

**O-634-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3175538  
BY RIVIERA HOME FURNISHINGS PVT. LTD. TO REGISTER THE FOLLOWING  
SERIES OF TWO TRADE MARKS**

**Riviera — Luxury Carpets**

**Riviera — Luxury Carpets**

**IN CLASS 27**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 407836  
BY RIVIERA HOLDING B.V.**

## Background and pleadings

1) Riviera Home Furnishings Pvt. Ltd. (“the applicant”) applied to register a series of two trade marks (application number 3175538) on 20 July 2016. It was accepted and published in the Trade Marks Journal on 5 August 2016. The marks and the goods it was applied for are:

**Riviera – Luxury Carpets**

**Riviera – Luxury Carpets**

**Class 27:** *Carpets, rugs, mats and matting, for covering existing floors.*

2) Riviera Holding B.V. (“the opponent”) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier International Registration designating the EU (“IREU”) number 876616 that designated the EU on 6 July 2005, claiming priority from 24 June 2005 (Benelux), and is in respect of the trade mark:



3) The following goods and services are relied upon:

**Class 20:** *Furniture ...*

**Class 35:** *... retail trade services relating to furniture and home decoration products, business intermediary services regarding purchase, sales, import and export of ... carpets, rugs*

4) This IREU is an earlier mark in accordance with section 6 of the Act by virtue of it having a date of designating the EU (that includes the UK) that pre-dates the filing date of the contested application. The IREU was granted protection in the EU on 12 April 2007.

5) The opponent submits that the respective goods and services are similar and that the marks are similar with the dominant word in each trade mark being the same, namely, the word “Riviera”.

6) The opponent also submits that the application offends under Section 5(4)(a) of the Act. This is on the basis of its claimed earlier right in the sign *Riviera Maison*. It claims to have been trading under the sign in the UK since 2012 and has acquired “a significant reputation and goodwill” under the sign. Use of the trade mark applied for would therefore be a misrepresentation to the public and would therefore give rise to an actionable passing off.

7) The applicant filed a counterstatement denying the claims made putting the opponent to proof of use of its earlier IREU.

8) The opponent was represented throughout these proceedings by James Love Legal and the applicant by Albright IP Limited.

9) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Written submissions have also been provided by both sides which will not be summarised but will be referred to if necessary during this decision. No hearing was requested and so this decision is taken following careful consideration of all the papers.

## Opponent's evidence-in-chief

10) This consists of a witness statement by J. Eijkman, Director of the opponent. It is stated that the opponent has used its mark in the UK for over 8 years.

11) An extract from the opponent's website is provided at Exhibit JE2 detailing its history from its beginnings as a florist in Amsterdam in 1948. It produced its first line of furniture in 1993 and adopted its current name in 1997. Other highlights include:

- being voted the "Best Chain Store in the Netherlands" in 2008;
- opening its first "flagship store" in Germany in 2009;
- opening a store in Helsinki in 2010 and a second store in Germany;
- it opened its 17<sup>th</sup> store in the Netherlands in 2013
- a second store in Hamburg is opened in 2014.

12) Copies of catalogues dated between 2012 and 2016 are provided at Exhibit JE3. These show the opponent's device and word mark on the front cover of the 2015 catalogue and the front and back covers of the 2016 catalogue (but nowhere else) and a number of examples of the word mark *Rivière Maison* appearing as a heading above the opponent's contact details in the Netherlands. The catalogues are in English and they display various beds, wardrobes, cabinets, chairs, tables, benches, tables and rugs. The goods are not priced.

13) Pages of the opponent's website are provided at Exhibit JE4. These show the words *Rivière Maison* appearing at the top of the pages, but not the word and device mark. These pages show rugs and furniture. Under the heading "Furniture" are images of a cabinet, a chair and a table and the following statement appears: "Each piece of furniture is hand made. Our furniture provides endless possibilities for variation, and there is something for every type of interior, so go ahead and mix and match". Prices are shown in Euros.

14) Exhibit JE5 consists of copies of five photographs showing labels on rugs (or carpets) bearing the mark *Rivière Maison*, a stylised "RW" or the earlier IREU. One

showing both the IREU and the word mark *Rivière Maison* is dated “08/2016” and another bearing the *Rivière Maison* word mark is dated “11/2016”. The others are undated.

15) It is stated that, since 2012 there have been 27 resellers of *Rivière Maison* in the UK and that there is currently (the statement is dated 24 April 2017) “15 active resellers”. These are listed. Two are indicated as being in Scotland, one in the North of England, one in the midlands and four in the south-east of England.

16) Mr Eijkman states that the opponent’s mark was first used in respect of furniture, in the UK, in 2009 and in respect of the services relied upon since 2011. UK sales are disclosed and in the last full five years before the relevant date in these proceedings, it has been in the range of €130,000 and €185,000 except for 2012 when it peaked at €275,000. These sales figures are supported by numerous sample invoices (Exhibit JE6), dated between January 2012 and 31 October 2016, that all prominently feature the earlier word and device mark at the top of the page. The goods referred to in these invoices include chairs, cabinets, dressers, tables, footstools, sofas, benches and bar stools. The precise description of the goods in these invoices may have some relevance to certain issues, however, I do not detail these descriptions here, but I will identify and discuss their relevance later. However, I note here that an invoice to a business in Berkshire, dated 6 August 2012, is in respect of the single item identified as “Taj Treasure Carpet grey 160x240”. Promotional spend in respect of the UK is provided and is in the region of £10,000 to £20,000 a year.

17) Annual sales figures are also provided for a list of 23 EU countries (in addition to the UK). In respect of the Netherlands, these figures are in the €18 million to €20 million, in respect of Germany they are in the €4 million to €6 million range and in respect of Finland and Belgium they are in the region of €1 million to €2 million. For most of the other countries, the figures are in the tens of thousands or low hundreds of thousands. Promotional spend for the EU as a whole is provided and is in the range €1.7 million to €2.2 million a year.

## Applicant's evidence

18) This takes the form of a witness statement by R. K. Bansal, President-Commercial of the applicant. He states that the applicant is an Indian company that is a leading manufacturer and exporter of various home furnishings, floor coverings, shower curtains, bedspreads, other bed products and home textiles. Mr Bansal describes how the applicant runs a subsidiary by the name of Riviera Home UK (hereafter "Home"), incorporated in the UK in October 2011.

19) Mr Bansal provides the following information regarding the applicant's presence in the UK:

- the applicant has been supplying the UK retail market with "a significant volume of bath mats and other goods" for 17 years and states later that Home is supplying a range of products that includes bath mats, rugs and broadloom carpet. At Exhibit RKB2 are copies of undated pages from Home's website where reference is made to "Riviera Home UK" and "Riviera Home Furnishings" and also the following mark appears in respect of the goods identified by Mr Bansal:



- it has "recently" (the witness statement is dated 21 June 2016) opened a 5,000 square foot warehouse and showroom in the UK;
- Exhibit RKB5 includes an invoice dated "13-06-07" to a company in Dorking in respect of bathmats. The total value of the goods that the invoice relates is recorded as over £14,000. Export figures are also provided in the same exhibit, but it is not possible from the information provided to ascertain which countries these exports related;

## **Opponent's evidence in reply**

20) This consists of a further witness statement by Mr Eijkman. This evidence includes, at Exhibit JE14, sample invoices issued to customers in Austria, Belgium, Germany, the Netherlands and Spain in the years 2013 to 2016. As with the UK focused invoices at Exhibit JE6, they all prominently feature the earlier mark at the top of each page and relate to numerous goods including tables, sofas, bureaus, stools and chairs.

## **Proof of Use**

21) The relevant provision is set out in section 6A of the Act:

“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.”

22) 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. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary



by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237 ). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [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).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

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 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].

(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].”

23) The following guidance of the Court of Justice of the European Union (“the CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, is also relevant in respect of assessing genuine use of a European Union Trade Mark (and by extension, an International Registration designating the EU):

“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).”

24) 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."

25) In *The London Taxi* Arnold J. also 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."

26) The General Court ("the GC") 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 (and equally an IREU) in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM or IR(EU). 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.

27) Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the IREU, 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

28) In its written submissions, the applicant states its view that “the opponent has failed to provide sufficient documentary proof of ... the evidence of use of their trade mark as filed”. However, it does not elaborate or provide any reason as to why it takes this view.

29) The opponent has provided evidence illustrating that it has:

- had 27 re-sellers of its goods in the UK since 2012 (15 of which were still current in April of this year). A list of these is provided, illustrating a geographical spread from Scotland to the South East of England;
- catalogues showing that it uses its mark in respect of beds, wardrobes, cabinets, chairs, benches and tables. Invoices provided in evidence all prominently display the mark. These invoices list numerous goods including various types of tables, mirrors, benches, stools, chairs, sofas and cabinets;
- UK sales have been in the region of €150,000 on average, per year in the UK;
- In addition to the UK invoices, numerous further invoices are also provided to third parties in Austria, Belgium, Germany, the Netherlands and Spain and relating to various goods including tables, chairs, stools, sofas and cabinets. As with the UK invoices, the earlier mark appears prominently at the top of each invoice.

30) Insofar as this evidence illustrates genuine use in respect of furniture, it suffers from an inadequacy, namely, on their face it is not clear whether the goods themselves are sold under the earlier mark, or whether they are merely provided by the opponent acting as a wholesaler of third party goods bearing other marks. The goods descriptions on all the invoices are mixed in their nature. The vast majority do not identify the individual items as *Riviera Maison* goods. There are a few exceptions, such as “Riviera Maison Toilet Brush”, “Riviera Maison Garbage Bin” (Exhibit JE14, page 55) and “Riviera Maison Mercury Ornament (Exhibit JE14, page 63), however, these references are not in respect of goods that would be described as “furniture”. Further, there are a few goods descriptions beginning with “RM ...”, that could be a reference to *Riviera Maison*, but once again, none of these are in respect of furniture.

31) Set against these inadequacies, I note that many of the descriptions of goods used in the invoices are not obviously referring to third party goods either. For example, some appear to be purely descriptive such as the following examples from the invoices provided at Exhibit JE14:

“Outdoor Rustic Rattan Nic. W Chair” (Page 74)

“Driftwood Flatscreen Sidetable” (p.91)

“Driftwood D.” Table (p.95)

“Outdoor Rustic Rattan Nic. W. Chair” (p.96),

“The Classic Footstool” (p.100)

32) Others appear to have a geographical theme, such as:

“San Sebastian glass cabinet” (p.79).

“Manhattan Loveseat linen Café Noir” (p.74)

“Hampton Island Chest draw” (p.92)

“San Sabastian book cabinet” (p.93)

“Corey Hill Dining Table” (p.95)

“Vancouver Island Diningt.” (p.96)

“New Orleans Wardrobe” (p.98)

“Richmond Mews Glass Cabinet” (p.98)



“Cape Breton Bench” (p.101)  
“Cedar Point Sofa” (p.101)  
“Newport Shutters Cabinet” (p.103)  
“Kensington 3,5 seater Sofa” (p.103)  
“St Malo Dining Chair” (p.103)

33) The regular occurrence of such descriptions points to the opponent using secondary marks to identify various ranges, but this is not explained in the evidence.

34) Others have descriptions that may be perceived as including trade names, such as the following:

“Hyannis Port Bench” (p.74)  
“SSSH...Bed Cabinet cream” (p.74)  
“Nicolas Wing Chair” (p.97)  
“Dune Deck Café Dining Armchair” (p.99)  
“Sanibel Coffeetable” (p.97)  
“Keith Lowback Barstool” (p.100)  
“Paramount Armchair” (p.103)

35) Taking all of the above into account, the evidence does not consistently point towards the opponent’s earlier mark being used in respect of “furniture”. The items of the type identified in paragraph 34 above suggest that they are third party goods being sold to third party retailers.

36) On the other hand, the other two categories in paragraphs 31 ad 32 suggest that the opponent is selling its own branded goods. This final point is also supported by Mr Eijkman who stated in his first witness statement that all the goods the opponent sells are designed in-house and by the fact that all the invoices prominently show the earlier mark appearing at the centre top of each page. Therefore, taking all of this into account, together with the reasonable levels of turnover and promotion referred to in the opponent’s evidence I conclude that, on balance, it has genuinely used its earlier mark in respect of numerous items of furniture and it is entitled to rely upon its earlier mark insofar as it covers “furniture” in Class 20.

37) The opponent also relies upon a list of retail services (as set out in paragraph 3, above). The evidence of genuine use in this respect includes statements from Mr Eijkman that illustrate that the opponent has stores in the Netherlands and at least two stores in Germany. The fact that the opponent was voted the “Best Chain Store in the Netherlands” in 2008 suggests that, at that time, the opponent operated a chain of stores in that country. The turnover and promotional figures provided do not separate the opponent’s trade in goods and its retail service provision and it is not clear, for example, if its disclosed turnover for countries such as Finland, Belgium and other countries relates to goods or its retail provision. There appears to be little else to show the nature of the use in its physical stores. For example, there are no exhibits showing the opponent’s earlier mark in use in any of its retail stores.

38) There is no other exhibits that support the claim to use in respect of the opponent’s retail services. The copies of catalogues provided show various items of goods but there are no prices shown and, whilst company contact details are provided on the inside of the back cover, including a telephone number and the following email address: sales@riviera-maison.nl, there is no other contact details provided as would normally be expected in a retail catalogue. This suggests to me that these catalogues are targeted at business to business customers rather than as part of a retail provision. Therefore, this evidence, in itself, does not support the claim that the opponent’s retail activities are identified by its earlier IREU.

39) The opponent also provides extracts from its website. This consists of 5 pages, but none of these show the earlier IREU. Therefore, this evidence fails to support any claim to genuine use.

40) In summary, the evidence fails to support the claim of genuine use of the earlier IREU in respect of the retail services relied upon in Class 35. There is no corroboratory evidence to support a claim that the opponent’s retail stores use the mark relied upon or that it is used as part of an Internet retail offering. Further, the opponent’s catalogues fall short of illustrating retail sales by telephone or other method.

41) Finally, the opponent also claims genuine use in respect of its *business intermediary services regarding purchase, sales, import and export ... carpets, rugs*. The term “intermediary” suggests that the opponent provides a link between third parties, but there is nothing in the evidence to support this claim. The closest the evidence does get is, as I have already noted at paragraph 34, a suggestion in the invoices that the opponent provides third party goods to other traders. However, this is far from clear and there is nothing else to suggest that it provides intermediary services. I reject the claim that it has made genuine use in respect of these services.

42) In light of these findings, for the purposes of assessing the opponent’s grounds based upon section 5(2)(b), it may only rely upon the following:

**Class 20: Furniture ...**

### **Section 5(2)(b)**

43) 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”.

### **Comparison of goods/services**

44) In the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, 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 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”.

45) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

46) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated that:

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

47) For ease of reference, the respective goods are as follows:

Opponent's goods	Applicant's goods
<b>Class 20:</b> Furniture ...	<b>Class 27:</b> Carpets, rugs, mats and matting, for covering existing floors.

48) In its written submissions, the opponent relies upon the results of the EUIPO's similarity search tool on its website <http://euipo.europa.eu/sim/search> to support its claims that *furniture* and *carpet* are similar in term of purpose, distribution channels and relevant public. I note the information provided on this database, however, as the "Home" page (<https://euipo.europa.eu/sim/>) clearly states, it is not legally binding on any entity and I must conduct my own analysis of similarity and I will do so below. Secondly, the results provided only relate to similarity between furniture and carpets and not to the broader term *coverings for existing floors*.

49) The respective goods are different in nature in that floor coverings are flat and without obvious three dimensional form, whereas furniture in its various guises will invariably have a form. Their intended purpose, at the highest level, are both chosen to "furnish" a home or other building. In this respect, I concur with the record held on the EUIPO's database. However, such similarity being at a broad level creates only a low level of similarity. At a more detailed level, the intended purpose of the respective goods is different. Floor coverings are intended to serve some aesthetic function but are also for providing a functional surface to walk upon, whether that be comfort (if in a home, for example), or hard wearing (in a commercial environment for example) and also to provide insulation. Furniture is also likely to have an aesthetic function but it will have numerous purposes depending on its form, such as to be sat upon in the case of chairs, sofas, stools etc, or to provide a platform to place things upon or in, such as in the case of tables, stands or cabinets.

50) In terms of methods of use, there is no similarity. Floor coverings are laid on the floor to be walked upon. Furniture is used in a way consistent with its function and is sat on (chairs), used to place items upon (tables), to display or store items (cabinets) etc.

51) In respect of trade channels, I recognise that traders specialising in home furnishing may sell both furniture and carpets/rugs. However, I also recognise that it is not uncommon for carpets to be sold from a specialist retailers displaying very many different styles of carpet and other floor coverings. Similarly, furniture may also be sold from specialist furniture outlets. Consequently, I find that there is overlap of trade channels, but that this is not always the case.

52) Clearly, there is no competition between the respective goods.

53) In respect of complementarity, I keep in mind the following guidance of the General Court (“the GC”) in *Boston Scientific Ltd v OHIM*, Case T-325/06, where it stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

54) I recognise that both furniture and carpets and other floor coverings may be chosen to create a specific aesthetic character and consequently they may be chosen to aesthetically complement each other. However, the same could be said in respect of any other items that may contribute to the aesthetic look such as a fire place or an ornament. When considered in this way, it is clear to me that aesthetic complementarity is insufficient for a finding of complementarity of the kind described in *Boston Scientific*.

55) Taking all of the above into account, I find that the respective goods share a low level of similarity.

***Average consumer and nature of the purchasing act***

56) 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*.

57) 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.”

58) In respect of the goods relevant to these proceedings, the average consumer may be ordinary members of the home furnishing buying public or business purchasers fitting out buildings on a commercial basis. In respect of the former, the purchase of the relevant goods will be occasional rather than regular. The cost of the various goods relevant to these proceedings is higher than for everyday products, but generally not being of the highest cost. Nevertheless, I accept that the costs involved when combined with the aesthetic requirement that the consumer may have, will lead to the level of care and attention being paid during the purchasing process being elevated to a degree. The purchasing act will usually be visual in nature because the aesthetic aspects of the goods play an important part in selection. However, I do not ignore that the purchasing act may sometimes be conducted over the telephone where aural considerations will play a part.

### ***Comparison of the respective trade marks***

59) It is clear from *Sabel BV v Puma AG*, Case C-251/95 (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 Court of Justice of the European Union 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.”

60) 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.

61) The respective marks are shown below:

Earlier trade mark	Contested trade marks
	<p data-bbox="834 1529 1342 1585"><b>Riviera</b> — Luxury Carpets</p> <p data-bbox="831 1727 1345 1783"><b>Riviera</b> — Luxury Carpets</p>



62) The opponent's mark consists of the words *Riviera Maison* separated by the device of a house, both surrounded by a double lined square border. The distinctive elements are the device of the house and the words *Riviera Maison*. They both appear prominently and are of similar proportions. Despite the words being separated by the device, they will be perceived as the single element *Riviera Maison* and I conclude that the words and device share equal dominance in the mark. The applicant's marks both consist of the word *Riviera* followed by a dash and the words *Luxury Carpets*. The words *Luxury Carpets* are descriptive in respect of the applicant's goods and also appear in a smaller font. The word *Riviera* is therefore, the dominant and distinctive element of the marks. I note that the first mark in the series is presented in the colour purple. Whilst I do not ignore this, it will not materially impact upon the level of similarity between the marks or the likelihood of confusion.

63) Visually, the marks share similarity by virtue of the word *Riviera* appearing in both marks. However, the presentation of the word differs with it appearing in an ordinary typeface in the applicant's mark and in a more stylised script more closely resembling a handwritten style. There are no other similarities between the marks. The addition of the device of a house and the word *Maison* in the opponent's mark are points of difference. Taking all of this into account, I find that the respective marks share a low to medium level of visual similarity.

64) Aurally, the opponent's mark will be expressed as the six syllables RIV-E-AIR-A-MAY-SON. The applicant's mark will be expressed as the nine syllables RIV-E-AIR-A-LUX-UR-E-CARP-ETS. The marks coincide in respect of the first four syllables but differ in length and in respect of the other syllables. Taking all of this together, I conclude that the respective marks share a medium level of aural similarity.

65) Conceptually, the marks coincide in respect of the word *Riviera* that will be readily understood as a reference to a coastal region with a favourable climate. This similarity is diluted to a degree because, in the opponent's mark, it forms part of the phrase *Riviera Maison*. The word *Maison*, is a French word meaning "house". Whilst the parties make no submissions regarding to what extent this will be understood by the UK average consumer, it is nevertheless a word that anybody who has studied

French at school, for example, will be familiar with. Therefore, for those UK consumers familiar with the word, the mark is likely to be perceived as a reference to a house or home named *Riviera*. This is reinforced by the device of a house. This combination (that includes the device of a house) makes it less likely that the word MAISON will stand alone and be perceived as an allusion to home or house furnishings. Whilst a small proportion of average consumers will have no or very little knowledge of the French language and may perceive the words as a reference to a coastal region and a made up word, but these consumers are likely to be in the minority. In addition to the word “Riviera”, the applicant’s mark also contains the words “Luxury Carpets”. This phrase has an obvious descriptive meaning that is absent in the opponent’s mark. Taking all of this into account, I conclude that, overall, the marks share a low to medium level of conceptual similarity.

### ***Distinctive character of earlier mark***

66) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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).”

67) The opponent’s mark consists of a number of elements that combine to create a mark of normal distinctive character. Furniture may be considered, more broadly, to be a category of home furnishings. In respect of these goods, the device of a house may play some kind of allusive role but this does not detract from my conclusion when it is factored into the mark, as a whole.

68) There is no specific claim by the opponent to an enhanced level of distinctive character through use in the UK, nevertheless, I comment on this briefly, in light of the evidence presented that goes to the issue of use in the UK. This shows that the extent of use is less than €200,000 per year (except one year when it peaked at €275,000). When this is considered within the context of a self-evidently huge UK market for furniture, I conclude that the opponent’s mark does not benefit from any enhanced level of distinctive character. Further, it is not evident what proportion of UK turnover relates to furniture as opposed to other items that commonly appear in the sample invoices provided, such as lunch sets, photo frames, toilet roll holders, lampshades, flower vases etc.

### ***Likelihood of confusion***

69) The following principles are gleaned from the decisions of the CJEU 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:

(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.

70) I have found that:

- the respective goods share a low level of similarity;
- the purchasing process is mainly visual in nature (but recognise that aural considerations may play a part);
- the average consumer can be the ordinary home furnishing purchasing public or business purchasers;
- the normal degree of attention paid during the purchasing process is elevated to a degree;
- The words *Riviera Maison*, present in the opponent's mark shares equal dominance with the device element and that the word *Riviera* is the dominant and distinctive element of the applicant's marks;
- the respective marks share a low to medium level of visual and conceptual similarity and a medium level of aural similarity, and;
- the opponent's mark has a normal level of distinctive character and that has not been enhanced through use.

71) The word *Riviera* in the opponent's mark forms part of the element *Riviera Maison* being perceived as a reference to the name of a house. The dominant element of the applicant's mark is the word *Riviera* being a reference to a coastal region. The difference in conceptual identity creates a dissidence between the marks. This alone, may not be fatal to the opponent's case, but when I factor in the visual differences between the marks and the fact that there is, at best, only a low level of similarity between the goods (despite the fact that they are all home furnishings), I conclude that there is no likelihood of confusion either direct (where the marks are confused with each other) or indirect (where the consumer will

assume that goods sold under the respective marks originate from the same or linked undertaking).

72) Finally, the applicant has also placed heavy reliance upon its mark being afforded protection as a well-known mark under the Paris Convention. I do not find this defence persuasive because the Paris Convention requires contracting parties (for which the UK is one) to provide trade marks (including well known trade marks) with a negative right in their national laws. Such a negative right is provided through mechanisms built into the Act for owners of marks to take action against what it believes to be an application or registration that infringes its mark. There is no requirement for a “positive right“, providing a mark with a right to use or registration. Therefore, I dismiss this defence.

73) In summary, I find that the opposition based upon section 5(2)(b) of the Act fails in its entirety.

#### **Section 5(4)(a)**

74) 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.”

75) Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based

on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

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

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

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

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

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

76) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

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

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

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

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

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

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

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have



acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

### ***The relevant date***

77) The relevant date for assessing if section 5(4)(a) applies has been discussed by Mr Daniel Alexander QC sitting as the Appointed Person in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11. A summary of the position provided by Allan James, for the Registrar, in *SWORDERS TMO-212-06* was quoted with approval and I reproduce it below:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

78) Mr Bansal makes a claim in his witness statement that the applicant has been supplying the UK retail market for 17 years (since 1999 is claimed in the counterstatement). The opponent claims that it has been trading under the earlier mark in the UK since 2012. I note the primary relevant date for the purposes of these proceedings is the filing date of the contested application, namely 20 July 2016. However, it is relevant that I also consider the nature of the claimed 17 years use by the applicant. Therefore, I will proceed on the basis that there is a potential additional date in 1999 as well as the filing date of the application that are relevant to my considerations.

### **Goodwill**

79) A long standing definition of goodwill is provided in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

80) The opponent, in its statement of case fails to expressly list the goods and services in which it claims that its goodwill extends. However, in his first witness statement, Mr Eijkman, states that the opponent’s mark was first used in the UK in 2009 in respect of furniture and since 2011 in respect of the services. He also provides photographs illustrating the *Riviera Maison* sign appearing on labels attached to carpets (or rugs) dated June and November 2016 respectively. The first of these dates predates the filing date of the contested mark. There is no evidence that the opponent has provided any services in the UK because the evidence is restricted to sales of its goods through its “resellers” in the UK. Mr Eijkman states that since 2012 the opponent has had 27 re-sellers in the UK (with 15 of these being current). The invoices exhibited showing sales to third parties in the UK confirm that various items of furniture have been supplied to UK resellers since 2012. The sign *Riviera Maison* does not appear on the invoices except:

- as part of the word and device mark relied upon in respect of the section 5(2)(b) ground, and;
- as part of both the email address [invoices@riviera-maison.nl](mailto:invoices@riviera-maison.nl) and the website address [www.riviera-maison.nl](http://www.riviera-maison.nl).

81) In addition, extracts of the opponent’s website show use of the sign RIVIERA MAISON at the top of each page. Whilst also showing items of furniture for sale, they are priced in Euros. Further, the opponent’s English language catalogues show a number of examples of the sign being used. I infer from the fact that these catalogues are in English, that they are the same catalogues available to its UK resellers.

82) Taking all of the above into account, I conclude that the opponent's goodwill is identified by its word sign *Riviera Maison* and that this goodwill extends across a number of geographical areas in the UK by virtue of its network of resellers. However, UK sales are modest and whilst I find that the opponent has the requisite goodwill, it is relatively modest. This goodwill relates to the sale of furniture and not to any services. Further, as I noted earlier, Mr Eijkman has provided a copy of a photograph dated shortly before the filing date of the contested application that shows the opponent's *Riviera Maison* sign appearing on a label attached to a carpet or rug. In the 125 pages of invoices provided relating to sales into the UK, there is only a single reference to a floor covering of any kind. This is in an invoice to a business in Berkshire, dated 6 August 2012 that is in respect of the single item "Taj Treasure Carpet grey 160x240". There is nothing further to corroborate a claim that the opponent's goodwill extends to such goods. I cannot find otherwise on the basis of a single photograph a a single sale some 4 years before the filing date of the contested mark.

## **Misrepresentation and Damage**

83) In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, 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 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.”

84) The question before me is whether the opponent's customers or potential customers, upon seeing the applicant's mark in use, will be deceived into believing that its goods originate from the opponent. My considerations relate to the following sign and marks:

Opponent's Sign	Applicant's Marks
Rivière Maison	<p style="text-align: center;"><b>Riviera</b> — Luxury Carpets</p> <p style="text-align: center;"><b>Riviera</b> — Luxury Carpets</p>

85) The word *Riviera* in the opponent's sign appears at the front of the sign and makes up over half of it. As I noted earlier, the word *Maison* will be understood by a number of consumers, and I would say that because of even a very rudimentary knowledge of the French language, a substantial number of members of the public in the UK will know that it means “house”. The word *Riviera*, whilst having a meaning

readily understood by members of the UK public, does not have a meaning in respect of the respective goods. It is therefore the dominant and distinctive element of both the applicant's mark and the opponent's sign. I conclude they share a good deal of similarity.

86) When considering the similarity of the respective goods under section 5(2)(b) of the Act, I concluded that they share a low level of similarity, finding that the respective goods are not being in competition. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA) (*Harrods*), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in the a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

87) Home furnishings are commonly sold by retailers specialising in this area. This may result in the parties goods being encountered in the same retail outlet and the public may believe that the opponent has diversified into floor coverings. In reaching this conclusion, I keep in mind that the respective sign and marks here are somewhat more similar than the marks I considered in respect of the section 5(2)(b) grounds. The opponent is relying upon the word sign *Riviera Maison* and not its registered word and device mark. When this is also factored in, I conclude that a substantial number of members of the public upon encountering the various goods sold under the respective marks and sign, will believe that the same undertaking is responsible for both. Consequently, I conclude that use of the applicant's mark would result in misrepresentation of the opponent's word sign.

88) Whilst furniture and floor coverings may not be in competition, damage may still occur. In *Harrods*, Millett L.J. described the requirements for damage in passing off cases like this:

“... damage ... may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

89) Having found the existence of misrepresentation, it follows that in situations like here, where the goods are sold adjacent to each other in home furnishing retail stores, there is a real risk that damage of the type identified above.

90) In conclusion, I find that grounds, insofar as they are based upon section 5(4)(a), would be successful at the filing date of the contested mark unless the applicant's counterclaim provides it with a successful defence.

91) The applicant's counterclaim is that it has been trading in the UK for 17 years. This raises the issue of whether there is a concurrent goodwill and if so, what impact it has on these proceedings. In *W.S. Foster & Son Limited v Brooks Brothers UK Limited*, [2013] EWPC 18 (PCC), Iain Purvis Q.C. sitting as a Deputy Judge set out the following test for whether honest concurrent use provides a defence in a passing off action:

"61. The authorities therefore seem to me to establish that a defence of honest concurrent use in a passing off action requires at least the following conditions to be satisfied:

(i) the first use of the sign complained of in the United Kingdom by the Defendant or his predecessor in title must have been entirely legitimate (not itself an act of passing off);

(ii) by the time of the acts alleged to amount to passing off, the Defendant or his predecessor in title must have made sufficient use of the sign complained of to establish a protectable goodwill of his own;

(iii) the acts alleged to amount to passing off must not be materially different from the way in which the Defendant had previously carried on business when the sign was originally and legitimately used, the test for materiality being that the difference will significantly increase the likelihood of deception."

92) It is clear from the applicant's evidence that it has a long standing business under its RIVIERA brand and that its goods have been exported to a number of countries, including the UK, for a number of decades. This indicates to me that the first use of its various RIVIERA signs in the UK was entirely legitimate.

93) In respect of activity in the UK, the relevant parts of Mr Bansal's evidence are:

- By virtue of "continuous and extensive use over the ... past 17 years in the UK ... Riviera's trade mark RIVIERA and its variations thereof has become

distinctive and is well-known and exclusively identified with Riviera and its goods and services alone”;

- The applicant incorporated its UK subsidiary on 5 October 2011;
- The applicant has “recently” (the witness statement is dated 21 June 2017) established a warehouse, showroom and administrative offices in the UK;
- Undated web pages, printed on 20 June 2017, from Home’s website illustrate use of the word sign “Riviera HOME UK” and the following sign:



- An invoice, dated 13 June 2007, from the applicant to a business based in Dorking in respect of various bathmats and totalling over £14,000;

94) When taking all of the above together, whilst there is no use shown of the applied for mark, there is use of a number of other RIVIERA signs by the applicant. Such use results in the applicant having its own goodwill attached to these signs at the both the date the opponent claims that its goodwill begins (in 2012) and also at the date it applied for the mark on 20 July 2016. Further, I would say that these signs are more similar to the opponent’s mark than the applied for mark because they include the word “Home” that will be perceived by a substantial part of the general public as meaning the same as, or at least analogous to, the word “Maison” in the opponent’s mark.

95) I find that, as a result of the applicant’s use in the UK of its RIVIERA signs, it has traded concurrently with the opponent’s sign and enjoys goodwill that is concurrent to that of the opponent. Consequently, I find that the market position should remain unchanged and the opponent is not entitled to prevent the use of the applied for mark under the law of passing off.

96) In conclusion, I find that grounds, insofar as they are based upon section 5(4)(a), fail because the applicant has shown that it benefits from a concurrent goodwill.



## **COSTS**

97) The applicant has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 2/2016. I take account that both sides filed evidence and written submissions in lieu of a hearing. With this in mind, I award costs as follows:

Considering statement and preparing counterstatement	£400
Preparing evidence and considering other side's evidence	£800
Preparing written submissions	£400
<b>Total:</b>	<b>£1600</b>

98) I order Riviera Holdings B.V. to pay Riviera Home Furnishings PVT. Ltd. the sum of £1600 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

**Dated this 11th day of December 2017**

**Mark Bryant**  
**For the Registrar**  
**The Comptroller-General**