

**O-063-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3262317  
BY JOHN BEALE TO REGISTER:**

**MUSEUM SELECTION**

**AS A TRADE MARK  
IN CLASSES 3, 9, 16, 18, 20, 21, 25, 27, 28, 29, 30 AND 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 411519 BY KNOW HOW S.R.L.**

## **Background and pleadings**

1. On 09 October 2017, John Beale (“the applicant”) applied to register the trade mark MUSEUM SELECTION for a range of goods and services in classes 3, 9, 16, 18, 20, 21, 25, 27, 28, 29, 30 and 35 (the specification is reproduced in full in the annex to this decision).

2. The application was published for opposition purposes on 27 October 2017.

3. On 30 January 2018, Know How S.R.L. (“the opponent”), filed a notice of opposition to the application. The opposition is brought under Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Following a partial withdrawal of the opposition, the objected goods and services are as follows (under all of the three grounds):

**Class 18:** *Leather and imitations of leather; trunks; handbags; purses; wallets; toilet bags; rucksacks; travelling bags;*

**Class 25:** *Clothing; footwear; headgear; neck ties; hats; scarves; gloves; belts; pyjamas; dressing gowns;*

**Class 35:** *Retail, wholesale, internet retail or mail order retail services in relation to leather and imitations of leather, trunks, handbags, purses, wallets, toilet bags, rucksacks, travelling bags, clothing, footwear, headgear, neck ties, hats, scarves, gloves, belts, pyjamas, dressing gowns.*

4. In relation to the objection based upon Sections 5(2)(b) and 5(3) of the Act, the opponent relies upon its European Union Trade Mark (EUTM) No. 2986693 for the word mark MUSEUM, which was applied for on 20 December 2002 and registered on 30 March 2005. The opponent’s mark is registered in classes 18, 24 and 25 but the opponent indicates that it relies only on its registration for the following goods:

**Class 25:** *Clothing*

5. The mark relied upon qualifies as an earlier mark in accordance with Section 6 of the Act. Given its registration date, it is also subject to the proof of use provisions contained in Section 6A (in relation to the goods relied upon) and the opponent indicated that the mark has been used in relation to such goods.

6. Under Section 5(2)(b), the opponent claims there is a likelihood of confusion because the respective goods are identical or similar and the marks are similar.

7. Under section 5(3), the opponent claims that 1) the opponent is an Italian company specialising in outdoor jackets and coats; 2) the earlier mark has a reputation in the EU and in the UK in respect of clothing and 3) use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier mark.

8. The opponent further claims under Section 5(4)(a) of the Act that the sign MUSEUM has been used throughout the UK since 2014 in respect of clothing and jackets. The opponent claims that it has established a considerable goodwill in association with the sign and that use of the contested mark would amount to a misrepresentation to the relevant public that the applicant is the opponent or is licensed by the opponent. The goodwill of the opponent would, it claims, be damaged as a consequence.

9. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of its claims, including putting it to proof for the purposes of the proof of use provisions.

10. The opponent is represented by CSY London and the applicant is represented by Brand Protect Limited. Only the opponent filed evidence. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## EVIDENCE

### The opponent's evidence

11. The opponent's evidence consists of the witness statement of Diego Formato, dated 28 May 2018, with 29 exhibits. Mr Formato is the president of the opponent, a position he has held since 14 June 2016. Mr Formato states that:

- a) The opponent's company was established in Italy in June 2016. It specialises in outdoor jackets and coats sold under the brand MUSEUM. Exhibit 1 is an extract from what is said to be Italy's largest commercial database. It shows that the opponent was incorporated on 14 June 2016 and commenced its activity on 3 October 2016;
- b) The MUSEUM brand was created in Italy in 1986 and was initially used in relation to imported outdoor clothing from Canada;
- c) In 2003, in light of the growing success of the business, an own collection was created under the own brand MUSEUM. Since then, the MUSEUM brand has been used continuously in relation to outdoor jackets and coats. In this regard Mr Formato relies on Exhibits 2 and 3 which consist of undated screenshots from what is said to be the opponent's website – though the website address is not visible. The copies are in very small print but it is possible to discern the word MUSEUM used in relation to a range of outdoor jackets with a stylised maple leaf above it. It looks like this:



The goods are said to be from the 2017 winter collection and from the 2018 spring/summer collection. Mr Formato also states that more information about the opponent's activities under the MUSEUM brand can be found on its website at [museumtheoriginal.com](http://museumtheoriginal.com); this, it is later said, has operated since 2005<sup>1</sup>;

---

<sup>1</sup> §16

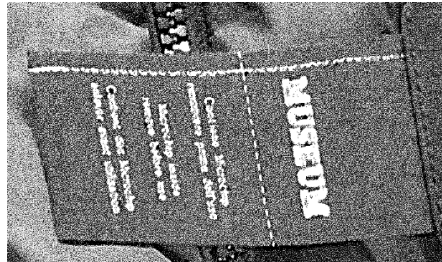
d) The opponent acquired the MUSEUM business and trade marks from the Italian company Interpool S.r.l on 29 September 2016. Prior to the acquisition by the opponent, its predecessor sold goods bearing the MUSEUM mark in various countries across the EU and beyond. In this regard, Mr Formato relies on, inter alia:

- Exhibit 4: it consists of photocopies of two MUSEUM catalogues for the periods “Fall/Winter 2012-2013” and “Fall/Winter 2014-2015”. The goods are outdoor jackets. The word MUSEUM appears 1) within the logo



- ; 2) within the texts “All Museum garments have thermal properties [...]”, “Museum is paying close attention to the choice of down inside garments [...]”, “Museum is using Thermore padding named Ecodown [...]”, “Museum is using Finn Raccoon of Finland origin [...]”; 3) within the website address WWW.MUSEUMORIGINAL.COM and 4) on product labels followed by a ® symbol with the product name (in smaller size) underneath it, e.g. Ground Field; a few labels also feature the representations of mountain landscapes, e.g. Antarctica, Fiumi e Foreste (see example of label C below);
- Exhibit 5: it consists of pages showing global turnover figures broken down by country, including non-EU countries. The figures are said to have been obtained from the opponent’s predecessor. The currency is not specified but Mr Formato says that the figures are in euros. The figures show global turnover of approximately 37 million for the period 2011-2015, most of which (between 70% and 90%) appears to relate to Italian sales. They also show UK annual turnovers of €23,550 (2011), €9,179 (2012), €23,160 (2013) and €47,859 (2014). There is no information about what goods (or brands) generated these figures. The figures appear to relate to the company as a whole and Mr Formato does not say that they relate specifically to items of clothing sold under the MUSEUM brand;

- Exhibit 6: consists of screenshots from the opponent's Facebook and Twitter pages. They show a number of MUSEUM branded outdoor jackets; these are said to be examples of products sold throughout the EU between 2012 and 2015. The word MUSEUM appears both on the pages and on product labels either on its own or within the logos shown below:



(Label A)



(Label B)



(Label C)



(Label D)

Some of the pages show various dates in 2014 and 2015. One of the pages, which is dated 16 December 2014, shows an outdoor jacket with the word MUSEUM above it. The description of the jacket is in Italian, with an English translation and the page look like that:



Another page<sup>2</sup>, dated 7 January 2015, invites followers to visit the Fall/Winter 2015-2016 Collection at fashion exhibitions in Florence (at Palazzo Pitti), Berlin (at Seek) and Paris (at Tranoi Homme Paris).

e) The opponent's products have been sold in various EU countries including Italy since 2003. Sales of MUSEUM branded products in the UK began in 2014. In this connection, Mr Formato produces the following documents which are said to cover the period January-October 2017:

- Exhibits 7: it is an excel spreadsheet which is said to list the EU countries where MUSEUM branded goods were sold. The list includes Canada. It indicates both the quantity sold and the sale value<sup>3</sup> but contains no information as to the categories of goods sold. The sale value appears to be of approximately 3 million (here again although the currency is not specified the figures are said to be in euros), most of which are Italian sales with only 29,785 being UK sales;
- Exhibits 8-12: it consists of excel spreadsheets listing the opponent's customers in the UK, Italy, France, Sweden, Germany and Spain. Mr Formato points out that the exhibits include details of sales in terms of quantities and values, however, once again, no information is provided as to the categories of goods sold;

12. Mr Formato exhibits to his witness statement the following invoices:

- A set of 11 invoices issued by INTERPOOL SPA to Italian companies on various dates in 2013 and 2014 (Exhibit 14). All, or nearly all<sup>4</sup>, of these invoices are for goods described as "*giacconi*" and "*giubbotti*" for the following amounts and quantities: €8.399 - quantity 90 (2013);

---

<sup>2</sup> Page 4

<sup>3</sup> The documents are in Italian but Mr Formato explains that the terms "Quantita" means the number of item sold and the term "Importo" means turnover.

<sup>4</sup> A number of invoices include items described as "look book" and "catalogo MUSEUM" but there is no charge for those items. Further, 2 invoices (see those exhibited at pages 1 and 23) include about 40 items described as "maglieria" (with no translation) at the cost of €31 each.

€67.705,51 – quantity 275 (2013); €90.428,84 - quantity 406 (2013); €60.037,73 – quantity 425 (2013); €17.681,46 – quantity 59 (2014); €22.124,00 – quantity 189 (2014); €5.293,38 – quantity 57 (2014); €24.839,30 – quantity 177 (2014); €10.837,26 – quantity 131 (2014); €64.062,20– quantity 250 (2014); €12.986,90 – quantity 76 (2014) for a total value of €384,395.58, corresponding to the sale of 2,133 items. The goods are labelled as “Linea MUSEUM”. Though the description of the goods is in Italian with no translation, it is possible to cross-reference some of the product codes corresponding to the Italian descriptions “*giacconi*” and “*giubbotti*” with 1) some of the product codes shown on invoices produced at Exhibit 15 (see below) corresponding to the English descriptions “heavy jackets” and “jackets”, e.g. MU19585 ART. MU151/953<sup>5</sup> and MU21713 ART. MU284/004<sup>6</sup> and 2) some of the fabric codes listed in the catalogues produced at Exhibit 4<sup>7</sup>, i.e. MU151, MU296, MU297, MU293, MU130, MU291 etc, which show use of the MUSEUM mark in relation to jackets and coats;

- A range of invoices issued on various dates in September and October 2017 by a company called BENCHMARK S.R.L. - which Mr Formato says has a licence agreement with the opponent - to consumers in Italy (Exhibit 14) and UK (Exhibit 15). The mark MUSEUM features on the top of each invoice, however it does not appear anywhere in the description of the goods. The goods here are identified by product names, e.g. ONTARIO, HELY ARTIC, and codes e.g. MS17AIUJA19NY057C002, which Mr Formato says “can be cross-referred with the product names shown on our website as per Exhibit 3”. However, there are no codes exhibited at Exhibit 3 so I can only assume that Mr Formato asked me to access the website to verify the names/codes he refers to. If Mr Formaro wished to corroborate this evidence by way of cross-

---

<sup>5</sup> See invoice exhibited at page 33 of Exhibit 15 and invoice exhibited at page 37 of Exhibit 14. The description of the articles identified by the identical code MU19585 ART. MU151/953 are *Giacconi* (invoice written in Italian) and *Heavy Jacket* (invoice written in English)

<sup>6</sup> See invoice exhibited at page 33 of Exhibit 15 and invoice exhibited at page 28 of Exhibit 14. The description of the article identified by the identical code MU21713 ART. MU284 are *Giubbotti* (invoice written in Italian) and *Jacket* (invoice written in English)

<sup>7</sup> Pages 15 and 26



references, he should have included copies of the webpages to which he refers;

- A range of invoices issued by INTERPOOL SPA to UK companies on various dates (some of which are illegible) (Exhibit 15). These include, inter alia, 14 invoices dated between 12 February 2013 and 15 September 2014 for goods described as “Line MUSEUM” “menswear” and “womenswear” most of which are described as jacket and heavy jackets, though one of the invoice also show sale of 11 waistcoats. The invoices are for the following amounts and quantities<sup>8</sup>: €3,318.50 – quantity 32 (2013); €180 – quantity 1 (2013); €2,431.00 – quantity 9 (2013); €287.00 – quantity 1 (2013); €150.17 – quantity 1 (2013); €287.00– quantity 1 (2013); €289.00 – quantity 1 (2013); €287.00 – quantity 1 (2013); €4,792.00– quantity 37 (2014); €4,701.00 – quantity 17 (2014); €180.00 – quantity 1 (2014); €2,844.25 – quantity 43 (2014); €163,25 – quantity 3 (2014); €3,564.00 – quantity 10 (2014); €1,740.00 – quantity 6 (2014) for a total value of € 25,214.17, corresponding to the sale of 164 items.

13. Mr Formato provides net figures relating to the sale of MUSEUM branded products – although it is not clearly stated what the products are - in the EU and UK for the period 2012-2017<sup>9</sup>. He clarifies that no sales figures are available for the year 2016 due to ownership transfer. According to Mr Formato, the figures have been obtained from the opponent and its predecessor’s internal records and are as follows:

Year	EU sale (in €)	UK (in €)
1.01.17 to 10.10.17	3,177,034	29,785
2015	1,429,041.57	47,895.44
2014	4,156,477.63	23,160.11
2013	5,904,763.16	9,179.61
2012	9,155,902.18	35,375.40

<sup>8</sup> A number of invoices include items described as “look book” and “catalogue MUSEUM” which are described as free goods

<sup>9</sup> § 14 of Mr Formato’s witness statement

14. He also provides global advertising spend figures for the period 2011-2015 (Exhibit 16). The document is not translated but Mr Formato explains that “totale anno” means “total per annum”. The amount is approximately €3million and is said to relate to “the promotion of the MUSEUM brand in all the countries where the goods have been sold” as listed at Exhibit 5 – which include non-EU countries - however, the figures are not broken down by country so it cannot be established what proportion of the said sum was spent to promote the mark in the EU and the UK. In terms of advertising and promotion of the brand, Mr Formato relies on, inter alia:

- Exhibits 17 and 19: they are screenshots from the opponent’s Facebook and Instagram pages showing 18,302 likes and 3,721 followers respectively. The copies are undated save for the printing date of 15 May 2018 and feature the word MUSEUM, both on its own and alongside the maple leaf logo.
- Exhibit 18: it is a copy of a report (untranslated) from a marketing agency based in Rome, Luther Desgn, providing statistics about Museum’s Facebook page for the period 2016-2018;
- Exhibits 20-25: they are aimed at supporting Mr Formato’s claims that the opponent (or its predecessor) attended a number of fashion trade shows. They include: a) a screenshot (Exhibit 21) said to be from the opponent’s Facebook page showing a post from 18 January 2015 stating “Second day in Paris for Museum @ Capsule Show” and 2) copies of two invoices dated 6 October 2014 and 11 December 2014 (Exhibit 24-25) issued to Interpool Spa and MUSEUM Interpool Spa respectively. The invoices, which are said to relate to equipment provided in respect of two trade shows attended by MUSEUM in Germany and France, amounts to €4,900 and €9,620 respectively and are expressly headed as concerning the brand MUSEUM;

- Exhibits 26-28: they include 1) copies of adverts for MUSEUM branded



outdoor jackets featuring the mark . The copies are said to relate to adverts placed in French, UK and Italian magazines in the period 2013-2014 but are undated; 2) copy of a screenshot from the opponent's Facebook page dated 27 October 2011 showing MUSEUM branded outdoor jackets being advertised on Italian magazines.

15. That concludes my summary of the evidence.

## **PROOF OF USE**

### **Legislation**

16. As stated in paragraph 5, the proof of use provisions apply to the opponent's earlier mark. Section 6A of the Act states:

"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.”

17. Section 100 of the Act is also relevant. It states that:

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

## Case law

18. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. What constitutes genuine use has been subject to a number of judgments. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU [i.e. the Court of Justice of the European Union] has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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 Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

19. As the earlier mark is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, are relevant. The court noted that:

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

and

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

20. It went on to state:

“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).”

21. 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.”

22. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

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

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

the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

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

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

24. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5-year period. In making the required assessment I am required to consider all relevant factors, including:

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

### **Sufficient use?**

25. Given the provisions of Section 6A of the Act, the relevant period for proof of use purposes is the five-year period ending on the day on which the application was published, namely 28 October 2012 – 27 October 2017.

26. I begin by noting that the evidence clearly shows that the earlier MUSEUM mark has predominantly been used in Italy but there are also sales to the UK. This is supported by the invoices provided. The evidence also includes examples of how the mark is used on the goods and details of how it is promoted.

27. The applicant filed 52 pages of submissions in lieu, accompanied by two sets of documents. The documents are inadmissible, as they should have been filed as evidence – no leave has been sought to file further evidence. Most of the applicant's submissions point out a number of inadequacies and inconsistencies in Mr Formato's witness statement (which had not been raised before) and purport to question the reliability of his statement.

28. Some of the applicant's criticisms relate to the fact that the opponent acquired the earlier mark in 2016 and it is said that the evidence relating to use of the mark by the opponent's predecessor is hearsay. The applicant also points to an alleged inconsistency between the company recorded *ab initio* as the owner of the earlier mark, which is named Interpool Spa, and the company referred by Mr Formato in his narrative, which is named Interpool S.r.l.

29. Mr Formaro explains in his evidence that the earlier mark was owned by the opponent's predecessor until 29 September 2016, when the opponent acquired it. He also stated that some of the evidence of use of the earlier mark was obtained from the

opponent's predecessor's internal records. If the applicant wished to challenge the truth of Mr Formato's narrative evidence, it could have filed evidence to undermine his testimony (during the evidence rounds) or applied to cross-examine him.

30. The earlier mark is undoubtedly owned by the opponent and I am satisfied that the opponent can rely on it. Likewise, I am not troubled by the alleged misreference made by Mr Formato in quoting the predecessor company. This appears to be a simple mis-identification of the company designation and without this being challenged earlier (and so giving the opponent an opportunity to explain this), I do not consider that the evidence should be ignored. I accept Mr Formato's evidence on use of the earlier mark by the predecessor company. Trade marks are often assigned or transmitted from one person to another. In the case of an assignment or other succession in title, use by the predecessor can generally be relied upon. Use made by the predecessor may be evidenced by the predecessor itself or, if the predecessor is not available, by other reliable means, for instance, information from business records and invoices, which has been done in this case.

31. The invoices at Exhibits 14 and 15 show actual sales of nearly 2,300 items of clothing under the earlier word MUSEUM mark in two EU countries. Those invoices, drawn up within the relevant period, were addressed to different Italian and UK companies, which could be safely inferred were retailers and/or distributors (and, as such, would count towards genuine use<sup>10</sup>), and indicate a not-insignificant level of sales, given that over 384 thousand euros worth of sales were made in Italy and over 25 thousand euros worth of sales were made in the UK. This gives an overall figure of over 400 thousand euros. In my view, such level of sales would, even on its own, be sufficient to prove genuine use of the earlier mark in the EU.



32. As regards the applicant's argument that most of the documents showing use of the MUSEUM mark are undated and as such have no evidential value in themselves, even if some of the material submitted as proof of use is undated (or it has been printed after the relevant period), it is, nevertheless, corroborated by other documents which are dated within the relevant period. I refer, in particular to the catalogues produced at

---

<sup>10</sup> See *Laboratoire de la Mer Trade Mark* [2006] FSR 5, where the Court of Appeal held that sales under the mark to the trade may qualify as genuine use

Exhibit 4 (which are dated 2013/2014 and 2014/2015) and the screenshots from the opponent's Facebook page produced at Exhibits 6 and 21 (some of which are dated 2014 and 2015). Taken together this evidence it is capable of supporting the invoices in proving that the earlier mark has been used<sup>11</sup>.

33. As regards the way the mark has been used, leaving aside the question of whether

use of  and  are variations which alter the distinctive character of the mark as originally registered or not, and even disregarding use of the mark in those forms, there is clearly use of the earlier word MUSEUM mark as registered on the invoices (Exhibits 14 and 15) and on catalogues (Exhibit 4). Further, there is use of the word MUSEUM in a slightly different form, i.e. in block capitals, on the examples of product labels (Exhibit 4 label A). Those are all examples of use within the relevant period. In relation to such use, the applicant claims that the material exhibited by Mr Formato is aimed at the Canadian market and points to the following 1) that the word MUSEUM is used alongside the image of a Canadian maple leaf; 2) that Mr Formato said "the Museum brand was imported from Canada"; 3) that use of the word "Fall" in "Fall/Winter 2017" is "probably the North American way of describing "autumn"" and 4) that the evidence is printed in English with no translation as it would be expected if the goods were aimed at the EU market. In the face of such criticisms, it is necessary for me only to say that the applicant's conclusions are based on inferences which have no factual basis and do not accord with the clear evidence of sales in the EU to which I have already referred. Further, there is evidence of promotion of the mark at EU fashion shows and on social media platforms (Exhibit 6).

34. Overall my conclusion is that taking into account all of the evidence produced by the opponent, it is sufficient to demonstrate genuine use of the earlier mark in relation to outdoor coats and jackets.

---

<sup>11</sup> VITAFRUIT, T- 203/02, paragraph 53

## Fair specification

35. The final aspect to consider relates to the goods. It is necessary to decide upon a fair specification for the goods for which genuine use has been shown and which falls within the parameters of the registered specification.

36. *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 as being:

“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.”

37. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme

Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to 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; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

38. The evidence illustrates use in respect of outdoor coats and jackets. This equates with the claim made by the opponent in its submissions in lieu that it has used the mark in relation to coats and outdoor jackets and that "a fair specification is probably "clothing, namely coats and outdoor jackets". I will therefore select *outdoor coats and jackets* as a fair description of the category of goods. Accordingly, the opponent can rely for the purposes of this opposition on the following goods:

**Class 25:** *outdoor coats and jackets*

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

39. Section 5(2)(b) of the Act states:

“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”.

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;



- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

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

41. 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”.

42. 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 uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) 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;

(f) 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.

43. 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 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."

44. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

45. In *Kurt Hesse v OHIM* (Case C-50/15 P), the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, (Case T-325/06), the General Court (GC) 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".

46. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated:

"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".

47. The goods and services to be compared are:

Applied for goods and services	Opponent's goods
<p><b>Class 18:</b> Leather and imitations of leather; trunks; handbags; purses; wallets; toilet bags; rucksacks; travelling bags;</p> <p><b>Class 25:</b> Clothing; footwear; headgear; neck ties; hats; scarves; gloves; belts; pyjamas; dressing gowns;</p> <p><b>Class 35:</b> Retail, wholesale, internet retail or mail order retail services in relation to leather and imitations of leather, trunks, handbags, purses, wallets, toilet bags, rucksacks, travelling bags, clothing, footwear, headgear, neck ties, hats, scarves, gloves, belts, pyjamas, dressing gowns.</p>	<p><b>Class 25:</b> outdoor coats and jackets</p>

48. The applicant states, in its submissions in lieu, that the applied for goods in class 25 and related retail services in class 35 are similar to the opponent's coats and outdoor jackets, however, the position is somehow unclear. It states:

“92. [...] The only goods applied for that are similar to “outdoor coats and jackets” are found in class 25 and the services of retailing of clothing etc in class 35.” (emphasis added)

“93. [...] The applicant applied for “pyjamas and dressing gown”. These are used indoor only and are used not for protection but generally for modesty of the user. Beside “neck ties” the other goods in the application are either identical or similar to “outdoor jackets and coats”. That said, not all clothing are similar to outdoor jackets and coats. A person wearing a summer dress will notice the difference between that and a winter overcoat. Most of the goods defined as “clothing” by the applicant will be different to “outdoor coats and jackets”. (emphasis added)

49. It seems reasonably clear that with the exception of pyjamas, dressing gown, neck ties and, possibly, some items of clothing, the applicant accepts that the respective goods in class 25 are either similar or identical to the opponent's *outdoor coats and jackets*. However, as the applicant has not said to what degree it believes some of the goods are similar, I will proceed to my own assessment even in relation to the goods for which similarity is accepted.

## **Class 25**

50. Clothing. Though the applicant contends that not all the goods falling within the applied for term *clothing* are similar to the opponent's *outdoor coats and jackets*, it has applied for the broad term. As the applied for *clothing* includes, within its ambit, the opponent's *outdoor coats and jackets*, the goods must be regarded as identical on the principle outlined in the *Meric* case as set out above.

51. Scarves, gloves, hats and headgear. The applied for *scarves, gloves and hats* are similar in nature to the opponent's *outdoor coats and jackets*. They also serve the same purpose, in particular in the case of goods designed to give protection against the weather. Furthermore, these goods might be chosen to complement the opponent's *outdoor coats and jackets* so there is a certain degree of complementarity. The goods are not in competition but target the same users, are often produced by the same manufacturers and share the same distribution channels as they are sold in the same outlets. Taking all these factors into account, these goods are similar to a medium degree to the opponent's *outdoor coats and jackets*.

52. Belts. The earlier specification does not include belts type goods on their own, although it includes belts in so far as they are parts of *outdoor coats and jackets*. The goods here must enjoy a limited similarity and in my view, are similar to a low degree.

53. Footwear. The applied for *footwear* include footwear for wear in outdoor or winter pursuits (such as, for example, winter boots), which serves the same basic purpose as the opponent's *outdoor coats and jackets*: both are worn outdoor and are used for covering and protecting parts of the human body against the weather. The goods target the same sectors of the buying public as the opponent's *outdoor coats and*

*jackets*, are often found in the same retail outlets and might be produced by the same manufacturers. Furthermore, the opponent's *outdoor coats and jackets* can be matched with the applied for *footwear*, and are complementary to some extent. Taking all this into account, there is a medium level of similarity between the applied for *footwear* and opponent's *outdoor coats and jackets*.

54. *Pyjamas and dressing gowns*. The opponent did not make any specific submissions as to the similarity between the applied for *pyjamas* and *dressing gowns* and the opponent's *outdoor coats and jackets* apart from referring to the existence of case law which it is said to suggest that "all types of clothing are similar". In this connection, the opponent referred me to two decisions of the UKIPO. In the first one, BL-O-434-15, the Hearing Officer concluded that the competing goods in class 25 were similar either because the terms appeared in both specifications or because one term was covered by a broader term in the other party's specification (*Meric*). In the second one, BL-O-536-17, the Hearing Officer stated "[...] *This leaves "clothing for children; infant wear; sleepwear, lingerie; nightwear; underwear; men's jackets, coats, trousers, vests" from the applicant's specification. These items must be considered as being similar to a medium degree to the following items in the opponent's specification: "Women's jackets, shirts, slacks, socks, pantyhose, gloves, sportswear and hats"*. It does not seem to me that these decisions substantiate the opponent's argument that the respective goods are similar merely because they are all items of clothing and therefore I reject it.

55. Whilst I accept that the users of *pyjamas* and *dressing gowns* are the same as those of the opponent's *outdoor coats and jackets* and that the intended purpose of the respective goods (i.e. to cover the body) is the same, these are very superficial aspects. The nature and method of use of the respective goods are different as it is their purpose, to the extent that the opponent's goods are worn outdoor and the applicant's goods are items of nightwear. The goods are unlikely to share channels of trade to any material extent. Whilst I accept that they may be on sale in the same department stores or large clothing stores, they are not likely to be offered for sale in the same section or in close proximity to one another. They are neither in competition nor complementary. The goods are not similar.

56. *Neck ties*. The applied for *neck ties* are different in nature and purpose to the opponent's *outdoor coats and jackets*. As with *pyjamas* and *dressing gowns*, any potential overlap in channels of trade is too superficial to engage overall similarity. The goods do not compete and are not complementary. There is no meaningful similarity between these goods.

57. As some degree of similarity is required for there to be a likelihood of confusion<sup>12</sup>, the application can proceed to registration in respect of the applied for *pyjamas and dressing gowns* and *neck ties*.

## **Class 18**

58. Turning to the similarity between the applicant's goods in class 18 and the opponent's goods in class 25, the opponent referred me to *El Corte Inglés SA v OHIM* (Case T-443/05) and to in which the GC stated:

“42. First, the goods in class 25 and those in class 18 are often made of the same raw material, namely leather or imitation leather. That fact may be taken into account when assessing the similarity between the goods. However, given the wide variety of goods which can be made of leather or imitation leather, that factor alone is not sufficient to establish that the goods are similar (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 55).

43. Second, it is apparent that the distribution channels of some of the goods at issue are identical. However, a distinction must be made according to whether the goods in class 25 are compared to one or other of the groups of goods in class 18 identified by OHIM.

44. On the one hand, as regards the second group of goods in class 18 (leather and imitations of leather, animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery), the

---

<sup>12</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Board of Appeal rightly held that the distribution channels were different from those used for the distribution of goods in class 25. The fact that those two categories of goods may be sold in the same commercial establishments, such as department stores or supermarkets, is not particularly significant since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin (see, to that effect, Case T-8/03 *El Corte Inglés v OHIM – Pucci (EMILIO PUCCI)* [2004] ECR II-4297, paragraph 43).

45. On the other hand, as regards the first group of goods in class 18, namely leather and imitation leather goods not included in other classes such as, for example, handbags, purses or wallets, it should be noted that those goods are often sold with goods in class 25 at points of sale in both major retail establishments and more specialised shops. That is a factor which must be taken into account in assessing the similarity of those goods.

46. It must be recalled that the Court has also confirmed the existence of a slight similarity between ‘ladies’ bags’ and ‘ladies’ shoes’ (*SISSI ROSSI*, paragraph 42 above, paragraph 68). That finding must be extended to the relationships between all the goods in class 25 designated by the mark applied for and the leather and imitation leather goods not included in other classes, in class 18, designated by the earlier mark.

47. In light of the foregoing, it must be held that there is a slight similarity between the goods in class 25 and the first group of goods in class 18. Consequently, the Board of Appeal could not conclude that there was no likelihood of confusion on the part of the relevant public solely on the basis of a comparison of the goods concerned.

48. As to whether clothing, footwear and headgear in class 25 are complementary to ‘leather and imitations of leather, and goods made of these materials and not included in other classes’ in class 18, it must be recalled that, according to the case-law, 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 the production of those goods lies with the same undertaking (*SISSI ROSSI*, paragraph 42 above, paragraph 60).

49. Goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image ('look') of the consumer concerned.

50. The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in class 25 and the various clothing accessories which complement them such as handbags in class 18. Any such coordination depends on the consumer concerned, the type of activity for which that look is put together (work, sport or leisure in particular), or the marketing strategies of the businesses in the sector. Furthermore, the fact that the goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and strengthen the perception that the same undertaking is responsible for the production of those goods.

51. It is clear that some consumers may perceive a close connection between clothing, footwear and headgear in class 25 and certain 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which are clothing accessories, and that they may therefore be led to believe that the same undertaking is responsible for the production of those goods. Therefore, the goods designated by the mark applied for in class 25 show a degree of similarity with the clothing accessories included in 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which cannot be classified as slight."

59. It also referred me to *Gitana SA v OHIM*, Case T-569/11 in which the GC said:

“Moreover, in respect of the relationship between the ‘goods in leather and imitations of leather’ in Class 18 covered by the trade mark sought and the goods in Class 25 covered by the earlier mark, it is apparent also from settled case-law that the ‘goods in leather and imitations of leather’ include clothing accessories such as ‘bags or wallets’ made from that raw material and which, as such, contribute, with clothing and other clothing goods, to the external image (‘look’) of the consumer concerned, that is to say coordination of its various components at the design stage or when they are purchased. Furthermore, the fact that those goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and support the impression that the same undertaking is responsible for the production of those goods. It follows that some consumers may perceive a close connection between clothing, footwear and headgear in Class 25 and certain ‘goods made of these materials [leather and imitations of leather] and not included in other classes’ in Class 18 which are clothing accessories. Consequently, clothing, shoes and headgear in Class 25 bear more than a slight degree of similarity to a category of ‘goods made of these materials [leather and imitations of leather] and not included in other classes’ in Class 18 consisting of clothing accessories made of those materials (see, to that effect, *PiraÑAM diseño original Juan Bolaños*, paragraph 42 above, paragraphs 49 to 51; *exē*, paragraph 42 above, paragraph 32; and *GIORDANO*, paragraph 42 above, paragraphs 25 to 27).”

60. As the case law above makes clear “clothing” in Class 25 and clothing accessories which complement them, such as “handbags”, “purses” and “wallets” in class 18, are similar to the extent that the intention is to create a “coordinated look”. This concords with my own experience that it is not unusual for traders in clothing to also trade in complementary fashion items such as handbags, which are often sold as a matching accessory to clothing and footwear. However, that is not the case in respect of the outdoor coats and jackets for which the opponents have used the mark. That said, there is a genus of goods, such as rucksacks and travelling bags, that would be sold alongside such outdoor coats and jackets. In this connection, the opponent argued that “items of luggage, including trunks [...] toilet bags, rucksack and travelling bags are often produced by the same manufacturers as coats and jackets [...] and sold

alongside coats and jackets at points of sale [...]” so that the goods are complementary. It relies in support of its argument on Exhibit 29. The quality of the images is very poor but the aim of this evidence is to establish that a number of well-known brands including The North Face, Berghaus, Puma, Timberland, Nike and Adidas market both outdoor jackets and bags, such as rucksacks and duffel bags, under the same brands.

61. Both the applicant’s evidence and my experience tells me that the public would normally expect *rucksacks* and *travelling bags* (which include duffel bags) to be marketed by a manufacturer of *outdoor coats and jackets*. My conclusion is therefore that these goods which are all for use in outdoor pursuits are likely to share the same channels of trade and I would consider them complementary and similar to at least a low degree. However, I do not find that the same considerations extend to the remaining goods in class 18, namely *leather and imitations of leather* (which, to my mind, include raw materials but not goods made of those materials); *trunks* and *toilet bags*.

62. As some degree of similarity is required for there to be a likelihood of confusion<sup>13</sup>, the application can proceed to registration in respect of the applied for *leather and imitations of leather; trunks; handbags; purses; wallets; toilet bags*.

### **Class 35**

63. Retail, wholesale, internet retail or mail order retail services in relation to leather and imitations of leather, trunks, handbags, purses, wallets, toilet bags, rucksacks, travelling bags, clothing, footwear, headgear, neck ties, hats, scarves, gloves, belts, pyjamas, dressing gowns.

64. The applicant argues that the opponent’s goods in class 25 are not similar to the applied for retail services in class 35, because “there is an important difference between selling the goods of others (retailing) and selling one’s own goods” (under one’s own brand). It also submits that a manufacturer of *outdoor coats and jackets* will

---

<sup>13</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

be aiming to sell his goods to retailers (rather than the general public) so that the sale channels are very different. The argument must be rejected. The opponent's registration for goods in class 25 covers the sale of the opponent's own goods to end consumers (as well as retailers), which means that the ultimate consumers of the opponent's goods in class 25 and the ultimate consumers the applicant's services for the retailing of goods in class 25 are the same, i.e. the general public.

65. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

66. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

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

67. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*<sup>14</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>15</sup>, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*<sup>16</sup>, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

68. Bearing in mind the above guidance, I find that there is a medium degree of similarity between the opponent's *outdoor coats and jackets* and the applied for *retail, wholesale, internet retail or mail order retail services in relation to clothing* (which I considered to be identical to the opponent's *outdoor coats and jackets*). The services in class 35 covered by the application relate to the goods in class 25 covered by the opponent's mark and constitute one of the possible distribution channels for the goods covered by the opponent's mark.

---

<sup>14</sup> Case C-411/13P

<sup>15</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>16</sup> Case C-398/07P

69. Turning to the remaining goods listed in the applied for specification in class 35, I find that the retail and wholesale activity of selling *headgear, hats, scarves, gloves and footwear* is similar to a low degree to the opponent's *outdoor coats and jackets*, because the goods are commonly sold together.

70. I also find that the retail and wholesale activity of selling *rucksacks and travelling bags* is similar to a very low degree to the opponent's *outdoor coats and jackets* because *rucksacks and travelling bags* are less commonly sold with *outdoor coats and jackets* than in the case of *headgear, hats, scarves, gloves*.

71. Finally, I find that the retail and wholesale activity of selling *belts* is not similar to the opponent's *outdoor coats and jackets*, as the complementarity between them is insufficiently pronounced.

72. Given my findings above that there is no similarity between the opponent's *outdoor coats and jackets* and the applied for *leather and imitations of leather, trunks, handbags, purses, wallets, toilet bags*, in class 18 and *neck ties, belts, pyjamas, dressing gowns* in class 25, there is also no similarity between the opponent's *outdoor coats and jackets* and the applied for services for the retailing and wholesaling of these goods. As some degree of similarity is required for there to be a likelihood of confusion<sup>17</sup>, the application can proceed to registration in respect of the applied for *retail, wholesale, internet retail or mail order retail services in relation to leather and imitations of leather, trunks, handbags, purses, wallets, toilet bags, neck ties, belts, pyjamas, dressing gowns*.

### **The average consumer and the nature of the purchasing act**

73. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods and services at issue; I must then determine the manner in which these goods and services will be selected in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The*

---

<sup>17</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

*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.”

74. The products of both parties in classes 18 and 25 are such that they would be aimed at the general public. The purchase is likely to be primarily visual as the average consumer is likely to select the goods by visual means from a store, a website or a catalogue. However, I do not discount aural considerations in the form of, for example, discussions with sale assistants or sale representatives.

75. As regards the degree of attention, the applicant states:

“When the average consumer is purchasing outdoor coats and jackets they will take more care than when they are purchasing more everyday clothing. [...] Additionally, outdoor coats and jackets last longer than ordinary clothing and are purchased to protect the user in more extreme environments, such as skiing and hill walking where the coats and jackets will be purchased with great care. The environment where outdoor coats and jackets are purchased are likely to be specialist outlets where the label will be looked at with care by the average consumer of those goods. This needs to be compared with clothing, such as that applied for where the average consumer will be more concerned with the price of the goods, their colour and considerations that will not be taken into account when purchasing outdoor coats and jackets”.

76. Whilst the purchase of an outdoor coat/jacket may be slightly more considered than some other items of clothing, it is still not a highly considered process. Accordingly, the average consumer’s level of attention will vary depending on the cost and nature

of the item at issue but overall the average consumer is likely to pay a normal degree of attention to the selection of the parties' goods in class 25. Similar views hold true for the applied for goods in class 18.

77. The applied for retail and wholesale services in class 35, relate to the same goods listed in the applied for specification in classes 18 and 25. The services will be selected visually from signage on the high street and from websites. The level of attention paid to the selection of the retailer (or wholesaler) will vary according to the nature of the items the subject of the retail/wholesale service and will be at least normal.

### **Comparison of marks**

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

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

79. It would be wrong therefore artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features, (which are not negligible) and therefore contribute to the overall impressions created by them. The marks to be compared are:



Applied for mark	Opponent's mark
MUSEUM SELECTION	MUSEUM

80. Both marks are simple word marks. Visually and aurally the marks are similar by virtue of having the same component MUSEUM. The applicant's mark also includes the additional element SELECTION indicating that the selection is that of MUSEUM. The combination of MUSEUM SELECTION forms a unit; however, it is likely that MUSEUM will be viewed as the primary mark with SELECTION functioning as a sub-brand. Given its significance, the word SELECTION is therefore likely to be given less importance than the word MUSEUM in the overall impression of the mark. Taking the similarities and the differences into account, I conclude that the respective marks share a high level of visual and aural similarity.

81. Conceptually, the applicant states:

“[...] the “SELECTION” element within the new composite trade mark application serves in the mind of the average consumer, to qualify the MUSEUM element of the application (a selection of museums, or paraphs goods selected from a museum) rather than having an independent distinctive role within the combined mark.

[...] The additional word serves to qualify the noun and creates a completely conceptual meaning, and thus the word selection has an independent distinctive role within the combined mark” (emphasis added).

82. Aside from the fact that the applicant's submissions as to whether the element SELECTION in the applied for mark has an independent distinctive role or not, are contradictory, the meaning attributable to the words MUSEUM SELECTION by the applicant is not the meaning that the words will bear in the mind of the average consumer. As I have already explained above, the words MUSEUM SELECTION when applied to goods in classes 18 and 25 (and to retail services connected with the sale of the same goods), mean, and will be understood to mean, a selection or a range

of goods from an undertaking called MUSEUM. Taking into account the fact that the marks share the identical concept conveyed by the word MUSEUM, which will be generally understood as “a building in which objects of historical, scientific, artistic, or cultural interest are stored and exhibited<sup>18</sup>”, and that the idea of a “SELECTION” in the later mark introduces a concept which has little distinctive character, I conclude that the marks are conceptually similar to a high degree.

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

83. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>26</sup>, 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).”

---

<sup>18</sup> Cambridge English Dictionary

84. The opponent's earlier mark consists of the single word MUSEUM. *Prima facie*, MUSEUM is an ordinary dictionary word though it has no obvious relationship with coats and jackets. It is distinctive to an average degree.

85. The opponent has provided evidence of the mark use; however, the level of UK sales is very small and there is nothing in the evidence to suggest the earlier trade mark enjoys a greater degree of protection as a result of the use made of it.

### **Likelihood of confusion**

86. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

87. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms,

is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

88. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

89. The marks are visually, aurally and conceptually similar to a high degree. Some of the goods and services are similar to various degree. The selection process will be dominated by visual considerations and the consumer’s level of attention will be at least normal.

90. Taking first the identical and highly similar goods, i.e. *clothing, headgear, hats, scarves and gloves*, I find that given the closeness of the goods and the similarity of the marks and allowing for the concept of imperfect recollection, there is a risk of the average consumer directly confusing one mark for the other. This is all the more true, since the shared component of the marks, i.e. the word MUSEUM, has an average degree of distinctive character and the only difference between the marks is created by an element, i.e. the word SELECTION, which has inherently weak distinctive character for the goods and services at issue. Even if the average consumer were to register the differences between the marks, he/she would still likely to believe that MUSEUM SELECTION is a sub-brand of MUSEUM and that the parties’ goods originate from the same (or a linked) undertaking. I conclude that there is a likelihood of both direct and indirect confusion in respect of these goods.

91. I extend the same finding to the goods and services which I have found to be similar to a low (or very low) to medium degree, namely, *rucksacks and travelling bags* in class 18, *footwear and belts* in class 25 and *retail, wholesale, internet retail or mail order retail services in relation to rucksacks, travelling bags, clothing, footwear, headgear, hats, scarves, gloves* in class 35. The lesser degree of similarity between

the opponent's goods and the applicant's goods and services, even those which are similar only to a low degree, is not sufficient to offset the conceptual similarity between the marks and the likely risk of indirect confusion. This would arise out of the consumer misremembering the marks whilst appreciating the differences between the respective goods and services.

## **Conclusions**

92. The opposition under Section 5(2)(b) is successful (and the application will be refused) in relation to:

**Class 18:** *rucksacks; travelling bags;*

**Class 25:** *Clothing; footwear; headgear; hats; scarves; gloves; belts;*

**Class 35:** *Retail, internet retail or mail order retail services in relation to rucksacks, travelling bags, clothing, footwear, headgear, hats, scarves, gloves.*

93. The opposition under Section 5(2)(b) fails (and the application will proceed to registration) in relation to:

**Class 18:** *Leather and imitations of leather; trunks; handbags; purses; wallets; toilet bags;*

**Class 25:** *Neck ties; pyjamas; dressing gowns;*

**Class 35:** *Retail, wholesale, internet retail or mail order retail services in relation to leather and imitations of leather, trunks, handbags, purses, wallets, toilet bags, neck ties, belts, pyjamas, dressing gowns.*

## **Other grounds**

94. I will consider the additional grounds under Section 5(3) and 5(4)(a) only to the extent that the opposition under Section 5(2)(b) has been unsuccessful.

## **Section 5(3)**

95. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

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

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

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

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

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

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph

68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

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

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

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

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

97. The opponent's mark is a EU mark and to qualify for protection under Section 5(3) it must be shown to have a reputation in the EU. In *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C 301/07, the CJEU held that:

“20. By its first question, the national court in essence asks the Court, first, to clarify the meaning of the expression ‘has a reputation in the Community’, by means of which, in Article 9(1)(c) of the regulation, one of the conditions is laid down which a Community trade mark must fulfil in order to benefit from the protection accorded by that provision and, second, to state whether that condition, from a geographical point of view, is satisfied in a case where the Community trade mark has a reputation in only one Member State.

21. The concept of ‘reputation’ assumes a certain degree of knowledge amongst the relevant public.

22. The relevant public is that concerned by the Community trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector (see, by way of analogy, *General Motors*, paragraph 24, with regard to Article 5(2) of the directive).

23. It cannot be required that the Community trade mark be known by a given percentage of the public so defined (*General Motors*, by way of analogy, paragraph 25).

24. The degree of knowledge required must be considered to be reached when the Community trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark (*General Motors*, by way of analogy, paragraph 26).

25. In examining this condition, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of



the investment made by the undertaking in promoting it (*General Motors*, by way of analogy, paragraph 27).

26. In view of the elements of the main proceedings, it is thus for the national court to determine whether the Community trade mark at issue is known by a significant part of the public concerned by the goods which that trade mark covers.

27. Territorially, the condition as to reputation must be considered to be fulfilled when the Community trade mark has a reputation in a substantial part of the territory of the Community (see, by way of analogy, *General Motors*, paragraph 28).

28. It should be noted that the Court has already ruled that, with regard to a Benelux trade mark, it is sufficient, for the purposes of Article 5(2) of the directive, that it has a reputation in a substantial part of the Benelux territory, which part may consist of a part of one of the Benelux countries (*General Motors*, paragraph 29).

29 As the present case concerns a Community trade mark with a reputation throughout the territory of a Member State, namely Austria, the view may be taken, regard being had to the circumstances of the main proceedings, that the territorial requirement imposed by Article 9(1)(c) of the regulation is satisfied.

30. The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.”

## Reputation

98. Though the opponent claims that its mark has been used (and has a reputation) in the EU, I have found that the only unambiguous evidence of use is that provided by the invoices exhibited at Exhibits 14 and 15, which show around 400 thousand euros worth of sales, most of which were made in Italy. The extent of any possible wider use of the mark in relation to outdoor coats and jackets (or indeed clothing) is not clear. There is no indication of any market share and though there are some promotional figures, they are incomplete and do not allow me to establish the sums spent on promoting the mark in the EU and/or in the UK in relation to the goods concerned. I am not satisfied by the evidence that the opponent's MUSEUM mark was known by a significant part of the relevant public in Italy at the relevant date. Indeed, I am not even satisfied that it was known by a significant part of the relevant public in the UK. The mark did not therefore have a reputation in the EU (or the UK) and the ground of opposition under Section 5(3) must be rejected accordingly.

## Link

99. In case I am wrong, I will go on to consider the opponent's position on the basis that it had a reputation in Italy for outdoor coats and jackets sold under the MUSEUM brand.

100. In *Iron & Smith kft v Unilever NV*, Case C-125/14, the CJEU was asked whether a CTM (now an EUTM) with a reputation 'in the Community' (now the European Union), but not in the Member State where infringement was alleged, was capable of being infringed under provisions of the Community Trade Mark Regulation (now the European Union Trade Mark Regulation) broadly equivalent to Section 5(3) of the Act. The court answered that:

"If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3)

of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future.”

101. A European Union trade mark may therefore be known to “a significant part of the public concerned by the products or services covered by that trade mark” in the EU, without meeting that threshold in a particular Member State. Nevertheless, provided that the mark is known to “a commercially significant part of” the relevant public in the relevant Member State concerned, it may be entitled to extended protection in that Member State on account of its reputation in the EU. The distinction is clearer in the French version of the same judgment, which talks of a “commercially non-negligible” part of the relevant public in the Member State being aware of the earlier CTM (now EU TM) and making a link with the later national trade mark. A “commercially non-negligible” part of the relevant public therefore represents a lower threshold than the standard requirement. It follows that the standard requirement must be for more than a non-negligible or minimal level of reputation. This makes sense because Section 5(3) is intended to provide more extensive protection to marks with a certain level of reputation. This suggests that the level of reputation required under Section 5(3) is more than minimal, and probably higher than that which is required in order to support a passing off right under the common law in the UK.

102. The reputation is outside the UK. As the extract from *Iron & Smith* reproduced above makes clear, the fact that the earlier mark’s reputation is not in the UK is not fatal to the opponent’s claim of a link. If a commercially significant part of the public in the UK is familiar with the earlier mark and makes a connection between this mark and the contested mark, the required link may be made out. However, the use in the UK is extremely low, amounting to just over 25 thousand euros in the period 2013-2014 and there is no evidence to show that use in Italy (or elsewhere) would have spilled over in the UK. Consequently, even if the opponent had established the required reputation in Italy (or elsewhere) the evidence is insufficient to establish that a commercially significant part of the UK public is familiar with the earlier mark. In

those circumstances no link would be made from the perspective of the UK relevant public.

103. The opposition under Section 5(3) fails.

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

104. 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.”

105. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per

*Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

106. The opponent’s claims use of the MUSEUM mark in the UK in relation to coats and jackets since 2014. It states, in its submissions in lieu:

“49. The contested Application was filed on 9 October 2017. The accompanying Witness Statement for the Opponent shows that the word mark MUSEUM has been used in the United Kingdom in a consistent and prominent manner in relation to coats and jackets since 2014<sup>19</sup>, i.e. 3 years before the contested Application was filed. (emphasis added)

....

53. It is submitted that the evidence submitted in support of this opposition shows that the Opponent had considerable goodwill in its MUSEUM trade mark in the United Kingdom in relation to coats and jackets. The Witness Statement of Diego Formato shows that the Opponent’s MUSEUM branded products are sold in almost 50 outlets in the United Kingdom, with a significant value each year. The Witness Statement of Diego Formato also shows that the brand has had a wide reach; apart from more traditional advertising platforms, the brand is discussed on social media. Based on this, it is not unreasonable for the Opponent to conclude that it has considerable goodwill and reputation in the MUSEUM brand in the United Kingdom. [...]”

### Goodwill

107. 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

---

<sup>19</sup> The same reference to 2014 is made in the Form TM7 and in the evidence

which distinguishes an old-established business from a new business at its first start.”

108. The applicant claims:

“The date of the application is 9 October 2017. The date of the opposition is 29 January 2018. The hearing officer is therefore required to assess the purported evidence to assess if the opponent has proven that it had acquired goodwill in the 3-month period between 9 October 2017 and 29 January 2018”.

109. As there no evidence of prior use of the applied for mark, the date goodwill must be established, is the date of the application for registration, i.e. 09 October 2017<sup>20</sup>.

110. The applicant also claims that none of the evidence filed shows evidence of use by the opponent or with its consent.

111. The only evidence of use of MUSEUM in the UK in relation to coats and jackets is provided by the invoices issued by the opponent’s predecessor, i.e. Interpool Spa, to UK companies between 2013 and 2014. These show a total value of around 25 thousand euros - even less, i.e. just over 13 thousand euros, if one considers only the invoices dated 2014, from when use (in the UK) is claimed by the opponent. There is no evidence of any sales after this period. Although the opponent has filed evidence of sales made in 2017 under the MUSEUM brand by a company which is allegedly its licensee, as I have already explained, there is no way for me to verify what the goods were that were sold, so I disregard it.

112. Whilst it is clear that the opponent had bought the MUSEUM mark from Interpool Spa, it has not claimed that the goodwill attached to the mark was assigned to it. Even allowing for that inference to be made, any goodwill which the old Interpool business had generated in the UK under the MUSEUM sign in 2014 (or even between 2013 and 2014) was on an extremely small scale. Consequently, I doubt that any goodwill generated in that period by Interpool still existed three years later in 2017, i.e. at the

---

<sup>20</sup> See *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11

relevant date. But even if it did exist, there is nothing to support the conclusion that the Interpool's customers who knew about the business in (2013-) 2014 would have some recollection of it at the relevant date in 2017 (or would have known that the goodwill had been acquired by the opponent who trades under a different name). The onus was on the opponent to provide sufficient material to support its claim and I find that the evidence does not support the conclusion that, if there was still a goodwill attached to the MUSEUM mark in the UK, it would have been known, at the relevant date, to more than a trivial number of the Interpool's customers. Consequently, I find that any goodwill the opponent may have had (which I doubt it had) at the relevant date, was trivial<sup>21</sup> and does not qualify for protection under the law of passing off.

### Misrepresentation

113. In case I am wrong, I will consider briefly the matter of misrepresentation.

114. The basis of the attack is not materially different to the Section 5(2)(b) claim. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires "a substantial number of members of the public are deceived" rather than whether the "average consumer are confused". However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here. Even accepting that the opponent had a goodwill identified by the sign MUSEUM, it would be extremely small and would not take the opponent's case any further. For the reasons set out earlier, I consider that in relation to the goods and services which I found to be not similar (or not similar enough to cause confusion), namely *leather and imitations of leather; trunks; handbags; purses; wallets; toilet bags* (in Class 18); *neck ties; pyjamas; dressing gowns* (in Class 25) and *retail, wholesale, internet retail or mail order retail services in relation to leather and imitations of leather, trunks, handbags, purses, wallets, toilet bags, neck ties, belts, pyjamas, dressing gowns* (in Class 35), there will be no misrepresentation. Consumers may wonder if the applied for goods and services are from the same undertaking but, I do not consider that they would

---

<sup>21</sup> *Hart v Relentless Records* [2002] EWHC 1984

purchase the applicant's goods and services in the mistaken belief that they are provided by the opponent's business on the basis of its (predecessor's) trade in outdoor coats and jackets.

115. The opposition under Section 5(4)(a) fails.

### **Conclusions**

116. The opposition under Section 5(2)(b) is successful to the extent outlined at paragraphs 92 and 93 above.

### **Costs**

Both parties have achieved a measure of success. As the opponent has been only slightly more successful than the applicant, I order that each party bear their own costs.

**Dated this 29<sup>th</sup> day of January 2019**

**Teresa Perks**

**For the Registrar**

**The Comptroller – General**



## **Annex**

**Class 3:** Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring or abrasive preparations; soaps; perfume; essential oils; cosmetics; hair lotions; dentifrices; toiletries;

**Class 9:** Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs or recorded discs; data processing equipment or computers; computer hardware or firmware; computer software; compact discs; downloadable computer software; digital music (downloadable from the Internet); telecommunications apparatus; computer games equipment adapted for use with TV receivers; mouse mats; DVDS; CDs; thermometers; reading glasses; telescopes; compasses; barometers; magnifying glasses;

**Class 16:** Printed books; address books; stationery; greetings cards; mail order catalogues; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); Paper, cardboard; printed matter; pens; felt tip pens; fountain pens; ball point pens; colouring pencils; pencils; boxes of pencils; paint boxes; calendars; diaries; drawings; paintings; bookends; letter opener; vouchers; gift vouchers; wrapping paper; gift wrapping paper; .

**Class 18:** Leather and imitations of leather; animal skins, hides; trunks; handbags; purses; wallets; toilet bags; rucksacks; travelling bags; umbrellas; parasols; walking sticks;

**Class 20:** Photograph frames of silver plate, metal, resin, shell, mother of pearl or wood, small mirrors; frames; cushions; furniture; storage furniture; storage racks; .

**Class 21:** Perfume bottles and vases of glass and porcelain; glass candle holders; trinket boxes in porcelain, metal and resin; jewellery polishing cloths; household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); articles for cleaning purposes; un-worked or

semi-worked glass (except glass used in building); glassware; porcelain; earthenware; mugs; cups; saucers; plates; glasses (drinking); tableware; vases; bird feeders; bird baths; hipflasks; money boxes; terrariums; bottle openers; chopping boards; .

**Class 25:** Clothing; footwear; headgear; neck ties; hats; scarves; gloves; belts; pyjamas; dressing gowns;

**Class 27:** Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile); Rugs; Mats; Matting; Play mats; Carpets; Bath mats; Floor coverings; Door mats; Wallpapers;

**Class 28:** Games, toys and playthings; Gymnastic and sporting articles; Decorations for Christmas trees; Video game apparatus; Toys; Cuddly toys; Games; Game consoles; Game cards; Boards games; Cards [games]; Video game apparatus; Sports games; Sports equipment; Puzzles; Kites; Toy model kits; Radio-controlled toys; Remote control toys; Toy sets; Roulette sets; Backgammon sets; Domino sets; Chess sets; Checkers sets; Badminton sets; Croquet sets; Archery sets; Model train sets; Toy building block sets; Board games; Dart boards; Bowls bags; Playing bowls; Bowls [games]; Toy models; Kaleidoscopes; .

**Class 29:** Meat, fish, poultry and game; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; Jellies, jams, compotes; Eggs; Milk and milk products; Edible oils and fats; Jellies; Jams; Jellies, jams, compotes, fruit and vegetable spreads; Pickles; Relishes [pickles]; Pâtés; Pates; Cooked truffles; Preserved truffles; Cheese; Almonds, ground; Almond butter; Preserved nuts; Edible nuts; Dried nuts; .

**Class 30:** Coffee, tea, cocoa and artificial coffee; Rice; Tapioca and sago; Flour and preparations made from cereals; Bread, pastries and confectionery; Edible ices; Sugar, honey, treacle; Yeast, baking-powder; Salt; Mustard; Vinegar, sauces [condiments]; Spices; Ice; Sauces; Puddings; Crackers; Biscuits; Confectionery; Chocolate; Chocolates; Fudge; Toffee; Toffees; Tea; Tisanes made of tea (Non-medicated -); Fruit infusions; Fruit teas; Coffee; Coffee bags; Coffee essence; Coffee beans; Coffee pods; Gum sweets; Sweets [candy]; Boiled sweets; Sugarfree sweets; Truffles [confectionery]; Honey; Cakes; Candy mints; Turkish delight; Marzipan;

Chocolate marzipan; Piccalilli; Almond pastries; Almond confectionery; Mustard; Nut confectionery; condiments; .

**Class 35:** Advertising; Business management; Business administration; Office functions; marketing services; publicity services; Retail, wholesale, internet retail or mail order retail services in relation to Bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfume, essential oils, cosmetics, hair lotions, dentifrices, toiletries, Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, and teaching apparatus and instruments, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs and recorded discs, data processing equipment and computers, computer hardware and firmware, computer software, compact discs, downloadable computer software, digital music (downloadable from the Internet), telecommunications apparatus, computer games equipment adapted for use with TV receivers, mouse mats, DVDS, CDs, Printed books, address books, stationery, greetings cards, mail order catalogues, instructional and teaching material (except apparatus), plastic materials for packaging (not included in other classes), Paper, cardboard, printed matter, pens, felt tip pens, fountain pens, ball point pens, colouring pencils, pencils, boxes of pencils, paint boxes, calendar, diary, drawings, paintings, Leather and imitations of leather, animal skins, hides, trunks, handbags, purses, wallets, toilet bags, rucksacks, travelling bags, umbrellas, parasols, walking sticks, Photograph frames of silver plate, metal, resin, shell, mother of pearl or wood, small mirrors, frames, cushions, furniture, storage furniture, storage racks, Perfume bottles and vases of glass and porcelain, glass candle holders, trinket boxes in porcelain, metal and resin, jewellery polishing cloths, household or kitchen utensils and containers (not of precious metal or coated therewith), combs and sponges, brushes (except paint brushes), articles for cleaning purposes, un-worked or semi-worked glass (except glass used in building), glassware, porcelain, earthenware, mugs, cups, saucers, plates, glasses (drinking), tableware, Clothing, footwear, headgear, neck ties, hats, scarves, gloves, belts, pyjamas, dressing gowns, Candles, Mechanical tools, Power tools, hand tools, Cutlery, Garden forks, Lighting, Lamps, Kitchen ranges, Cookers, Bookends, Tablemats of paper, Garden umbrellas, Parasols, statues, ornaments, Plaster statues, Models [ornaments], Statues, figurines, works of art, ornaments, decorations, Garden furniture, Statues, Tablemats of plastic,

Vases, Candlesticks, coasters, Bird feeders, Bird baths, Throws, Tapestries of textile, Tablemats of textile, Towels, Coasters [table linen], Coasters of textile, Tea towels, Aprons, Flowers (Artificial -), Silk flowers, Rugs, Christmas tree decorations, Festive decorations and artificial Christmas trees, Flowers, puzzles, toys, kits, games, playthings, chocolates, confectionery, biscuits, relishes, jams, pate, tea, coffee, cake, mints, tisanes, condiments, sauces, wrapping paper, gift wrapping paper, Christmas crackers, thermometers, weather vanes, reading glasses, hipflasks, telescopes, money boxes, sundials, torches, compasses, barometers, terrariums, manicure sets, bottle openers, magnifying glasses, hair clips, wine stoppers, plaques, chopping boards, cufflinks, Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors, wall hangings (non-textile), Rugs, Mats, Matting, Play mats, Carpets, Bath mats, Floor coverings, Door mats, Wallpapers, Games, toys and playthings, Gymnastic and sporting articles, Decorations for Christmas trees, Video game apparatus, Toys, Cuddly toys, Games, Game consoles, Game cards, Boards games, Cards [games], Video game apparatus, Sports games, Sports equipment, Puzzles, Kites, Toy model kits, Radio-controlled toys, Remote control toys, Toy sets, Roulette sets, Backgammon sets, Domino sets, Chess sets, Checkers sets, Badminton sets, Croquet sets, Archery sets, Model train sets, Toy building block sets, Board games, Dart boards, Bowls bags, Playing bowls, Bowls [games], Toy models, Kaleidoscopes, Meat, fish, poultry and game, Meat extracts, Preserved, frozen, dried and cooked fruits and vegetables, Jellies, jams, compotes, Eggs, Milk and milk products, Edible oils and fats, Jellies, Jams, Jellies, jams, compotes, fruit and vegetable spreads, Pickles, Relishes [pickles], Pâtés, Pates, Cooked truffles, Preserved truffles, Cheese, Almonds, ground, Almond butter, Preserved nuts, Edible nuts, Dried nuts, Coffee, tea, cocoa and artificial coffee, Rice, Tapioca and sago, Flour and preparations made from cereals, Bread, pastries and confectionery, Edible ices, Sugar, honey, treacle, Yeast, baking-powder, Salt, Mustard, Vinegar, sauces [condiments], Spices, Ice, Sauces, Puddings, Crackers, Biscuits, Confectionery, Chocolate, Chocolates, Fudge, Toffee, Toffees, Tea, Tisanes made of tea (Non-medicated -), Fruit infusions, Fruit teas, Coffee, Coffee bags, Coffee essence, Coffee beans, Coffee pods, Gum sweets, Sweets [candy], Boiled sweets, Sugarfree sweets, Truffles [confectionery], Honey, Cakes, Candy mints, Turkish delight, Marzipan, Chocolate marzipan, Piccalilli, Almond pastries, Almond confectionery, Mustard, Nut

confectionery, condiments; information, advice or consultancy services relating to the aforesaid.