

O-187-13

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NUMBERS
2575047, 2551481 AND 2537421
STANDING IN THE NAME OF
BOWLYN STYLE LIMITED**

AND

**CONSOLIDATED APPLICATIONS
FOR DECLARATIONS OF INVALIDITY THERETO
UNDER NUMBERS 84393, 84394 AND 84395 RESPECTIVELY
BY MICHEL ROGER MAURER
AND GUMBIES LIMITED**

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BY MICHEL ROGER MAURER AND GUMBIES LIMITED

THE BACKGROUND AND THE PLEADINGS

1) Bowlyn Style Limited (“the Registered Proprietor”) is the proprietor of the following trade marks (“the Registered Proprietor’s marks”):

Registration number 2575047 was applied for on 14 March 2011 and completed its registration procedure on 17 June 2011. The mark and the goods for which it is registered are shown below:

EWE

Class 25: Sheepskin lined wellington boots. Clothing, accessories, footwear for adults and children.

Registration number 2551481 was applied for on 25 June 2010 and completed its registration procedure on 24 September 2010. The mark and the goods for which it is registered are shown below:

EWE BOOT

Class 25: Sheepskin lined wellington boots

Registration number 3537421 was applied for on 29 January 2010 and completed its registration procedure on 7 May 2010. The mark and the goods for which it is registered are shown below:

EWE Style

Class 25: Sheepskin Lined Wellington Boots, Sheepskin Jackets and other Sheepskin clothing and accessories.

2) On 17 April 2012 Mr Michel Roger Maurer filed application nos. 84393, 84394 and 84395 respectively for declarations of invalidity in respect of each of the above registrations, in each case relying on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”), such claims being based on his proprietorship of community trade mark 7249303 (“the earlier mark”) and on goodwill associated with the unregistered sign EWE. The earlier mark, which was applied for on 22 September 2008 and registered on 9 May 2012, and the goods for which it is registered, are shown below:



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; umbrellas, parasols and walking sticks; whips, harness and saddlery; articles of luggage being bags; baggage; travel baggage; travel bags; wash bags; weekend bags; work bags; toilet bags; tool bags; sports bags; shopping bags; bags for clothes; bags made of leather; bags made of imitation leather; bags made of plastics; money bags; school bags; shoe bags.

Class 25: Clothing; footwear; headgear.

Class 28: Sports equipment and accessories therefor.

3) On 24 May 2012 the Registered Proprietor filed defences and counterstatements in respect of each of the above applications for declarations of invalidity. The proceedings were consolidated. Both sides filed evidence. The matter then came to be heard before me on 11 April 2013. Mr Dominic Hughes of counsel (instructed by Taylor Wessing LLP) appeared on behalf of Mr Maurer. Mr Tomás Lynch, a director and shareholder of the Registered Proprietor, appeared on behalf of the Registered Proprietor.

4) At the hearing Mr Hughes addressed me on a preliminary point, which he had raised in his skeleton argument (filed the day before the hearing). He submitted that the evidence filed by Mr Maurer included evidence of sales made by Mr Maurer or his companies, such as Gumbies Ltd. Mr Maurer was anxious that a technical point should not be made that the goodwill was actually owned by Mr Maurer’s companies – who were not party to the proceedings. The best course would therefore be to join to the action all those who had a potential interest in the goodwill – i.e. Mr Maurer’s companies. Mr Hughes suggested that Gumbies Ltd was the most obvious party to join, but it might be relevant to join Abogear Ltd, because it owned the domain names eweboots.com and eweboots.co.uk.

5, I could see that the existing evidence contained references to Gumbies Ltd and, in particular, to sales effected by that company. I could not see why Abogear should be joined, as I was not aware of any references to relevant sales by Abogear Ltd in the existing evidence, and ownership of the domain name was not in itself relevant to goodwill. . Mr Lynch then agreed that he did

not wish to take a point on whether the sales in question were made by Michel Maurer, or by his companies. On this basis, I directed that Gumbies Limited be joined as co-applicant in these proceedings; I could see no point in joining Abogear. Mr Maurer and Gumbies Limited are together referred to hereafter as “the Applicants”.

THE EVIDENCE

The Applicants’ evidence

6) The Applicants’ evidence consists of a witness statement of 1 August 2012 from Mr Michel Roger Maurer. Mr Maurer states that he has been selling footwear branded EWE from 2008, the first EWE footwear arriving in the UK, and the first UK sales, being made in September 2008.

7) Exhibit MRM2 consists of a document headed “Gumbies Limited – Sales by item summary (Ewe Boots),” showing sales by item in the UK from September 2008 to July 2012. Legibility is poor (a weakness shared with many of the exhibits) but it appears to give a figure of 47,000 pairs of boots sold in that period for a total sales value of £807,432.95. However, it is not broken down by year, and no invoices are provided.

8) In his witness statement Mr Maurer provides the following figures for boots sold per calendar year:

Year	Unit Sales (pairs)	Invoice Sales Value
Sep to 31 Dec 2008	2,440	£52,488.72
2009	10,520	£197,259.54
2010	14,338	£245,612.45
2011	19,315	£292,965.53
2012 (to date)	966	£19,227.44
Total	47,581	£807,533.76

9) Mr Maurer says UK customers include:

- High Street Store TK Maxx, which has over 200 stores in the UK, and has bought 20,000 pairs of EWE branded footwear. The dates when these sales were made are not given.
- High Street shop Jones Bootmaker, with over 80 branches in the UK. No sales dates are given.
- The Factory Shop. No sales dates are given.
- Catalogue company Scott’s of Stow since 31 July 2009. Exhibit MRM3 consists of a print out of the current Scotts’s webpage showing the words “Ewe boots”. The earlier mark (which is) stylised does not appear on the copy.

- Online company JD Williams since 4 September 2009.

10) Exhibit MRM4 consists of the following advertisements:

- *Footwear Today* of November 2008 (showing the earlier mark and the words “Ewe Boots” in unstylised text), April 2009 (showing “Ewe Boots”) and August 2009 (showing the earlier mark)
- *Out on a Limb* of December 2009/January 2010 (showing the earlier mark)
- Ryan Air Inflight Magazine of Jan/Feb 2010. The sign was scarcely legible in the copy provided, but seems to be the words “Ewe Boots”.

I have no circulation figures for any of these publications. Mr Maurer describes *Footwear Today* as “the UK’s oldest independent trade mark [sic] journal for the footwear industry” and *Out on a Limb* as “the UK’s most authoritative magazine for current use, innovation and products for the direction on footwear and accessories industry”.

11) Mr Maurer says he has marketed “Ewe boot” in reader offers in the following publications since 25 September 2008 (or possibly 2009 - the final digit is not completely clear): The Guardian, The Daily Telegraph, Country Living and The Daily Express. Exhibit MRM5 consists of two such reader offers from The Guardian (showing “Ewe” and the earlier mark) and one from Country Living 2011 (showing “Ewe Boots”). The date is not clearly legible on any of them.

12) Mr Maurer says he has “promoted the products at the following shows”:

MODA – Biannually since February / August 2008

PURE – Biannually since February / August 2008

Spring Fair – February 2009

Autumn Fair – September 2008

BETA International – Annually since February 2009

GDS (Germany) – Biannually since March 2008 / September 2008

Micam (Italy) – Biannually since March 2008 / September 2008

13) Exhibit MRM6 consists of print-outs from the internet (dated September 2011, January 2009 and undated), mentioning “Ewe boots by Gumbies”, “Ewe boots” and “Gumbies Ewe Boots”, and an interview with Mr Maurer from the January 2009 issue of *Footwear Today*: “*Footwear Today* talks to Australian-born former sheep-shearer and shoe designer Michel Maurer about his fast-growing funky footwear brand Gumbies, including Gumboots, Gumrunners, Ewe boots, Aquashopz, [illegible], 1,000 Milers and Smelly Wellies. Fun, Functional footwear at fair prices How did you first come up with the name “Gumbies”? I came up with three names: Gumbies, Ewe (for obvious reasons) and lastly Australian Bush Outfitters or ABO”.

14) Exhibit MRM7 consists of a series of letters:

- In a letter of 31 July 2012 Mr Clive Rollinson of Holster UK Ltd says Holster UK is an importer and distributor of footwear, has shared a stand with Mr Maurer at the MICAM trade show and has stocked his “EWE brand boots” in its retail outlet. He expresses surprise at learning of the Registered Proprietor’s “Ewe Boot” product, and says “the EWE brand trade mark has been synonymous with the products distributed by Mr Michel Maurer and his company Gumbies”
- In a letter of 31 July 2012 Ms Kristina Spencer of Lambland Ltd. describes Lambland Ltd. as an online business and retail shop. She says they associate footwear “with the brand name “EWE” as unmistakably from yourselves at Gumbies Ltd.”, they “first discovered the EWE brand” at the Spring Fair in 2009 and purchase products from Mr Maurer annually via the trade shows Beta and Moda.
- In an email of 31 July 2012 Mr Sean O’Connor confirms, as Event Director of ITE Moda Ltd, that “Gumbies Ltd and “Ewe” first exhibited with us in February 2008 and several subsequent editions since then”.
- In an email of 31 July 2012 Mr Richard Kottler, the Chief Executive of the British Footwear Association (“BFA”), which Mr Maurer says represents over a hundred companies which supply footwear, says the Association has worked with Mr Maurer and his company for at least 5 (or 6 – the digit is not completely clear) years. During that time it was aware that Mr Maurer had been selling “the Ewe range of footwear” both in the UK and export markets. He concludes: “In our view, and probably that of the footwear trade generally, the Ewe brand is synonymous with Gumbies Ltd and you as its owner”.

15) These letters appear to have been solicited for the proceedings and are thus to be treated as hearsay evidence, in accordance with Tribunal Practice Notice (“TPN”) 5/2009. Hearsay evidence will not be discounted simply because it is hearsay but, in accordance with section 4 of the Civil Evidence Act 1995, is to be given such weight as it deserves, assessing each case on its own merits. I must bear in mind, for example, that a difficulty with such letters may be that, without fuller background information, it can be difficult to gauge how representative or subjective the views expressed by the signatories may be, and exactly how these views were arrived at. (A letter of 20 August 2012 sent by Mr Lynch’s firm to Mr Kottler, and exhibited to Mr Lynch’s witness statement (see paragraph 21) also bears on this issue). I give some weight to the evidence of the Applicants’ trade customers in MRM7 at least of a corroborative nature as to Mr Maurer’s claimed trading – as I do to the corresponding evidence of the Registered Proprietor’s trade customers in Exhibits TL6 and TL7 (see paragraph 19). I also accord some weight to the evidence in Mr Kottler’s letter – but this must necessarily be limited by the rather general nature of the brief statements made, the fact that the views expressed seem to be those of Mr Kottler personally, rather than representing an officially agreed position of the BFA, and more concrete details of the process by which they

were arrived are lacking. The evidence in Mr O'Connor's email of 31 July 2012 provides helpful support for the evidence of trade fair attendance in Mr Maurer's witness statement.

The Registered Proprietor's evidence

16) The Registered Proprietor's evidence consists of a witness statement of 28 September 2012 from Mr Tomás Lynch. Mr Lynch states that he is a director and shareholder of the Registered Proprietor, which trades under the name Ewe Style. Mr Lynch states that "Ewe branded products have been available for sale not only from the Ewe Style website, but also from other online retailers and high street shops for a number of years", and that "Customers of Bowlyn include CoCoBee, a high end fashion retailer based in Cheltenham" and a number of online retailers.

17) Mr Lynch states that on 12 August 2011 the Registered Proprietor acquired the assets of Ewe Style Limited, a company engaged in the design, production and sale of sheepskin-inspired products, in particular "Ewe Boot", a sheepskin-lined wellington boot for women. With effect from the same date the Registered Proprietor also acquired from their respective owners the Registered Proprietor's marks, which had previously been used under licence by Ewe Style Limited.

18) Exhibit TL3 to Mr Lynch's witness statement consists of a print-out from the OHIM website showing that the "Trade mark name" of the earlier mark was recorded as "WE". Exhibit TL4 contains a letter of 30 May 2012 from Taylor Wessing LLP to OHIM, seeking to amend the name from WE to EWE in the official record. TL5 shows a letter of 12 June 2012 from the OHIM, confirming that the "verbal element" had been amended to EWE.

19) Exhibits TL6 consists of a letter of September 2012 from a Ms Sandra Law confirming on behalf of *SimpleDesigns.nl* that it is an online retailer in the Netherlands, and has been selling the Ewe Boot on behalf of Ewe Style for a number of years. She states that in the Netherlands Ewe and Ewe Boot are marks associated with Ewe Style. Exhibit TL7 consists of a letter of 27 September 2012 from a Ms Harriet Easton on behalf of the "online marketplace" *Not on the High Street*, stating that "The Ewe Boot was first introduced to us by the original sellers, Rafe and Karen Easter, and joined notonthehighstreet.com as a seller in February 2011. Since the acquisition of the Ewe brand in 2011 we have continued to work with the management of [the Registered Proprietor] to list their products on notonthehighstreet.com". My remarks in paragraph 15 on letters solicited for the proceedings also apply to these letters. Exhibit TL8 contains print-outs showing the Registered Proprietor's wellington boots being offered for sale on its own website and on those of the following firms: *Easy Wellies*, described by Mr Lynch as "a leading online retailer of wellington boots in the UK", *Smarter Products*, described by Mr Lynch as "an online retailer of innovative products", *Not on the High Street* and *Amazon*. Use of the Registered Proprietor's marks is shown, but the print-outs all date from 2012, and no earlier use is shown.

20) Exhibit TL9 contains a print-out from the Registered Proprietor's Ewe Style Twitter page showing over 1,000 followers of Ewe Style's daily updates. The exhibit also shows examples of the Registered Proprietor's marks being used in online fashion commentaries and magazines. All are either undated or date from 2012. TL10 contains examples of mentions of the Registered Proprietor's marks in the national press. All are undated or dated 2012. Exhibit TL11 shows a competition organized with BBC Wildlife Magazine to "win a pair of EWE boots". This is dated August 2012.

21) Exhibit TL13 shows a letter of 20 August 2012 from Mr Lynch's firm Lynch Advisory Services to Mr Richard Kottler, Chief Executive of the BFA, in which he seeks information regarding the nature of the relationship between the BFA, Gumbies Ltd and Mr Maurer, and asks whether the statements in Mr Kottler's letter of 31 July 2012 (as mentioned in paragraph 15) were made in a personal capacity or reflect the position of the BFA and, in the latter case, exactly how this position was arrived at. Mr Lynch says he received no reply from Mr Kottler.

SECTION 5(2)(b)

The Law

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

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

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

23) 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."

24) In making an assessment of the similarity of the goods, all relevant factors relating to the goods in the respective specifications should be taken into account. 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.”

25) 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.”

26) Whether goods are complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), will depend on whether there exists a close connection or relationship such that one is 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).”

27) Of importance in the present case is the decision in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*

Case T-133/05 (“*Meric*”). This decision requires that, when comparing the respective goods, if a term clearly falls within the ambit of a term in the competing specification, then identical goods must be considered to be in play,

Comparison of the goods

28) All the goods covered by the Registered Proprietor’s marks fall within the ambit of *clothing* and *footwear* covered by the earlier mark. Under the rule in *Meric* they are therefore to be considered identical. The only possible exception is the term *accessories*. I consider that *accessories* in Class 25 fall within the ambit of the earlier mark’s *clothing*, and are therefore also identical. However, even if they are not identical, accessories will be regarded as important for the use of clothing in such a way that customers may think that responsibility for those goods lies with the same undertaking. Moreover, given their nature, purpose, users and channels of trade, they will in any case be highly similar to the goods of the earlier mark.

The average consumer and the purchasing process

29) According to the case-law, 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 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)). The average consumer for clothing and footwear will consist of the general public. The goods may vary in price. I bear in mind that the Registered Proprietor’s specification covers, for example, sheepskin-lined wellington boots, and that those actually sold by the Registered Proprietor are relatively expensive. However, they are still boots, and it is the inherent nature of the goods of the specification which I have to consider, rather than current pricing and marketing strategy (see *Devinlec Développement Innovation Leclerc SA v OHIM* Case T- 147/03). With regard to the purchasing process, consumers will consider the goods from the point of view of personal taste and suitability for purpose, and the appearance of the articles will normally be an important consideration for them. They will therefore pay a reasonable degree of attention (but no higher or lower than the norm) when selecting clothes and footwear, and the selection process will normally be a predominantly visual one, although aural similarity will not be ignored in my analysis


The distinctiveness of the earlier mark

30) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

31) The sales and promotional efforts described in the evidence I have summarised in paragraphs 6 to 15, while not trivial, are not such as to have enhanced the distinctiveness of the mark to any material extent. As regards inherent distinctiveness, the word EWE, which the average UK consumer will see in the earlier mark, clearly has an allusive or suggestive element in relation to clothing or footwear items with a sheepskin element. However, it is in no way descriptive of those goods, or of the wider goods covered by the earlier mark. The stylisation also contributes to the mark’s distinctiveness. It has at least an average degree of distinctiveness.

Comparison of the marks

32) 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 marks to be compared are:

The Registered Proprietor’s marks			The earlier mark
UK No. 2575047	UK No. 2551481	UK No. 3537421	CTM No. 7249303
EWE	EWE BOOT	EWE STYLE	

I shall begin by comparing UK registration no. 3537421 **EWE STYLE** with the earlier mark.

33) Use of the word “style” is commonplace with regard to clothing and footwear, and will be perceived as laudatory. It is the word EWE which forms the dominant and distinctive element of mark no. 3537421. With regard to the earlier mark, although the contribution of the stylisation or device element is by no means insignificant, it is the word EWE which forms the dominant and distinctive element of the mark. Although the presentation is a little unusual, I do not consider that the word EWE is disguised and it will be seen as a stylised presentation of that word. At the hearing Mr Lynch also thought that an English-speaking person, seeing the earlier mark, would interpret it as EWE.

34) From a visual perspective, mark no. 3537421 consists of two words of three and five letters, and the earlier mark consists of one word of three letters. However, although the stylisation/device element of the earlier mark contributes further visual differentiation, an English-speaker will, as I have already stated, see in it the word EWE, which is the first word of mark no. 3537421. These considerations carry over into the aural comparison. An English-speaker will pronounce the earlier mark in the same way as the first word of mark no. 3537421. There is a reasonable degree of visual similarity between the marks and, since the visual stylisation does not affect the pronunciation, a somewhat higher degree of aural similarity. The conceptual impact of the word STYLE in mark 3537421 will be limited, as its use is commonplace in connection with

footwear and clothing and it will be perceived as laudatory. However, the word EWE creates a firm conceptual similarity between the marks.

35) The same reasoning applies in the case of the Registered Proprietor's mark no. 2551481, where the descriptive word BOOT puts the Registered Proprietor in no better position than the laudatory STYLE. The Registered Proprietor's case is even weaker in respect of mark no. 2575047, where the difference between the marks consists simply of the stylisation of the earlier mark.

Likelihood of confusion

36) 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.

37) I have found the goods specified respectively for the Registered Proprietor's marks to be identical or at least highly similar to the goods covered by the earlier mark. I have found the marks to have a reasonable degree of visual similarity, a somewhat higher degree of aural similarity, and a firm conceptual similarity. I have found the earlier mark to possess at least an average degree of distinctiveness.

38) Bearing all this in mind, together with my assessment of the nature of the average consumer and their purchasing process, allowing for the principle of imperfect recollection, and having regard to the interdependency principle, I think it likely that the average consumer will consider the relevant goods provided under the Registered Proprietor's mark no. 3537421 and under the earlier mark to be the responsibility of the same or an economically linked undertaking. The consumer is used to seeing businesses use variations of their marks in trade. Insofar as the consumer registers and retains the stylisation of the earlier mark or the laudatory word STYLE in the Registered Proprietor's mark, s/he will regard them as variations of the same basic mark. The same reasoning is true of mark no. 2551481, where the descriptive word BOOT puts the Registered Proprietor in no better position than the laudatory STYLE. The Registered Proprietor's case is even weaker in respect of mark no. 2575047, where the difference between the marks consists simply of the stylisation of the earlier mark. Accordingly, there is a likelihood of confusion in respect of all the goods covered by all three of the Registered Proprietor's marks. **The request for invalidation on the basis of section 5(2)(b) of the Act succeeds in its entirety.**

SECTION 5(4)(a)

39) In view of my finding under section 5(2)(b) of the Act, it is not strictly necessary for me to consider the claim made under section 5(4)(a). However,

in case my conclusions under section 5(2)(b) are found to be wrong, I record here my conclusions under section 5(4)(a).

Section 5(4)(a) of the Act reads:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom 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, ...”

40) The requirements for this ground of opposition can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponent’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponent; and

(3) that the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.

The Relevant Date

41) The Applicants’ rights to restrain use of the Registered Proprietor’s marks under the law of passing-off must have been acquired before the applications for the Registered Proprietor’s marks were filed. (*Last Minute Network Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Joined Cases T-114/07 and T-115). Where the applicant for the later mark was using his mark prior to the date of the application, the passing-off right must have existed at the earlier date as well as at the date of the application (*Cadbury-Schweppes Pty. Ltd. v The Pub Squash Co. Ltd.* [1981] RPC 429). In the present proceedings, both parties claim goodwill in connection with signs consisting of, or whose distinctive element is, the word EWE. The principles to be applied in this case were stated as follows by the Appointed Person in *Croom’s Trade Mark Application* [2005] RPC 2 (AP):

“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 it is inequitable for him to do so.”

42) In the present case I will therefore need to determine which party is the senior user of the sign in question.

Goodwill

43) I note from the Applicants’ respective applications for invalidity that they claim that their business attracts a protectable goodwill in respect of footwear, and that the signs relied on for the purposes of their claims under section 5(4)(a) are both the mark which was registered as the earlier mark (which I shall continue to refer to as the earlier mark) and the unregistered sign EWE.

44) The nature of goodwill was explained in *Muller & Co’s Margarine Ltd* [1901] AC 217 at 223 as follows:

“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. It is the one thing which distinguishes an old-established business from a new business at its first.”

To qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature (*Hart v Relentless Records* [2002] E.W.H.C. 1984). However, being a small player does not prevent the law of passing-off from being relied upon, as it can be used to protect a more limited goodwill (*Stannard v Reay* [1967] F.S.R. 140, *Teleworks v Telework Group* [2002] R.P.C. and *Stacey v 2020 Communications* [1991] F.S.R. 49).

45) In his witness statement Mr Lynch states that “Ewe branded products including the Ewe Boot have been available for sale not only from the Ewe Style website but also from other online retailers and high street shops for a number of years”. However, no further concrete data on sales before February 2011 is presented. Exhibit TL7 consists of a letter of 27 September 2012 from a Ms Harriet Easton on behalf of the “online marketplace” *Not on the High Street*, stating that “The Ewe Boot was first introduced to us by the original sellers, Rafe and Karen Easter, and joined notonthehighstreet.com as a seller in February 2011”. Other items of evidence showing use of the Registered Proprietor’s marks are undated or date from 2012.

46) Mr Maurer did not exhibit any evidence showing, for example, photographs of trade fair stands illustrating promotion of his products under the earlier mark and the sign EWE. However, the evidence I have summarised in paragraphs 6 to 15 shows that Mr Maurer has been promoting his products at trade fairs since 2008 and that “Gumbies Ltd and ‘Ewe’” first exhibited at ITE Moda in February 2008. Moreover, it is clear that Mr Maurer was already promoting his Ewe Boots and explaining his choice of the word “Ewe” at the time of his interview with *Footwear Today* in January 2009. Letters from Lambland Ltd

and from the Event Director of ITE Moda indicate an awareness of a “Ewe” brand before 2010. Advertisements and “reader offers” from 2008 and 2009 show use of “Ewe Boots” and the earlier mark. Mr Maurer exhibited no invoices showing sales of the products. However, in his witness statement he has given evidence of the sale of 2,440 pairs boots sold for an invoice total of £52,488.72 from September to December 2008 and 10,520 pairs for an invoice total of £197,259.54 in 2009. At the hearing Mr Lynch observed that, since TK Maxx were such an important customer of the Applicants, if he had been in the Applicants’ place he would have included direct evidence from TKMaxx. However, he did not challenge Mr Maurer’s figures during the evidence rounds.

47) I consider that the totality of the evidence indicates: 1. that the Applicants were senior to the Registered Proprietor in their use both of the earlier mark and the unstylised sign EWE in connection with footwear; 2. that by the time the Registered Proprietor applied for the first of its marks in suit in January 2010 the Applicants had already acquired goodwill in the sale of footwear sold by reference both to the earlier mark and to the unstylised sign EWE, and that this goodwill was more than trivial, and sufficient to ground a claim for passing-off. The advertisement texts provided in the Applicants’ exhibits all show the word “Ewe” used in the combination “Ewe Boots”. But the word “boots” is clearly descriptive, “Ewe” is the distinctive element, and evidence from trade sources indicates an awareness of a “EWE” brand. It is the sign EWE which will form the primary way in which customers will remember the business.

Misrepresentation

48) In the Court of Appeal’s decision in *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473 Morritt LJ confirmed that the test to be applied to determine whether deception has been shown for the purposes of passing-off was whether a substantial number of the claimant’s customers or potential customers would be misled into purchasing the defendant’s products in the belief that they were the claimant’s.

49) In paragraphs 33 to 35 I have already compared the earlier mark with the Registered Proprietor’s marks, and explained that I found a reasonable degree of visual similarity, a somewhat higher degree of aural similarity and a firm conceptual similarity between the earlier mark and the Registered Proprietor’s marks 3537421 and 2551481, and that there was even more similarity with the Registered Proprietor’s mark 2575047, where the sole difference is the stylisation of the earlier mark. My reasoning carries over into my comparison with the earlier mark under section 5(4)(a). The similarity is even stronger with regard to the Applicants’ use of the unstylised sign EWE. Such closeness of mark/sign provides clear potential for a misrepresentation to arise.

50) I must also consider the goods in question. Although there is no requirement in passing-off for goods or services to be similar, or for there to be a common field of activity, it is nevertheless a highly relevant factor, as can be seen from the judgment of the Court of Appeal in *Harrods Ltd v Harrodian School* [1996] RPC 697, where Millett LJ stated:

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

and

“The name "Harrods" may be universally recognised, but the business with which it is associated in the minds of the public is not all embracing. To be known to everyone is not to be known for everything.”

and

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

51) The Applicants have established goodwill in the business of the marketing of boots referencing sheepskin and sheepswool in association with the earlier mark and the sign EWE. At the hearing Mr Lynch highlighted that the Registered Proprietor’s boots are currently being offered for sale at £160 per pair as “the ultimate in premium outdoor footwear”. He also stated that TK Maxx (a principal customer of the Applicants) is “a discounter” (there is no evidence before me on this). As stated earlier, the fact that the Registered Proprietor’s current marketing strategy is to sell expensive products is not a significant factor – the goods its marks are registered for cover goods of all price ranges. Furthermore, I consider that consumers will not in fact perceive sheepskin lined wellington boots as a product so different from other footwear referencing wool lining and sheepskin (or indeed from footwear in general). A significant number will be misled where they are marketed under the signs/marks under consideration here. Moreover, the specifications of the Registered Proprietor’s marks include not only *sheepskin lined wellington boots* (in the specifications of all the Registered Proprietor’s marks), and *footwear for adults and children* (for mark no. 2575047) but also *sheepskin jackets and other sheepskin clothing and accessories* (for mark no. 3537421). These have the capacity to be targeted at the same market – the general public – and I consider them to be similarly apt to misrepresent.

52) That leaves *clothing, accessories for adults and children* in the specification of mark no. 2575047. As well as clothing and accessories of other kinds, this specification also includes sheepskin clothing and accessories; so in respect of this category too I consider goods will be taken by a significant number of the Applicant’s customers or potential customers to be offered by the Applicants. If my decision were based solely on the section 5(4)(a) ground I would have given thought as to whether there were other goods within the term *clothing, accessories for adults and children* that would not give rise to misrepresentation; however, as the invalidation has already succeeded in full, and given that the parties do appear to trade in products with a sheepskin connection, there is no point in discussing it further.

Damage

53) Damage may consist of loss of sales, or of damage to the business in a more general sense, as was stated in *Ewing v Buttercup Margarine Co Ltd* 34 RPC 232:

“To induce the belief that my business is a branch of another man’s business may do that other man damage in all kinds of ways. The quality of goods I sell; the kind of business I do; the credit or otherwise which I might enjoy – all those things may immensely injure the other man who is assumed wrongly to be associated with me.”

The goods in respect of which the Applicants have established goodwill – boots referencing sheepskin and sheepswool – are covered by the general specifications of the Registered Proprietor’s marks, so there is a clear potential for loss of sales. In this context I have not overlooked Mr Lynch’s highlighting of the current price differential between the Applicant’s boots and the *sheepskin lined wellington boots* included in the specifications of all the Registered Proprietor’s marks. However, that is a matter of marketing policy. Moreover, the existence, as here, of two businesses using very similar marks in a closely related field will naturally involve some loss of distinctiveness of the earlier mark. In a recent case in the Patents County Court, *WS Foster & Son Limited v Brooks Brothers UK Limited* [2013] EWPC 18, Mr Recorder Iain Purvis QC stated:

“55 Although proof of damage is an essential requirement of passing off cases, it will generally be presumed where a misrepresentation leading to a likelihood of deception has been established, since such deception will be likely to lead to loss of sales and/or more general damage to the exclusivity of the Claimant’s unregistered mark. Mr Aikens accepted that if there was a misrepresentation in the present case, then he had no separate case on damage. I hold that damage is inevitable, at least in the sense recognised in *Sir Robert McAlpine v Alfred McAlpine* [2004] RPC 36 at 49 (the ‘blurring, diminishing or erosion’ of the distinctiveness of the mark).”

The requirement of damage is fulfilled in this case.

54) Accordingly, the request for invalidation on the basis of section 5(4)(a) of the Act succeeds.

SECTION 5(3)

55) In view of my findings under sections 5(2)(b) and 5(4)(a) I do not consider it necessary to make a finding under section 5(3); the Applicants are in no stronger position.

OUTCOME

56) For the reasons given above I find that registration nos. 2575047, 2551481 and 2537421 are invalid, in accordance with section 47(2) of the Act, and are deemed never to have been made.

COSTS

57) The Applicants have been successful, and are entitled to a contribution towards their costs. I hereby order Bowlyn Style Limited to pay Michel Roger Maurer and Gumbies Limited the sum of £1,900. This sum is calculated as follows:

<i>Preparing a statement and considering the other side's statement</i>	£300
<i>Preparing evidence and considering and commenting on the other side's evidence –</i>	£500
<i>Preparing for and attending a hearing –</i>	£500
<i>Invalidation application fees</i>	£600

58) 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 9th day of May 2013

**Martin Boyle
For the Registrar,
The Comptroller-General**