

O-562-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3069305 BY
RECEP EKSI**

TO REGISTER:

Homies England

Homies Scotland

Homies United Kingdom

AS A SERIES OF 3 TRADE MARKS

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000173 BY
STYLES CLOTHING LTD**

BACKGROUND

1. On 20 August 2014, Recep Eksi (“the applicant”) applied to register the series of three trade marks shown on the cover page of this decision. The application was published for opposition purposes on 19 September 2014 for the following goods in class 25:

All Kind of Cloting for Women, Men and Children All kind of Footwear and headgear for Women, Men and Children.

2. The application is opposed in full by Styles Clothing Ltd under the fast track opposition procedure. The opposition is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The trade mark and goods relied upon are shown below:

UK no. 3012353 for the trade mark:

HOMIES
LONDON

applied for on 2 July 2013 and for which the registration procedure was completed on 6 December 2013:

Class 25 - Clothing, namely, shirts, long-sleeved shirts, T-shirts, under shirts, night shirts, rugby shirts, polo shirts, cardigans, jerseys, uniforms, scrubs not for medical purposes, smocks, dress shirts, bottoms, pants, jeans, culottes, cargo pants, stretch pants, denim jeans, overalls, coveralls, jumpers, jump suits, shorts, boxer shorts, tops, stretch tops, tube tops, crop tops, tank tops, tankinis, halter tops, sweat shirts, hooded sweat shirts, sweat jackets, sweat shorts, sweat pants, wraps, warm-up suits, jogging suits, track suits, track pants, play suits, blouses, skirts, dresses, gowns, sweaters, vests, fleece vests, pullovers, snow suits, parkas, capes, anoraks, ponchos, cloaks, shrugs, shawls, pashminas, jackets, reversible jackets, wind-resistant jackets, shell jackets, sports jackets, golf and ski jackets, jean jackets, coats, heavy coats, over coats, petticoats, blazers, suits, tuxedos, cummerbunds, cuffs, collars, removable collars, collar protectors, turtlenecks, cloth ski bibs, swimwear, beachwear, tennis wear, surf wear, ski wear, layettes, infantwear, infants sleepers, booties, baby bibs not of paper, cloth diapers, caps, hats, visors, headbands, wrist bands, sweat bands, headwear, ear muffs, aprons, scarves, bandanas, belts, suspenders, neckwear, ties, neckerchiefs, pocket squares, ascots, singlets, socks, leg warmers, hosiery, leggings, tights, leotards, body suits, unitards, loungewear, robes, underwear, thermal underwear, long underwear, briefs, bras, sports bras, thongs, G-strings, foundation garments, underclothes, pajamas, sleepwear, lingerie, slippers, sarongs, gloves, mittens, rain slickers, rainwear, footwear, shoes, mules, sneakers, boots, galoshes, sandals, flip-flops, and slippers; trousers; braces; clothing; footwear; headgear.

3. The applicant filed a counterstatement in which he stated:

“1. There is a clear distinction between the opponent’s trademark name of Homies London and my proposed trademark name of Homies England.

2. Furthermore, I have successfully registered another trademark by the name of Homies France despite the fact that another trademark by the name of Homies Paris exists. No opposition was ever made to this. It is in my view therefore unfair, unreasonable and disproportionate to disallow me the use of the trademark name of Homies England simply because a Homies London exists. It is also imperative to note that numerous different Homies trademarks exist all around the world such as Homies Paris, Homies New York and Homies South Central. Most of these companies also sell headgear, footwear and all sorts of clothing similar to that being alleged by the opponent. In light of this, It would contravene competition practice to disallow me the use of Homies England given the numerous different Homies trademarks that exist within the UK, Europe and around the world.

3. Thus given the broad diversity with the Homies trademark I do not accept there would be any confusion between Homies London and Homies England.”

4. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

5. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

6. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise written arguments will be taken. A hearing was neither requested nor considered necessary; the applicant filed written submissions which I will refer to, as necessary, below.

DECISION

7. The opposition is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Act, which read as follows:

“5 (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

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

(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.”

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this earlier trade mark is not subject to proof of use, the opponent is entitled to rely upon all of the goods it has identified.

The opposition based upon sections 5(1) and 5(2)(a) of the Act

10. In order to get an objection based upon the above sections of the Act off the ground, the competing trade marks must be identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

11. Applying the above principle to the comparison at hand, I have no doubt that the presence of, at least, the letter “O” with a cross through it which appears in the word HOMIES in the opponent’s trade mark will be noticed by the average consumer. The opposition based upon sections 5(1) and 5(2)(a) of the Act fail and are dismissed accordingly.

The opposition based upon section 5(2)(b) of the Act

Section 5(2)(b) – case law

12. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

13. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

14. As the phrase “clothing; footwear; headgear” in the opponent’s specification would include all of the goods in the applicant’s specification, the competing goods are identical.

The average consumer and the nature of the purchasing act

15. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

16. The average consumer for the goods at issue is a member of the general public. As to the manner in which such an average consumer will select these goods, in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, the GC considered the level of attention paid to and the manner in which clothing is selected. It stated:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question

(see, by analogy, Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.

50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

17. As items of clothing, footwear and headgear are, most likely to be the subject of self selection from traditional retail outlets on the high street, catalogues and websites, visual considerations are likely to dominate the selection process, though not to the extent that aural considerations can be ignored. The cost of the goods at issue can vary considerably. Nevertheless, as factors such as material, size, colour, cost and compatibility with other items may all come into play, the average consumer will, in my experience, pay an average degree of attention when making their selection. This level of attention is, in my experience, likely to increase as the cost and importance of the item increases.


Comparison of trade marks

18. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

19. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and

therefore contribute to the overall impressions created by the trade marks. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade marks
	<p data-bbox="810 369 1046 403">Homies England</p> <p data-bbox="810 443 1054 477">Homies Scotland</p> <p data-bbox="810 517 1158 551">Homies United Kingdom</p>

20. The opponent's trade mark consists of a number of elements. The first is the word HOMIES presented in upper case in a slightly stylised bold font. The letter "O" has a cross through it and above the letter "I" there appear an acute accent rather than the more usual tittle. Below the word HOMIES there appears an underlining and the word LONDON presented in upper case in a standard typeface and which is centrally positioned. As the underlining has no distinctive character (and may well go unnoticed), and as the word LONDON would be regarded as being purely geographical, these elements will have very little (if any) weight in the overall impression the opponent's trade mark conveys. Although given its size and positioning it is the word HOMIES that will dominate the overall impression the opponent's trade mark conveys, the visually arresting letter "O" with a cross through it will also make a contribution, albeit to a much lesser extent than the word HOMIES. As the acute accent above the letter "I" is somewhat unusual, it too may make a very small contribution to the overall impression; however even if it does, it will, in my view, be a much smaller contribution than the letter "O" with a cross through it.

21. Although in his counterstatement and submissions the applicant refers to his trade mark as Homies England, his application consists of a series of three trade marks. Each trade mark consists of the word Homies presented in title case, followed by a geographical location i.e. England, Scotland and United Kingdom also presented in title case. In relation to these geographical locations, I reach the same conclusion I did in relation to the word LONDON in the opponent's trade mark i.e. they will have "very little (if any) weight" in the overall impression the applicant's trade marks convey. Having reached that conclusion, it follows that the overall impression of the applicant's trade marks will be dominated by the word Homies.

22. Having reached the above conclusions, I now turn to compare the competing trade marks from the visual, aural and conceptual perspectives. Notwithstanding the presence of, inter alia, the visually arresting letter "O" with a cross through it in the opponent's trade mark, the fact that the overall impression of both parties' trade marks will be dominated by the word HOMIES/Homies, results in a high degree of visual similarity between them.

23. I think it highly unlikely that when the competing trade marks are referred to orally the geographical locations present in the competing trade marks will be articulated. If I am correct, and as the "O" with a cross through it and the acute accent above the letter "I" in the opponent's trade mark will not affect how the word HOMIES would be pronounced, the competing trade marks would be aurally

identical. However, even if I am wrong in that conclusion and the average consumer does articulate the geographical place names present in the competing trade marks, the fact that the word HOMIES/Homies would be the first word spoken, would still result in an above average degree of aural similarity.

24. Turning to conceptual similarity, the presence of the various geographical names will send purely descriptive messages. Insofar as the word HOMIES/Homies is concerned, it is possible (I put it no higher) that some average consumers will see this word as a shortened version of the word “homeboy” which collinsdictionary.com defines as: “noun, (slang, mainly US), (1) a close friend, (2) a person from one’s home town or neighbourhood.” However, for some average consumers the word HOMIES/Homies will be meaningless. As the presence of the geographical names will not affect the word HOMIES/Homies, if the average consumer construes this word in the manner I have described, the competing trade marks will, to that extent, be conceptually identical. In the alternative scenario, the conceptual position in relation to this word will be neutral.

Distinctive character of the earlier trade mark

25. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

26. These are fast track opposition proceedings in which it was not necessary for the opponent to provide evidence of the use it may have made of its earlier trade mark. Although in its Notice of Opposition the opponent mentions that “items with this mark on are in production to be released beginning 2015” (i.e. after the date of the application) and “Homies London is a brand we have been building on and advertising before bringing the actual stock in” (possibly before the date of application), as the opponent has not sought leave to file evidence in these proceedings I have only the inherent characteristics of its trade mark to consider.

27. In his submissions, the applicant states that he owns an earlier trade mark i.e. Homies France and comments upon the state of the clothing market in relation to various trade marks which consist of or contain the word Homies. He concludes:

“6. ...In light of this it is very clear that the use of Homies trademarks exists all around the world and is therefore anything but distinctive...”

And:

“7...the opponent’s trade mark of Homies London does not have distinctive character...”

And:

“13...nor does the opponent fulfill any of the criteria under the Trade Marks Act with particular regard to section 3(1).”

28. As the applicant has not sought leave to file any evidence to support these submissions nor has he sought to invalidate the opponent's earlier trade mark, these comments do not assist him.

29. Absent evidence to the contrary, I have already concluded that the word HOMIES *per se* will be treated by the average consumer as either a meaningless word or as a shortened version of the word “homeboy”. In the first scenario the word alone has a high degree of inherent distinctive character. However, even if the second scenario is correct, as it is, in my view, neither descriptive of nor non distinctive for the goods for which it stands registered, the word *per se* is possessed of at least a normal degree of inherent distinctive character. Even if the applicant is correct and the word HOMIES *per se* is, in of itself, lacking in distinctive character, the fact that the opponent's trade mark also includes, inter alia, the visually arresting letter “O” with a cross through it, renders it inherently distinctive to (at least) a low degree.

Likelihood of confusion

30. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- the competing goods are identical;
- the average consumer is a member of the general public who will select the goods by predominantly visual means and who will pay, in the main, an average degree of attention during the selection process;
- the overall impressions of both parties' trade marks will be dominated by the word HOMIES/Homies;
- the competing trade marks are visually similar to a high degree and if not aurally identical, aurally similar to an above average degree;
- the word HOMIES/Homies in the competing trade marks results in either conceptual identity or conceptual neutrality;

- the opponent's earlier trade mark is possessed of (at least) a low degree of inherent distinctive and, more likely, a normal degree of inherent distinctive character.

31. Absent evidence to the contrary, the opponent's trade mark is, in my view, possessed of at least a normal degree of inherent distinctive character. The fact that the overall impression of the competing trade marks is dominated by the word HOMIES/Homies, inevitably, in my view, leads to a likelihood of direct confusion i.e. where one trade mark is mistaken for another. However, even if the presence of, inter alia, the arresting letter "O" with a cross through it in the opponent's trade mark and the differing geographical names is thought to be sufficient to avoid direct confusion, the well established practice of traders in clothing using different geographical names to indicate, for example, different ranges or places of incorporation or manufacture, will still lead to a likelihood of indirect confusion i.e. where the average consumer assumes the competing goods come from undertakings which are economically linked.

32. For the avoidance of doubt, I shall comment briefly on two further issues. First, if, notwithstanding my primary conclusion, the applicant is correct and the word HOMIES *per se* has weak distinctive character, the fact that the opponent's trade mark consists of more than the word HOMIES *per se* does not preclude a likelihood of confusion for the reasons explained by the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P i.e.

"45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders."

33. In relation to the second point, although the applicant has provided no evidence of his registration of the trade mark Homies France, even if he owns such a trade mark and even he has used or registered such a trade mark for goods in class 25 from a date earlier than that of the trade mark upon which the opponent relies, it does not assist him for the reasons outlined in Tribunal Practice Notice ("TPN") 4 of 2009, the relevant parts of which read as follows:

“Trade mark opposition and invalidation proceedings - defences

Defences including a claim that the applicant for registration/registered proprietor has a registered trade mark that predates the trade mark upon which the attacker relies for grounds under sections 5(1) and 5(2) of the Act.

1. A number of counterstatements in opposition and invalidation actions have sought to introduce as a defence that the applicant for registration/registered proprietor has a registered trade mark (or trade mark application) for the same or a highly similar trade mark to that which is the subject of the proceedings that predates the earlier mark upon which the attacker relies.

2. Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds.

3. The position was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) T-269/02*:

"24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (Case T 6/01 *Matratzen Concord v OHIM - Hukla Germany (MATRATZEN)* [2002] ECR II 4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities."

The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

Overall conclusion

34. Although the opposition based upon sections 5(1) and 5(2)(a) of the Act have failed, the opposition based upon section 5(2)(b) of the Act succeeds in full.

Costs

35. As the opponent has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, but bearing in mind that the opponent has not been professionally represented in these proceedings and having reduced the award slightly to reflect the fact that the opposition based upon sections 5(1) and 5(2)(a) of the Act have failed and never, in my view, had any realistic prospect of success, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement:	£75
Opposition fee:	£100
Total:	£175

36. I order Recep Eksi to pay to Styles Clothing Ltd the sum of **£175**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of December 2015

C J BOWEN
For the Registrar