

**O-400-17**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO 3151463  
BY JOEL HARRY BROWN  
TO REGISTER**

**STONE-DRI**

**AS A TRADE MARK  
IN CLASS 25  
AND OPPOSITION THERETO (UNDER NO. 406762)  
BY  
STONEFLY S.P.A.**

## BACKGROUND & PLEADINGS

1. This decision replaces a previous decision issued on 21<sup>st</sup> July 2017 which had not taken account of the opponent's submissions dated 15<sup>th</sup> June 2017, due to a procedural error at the Tribunal.

2. Joel Harry Brown ('the applicant') applied to register the mark **STONE-DRI** on 24<sup>th</sup> February 2016 in class 25. The mark was accepted and published on 11<sup>th</sup> March 2016.

3. Stonefly S.p.A. ('the opponent') opposed the trade mark under section 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of the trade mark set out below. The trade mark is registered in class 18, 25 and 28, however these opposition proceedings are based on only some of their goods listed for class 25.

Opponent's mark	Opponent's goods relied on
EU TM 681478  <b>STONEFLY</b>  Filing date: 12 November 1997 Registration date: 13 July 1999	Footwear

4. Opposition is directed specifically at the following goods in the applicant's specification:

*Footwear; **parts and fittings for footwear**; beach shoes; fittings of metal for footwear; football boots; bath sandals; bath slippers; footwear uppers; galoshes; gymnastic shoes; half boots; heels; inner soles; soles for footwear; lace boots; esparto shoes or sandals; shoes; ski boots; slippers; sport shoes; studs for football boots; tips for footwear; welts for footwear; boot uppers; boots; boots for sport.*

5. Although the emboldened term above is stated in the opponent's notice of opposition, I note that the term itself does not feature in the applicant's specification.

6. The opponent's trade mark is an earlier mark, in accordance with Section 6 of the Act. The opponent made a statement of use in respect of all the goods it relies on. As it completed the registration procedure more than 5 years prior to the publication date of the applicant's mark, the earlier mark is subject to the proof of use conditions, as per section 6A of the Act.

7. The applicant filed a counterstatement in which it denied the grounds of opposition under section 5(2)(b) and requested that the opponent produce evidence to demonstrate proof of use.

8. In these proceedings the applicant is professionally represented by Mathys & Squire LLP and the opponent by CSY St Albans.

9. Both parties filed evidence and submissions. I have reviewed the evidence. In addition I have reviewed the evidence summary and comprehensive analysis given by the hearing officer in the previous decision. Having considered the matter afresh, I have come to the same conclusions as the previous hearing officer, and for the same reasons. I have reviewed the opponent's submissions (which were not considered by the previous hearing officer), and conclude that these submissions have no impact on my conclusions with regard to the evidence, namely:

- That the evidence was sufficient to constitute genuine use in the EU.
- That the use shown is an acceptable variant of the registered mark.
- That the opponent may rely on 'footwear' at large.

10. Therefore in the interests of procedural economy, I do not propose to rewrite the evidence summary or conclusions but adopt as my own the following paragraphs of the previous decision outlined below.

## **“Opponent’s evidence**

9. This consists of the witness statement of Andrea Tomat, with eight accompanying exhibits. Mr Tomat states that he has been president of the opponent since April 2008.

10. At exhibit 1, Mr Tomat provides prints from the opponent’s website. The prints do not appear to be archive prints. The web pages exhibited describe the history of the opponent, dating back to 1993. The following logo is at the top of each page:



11. Exhibit 2 consists of prints from the waybackmachine, which show the website [www.stonefly.it](http://www.stonefly.it) as at 13 April 2004. The mark is shown as follows:



12. Exhibit 3 is said to show turnover in the EU between 2010 and November 2016. Turnover figures throughout the EU are in excess of €30 million in each year from 2010 to 2016. The largest market appears to be Italy, where turnover did not drop below €21million annually in the same period. Figures are provided for the UK, which are significantly lower. Nonetheless, UK turnover is given as €256,689 (2011), €100,133 (2012), €2,628 (2014) and €70,022 (2016). No UK figures are given for the years 2013 or 2015.

13. Advertising spend for 2010-2015 is detailed at exhibit 4, with the figures split between press, television and “various media” investments. The sums laid out vary considerably (for example, press spend in 2011 was €6,571 but increased to €163,669 in 2012). The actual publications are not identified and it is not clear to which countries the advertising figures relate, though some of

the organisations appear to have Spanish or Italian names (e.g. PUBLIESPAÑA, MONDADORI INTERNATIONAL BUSINESS SRL).

14. Exhibit 5 consists of 21 advertisements in Italian and Spanish newspapers, such as *Il Resto del Carlino*, *Il Messaggero*, *Il Corriere della Sera* and *El País*. All are dated within the period October 2013 to November 2015. The following logo is present on all of the advertisements, though the background is occasionally blue rather than black:



Some of the advertisements also feature the web address [stonefly.it](http://stonefly.it). The footwear advertised appears to be women's boots and sandals, except at p. 13, where the boots may be for men.

15. Exhibit 6 consists of cover pages for 10 brochures. The brochures are for spring/summer and autumn/winter for each year 2012 to 2016. The brochures for spring/summer 2012 and 2013, and for autumn/winter 2013 and 2014, do not have printed dates but the date has been handwritten on the exhibit (Mr Tomat notes this at paragraph 6 of his witness statement)<sup>1</sup>. Some of the opponent's footwear is shown in the exhibit; the vast majority is clearly women's footwear, though some of the images in the 2012 brochures could equally be of men's shoes. The logo as shown at paragraph 14, above, appears on all of the catalogues.

16. Exhibit 7 contains [REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]

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<sup>1</sup> pp. 4, 3, 5 and 7

<sup>2</sup> pp. 7-23

[REDACTED]

17. Exhibit 8 contains [REDACTED]

[REDACTED]

**Proof of use**

22. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are 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 Community 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 Community.

(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”.

23. Section 100 of the Act is also relevant, which reads:

“100. 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”.

24. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch); [2013] F.S.R. 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *Pasticceria e Confetteria Sant Ambroeus Srl v G&D Restaurant Associates Ltd (SANT AMBROEUS Trade Mark)* [2010] R.P.C. 28 at [42] of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV (C-40/01)* [EU:C:2003:145]; [2003] E.T.M.R. 85, *La Mer Technology Inc v Laboratories Goemar SA (C-259/02)* [EU:C:2004:50]; [2004] E.T.M.R. 47 and *Silberquelle GmbH v Maselli-Strickmode GmbH (C495/07)*[EU:C:2009:10]; [2009] E.T.M.R.28 (to which I added references to *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-416/04 P)* [EU:C:2006:310] ). I also referred at [52] to the judgment of the CJEU in *Leno Merken BV v Hagelkruis Beheer BV (C149/11)* EU:C:2012:816; [2013] E.T.M.R. 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-141/13 P)* EU:C:2014:2089 and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd (O/528/15)* [2016] E.T.M.R. 8.

218. [...]

219. 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 RadetskyOrder v Bunderversvereinigung 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].

(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]”.

25. As the opponent’s trade mark is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C149/11, are relevant. It noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use”.

And

“50. Whilst there is admittedly some justification for thinking that a

Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark”.

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)”.

26. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its

essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity”.

27. In *London Taxi*, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant

was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33][40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use".

28. The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

29. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the

goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown.

34. The applicant has made no submissions regarding the opponent's evidence of use.

### **Sufficiency of use**

35. The evidence showing use in the UK is not overwhelming: sales figures are €256,689 (2011), €100,133 (2012) and €2,628 (2014). I take into account that a proportion of the €70,022 recorded in 2016 is also likely to relate to the relevant period. However, the opponent has provided evidence of annual turnover throughout the EU over €30 million, principally in Italy. This is supported by invoices showing not insignificant sales to a range of customers throughout the territory, including Italy and the UK, throughout the relevant period.<sup>3</sup> As the case law above indicates, sales to the trade qualify as genuine use. There is also some evidence of advertising spend, as well as examples of advertisements which appeared in Italian and Spanish publications in the period October 2013 to November 2015. Whilst I bear in mind that there is no evidence of the size of the market in which the opponent operates, and notwithstanding the likelihood that it is vast, I am satisfied that there have been sales, at least in Italy, sufficient to constitute genuine use in the EU.

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<sup>3</sup> Exhibits 7 & 8

## Form of the mark

36. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s. 46(2) of the Act as follows:

“33. [...] The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all”.

37. Although this case was decided before the judgment of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered but as part of a composite mark.

38. The evidence shows that the mark has been used in the following form:



39. The “O” in the mark is rotated off-centre but the stylisation is very slight and the letter is still clearly recognisable as an “O”. The overall impression

remains dominated by the word “STONEFLY”. I do not consider that the use of the word in white on a dark background has any material effect on the distinctive character of the trade mark, the effect being merely that the dark background provides a contrast against which the word may be read. I find that the use shown is use of the mark as registered, or at least use of the mark in a form which does not alter the distinctive character of the mark as registered, upon which the opponent is entitled to rely<sup>4</sup>.

### **Fair specification**

40. The next step is to decide whether the opponent’s use entitles it to rely on all of the goods for which it is registered. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods for which it is registered. He said:

“.....the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

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<sup>4</sup> Section 6A(4)(a) of the Act refers



65. It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered”.

41. There is ample evidence that the mark has been used in relation to women’s footwear: the brochures and advertisements in evidence clearly show a range of women’s shoes, sandals and boots being offered for sale. There is less clear evidence of use in relation to men’s footwear. However, the images on the cover pages of two brochures in the relevant period show footwear which may be for men or women<sup>5</sup>, [REDACTED]

[REDACTED]<sup>6</sup>. Consequently, I consider that the opponent may rely upon “footwear” at large in class 25.”

## **SECTION 5(2)(B)**

11. Section 5(2)(b) of the Act is as follows:

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

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<sup>5</sup> Exhibit 6, pp.1-3

<sup>6</sup> E.g. exhibit 7, pp. 9-11

(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.

12. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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. The applicant made the following concession in their written submissions:

“It is accepted that the goods overlap and there is at the very least similarity between the goods applied for and the goods covered by the earlier Registration”

14. The identical term ‘footwear’ appears in both specifications. For the sake of procedural economy, as there are identical goods and the applicant has accepted that all of their goods are similar, I do not intend to undertake a comparison of the contested goods. If the opposition fails where the goods are identical, it will follow that the opposition fails where the goods are only similar.

### **AVERAGE CONSUMER AND THE PURCHASING ACT**

15. I must now consider the role of the average consumer and how the goods are purchased. 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, Case C-342/97*.

16. 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.”

17. The average consumer for the contested goods is a member of the general public. The goods can be sold in traditional footwear retailing premises or in the footwear section of a general clothing retailer as well as online or through mail order

catalogues. In relation to the nature of the purchasing process the opponent submits that:

“aural considerations are more relevant to footwear than to clothing generally, as the issue of comfort is of paramount importance to most consumers with respect to footwear. Consumers therefore often purchase footwear on recommendations from others, with regard to the issue of comfort and those recommendations will often be spoken and not recorded in any physical way”.

18. Whilst I do not discount word of mouth recommendations, in my view the act of purchasing footwear will be a primarily visual process and will include factors such as aesthetics, functionality and fit in addition to the cost. In a physical retail premises, the average consumer will be viewing a range of footwear, handling the physical goods and trying them on. In an online or mail order catalogue, a consumer will be viewing images of the goods before selection. Therefore the selection process at least includes a visual assessment in which the trade mark will be visible. Overall I conclude that the average consumer will be paying a normal degree of attention during the purchasing process.

## **COMPARISON OF THE MARKS**

19. The marks to be compared are:

Opponent's mark	Applicant's mark
<b>STONEFLY</b>	<b>STONE-DRI</b>

20. I have compared the marks and come to the conclusion that the marks are visually similar to a medium degree and aurally similar to a reasonably high degree

21. Again I have come to these conclusions for the same reasons as the previous hearing officer. In the interests of procedural economy, I do not propose to give the

same reasons in different words but will instead adopt paragraphs 49 to 50 and 52 to 54 of the reasoning set out in the previous decision as my own. That reasoning is outlined below.

“49. 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 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”.

50. 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 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. The marks to be compared are:

52. The applicant’s mark consists of the common dictionary word “STONE” and the letters “DRI”, connected by a hyphen. I am not persuaded by the applicant’s argument that the mark is dominated by the “DRI” element, both because the average consumer is likely to perceive it as a misspelling of the word “dry” and because the position of the letters “DRI” at the end of the mark reduces somewhat their impact in the overall impression. I consider that “STONE” and “DRI” make a roughly equal contribution to the overall impression. The hyphen plays only a very weak role.

53. The opponent's mark consists of the word "STONEFLY". The average consumer is likely to perceive the common words "STONE" and "FLY" in the mark, though neither dominates and the overall impression rests in the whole.

54. Both marks share the same first element, namely the word "STONE", but the second elements of the marks are different. The marks are visually similar to a medium degree. In terms of the aural comparison, the marks are made up of two syllables, the first of which is the same. However, as both also end in a "y" sound, the aural similarity between the marks is reasonably high.

22. With regard to the conceptual comparison, I have considered the applicant's and opponent's submissions. The applicant submits that:

"'STONE-DRI' will be read and understood by the relevant public as "stone dry". This has a clear conceptual meaning of being something which is as dry as stone, i.e. very dry. Conceptually, this informs the average consumer as to the potential qualities of the products and, in relation to clothing, creates the clear conceptual meaning of something being dry, e.g. waterproof".

Whereas the opponent submits that:

"It is accepted that a stonefly is a type of small insect being a sub-species of riverfly but we submit that many adults in the UK would not know that a stone fly is a type of fly. Because they are only found in and around stony river and lakes, it would probably only be anglers who would be expected to be aware of this type of fly, unless the individual concerned has a particular academic interest in this sub species, plecoptera. Our submission therefore is that it is going too far to say that the mark STONEFLY has a clearly understandable conceptual meaning within the UK. It could well be seen as an invented word."

23. I agree with the applicant that the mark STONE-DRI will be seen and understood as "stone dry". However I disagree that this brings to mind a clear message of something which is as dry as stone or very dry. It is not a common English idiomatic

expression for dryness. At best the immediately graspable concept is that of something 'of stone' and a reference to 'dry', which do not work together to give a clear conceptual message in their totality. In relation to the concept of the earlier mark, I agree with the opponent's submission that most consumers will not know what a stone fly is. Some, as stated, may know what a stonefly is and some may make a guess that it is some kind of fly, given that most flies are preceded by an attributive noun, e.g. horsefly or sandfly, but it is by no means a certain assumption. Overall then I consider the marks to be conceptually neutral.

## **DISTINCTIVE CHARACTER OF THE EARLIER MARK**

24. I have reviewed the assessment of the distinctiveness of the earlier mark in the previous decision in relation to the issue of inherent distinctiveness or enhanced distinctiveness acquired through use. I am satisfied that the evidence supplied is insufficient to prove that the earlier mark enjoys enhanced distinctiveness and I should consider only the inherent distinctiveness. There was nothing within the opponent's submissions which has caused me to reach a different conclusion. Again, my reasons coincide with those of the previous hearing officer. Therefore, rather than use different words, I adopt paragraphs 57 to 60 of the previous decision as outlined below.

“57. 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. In *Lloyd Schuhfabrik*, 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-2779, 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)”.

58. Invented words usually have the highest degree of distinctive character, while words which are descriptive of the goods normally have the lowest. Distinctiveness can be enhanced through use of the mark. Although the opponent has not made a specific claim of enhanced distinctiveness, it has filed evidence of use. For the purposes of this assessment, the relevant market to which I must have regard is the UK market<sup>7</sup>. There is some evidence of sales to the UK but it is limited. Any evidence of promotional activity is confined to continental Europe. On the basis of the evidence filed, I am unable to determine that the earlier mark has an enhanced distinctive character in relation to the goods at issue.

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<sup>7</sup> On the irrelevance of a reputation in continental Europe when assessing enhanced distinctiveness for the purposes of Section 5(2), see the comments of Iain Purvis QC, sitting as the Appointed Person, in *China Construction Bank Corporation v Groupement des cartes bancaires* (BL O/281/14) at [30]-[34].

59. I therefore have only the inherent position to consider. The applicant claims that “[t]he use of the word “stone” in relation to clothing, footwear and headgear is [...] highly prevalent within the industry. As such, “stone” has a low distinctive quality within the market”. Its evidence in support of that submission consists of the details of eight trade marks and five web prints showing companies including “stone” in their name. Given the size of the market, that evidence is clearly insufficient to support the applicant’s contention.

60. The earlier mark contains two common dictionary words, neither of which is descriptive of the goods. The conjoining of the words is somewhat unusual. I consider that the earlier mark has an average degree of inherent distinctive character.”

## **LIKELIHOOD OF CONFUSION**

25. I must now draw together my earlier findings and the findings of the previous decision into the global assessment of the likelihood of confusion, keeping in mind the following factors:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*).

26. So far it has been established that the goods at issue in class 25 are identical and that the average consumer is a member of the general public who will select the goods by primarily visual means whilst paying a normal degree of attention during

the purchasing process. I also found that the earlier mark has an average level of inherent distinctiveness

27. In terms of the mark comparison, I found that they are visually similar to a medium degree, aurally similar to a high degree and conceptually neutral. Given that the selection and purchasing process will be primarily visual, then the visual and conceptual consideration will predominate. In which case I do not believe there is a likelihood of direct or indirect confusion in this matter. Further, to the limited extent that there is risk of aural confusion through goods being bought or avoided as a result of aural recommendations (or the opposite), I find that this risk is further mitigated by the fact that (a) although similar to the ear, the marks do not sound the same, and (b) the average consumer is deemed to be reasonably careful and circumspect. They can therefore be assumed to be the sort of person who makes reasonable enquiries before purchasing (or avoiding) a brand of footwear based purely on misheard comments.

## **CONCLUSION**

28. The opposition has failed so subject to any successful appeal, the application will proceed to registration.

## **COSTS**

29. As the applicant has been successful, they are entitled to a contribution of their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4/2007 (which was in force at the point these proceedings began). Bearing in mind the guidance given in TPN 4/2007, but making no award to the applicant in respect of their evidence as it did not assist in these proceedings, I award costs to the applicant as follows:

£200            Considering the Notice of Opposition and filing a counterstatement

£400            considering the opponent's evidence and filing written submissions

**£600**            **Total**

30. I order Stonefly S.p.A. Limited to pay Joel Harry Brown the sum of **£600**. 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 23<sup>rd</sup> day of August 2017**

**June Ralph**  
**For the Registrar**  
**The Comptroller-General**