

O-086-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION 2557532 IN THE NAME
OF GRENSON LTD IN RESPECT OF THE FOLLOWING TRADE MARK IN
CLASSES 25 & 35:**

WILLIAM GREEN

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO UNDER
NO 84205 BY EDWARD GREEN & COMPANY**

THE BACKGROUND AND THE PLEADINGS

1) Grenson Limited (“Grenson”) filed the trade mark **WILLIAM GREEN** on 31 August 2010. It was published in the Trade Marks Journal (for opposition purposes) on 24 September 2010 and it completed its registration procedure on 31 December 2010. It is registered for the following goods and services:

Class 25: Articles of clothing, footwear and headgear; parts and accessories for shoes and footwear included in class 25.

Class 35: Retail services in connection with the sale of footwear, clothing and headgear.

2) Edward Green & Company (“Edward”) seeks a declaration that the above trade mark is invalid. Its grounds for doing so are based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). A ground under section 3(6) of the Act was also initially pleaded, but this was subsequently dropped. Edward relies on the following marks/signs:

Community Trade Mark (“CTM”) registration 5708656 which was filed on 22 February 2007 and which completed its registration procedure on 30 January 2008. The mark and the goods for which it is registered are:

EDWARD GREEN

Class 25: Footwear; belts

A sign corresponding to the above trade mark is relied upon under section 5(4)(a) of the Act on account of its claimed first use (in relation to footwear and the retailing thereof) in Northampton in the year 1890.

CTM registration 6991129 which was filed on 16 June 2008 and which completed its registration procedure on 16 January 2009. The mark and the goods for which it is registered are :

E D W A R D G R E E N

Class 25: Footwear; belts

3) It is not in dispute that both of Edward’s marks constitute earlier marks as defined by section 6 of the Act. Nor is it in dispute that the earlier marks are free from the requirement to prove that genuine use has been made of them; they may, consequently, be relied upon for their specifications as registered.

4) Grenson filed a counterstatement denying the grounds of invalidity. Both sides filed evidence and written submissions. Neither side requested a hearing.


THE EVIDENCE

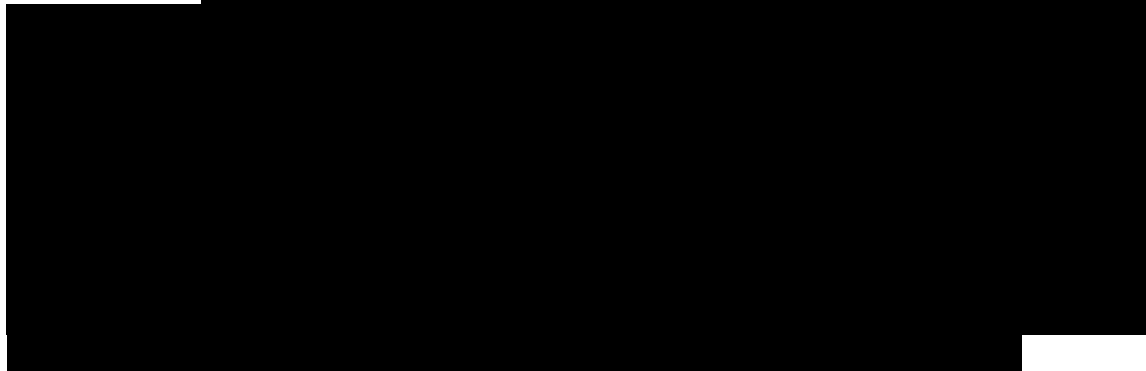
Edward's evidence

Witness statement of Hilary Freeman dated 4 June 2012

5) Ms Freeman is a director of Edward. She states that the EDWARD GREEN mark has been used in respect of high quality men's shoes since 1890; the business was founded by the shoemaker of the same name. Edward is based in Northampton which Ms Freeman states has a long and illustrious reputation for shoe making (names of other shoe makers in Northampton are given). It is explained that Mr John Hlustik (Ms Freeman's late partner) purchased the business in 1982 from a previous owner who had incurred large debts. Mr Hlustik began designing shoes using the EDWARD GREEN mark from then. Further information is provided about Mr Hlustik and how he developed the business; this includes the introduction of "antiquing" and making "brown shoes acceptable". In May 1994 Edward was formed to administer and run the business.

6) Ms Freeman explains that the shoes Edward makes are of a high quality and are hand crafted. Given this, Edward's sales strategy is to target exclusive retailers in premium locations combined with sales in a few department stores. Edward has a store in Jermyn Street London and another in Paris; it is not possible to ascertain from the evidence how long these stores have been open. Photographs of the stores are provided which prominently display the words EDWARD GREEN on the store front. Ms Freeman states that sales are made elsewhere in the UK (and internationally). Exhibit HF4 contains invoices issued by Edward between 2007 and 2012. The invoices are to: Kurt Geiger (London), Amand Shoes (Leicester), Edwards of Manchester (Manchester), Trunk Clothiers (London), Welsey Richards & Co (Birmingham) and Spencer Hart (London). The same exhibit also contains an extract from the website www.europe-re.com which discusses the opening of a new Kurt Geiger store in London and that Edward Green is one of the luxury shoe brands it will carry.

7) Exhibit HF5 has been granted confidentiality with regards to the general public. The following information is therefore redacted from the public version of this decision. 



8) Exhibit HF6 contains various examples of press coverage, as follows:

- A *Daily Telegraph* article dated 23 September 2011 [after the date of application for registration of Grenson's trade mark]. The article is about English shoemakers and lists Edward Green as one of the "small but healthy crowd of firms". The article focuses mainly on the largest shoemaker, Church's Shoes.
- A *Financial Times* article dated 2 December 2011 [after the date of application for registration of Grenson's trade mark]. The article is entitled "Power dressing: Hugh Delvin". Mr Delvin is a partner in a law firm and the article is about his clothing choices. His shoes are "by Edward Green", Mr Delvin explains that he got into bespoke footwear at the age of 40.
- An article from *The Observer* dated 30 November 2008. The article encourages readers to "buy British". On the second page of the article is information about shoes. It states that for "...a fine pair of homegrown shoes try Northampton"; a list of eight factories is then provided which includes Edward Green. More specific detail is then provided about Church's Shoes.
- A *Sunday Times* article dated 11 March 2007. The article is entitled "Head over Heals". It is a long article which, on page 4, refers to Church's shoes and other manufacturers in Northampton, including Edward Green.
- An article in *The Mail on Sunday* dated 23 February 2003. The article is entitled "Sole Survivors; The Third Of A Three-Part Series On Made-To-Measure Clothes". The article is about handmade shoes. At the end of the article is a list of the "Top six Cobblers", of which Edward Green is one.
- An article from *The Observer* dated 15 May 1994. The article is entitled "There is only one problem with shoes: walking in them". The article is about fashion shoes being uncomfortable; the writer emphasises that she does not mean "classic bespoke works by companies such as Edward Green".
- A *Daily Telegraph* article dated 30 September 2011 [after the date of application for registration of Grenson's trade mark]. The article is entitled "Anglomania is alive and well in one corner of Paris; Old England Men cyclopedia". The article is about a part of Paris that has an English-centric feel and which includes a clothes shop which, downstairs, has a shoe department selling Edward Green [and Church's].
- An article in *GQ Magazine* dated March 2007. The article is, essentially, about the Edward Green brand. There is a reference to the writer of the

article when buying his “last pair of Green’s”. It states that work goes into the shoes rather than their promotion.

- An article in *GQ Magazine* dated January 2012 [after the date of application for registration of Grenson’s trade mark]. This is, again, essentially about Edward Green shoes (or more specifically in this case boots). Edward Green is identified as one of our most celebrated shoemakers. The boots on show cost £880.
- A *Financial Times* article dated 15 November 2011 [after the date of application for registration of Grenson’s trade mark] in the “how to spend it” section. It lists a pair of Edward Green shoes which cost £775.
- An extract from a publication called *The Monocole* entitled “100 Favourite Things”. The date of this extract is not clear. It shows a collection of clothes as a way of selecting a “men’s classic simple look”. The shoes on show are “by Edward Green”.
- A similar article from an unknown and undated publication. It shows 31 products for men, one of which is identified as “Shoes by Edward Green”.
- An article from the *Carmarthen Journal* dated 4 January 2012 [after the date of application for registration of Grenson’s trade mark]. The article is about a student who won an international award for embroidery skills. The prize was the “Edward Green prize”. The article explains that Edward Green is a specialist supplier of mainly hand-crafted shoes, based in London and Paris. Further information about this prize is provided in Exhibit 7.

9) Advertising and marketing expenditure figures are provided. The figures range from around £15,000 at its lowest (in 1998) to £71,000 at its highest (in 2009). The latest figure was £55,717, for the year 2011.

10) Ms Freeman highlights the use of the word “Green” or “Green’s” in the *GQ* article. She believes that this happens because of Edward’s reputation and also because consumers will use the surname alone, as is done with other luxury goods (Dior, Versace, Armani etc). She considers that this increases the likelihood of confusion.

11) Ms Freeman refers to a letter in Exhibit HF8 which is to a retailer in the US which Edward previously supplied. Edward learned that this retailer was to sell shoes made by Grenson under the WILLIAM GREEN mark. A cease and desist letter was sent as Edward considered that such use would infringe its EDWARD GREEN mark. The letter exhibited is a follow-up cease and desist letter relating to potential sales by the retailer in question of the brand STUART’S CHOICE

which was to be indicated as having been manufactured by William Green; this is also claimed to be an infringement.

12) Exhibit 9 contains an invoice sent to Edward by a company called Horween Leather Company. It should have been sent to Grenson; the invoice was made out to William Green and Son's Limited but delivered to Edward. Ms Freeman believes this to be an actual example of confusion.

13) Exhibit 10 contains a number of extracts from a message board (possibly a US orientated one but this is not clear). The topic relates to an item for sale on eBay.com which apparently states that the shoes for sale in an eBay auction are made by Grenson whilst at the same time saying that they are by Edward Green. This is said to illustrate the potential for confusion which will be exasperated by the use of WILLIAM GREEN. There are references by some of the users to "Green's" (a reference to Edward Green shoes) which Ms Freeman highlights. Also highlighted is a comment by a poster in which it is expressed that they cannot see why an association with Grenson is being made if they could claim an association with the higher provenance of Edward Green. This is said to illustrate that Edward's goods could be damaged by an association with lower quality goods from Grenson.

14) Ms Freeman gives her understanding of the position regarding Grenson's WILLIAM GREEN mark. She believes Grenson to have been founded in 1866 under the name William Green & Son. It was then subsequently called Green & Son and eventually shortened to Grenson. The Grenson business has been using Grenson for several years and only recently has it shown an interest in using William Green due, Ms Freeman believes, to the success of Edward Green. She believes the intention was to take unfair advantage of Edward's reputation.

Grenson's evidence

Witness statement of Sylvie Tate dated 6 August 2012

15) Ms Tate is a trade mark attorney at Groom Wilkes & Wright LLP. I will summarise her evidence with reference to the four exhibits she provides:

- Exhibit ST1 are pages from Grenson's website. The mark GRENSON is used prominently. The prints depict numerous men's shoes. The prices range from £180 - £445. Information about Grenson is contained on the website including that it has been a shoemaker since 1866 with a factory in the heart of Northamptonshire. They sell in stores such as Harrods and Harvey Nicholls. Grenson was started by Mr William Green.
- Exhibit ST2 are prints from the BT London Telephone Directory showing 173 people with the surname Green.

- Exhibit ST3 contains i) an extract from the IPO Work Manual in relation to the IPO's practice for GREEN trade marks; the guidance focuses on the eco message of the word GREEN and ii) a further extract relating to the IPO's surname practice – the highlighted part relates to an objection (on distinctiveness grounds) being appropriate if numerous undertakings trade in the same field and, thus, the surname would not designate a particular undertaking – the practice also stresses that if the surname has another meaning which is also descriptive then an objection may be taken on such grounds.
- Exhibit ST4 – A Marquesa report showing registered trade marks which include goods in Class 25 with the word GREEN in them. There are 19 in total, some are CTMs. A number use the word Green as a surname but a number use it in different contexts (e.g. colour/eco friendly messages).

Edward's reply evidence

Witness statement of Ms Hilary Freeman dated 8 October 2012

16) This is the same Ms Freeman who gave evidence earlier. She states that the intention of the invalidation application was to prevent the registration and use of the WILLIAM GREEN mark on shoes. The invalidation is, though, made against all of the goods and services sought to be registered by Grenson and this remains the case. Ms Freeman stresses that Edward does not itself wish to use the name WILLIAM GREEN. Ms Freeman refers, again, to consumers identifying Edward Green shoes with the name Green. She states that this has also become apparent beyond the UK, most notably in France. Exhibit HF1 contains an article from a French magazine called Pointure dated Autumn/Winter 2012 [after the date of application for registration of Grenson's trade mark]. The article is headed "GREEN (Edward)". The article is in French. There is a reference in it to E. Green.

Witness statement of Robert James Seemarks dated 8 October 2012

17) Mr Seemarks has over 46 years in the shoe making business. Between 1970 and 1976 he was in the employ of Grenson as a factory manager. He states that Grenson has been producing shoes for over 100 years and that during his employment with it and for as long as he has known of the business, it has only ever traded under the GRENSON name. Mr Seemark recounts his recollection of a discussion he once had (in 1973) with the son of Edward Green who apparently remarked "Yes, we [Edward] make the samples and you [Grenson] make the bulk". Mr Seemarks believes that this was a reference to Mr Green's view that Edward's goods were of a better quality than the mass produced items of Grenson.

18) Mr Seemarks states that he has known of the Edward Green brand for all of his adult life because he has an interest in men's footwear; he adds that Edward has been the only company using EDWARD GREEN or a similar brand including the word "green" for the manufacture of high-end shoes in the UK. He completes his evidence by stating that whilst Grenson make quality, similar classic shoes [to Edward], the material and extra details of the Edward Green product are of a higher quality and craft.

SECTION 5(3) OF THE ACT

19) Section 5(3)¹ of the Act reads:

"5-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

20) In order to succeed under this ground the earlier mark must have a reputation. In *General Motors Corp v Yplon SA (Chevy)* [2000] RPC 572 the CJEU stated:

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

21) The earlier marks are CTM's and, so, the reputation must be in the Community. The goods covered by the earlier mark(s) are "footwear; belts". The public concerned with such goods is the general public. There is no evidence in relation to them so Edward cannot claim a reputation in relation to them. There is evidence in relation to shoes. It is clear from the evidence that the shoes Edward produces are high end, luxury goods. It specifically targets this market. The cost of the shoes is, relatively speaking, extremely high. Therefore, £2 million worth of sales does not equate to a lot of shoes. If all of the shoes cost £775 (as per the shoes shown in the evidence) then this equates to unit sales of just 2580 pairs. Edward's own evidence is that they market its shoes subtly. The figures expended on promotion and marketing are low. One of the GQ articles refers to Edward's work going into its shoes and not into promotion. The press coverage must, though, be factored in. However, whilst Edward Green shoes are mentioned in the articles, it is often no more than a fleeting reference which could

¹ Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946).

be lost in the body of the article. Also, a good many of the articles stem from after the date of application for registration of Grenson's trade mark, diluting further any impact the articles may have had on the relevant public. The GQ articles focus on Edward Green, one of which dates from before the relevant date. This, though, is just one article. The CJEU went on to state in *Chevy*:

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

22) The above is not a prescriptive formula but nevertheless provides appropriate guidance. Although the mark may have a longstanding period of use, its evidence falls short on the basis of (inferred) market share, intensity and promotional investment. In terms of geographical extent, whilst there is evidence that goods have been sold in a number of places in the UK (and in Paris), it is not particularly significant and the number of physical outlets appears to be low. I come to the conclusion that the EDWARD GREEN mark has not been used sufficiently so as to be known by a significant part of the public concerned with the goods. Whilst some brands that operate in the luxury market have expanded out in terms of knowledge (such a Versace, Louis Vuitton etc), the evidence does not persuade me that this is the case here. In making this assessment I have focused more on the facts and figures relating to the UK use (which Edward accepts is of primary significance). There is even less evidence in relation to Community use outside the UK. The mark does not have a reputation be it in the UK or in the EU as a whole. **The mark does not possess the requisite reputation and, therefore, the opposition under section 5(3) of the Act is dismissed.**

SECTION 5(2)(b) OF THE ACT

23) Section 5(2)(b) of the Act reads:

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

(a)

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

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

24) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

25) As the conflict involves trade marks incorporating names, it is useful to bear in mind what the CJEU stated in *Harman International Industries, Inc v OHIM* (C-51/09 P) ("*Harman*"):

"34. However, in paragraphs 30 and 31 of *Medion*, the Court held that, beyond the usual case where the average consumer perceives a mark as a whole, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element. In such a case, the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue come, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

35. In the present case, having repeated all of the rules set out in paragraphs 30 to 33 of this judgment, the General Court held essentially, in its assessment of the conceptual similarity of the marks at issue, first, that, as consumers in part of the European Union generally attribute greater distinctiveness to the surname than to the forename in word signs, the component 'Becker' in the mark applied for was likely to have attributed to it a stronger distinctive character than the component 'Barbara'; second, that the fact that Ms Becker is famous in Germany had no effect on the similarity of the marks at issue since they refer to the same surname and the component 'Barbara' is merely a forename and, third, that the component 'Becker' retained an independent distinctive role in the composite mark because it would be perceived as a surname.

36. Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than

forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname 'Becker' which the Board of Appeal noted is common.

37. Account must also be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known, since that factor may obviously influence the perception of the mark by the relevant public.

38. Furthermore, it must be held that, in a composite mark, a surname does not retain an independent distinctive role in every case solely because it will be perceived as a surname. The finding with respect to such a role may be based only on an examination of all the relevant factors of each case.

39. Moreover, as the Advocate General pointed out in essence, in point 59 of his Opinion, the grounds relied on by the General Court in order to conclude that the marks at issue are conceptually similar, if they were held to be consistent with Article 8(1)(b) of Regulation No 40/94, would result in acknowledging that any surname which constitutes an earlier mark could be effectively relied on to oppose registration of a mark composed of a first name and that surname, even though, for example, the surname was common or the addition of the first name would have an effect, from a conceptual point of view, on the perception by the relevant public of the composite mark.”

The average consumer

26) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is involved (see, for example, the judgment of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

27) The conflict involves clothing/footwear/headwear products and the retailing thereof. Such goods/services are “consumed” by members of the general public. The goods may be tried on and are likely to be inspected for colour, size, style etc. All of this increases the potential exposure to the trade mark. That being said, the purchase of clothing is unlikely to be a highly considered process as it is purchased relatively frequently and, although cost can vary, it is not, generally speaking, a highly expensive purchase. In its submissions Grenson refers to the luxury nature of the goods and that the purchase will be highly and carefully considered. The argument is that this will assist to militate against confusion.

However, this is not the correct approach because Edward's earlier mark is not confined to luxury goods. The analysis must be based on the inherent characteristics of the goods and not the current marketing strategies of the parties². I consider the purchasing process to be a normal, reasonably considered one, no higher or lower than the norm. This also applies to the services sought to be registered by Grenson.

28) In terms of how the goods will be selected, clothing will normally be self-selected from a clothing rail or shelf (or the online equivalents) or perhaps chosen from catalogues/brochures. This suggests a process of visual selection, a view which has been expressed in previous cases³; aural similarity will not, however, be completely ignored from the analysis. The same applies to footwear, even though a sales assistant may be present, the consumer will normally hand a self-selected shoe to the assistant in order for the correct size to be tried on.

The distinctiveness of the earlier mark

29) The degree of distinctiveness of the earlier mark(s) must be assessed. This is because the more distinctive the earlier mark(s) (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). I have already commented on the reputation of the earlier mark. For similar reasons to those already expressed, I do not consider that the earlier marks' distinctive character has been enhanced to any material extent through their use.

30) In terms of the marks' inherent characteristics, they consist, essentially, of the full name EDWARD GREEN. I think I can take it on judicial notice that names are popular trade marks, often being based on the founder of the company responsible for the goods. Indeed, this seems to be the case with both the earlier marks and the trade mark of Grenson. Neither the forename EDWARD nor the surname GREEN are unusual names. They strike me as being common names. Whilst Edward does not claim that the surname GREEN is unusual, it argues that it is not as common as a surname such as Smith. This may be so, but I still regard it as a fairly common surname. There is evidence from the London telephone directory in relation to the surname Green to support this view. Even though the total number of Green's in the London telephone directory would not, as Edward argues, amount to a large proportion of the population of London, this does not account for those Greens who are not listed in the telephone directory and for multiple Greens who live in the same premises. I agree with Edward, though, that the evidence of other GREEN marks on the register has little weight because state of the register evidence is rarely significant, it is what is happening

² See, for example, *NHL Enterprises BV v Office for Harmonization in the Internal Market(Trade Marks and Designs)* (OHIM) Case T-414/05

³ See, e.g. *New Look Ltd v OHIM* – Joined cases T-117/03 to T-119/03 and T-171/03 (GC)

in the market place that is of significance. The fact that there may be no other Greens using that surname in the footwear field does not displace the commonness of the name – in any event, the only evidence that this is the case comes from Mr Seemarks’ evidence which is, of course, just one person’s knowledge, knowledge based squarely in relation to the particular (high end) market. **My view is that the trade mark EDWARD GREEN has no more than an average level of inherent distinctive character.**

Comparison of goods/services

31) When making the comparison, all relevant factors relating to the goods/services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

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

32) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

33) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“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).”

34) In relation to understanding what terms used in specifications mean/cover, the case-law informs 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”⁴ and that 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 meaning⁵.

35) The earlier marks cover footwear and belts. Consequently, the footwear of Grenson’s registration is identical. Furthermore, I consider that “parts and accessories for shoes and footwear” are highly similar to footwear given the key complementary relationship between them, the likely similarity in terms of trade channels, and that they have the same users and similar end purpose.

36) In relation to Grenson’s “clothing”, strictly speaking, such a term is broad enough to include footwear within its ambit and, therefore, identical goods are still in play. In so far as other types of clothing are concerned, they are still similar (or identical in the case of belts) as all clothes are to be worn by the user, and may be sold though the same retail environments.

37) That leaves Grenson’s:

“Retail services in connection with the sale of footwear, clothing and headgear.”

⁴ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

⁵ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

38) The retail of specific goods can create a very close link to the goods themselves, on account of the complementary relationship between them, as per the GC's judgment in *Oakley, Inc v OHIM*, Case T-116/06:

“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 Bauund 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.”

39) I think that this is a clear case in point. Indeed, Edward's own evidence demonstrates that as well as selling its goods via third party shops, it also sells its own shoes in its own shop. There is a reasonable degree of similarity between footwear and the retailing of footwear, a finding which also extends to the retailing of clothing (because this will include the retailing of footwear and belts). In relation to the retailing of headwear and non footwear, non belt clothing, then there is still some similarity albeit on a more modest level.

Comparison of the marks

40) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The “word only” earlier mark is the closest so I will make a comparison on this basis. The marks to be compared are:

WILLIAM GREEN v EDWARD GREEN

41) Both marks will be perceived as full names. Neither the names WILLIAM, GREEN or EDWARD are unusual. As was pointed out in *Harman*, it cannot be held that a surname will always dominate a full name. I come to the view that the respective names in the marks will have equal significance as the other word in the mark; neither name dominates the other.

42) Both marks are made up of two words (or more precisely two names), the second of which are shared in the respective marks. However, the first word (name) is completely different and there are no material points of co-incidence. The sharing of the second word (name) creates some similarity between the

marks as a whole on both a visual and aural basis, but the completely different first word means that such similarity, overall, is modest. There is also a modest degree of conceptual similarity as both marks refer to a person with the same surname (GREEN), however, the conceptualised persons are different in that one is called William Green the other Edward Green. I should add that Edward's submission that both WILLIAM and EDWARD are "royal" names does not alter my assessment, I doubt that this will form part of the respective marks' conceptual hooks.

Likelihood of confusion

43) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

44) Edward has filed what it claims to be evidence of actual confusion. It relies on the message board extracts, however, this appears to be more of a discussion as to the provenance of the shoes listed on eBay.com rather than actual confusion between the names involved. The cease and desist letters sent to a US retailer are, likewise, not indicative of confusion. They are simply Edward's opinion. Whilst a reference is made to instances of confusion/disappointment, no evidence of this is provided. This is also the misdirection of an invoice intended for Grenson to Edward. However, the circumstances of this error are not known, it could have been a simple clerical mistake with no actual confusion having arisen between the names. None of this evidence is indicative of confusion.

45) Grenson relies on a decision of OHIM's Second Board of Appeal involving the names WILLI SMITH and WILLERBY SMITH where it was held that there was no likelihood of confusion. Edward highlights that SMITH is the most common of surnames which may have assisted the distinguishing process. I do not consider it necessary to draw any parallels either way with the decision of the Second Board of Appeal given that it is not binding and was merely a finding on the facts that were before it in that case.

46) Edward submits that there is a greater likelihood of confusion in this case because shoes sold under the EDWARD GREEN mark are abbreviated, so as to be called GREEN'S. However, the mark before me is EDWARD GREEN not GREEN/GREEN'S and, therefore, this does not assist. Furthermore, I have found that the evidence of Edward does not enhance the distinctive character of the EDWARD GREEN marks, the position is even weaker in terms of any claim that through use more focus will be placed on the GREEN element.

47) The very purpose of a forename is to distinguish between people who share the same surname. However, I must bear in mind that I am not comparing people per se, but two trade marks used in the course of trade that mirror the names of people. I must bear in mind that imperfect recollection could arise. However, in the case before me, and bearing in mind my earlier finding that the surname GREEN does not dominate the mark to the detriment of WILLIAM/EDWARD (or vice versa), I come to the view, after weighing all the relevant factors, that the average consumer will not be directly confused even in the context of identical goods. The average consumer will appreciate the marks in their totalities and will recall that one name is EDWARD GREEN and that the other is WILLIAM GREEN. Furthermore, there is no likelihood of indirect confusion either. An average consumer will not put the common use of the surname GREEN down to the responsible undertakings being the same or being related. The similarity will simply be put down to a co-incidental use of a common surname. The average consumer will identify two different undertakings as they would identify two different persons. **There is no likelihood of confusion. The claim under section 5(2)(b) of the Act fails.**

SECTION 5(4)(A) OF THE ACT

48) Section 5(4)(a) of the Act prevents the registration of a mark the use of which is liable to be prevented:

“(a) by virtue of any rule of law (in particular, the law of passing-off) protecting an unregistered trade mark or other sign used in the course of trade..”

49) The elements of passing-off (often referred to as the classic trinity) can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position quite succinctly when he stated:

“The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the

plaintiff...Thirdly he must demonstrate that he suffers, or in a quia timet action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

50) The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom."

51) I note from the relevant case-law that to qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature⁶. However, being a small player does not necessarily prevent the law of passing-off from being relied upon⁷.

52) In terms of the material date, I note the judgment of the GC in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07 where it was stated:

"50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000."

53) Use of the applied for mark before its date of application may be relevant. It could establish that Grenson are the senior users, or that there had been common law acquiescence, or that the status quo should not be disturbed which, in turn, could mean that the use of the mark could not have been prevented under the law of passing-off at the material date⁸. However, whilst Grenson was

⁶ *Hart v Relentless Records* [2002] EWHC 1984

⁷ See, for instance, *Stannard v Reay* [1967] FSR 140, *Teleworks v Telework Group* [2002] RPC 27 and *Stacey v 2020 Communications* [1991] FSR 49

⁸ See, for instance: *Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42.

founded by William Green, it is not clear when (if at all) it has made the change from using GRENSON to also using WILLIAM GREEN. There is, therefore, no impact on the material date.

54) Whilst I have no doubt that Edward possessed goodwill associated with the sign EDWARD GREEN at the material date (albeit a small goodwill in the field of luxury men's footwear) I am not satisfied that this will lead to a misrepresentation. For reasons already expressed, I believe that consumers in the relevant field will be readily able to distinguish between WILLIAM GREEN and EDWARD GREEN. I touched on the GREEN/GREEN'S aspect earlier. Similar consideration apply here because the sign relied upon by Edward is the sign EDWARD GREEN not GREEN/GREEN'S. In any event, the evidence of abbreviated use is in my view weak and it is mainly in the context of the full name already have been expressed; the evidence does not satisfy me that the name Green's has become a common shorthand to refer to Edward's goods. This "abbreviation" evidence does not, therefore, make a misrepresentation any more likely.

55) I have borne in mind Edward's claim that Grenson's move from using GRENSON to using WILLIAM GREEN is timed to coincide with the increased reputation of the EDWARD GREEN mark and that the goods are in direct competition in the luxury men's shoe market. There is, though, no evidence that this was the intention of Grenson and the claim is nothing more than speculation. **There will be no misrepresentation and, therefore, the claim under section 5(4)(a) of the Act fails.**

COSTS

56) Grenson has been successful and is entitled to a contribution towards its costs. I hereby order Edward Green & Company to pay Grenson Limited the sum of £1400. This sum is calculated as follows:

Preparing a statement and considering the other side's statement

£400

Considering and filing evidence

£600

Written submissions

£400

57) The above sum should 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 25th day of February 2013

**Oliver Morris
For the Registrar, The Comptroller-General**