctive character are the same for all categories of trade marks, but nevertheless the perception of the relevant public is not the same for all categories of trade marks and it may therefore be more difficult to establish distinctive character in relation to some categories (such as shapes, colours, personal names, advertising slogans and surface treatments) than others....."

The public are not used, in the norms of trade, to seeing a three dimensional object attached to a product as being an indicator of origin; it is more likely to be perceived as decoration. The shape mark could be attached to an umbrella, to a

bottle of perfume, to an article of clothing. I can see no reason why the average, relevant consumer would perceive such use as indicating origin; it would require education to give such use trade mark significance, and this is a case with a total absence of use of the trade mark in the United Kingdom. **In this form of use the trade mark would be devoid of any distinctive character in respect of all of the goods of the registration.**

37) The class 3 products require a container to effect their commercialisation and so the shape could be a container in the shape of a Scottish terrier. In *Henkel KGaA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-144/06 P the ECJ stated:

“36 According to equally consistent case-law, the criteria for assessing the distinctive character of three-dimensional trade marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade mark. However, when those criteria are applied, account must be taken of the fact that the perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (Case C-136/02 P *Mag Instrument v OHIM* [2004] ECR I-9165, paragraph 30, and *Storck v OHIM*, paragraphs 26 and 27).

37 In those circumstances, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94 (Case C-173/04 P *Deutsche SiSi-Werke v OHIM* [2006] ECR I-551, paragraph 31, and *Storck v OHIM*, paragraph 28).”

**In this case if the Scottish terrier shape was used as a container it would depart significantly from the norm of customs of the sector and, therefore, in relation to such use would not be devoid of any distinctive character.**

*The shape mark and section 3(1)(c) of the Act*

38) In *Linde AG, Winward Industries Inc and Rado Uhren AG v Deutsches Patent- und Markenamt* Joined Cases C-53/01 to C-55/01 the ECJ stated:



“63. As regards the first limb of the second question, according to Article 3(1)(c) of the Directive, descriptive trade marks, that is to say, those which consist exclusively of signs or indications which may serve, in trade, to designate the characteristics of the goods or services for which registration is sought, cannot be registered.

64. Under Article 3(1)(e) of the Directive, signs which consist exclusively of the shape which results from the nature of the goods themselves, or the shape of goods which is necessary to obtain a technical result, or the shape which gives substantial value to the goods are not to be registered.

65. Those specific grounds for refusing the registration of certain signs consisting of the shape of the product set out expressly in Article 3(1)(e) of the Directive constitute, as paragraph 44 of this judgment makes clear, a preliminary obstacle liable to prevent such signs from being registrable (see *Philips*, paragraphs 74 and 76).

66. However, even if that preliminary obstacle is overcome, neither the wording of Article 3(1) of the Directive nor the scheme of the Directive indicates that the other grounds for refusing registration in that provision, including those in Article 3(1)(c), should not also apply to applications to register three-dimensional shape of product marks.

67. It is clear from Article 3(1) of the Directive that each of the grounds for refusal listed in that provision is independent of the others and calls for separate examination.

68. It follows that if a three-dimensional shape of product trade mark is not refused registration under Article 3(1)(e) of the Directive, registration may still be refused if it falls within one or more of the categories set out in Article 3(1)(b) to (d).

69. In regard to Article 3(1)(c) of the Directive in particular, there is nothing in principle to stop that provision applying to an application for a three-dimensional shape of product trade mark. The reference to trade marks which consist exclusively of signs or indications which may serve to designate characteristics of the goods or service other than those expressly referred to in that provision is sufficiently broad to cover a wide variety of trade marks, including three-dimensional shape of product trade marks.

70. Having regard to the foregoing, the reply to the first limb of the second question must be that, independently of Article 3(1)(e) of the Directive, Article 3(1)(c) also has significance for three-dimensional shape of product trade marks.”

So the shape of the goods can represent a characteristic of the goods and so be subject to objection under section 3(1)(c) of the Act. (The shape of the goods should not be conflated with the goods, the goods themselves cannot be a characteristic of themselves, they are the sum of all their characteristics, one of which is their shape). **In this case the shape is a characteristic of goods which are in the shape of the Scottish terrier, consequently the shape trade mark will be subject to objection to the goods identified in paragraph 35, ie:**

***goods in precious metals or coated therewith; jewellery, not including charm bracelets and charm necklaces;***

***goods made of leather and imitations of leather; backpacks not including novelty backpacks, haversacks not including novelty haversacks, purses.***

39) Agatha has made the application on the basis that it will use the shape mark on the goods of the specification and I have had to take into account various potential forms of use, all of which Agatha could make and consider the objections on the basis of each form of use. The registration gives a potentiality for all these uses and must be considered on the basis of the potential uses, all of which come within the parameters of normal and fair use. There is no indication as to how Agatha does or will use the trade mark; if there were this would not affect the matter as the strategies of Agatha could change at any time and the registration could be sold at any time.

*The device marks and section 3(1)(c) of the Act*

40) No distinction has been drawn between the three trade marks of the series by the parties. I cannot see the reversal of the position of the dog in one trade mark or the highlighting of the collar of the dog in one trade mark have any effect in consideration of the matters before me. If one trade mark is subject to invalidation under section 3(1)(c) (of section 3(1)(b)) of the Act then the others will also be subject to invalidation.

41) A convenient analysis of the considerations that need to be made in relation to section 3(1)(c) of the Act was given by the CFI in *Tegometall International AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-458/05*:

“77 According to settled case-law, Article 7(1)(c) of Regulation No 40/94 prevents the signs or indications to which it refers from being reserved to one undertaking alone because they have been registered as trade marks. That provision pursues an aim that is in the public interest, which requires that such signs and indications may be freely used by all (Case T-348/02 *Quick v OHIM (Quick)* [2003] II-5071, paragraph 27; see also, by analogy, Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 25).

78 Furthermore the signs referred to by Article 7(1)(c) of Regulation No 40/94 are signs regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquired the product or service to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (see Quick, paragraph 28, and the case-law cited).

79 The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are those which may serve in normal usage from the point of view of the relevant public to designate, either directly or by reference to one of their essential characteristics, goods or services in respect of which registration is sought (Case C-383/99 P Procter & Gamble v OHIM [2001] ECR I-6251, paragraph 39, and Case T-19/04 Metso Paper Automation v OHIM (PAPERLAB) [2005] ECR II-2383, paragraph 24).

80 It follows that, for a sign to be caught by the prohibition set out in that provision, there must be a sufficiently direct and specific relationship between the sign and the goods or services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods or services in question from one of their characteristics (see, to that effect, Case T-311/02 Lissotschenko and Hentze v OHIM (LIMO) [2004] ECR II-2957, paragraph 30, and PAPERLAB, paragraph 25).

81 Therefore, the descriptiveness of a mark may only be assessed, first, in relation to the goods or services concerned and, secondly, in relation to the perception of the target public, which is composed of the consumers of those goods or services (CARCARD, paragraph 25, and Joined Cases T-367/02 to T-369/02 Wieland-Werke v OHIM (SnTEM, SnPUR, SnMIX) [2005] ECR II-47, paragraph 17).”

42) In the case of goods that are in the shape of a Scottish terrier, or could be in that shape, (see above) the device trade marks are pictorial representations of the goods and so will designate directly to the relevant public the nature of the goods. The device could, for instance, be placed on a box which holds the product. It may be that certain of the goods in the specification could be specifically designed for dogs eg the suggestion of perfumes being made for dogs. This is not a notorious fact, it is certainly not something of which I am aware; although I may be at a disadvantage as someone who does not keep a pet. If some of the class 3, 14 and 18 goods could be specifically designed for dogs it was for Monsoon to put evidence forward to demonstrate this. **Consequent upon this, I consider that the only goods that fall foul of section 3(1)(c) of the Act are those which could be in the shape of a Scottish terrier, ie:**

**goods in precious metals or coated therewith; jewellery, not including charm bracelets and charm necklaces;**

**goods made of leather and imitations of leather; backpacks not including novelty backpacks, haversacks not including novelty haversacks, purses.**

*The device marks and section 3(1)(b) of the Act*

43) I have already referred to the considerations to be made in relation to section 3(1)(b) of the Act.

44) The goods which are excluded as per section 3(1)(c) of the Act are automatically excluded under section 3(1)(b) of the Act as per *Koninklijke KPN Nederland NV v Benelux Merkenbureau* Case C-363/99:

“86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

45) The challenge by Monsoon under section 3(1)(b) of the Act essentially relates to the use of the device of a Scottish terrier as a form of decoration. Any representation of an animal could be used as decoration on certain goods; I cannot see that there can be a bar per se to the use of a device of any animal. It is a question of the facts of a particular case. The evidence shows that the device of a Scottish terrier is used as decoration on a variety of articles. Most of the evidence cannot be identified as emanating from before the material date in the United Kingdom, however, it does indicate that undertakings do and will wish to use the device of a Scottish terrier, including Monsoon. I cannot see that there is anything tainted about Monsoon's evidence of its own use of the Scottish terrier device, there has been no challenge to the genuineness of this use. There is nothing to suggest that the device was used for anything other than decoration, that there was any ulterior motive in the use of the device. The device of a Scottish terrier is used on its own, eg on the Topshop skirt and the Simply Be nightshirt, and also used in the plural to form a pattern. In both forms of use, the use is one of decoration, there is nothing to suggest trade mark usage. The average, relevant consumer is unlikely to perceive that the use is for anything other than decorative purposes. It is common nowadays for trade marks to be placed on the exterior of various products such as clothing, footwear and bags. The Scottish terrier on the t-shirt is, as far as one can tell, there for decorative purposes, not as an indication of origin; the very potential ambiguity underlines the problems that are given rise to by granting registered trade mark status to the device trade marks of Agatha. If used on the front of clothes is this decorative

use or does it indicate origin? How is the average, relevant consumer to know without something else to indicate the nature of the use? Why should the average, relevant consumer assume that such use is trade mark use? In relation to the class 18 goods there is no evidence of use in a Scottish terrier in the singular but the evidence suggests that such use is a probability. The decorative use of the Scottish terrier has been established, if not in singular form for the class 18 goods. The trade marks could be used on such things as swing tags and sewn in labels, such use would then be perceived by the average, relevant consumer as trade mark use. I cannot see that, taking into account the nature of the trade marks, that one can assume that the registration is invalid under section 3(1)(b) of the Act because one particular form of use would not be seen as trade mark use. There is plenty of case law to say that certain types of two dimensional trade marks would normally fail to clear a perception barrier eg slogans. The issues herein relating to decoration hinge on actual use by other traders of the particular type of device; giving rise to the need to leave free. The need to leave free is the basis of objections under section 3(1)(c) and 3(1)(d); in relation to the decorative use of the Scottish terrier this is a matter, if it is a matter of anything, of section 3(1)(d) of the Act; the decorative use does not link to a characteristic. (I have dealt with the areas where the trade marks are objectionable under section 3(1)(c) of the Act above.) **Consequent upon this I cannot find that the registration of the trade marks was contrary to section 3(1)(b) of the Act where it was not contrary to section 3(1)(c) of the Act.**

#### *Summing up*

46) Monsoon launched these actions on 11 October 2007. It is likely that the actions were launched as a result of the infringement proceedings brought by SARL Agatha Diffusion in France; judgment was given in relation to these proceedings on 7 November 2007. Monsoon clearly consider that there is a need to leave free. The first defence of other traders is that of refusal of applications for registration or cancellation of registrations. The defences allowed to traders under section 11 of the Act can never be the basis of allowing registration<sup>8</sup>. (There is also currently a certain amount of incoherence in relation

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<sup>8</sup> of the judgment of the CFI in *Nordmilch eG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-295/01*

“55. It must be observed that the purpose of Article 12(b) of the Regulation, in the context of its relationship with Article 7(1)(c), in particular for trade marks which do not fall within the scope of that provision because they are not exclusively descriptive, is to ensure, inter alia, that use of an indication relating to geographical origin, which also forms part of a complex trade mark, does not fall within a prohibition that the proprietor of such a mark is entitled to enforce under Article 9 of the Regulation, where that indication is used in accordance with honest practices in industrial and commercial matters (see, by analogy, *Windsurfing Chiemsee*, cited above, paragraph 28, and *Case T-359/99 DKV v OHIM (EuroHealth)* [2001] ECR II-1645, paragraph 28).

56. If it is to apply, therefore, there must be a prior finding that a trade mark has been validly registered and that the proprietor thereof is enforcing his rights. The alleged infringer may then

to the application of article 5(1) of Directive 2008/95/EC of 22 October 2008 as detailed by the opinion of AG Mengozzi in *O2 Holdings Limited & O2 (UK) Limited v Hutchison 3G UK Limited* Case C-533/06<sup>9</sup>.) The problem for Monsoon

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rely on Article 12 of the Regulation as a defence to resist a claim of infringement of the proprietor's rights.

57. Consequently, application of that provision may not be taken into account during the registration procedure. Therefore, given that the trade mark is not registrable, the second plea must also be rejected.”

<sup>9</sup> 20. A detailed reply to the question thus raised by the referring court would require an examination of the case-law relating to Article 5(1)(a) and (b) of Directive 89/104, which does not appear, at least at first sight, to be at all consistent as to the conditions on which those provisions apply. I note in particular, in this connection, the difficulty of reconciling the approach adopted by the Court in *BMW*, from which it seems to follow that the use by a third party of another's trade mark, not to distinguish that party's own goods or services but to distinguish the goods or services of the proprietor of the trade mark, does not of itself escape Article 5(1)(a) of Directive 89/104, with the approach adopted in more recent judgments, which tend rather to favour the opposite solution.

21. In *BMW*, the Court held that the use in an advertisement of another's trade mark to distinguish the goods *of the proprietor of the trade mark* as the subject of the services provided by the advertiser fell within the ambit of Article 5(1)(a) of Directive 89/104, subject to the provisions of Article 6 or Article 7 of that directive.

22. In *Hölterhoff*, the Court held that the proprietor of a trade mark cannot rely on his exclusive right under Article 5(1) of Directive 89/104 where a third party, in the course of commercial negotiations, reveals the origin of goods which he has produced himself and uses the sign in question solely to denote the particular characteristics of the goods he offers for sale, so that there can be no question of the trade mark used being perceived as a sign indicative of the undertaking of origin.

23. In *Arsenal Football Club*, the Court ruled that the exclusive right under Article 5(1)(a) of Directive 89/104 was conferred 'in order to enable the trade mark proprietor to protect his specific interests as proprietor, that is, to ensure that the trade mark can fulfil its functions' and that '[t]he exercise of that right must therefore be reserved to cases in which a third party's use of the sign affects or is liable to affect the functions of the trade mark, in particular its essential function of guaranteeing to consumers the origin of the goods'.

24. In the same judgment, the Court noted that, in that particular case, the use of the sign in question was obviously not intended for purely descriptive purposes, which would otherwise be excluded from the scope of the abovementioned provision, but was such as to create the impression that there was a material link in the course of trade between the goods concerned and the trade mark proprietor and was therefore liable to jeopardise the guarantee of origin which constitutes the essential function of the mark. The Court held that it was consequently a use which the trade mark proprietor might prevent in accordance with Article 5(1) of Directive 89/104.

25. In *Adam Opel* the Court held that, '[a]part from [the] specific case of use of a trade mark by a third-party provider of services having as subject-matter the products bearing that trade mark', such as the case examined in the judgment in *BMW*, 'Article 5(1)(a) of the directive [Directive 89/104] must be interpreted as covering the use of a sign identical to the trade mark in respect of goods marketed or services supplied *by the third party* which are identical to those in respect of which the trade mark is registered'. Again in *Adam Opel*, it stated that 'it was having regard to [the] specific and indissociable link between the products bearing the trade mark and the services

is that this need to leave free in relation to the decorative use of the Scottish terrier hinges on establishing that this is a sign that at the date of application was customary in the bona fide and established practices of the trade. The evidence has failed to do this, it can indicate what is the current position, it can establish the position re futurity, but it is simply not good enough to establish the position at the material date. It was for Monsoon to prove its claim. It clearly thought that it had, as it added section 3(1)(d) of the Act as a ground of opposition after filing its evidence. Its view of the matter is not shared by me, it has made no attempt to show clearly what the position was prior to the date of the application for registration in the United Kingdom. There was no precision or clarity in relation to the evidence of use of the Scottish terrier device by Monsoon itself, something clearly in its control. There was no evidence from the trade, no evidence from catalogues or advertisements emanating prior to the date of application. The evidence from the Internet was also without precision or detail. Monsoon's evidence in relation to section 3(1)(d) of the Act leaves the matter to speculation rather than inference. Monsoon launched these proceedings, it knew what the parameters were, it was for it to support its case with evidence.

*The extent of the refusal*

**47) The registration of the shape trade mark is to be cancelled in its entirety. The registration of the two-dimensional trade marks is to be cancelled in respect of the following goods:**

***goods in precious metals or coated therewith; jewellery, not including charm bracelets and charm necklaces;***

***goods made of leather and imitations of leather; backpacks not including novelty backpacks, haversacks not including novelty haversacks, purses.***

**This means that the specifications in classes 14 and 18 of registration no 2380724A will read:**

***precious metals and their alloys; precious stones; horological and chronometric instruments;***

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provided by the third party that the Court held that, in the specific circumstances of the *BMW* case, use by the third party of the sign identical to the trade mark in respect of goods marketed *not by the third party but by the holder of the trade mark* fell within Article 5(1)(a) of the directive'.

26. Thus, the use of another's trade mark by a third party to distinguish the goods or services supplied by the proprietor of the trade mark, which does not cause confusion regarding the origin of those goods or services and the third party's goods or services, may apparently fall within the ambit of Article 5(1) of Directive 89/104 on the basis of *BMW*, and may escape it on the basis of *Hölterhoff* and *Adam Opel*, while, on the basis of the case-law cited in point 23 above, in order to determine whether or not the said use is caught by that provision, it must be ascertained whether it is liable to affect a function of the trade mark other than the essential function of providing a guarantee of origin.

***leather and imitations of leather; hides; trunks and travelling bags; umbrellas and parasols; handbags, make-up bags, wallets, garment bags, briefcases, attaché cases, card cases, key cases, school bags, travelling trunks and vanity cases.***

**In accordance with section 47(6) of the Act the registration of no 2380724B is deemed never to have been made. The registration of 2380724A is deemed never to have been made in respect of the goods identified in this paragraph.**

48) At the hearing Mr Hackney intimated that if the findings were against Agatha that he would be interested in submitting an amended specification in relation to some of the general terms. Following the writing of the decision, but prior to its issue, on 10 February 2009, a facsimile transmission was received from Mr Hackney re amending the specification. The specification proposed by Mr Hackney in relation to class 14 goods excluded charm or novelty earrings and novelty cufflinks. I cannot see that such an amendment of the specification would be compliant with the *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* principles. Indeed I cannot see that any exclusions, as suggested in the facsimile transmission, would assist Agatha. I cannot see that any tinkering with the specifications could assist Agatha; especially bearing in mind the need for clarity and precision in the specification. Outwith this, the issues must be judged on whether the general categories of goods encompass goods for which there can be objection as per the judgment of the CFI in *Duro Sweden AB v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 346/07*:

“63 It follows from the foregoing that the mark EASYCOVER, taken as a whole, presents, with regard to the target public, a sufficiently direct and concrete link with the goods covered by the application for registration, with the exception of those in the category of ‘monuments, not of metal’. In that regard, it should be added that, even if the mark EASYCOVER were not descriptive of all the goods within each of the categories in question, except for the category ‘monuments, not of metal’, the applicant applied for registration of the sign for all the goods within those categories without distinguishing between them, so that, accordingly, the Board of Appeal’s assessment must be upheld in so far as it relates to those categories of goods as a whole except for those goods in the category ‘monuments, not of metal’ (see, that effect, Case T-106/00 *Streamserve v OHIM (STREAMSERVE)* [2002] ECR II-723, paragraph 46, and *CARCARD*, paragraph 36).”

49) Reference has been made to an earlier trade mark registration of Agatha. This registration was made under the 1938 Act, the criteria for assessing it do not apply to the 1994 Act. I, also, have to consider the merits of these cases based on the facts before me and within the parameters of the current law.



## Costs

50) Monsoon has been more successful than Agatha in relation to what has been retained and what cancelled. The success has been total in relation to the shape mark but more limited in relation to the device marks. Consequently, I have reduced the amount of costs that I have awarded to Monsoon by ten percent. I award costs on the following basis:

Application fees:	£400 (2 x £200)
Statement of grounds:	£270 (owing to their nature one fee for the two statements)
Considering statement of case in reply:	£180 (owing to their nature one fee for the two statements)
Evidence:	£180
Consideration of evidence of Agatha:	£90
Preparation for and attendance at hearing:	£180
<b>TOTAL</b>	<b>£1,300</b>

I order Agatha Diffusion to pay Monsoon Accessorize Limited the sum of £1,300. 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 12 day of February 2009**

**David Landau  
For the Registrar  
the Comptroller-General**