

**o/189/18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF THE APPLICATION BY  
OPERA PARTNERS LTD  
UNDER NO 3199514 FOR THE TRADE MARK**

**OPERA**

**AND**

**IN THE MATTER OF OPPOSITION NO. 409227 THERETO**

**BY**

**ADOLF RIEDL GmbH & Co KG**

## Background and pleadings

1) Opera Partners Ltd (“the Applicant”) applied to register the following trade mark (“the opposed mark”) in the UK on 30 November 2016:

### OPERA

It was accepted and published for opposition purposes in the Trade Marks Journal on 10 February 2017 in respect of goods and services in Classes 25, 26 and 41. Only the specification in Classes 25 and 26, however, as shown below, is opposed in these proceedings:

**Class 25:** *Clothing; footwear; headgear; swimwear; sportswear; leisurewear.*

**Class 26:** *Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.*

2) Adolf Riedl GmbH & Co KG (“the Opponent”) opposes the registration of the trade mark under section 5(1) of the Trade Marks Act 1994 (“the Act”), on the grounds that it is identical with an earlier mark and for identical goods as the earlier mark, and under section 5(2)(a) of the Act, on the grounds that it is identical with an earlier mark and for similar goods as the earlier mark. For the purposes of its claims under sections 5(1) and 5(2)(a) the Opponent relies upon International Registration designating the EU No. 596176 (“the earlier mark”), for the following mark:

### OPERA

The earlier mark is registered for the following goods, which are relied on for the purposes of this opposition:

**Class 25:** *Bathing and beach clothing.*

3) The earlier mark has an international registration date of 18 December 1992, the date of designation of the EU being 17 September 2008, and it was granted protection in the EU on 28 September 2009. The significance of these dates is that (1) the

Opponent's mark constitutes an earlier mark in accordance with section 6 of the Act, and (2) it is subject to the proof of use conditions contained in section 6A of the Act, the conferring of protection having been completed more than five years before the publication of the opposed mark.

4) The Applicant filed a counterstatement, denying the claims made. It also put the Opponent to proof of use of the earlier marks in respect of the goods relied on. The period during which use must be proved ("the relevant period") is 11 February 2012 to 10 February 2017. The Applicant is not professionally represented in these proceedings. The Opponent is represented by Brookes Batchellor LLP. The Opponent filed evidence. The Applicant filed written submissions in reply during the evidence rounds. No hearing was requested. The Opponent filed written submissions in lieu of attendance at a hearing. The Applicant referred to its counterstatement and its earlier written submissions in reply. I therefore give this decision after a careful review of all the papers before me.

#### **Summary of the Opponent's evidence**

5) In a witness statement of 19 September 2017 Mr Jens Friemann explains that the Opponent is a limited partnership under German law, of which the general partner is itself a limited liability company. Mr Friemann states that he is the CEO of this corporate general partner. He further states that the Opponent produces and distributes bathing wear and beachwear under the trade mark OPERA, the mark being attached to each product in the sewn-in label and the swing tag, images of which he provides. He also provides a series of tables showing turnover and sales figures for goods marked with the OPERA trade mark in the UK and European Union between 2012 and 2017. He includes a further table giving turnover and sales figures of selected OPERA-branded products (swimsuits, bikinis, tankinis and dresses) during the business year 2015/2016.

6) Mr Friemann states that the Opponent sells its products to a number of outlets throughout the European Union, and attaches as Exhibit JF2 what he describes as a representative sample of invoices for these outlets in 2015 and 2016, to show use of the earlier mark. Giving figures for the number of OPERA-branded catalogues

produced and distributed in the years 2013-2016, he attaches as Exhibits JF3, JF4. Exhibits JF5 and JF6 consist of scanned pages from the OPERA-branded catalogues in 2013, 2014, 2015 and 2016 to show use of the earlier mark. Using the “Wayback Machine” he attaches copies of webpages as they appeared at points in the past to show use of the earlier mark in the relevant period. Exhibit JF8 consists of examples of press releases issued in 2012, 2014, 2015 and 2016.

### **The law on proof of use**

7) Section 6A of the Act reads as follows:

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.”

8) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised (at paragraph 217) the case law on genuine use of trade marks. He said:

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

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

(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].”

9) Where earlier marks are EUTMs, he added (at paragraph 227) the following further points:

“(9) 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: *Leno* at [44], [57].

(10) While it is reasonable to expect that a Community trade mark should be used in a larger area than a national trade mark, it is not necessary that the mark should be used in an extensive geographical area for the use to be deemed genuine, since this depends on the characteristics of the goods or services and the market for them: *Leno* at [50], [54]-[55].

(11) It cannot be ruled out that, in certain circumstances, the market for the goods or services in question is in fact restricted to the territory of a single

Member State, and in such a case use of the Community trade mark in that territory might satisfy the conditions for genuine use of a Community trade mark: *Leno* at [50]”.

### **The evidence of use**

10) The Applicant submits that the evidence discloses that the Opponent has used the earlier mark in a form differing in elements which alter the distinctive character of the mark in the form in which it was registered, i.e. it has used it as follows:



This is the form in which the mark is presented in the images of sewn-in labels and swing tags provided by Mr Friemann. It also appears in this form in the catalogue pages and web pages in the exhibits attached to his witness statement. I do not agree that the distinctive character of the earlier mark has been altered here. The average consumer will see the phrase “swim fascination” as a promotional slogan. The use of the ® symbol after both the logo on the left and the word OPERA will flag up the fact that two marks are being jointly affixed here. Finally, I consider that the mild stylisation of the straightforwardly legible word OPERA, including the omission from the E of its normal vertical stroke, will be regarded by the average consumer as a decorative presentation, rather than as having distinctive significance.

11) Even if I am wrong in thinking that the average consumer will not attribute distinctive significance to the mild stylisation of the word OPERA shown above, however, there has in any case been ample use of the mark OPERA in plain font and block capitals, for example, at the bottom of every page scanned from the 2015 and 2016 catalogues. Moreover, I bear in mind that trade marks are not only used on the market in which goods bearing the mark are sold to consumers and end users. In *Laboratoire de la Mer Trade Mark* [2006] FSR 5, the Court of Appeal held that sales



under the mark to the trade may qualify as genuine use<sup>1</sup>. The word OPERA in plain font and block capitals appears prominently at the top right-hand corner of all the commercial invoices provided in Exhibit JF2. The evidence therefore in any event discloses ample use of the earlier mark as registered in connection with the goods billed in the invoices from 2015 and 2016 in Exhibit JF2 and those appearing in the 2015 and 2016 catalogues in Exhibits JF5 and JF6.

12) The Applicant submits that “the pertinent sales revenue to be considered for this opposition is the sales revenue in the United Kingdom”. This submission is misconceived. Since the earlier mark is an international registration designating the EU, genuine use of the mark must be shown in the EU, as required by section 6A(5) of the Act. The Applicant goes on to submit that it is unlikely that the low volume of alleged goods bearing the mark can amount to genuine use of the earlier mark in the UK.

13) The quantity of catalogues distributed under the trade mark OPERA varies from 3,300 in 2013 to 2,613 in 2016. In the business year 2012/2013 the turnover statistics provided by Mr Friemann show figures for Germany of €889,000 and €127,000 for bathing wear and beach wear respectively. The corresponding figures for the Benelux countries are €229,000 and €52,000 respectively, and for Italy €150,000 and €24,000. Smaller figures are given for other EU countries. The relative proportion of the figures as between countries remains roughly constant in the business years 2013/14, 2014/15 and 2015/16. In the business year 2016/2017 the figures for Germany are €1,060,000 and €144,000 for bathing wear and beach wear respectively. The corresponding figures for the Benelux countries are €343,900 and €42,000 respectively, and for Italy €126,000 and €11,000. Again, smaller figures are given for other EU countries.

14) It is true that not every proven commercial use of the mark may automatically be deemed to constitute genuine use<sup>2</sup>. I must also bear in mind, however, that the

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<sup>1</sup> See paragraphs 48-49. See also the judgment of the General Court in *Fruit of the Loom v EUIPO*, Case T-431/15 at paragraphs 48-50

<sup>2</sup> This is clear from the reasoned order of the CJEU in *Reber Holding & Co KG v OHIM* Case C-141/13 P

purpose of the requirement for genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade mark protection to the case where large scale commercial use has been made of the marks (*Sunrider v OHIM — Espadafor Caba (VITAFRUIT)* T 203/02, paragraph 38 and the case-law cited). 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. The question I must address is whether the proven use was commercially warranted in the marketplace, taking account of all the relevant interdependent facts and circumstances of the case.

15) The figures may be very small in terms of what must be a huge EU market for bathing and beach wear, but they are not insignificant. The picture that emerges from the invoices in Exhibit JF2, taken together with the figures given by Mr Frieman in his witness statement, is of an enterprise with a fairly strong foothold of sales of bathing and beach clothing under the earlier mark in its base markets within the EU, i.e. principally Germany and Benelux, but also using the mark more widely in other EU countries. Though the figures for other EU countries are modest, they show a certain geographic spread, continuity and consistency of purpose. Stepping back and viewing the evidence as a whole, I am satisfied that there has been genuine use of the earlier mark in the EU during the relevant period in respect of the following products: swimsuits, bikinis, tankinis, shirts, blouses, frocks, dresses, ponchos, trouser suits and hats.

### **A fair specification**

16) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law on framing a fair specification as follows:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of

the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

17) My task in considering what would constitute a fair specification is not to cut the Opponent’s protection 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 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<sup>3</sup>. But conversely, if the average consumer would consider that the goods for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly.

18) When it comes to understanding what terms used in specifications mean and cover, the guidance in the case-law is to the effect that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”<sup>4</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>5</sup>. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category

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<sup>3</sup> See on this Carr J's summary of the General Court's decision in *Mundipharma AG v OHIM* (Case T-256/04) at paragraph 47 of his decision in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch).

<sup>4</sup> *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281

<sup>5</sup> *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

19) I consider that the term *bathing clothing* in its ordinary and natural meaning is apt to cover the type of clothing used for aquatic activities such as swimming, and represents a suitably coherent category or sub-category providing the Opponent with fair protection in the light of the goods, such as *swimsuits* and *bikinis*, for which I have found genuine use in paragraph 15 above. I consider that the term *beach clothing* in its ordinary and natural meaning is apt to cover the type of clothing suitable for wearing on the beach and represents a suitably coherent category or sub-category providing the Opponent with fair protection in the light of the goods, such as *tankinis, shirts, blouses, frocks, dresses, ponchos, trouser suits* and *hats*, for which I have found genuine use in paragraph 15 above. Accordingly, I find that the Opponent's Class 25 specification as it currently stands, as shown below, represents a fair specification, on which the Opponent can rely for the purposes of this opposition:

**Class 25:** *Bathing and beach clothing.*

### **Section 5(1)**

20) Section 5(1) of the Act reads:

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

### **Section 5(2)(a)**

21) Section 5(2)(a) of the Act reads as follows:

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

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

### **Comparison of goods and services**

22) In the judgment of the CJEU in *Canon*, 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”.

23) 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.

24) *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case T- 325/06 provides guidance on when goods are to be regarded as complementary:

“It is true that goods are complementary if 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.”

25) In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

26) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”), the General Court 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 fur 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 (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

## Class 25

27) I consider the Applicant's *swimwear* to be coterminous in meaning with the Opponent's *bathing clothing*; the goods are identical. The Opponent's *bathing clothing* falls within the ambit of the Applicant's *sportswear* and is thus identical according to the guidance in *Meric*. The Opponent's *bathing and beach clothing* also fall within the ambit of the Applicant's *leisurewear* and are thus identical according to the guidance in *Meric*. Similarly, the Opponent's *bathing and beach clothing* cover goods falling within the ambit of the Applicant's *clothing; footwear; headgear*; there is identity under the principle explained in *Meric*. The Applicant's mark is visually, aurally and conceptually identical with the earlier mark and I have found all of the goods of the Applicant's specification in Class 25 to be identical with those of the earlier mark in Class 25. Accordingly, **the opposition succeeds under section 5(1) in respect of all the goods of the Applicant's specification in Class 25.**

## Class 26

28) The Opponent submits that the goods of the Applicant's specification in Class 26 are complementary to those of the Opponent's goods in Class 25. In particular, it submits that the goods of the Applicant's specification in Class 26 include dressmaker's articles which by their nature are complementary to clothing goods, because they would be used in conjunction with clothing – for example, where consumers wish to make modifications to clothing they have purchased. While I accept that some consumers who purchase clothing may also purchase dressmaking items, that level of generality cannot in itself give rise to similarity. The Applicant's *lace, embroidery, ribbons* and *braid* might be said to have a similar physical nature to the Opponent's goods in Class 25 in the very broadest sense that they are both composed of textiles; but again, this is only at an extremely broad level of generality. Their intended purpose and method of use are quite different and there is no competitive relationship between them. While such goods may be used to adorn articles of clothing, that does not (for the reasons explained in *Les Éditions Albert René v OHIM*) make them similar nor (in the absence of evidence to suggest that those conducting a trade in clothing also conduct a trade in such goods) does it make them

complementary in the sense explained in *Boston Scientific Ltd v OHIM*, i.e. in the sense that the consumer would think that the responsibility for the Applicant's goods lies with the Opponent. There is no similarity between these goods and those of the Opponent.

29) The nature of the Applicant's *buttons, hooks and eyes, pins, needles and artificial flowers* and that of the Opponent's goods in Class 25 is different, as is their intended purpose and method of use. There is no competition between such goods. While it is true that *buttons, hooks and eyes* have an important role to play in the use of clothing, this does not make them complementary in the sense explained in *Boston Scientific Ltd v OHIM*; nor, for the reasons explained in *Les Éditions Albert René v OHIM*, does the mere fact that they may be used as components in some of the Opponent's goods suffice in itself to show that the finished goods containing them are similar. There is no similarity between these goods and those of the Opponent.

30) I have found no similarity between any of the Applicant's goods in Class 26 and those of the Opponent. Where there is no similarity between the goods and services, neither identity between the marks nor a good degree of distinctive character in its earlier mark will help the Opponent's case; as the CJEU pointed out in case C-398/07, *Waterford Wedgwood plc v OHIM*, neither of these make up for the total absence of similarity. Since I have found no similarity between any of the Applicant's goods in Class 26 and those of the Opponent, one of the conditions necessary to establish a likelihood of confusion is lacking. Accordingly, **the Opponent's opposition under section 5(2)(a) fails in respect of all the Applicant's goods in Class 26.**

31) In view of the broad nature of the terms *clothing, footwear and headgear* in the Applicant's specification in class 25 I have considered whether an amendment of this specification could be made to avoid not only identity under section 5(1) but also a likelihood of confusion under section 5(2)(a). I have concluded that this would not be a practical expedient in this case. Since identical marks are in play, the penumbra of protection of the goods in the Opponent's class 25 specification will extend very widely to clothing in Class 25. The boundaries between casual clothing and more formal clothing are more fluid than they once were, and so are the contexts in which clothes are worn, as is illustrated, for example, by the reference in the 2015 press release on



page 12 of Exhibit JF8 to an item also being “ideal for warm summer evenings at home or out on the town”. It is nowadays not unusual to find items of casual and formal clothing supplied under the same mark. I also note that in the letter issued by the Tribunal to the parties when the proceedings were ready for substantive determination the Applicant was invited to make clear whether it had a fall-back position in the form of a limited specification. No fall-back position was submitted

## **Outcome**

32) The opposition succeeds in respect of all the goods of the Applicant’s specification in Class 25, as shown below. **The opposed mark may not proceed to registration in respect of these goods:**

**Class 25:** *Clothing; footwear; headgear; swimwear; sportswear; leisurewear.*

The opposition fails in respect of all the goods of the Applicant’s specification in Class 26, as shown below. **The opposed mark may proceed to registration in respect of these goods:**

**Class 26:** *Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.*

**The Applicant’s specification in Class 41 was not opposed, and may proceed to registration.**

## **Costs**

33) The Opponent has succeeded in its opposition to the Applicant’s specification in Class 25. On the other hand, the Applicant has successfully defended its specification in Class 26. The result might be described as a “score draw”. Neither side will be favoured with an award of costs.

**Dated this 26<sup>th</sup> day of March 2018**

**Martin Boyle  
For the Registrar,  
The Comptroller-General**