

O-455-16

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3108957

BY IT LUGGAGE LTD

AND

OPPOSITION No. 405003

BY SAMSONITE IP HOLDINGS S.À.R.L.

Background and pleadings

1. This is an opposition by Samsonite IP Holdings S.à.r.l. (“the opponent”) to an application made on 15th May 2015 (“the relevant date”) by IT luggage Ltd (“the applicant”) to register the trade mark **ROLLING SOLUTIONS**.

2. The trade mark was published in the Trade Marks Journal on 5th June 2015 in respect of the following goods/services:

Backpacks; garment bags for travel; holdalls; rucksacks; sports bags; travel bags; trolley suitcases; wheeled shopping bags; trunks.

3. The opponent opposes the application on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The first two grounds are based on the opponent’s ownership of the following earlier UK/European Union/International trade marks.

EU 6581078

This mark consists of the words **ROLLING LUGGAGE**. The mark was entered in the EU trade mark register on 22nd November 2009. The opponent relies on the registration of this mark in relation to various retail services in class 35 relating to, inter alia, “*purses, wallets, notecases, key cases, umbrellas, walking sticks*”, which the opponent says are similar to the goods covered by the application.

UK 2248978

The mark consists of the logo shown below.



The mark is registered in colour. This is reflected in the associated claim that “*The applicant claims the colours Red, Yellow and Green as an element of the mark*”. This mark was entered in the register on 16th October 2000. The mark is registered in class 35 in relation to “*The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail luggage and travel accessories store*”.

UK 2605425



The mark is registered in colour. It was entered in the register on 23rd December 2011. It is registered for “*Goods made of leather and/or imitations of leather; bags; briefcases; attaché cases; suitcases; travelling bags; trunks; backpacks and rucksacks; purses, wallets, notecases; key cases; umbrellas and walking sticks*” in class 18 and various retail services in class 35 relating to such goods.

International registration (“IR”) 1143939

This mark consists of the same logo as registered under UK 2605425 (see above). The IR was protected by the EU on 19th November 2013. The international register contains an indication that the mark is registered in the colours shown. The IR is protected for essentially the same goods and services as UK 2605425.

4. The opponent claims that the earlier marks are registered in respect of goods and services which are identical or similar to the goods covered by the application. Further, the opponent claims that the applicant’s mark is similar to the earlier marks. In this connection, the opponent points out that the words SOLUTIONS and LUGGAGE are descriptive, or otherwise non-distinctive, in relation to the goods/services at issue. According to the opponent, the word ROLLING is the dominant element of all the marks. There is therefore a likelihood of confusion on the

part of the public and, consequently, registration of the applicant's mark would be contrary to s.5(2)(b) of the Act.

5. The opposition under s.5(3) of the Act is based on the same four earlier trade marks set out above. The opponent claims that the earlier marks have a reputation for the goods/services described above, and that use of the applicant's mark will, without due cause, take unfair advantage and/or be detrimental to the reputation or distinctive character of the earlier marks.

6. In this connection, the opponent says that its marks are used in relation to the sale of luggage and travel accessories in airport terminals and other international terminals in the UK and throughout the world. It claims that this 'retail environment' is high-end and selective. Consequently, the association of the applicant's mark with the opponent's retail stores is liable to give the applicant's goods the aura and prestige of international travel and a luxury retail environment. Alternatively, the reputation of the opponent's marks may be tarnished if the applicant's goods are sold through lower-market distribution channels. In the further alternative, use of the applicant's mark is liable to erode the attractive quality and prestige of the earlier marks.

7. The opposition under s.5(4)(a) of the Act is based on the opponent's claim to be the proprietor of the unregistered mark **ROLLING LUGGAGE**. According to the opponent, such rights have been acquired as a result of the use of that mark since 1997, by a predecessor in business, as the name of retail shops selling luggage and travel accessories at Gatwick and other airports and terminals in the UK and around the world. Additionally, the mark has been used in relation to online retail services relating to luggage, cases, bags, travel accessories etc. The opponent claims that consumers will believe that the applicant's goods are connected with its retail business and that this will amount to passing off.

8. The applicant filed a counterstatement denying the claims made and requesting that the opponent provide proof of use of earlier trade marks EU 6581078 and UK 2248978 (both of which had been registered for more than 5 years at the date of publication of the applicant's mark). In addition, I note the following points.

- The word 'ROLLING' is not the dominant element of the earlier marks, as claimed by the opponent.
- The dominant element of UK 2248978 is the relatively larger word LUGGAGE.
- The dominant element of UK 2605425 and IR 1143939 is the stylised RL figurative device ("RL logo") in the centre of the marks.
- The words ROLLING LUGGAGE are descriptive and therefore of low distinctiveness.
- The services for which UK 2248978 is registered are only similar to a low degree, or are dissimilar, to the goods covered by the application.
- The services for which EU 6581078 is registered are only similar to a very low degree or are "*completely different*".
- The applicant accepts that the goods covered by UK 2605425 are similar to the goods covered by the application. However, it denies that the retail services in class 35 are similar to more than a low degree to the goods specified in the application.
- The applicant makes the same points in relation the goods and services covered by IR 1149939.
- The applicant denies that any of the earlier marks have a reputation in the UK or that the opposed mark is likely to be associated with any of them.
- In relation to the opponent's claim of tarnishing, the applicant notes that the opponent itself appears to have the earlier marks on a non-selective website and therefore without the cachet of international travel.
- The applicant claims that many traders use ROLLING LUGGAGE to describe wheeled luggage. Therefore to the extent that ROLLING SOLUTIONS is

deemed be too close to ROLLING LUGGAGE, the applicant claims to have due cause to use the former.

- As regards the passing off right claim, the applicant put the opponent to proof that it has used the words ROLLING LUGGAGE, without further indicia, to identify its business. It also put the opponent to proof that its use of the sign at airports etc. generated sufficient goodwill to support a passing off action.

9. Both sides seek an award of costs. No hearing was requested and so this decision is taken following a careful review of the papers.

The evidence

10. The opponent filed evidence in support of the opposition. This consists of a witness statement by Mr Alex Wilson who is currently the Retail Director of the opponent's retail luggage business. Mr Wilson joined the opponent's predecessor in business (Tie Rack Trading Ltd) in August 2011 and transferred with the business when it was sold to the opponent (with the goodwill in the business) in February 2015.

11. According to Mr Wilson, the ROLLING LUGGAGE brand was first used by an affiliate of the opponent's predecessor in business in 1991 in relation to a retail store at terminal 1 of Heathrow airport. The store sold luggage, bags and travel accessories.

12. Mr Wilson says that the opponent has operated 50 stores under one or other of the earlier marks during the previous 5 years. Some have closed. The opponent operated 41 stores as at the date of Mr Wilson's statement in March 2016. 32 of these are in the EU. The majority of these are in the UK. Nearly all the stores are located at airports. However, three of the stores in the EU, including one in the UK (St Pancras International), are (or were) located at major railway terminals.

13. The evidence of Mr Wilson is that EU 6581078 – **ROLLING LUGGAGE** – has been used on the exterior and interior signage of the opponent's stores, sometimes

as words and sometimes in the form of one of the logos covered by the other three earlier marks (principally, the RL logo mark registered under UK 2605425 and the IR). Mr Wilson says that word-only versions of the mark *“have been used”* at 5 of the stores at Heathrow airport, at Luton airport, and at the store at St Pancras International railway station. Mr Wilson’s statement is rather vague as to exactly when these stores carried the signage in question, and even when the store at St Pancras opened. However, I note that an article in the Retail Gazette dated 20th November 2014¹ shows a retail store at Heathrow under the word-only sign ROLLING LUGGAGE. This indicates that the word mark was used in the UK during the 5 year period leading up to publication of the applicant’s mark.

14. I also note that schedule 5 to the sale agreement dated 19th December 2014² indicates one of the properties covered by the sale was the ROLLING LUGGAGE store at St Pancras station. Consequently, it appears that at least some of the opponent’s retail stores operated under signs bearing the word-only mark ROLLING LUGGAGE during the 5 year period leading up publication of the applicant’s mark.

15. Exhibits AW6 and AW7 consist of a stocking list and transfer receipts for goods stocked at, inter alia, some of the Heathrow stores (including those at terminals 2 and 3 which carried the word-only signage) and St Pancras station. These show that the stores stocked, inter alia, purses, wallets, notecases, key cases. Mr Wilson says that the ROLLING LUGGAGE mark was used in relation to these goods *“and other goods which have no relevance to this opposition”*³. I note that all the goods shown in the evidence carried third party trade marks, or at least trade marks other than ROLLING LUGGAGE.

16. According to Mr Wilson, the word-only version of the mark was also used on advertising material, retail directories at airports etc., on product packaging⁴, carrier

¹ See AW15 at page 235

² See AW1 at page 12

³ I take this to be a reference to sale of umbrellas, which are included in the specification of EU 6581078 and were originally relied upon in the notice of opposition.

⁴ It is not clear how the mark was used on product packaging, or when. There is an undated picture in AW14 showing use of the mark on a luggage tag for carry-on bags, but this is not product packaging in the usual sense of the words. The goods shown in the evidence are not shown in packaging.

bags, and on the opponent's website at rollingluggage.com. The latter operated as an e-commerce website between November 2013 and February 2015.

17. The main mark visible on the website was the RL logo mark registered under UK 2605425 and the earlier IR. However, the words Rolling Luggage appeared at the top of each page of the site⁵. The site stocked the goods mentioned at paragraph 15 above, as well as many types of suitcases, cases, bags and travel accessories. Whilst in operation, the site received between 2500 and 6000 visitors per month.

Finding of fact

18. I find that the opponent used EU 6581078 - ROLLING LUGGAGE - in the UK during the 5 year period leading up until the date of publication of the opposed mark in relation to:

Retail services relating to purses, wallets, notecases, key cases; the bringing together, for the benefit of others, of purses, wallets, notecases, key cases for travellers, enabling customers to conveniently view and purchase those goods from a store; the bringing together, for the benefit of others, of a variety of goods namely, purses, wallets, notecases, key cases, enabling customers to conveniently view and purchase those goods from a general merchandise Internet web site.

19. There is also some evidence of use of the ROLLING LUGGAGE mark in relation to umbrellas, but Mr Wilson appears to discount this as irrelevant for present purposes. I find that there is no evidence of use of the mark in relation to the remaining services covered by EU 6581078 which were originally relied upon, i.e. *retail services connected with walking sticks*. Nor is there any evidence of use of ROLLING LUGGAGE in relation to *the bringing together, for the benefit of others, of a variety of goods.... enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order or by means of telecommunications*.

⁵ See AW18 for an archived copy of the website

20. Mr Wilson claims that the mark registered under UK 2248978, which he calls the Rolling Wheel logo, was used for many years at two retail stores at terminal 1 Heathrow, until these stores were closed in November 2014 when the terminal itself closed for re-development. He says that the services offered at these stores corresponded to the specification for UK 2248978. In support of this claim he says that the goods offered at the stores correspond to those shown in exhibits AW6 and AW7. Mr Wilson also provides sales figures for these stores showing that the airside store was turning over £1m plus per annum in the years leading up closure, and the landside shop was turning over around £380k per annum.

21. Additionally, Mr Wilson claims that the opponent's Rolling Wheel Logo has also been used at the opponent's retail stores in Melbourne and Toulouse airports⁶. However, neither of these is relevant for the purposes of establishing use of the earlier UK mark.

22. Exhibit AW3 contains pictures of the opponent's stores at Heathrow airport's Terminal 1. I take this to be representative of the use claimed. The pictures are shown below.



23. It can be seen that the colours used vary between the stores, and neither colour scheme matches that of the registered UK mark, which looks like this.

⁶ Only the latter is relevant for the purposes of establishing use



Finding of fact

24. I find that a mark matching the words and figurative elements of earlier UK mark 2248978 was used in the UK during the 5 year period leading up to the date of publication of the opposed mark, in relation to retail services for the sale of luggage, backpacks, cases, bags and certain travel accessories, namely electricity adaptors, ear plugs, travel eye masks, travel socks, locks for cases, luggage tags and covers, passport holders and covers, neck pillows, portable battery chargers, money belts, luggage straps, travel trolleys, travel bottles, bag clips, laptop sleeves. However, the mark was not used in the colours claimed in the registration.

25. Mr Wilson provides sales figures showing that the opponent's retail stores, operated under the earlier marks, sold £31m worth of goods in 2013 (of which £17.7m was in the UK and a further £9.6m was elsewhere in the EU) and £27m in 2014 (of which £16.5m was in the UK and a further £5.5m was elsewhere in the EU). These figures represent over 700k transactions in 2013 and over 500k transactions in 2014. The largest volume of UK sales are made via the stores at Heathrow. In 2014/15 these stores accounted for £14.7m of UK sales. The next largest was the store at Manchester airport, which turned over £1m. Similarly, the largest volume of non-UK EU sales was at Frankfurt airport which, like Heathrow, is a large international hub.

26. The opponent spends around £100k promoting the business conducted under the earlier marks. Mr Wilson gives examples of advertisements at airports and in travel, airport and airline publications. He provides examples of the use of the RL logo mark on carrier bags, flyers and vouchers. He also claims that the mark is advertised in the national press. However, there is little particularisation or substantiation of this claim. The marks are also promoted by the airports at which the stores are located. Mr Wilson points out that airports and international terminals have a high footfall. According to the ACI Annual World Airport Traffic Report 2013, the

footfall at Heathrow in 2013 was 72m. Frankfurt was 58m and Manchester 21m. Further, St Pancras International train station had an estimated footfall of 45m.

27. Mr Wilson points out that the key brands sold in the opponent's retail stores are reputable brands.

28. Finally, Mr Wilson exhibits nine articles, dated prior to the relevant date, from trade and national publications which refer to the opponent, or the opponent's goods, or its website, as ROLLING LUGGAGE. The high point of this evidence, from the opponent's perspective, is an article from the Independent dated 2014 which refers to two [named] brands of suitcases available from "*Rolling Luggage stores or online*".

Finding of fact

29. The opponent had acquired goodwill under the earlier mark, including the words ROLLING LUGGAGE alone, at the relevant date as a retailer of luggage, cases, bags, and travel accessories. However, the extent of the goodwill and reputation in the UK (and reputation in the EU) is likely to have been restricted by its business model of placing stores at airports and international train terminals. Together with the relatively modest extent of the promotion of the mark outside the environment of travel terminals, this means that UK and EU consumers who regularly travel by aircraft or international trains are likely to be familiar with the opponent's marks, but UK and EU consumers who travel less regularly, or who do not travel these ways, are less likely, or unlikely, respectively, to be familiar with the opponent's marks. It may also mean that quite a large number of consumers from outside the UK and EU are familiar with the opponent's marks, but these consumers are irrelevant for present purposes.

Proof of Use

30. Section 6A of the Act is as follows:

"Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(b) or (ba) in relation to which the conditions set out in section 5(1), (2)
or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed
before the start of the period of five years ending with the date of
publication.

(2) In opposition proceedings, the registrar shall not refuse to register the
trade mark by reason of the earlier trade mark unless the use conditions are
met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of
the application the earlier trade mark has been put to genuine use in
the United Kingdom by the proprietor or with his consent in relation to
the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper
reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements
which do not alter the distinctive character of the mark in the form in
which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

31. Two of the opponent’s earlier marks – EU 6581078 and UK 2248978 – were registered more than five years prior to the date of publication of the opposed mark on 5th June 2015. Consequently, the opponent’s reliance of these marks is subject to proof of use of the marks. The relevant period within which genuine use of the marks must be established is 6th June 2010 to 5th June 2015.

32. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*⁷, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

⁷ [2016] EWHC 52

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of

the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

33. In terms of the burden of proof, I note that Section 100 of the Act states that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

34. Applying the case law to the use shown of EU 6581078 – ROLLING LUGGAGE - I find that the opponent has shown genuine use of the mark in the UK during the relevant period. Further, having regard to the case law of the CJEU in *Leno Marken BV v Hagelkruis Beheer BV*⁸ and taking into account:

(1) The application of that case law by the General Court in *Now Wireless Ltd v OHIM*⁹ and *TVR Automotive Ltd v OHIM*¹⁰;

⁸ Case C-149/11

⁹ Case T-278/13

¹⁰ Case T-398/13

- (2) The nature, scale and frequency of the opponent's use of the mark in relation to the retail stores in question;
- (3) The number of EU consumers who are likely to have been exposed to the mark as a result of the use in the UK (particularly in relation to the opponent's stores at some of the terminals at Heathrow airport and at the store at St Pancras railway terminal);
- I find that the use shown of ROLLING LUGGAGE in relation to some of the opponent's UK stores is sufficient to constitute use of EU 6581078 in the EU.

35. Consequently, it is not necessary to address the opponent's submission that use of the words ROLLING LUGGAGE as part of the Rolling Wheel logo or the RL logo is also sufficient to constitute genuine use of the word only mark.

36. I find that the specification shown at paragraph 18 above is a fair reflection of the established use of EU 6581078 in relation to the services now relied on by the opponent for the purposes of these proceedings.

37. Turning to the evidence of use of UK 2248978, I find that the use described in paragraphs 20-24 above is, in principle, capable of constituting genuine use of the trade mark in the UK during the relevant period. However, it is necessary to assess the discordance between the marks shown in the opponent's evidence and the registered mark, particularly as regards the colours used, and also the adequacy of the opponent's specification of its retail services in the context of the CJEU's ruling in *Praktiker Bau*¹¹ that:

"For the purposes of registration of a trade mark for such services, it is not necessary to specify the actual service(s) in question. However, details must be provided with regard to the goods or types of goods to which those services relate."

¹¹ Case C-418/02

38. Turning first to the difference between the colours in which UK 2248978 is registered and used, I note that the registration is subject to a claim that the colours red, yellow and green are an element of the mark. The marks used do not include, in one case, the colours yellow and green and, in the other, the colour red and green. Therefore one of the elements of the registered mark – the colours of UK 2248798 – is missing from the versions of the mark shown in the opponent’s evidence. This does not necessarily mean that the use of the registered mark in a different colour scheme cannot be “*use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered*”, per s.6A(4) of the Act. This is because, firstly, a colour claim is not a limitation of rights under s.13 of the Act¹². It merely points up that the mark is registered in the colours shown on the form of application¹³. Secondly, the omission, or substitution, of an element of a mark is only likely to affect the distinctive character of the mark where the element has trade mark character.

39. In my judgment, the distinctive elements of UK 2248978 are the word ROLLING, arranged at an angle within a circle conveying the impression of a wheel, in combination with the word LUGGAGE. The colours used are not part of the distinctive character of the mark. Consequently, the use of the registered mark in variant colour schemes qualifies as use of the registered mark by virtue of s.6A(4) of the Act.

40. Turning to the question of a fair specification for UK 2248978 for the purposes of this opposition, I note that in *In Frag Comercio Internacional, SL, v OHIM*¹⁴, the General Court held that a registration for ‘retail services’, which did not identify the kinds of goods covered by the services, was too vague to permit a proper comparison to be made between those services and the goods covered by the later mark. It was not therefore possible to determine that the respective services and goods were similar. Further, in *Advance Magazine Publishers, Inc. v OHIM*¹⁵, the

¹² See Nestlé’s S.A.’s Trade Mark Application [2008] EWCA 1008 (Civ) and *Phones 4U* [2007] RPC 5 CA

¹³ This was a necessary requirement at the time when UK 2248978 was registered and the register was displayed in monochrome form. The register is now capable of showing colour(s) and therefore colour claims are no longer required.

¹⁴ Case T-162/08

¹⁵ Case T-229/12

General Court held that ‘accessories’ is a vague term. The OHIM Board of Appeal therefore erred in law in comparing it with ‘umbrellas’. It therefore appears that where a term is not sufficiently precise to identify the characteristics of the goods (or services) at issue, that term cannot be the subject of a finding that it covers goods/services which are similar to other goods/services.

41. On one view, the specification of UK 2248978 does not identify any particular goods. The services covered by the registration are merely described as relating to “a variety of goods”. That is plainly not sufficient to enable a proper comparison to be made with the goods covered by the opposed application. However, the specification also contains the statement “enabling customers to conveniently view and purchase those goods in a retail luggage and travel accessories store” (emphasis added). In my view, this statement identifies the goods covered by the services as those goods likely to be offered for sale in a retail luggage and travel accessories store. Therefore, having regard to the opponent’s evidence and the need for a specification which fairly reflects the use shown, but which also has the necessary precision and clarity for the purposes of this opposition, I find that an appropriate specification for UK 2248978 is:

The bringing together, for the benefit of others, of luggage, backpacks, cases, bags and travel accessories, namely, electricity adaptors, ear plugs, travel eye masks, travel socks, locks for cases, luggage tags and covers, passport holders and covers, neck pillows, portable battery chargers, money belts, luggage straps, travel trolleys, travel bottles, bag clips, laptop sleeves.

Section 5(2)(b)

42. Sections 5(2)(b) of the Act is as follows:

“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”.

43. I will first deal with the opposition based on EU 6581078, being the word mark ROLLING LUGGAGE.

Comparison of goods and services

44. The comparison is between:

Applicant's goods	Opponent's services
Backpacks; garment bags for travel; holdalls; rucksacks; sports bags; travel bags; trolley suitcases; wheeled shopping bags; trunks.	Retail services relating to purses, wallets, notecases, key cases; the bringing together, for the benefit of others, of purses, wallets, notecases, key cases for travellers, enabling customers to conveniently view and purchase those goods from a store; the bringing together, for the benefit of others, of a variety of goods namely, purses, wallets, notecases, key cases, enabling customers to conveniently view and purchase those goods from a general merchandise Internet web site.

45. The opponent claims that the goods and services are only similar to a very low degree or are “*completely different*”. The opponent submits that the applicant's goods are closely similar to the opponent's services.

46. In the judgment of the Court of Justice of the European Union in *Canon*¹⁶, the court stated at paragraph 23 of its judgment that:

“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

¹⁶ Case C-39/97

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”.

47. The applicant’s goods are self-evidently different in nature to retail services. The intended purpose of backpacks, garment bags for travel, holdalls, rucksacks, sports bags, travel bags, trolley suitcases, wheeled shopping bags and trunks is to hold and transport other goods, whereas the intended purpose of the services is to facilitate and encourage the sale of purses, wallets, notecases, key cases. Therefore the purpose of the goods/services is different. The goods are not in competition with the services. The method of use of the goods is also different to the method of use of the services.

48. In *Oakley, Inc. v OHIM*¹⁷, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and are therefore similar to a degree.

49. In *Tony Van Gulck v Wasabi Frog Ltd*¹⁸, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in

¹⁷ Case T-116/06 at paragraphs 46-57

¹⁸ Case BL O/391/14

which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

50. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*¹⁹, and *Assembled Investments (Proprietary) Ltd v. OHIM*²⁰, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*²¹, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary, if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the goods and then to compare the goods with those retail services;
- iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;
- iv) The General Court’s findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party’s trade mark was registered (or proposed to be registered).

51. I find that the sort of retail stores that would be likely to offer retail services in relation to purses, wallets, notecases, key cases would be likely to offer the same services in relation to the goods covered by the opposed application. It follows that the opponent’s services are complementary to a material degree to the applicant’s

¹⁹ Case C-411/13P

²⁰ Case T-105/05, at paragraphs [30] to [35] of the judgment

²¹ Case C-398/07P

goods and that there is an overlap in the channels through the goods/services reach the market.

52. However, the degree of complementarity is not as pronounced as it would be if the opponent's services related to the goods covered by the opposed application (as opposed to just similar goods) and all the other factors for assessing similarity point away from a finding of similarity. Overall, I agree with the applicant that the respective goods/services are similar to a low (but potentially material) degree.

The global comparison - principles

53. 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the marks

54. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the

average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *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.”

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

55. The respective trade marks are shown below:

ROLLING SOLUTIONS	ROLLING LUGGAGE
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56. The marks are visually and aurally similar to the extent that they each consist of two words, the first of which is ROLLING, and they are of roughly equal length. The obvious difference is that the second words are entirely different with no resemblance to each other.

57. The opponent submits that SOLUTIONS and LUGGAGE are non-distinctive/descriptive. Therefore, it argues that ROLLING is the dominant and distinctive element of the marks. I agree that SOLUTIONS is non-distinctive because it is capable of being used to describe goods that are a solution to a particular

problem. However, ROLLING is also relatively descriptive and lacking in distinctiveness in relation to luggage, trunks, cases, backpacks, holdalls, rucksacks and bags, all of which may be designed to be wheeled or rolled along (instead of having to be carried). In these circumstances I do not accept that the public would mentally dissect the earlier mark so as to arrive at the conclusion that ROLLING is the distinctive and dominant 'component'. The impression created by the mark will instead depend on the mark as a whole, i.e. the combination of the words ROLLING and SOLUTIONS.

58. The opponent's services are not LUGGAGE as such. And I do not consider that the opponent's mark would impact on average consumers as a 'ROLLING' mark. Rather the impression it creates is also based on the mark as a whole, i.e. the combination of ROLLING and LUGGAGE.

59. It is true that the beginnings of marks generally make more of an impression on consumers than the ends²². Therefore the coincidence of ROLLING as the first word in both marks makes will make a little more impact than the difference between SOLUTIONS and LUGGAGE. Even so, I find that there is no more than a medium degree of overall visual and aural similarity between the marks.

60. Conceptually, both marks convey the general idea of 'rolling', although the opponent's mark has the more specific meaning of luggage that can be rolled. Therefore there is reasonable degree of conceptual similarity between the marks, although not necessarily any distinctive conceptual similarity (see below).

Average consumer and the selection process

61. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.

²² Although this is no more than a rule of thumb; see *CureVac GmbH v OHIM*, Case T-80/08

62. The relevant average consumer in this case is a UK consumer of the goods covered by the application. In my view, such a consumer is likely to select the goods displaying an average or normal degree of attention. The applicant's goods are likely to be selected primarily by visual means from shops, catalogues or websites. However, word of mouth recommendations cannot be ruled out, so the level of aural similarity is also relevant, albeit to a lesser degree.

Level of distinctiveness of the earlier mark

63. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

64. Although the opponent's retail services are not luggage, let alone wheeled luggage, they relate to services provided by an undertaking that is also likely to sell

luggage. Indeed, the opponent relies on this relationship to support its arguments that the applicant's goods are similar to the opponent's services. As I indicated above, the word ROLLING is descriptive of a characteristic of cases, bags, backpacks, holdalls etc. that are designed to be wheeled or rolled along rather than carried. It follows that the words ROLLING LUGGAGE are, *prima facie*, weakly distinctive of retail services relating to wheeled luggage/cases/bags²³. In my judgment, this relative lack of distinctiveness extends to retail services relating to goods that are likely to be offered for sale alongside wheeled luggage. Therefore, I find that *prima facie*, ROLLING LUGGAGE is low in distinctiveness for the services covered by EU 6581078.

65. Taking account of the opponent's longstanding use of EU 6581078, and also the use of ROLLING LUGGAGE as an element of the other marks relied on by the opponent, I find that the mark had acquired an enhanced distinctive character. However, based on my analysis in paragraph 29 above, I find that the earlier mark was still only averagely distinctive of the opponent's services to UK consumers at the relevant date.

Likelihood of confusion

66. The opponent submits that there is a likelihood of direct confusion, through imperfect recollection of one or other of the marks. Additionally, the opponent submits that there is a likelihood of indirect confusion though consumers believing that the applicant's mark represents an own-label mark for goods connected with ROLLING LUGGAGE retail services.

67. As to the first point, the medium degree of similarity between ROLLING SOLUTIONS and ROLLING LUGGAGE in combination with the low degree of similarity between the applicant's goods and the opponent's services, appears to me to make it unlikely that there will be confusion through imperfect recollection.

²³ I doubt that it is a coincidence that the opponent's ROLLING LUGGAGE word mark is not registered for retail services relating to luggage as such.

68. As to the second point, I note that in *L.A. Sugar Limited v By Back Beat Inc.*²⁴, Mr Iain Purvis Q.C. as the Appointed Person stated that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

²⁴ Case BL-O/375/10

69. The opponent's case essentially corresponds to category (b) above. In effect, the opponent submits that the words SOLUTIONS and LUGGAGE are of little or no distinctiveness and the applicant's mark is comprised, in effect, of its mark plus the non-distinctive word SOLUTIONS. However, as I pointed out above, the earlier mark is not ROLLING (which is itself low in distinctiveness) but ROLLING LUGGAGE. The words form a unit, i.e. together the words convey the idea of luggage that can be rolled along. Further, to the extent that the mark has acquired an enhanced distinctive character through use, the word LUGGAGE has been an integral part of the branding. So much so that one of the opponent's variant marks combines the words with an RL logo (which obviously stands for Rolling Luggage). I do not therefore accept that average consumers, paying a normal degree of attention, are likely to regard the applicant's mark, when used in relation to the goods covered by the application, as a variant own-label mark for goods that are economically connected to the user of the ROLLING LUGGAGE mark for retail services. Given that all the goods covered by the application are capable of being sold with wheels, and therefore being designed to be rolled, I find it far more likely that average consumers will see the word ROLLING in ROLLING SOLUTIONS as a reference to a likely characteristic of the goods.

70. I conclude that there is no likelihood of confusion and the opposition under s.5(2)(b) based on EU 6581078 fails.

71. I will deal next with the opposition based on UK 2248978. I earlier found that this mark was entitled to protection in relation to *the bringing together, for the benefit of others, of luggage, backpacks, cases, bags and travel accessories, namely, electricity adaptors, ear plugs, travel eye masks, travel socks, locks for cases, luggage tags and covers, passport holders and covers, neck pillows, portable battery chargers, money belts, luggage straps, travel trolleys, travel bottles, bag clips, laptop sleeves.*

Similarity of goods/services

72. I find that the position is broadly similar to the comparison based on EU 6581078, except that in this case the earlier mark is protected in relation to retail services relating to luggage as such, and not just services relating to similar goods in class 18.

73. Consequently, the applicant's goods are more similar to the services for which UK 2248978 is protected than the services covered by EU 6581078, but the other relevant factors remain the same. Therefore, I find that the applicant's goods are similar to a low to medium degree to the services covered by UK 2248978.

Similarity of marks

74. The distinctive and dominant features of the earlier mark (re-produced below for ease of reference) consists of the word ROLLING at an angle within a circle, giving the impression of a wheel, and the word LUGGAGE. The former is relatively more distinctive, the latter the more dominant in terms of size.



75. The applicant's mark does not have a distinctive and dominant element. Rather, the impression created results from the mark as a whole, i.e. ROLLING SOLUTIONS. In my view, there is a low degree of visual similarity between the marks. The graphical elements in the earlier will not be verbalised. Therefore the marks are more similar to the ear than to the eye. I find that there is a medium degree of aural similarity between the marks.

76. Conceptually, both marks convey the general idea of 'rolling', although the opponent's mark has the more specific meaning of luggage that can be rolled.

Therefore there is reasonable degree of conceptual similarity between the marks, although not necessarily any distinctive conceptual similarity.

Average consumer and the selection process

77. I adopt the reasoning and findings at paragraphs 61/62 above.

Level of distinctiveness of the earlier mark

78. With the following additions, I adopt the reasoning and findings set out in paragraphs 63 to 65 above. In this case the earlier mark is registered for services relating to luggage as such. However, for the reasons explained in paragraph 64, I find that this makes no material difference to the level of inherent distinctiveness of the earlier mark, which is low. I have not overlooked the distinctiveness of the visual element of UK 2248978, but as this have no counterpart in the opposed mark, it cannot increase the likelihood of confusion with the opposed mark.

Likelihood of confusion

79. The opponent's services are more similar to the applicant's goods than was the case in the comparison I made based on EU 6581078 (although they are still not highly similar), but the level of visual similarity between the marks is lower. This is significant in the context of my earlier finding that the applicant's goods are likely to be selected primarily be eye. Overall, I find that these factors balance each other out. I therefore reach the same conclusions in relation to earlier UK mark 2248978 as I reached in relation to EU 6581078. In the result, the opposition under s.5(2)(b) based on earlier mark UK 2248978 also fails.

80. I will deal next with the opposition based on earlier UK mark 2605425 and IR 1143939. For ease of reference the marks look like this.



81. The earlier marks are registered/protected for *goods made of leather and/or imitations of leather; bags; briefcases; attaché cases; suitcases; travelling bags; trunks; backpacks and rucksacks; purses, wallets, notecases; key cases; umbrellas and walking sticks* in class 18 and various retail services in class 35 relating to such goods.

82. There is no evidence of use of the earlier marks directly in relation to goods in class 18 (as opposed to use in relation to retail services in class 35 connected with such goods). In *Aegon UK Property Fund Limited v The Light Aparthotel LLP*²⁵, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“17. unless it is obvious, the proprietor must prove that the use was in relation to the particular goods or services for which the registration is sought to be maintained.

18. In *Céline SARL v. Céline SA*, Case C-17/06 (*Céline*), the Court of Justice gave guidance as to the meaning of “use in relation to” goods for the purpose of the infringement provisions in Article 5(1) of the Directive. Considering a situation where the mark is not physically affixed to the goods, the court said at [23]:

“...even where the sign is not affixed, there is use “in relation to goods or services” within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party.”

19. The General Court has, on more than one occasion, proceeded on the basis that a similar approach applies to the non-use provisions in what is now Article 42 of the European Union Trade Mark Regulation. For example, in *Strategi Group*, Case T-92/091, the General Court said:

²⁵ BL O/472/11

“23. In that regard, the Court of Justice has stated, with regard to Article 5(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989, L 40, p. 1), that the purpose of a company, trade or shop name is not, of itself, to distinguish goods or services. The purpose of a company name is to identify a company, whereas the purpose of a trade name or a shop name is to designate a business which is being carried on. Accordingly, where the use of a company name, trade name or shop name is limited to identifying a company or designating a business which is being carried on, such use cannot be considered as being ‘in relation to goods or services’ (*Céline*, paragraph 21).

24. Conversely, there is use ‘in relation to goods’ where a third party affixes the sign constituting his company name, trade name or shop name to the goods which he markets. In addition, even where the sign is not affixed, there is use ‘in relation to goods or services’ within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party (see *Céline*, paragraphs 22 and 23).

20. Those passages must be read together with the general requirements of proof of use in *Ansul* at [43] that there is genuine use of a trade mark where the mark is used in accordance with its essential function namely to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services.”

83. The evidence indicates that the goods marketed through the opponent’s retail stores and website are marketed under trade marks which are different to the opponent’s earlier marks. In these circumstances, there is nothing to indicate that the marks used in relation to the opponent’s retail services would be understood by consumers to designate the undertaking responsible for the goods sold through the stores/website.

84. However, as UK mark 2605425 and IR 1143939 were registered/protected less than 5 years before the date of publication of the opposed mark, proof of use of the marks in relation to goods in class 18 is not required. The opponent can legitimately ask for the likelihood of confusion to be assessed on the basis that the earlier marks are notionally in use for the goods for which they are registered.

85. Some of the goods covered by the opponent's earlier marks, i.e. *goods made of leather and/or imitations of leather; bags; suitcases; travelling bags; trunks; backpacks and rucksacks*, are plainly identical to the goods covered by the opposed application. This presents the most favourable basis for comparison from the opponent's perspective. Further, the registration/protection of these earlier marks in relation to retail services in class 35 does not provide the opponent with any stronger case than the case than the one I have already considered and rejected based on UK 2248978. Therefore, there is no need to consider the opposition based on the registration of UK mark 2605425 and IR 1143939 in relation to retail services.

Distinctiveness of the earlier marks

86. The words ROLLING LUGGAGE are *prima facie* descriptive of a characteristic of goods in the nature of luggage which may be rolled along (on wheels). This applies to all the goods covered by the earlier mark which are identical, or highly similar, to those covered by the application, i.e. *goods made of leather and/or imitations of leather; bags; briefcases; attaché cases; suitcases; travelling bags; trunks; backpacks and rucksacks*.

87. The opponent has made no use of ROLLING LUGGAGE as a trade mark for goods in class 18. As Neuberger J. (as he then was) stated in *Premier Brands UK Ltd v Typhoon Europe Ltd*²⁶

“Another issue of principle between the parties arises from Mr Bloch's contention on behalf of TEL that “the defensive marks have no reputation whatsoever” in that there is no suggestion that the public associate the mark

²⁶ [2000] FSR 767

TY.PHOO with any goods other than tea, and that, accordingly, it follows that the defensive marks “are entitled to the most limited protection” only. In this connection, it is accepted on behalf of Premier that, in connection with its claim under Section 10(2), the “likelihood of confusion” and the “likelihood of association with the trade mark” is limited to confusion between (a) the TYPHOON sign, in the way in which it is used and in connection with the goods with which it is used by TEL, and (b) the mark TY.PHOO limited to the goods in connection with which each of the defensive marks is registered.

However, although he accepted that the reputation which has been built up over the past century or so for the TY.PHOO mark in relation to tea plays no part in the exercise required to be carried out under Section 10(2), Mr Arnold contended that the extent of the protection to be accorded to a mark with no reputation depends upon the distinctiveness of the mark, which can either be inherent or acquired, and in this connection he relied on observations of the ECJ in *Sabel [1999] RPC 199 at 224*, *Canon [1999] RPC 117 at 132* (paragraph 18) and *Lloyd [1999] All ER (EC) 587 at 598* (paragraph 20).

In my judgment, the dispute between the parties in this connection is more apparent than real. I accept that the three decisions of the ECJ to which I have referred support the proposition advanced by Mr Arnold on behalf of Premier. However, it seems to me that they do not detract from what may fairly be said to be the fundamental point made by Mr Bloch on behalf of TEL on this aspect, namely that, in connection with a particular registered mark, the less use it has had in connection with the goods for which it is registered, the less distinctiveness it is likely to have acquired, and, therefore, the more the protection claimed for it has to be limited to its inherent distinctiveness. To my mind, that proposition is really no more than the corollary of the principle (accepted by both parties) that the greater the exposure and use of a particular registered mark, the greater its reputation is likely to be, and therefore the greater the protection likely to be afforded to it.”

It therefore follows from my finding that the opponent has not used the words ROLLING LUGGAGE marks as a trade mark for goods, that it has not acquired an

enhanced distinctive character as a result of such use in relation to goods in class 18.

88. The distinctiveness of the earlier marks for the goods listed in paragraph 86 therefore depends on the RL logo and the particular way in which the words ROLLING LUGGAGE are presented in the marks. The RL logo is undoubtedly a distinctive element of the earlier mark. However, as this element of the earlier marks has no counterpart in the opposed mark, this cannot strengthen the opponent's case. I conclude that the element claimed to be similar to the opposed mark, ROLLING (and ROLLING LUGGAGE), is descriptive and therefore lacking in distinctiveness in relation to the goods listed in paragraph 86.

89. Admittedly, the words ROLLING LUGGAGE are more distinctive in relation to other goods covered by the earlier marks, i.e. *purses, wallets, notecases; key cases; umbrellas and walking sticks*. This is because these are not kinds of goods that consumers would expect to be available with wheels so that they can be rolled along. However, these goods are not identical or highly similar to the goods covered by the application. Indeed, *umbrellas and walking sticks* appear to be dissimilar goods.

Comparison of marks

90. The applicant submits that the distinctive character of earlier UK mark 2605425 and IR 1143939 is vested in the RL logo in the centre of the mark. The opponent submits that the RL logo is a "*minor graphical element*" of the earlier mark and, given the obvious descriptiveness of the word LUGGAGE, says that the dominant element of the marks is the word ROLLING. In this connection, the opponent relies on various judgments of the General Court as support for the general proposition that in composite marks consisting of figurative and verbal elements, the latter are considered "*in principle*" to be the dominant element of the mark. However, if such a presumption is justified at all, it can only be as a rule of thumb. In this connection I note that in *L&D SA v OHIM*²⁷, the CJEU stated that:

²⁷ [2008] E.T.M.R. 62

“55 Furthermore, inasmuch as L & D further submits that the assessment of the Court of First Instance, according to which the silhouette of a fir tree plays a predominant role in the ARBRE MAGIQUE mark, diverges from the case-law of the Court of Justice, it need only be stated that, contrary to what the appellant asserts, that case-law does not in any way show that, in the case of mixed trade marks comprising both graphic and word elements, the word elements must systematically be regarded as dominant.”

Ultimately, the impact of the figurative and verbal elements of composite trade marks is a matter of fact which must be assessed on a case by case basis.

91. In my judgment, the words ROLLING LUGGAGE is the most dominant element of the earlier marks, but it is not a distinctive element, except in relation to *purses, wallets, notecases; key cases; umbrellas and walking sticks*. The RL logo is distinctive for all the goods in class 18 and is more than a “*minor graphical element*” (as claimed by the opponent).

92. From a visual perspective, the similarity between the parties’ marks is limited to the use of the word ROLLING as the first word of each mark. However, given the difference between the words SOLUTIONS and LUGGAGE, the absence of any counterpart to the RL logo in the applicant’s mark, and the particular get-up of the earlier marks, which is also absent from the applicant’s mark, I find that there is only a low degree of visual similarity between the marks.

93. The graphical elements of the earlier marks will not be verbalised. Therefore, the marks are more similar to the ear than to the eye. I find that there is a medium degree of aural similarity between the marks.

94. Conceptually, both marks convey the general idea of ‘rolling’. However, the opponent’s mark has the more specific meaning of luggage that can be rolled. Therefore there is a reasonable degree of conceptual similarity between the marks, although not necessarily any distinctive conceptual similarity.

Average consumer and the selection process

95. I adopt the reasoning and findings at paragraphs 61/62 above.

Likelihood of confusion

96. As I have already noted, the opponent's earlier UK mark 2605425 and IR 1143939 cover identical and similar goods to those specified in the application. However, the level of visual similarity between the marks is low. This is significant in the context of my earlier finding that the applicant's goods are likely to be selected primarily by eye. Further, to the extent that the earlier marks cover identical goods to the applicant's goods, the common word - ROLLING – is descriptive and non-distinctive. Admittedly, the words ROLLING LUGGAGE have some distinctive character in relation to similar goods, such as purses and wallets. Whilst this strengthens the opponent's case in one respect, it weakens it in another: the respective goods are then no longer identical. Further, the potential descriptiveness of ROLLING in relation to the applicant's goods will remain apparent to relevant average consumers whether or not it is descriptive of the opponent's goods. This makes it less likely that such consumers will take the word ROLLING in the applicant's mark as a reference to the opponent's earlier marks. Therefore, I find that there is no likelihood of confusion as a result of the (notional) use of the opponent's earlier marks in relation to the registered goods in class 18, and the concurrent use of the applicant's mark in relation to the goods covered by the application.

97. In the result, the opposition under s.5(2)(b) based on earlier UK mark 2605425 and IR 1143939 also fails.

Section 5(3)

98. Section 5(3) states:

“(3) A trade mark which-

- (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United

Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

99. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

Reputation

100. For present purposes I am prepared to accept that each of the opponent's earlier marks has a qualifying reputation in the UK and EU. Their reputation is as trade marks for retail services relating to luggage, cases, bags, and travel accessories. The earlier marks have no reputation as trade marks used in relation to goods.

Link?

101. The assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

I earlier found that the marks are visually similar to a 'low' degree in the case of the earlier UK marks and the IR, to a 'medium' degree in the case of EU 6581078, aurally similar to the earlier marks to a medium degree, and conceptually similar to the earlier marks to a reasonable degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

The retail services for which the earlier marks are registered/protected (and have a reputation) are similar to the applicant's goods to a 'low' degree (in the case of EU 6581078) or to a 'low-to-medium' degree (in the case of the earlier UK marks and the IR). The relevant public for the opponent's retail services overlaps with the relevant public for the applicant's goods. In both cases the relevant public is the general public.

The strength of the earlier mark's reputation

The earlier marks have a reasonable reputation in the UK and EU. However, the extent of the reputation is likely to have been restricted by the opponent's business model of placing stores only at airports and international train terminals. This means that the reputation of the marks is likely to be concentrated amongst those that use airports and international train terminals on a more-than-occasional basis. In this connection, I note that the opponent's website did not receive very high levels of visitors (even assuming that they were all from the UK/EU) and did not operate as an e-commerce site for very long.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

The words ROLLING LUGGAGE are, *prima facie*, weakly distinctive of retail services relating to luggage/cases/bags and similar goods which may be wheeled so as to roll along. However, all the earlier marks had acquired an average level of distinctive character through use as trade marks prior to the relevant date.

The existence of the likelihood of confusion on the part of the public

There is no likelihood of confusion.

102. Taking all these factors into account, I find that the relevant public will not make a link between the marks. If that is right, the s.5(3) ground fails. In case I am not right about this, I will briefly consider the opponent's claims of unfair advantage and detriment to reputation/distinctive character of the earlier marks. In making this assessment I must necessarily assume, contrary to my primary finding, that the relevant public will make a link between the marks. That is to say that the applicant's mark will call the earlier marks to mind.

Unfair advantage/detriment to reputation/distinctive character of the earlier marks

103. The opponent claims that a link between the earlier marks and the applicant's mark would imbue the applicant's goods with the aura and prestige associated with international travel and a luxury retail environment. The suggested transfer of image therefore depends on the channels through which the applicant's goods are sold rather than on any characteristic of the applicant's goods. However, there is no evidence that consumers associate retail stores at airports etc. with glamorous and positive ideas about international travel, or that consumers regard retail facilities as a 'luxury retail environment' just because they are located at airports or other international terminals. Therefore, and especially as I regard any link that consumers may make between the parties' marks as a relatively weak one (at most), I do not consider that the opponent has established that the use of the applicant's mark will result in any image transfer that would take unfair advantage of the reputation of the opponent's marks.

104. The opponent's claim of detriment to the reputation of the earlier marks is, in my view, weaker. The opponent claims that use of the applicant's mark in relation to goods marketed through "*indiscriminate*" or "*lower-market*" channels is liable to tarnish the reputation of the opponent's marks. However, as the applicant points out, the opponent itself appears to have offered luggage etc. for sale under some of the earlier marks via its e-commerce website. It would be surprising if the opponent would have done this if there was a serious risk that the sale of such goods through a non-selective retail environment was liable to damage the reputation of the earlier marks. I do not consider that the opponent has established that the use of the applicant's mark would be detrimental to the reputation of the opponent's marks.

105. The opponent also claims that use of the applicant's mark would be detrimental to the distinctive character of the earlier marks by eroding the distinctiveness of the marks, which it claims will lead to the marks losing their attractiveness to consumers and their prestige. However, given the differences between the parties' marks, and between the applicant's goods and the opponent's services, and the descriptiveness of the common word ROLLING, at least in relation to the applicant's goods, I find that the opponent's concerns are unfounded.

106. In *Environmental Manufacturing LLP v OHIM*²⁸, the CJEU held that the success of an objection based on detriment to the distinctive character of a reputed mark depended on evidence that use of the applicant's mark would result in a serious likelihood of a change in the economic behaviour of consumers of the goods or services provided under the earlier mark(s). Although such a change may be inferred on the basis of logical deductions, they cannot be based on mere suppositions. I find the opponent's case is based on mere supposition. Consequently, I do not consider that the opponent has established that the use of the applicant's mark would be detrimental to the distinctive character of the opponent's marks.

107. In the light of these findings there is no need to consider whether the applicant has due cause to use the opposed mark.

108. I find that the s.5(3) ground fails.

Section 5(4)(a) – passing off right

109. Section 5(4)(a) states:

“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, or

(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.”

110. The opponent's claims to be the proprietor of an earlier right in the words ROLLING LUGGAGE.

²⁸ Case C-383/12P

111. The relevant principles are well established and not in dispute. They are conveniently set out in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue). Passing off requires the presence of (i) goodwill, (ii) misrepresentation, and (iii) damage.

112. I have found that the opponent has established goodwill under ROLLING LUGGAGE as a retailer of luggage, cases, bags and travel accessories. The correct comparison is with the applicant's use of ROLLING SOLUTIONS in relation to items of luggage, such as bags, backpacks and cases.

113. On the question of misrepresentation, I note that in *Neutrogena Corporation and Another v Golden Limited and Another*²⁹, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University*

²⁹ [1996] RPC 473

of London (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

114. The opponent’s case appears to be that the relevant public (or at least a substantial number of them) will mistake the applicant’s mark for the earlier marks, or will be misled into thinking that the goods sold under the applicant’s mark are the opponent’s own-label goods.

115. As to the first possibility, it is important to keep in mind that the application does not cover retail services associated with the marketing of branded luggage, i.e. the opponent’s business, but the use of ROLLING SOLUTIONS as a trade mark used in relation to goods.

116. Importantly, the common word - ROLLING - is not highly distinctive for luggage (or retail services relating to such goods). It is well established that descriptive marks are given a narrower scope of protection compared to marks composed of arbitrary words. The case most usually quoted as authority for this proposition is *Office Cleaning Services Ltd v Westminster and Window and General Cleaning Ltd*³⁰ when Lord Simonds said:

“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first trader is allowed to unfairly monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be accepted from the public where a trade name consist wholly or in part of words descriptive of the articles to be sold or the services rendered”.

³⁰ [1946] 1 All E.R. 320; 63 R.P.C. 39, HL

117. In my view, members of the public will recognise that ROLLING has a potentially descriptive connotation in relation to the goods and services at issue, and as a result, will be less likely to rely on that word alone to identify the opponent's business, or the applicant's goods. Further, as I noted before, the opponent's branding is clearly ROLLING LUGGAGE as a whole, often in combination with an RL logo. I do not therefore accept that a substantial number of persons are likely to purchase the applicant's goods on the basis of a misremembering of ROLLING LUGGAGE as ROLLING SOLUTIONS.

118. There is no evidence that the opponent has in fact offered own-label branded luggage through its retail stores or online. Although this does not exclude the possibility of the public believing that the applicant's goods are the opponent's own-label products, it is a relevant factor because it makes it less likely that the public will expect ROLLING LUGGAGE to sell own branded goods and therefore less likely to assume that ROLLING SOLUTIONS luggage is connected with the opponent. This seems particularly unlikely if the applicant's goods are not being offered for sale through the opponent's ROLLING LUGGAGE retail stores or website.

119. In this connection, I note that it is not sufficient for the purposes of passing-off law if the public merely wonder whether or not ROLLING SOLUTIONS luggage, bags, cases etc. are connected with the opponent. In *W.S. Foster & Son Limited v Brooks Brothers UK Limited*³¹, Mr Iain Purvis QC, as a Recorder of the Court noted the point like this:

“54. Mr Aikens stressed in his argument the difference between ‘mere wondering’ on the part of a consumer as to a trade connection and an actual assumption of such a connection. In *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd* [2007] RPC 5 at 16–7 Jacob LJ stressed that the former was not sufficient for passing off. He concluded at 17:

‘This of course is a question of degree – there will be some mere wonderers and some assumers – there will normally....be passing off if

³¹ [2013] EWPC 18 (PCC)

there is a substantial number of the latter even if there is also a substantial number of the former'.”

120. I find that, at the relevant date, it was not likely that a substantial number of the opponent's customers or potential customers would have been deceived or misled into believing or assuming that the opponent was responsible for goods sold under the mark ROLLING SOLUTIONS. Consequently, use of that mark by the applicant would not have amounted to a misrepresentation to the public.

121. The s.5(4)(a) ground fails accordingly.

Overall outcome

122. The opposition has failed. Subject to appeal, the mark will proceed to registration.

Costs

123. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

£600 for considering the notice of opposition and filing a counterstatement;

£400 for considering the opponent's evidence.

124. I therefore order Samsonite IP Holdings S.à.r.l. to pay IT luggage Ltd the sum of £1000. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 29th day of September 2016

**Allan James
For the Registrar**