

O-208-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2465181
BY KOLIOS SA TO REGISTER
A TRADE MARK IN CLASSES 14, 18, 25 AND 35**

AND

**IN THE MATTER OF OPPOSITION NO 96580 BY
RAUTUREAU APPLE SHOES SOCIETE PAR ACTIONS SIMPLIFEE**

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IN THE MATTER OF Application No 2465181

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IN THE MATTER OF Opposition No 96580

By Rautureau Apple Shoes Societe par Actions Simpliffee

BACKGROUND

1. On 24 August 2007, Kolios SA ("KS") applied to register the trade mark "NO NAME" for the following goods and services:

Class 14:

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; clocks and watches; costume jewellery.

Class 18:

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25:

Clothing and headgear.

Class 35:

Retail services connected with the sale of precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes, jewellery, precious stones, horological and chronometric instruments, clocks and watches, costume jewellery, leather and imitations of leather, and goods made of these materials and not included in other classes, animal skins, hides, trunks and travelling bags, handbags, rucksacks, purses, umbrellas, parasols and walking sticks, whips, harness and saddlery, clothing and headgear.

2. On 7 March 2008, Rautureau Apple Shoes Societe par Actions Simpliffee ("RAS") filed a notice of opposition to this application based on a single ground under Section 5(2)(a) of the Trade Marks Act 1994 ("The Act"). In relation to this ground, RAS relies upon its earlier trade mark number 1556522 for the words "NO NAME". The earlier trade mark is registered in respect of goods in Class 25, namely shoes, boots and slippers.

3. KS filed a counterstatement denying the ground of opposition.

4. Only RAS filed evidence. I will detail the evidence to the extent necessary, where relevant in this decision. Neither side requested a hearing, although KS did file written submissions in lieu of a hearing. Although RAS did not file formal written submissions, it did make a number of submissions in its counterstatement and in a letter, dated 25 June 2009, which I will take into account.

DECISION

Proof of use regulations

5. In opposition proceedings, earlier marks for which the registration procedure was completed before the five year period ending with the date of publication of the applied for mark (KS's mark) may only be relied upon to the extent that they have been used (or that there are proper reasons for non-use)¹. KS's mark was published on 7 December 2007. RAS's mark completed its registration procedure on 23 September 1994, therefore, the proof of use regulations do apply. The earlier mark will, consequently, be considered for its specification to the extent for which use of the trade mark can be proven.

6. In relation to proof of use, the relevant legislation reads:

“6(A) (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

¹ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

7. The relevant period for the purposes of demonstrating genuine use is the five year period ending on the date of publication of KS's application. This is, therefore, **8 December 2002 to 7 December 2007**

Assessment of RAS's evidence of use

8. RAS's evidence of use is in the form of a number of invoices contained within an exhibit attached to the witness statement of David John Crouch, RAS's trade mark attorney in these proceedings. Mr Crouch explains that he was instructed by RAS's French attorney, William Hammond, to file the opposition. In a letter, dated 28 August 2008, Mr Crouch asked the French attorney to provide evidence of use of RAS's mark. Though this letter is not exhibited in evidence, Exhibit DJC2 consists of the response to this letter from William Hammond, dated 8 October 2008, together with evidence (the invoices) purporting to show use of RAS's mark. Mr Crouch confirms that he believes this evidence to be true.

9. In its written submissions, KS argue that this evidence is “third hand” as it is provided by a UK attorney, acting on instructions from a French attorney, presumably who obtained the information from RAS. On this basis, it argues that very little weight should be attached to the evidence as the maker of the witness statement has no direct knowledge of its contents, though it accepts that Mr Crouch has declared that he believes the evidence to be true. While I accept that this evidence has come from a third party, this third party is the instructing attorney in these proceedings who has done no more than attach invoices, which are factual documents, to a covering letter. The content of the invoices themselves are not changed by virtue of them not being attached to a witness statement from Mr Hammond himself and, as such, I am prepared to take them into account.

10. I note that there are a number of invoices to consider, dated both during the relevant period and afterwards. I note that the first seven invoices exhibited are dated after the relevant period and show evidence of sales. I cannot therefore take these into account when assessing whether there is genuine use of the mark. There are, however, a number of invoices (nineteen in total) which are dated within the relevant period, showing sales of footwear. I have been able to deduce that it is footwear that the invoices refer to as the sizing information for the particular items invoiced are footwear sizes. There is also an email, albeit outside of the relevant

period (it is dated 13 May 2008), with the subject matter “no name shoes”, which helps to provide context as the content of the email refers to a number of different models of footwear, some of which correspond with the descriptions appearing on the invoices. Each invoice is headed up with “Collection: NO NAME”. This is followed by a breakdown of the different models of footwear that fall within this collection. These different models also have their own names attached to them, e.g. ASUKO, FLYER and others. In this regard, KS are critical of this evidence. It argues that this is not trade mark use. Rather, that the trade marks being used in relation to the goods are FLYER, ASUKO etc. KS also suggest that the use of “NO NAME” on the invoices may even refer to a collection of footwear that has not been given any name, as there is no supporting evidence to indicate what exactly “COLLECTION: NO NAME” refers to.

11. I do not consider KS’s arguments to be fatal to RAS’s case. Firstly, to my mind, the invoices do show that the “NO NAME” trade mark refers to a “collection” of footwear sold under this name, despite the use of what appears to be additional trade marks. Trade mark owners often choose to use more than one trade mark at the same time, with one, perhaps, acting as a sub brand. There is nothing in this practice which prevents a trade mark owner from being able to show proof of use of its mark, in this case the NO NAME mark. Secondly, though the words “No Name” could ordinarily be interpreted as meaning no brand name, the witness statement of Mr Crouch confirms that the invoices constitute evidence of use of the NO NAME mark. This puts the use of these particular words into context. Furthermore, if the collection had no name, it seems strange as to why RAS would go to the trouble of registering the words NO NAME as a trade mark. In totality, this is enough to lead me to the conclusion that the invoices refer to the “NO NAME” collection of footwear. I am satisfied, therefore, that the invoices show use of NO NAME in a trade mark sense.

12. In considering whether or not the invoices constitute genuine use, it seems to me that the evidence filed is not as cogent as it could have been. There are only invoices showing a number of individual sales that have been made, there is no indication of total number of sales made during the relevant period. The nature of the evidence gives no indication as to how the general public perceive the NO NAME mark. No examples of how the mark has been advertised or promoted have been included nor how the mark is used at the point of sale. The amount spent on advertising (if any has taken place), is also absent. The invoices appear to show that goods have been supplied for sale in more than one establishment, however, no details on the extent of this have been provided, for example, how many establishments in the UK sell the goods and the nature of these establishments. I therefore, have little understanding of the scale of any use made. KS refer, in its written submissions, to the evidence as “sparse”. However, I can see from the evidence that some trade under the mark has taken place. I must, therefore, decide whether this is enough to constitute genuine use. In assessing this point, I bear in mind the guidance on the meaning of “genuine use” from the following judgments from the European Court of Justice (ECJ):

- a) In *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] ETMR 85, the ECJ stated:

“35. ... ‘Genuine use’ therefore means actual use of the mark....

36. ‘Genuine use’ must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user...

37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of its enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

b) In *La Mer Technology Inc v Laboratoires Goemar SA* [2004] FSR 38, the ECJ provided further guidance when it stated:

“20. It follows from those considerations that the preservation by a trade mark proprietor of his rights is predicated on the mark being put to genuine use in the course of trade, on the market for the goods or services for which it was registered in the Member State concerned.

21. Moreover, it is clear from paragraph 39 of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive, even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed to be

justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case-by-case assessment which is for the national court to carry out. The characteristics of those products and services, the frequency or regularity of the use of the mark, whether the mark is used for the purpose of marketing all the identical products or services of the proprietor or merely some of them, or evidence which the proprietor is able to provide, are among the factors which may be taken into account.

23. Similarly, as emerges from paragraphs 35 to 39 of *Ansul* set out above, the characteristics of the market concerned, which directly affect the marketing strategy of the proprietor of the mark, may also be taken into account in assessing genuine use of the mark.

24. In addition, use of the mark by a single client which imports the products for which the mark is registered can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor of the mark.”

13. What is clear from these judgments is that the test for genuine use is qualitative rather than quantitative. I should be prepared to make a finding of genuine use when the trade mark has been used in such a way so as to create or maintain a share in the market for the goods for which it is registered. In relation to this market share, the guidance from *Laboratoire de la Mer* at paragraph 44, states that this should not be construed as imposing a requirement that a significant market share has been achieved. The ECJ in *Ansul* felt that genuine use should not be found if use is mere “token” use or if it is merely internal to the registered proprietor’s business.

14. Applying the guidance from these judgments, it is clear that the use cannot be classified as mere token use for the purposes of preserving the registration nor is it use internal to RAS. The invoices show evidence of trade between RAS and a (albeit limited) number of retailers and represent sales of around 62,000 Euros. These sales also took place over a period of time (25th May 2004 – 18th October 2007) and the retailers were located in a number of different locations. Although the scale of use is not great, it is at least spread over three and a half years. Considered as a whole, I conclude that it does constitute genuine use of the NO NAME mark.

15. This is not the end of the matter. Having concluded that there is genuine use, I must now determine what would be a fair specification for the use shown. In doing so, I take into account the guidance provided in a number of cases. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 Aldous LJ stated at paragraph 31:

“Pumfrey J. in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view the task should be carried

out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use.”

16. In *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 the Court of First Instance (“CFI”) stated:

“43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.”

In *Animal Trade Mark* [2004] FSR 19 Jacob J held:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

17. Taking the above cases in the round, it appears to me that I should not be overly picky in the specification I adopt, but neither should I allow an overly broad specification measured against the goods on which use has been shown. In deciding on a fair specification, the evidence is, once again, not as cogent as it could have been. The invoices show that types of footwear have been sold, however, it gives no more detail and is not broken down in a manner which would allow this Tribunal to clearly identify whether it is just shoes that have been sold under the mark, or whether those sales also include boots and slippers.

18. Out of the nineteen invoices exhibited, I note that fifteen use the following descriptions – “sneakers”, “trainers” and “joggers”. In my view, it is reasonable to conclude that these refer to training shoes. These make up the majority of the types of footwear sold according to the evidence. However nine of the invoices also make reference to other types of shoes, e.g. “slingback” shoes appear twice, as do shoes described as “rhythmic”, “Clogs” appears once, as does “springer” and “ballet” shoes and three refer to “derby” shoes. I am, therefore, satisfied that the invoices show there have been sales on a range of shoes. However, the evidence goes no further than this. It does not, in my view, enable me to conclude that NO NAME has also been used on boots and slippers. My finding is, therefore, that RAS’s NO NAME mark can be considered as an earlier mark in relation to “shoes” only.

The law and the leading authorities

19. Section 5(2)(a) of the Act states:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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.”

20. When making my determination, I take into account the guidance from the case law of the ECJ on this issue, notably: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and services, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(d) 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 BV v Puma AG*,

(e) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

Average consumer and the purchasing act

21. As the ECJ states in *Sabel BV v. Puma AG*, matters must be judged through the eyes of the average consumer. I must, therefore, assess who this is. The respective goods in question are, by and large, consumer goods and the retail services relate to the selling of those goods. The average consumer of both parties' goods is therefore, in the main, the public at large, who is deemed to be reasonably observant and circumspect. I would therefore expect such a consumer to display a reasonable degree of care and attention in purchasing these items. There may also be an additional, distinct category of consumer to consider, specifically in relation to whips, harness and saddlery in Class 18. Arguably, the average consumer for these goods may indicate a more specialist, average consumer (those interested in horse riding), who may display a higher than average degree of care and attention. I will return to this point, if necessary, later in my decision.

22. With regards to the purchasing act, I am of the view that this will, mainly, be on a self selection basis, whether online via a website or from a rail or shelf in a retail establishment. Some items, particularly (but not exclusively) Class 14 goods, such as precious stones and metals, may also be purchased over a counter or via a transaction style which necessitates assistance or guidance prior to purchasing.

Comparison of the goods and services

23. All relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23 of its judgment:

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

24. Other factors may also be taken into account such as, for example, the relevant channels of distribution (see paragraph 53 of the judgement of the CFI in Case T-164/03 *Ampafrance S.A. v OHIM – Johnson & Johnson GmbH (monBebe)*).

25. I will break down my assessment with reference to the classes sought by KS. The respective specifications are shown below for ease of reference.

RAS's specification following proof of use assessment:	KS's specification
<p>Class 25:</p> <p>Shoes.</p>	<p>Class 14:</p> <p>Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; clocks and watches; costume jewellery.</p> <p>Class 18:</p> <p>Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery.</p> <p>Class 25:</p> <p>Clothing and headgear.</p> <p>Class 35:</p> <p>Retail services connected with the sale of precious metals and their alloys and goods in precious metals or coated therewith, not included in</p>

	<p>other classes, jewellery, precious stones, horological and chronometric instruments, clocks and watches, costume jewellery, leather and imitations of leather, and goods made of these materials and not included in other classes, animal skins, hides, trunks and travelling bags, handbags, rucksacks, purses, umbrellas, parasols and walking sticks, whips, harness and saddlery, clothing and headgear.</p>
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Class 25 of KS's application

26. As a result of my findings with regard to RAS's evidence of use, the comparison to be made in this regard is between "shoes" and "clothing and headgear" at large. RAS argue that these goods are clearly complementary as shoes are an accessory to clothing. KS argue that clothing and headgear can be differentiated from footwear even though it accepts that such goods can be sold through similar channels. In this regard, it argues that RAS's evidence shows its goods are only sold to establishments which specialise in the sale of footwear, therefore the distribution channels are different. In KS's view, provided that RAS's mark is limited to these channels of trade and if KS's mark is not used in relation to footwear, there is no reason for the respective marks to come into conflict. I note this, however, there is nothing to prevent RAS from supplying its goods to retailers which also stock clothing and headgear at large and a specification cannot differentiate between the goods in the manner in which KS suggest.

27. In terms of approach, the case-law tells me that "in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade"². I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning³. I also bear in mind the CFI judgment in Case T-133/05 (*Gerard Meric v OHIM*), where at paragraph 29, it stated:

"In addition, the goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM –*

² *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

³ *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42.”

28. In making a comparison between the respective Class 25 goods, I note that KS’s specification includes the term “clothing”, which is wider than RAS’s “shoes”. I must therefore consider the natural meaning of the term clothing and what this term means to the trade in order to assess whether the narrower term is included within the broader term. In the Collins English Dictionary, clothing is defined as “something that covers or clothes”. To my mind, shoes are included within this definition as they perform the same function, albeit for a specific area of the body. With regards both the natural meaning of the word clothing and how these goods would be regarded for the purpose of the trade, to my mind, it is clear that shoes would be seen as constituting a type of clothing. Given that no restriction to the term “clothing” has been filed, and taking into account the guidance in the *Gerard Meric* decision, “clothing” (KS’s term) is identical to “shoes” (RAS’s term).

29. The same conclusion cannot be drawn in relation to the comparison between “headgear” (KS’s term) and “shoes”. However, to my mind, the overall purpose of each is similar, to cover or clothe, albeit applied to different parts of the body. To my mind, this makes the respective terms similar to at least a moderate degree.

Comparison of Classes 18 and 14

30. The parties have made a number of arguments in relation to both Class 14 and Class 18 of the application. I will sum these up simultaneously before going onto consider each of these classes as against shoes. RAS argue that most of its goods are sold as accessories to clothing and that the goods of the application are either clothing itself, or accessories. This is with the exception of clocks, however these are, it argues, closely related to watches (which are an accessory to clothing). My understanding of this argument is that if I find that watches are similar to shoes, because both are accessories to clothing, then this finding can also extend to clocks. RAS also argues that harness and saddlery which, it argues, are closely related to riding boots (though I note that its earlier specification does not include riding boots) and the services of the application are simply the retail services connected with the sale of those goods. It argues that all the goods of the application are worn by or adorn an individual (or are closely related to such goods); they may be sold in the same trade outlets as its earlier Class 25 goods and the end users of the respective products overlap. As such, the goods and services of the application are, it argues, complementary to those of the earlier mark.

31. KS argue that even if some of the goods in Class 14 and 18 are similar to clothing, it does not follow that they are also similar to footwear. In addition, many of the goods in Class 14 and 18 are not accessories to clothing. KS also argue that RAS has failed to show use of its mark on riding boots and that it has also failed to show how some of the Class 18 goods (trunks and travelling bags, rucksacks and umbrellas) are similar to shoes, nor how shoes are similar to precious metals and stones, watches or chronometric and horological instruments in Class 14.

In relation to Class 18, I bear in mind the guidance of the CFI in Case T-169/03 (*SISSI ROSSI*) and Case T-443/05 (*El Corte Inglés v OHIM*). The *SISSI ROSSI* judgment took account of the fact that the goods in question are often made from the same raw material, namely leather, and the fact that the goods may sometimes be sold in the same shops. However, though this fact was an indication of similarity, it did not cancel out differences between the goods. As a consequence, the court held that there was “slight” similarity between “women’s footwear” and “women’s bags”.

32. In relation to the issue of whether or not goods are complementary, I bear in mind the guidance in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (*OHIM*) Case T- 325/06, where the CFI stated:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

33. In *El Corte Ingles*, the court said that in making a comparison between Class 25 and Class 18 goods, a distinction must be drawn between different types of Class 18 goods:

“ 44 On the one hand, as regards the second group of goods in Class 18 (leather and imitations of leather, animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddler), the Board of Appeal rightly held that the distribution channels were different from those used for the distribution of goods in Class 25. The fact that these two categories of goods may be sold in the same commercial establishments, such as department stores or supermarkets, is not particularly significant since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin (see, to that effect, Case T-8/03 *El Corte Ingles v OHIM – Pucci (EMILIO PUCCI)* [2004] ECR II-4297, paragraph 43).

45 On the other hand, as regards the first group of goods in Class 18, namely leather and imitation leather goods not included in other classes such as, for example, handbags, purses or wallets, it should be noted that those goods are often sold with goods in Class 25 at points of sale in both major retail establishments and more specialised shops. This is a factor which must be taken into account in assessing the similarity of those goods.

46 It must be recalled that the Court has also confirmed the existence of a slight similarity between ‘ladies’ bags’ and ‘ladies’ shoes’ (*SISSI ROSSI*, paragraph 42 above, paragraph 68). That finding must be extended to the relationship between all the goods in Class 25 designated by the mark applied

for and the leather and imitation leather goods not included in other classes, in Class 18, designated by the earlier mark.

47 In light of the foregoing, it must be held that there is a slight similarity between the goods in Class 25 and the first group of goods in Class 18. Consequently, the Board of Appeal could not conclude that there was no likelihood of confusion on the part of the relevant public solely on the basis of a comparison of the goods concerned.

48 As to whether clothing, footwear and headgear in Class 25 are complementary to 'leather and imitations of leather, and goods made of these materials and not included in other classes' in Class 18, it must be recalled that, according to the case-law, goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods lies with the same undertaking (*SISSI ROSSI*, paragraph 42 above, paragraph 60).

49 Goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image ('look') of the consumer concerned.

50 The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in Class 25 and the various clothing accessories which complement them such as handbags in Class 18. Any such coordination depends on the consumer concerned, the type of activity for which that look is put together (work, sport or leisure in particular), or the marketing strategies of the businesses in the sector. Furthermore, the fact that the goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and strengthen the perception that the same undertaking is responsible for the production of those goods.

51 It is clear that some consumers may perceive a close connection between clothing, footwear and headgear in Class 25 and certain 'leather and imitations of leather, and goods made of these materials and not included in other classes' in Class 18 which are clothing accessories, and that they may therefore be led to believe that the same undertaking is responsible for the production of those goods. Therefore, the goods designated by the mark applied for in Class 25 show a degree of similarity with the clothing accessories included in 'leather and imitations of leather, and goods made of these materials and not included in other classes' in Class 18 which cannot be classified as slight."

34. The principle of the above judgment can be applied directly to this case. KS's Class 18 specification includes "leather and imitation leather goods" and "handbags

and purses". In accordance with the CFI judgment, the similarity between these goods and those in Class 25 (specifically shoes in these proceedings) cannot be described as merely slight. Though this was a comparison between the broader terms of clothing, footwear and headgear, I am satisfied that the same principle applies in relation to a comparison between these Class 18 goods and shoes in Class 25. I am, therefore, of the view that there is a moderate degree of similarity between them.

35. In relation to some of the other goods in the Class 18 specification (rucksacks, parasols etc) of KS, and, again, in applying the principles of this judgment, it seems to me that they are not similar to shoes as they are different in nature, purpose and method of use. They are also not in competition with shoes and there is no evidence of a complementary relationship in the manner described above. I am also not persuaded by RAS's argument that riding boots are similar to harness and saddlery. This, it seems to me, is stretching the realms of similarity and, in any case, RAS's earlier specification does not include riding boots. **I, therefore, conclude that "leather and imitations of leather goods, not included in other classes, handbags and purses" are moderately similar to shoes in Class 25. The remainder of the Class 18 specification is not similar.**

36. With regards to Class 14, it seems to me that the goods contained within the specification, can be split into two categories and as such, I must consider each category as against shoes. I will start with what I see as the first category, which I deem to be time keeping devices - chronometric and horological instruments, clocks and watches. RAS's line of argument, as I understand it, is that watches are an accessory to clothing, as are shoes, therefore watches are similar to shoes. Clocks are similar to watches and because watches are similar to shoes (in its view), this also makes clocks similar to shoes. I am not persuaded by these arguments. I accept that a watch is worn by an individual, as is clothing, which I have already found includes shoes. However, this does not in any way make them similar. All goods in this first category are therefore wholly different in nature, intended purpose and method of use. They are also not in competition with shoes, nor are they complimentary. They are, in conclusion, not similar.

37. This leaves me to consider a second category, which is the remainder of the Class 14 specification, namely "precious metals and their alloys and goods in precious metals or coated therewith; jewellery, precious stones and costume jewellery". There is no evidence that these goods may be sold in the same establishments as shoes (although the possibility cannot be ruled out). The broad purpose of many of these goods may be similar in the sense that both are worn by or adorn an individual. However, in my view, this analysis is too broad to necessitate a finding of similarity on this basis. I am mindful of the comments of the CFI in *El Corte Ingles* referred to above, where, at paragraph 44, the court said that the fact that these goods may be sold in the same commercial establishments (such as department stores and supermarkets) was not particularly significant as a wide variety of different types of goods can be found in such shops, without customers automatically believing they have the same origin. Though it is possible that items of jewellery may, on occasion, be chosen by an individual to wear with a specific outfit, this does not mean that these goods will be seen to be so closely connected that they would be seen as indispensable or important for the use of shoes. They would

not lead to a consumer automatically believing that the goods had the same origin. In addition, no evidence has been presented by RAS to support the argument that these are complementary goods, such as evidence of co-ordination at design stage or at point of sale. **I therefore, conclude that the Class 14 goods are not similar to shoes in Class 25.**

Comparison of Class 35

38. Bearing in mind my conclusions with regard to similarity of goods, I will only compare the retail services related to the sale of the corresponding goods which I have already found to be either identical (in the case of clothing) or moderately similar (with regard to headgear, leather and imitation leather goods, handbags and purses) with shoes.

39. In comparing firstly, shoes against retail services for clothing and headgear, I bear in mind the guidance of the CFI, who recently deliberated on this issue in T-116/06, *Oakley Inc. v. OHIM*. In this judgment, the CFI held that the nature, purpose and method of use of the goods and services in question were different. However, the sales outlets of the goods and services in question, were, generally the same:

“48. With regard, second, to the distribution channels of the services and the goods in question, it is correct, as rightly pointed out by the Board of Appeal in paragraph 22 of the contested decision, that retail services can be offered in the same places as those in which the goods in question are sold, as the applicant has also recognised. The Board of Appeal’s finding that retail services are rarely offered in places other than those where the goods are retailed and that consumers need not go to different places to obtain the retail service and the product they buy, must therefore be upheld.

49. Contrary to what is claimed by the applicant, the fact that the retail services are provided at the same sales points as the goods is a relevant criterion for the purposes of the examination of the similarity between the services and goods concerned ...”

40. The CFI also felt that the goods and services in question were complementary:

“52. ... according to settled case-law, complementary goods are those which are closely connected in the sense that one is indispensable or important for the use of the other, so that consumers may think that the same undertaking is responsible for both (see, to that effect, *SISSI ROSSI*, paragraph 49 above, paragraph 60; *PAM PLUVIAL*, paragraph 49 above, paragraph 94; and *PiraÑAM diseño original Juan Bolaños*, paragraph 49 above, paragraph 48).

53. In that regard, it must be pointed out that the goods covered by the earlier mark, that is, clothing, headwear, footwear, rucksacks, all purpose sports bags, travelling bags and wallets, are identical to those to which the applicant’s services relate.

54. Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bau- und Heimwerkermärkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.

55. Furthermore, the relationship between the goods covered by the earlier trade mark and the services provided in connection with retail trade in respect of goods identical to those covered by the earlier trade mark is also characterised by the fact that those services play, from the point of view of the relevant consumer, an important role when he comes to buy the goods offered for sale.

56. It follows that, because the services provided in connection with retail trade, which concern, as in the present case, goods identical to those covered by the earlier mark, are closely connected to those goods, the relationship between those services and those goods is complementary within the meaning of paragraphs 54 and 55 above.”

41. The conclusion reached was that the services and goods in question generally had the same sales outlets and were complementary. As a result, there was a degree of similarity between them. In these proceedings, the retail service in question will be in relation to goods which I have already found to be identical to those goods of the earlier mark. **I conclude, therefore, that there is some similarity between “shoes” and “retail services connected with the sale of clothing and headgear” and I assess the degree of this similarity as being moderate.**

42. I must also consider the situation with regards to the degree of similarity of a retail service connected to the sale of the Class 18 goods which I have already found to be moderately similar to the goods of the earlier mark. To my mind, the overall rationale of the judgment in *Oakley* still applies and what I must assess is the exact degree of similarity between “shoes” and “retail services connected with the sale of leather and imitations of leather goods not included in other classes, handbags and purses”. **On the basis of my earlier finding regarding the degree of similarity between the respective goods, I conclude that these services are similar to shoes. However, I assess the degree of similarity as being only a low degree.**

Comparison of the marks

43. It is a pre-requisite of an opposition based upon section 5(2)(a), that the marks are identical. The marks in these proceedings are clearly identical (the parties agree on this) so I need not say anything further.

Distinctiveness of the earlier mark(s)

44. The guidance in *Sabel BV v Puma AG* states 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.

45. The earlier mark in these proceedings is, in my view, highly unusual. It is not descriptive of the goods, nor is it in any way allusive. Though it is not an invented word (which traditionally leads to a finding of a high degree of distinctiveness), it is, to my mind, almost on a par with such a mark. It is so unusual, that I conclude that it has a high degree of distinctiveness.

46. What impact, if any, does the use made of the mark have on this assessment? Bearing in mind the comments I have already made in relation to the scale of use filed (although it was sufficient to show genuine use), the use filed has no impact on enhancing distinctive character. The mark is, in any event, highly distinctive per se.

Likelihood of confusion

47. I will conclude firstly, with regards to the Class 14 and 18 goods and Class 35 services that I have found to be dissimilar to the goods of the earlier mark. As I have already found that these goods and services are not similar to shoes, I do not need to consider confusion. The opposition therefore fails in this respect.

48. In relation to the similar goods and services, the case-law makes it clear that there is an interdependency between the relevant factors (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*) and that a global assessment of the factors must be made when determining whether there is a likelihood of confusion (*Sabel BV v. Puma AG*). I must, therefore, consider the relevant factors from the viewpoint of the average consumer to determine whether they are likely to be confused.

49. I will firstly consider the position with regard to those goods which I have found to be identical to shoes, namely clothing in Class 25. The respective trade marks are also clearly identical. In my view, this means that confusion, whether in mistaking one mark for another or assuming that they come from a single or economically linked undertaking, is not only likely, it is inevitable.

50. In relation to headgear in Class 25, the goods in Class 18, and the services in Class 35, I bear in mind that the marks are not only identical, but also highly distinctive. This is important because a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and services, and **vice versa** (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*) and there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character (*Sabel BV v Puma AG*). I have no doubt, given these factors, that the average consumer will believe the goods/services to be the responsibility of the same or an economically linked undertaking. I conclude, therefore, that there is a likelihood of confusion in relation to these goods and services. The opposition therefore, succeeds to this extent.

52. In conclusion, the opposition succeeds in respect of:

Class 18:

Leather and imitation leather goods, not included in other classes, handbags and purses.

Class 25:

Clothing, headgear

Class 35:

Retail services connected with the sale of leather and imitation leather goods, not included in other classes, handbags and purses, clothing, headgear.

However, it fails in respect of:

Class 14:

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; clocks and watches; costume jewellery.

Class 18:

Leather and imitations of leather; animal skins, hides; trunks and travelling bags; rucksacks, umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 35:

Retail services connected with the sale of precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes, jewellery, precious stones, horological and chronometric instruments, clocks and watches, costume jewellery, leather and imitations of leather, animal skins, hides, trunks and travelling bags, rucksacks, umbrellas, parasols and walking sticks, whips, harness and saddlery.

COSTS

53. Both parties have achieved a measure of success in these proceedings. I therefore direct that each party should bear its own costs.

Dated this 16th day of July 2009

**L White
For the Registrar
The Comptroller-General**