

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3191091 BY  
CHERRYANDJERRYLIMITED**

**AND IN THE MATTER OF OPPOSITION:**

- (1) NO 408960 BY DOUGLAS & GRAHAME LIMITED; AND  
(2) NO 408954 BY DOLCE & GABBANA TRADEMARKS SRL

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**DECISION**

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**Introduction**

1. This is the joint appeal against (1) the decision of Mr Martin Boyle, acting on behalf of the Registrar, dated 31 May 2018 (O-332-18); and (2) the decision of Ms Heather Harrison, acting on behalf of the Registrar dated 31 August 2018 (O-544-18).
2. On 13 October 2016 cherryandjerrylimited ("*the Applicant*") applied to register **DG Fashion** as a trade mark. The application was accepted and published for opposition purposes on 6 January 2017 in respect of a range of goods in class 25.
3. The application was opposed by Douglas and Grahame Limited ("*Opponent 1*") under section 5(2)(b) of the Trade Marks Act 1994 ("*the 1994 Act*") ("*Opposition 1*"). For these purposes Opponent 1 relied upon two UK trade mark registrations:

- (1) UK Registration No: 2177137A for the following series of two marks:



Registered in respect of the following goods in Class 25 '*Articles of outer clothing, but not including footwear or headgear.*' The mark was filed on 12 September 1998 and entered onto the Register on 18 June 1999.

- (2) UK Registration No: 2177137B for the following series of four marks:



DG'S



DG

Registered in respect of the following goods in Class 25 '*Articles of outer clothing, all for men and boys, but not including footwear or headwear.*' The mark was filed on 12 September 1998 and entered onto the Register on 28 July 2000.

4. By reason of the above dates both marks are earlier marks in accordance with section 6 of the 1994 Act and both were subject to the proof of use conditions set out in section 6A of the 1994 Act.
5. The Applicant filed a Counterstatement in which it denied that the requirements of section 5(2)(b) of the 1994 Act were satisfied and put Opponent 1 to proof of use of both the marks relied upon in support of the Opposition.
6. Both the Applicant and the Opponent 1 filed evidence and submissions but neither side requested a hearing. The Applicant filed further written submissions in lieu of attendance at the hearing.
7. On 31 May 2018 the Hearing Officer issued his Decision ("***Decision I***") in which he concluded at paragraphs 57 and 58 as follows (emphasis as in the original):

57. I have found varying degrees of similarity between the goods of the competing marks. I have found that the earlier mark has a medium degree of distinctive character, that it has a reasonably high degree of visual, aural and conceptual similarity with the opposed mark, that the selection process for the goods will be primarily visual (though I do not discount the fact that there may be an aural element), and that average consumer will pay a reasonable level of attention. The distinctive letter combination DG will be remembered. Bearing in mind the descriptive nature of the word FASHION in the Applicant's mark, the lack of significance of the possessive S, and the modest nature of the stylisation represented by the interlinking of the letters in the opposed mark, however, I think it likely that a significant proportion of the relevant public will

not retain these elements in the memory and will directly confuse the marks. Even where these differences are noticed and remembered, however, the average consumer will not attribute distinctive significance to them. He or she will simply assume them to represent variant marks of the same or a related undertaking. Bearing in mind that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, I find that there will be either direct or indirect confusion even in respect of those goods which I have found to have a low degree of similarity. It follows that there will also be confusion where the degree of similarity of the goods is greater.

### **Outcome**

58. The opposition succeeds in respect of all the goods of the Applicant's specification in Class 25, except those shown below.

The opposition fails in respect of the following goods of the Applicant's specification in Class 25; the opposed mark may proceed to registration in respect of these goods only, in so far as they are not opposed in other proceedings:

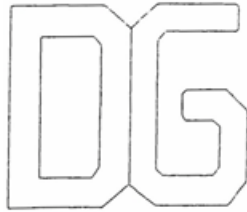
*Class 25: Paper clothing; Paper aprons*

8. The Hearing Officer went on to order that the Applicant pay to Opponent 1 the sum of £1,400 as a contribution to its costs.
9. The application was also opposed by Dolce & Gabbana Trademarks SRL ("**Opponent 2**"). The opposition was brought under sections 5(2)(b), 5(3) and 5(4)(a) of the 1994 Act ("**Opposition 2**"). Under each of the grounds the opposition was directed against all the goods in the application.
10. Under sections 5(2)(b) and section 5(3) Opponent 2 relied upon the following trade marks and all the goods for which they were registered:
  - (1) European Union trade mark ("**EUTM**") No 452359 ("**the 359 mark**") for the mark:

The logo consists of the letters 'D' and 'G' in a large, bold, black, sans-serif font, with an ampersand (&) between them. The letters are closely spaced and have a slightly irregular, hand-drawn appearance.

The mark was registered in respect of a range of goods in classes 3, 9, 18 and 25. The mark was filed on 10 September 1996 and entered on to the register on 22 February 1999.

- (2) International Registration (UK) 845608 (“*the 608 Mark*”) for the mark:



The mark was registered in respect of a range of goods in classes 3, 9, 14, 18 and 25. The international registration and designation date was 10 February 2005 and the date of protection in the UK was 24 March 2006.

11. By reason of the above dates both marks are earlier marks in accordance with section 6 of the 1994 Act and both were subject to the proof of use conditions set out in section 6A of the 1994 Act. Opponent 2 stated in its Notice of Opposition that it had used both marks for all the goods for which they are registered.
12. With respect to the way in which the Opposition was advanced on behalf of Opponent 2 the Hearing Officer set out the position as follows at paragraphs 5 to 7 of her Decision (“*Decision 2*”)(there is no suggestion that this summary is inaccurate):

5. The claims under s. 5(2)(b), identical for both marks, are that the mark applied for is highly similar to the earlier trade marks and that the goods are identical or similar. The opponent claims that this will lead to a likelihood of confusion, including the likelihood of association.

6. Under s. 5(3), the opponent claims that its marks have a reputation in the UK such that use of the mark applied for would cause the relevant public to believe that there is an economic connection between the applicant and the opponent, where no such connection exists. It claims that the applicant would gain an unfair advantage as it would be able to free-ride on the reputation of the opponent’s marks and “benefit from arousing an association in the mind of consumers with the Opponent’s mark on the basis of the Opponent’s investment in marketing and promoting its mark”. The opponent also claims that the earlier marks enjoy a reputation for the quality of the goods provided under the marks and that poor-quality goods produced by the applicant could damage the reputation of the opponent. Further, the opponent claims that use of the application would dilute the distinctive character of the earlier marks, which would lead to consumers being less likely to purchase the opponent’s goods.

7. The opponent further claims under s. 5(4)(a) of the Act that the signs **DG** and **D&G** have been used throughout the UK since 1996 in respect of: clothing; footwear; headgear; bags; articles of luggage; leather and imitation leather goods; accessories; glasses; sunglasses; watches; jewellery; cosmetics and perfumery. All of the goods in the application are opposed under this ground. The opponent claims that it has acquired goodwill under the signs and that use of the mark applied for would amount to a misrepresentation to the relevant public, resulting in damage to the opponent's goodwill.

13. With regard to the Applicant's response the Hearing Officer set out the position as follows (again there is no suggestion that this summary is inaccurate):

8. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of its claims. It denies that there is any visual or aural similarity between the application and the 359 mark. In relation to the 608 mark, it notes the existence of another registered trade mark for the letters "DG" and requests that the opponent provide examples of actual confusion. The applicant also denies that the goods are similar, claiming that the opponent's goods are "high-end", which will not be the case for the applicant's goods. It requires the opponent to provide evidence of use of both of its marks for the goods relied upon in class 25.

9. The applicant denies the opponent's claims under s. 5(3). I note that the applicant's position is slightly contradictory as, despite requiring proof of use in class 25 for both marks, the applicant concedes that the 639 mark has a reputation. It does not, however, say to which goods this concession refers. The applicant denies that the 608 mark has any reputation.

10. As regards the claims under s. 5(4)(a), the applicant's position is again somewhat unclear. It refers to the registered trade marks rather than the signs relied upon, accepting goodwill in the 639 mark but putting the opponent to strict proof of any goodwill in relation to the goods specified, for both marks. I note that an apparent concession is made in its final submissions regarding goodwill in the 639 mark. However, given the lack of clarity in the pleadings and that its submissions also refer to a registered trade mark, I am not persuaded that it would be safe to treat this submission as an unqualified concession on the point. I proceed on the basis that evidence of goodwill was required for both signs and all goods.

14. Both parties filed evidence. The Applicant also filed written submissions during the evidence rounds. Neither party requested a hearing but both filed written submissions in lieu of attendance at the hearing.

15. On 31 August 2018 the Hearing Officer issued Decision 2. In paragraph 1 she indicated that following the partial refusal of the application by reason of Decision 1 the specification for the application that was before her now read '*Class 25: Paper aprons; Paper clothing*'.
16. With regard to the Ground of Opposition under section 5(4)(a) the Hearing Officer found as follows:

Goodwill

...

52. I am satisfied that the opponent's business had a protectable goodwill in the field of clothing at the relevant date. In terms of the sign associated with the goodwill, although some of the uses of "DG" are in a heavily stylised typeface, I am satisfied that there are sufficient examples of "DG" in plain or minimally stylised form that the letters "DG" were distinctive of the opponent's business at the date of application.

53. Whilst the opponent has claimed turnover in relation to "non-apparel", as no invoice evidence is given apart from in relation to clothing, there is no way for me to determine with precision which goods are covered by this term. The evidence of stores featuring the sign "DG" can only be dated to 2009, some seven years before the relevant date, and is not instructive of the way in which the signs may have been used in shops in more recent times. Having said that, there is some limited evidence of use of the sign in relation to belts, bags, footwear, glasses/sunglasses and jewellery/watches by the relevant date. Despite the absence of invoice evidence, and whilst I bear in mind the lack of specificity in the turnover figures, these goods are closely allied to clothing and, on the balance of probability, the opponent's goodwill will have spilled over into these goods, though on a smaller scale.

Misrepresentation

...

55. Whilst there is no evidence that the opponent produces paper clothing or aprons, the goods at issue clearly fall within the same field of activity. I note the applicant's assertion that it does not intend to manufacture high-end or designer clothing. However, the specification applied for covers goods across the market sectors, including high-end or designer goods. The marks in issue are highly similar, visually and aurally, being either composed of or dominated by the identical element "DG". That element has no clear conceptual meaning and it

would certainly not be perceived as “Deal on Goods Fashion”. I note the applicant’s submissions to the effect that “fashion” is distinctive in relation to clothing. That proposition is, in my view, untenable: “fashion” is either a style of clothing or the area of business relating to clothing. Inherently, the word is non-distinctive for clothing goods and is incapable of distinguishing the applicant’s mark from the earlier sign. The evidence of other marks filed by the applicant does not support its submission, as all of the other marks shown include other, distinctive matter. I also dismiss the applicant’s submission that “DG” is non-distinctive: I can see no reason why “DG” would not serve to indicate the origin of the goods. I am satisfied that the use of “DG Fashion” in October 2016 was likely to amount to a misrepresentation to the public.

### Damage

...

58. In a case such as this involving the use of highly similar signs in the same field of activity, damage to the opponent’s business through diversion of sales or loss of control of the opponent’s reputation is easily foreseeable. Damage is made out.

17. The Hearing Officer went on to conclude as follows (emphasis as in the original):

### Conclusion

59. The opposition succeeds in full under s. 5(4)(a).

### Other grounds

60. Given my findings above, and considering the chronic deficiencies in the opponent’s evidence, the opponent’s position would not be materially improved if I were to consider the remaining grounds. I decline to do so.

18. The Hearing Officer went on to order that the Applicant pay to Opponent 2 the sum of £1,000 as a contribution to its costs.

## **The Appeal**

19. On 28 September 2018 appeals against the Hearing Officer's decision was filed on behalf of the Applicant pursuant to section 76 of the 1994 Act in respect of both Opposition 1 and Opposition 2.
20. In this connection, under the cover of a letter dated 28 September 2018 the Applicant filed (1) a Form TM9R seeking a retrospective extension of time in which to lodge an appeal in respect of Opposition 1; two Forms TM55P along with Grounds of Appeal (in identical form in all material respects); and a Form FS2.
21. By letter dated 1 October 2018 the Registrar indicated that his preliminary view that the request for a retrospective extension of time to the 28 September 2018 for the filing of an appeal in Opposition 1 should be granted. Neither party indicated that it disagreed with this preliminary view and therefore the preliminary view was automatically confirmed on 15 October 2018.
22. The Grounds of Appeal in respect of Opposition 1 and Opposition 2 were in all material respects identical. The position was summarised in the first two paragraphs of the Grounds of Appeal as follows:
  1. This is a joint appeal against decisions O-332-18 (Opposition No. 408960) and O-544-18 (Opposition No. 408954) against the registration of the Applicant's trademark "DG Fashion" (UK00003191091).
  2. The Applicant's main case in this appeal is that the two decisions cannot stand together on the distinctiveness point. Both marks also cover the same goods.
23. The Grounds of Appeal then proceeded to expand upon the Grounds and in particular contended in substance that:
  - (1) The effect of Decision 1 was that the distinctive element of Opponent 1's trademark was DG '*irrespective of stylisation*' (paragraphs 7 and 31 of the Grounds of Appeal);
  - (2) The effect of Decision 2 was that the distinctive element of Opponent 2's trademark was DG '*irrespective of stylisation*' (paragraphs 11 and 31 of the Grounds of Appeal);
  - (3) '*The effect of Decision [2] is therefore identical to the effect of Decision [1]. This necessarily affects the application of the distinctiveness test applied in both decisions since neither legal test can be satisfied*' (paragraph 12 of the Grounds of Appeal) and all the more so given that the respective goods



covered were exactly the same and all within Class 25 (paragraphs 21 to 28 of the Grounds of Appeal);

- (4) *‘The logical conclusion of these findings is that the “DG” element has a low level of distinctiveness since both of the Opponents have been using this mark for the exact same class of goods. There is no evidence of either confusion for the purposes of section 5(2)(b) of the Trade Marks Act 1994 or misrepresentation and resulting damage for the purposes of the law of passing off’* (paragraph 35 of the Grounds of Appeal) such that the Hearing Officer should have rejected both the Oppositions on this basis; and
- (5) The word ‘*Fashion*’ included in the Applicant’s mark was ‘*distinctive, even within the fashion sector*’ such being used by ‘*smaller fashion companies in their trademarks and is never used by medium sized or international companies in their trademarks*’ (paragraph 41 of the Grounds of Appeal) such that the Hearing Officer should have rejected the Oppositions on the basis of section 5(2)(b) and/or passing off.

24. With respect to the joined appeal Opponent 1 in a letter dated 19 November 2018 took the position in substance that:

- (1) Decision 1 should be upheld; and
- (2) The existence of other marks consisting of or containing the distinctive DG element was not relevant to the decision and/or detracted from the finding that there was a likelihood of confusion on the part of the public between the applied for mark and the earlier mark relied upon by Opponent 1.

25. In its Respondent’s Notice Opponent 2 took the position in substance that:

- (1) The Hearing Officer was correct in upholding the objection under section 5(4) of the 1994 Act in respect of the ‘DG sign’;
- (2) The Hearing Officer could have also upheld the objection under section 5(4) in respect of the ‘D&G sign’; and/or
- (3) If the decision was not upheld under section 5(4) of the 1994 Act Opponent 2 requested that the decision be remitted back to the Hearing Officer in order that the sections 5(2)(b) and section 5(4) Grounds of Opposition could be determined.

26. At the hearing of the appeal Mr Atif of C.M. Atif & Co appeared on behalf of the Applicant. Neither Opponent 1 nor Opponent 2 appeared at the hearing of the appeals but maintained their positions as outlined above.

### **Standard of review**

27. An appeal against decisions taken by the Registrar is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. see Reef Trade Mark [2003] RPC 5; and Actavis Group PTC v. ICOS Corporation [2019] UKSC 1671 at [78] to [81].
28. Moreover where the decision below involves the making of a value judgment the decision maker on appeal must be especially cautious about interfering with that judgment on appeal: see most recently Actavis (above) at [80]:

80. What is a question of principle in this context? An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. What is the nature of such an evaluative error? In this case we are not concerned with any challenge to the trial judge's conclusions of primary fact but with the correctness of the judge's evaluation of the facts which he has found, in which he weighs a number of different factors against each other. This evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible:  
*Assicurazioni Generali SpA v Arab Insurance Group (Practice Note)* [2002] EWCA Civ 1642; [2003] 1 WLR 577, paras 14-17 per Clarke LJ, a statement which the House of Lords approved in *Datec Electronic Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23; [2007] 1 WLR 1325, para 46 per Lord Mance.

29. It is necessary to bear these principles in mind on this appeal.

### **Decision**

30. It is important from the start of the consideration of this appeal to appreciate that it is not suggested on behalf of the Applicant that:
- (1) Either of the Hearing Officers made any error with respect to their identification of the relevant legal principles that were to be applied to the issues before them; and

- (2) Subject to the findings in relation to the absence of any evidence of confusion and/or the relevance of the word “Fashion” in the Applicant’s mark referred to in paragraph 23(5) above, there was any error of principle in the reasoning in either Decision 1 or Decision 2 when considered separately.
31. The gravamen of the complaint on this appeal is that the findings with respect of distinctiveness/goodwill made in respect of the underlying rights under section 5(2)(b) and section 5(4)(a) resulted in the two decisions being incompatible with either of the oppositions being upheld.
32. In substance, what is also said on behalf of the Applicant is that the Hearing Officers have exaggerated the power of the letters DG to individualise the goods in issue to a single undertaking and that neither Opponent 1’s trade marks registrations or Opponent 2’s goodwill were or could be an obstacle to the registration of the Applicant’s mark in the light of the concurrent findings of distinctiveness in Oppositions 1 and 2.
33. The effect of that submission is that given the findings of distinctiveness made in each of Decision 1 and Decision 2 the Applicant’s mark could be concurrently registered and used in the United Kingdom without giving rise to a likelihood of confusion with respect to the Opponent 1’s trade mark and/or give rise to a misrepresentation with respect to Opponent 2’s goodwill in the letters DG.
34. These propositions are put forward on the basis that the letters DG possess an inherently low degree of similarity such that, notwithstanding the fact that all the marks/earlier rights in suit are likely to be recognised and remembered by reference to one and the same element, namely the letters DG, the mark applied should be allowed to proceed to registration.
35. However this is not the correct approach. The correct approach is that as set out in the Decision of Geoffrey Hobbs QC sitting as the Appointed Person in GUSTO Trade Mark (O-327-06) at page 11 of the transcript (emphasis added):

In order to appreciate the symmetry and logic of this argument, it is necessary to have detailed knowledge of the state of the register relating to GUSTO marks in the relevant classes and a clear understanding of the legal test for determining whether there is or is not a likelihood of confusion. However, these are not attributes which I am able to project on to the average consumer of the goods and services concerned. **I must simply take account of the position of the average consumer in the relevant commercial setting, represented by notional and fair use of the mark applied for in relation to the goods and services specified by the applicant, taking**

**place concurrently with notional and fair use of each earlier trade mark taken in turn.**

When assessing the distinctiveness of the word GUSTO, it is not appropriate to apply anything in the nature of a discount for quantity based on the number of citations that need to be considered. The hurdles do not get lower the more of them there are to be jumped.

36. In this connection it seems to me that it makes no difference in principle that in the present case that (1) the objections were raised by two different proprietors of earlier proprietary rights; or (2) in one instance the objection was raised on the basis of an earlier registration under section 5(2)(b) and in the other under section 5(4)(a) of the 1994 Act. I note in passing that in Opposition 2 there were of course objections raised under section 5(2)(b) and section 5(3) of the 1994 Act but that these were not considered by the Hearing Officer in her decision.
37. In the circumstances, given the position adopted on this appeal on behalf of the Applicant as noted in paragraph 30 above, it seems to me that it was open to each of the Hearing Officers to reach the conclusions that they did on the objection that he/she was considering. It is to be noted in this connection that Opposition 1 succeeded in respect of all the goods specified in the trade mark application except '*paper clothing; paper aprons*' in Class 25; and Opposition 2 was only concerned with and succeeded in respect of '*paper clothing; paper aprons*' in Class 25.
38. Further, for the reasons given above I do not accept that the effect of the two decisions the subject of the present joint appeal is such that the '*test for distinctiveness*' cannot be satisfied as submitted on behalf of the Applicant such that neither of the Oppositions could succeed. In this connection it is to be noted that in relation to the earlier registered trademarks relied upon in Opposition 1 absent to a challenge to the validity of such marks they must be presumed to be validly registered and therefore to satisfy any relevant '*test for distinctiveness*' for these purposes.
39. I am reinforced in my views given that there was a clear finding in paragraph 46 of Decision 1 that the evidence showing offers of goods of third parties under marks which included a "DG" element relied upon by the Applicant fell '*a long way short of establishing that by the time the Applicant applied for the opposed mark UK consumers in the same sectors of the clothing market had been exposed to marks including a "DG" element to such an extent that the distinctiveness of that element had been diluted, or that the average consumer had been educated to distinguish between marks of different proprietors containing that element.*'
40. Further my view is not altered by the two further points raised by the Applicant on this appeal in respect of each of the Decisions namely: (1) the absence of any

evidence of confusion put forward on behalf of either Opponent; and (2) the inclusion of the word “Fashion” in the mark applied for.

41. First with regard to the absence of confusion. Whilst any evidence that the use of the offending sign results in actual confusion is likely to be very persuasive there is no requirement to prove confusion. What must be established is that there is a likelihood of confusion. As correctly pointed out on behalf of the Applicant in the course of the hearing of the appeal an absence of any evidence of confusion can become more significant if there is a longer period of parallel trade without any confusion: see Stichting BDO v. BDO Unibank Inc [2013] FSR 35 at [164] to [168].
42. However, in the present case there is no evidence that side by side trading has (or had at the relevant date) in fact occurred in the United Kingdom. Moreover the position of the Applicant was that the nature of the parties’ respective presences in the relevant market would be very different. Indeed there was evidence filed on behalf of the Applicant that the clothing market was heavily segmented. The evidence put forward on behalf of the Applicant was that their goods were within a separate segment of the market and would only be sold online. In those circumstances the absence of confusion cannot be regarded as material much less determinative in the assessments that either of the Hearing Officers had to make.
43. Second, with regard to the inclusion of the word “Fashion” in the mark applied for and the contention that the word “fashion” can be distinctive for goods in Class 25 the Hearing Officer in Opposition 1 found *inter alia* as follows:
  - (1) The state of the register evidence of trade marks including the word “fashion” all contained additional distinctive elements (paragraph 48 of Decision 1);
  - (2) The examples of the use of these marks demonstrate that the word “fashion” is clearly as a descriptor (paragraph 48 of Decision 1);
  - (3) ‘*When applied to goods in Class 25 the word “fashion” is descriptive in a laudatory way, indicating that they are in vogue or in the prevailing styles*’ (paragraph 49 of Decision 1); and
  - (4) ‘*Although not negligible in the overall impression of the mark, forming as it does, a considerable part of its length, the word FASHION is descriptive of goods covered by the opponent’s specification and will be immediately perceived as such*’ (paragraph 50 of Decision 1).
44. On the role of the word “Fashion” in the applicant’s mark the Hearing Officer in Opposition 2 found as follows at paragraph 55 of Decision 2:

. . . I note the applicant's submissions to the effect that "fashion" is distinctive in relation to clothing. That proposition is, in my view untenable: "fashion" is either a type of clothing or the area of business relating to clothing. Inherently, the word is non-distinctive for clothing goods and is incapable of distinguishing the applicant's mark from the earlier sign. The evidence of other marks filed by the applicant does not support its submission, as all the other marks shown include other distinctive matter. . . .

45. It seems to me that these findings are ones that it was open to the Hearing Officers to make. Mr Atif on behalf of the Applicant could point to no error of principle or identify any materials that had been overlooked or mischaracterised by the Hearing Officers in reaching their conclusions. In my view there are no errors in the findings made by the Hearing Officers on the basis of the materials that were before them.
46. Finally for completeness, I should mention one particular authority which Mr Atif particularly relied upon at the hearing of appeal. That is the judgment of Lloyd-Jacob J in In the matter of Helena Rubenstein Ltd's Trade Mark [1960] RPC 229. However it seems to me that this case is of no assistance in the present appeal because (1) it is a decision under the Trade Marks Act 1938 and not the Trade Marks Act 1994; (2) the common word in the marks in suit was the ordinary English word 'skin' and there was evidence before the Court that the word 'skin' was in common use in the trade respect of toilet creams which was the subject of the trade mark application; and (3) there was evidence before the Court that there had been actual side by side trading for two years of the products without any evidence of confusion.

### **Conclusion**

47. To conclude for the reasons set out above, it does not seem to me that there is any error of principle or material error in the Hearing Officers' decisions. It was in my view open to the Hearing Officers to make the decisions that they did and for Opposition 1 to be upheld in respect of all the goods specified in the trade mark application except '*paper clothing; paper aprons*' in Class 25; and Opposition 2 to be subsequently upheld in respect of the remaining goods specified in the application namely '*paper clothing; paper aprons*' in Class 25. Moreover for the reasons set out above there was no incompatibility between the decisions of the type relied upon in the joint appeal. In the result the joint appeals fail.
48. Neither of the Opponents asked for a special order as to costs on this appeal. Neither of the Opponents took part in the hearing of the joint appeal. Nonetheless both had to consider the fairly extensive Notice of Appeal and both responded to the joint appeal Opponent 1 by way of a letter and Opponent 2 by way of a more formal Respondent's Notice.

49. In all the circumstances it seems to me that the proportionate approach I direct that the Applicant to pay to:

- (1) Opponent 1 the sum of £150 as a contribution to its costs of the unsuccessful appeal against Decision 1. This sum is to be paid within 14 days of this decision and is payable in addition to the sum of £1,400 ordered by the Hearing Officer in respect of Opposition 1 below; and
- (2) Opponent 2 the sum of £200 as a contribution to its costs of the unsuccessful appeal against Decision 2. This sum is to be paid within 14 days of this decision and is payable in addition to the sum of £1,000 ordered by the Hearing Officer in respect of Opposition 2 below.

Emma Himsworth QC  
Appointed Person

2 April 2019