

O-284-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF International Registration 832107  
by Gilmar Spa to register  
a trade mark in Classes 18 and 25**

**IN THE MATTER OF Opposition No. 71407  
by Ice Clothing Co Ltd**

**Appeal of the Applicant from the decision of  
Mrs. Ann Corbett dated 11 January 2009**

---

**DECISION**

---

1. This is an appeal against a decision of Mrs Ann Corbett, the Hearing Officer for the Registrar, dated 12 January 2009, in which she upheld an opposition to the registration of the mark ICE B for goods in Class 25. The applicant was Gilmar Spa, ("the applicant") and the opponent Ice Clothing Co Ltd. ("the opponent").

**Background**

2. On 27 May 2004, the applicant sought protection of the mark ICE B pursuant to the Madrid Protocol by designating the UK in International trade mark registration 832107. It claimed priority on the basis of an Italian registration with a priority date of 5 May 2004. The specification of goods included leather goods in Class 18 and clothing, footwear and headgear in Class 25. The opposition related only to the Class 25 goods and was based on sub-section 5(4)(a) of the 1994 Act, as to which the opponent claimed earlier rights in two marks: ICE and ICE BABES.

3. Both sides filed substantial evidence. Neither sought a hearing, but their respective trade mark attorneys supplied Mrs Corbett with written submissions.

**The decision below**

4. In its Form TM7, the opponent relied on use of the mark ICE since 1996 and use of the mark ICE BABES since 2000, both on women's clothing. The applicant's counter-statement simply put the opponent to proof of its claims regarding those marks. The opponent filed substantial evidence of its use of its marks. However, the applicant's evidence in answer did not simply dispute the opponent's claim to goodwill but claimed that the applicant had been using the mark ICEBERG in the UK since 1982, together with several other related 'ICE' marks.
5. The opponent, in its written submissions to Mrs Corbett, objected to the applicant's apparent reliance on its marks, in the absence of any proper pleading as to the nature of its case. Mrs Corbett considered this objection as a preliminary point in paragraph 44 of her decision. She concluded that as the applicant raised its claim in its evidence, there was no real prejudice to the opponent. That part of her decision has not been challenged by the opponent.
6. Mrs Corbett analysed each party's evidence in detail and considered the usual authorities relating to sub-section 5(4)(a). No criticism is made of those parts of her decision. She also considered the question of the appropriate priority date, in accordance with section 35 and concluded that it should be the date of the Italian registration, 5 May 2004.

7. Mrs Corbett complained about the poor quality of the evidence produced by the applicant, some of which consisted of a copy of a witness statement made in other UKIPO proceedings. She commented that much of the material was unpaginated and undated and consisted of such poor photocopies that she could not see what they were intended to show. Her comments seem to me wholly justified on the basis of the copies provided to me. Doing the best she could, Mrs Corbett concluded at paragraph 53:

“...the evidence does not establish any use of the mark applied for, ICE B. Whilst amongst the invoices which have been filed there are isolated references to other marks such as HISTORY ICEBERG UOMO and HISTORY ICEBERG DONNA and amongst the advertising material there are, again isolated, generally undated references to ICE J, ICE ICE BABY BY ICEBERG and ICEBERG HISTORY, no other information is provided to establish the duration and extent of use of these marks. The evidence does not therefore show there was any protectable goodwill by reference to any of these marks at the relevant date.”

The applicant does not suggest that Mrs Corbett was wrong to conclude that the applicant had not made use of the mark ICE B at the relevant date (or at all)

8. The Hearing Officer went on to consider use of the applicant's mark ICEBERG which was said to have commenced in 1982. She analysed the advertising material provided, much of which was undated and some of which showed use of the mark ICE ICE ICEBERG from an unspecified date. She also considered the turnover figures provided. She concluded at paragraph 54:

“My strong impression is that ICEBERG has functioned as the core brand and provides a thematic link for the applicant's branding as a

whole. Given that the turnover figures referred to above represent aggregated figures for ICEBERG and ICE ICE ICEBERG, it is not possible to say what levels of consumer awareness exist in relation to the individual brands. In light of the fact that the evidence shows ICEBERG to be an almost constant feature of the applicant's branding, it is, I think, reasonable to suppose that an independent goodwill exists in this sign, reinforced by whatever use has been made of ICE ICE ICEBERG."

Whilst use of the mark was made from 1982 onwards, Mrs Corbett plainly had some doubts as to how far back any goodwill went, because so much of the material was undated. I do not think that it is clear from paragraph 54 when she thought the goodwill was first established, perhaps in 1998, that being the date for which the earliest turnover figures were provided.

9. She went on in paragraphs 55 to 59 to consider the applicant's marks SPORT ICE and ICE JEANS. She found that use of SPORT ICE was on a small-scale, took place mainly in 1992 and ceased in 1997; she found no evidence of any residual goodwill in the mark. She found no evidence of when use of the mark ICE JEANS commenced, but it was said to have replaced, and overlapped with, use of the mark SPORT ICE. She found that the evidence showed some use of the mark ICE JEANS but also of ICE JEANS ICEBERG, ICE JEANS by ICEBERG or ICEBERG ICE JEANS, consistently with the applicant's statement that it used a range of marks containing the word ICE "in conjunction with the word ICEBERG". She did not consider that she was able to tell whether the information provided to her related to "ICE JEANS solus or that sign in association with the ICEBERG housemark." At paragraph 58 she concluded:

"Although much of the use is of ICE JEANS in association with the housemark, the nature of that use, taken together with some

independent use of ICE JEANS is likely to mean that there is some recognition of that sign independently of the housemark.”

It is not clear to me whether or not Mrs Corbett meant, by “recognition” that she found that there was goodwill in ICE JEANS *solus*, but in any event she did not specify any date by which she considered that such goodwill had been established. She might well have had difficulty in doing so, given the evidence which she describes in her decision.

10. Mrs Corbett then went on to consider the opponent's evidence supporting its claim to goodwill in the marks ICE and ICE BABES. She found evidence of goodwill in ICE but not in ICE BABES as at the relevant date in 2004. No complaint was made by the applicant on the appeal as to her analysis of the evidence, save that it claimed that she was wrong to take the opponent's use of various different labels as use of ICE *solus* (see paragraph 32 below).
11. Mrs Corbett summarised her view of the evidence at paragraph 68.

“The position is, therefore, that by the relevant date the opponent had established goodwill in a business conducted under the sign ICE. I note also that the opponent sometimes uses its mark in repeated form (see e.g. use of ICE ICE ICE in exhibit SC1 and ICE ICE in exhibit SC4). The applicant, for its part, had longstanding use of ICEBERG, use of that mark with other elements to form ICE ICE ICEBERG and ICE JEANS ICEBERG/ICEBERG ICE JEANS and some standalone use of ICE JEANS.”
12. The Hearing Officer's findings as to the use of and goodwill in the various marks were, it seems to me, as follows:

<b>Mark</b>	<b>Proprietor</b>	<b>1<sup>st</sup> use claimed</b>	<b>Goodwill</b>
ICEBERG	Applicant	1982	Yes, but date unclear
SPORT ICE	Applicant	1992	No. Use ceased 1997, no residual goodwill
ICE	Opponent	1996	Yes. Use since 1996; goodwill in May 2004
ICE JEANS	Applicant	1998	Unclear.
ICE BABES	Opponent	2000	Not by relevant date

13. Having found those uses of the various marks, the Hearing Officer went on

“69. Given this state of affairs, it is perhaps somewhat surprising that conflict between the parties has not surfaced earlier. That may be due to the large size and fragmented nature of the clothing market, the relatively modest size of the parties within that market and the particular retail niches they occupy. The application to register ICE B is, of course, without restriction as to geographical coverage and is not constrained to the applicant’s past trading patterns and sales outlets. It represents, therefore, an extension of the applicant’s business into the “unclaimed middle ground”.

70. In relation to clothing, ICE is a very strong mark with no direct or allusive meaning in relation to the goods in issue. If the matter rested simply on a comparison of ICE and ICE B, I would have little hesitation in concluding that the latter would be regarded as a subbrand or development of the basic ICE mark. On that basis, a misrepresentation leading to damage would have been made out. The issue that I need to address here is whether a different conclusion should be reached in the circumstances of this case where the applicant can point to use of other “ICE” marks.”

14. Mrs Corbett then considered *Sir Robert McAlpine Ltd v Alfred McAlpine Plc* [2004] RPC 36, a case in which the two parties had common origins and an overlapping trade, their use of the name McAlpine was differentiated by the use of the respective forenames. The passing off action was “triggered by the defendant’s wish to re-brand itself by dropping, or significantly reducing the impact of, the name Alfred.” Mrs Corbett commented:

“72. This was a case involving what amounted to shared goodwill in the name McAlpine in circumstances where both parties would have had a cause of action against third parties based on use of the name. But it was held that the defendant was not entitled to trade under that name without the addition of some other distinguishing feature. I acknowledge that the facts of the case before me are somewhat different but the principle remains the same. In my view, if the applicant is allowed to register ICE B it will have encroached into the middle ground and misrepresented itself as being associated with the opponent.

73. The high point of the applicant’s case against this view of the matter is the fact that it has already traded under the sign ICE JEANS. Although the word JEANS has descriptive connotations, the picture that emerges from the evidence is that it is used on a variety of goods (see paragraph 59 above) and that even when used on trousers, the word is not always used in a more literal sense to indicate a product made from denim. In other words, JEANS is an integral part of the branding (again, see Jacob LJ’s observations in *Reed supra*) even though it lacks the distinctiveness of the word ICE. In the circumstances, I do not regard use of this mark as providing a basis for finding that the applicant is entitled to register ICE B. They are different marks.

74. I conclude that it is likely that confusion or deception would arise from the use by the applicant of the mark ICE B, as the consumer would be likely to believe that ICE B was a sub-brand of ICE. The confusion would divert trade from the opponent, potentially injure the opponent's reputation if there were any failings in the goods of the applicant and would cause the injury which is likely inherently to be suffered by any business when, on frequent occasions, it is confused by customers, or potential customers, with a business owned by another proprietor or is wrongly regarded as being connected with that business (*See Habib Bank Limited v Habib Bank Zurich* [1982] RPC 1).

75. The opposition based on section 5(4)(a) therefore succeeds and the application is to be refused in relation to the goods on which the opposition has been brought. The application therefore stands refused in respect of the specification of goods in class 25..."

### **Basis of the appeal**

15. The Grounds of Appeal challenged the decision on following grounds:

- (a) that Mrs Corbett was wrong to take the relevant date for assessing the opposition under sub-section 5(4)(a) as 5 May 2004: it should have been the date when the applicant commenced use of the mark ICE in 1992 or 1998;
- (b) that Mrs Corbett was wrong to dismiss the applicant's argument that the opponent did not have 'clean hands' to bring a passing off action and/or that the applicant would have been able to object to the opponent's use of the mark ICE;
- (c) that Mrs Corbett should have found that the applicant's use of the mark ICE JEANS was use of the mark ICE; and in contrast



- (d) that Mrs Corbett should have found that the opponent's use of the mark ICE CLOTHING was not use of the mark ICE alone.

### **Standard of review**

15. The standard of review for this appeal is helpfully set out at paragraphs 5-6 of the decision of Daniel Alexander QC in *Digipos Store Solutions Group Limited v. Digi International Inc* [2008] RPC 24:

"5... It is clear from *Reef Trade Mark* [2003] RPC 5 ("*Reef*") and *BUD Trade Mark* [2003] RPC 25 ("*BUD*") that neither surprise at a Hearing Officer's conclusion nor a belief that he has reached the wrong decision suffice to justify interference by this court. Before that is warranted, it is necessary for this court to be satisfied that there is a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong (*Reef*). As Robert Walker LJ (as he then was) said:

*"...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle"* (*Reef*, para. 28)

6. This was reinforced in *BUD*, where the Court of Appeal made it clear that it preferred the approach of the appellate judge but nonetheless held that there was no error of principle justifying departure from the Hearing Officer's decision. As Lord Hoffmann said in *Biogen v. Medeva* [1997] RPC 1 at 45, appellate review of nuanced assessments requires an appellate court to be very cautious in differing from a judge's evaluation. In the context of appeals from the Registrar relating to section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average

consumer or giving too much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference.”

The decision with regard to each of the issues in this case involved a multi-factorial assessment of the kind mentioned above.

### **What was the relevant date?**

16. The applicant's first Ground of Appeal was that to assess whether the opponent was in a position to object to the registration of the ICE B mark, one has to look at the date of commencement of the 'objectionable' behaviour by the applicant. The relevant behaviour, according to the applicant's argument on the appeal, was *its* use of the mark ICE, and it claimed that such use dated from its use of the mark SPORT ICE from 1992 or of ICE JEANS from 1998. I note that the argument was not put in those terms to the Hearing Officer; instead, the applicant's submissions to Mrs Corbett dealt with the issue in the manner discussed in paragraph 19 below.
  
17. The applicant referred me to a decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Croom's Trade Mark Application* [2005] R.P.C. 2; in considering an opposition based upon subsection 5(4)(a), he said:

“45.I understand the correct approach to be as follows. When rival claims are raised with regard to the right to use a trade mark, the rights of the rival claimants fall to be resolved on the basis that within the area of conflict:

  - (a) the senior user prevails over the junior user;
  - (b) the junior user cannot deny the senior user's rights;
  - (c) the senior user can challenge the junior user unless and until is it inequitable for him to do so.

46 The statutory provisions carried forward into ss.7, 11 and 12 of the Trade Marks Act 1938 reflected these principles: see CLUB EUROPE Trade Mark [2000] R.P.C. 329 at pp.342 to 344. The principles themselves are, in my view, deducible from:

- (a) the right to protection conferred upon senior users at common law ...
- (b) the common law rule that the legitimacy of the junior user's use of the mark in issue must normally be determined as of the date of its inception ... and
- (c) the potential for co-existence to be permitted in accordance with equitable principles ..."

In addition I was referred to the *Pub Squash* decision [1981] R.P.C. 429 (also cited by Mr Hobbs in *Croom*), a decision of the Supreme Court of New South Wales, which held that the relevant date for determining whether a party has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of.

18. In my judgment, the Hearing Officer was right to find that in this case the 'conduct complained of' by the opponent was not the applicant's use of the mark ICE, whether as SPORT ICE or ICE JEANS or otherwise, but its application to register the mark ICE B. There was no use of that mark prior to the application date or the slightly earlier priority date of the Italian registration. As a result, the decision which the Hearing Officer had to make was whether the opponent would have succeeded if it had brought a passing off action against the applicant's use of ICE B on the priority date. The complaint made by the applicant in paragraph 1 of its Grounds of Appeal is unjustified.

19. The applicant also argued on the appeal that if both parties were making use of the mark ICE, the opponent was the later user and so was not a position to object to the applicant's request to register the mark ICE B by claiming that it owned the exclusive rights in the mark ICE. This argument seems to me to rely upon the 'objectionable conduct' being the opponent's first use of the ICE mark in 1996, not the applicant's use of it in 1992. Indeed, that was how the applicant put the argument to the Hearing Officer in its written submissions dated 21 October 2008.
  
20. The question was, therefore, whether the evidence established that the applicant could have stopped the opponent's use of the mark ICE in 1996. The applicant's attorney accepted that the question the Hearing Officer posed in paragraph 70 was the right one, and it does not seem to me that the applicant identified any material error or error of principle in her answer to it. Mrs Corbett's analysis of the applicant's evidence did not support the applicant's claim to goodwill in the mark 'ICE' *solus* or in the form SPORT ICE in 1996. Certainly she made no finding to that effect. It is not clear to me whether the applicant seeks to challenge her findings in that respect, but in any event it seems to me that Mrs Corbett's findings were consistent with the evidence and with authority.
  
21. For all these reasons, it does not seem to me that the applicant proved that it was the senior user of the ICE mark, even if it were appropriate to consider that issue. I reject the first Ground of Appeal.

**'Clean hands'**

22. In addition to those arguments, which it seems to me were foreshadowed in the witness statements filed by the applicant, if not in its counter-statement, the applicant submitted to the Hearing Officer that at all times, both before and after 5 May 2004, it would have been entitled to bring

passing off proceedings to stop the opponent from using the ICE mark. That argument was presented to the Hearing Officer in the applicant's written submissions in October 2008 under the heading 'Clean Hands' and equally appears in paragraph 2 of the Grounds of Appeal under the same heading. So far as I am aware, no notice whatsoever had been given to the opponent that the applicant intended to argue this point in this way (as opposed to claiming its own prior rights). Certainly, the point was not anticipated in the very detailed written submissions produced on behalf of the opponent and filed on 22 October 2008.

23. The applicant's written submissions to the Hearing Officer said not only that it could have prevented the opponent from using its ICE mark, (contrary to the Hearing Officer's findings) but also that the opponent could not rely on any rights acquired by use of its ICE mark, as it "would not come to a passing off action with 'clean hands' and so would not succeed." The latter part of that argument was dealt with in a passage in paragraphs 65 and 66 of the Hearing Officer's decision:

"65. ...The applicant argues that the opposition should be rejected as the opponent has not come to this passing off action with "clean hands". It says this because it claims, essentially, that at the date the opponent began to use its marks, the applicant had already accrued rights in the mark ICE because of the commonality of that word within its own marks which would have prevented the opponents from using the word as a mark itself.

66. As the applicant has not shown it has used the mark applied for prior to the filing date, this claim must be taken to be based on the marks ICEBERG and SPORT ICE, these being the only marks which it had used at the time the opponent commenced use of ICE. The issue as to whether the applicant would have been entitled to restrain the opponent's use at that time based on the applicant's

rights in the business conducted under these signs, is a matter that is beyond the scope of this action.”

24. In paragraph 2 of the Grounds of Appeal, again under the heading ‘Clean Hands’ the applicant complained that the issue identified by the Hearing Officer was indeed relevant to the opposition. It seems to me that as the Hearing Officer had permitted the applicant to rely on the evidence of its use of various ICE marks prior to 5 May 2004, the question of which of the parties might have been able to restrain the other from using such marks was indeed a relevant one. That depended upon the analysis of which of them was the senior user of the various marks. In my view the Hearing Officer did carry out that analysis and did decide that issue, despite the comment she made in paragraph 66.
25. However, it seems to me that it is a very different matter to suggest that the opponent would have been barred from bringing a passing off action in 2004 because it did not come to it with clean hands. The basis for making that allegation appears to have been only that the applicant considered that the opponent's use of the mark ICE amounted to a misrepresentation that the goods concerned were connected in the course of trade with the applicant. There was no evidence to that effect, or of actual confusion, only the applicant's evidence as to its own use of its ICE marks. The applicant did not allege that the opponent had been aware of any of its trade marks, still less that it had chosen its own marks knowing or intending that they would make such a misrepresentation.
26. It seems to me that it was wholly inappropriate for an argument in those terms to be raised in this way before the Hearing Officer. It was not foreshadowed in any way in the counter-statement or in the evidence filed on behalf of the applicant. To suggest that someone should be denied

relief because they do not have clean hands is in my view to suggest that they are acting dishonestly or in bad faith. Such allegations are of a serious nature and must be pleaded and properly particularised (see e.g. *ROYAL ENFIELD Trade Marks* [2002] R.P.C. 24). Here, the argument was raised for the first time in the applicant's written submissions to the Hearing Officer. For that reason alone, it seems to me that this allegation should have been rejected outright by the Hearing Officer.

27. Furthermore, it is not clear to me (in the absence of a proper statement of case) whether the applicant has in mind the equitable rule that to seek equitable relief one must come to court with clean hands, or the related common law principle of *ex turpi causa*, that the court will not assist a claimant to recover compensation for the consequences of his own illegal conduct. The application of these principles in trade mark/passing off cases was considered by the Court of Appeal in *Inter Lotto (UK) Ltd v Camelot Group Plc* [2004] R.P.C. 9, whose comments are I think consistent with the very recent decision of the House of Lords in *Stone & Rolls Ltd v Moore Stephens* [2009] UKHL 39, [2009] 3 W.L.R. 455. At §33 the Court of Appeal said:

“The starting point is criminal illegality, or (possibly) “other reprehensible or grossly immoral conduct” (*Ibid.* , para.1.14; the Law Commission could only find one case, in the nineteenth century, where the principle had been successfully invoked in relation to conduct which was not also criminal). As the judge observed (para. [44]), there is some precedent for its application in the context of trade mark and passing off, where there has been misrepresentation amounting to “a fraud on the public.” “

28. Whichever doctrine the applicant was seeking to invoke, it did not produce any evidence of dishonesty, bad faith or any other reprehensible conduct on the part of the opponent. Even if there had been a misrepresentation by the opponent, there was nothing to show that this was deliberate, so as to mean that it did not have 'clean hands.' It seems to me that there is nothing in the evidence to show that this was anything but a genuine case of honest concurrent use by both parties of their various 'ICE' marks, in which each may have established an independent goodwill, in ignorance of the other.
29. Mrs Corbett referred in paragraph 66 to the decision of Pumfrey J in the *Merc* case [2001] R.P.C. 42 as showing that the applicant might have lost the right to object to the opponent's use of the ICE due to the latter's lengthy concurrent use of it. She was criticised by the applicant in paragraph 3 of the Grounds of Appeal for this; it was said that she should not have rejected the 'clean hands' argument on this basis. I agree with the applicant that the facts at issue in *Merc* were very different to the present facts, but I do not think that, in the circumstances, this is a reason to disturb Mrs Corbett's central findings in paragraph 68 as to the parties' respective rights at the relevant date. Moreover, for the reasons I have given above, it seems to me that Mrs Corbett was right to reject the applicant's 'clean hands' argument. I reject the appeal in so far as it is based on that argument.

### **Findings on ICE JEANS**

30. Paragraph 4 of the Grounds of Appeal complains that Mrs Corbett should have found that the applicant's use of the mark ICE JEANS amounted 'essentially' to use of the mark ICE. At paragraph 70 (set out above) her concern was whether her conclusion that ICE B should be refused registration was affected by the applicant's use of other 'ICE' marks. Mrs



Corbett held, in paragraph 73 of her decision, that she did not regard its use of ICE JEANS as entitling the applicant to register ICE B, as 'jeans' was an integral part of the branding.

31. I see no material error or error of principle in this part of Mrs Corbett's decision and would reject the appeal on this point.

**Findings on ICE CLOTHING**

32. Lastly, the applicant said that the Hearing Officer erred in treating the opponent's mark as ICE, not ICE CLOTHING. It seems to me that it was plainly open to the Hearing Officer to reach that conclusion on the evidence, and she made no error reviewable on appeal in that respect. The appeal fails on this basis also.

33. For all those reasons, I dismiss the appeal. The opponent took no part in the appeal and I therefore make no order as to the costs of the appeal. The costs order made by the Hearing Officer will stand, and take effect 7 days after this judgment.

Amanda Michaels  
16 September 2009

The applicant (appellant) was represented by Ms Kate Széll of Messrs Venner Shipley LLP.

The opponent did not appear and was not represented.