

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2556777 BY XU CAIJUN TO REGISTER**

**THE TRADE MARK**  **IN CLASSES 3, 14, 18 AND 25**

**AND IN THE MATTER OF OPPOSITION NO. 101301 THERETO BY KUVERA S.P.A.**

**OPPONENT'S APPEAL TO THE APPOINTED PERSON FROM THE DECISION OF MR C J BOWEN DATED 13 DECEMBER 2011**

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**DECISION**

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Introduction

1. This is an appeal brought under section 76 of the Trade Marks Act 1994 (“**the Act**”) against a decision of the Registrar’s Hearing Officer, Mr C J Bowen, to reject an opposition against application no. 2556777 (“**the Application**”) to register the following trade mark (“**the Mark**”):



in respect of the following goods and services:

**Class 3**

Hair lotions; non-medicated bath lotions; washing preparations; cleaning preparations; floor wax; perfumes; dentifrices; cosmetics; potpourris (fragrances); essential oils.

**Class 14**

Trinkets (jewellery); paste jewellery; jewellery; tie clips; cuff links; clocks; wrist watches; cases for watches (presentation); electronic clocks; watch cases.

**Class 18**

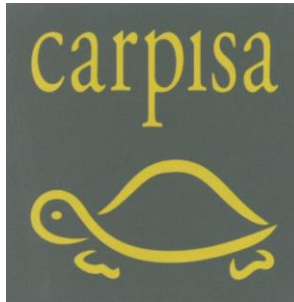
Handbags; pocket wallets; valises; furniture coverings of leather; articles made from leather; leather straps; umbrellas; canes; shopping bags; clothing for pets.

**Class 25**

Clothing; leather belts (clothing); swimsuits; waterproof clothing; football shoes; footwear; headgear for wear; hosiery; gloves (clothing); neckties.

2. The Application was filed by Xu Caijun (“**XC**” or “**the Applicant**”) on 24 August 2010.

3. The Opponent, Kuvera S.P.A (“**Kuvera**”), is an Italian company which licenses for sale in the United Kingdom (and elsewhere) a range of handbags, wallets, leather goods, luggage, clothing, accessories and other similar consumer goods under the brand name CARPISA.
4. The Opponent filed an opposition to the entire application on 16 December 2010, raising objections under sections 5(2)(b) and 5(3) of the Act, relying on the earlier registration and use of International trade mark registration number 821045 (the “**Earlier Mark**”) for the device mark depicted here,



registered in respect of the following goods and services:

**Class 14:**

Clocks, watches and chronometers; jewelry namely bracelets, rings, necklaces, earrings, ankle chains, pendants, pins, cufflinks.

**Class 18:**

Leather and imitation leather and goods made of these materials namely bags, handbags, briefcases, suitcases, wallets, document cases, key holders, purses, trunks and travelling bags, animal skins and hides, umbrellas, parasols and walking sticks.

**Class 25:**

Clothing namely jackets, hats, caps, shirts, ties, trousers, coats, sweaters, skirts, pullovers, t-shirts, socks, stockings, tights, gloves, scarves, jeans, underwear, nightwear, tracksuits, swimsuits, footwear.

5. The opposition was also based on section 5(4)(a) of the Act, relying on the use of the mark and sign CARPISA in respect of jewellery, leather and imitation leather goods, bags, luggage, clothing, footwear and headgear since 9 August 2007.
6. The Applicant defended the opposition in full by Notice of defence and counterstatement filed on 15 March 2011.
7. Only the Opponent filed evidence. Neither party asked to be heard and the Opponent filed written submissions in lieu of attendance at a hearing.
8. The Hearing Officer dismissed the opposition in a written decision dated 13 December 2011 (the “**Decision**”, reported at BL O-448-11) and ordered the Opponent to pay £800 as a contribution to the Applicant’s costs.

9. On 9 January 2012, the Opponent filed a detailed notice of appeal to the Appointed Person, contending that the Hearing Officer had erred as a matter of law in his assessment of the opposition in relation to both the section 5(2)(b) and section 5(4)(a) grounds. However, in the Opponent's skeleton argument filed for the hearing, the Opponent confined its appeal to the following single ground:

“in light of the hearing officer's findings on the evidence, the opposition should have succeeded based upon section 5(4)(a) insofar as it applied to the following goods in the specification of the Application:

Class 14

wrist watches; cases for watches (presentation); watch cases

Class 18

handbags; pocket wallets; valises; umbrellas; shopping bags

Class 25

leather belts (clothing); headgear for wear; gloves (clothing).”

10. The Opponent contended that the Hearing Officer had failed to conduct a proper assessment under section 5(4)(a), in ways which I shall expand on below.
11. The hearing of the appeal took place before me on 20 November 2012. The Opponent was represented by Counsel, Mr Chris Aikens (instructed by Saunders & Dolleymore LLP). The Applicant did not appear and was not represented.

#### Legislative basis

12. Section 5(4)(a) of the Act provides as follows:

5(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, ...

(b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

#### The Decision

13. The Hearing Officer set out the background to the Opposition and summarised the grounds relied on. He then summarised the Opponent's evidence in some detail. It is notable that no criticism is made of this summary by the Opponent. Indeed, all of the points from the evidence that were relied on in the Opponent's skeleton argument were mentioned in the Decision.
14. Paragraphs 20 to 66 of the Decision set out the grounds of opposition in turn, ending in each case with a finding in favour of the Applicant. Although the Opponent does not now appeal in respect of sections 5(2)(b) or 5(3), it is necessary for me to consider the

Decision as a whole, since some of the discussion under the other two grounds is of relevance to the section 5(4)(a) ground as well.

*Section 5(2)(b)*

15. In the course of analysing the section 5(2)(b) ground of opposition, the Hearing Officer considered the identity of the average consumer of the goods listed in the Application and the nature of the purchasing decision. He found (at paragraph 25) that “as all of the goods at issue in these proceedings are everyday consumer items,...the average consumer will be a member of the general public”. In relation to the act of purchasing, the Hearing Officer said:

“I also agree that the goods are, for the most part, likely to be the subject of self-selection from retail outlets, catalogues and websites. However, as Kuvera point out, the cost of some of the goods at issue can vary considerably. Keeping that in mind, it is, in my experience, not unusual for some retail premises to keep some of the goods (jewellery, watches and perfume for example) housed in locked glass cabinets; however, even in those circumstances, the average consumer is likely to have inspected the goods visually before approaching a sales assistant. Considered overall, I think the selection of the goods will be predominantly a visual one; while aural considerations may play their part, in my view, it will be to a lesser extent. ....As many of the goods at issue are for use on, to be worn by or for the average consumer’s personal adornment, I think that the average consumer will pay at least an average level of attention to the selection of the majority of the goods, a level of attention which is likely, in my view, to increase as the cost and importance of the goods increases, i.e. the average consumer is likely to pay far more attention when selecting, for example, a watch than they would when selecting, for example, a non-medicated bath lotion.”

16. The Hearing Officer undertook a thorough and detailed comparison of the goods set out in the specification of the Application and those covered by the Earlier Mark, summarising his conclusions as follows:

38. In summary, I have found that: (i) there is no clash between XC’s goods in class 3 and any of the goods in Kuvera’s registration, (ii) that XC’s goods in class 14 are identical or highly similar to Kuvera’s goods in class 14, (iii) with the exception of clothing for pets (which he found to be at best similar to only a low degree), XC’s goods in class 18 are identical or highly similar to Kuvera’s goods in class 18, and (iv) XC’s goods in class 25 are identical to Kuvera’s goods in class 25.

17. The Hearing Officer’s findings have not been challenged in respect of this comparison.

18. The Hearing Officer went on to consider whether the marks in question were similar. As a first step, he considered the mind-set of the average consumer, as follows:

40. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion of similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

19. In paragraphs 42 and 43, the Hearing Officer analysed the distinctive and dominant components of the Opponent's Earlier Mark and the Mark:

42. In my view, Kuvera's trade mark consists of three elements, i.e. the word carpisa, a stylised device of what both parties agree is a turtle and the colours claimed. As far as I am aware, neither the word carpisa nor the stylised device of a turtle either describe or are non-distinctive for any of the goods for which Kuvera's trade mark stands registered; as such, they are both distinctive elements. In terms of their relative sizes, both elements are, in my view, equally dominant. However, appearing as it does as the first element in Kuvera's trade mark and the element by which the average consumer is most likely to refer to the trade mark, the word carpisa is, in my view, the more dominant element. Finally, I note that Kuvera have claimed the colours green and gray as an element of its trade mark; I will return to the issue of colour below.

43. XC's trade mark consists of the word CARSYDA (in which the letter C is shown in the format above) accompanied by three Chinese characters. Once again, as far as I am aware neither the word CARSYDA (as shown above) nor the Chinese characters either describe or are non-distinctive for any of the goods for which XC seeks registration. However, while they are both distinctive elements the size of the CARSYDA element compared to the Chinese characters, means that it is the CARSYDA element which dominates XC's trade mark. While I accept that the initial letter of XC's trade mark has an element which projects downwards from the base of the letter C, I think that this is likely to go largely unnoticed by the average consumer.

20. He then considered visual similarity, concluding at paragraph 47:

47. The word elements of both trade marks consist of seven letters. The first three and seventh letters would, in my view, be viewed by the average consumer as the same, i.e. C A R and A. However, while both parties' trade marks share the letter S in the string of letters between letters four to six, the S is in a different position and the other two letters are completely different. Insofar as the colours claimed by Kuvera are concerned, it is clear from the comments in Specsavers that when making the comparison the correct approach is for me to imagine XC's trade mark presented in the same colours as Kuvera's trade mark; that is what I have done. Having done so, and whilst keeping in mind the distinctive and relatively prominent device element appearing in Kuvera's trade mark and the distinctive but much less dominant device element in XC's trade mark, it results in my view, in the competing trade marks sharing a relatively low degree of visual similarity overall.

21. Having set out the parties' respective submissions on aural similarity, the Hearing Officer set out his analysis at paragraph 50:

50. As words "speak louder" in trade marks than devices, I see no reason why the average consumer would attempt to refer to the competing trade marks by the device elements present in each. Insofar as the word elements are concerned, I agree that each trade mark is most likely to consist of three syllables with the first syllable of each trade mark i.e. CAR being the same; in addition, both trade marks end with an A sound. In my view, Kuvera's trade mark is most likely to be pronounced as either CAR-PEE-SA or CAR-PIE-SA. While it appears to me that XC's trade mark is open to more potential variations than Kuvera's trade mark, CAR-SID-A, CAR-SEE-DA or CAR-SIDE-DA are, in my view, the most likely variations. As each trade mark is likely to consist of three syllables, have the first syllable in common and end with an A sound, there is undoubtedly a degree of aural similarity between them. However, when considered overall, the difference between the sound produced by the letter P in Kuvera's trade mark as opposed to the sound produced by the letter S in XC's trade mark, results, in my

view, in a reasonable (and not as Kuvera argue, a high) degree of aural similarity between the competing trade marks.

22. For the conceptual comparison, at paragraph 52 the Hearing Officer accepted the Opponent's submission that the word elements of the competing marks are unlikely to create any conceptual imagery in the mind of the average consumer.

23. In paragraph 53, the Hearing Officer made the following finding on the inherent distinctive character of the Opponent's Earlier Mark:

53. ... As I have already concluded that neither the word nor device elements present in Kuvera's trade mark are descriptive/non-distinctive for the goods for which the trade mark stands registered, it follows that as a totality and absent use, Kuvera's trade mark is possessed of a fairly high degree of inherent distinctive character.

24. Moving on to the question of whether the Earlier Mark had acquire any additional distinctive character through use, the Hearing Officer said at paragraph 54:

54. Kuvera began using its trade mark in the United Kingdom in August 2007. By the date of XC's application for registration, Kuvera had been using its trade mark in the United Kingdom for approximately three years. If one assumes that the evidence which cannot be dated refers to a period before the material date in these proceedings, it indicates that by winter 2008 Kuvera had three stores (in Oxford Street and the Westfield shopping centre in London and in the Bluewater shopping centre in Kent ) and that its trade mark had been promoted by means of a launch event in 2007, in its own stores/catalogues etc. on London buses between January and February 2008, in the Bluewater Magazine at Christmas 2008, in an advertisement in The Sunday Times in February 2010 and on the London Underground. While these efforts will have built upon the inherent distinctiveness Kuvera's trade mark already possessed, Kuvera's turnover of approximately £6.3m achieved between 2007 and 2010 (which has not been split by class) must, given the obvious size of the markets in the United Kingdom for goods in classes 14, 18 and 25, be considered modest at best. In short, I do not consider that given the size of the markets in which Kuvera operates, that the use it had made of its trade mark by the material date in these proceedings will have built upon its inherent credentials to any appreciable extent.

25. The Hearing Officer set out the factors derived from the case law that he needed to bear in mind when assessing the likelihood of confusion, then summarised his conclusions up to that point in the Decision, before pulling them together with the following concluding paragraph:

57. In order to engage the test for likelihood of confusion there must be at least some similarity in both the trade marks and the goods. As I have found no similarity between Kuvera's goods and XC's goods in class 3, this part of Kuvera's opposition falls at the first hurdle. Insofar as the other goods which I have found to be predominately (sic.) identical or highly similar are concerned, bearing in mind that the selection of the goods is primarily a visual one and that given the nature of the goods at issue the average consumer will pay at least a reasonable degree of attention when making his selection, I have no hesitation in concluding that the superficial similarities between the competing trade marks are more than offset by the differences, such that there is no likelihood of either direct confusion (where one trade mark is mistaken for the other) or indirect confusion (where the average consumer assumes the goods of XC come from an

undertaking economically linked to Kuvera). Kuvera's opposition based upon section 5(2)(b) of the Act is dismissed.

*Section 5(3)*

26. The Hearing Officer began his analysis of the section 5(3) ground of opposition by citing the section and referring to the relevant case law. He correctly stated that in order for the Opponent to succeed in its section 5(3) objection it must establish that, at the material date, its trade mark was known by a significant part of the relevant public, which, given the nature of the goods for which the Earlier Mark is registered is the public at large.

27. He went on to say at paragraph 60:

“60. ... While I am aware that Kuvera began using its trade mark in the United Kingdom in August 2007 and that it has promoted it in the national press, on London buses and on the London Underground and that it has shops in Oxford Street and in the Westfield and Bluewater shopping centres, insofar as the latter is concerned so do a vast array of other traders, traders who compete in all market segments. When considered as a totality, the modest length and intensity of use made by Kuvera of its trade mark falls, in my view, a long way short of establishing that by the material date in these proceedings its trade mark would be known by a significant part of the public at large. Without the requisite reputation, Kuvera's opposition based upon section 5(3) cannot succeed and is dismissed.”

28. The Hearing Officer emphasised that the Opponent had fallen quite far short of the hurdle under section 5(3) by adding:

“61. However, even if it could be argued that I have taken too critical a view of Kuvera's evidence and that by the material date in these proceedings it had established the requisite level of reputation, its objection must still fail. This is because, as I mentioned above, the superficial similarities between the competing trade marks would, in my view, and notwithstanding the identity/similarity in some of the competing goods, be insufficient for the average consumer to call Kuvera's trade mark to mind and in so doing to create the link necessary to engage this section of the Act.”

*Section 5(4)(a)*

29. The Hearing Officer started off his discussion of the section 5(4)(a) ground of opposition by stating that the Opponent relied on use of the word CARPISA alone. He then said that he noted the comments of the Appointed Person, Mr Geoffrey Hobbs Q.C., in *Wild Child Trade Mark* [1998] RPC 455, including *inter alia* the following (at paragraph 62):

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in *Halsbury's Laws of England* (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman*

*Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’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 defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

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

30. The Hearing Officer identified the material date for the purpose of assessing the Opponent’s claimed earlier passing off right as being the filing date for the Application, i.e. 24 August 2010, given that there was no evidence to suggest that the Applicant had any basis for requiring proof at an earlier date.

31. He then set out his findings under section 5(4)(a), as follows:

“65. Kuvera’s evidence demonstrates that whilst the vast majority of its use of the word *carpisa* has been in lower case (and often accompanied by its turtle device) its evidence also contains examples of the word *CARPISA* presented alone and in upper case. As the difference between words presented in upper or lower case is likely to go largely unnoticed by the average consumer, I am prepared to accept that, at the material date, Kuvera had, since 2007, used the word *CARPISA* in relation to a range of goods (mainly bags of one sort or another) but also in relation to a number of other goods of the type I have identified in paragraph 18 above. Whilst earlier in this decision, I found that Kuvera had not established the necessary reputation under section 5(3) of the Act, I am satisfied that the use it has made of the word *CARPISA* is sufficient for me to conclude that by the material date it had a protectable goodwill in a business operated under, *inter alia*, the word *CARPISA* presented in upper case.

66. As there is no requirement in passing off for a common field of activity – see *Lego System Aktieselskab and Another v Lego M. Lemelstrich Ltd* [1983] FSR 155, and as the comparison to be made under section 5(4)(a) of the Act is between XC’s trade mark and the word *CARPISA* alone, Kuvera are clearly in a better position here than it was under section 5(2)(b) of the Act. However, once again the differences between the word *CARPISA* alone and the trade mark of XC more than offset the similarities and are, in my view, sufficient to avoid misrepresentation. Without misrepresentation there can be no damage and Kuvera’s opposition based upon section 5(4)(a) of the Act fails accordingly.”

#### Approach to this Appeal

32. As the Opponent accepts, the role of the Appointed Person is to review the Decision, not to re-hear the case. I should show a “real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle”: *REEF Trade Mark* [2002] EWCA Civ 763, [2003] RPC 5 at [28]. A decision does not contain an error of principle merely because it could have been better expressed.



The Grounds of Appeal

33. As stated in my introduction, the Opponent contends that the Hearing Officer fell into error in his assessment of the section 5(4)(a) ground, and on that basis invites me to reconsider the evidence and arguments afresh with a view to finding that the opposition should have succeeded in relation to the following goods in the specification for the Application:

Class 14: wrist watches; cases for watches (presentation); watch cases;

Class 18: handbags; pocket wallets; valises; umbrellas; shopping bags;

Class 25: leather belts (clothing); headgear for wear; gloves (clothing).

34. The Opponent's point is really that the Hearing Officer dealt with the passing off ground far too summarily. Mr Aikens argued that, in circumstances where the Hearing Officer had stated that the Opponent was in a better position under the passing off ground than under section 5(2)(b) (paragraph 66), it was incumbent on him to conduct a full and proper assessment in accordance with the applicable principles, and yet the Hearing Officer had set out his reasoning so briefly that he appeared not to have done so.

35. Specifically, Mr Aikens complained that, while the Hearing Officer did quote from the relevant passage of *Wild Child*, he did not refer to the following "further guidance" set out in *Halsbury's Laws* and quoted by the Appointed Person in *Wild Child* (at 460):

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

36. Mr Aikens contended that the Hearing Officer’s assessment of the likelihood of deception is contained in a single sentence in paragraph 66 of the Hearing Officer’s judgment :

“However, once again, the differences between the word CARPISA alone and the trade mark of XC more than offset the similarities and are, in my view, sufficient to avoid misrepresentation.”

37. He argued that the very cursory nature of this assessment, combined with the absence of any reference to the factors (a) to (e) in the above quotation from *Halsbury’s Laws*, indicated that the Hearing Officer did not conduct a proper analysis, including by reference to such factors, and that this constitutes a distinct and material error of principle.

38. I have taken account of all the points raised in the Notice of appeal, insofar as they relate to section 5(4)(a), and to the submissions made in the Opponent’s skeleton argument, as well as at the hearing.

### Decision

39. I have no doubt that, if the opposition had been based only on the section 5(4)(a) ground, the Hearing Officer’s discussion under that heading in the Decision would have been inadequate. Whatever one thought of the outcome, there would have been a legitimate concern that the Hearing Officer had not conducted a full and proper assessment of the Opponent’s rights in passing off as claimed against the Application. However, given that this ground was discussed following a very detailed consideration of the section 5(2)(b) ground, as well as discussion of the ground under section 5(3), and that there is considerable overlap between the factors to be considered under the various grounds, I do not think that one can jump to the same conclusion just because the assessment of the third ground is expressed very briefly.

40. I do not agree with the particular criticism that the Hearing Officer’s failure to quote the list of factors (a) to (e) discussed in *Halsbury’s Laws*, or to go through each such factor in turn in the section on passing off, means that he must have failed to consider them. While it is common for the extract from *Halsbury’s Laws*, as cited in *Wild Child*, to be set out in Registry decisions about oppositions based on alleged prior passing off rights, there is no requirement that the full list of relevant factors be set out. *Wild Child* is the leading case on the issue, which is a common one for hearing officers to have to tackle, and I do not doubt that Mr Bowen was aware of the factors to be considered.

41. In an ideal world, it might be said that each of the relevant factors to be taken into account under each ground of opposition should be listed in the relevant section of the decision and then applied to the facts one by one, with equal care and detail for each ground. However, in multi-ground cases there comes a point where the hearing officer has dealt with the key issues and his or her conclusion follows from what he/she has said

under one of the earlier grounds. Of course, if an assessment of one of the later grounds is not only brief, but also appears to be inconsistent with the rest of the discussion under previous grounds, then one has to question whether the hearing officer has taken the correct approach. Here, the Opponent has not pointed to any inconsistency, but merely relies on the fact that the Hearing Officer has failed to set out his reasoning in full.

42. I am willing to test the Opponent's complaints by reference to each of the factors (a) to (e) listed in the above extract from *Halsbury's Laws*, assessing whether the Hearing Officer dealt with them elsewhere in the Decision, and taking into account Mr Aikens' submissions in relation to each of them.

(a) *The nature and extent of the reputation relied on*

43. In the passing off section of the Decision, the Hearing Officer expressly accepted that the Opponent had, since 2007, used the word CARPISA in relation to a range of goods (mainly bags of one sort or other), but also in relation to other goods that he had identified earlier in the Decision (at paragraph 18), the list being as follows:

“handbags, fabric bags, synthetic bags, leather bags, straw bags, travel bags, beach bags, trolleys/luggage etc. there are also entries for a wide range of other goods such as briefcases, jewellery cases, wallets, document holders, credit card holders, coin holders, leather pouches, leather key holders, diary holders, luggage covers, umbrellas, playing card holders, beauty cases, watch holders, travel kits, mobile phone holders, purses, money belts, cases for glasses, lipstick cases, make-up kits, organisers, PC cases, metal pillboxes, metal mirrors, metal cigarette cases, metal bookmarks, metal key holders, mirrors, gloves, hats, leather belts, scarves, mobile phone pendants and watches.”

44. The Hearing Officer also stated that, although he had concluded that the Opponent had not established the necessary reputation under section 5(3) of the Act, he was satisfied that it had protectable goodwill in a business operated under the word CARPISA presented in upper case.
45. Mr Aikens stressed the following points from the evidence in relation to this factor: that, by the material date (24 August 2010), the annual turnover for goods sold by the Opponent's exclusive licensee under the CARPISA trade mark in the UK was over £2 million; that the goods were being sold from three shops in prime locations (Oxford Street, Westfield shopping centre in West London, and Bluewater shopping centre in Kent); and that substantial sums were being spent on advertising, including in the national press and on public transport. All of these points were expressly covered by the Hearing Officer in his review of the Opponent's evidence set out before his analysis of each of the grounds, and I do not see any reason to suggest that he then ignored these factors when considering the Opponent's reputation and goodwill at the relevant date.

(b) *The closeness or otherwise of the respective fields of activity*

46. Mr Aikens argued that, while the Hearing Officer was correct to point out (at paragraph 66 of the Decision) that there is no requirement in passing off for a common field of activity, this does not mean that an examination of the parties' respective fields of

activity is irrelevant. He cited the guidance in *Kerly's Law of Trade Marks and Trade Names* (§18-106) that the more remote the activities of the parties, the stronger the evidence needed to establish misrepresentation and the real likelihood of damage, and suggested that it must follow that the closer the fields of activity, the more likely it is that there will be a misrepresentation. In this case, the whittled down attack related to goods that had all been found to be identical or highly similar to those for which there was goodwill under the CARPISA name, and therefore the likelihood of deception was enhanced.

47. I do not accept that any of these points had passed the Hearing Officer by. He had conducted a careful analysis of similarity of goods under the section 5(2)(b) ground of opposition, and there is nothing in his decision under section 5(4)(a) to suggest that he had forgotten about that. When dealing with the section 5(3) ground, he had made the point that, even in the case of identity of goods, the Mark would not cause the average consumer to call the Earlier Mark (albeit including the device element) to mind. I am satisfied that the Hearing Officer was well aware that the Opponent's best case under passing off related to the goods that were found to be identical or highly similar under each of the parties' marks in issue and that he will have considered this point when considering the passing off ground.

*(c) The similarity of the Mark to the name used by the Opponent*

48. There is no doubt in my mind that the Hearing Officer took into account the extent of similarity of the Mark to the Opponent's CARPISA brand name when dealing with section 5(4)(a). In paragraph 66 of the Decision he twice stated that the relevant comparison was between the Mark and the word CARPISA alone, and he expressly acknowledged that the comparison was closer than it was between the Mark and the Earlier Mark, as registered with the device element, when he said that the Opponent was "clearly in a better position here than it was under section 5(2)(b) of the Act".

49. Under section 5(2)(b), the Hearing Officer had compared the Mark with the Earlier Mark. In doing so, he had found that the word "carpisa" was the dominant element of the Earlier Mark and that the word CARSYDA was the dominant element of the Mark, and had gone on to compare the two word elements, paying relatively little attention to the other elements in each mark. It would therefore have been unnecessarily repetitive for him to have set out a further detailed comparison between the Mark and the word CARPISA in the passing off section, and I do not criticise him for not doing so.

*(d) The manner in which the Opponent makes use of the name, mark etc. complained of and collateral factors*

50. Factor (d), as set out in *Halsbury's Laws*, relates to the actual use of a name or mark by a defendant in the context of a passing off action, rather than an opposition based on a prior passing off right. In the latter scenario, it is necessary to consider notional and fair use of the mark applied for in relation to the goods/services listed in the specification. Mr Aikens did not suggest that the Hearing Officer made any error in relation to this

factor, but merely put forward for the purpose of a new assessment by me the suggestion that the manner of use of the Mark would be similar if not identical to the manner of use of the mark CARPISA demonstrated in the exhibits. Although the Hearing Officer did not expressly deal with this factor, I believe that he would have envisaged an identical or similar manner of use of both parties' marks, given his finding of identity and close similarity of the goods concerned.

(e) The manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances

51. As I have summarised earlier in this decision, the Hearing Officer had considered *inter alia* the following factors in his assessment of the section 5(2)(a) ground of opposition:

- (1) the identity of the average consumer for the respective parties' goods, which he concluded was a member of the general public;
- (2) the nature of the purchasing process, which he thought would be self-selection in retail establishments or through catalogues or websites;
- (3) the fact that the selection of the goods would be predominantly a visual one; and
- (4) the level of attention likely to be paid to the selection of the goods, being average for most of them, but higher for more expensive items.

52. Perhaps it would have been helpful if the Hearing Officer had expressly referred back to these factors when discussing the passing off ground. However, given his earlier discussion of these points, he did not need to repeat them. There is no inconsistency in the Decision to persuade me that he did not bear them in mind when considering the question of misrepresentation and the risk of deception of the public.

53. Overall, it seems to me that the Hearing Officer did take into account, either expressly or by implication, the relevant factors in reaching his conclusion that there would be no misrepresentation if the Mark were used in relation to the goods attacked. I believe that his assessment under the section 5(4)(a) heading could usefully have been more detailed, not least to avoid the kind of criticism that has been raised by the Opponent, but I do not think that this was a material error that justified a full re-hearing of the matter, having regard to the Decision as a whole

54. The essential problem for the Opponent in relation to all the grounds on which it originally relied is that the Hearing Officer did not find either the Earlier Mark or the word CARPISA to be sufficiently similar to the Mark for the relevant public to be likely to be confused, deceived, or even to make a connection between them in order to satisfy any of the grounds, even when used in the same manner on identical goods sold to the same public in identical or highly similar circumstances.

55. Having gone through the various factors that the Opponent says must be taken into account in the course of my review, I have in any event concluded that the Hearing Officer reached the correct conclusion.

**Conclusion**

56. I therefore dismiss the Opponent's appeal and uphold the Hearing Officer's Decision, including his award of £800 to be paid by the Opponent to the Applicant as a contribution towards its costs. I extend the time for payment to 14 days.

57. The Applicant took no steps in the appeal and so I have no evidence that it incurred any costs. I therefore make no order in relation to the costs of the appeal.

ANNA CARBONI

15 July 2013

The Opponent (Appellant) was represented by Counsel, Mr Chris Aikens, instructed by Saunders & Dolleymore LLP.

The Applicant (Respondent) was not represented.