

**O-654-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3297458**

**BY SHENZHEN TORRAS TECHNOLOGY CO., LTD.**

**TO REGISTER AS A TRADE MARK**

**TORRAS**

**IN RESPECT OF GOODS IN CLASS 18**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 413666**

**BY RIMOWA GMBH**

## BACKGROUND AND PLEADINGS

1. On 16 March 2018, Shenzhen Torras Technology Co., Ltd (“**the Applicant**”) filed an application to register as a UK trade mark, the word “TORRAS”, in respect of the following goods in Class 18: *Leather, unworked or semi-worked; Imitation leather; Moleskin [imitation of leather]; Fur; Bags; Valises; Business card cases; Shopping bags; Leather laces; Shoulder belts [straps] of leather; Umbrellas; Umbrella rings; Canes; Mountaineering sticks; Covers for animals; Harness fittings; Muzzles; Leather leashes; Trimmings of leather for furniture.*
2. The application was published for opposition purposes in the Trade Marks Journal on 8 June 2018. RIMOWA GmbH (“**the Opponent**”) opposes registration in relation to some (only) of the goods applied-for, namely<sup>1</sup>:

*Bags; Valises; Business card cases; Shopping bags; Shoulder belts [straps] of leather; Umbrellas*

3. The opposition is based on a claim under section 5(2)(b) the Trade Marks Act 1994 (“the Act”), the Opponent relying on its ownership of two EU trade marks as detailed below:

The Opponent’s trade marks	
EUTM No. <b>10222396</b>	<b>TOPAS</b>
<b>Filing date:</b> 26 August 2011 and <b>Registered:</b> 26 January 2012	
Relying (only) on the following goods under its registration:	
<b>Class 18:</b> <i>Travel luggage, Luggage boxes, In particular trunks and Suitcases, Trunks, Beauty cases, Attaché cases, Suitcases, Trolley cases, Pilot bags, All the aforesaid goods being entirely or partly of metal or plastics or fabric material or a combination of the aforesaid materials; And pouches, bags, handbags, rucksacks of textile material, holdalls, toiletry bags, purses, travel cases, travelling sets, included in class 18.</i>	

<sup>1</sup> The opposition was filed on 7 September 2018 and was originally against all Class 18 goods under the application, but by its letter of 29 March 2019, the Opponent limited the scope to the goods as here listed.

EUTM No. **11591633** Topas Titanium

**Filing date:** 21 February 2013 and **Registered:** 22 July 2013

Relying (only) on the following goods under its registration:

**Class 18:** *Luggage boxes, Travelling trunks, Valises, Travelling bags, Trolley cases, Vanity cases, not fitted, Attaché cases, Cases and parts therefor, included in class 18, in particular suitcase handles, telescopic handles for cases, case wheels; Briefcase; Backpacks, Money holders, Pocket wallets, Belt bags, Travelling sets [leatherware], Garment bags for travel, Bags for sports, Travel kit bags sold empty, Waist pouches, book bags; Leather and imitations of leather, and goods made of these materials and not included in other classes; Luggage straps, luggage tags; Luggage and umbrellas.*

4. The question to be determined under the claim is whether the respective marks of the parties are similar, and their respective relevant goods identical or similar, such that there is a likelihood that the average consumer will be confused as to the source of those goods.
5. The Opponent applied for its trade marks before the filing date of the Applicant's mark; therefore, in relation to that opposed mark, each is an "earlier mark" as defined in section 6 of the Act. The Opponent's EUTM No. 10222396 (TOPAS) had been registered for more than five years at the publication date of the application, so falls in scope of the proof of use provisions under section 6A of the Act. The Opponent's EUTM No. 11591633 (TOPAS TITANIUM) completed its registration process on 22 July 2013, so had not, at the publication date, been registered long enough to engage the proof of use provisions; the Opponent is therefore able to rely on that earlier mark in these proceedings in respect of its claimed goods without having to prove that it has used the mark at all.
6. The Applicant submitted a Form TM8 notice of defence, including a counterstatement denying the claim that registration of its mark would be contrary to section 5(2)(b). The Applicant requested that the Opponent provide proof of use of EUTM No. 10222396 for the mark TOPAS insofar as it covers goods in Class 18.
7. The Opponent is represented by Swindell & Pearson Ltd, who, during the evidence rounds, filed submissions and evidence going to proof of use. The Applicant is represented by A. A. Thornton & Co. who filed nothing during the evidence rounds, but both parties filed

submissions in lieu of an oral hearing. I have read the papers filed and shall refer to the evidence and to points made by the parties where I consider it warranted to do so.

## **EVIDENCE**

8. The evidence filed by the Opponent comprises a **witness statement**, dated 26 March 2019, by **Dr Tobias Kircher**, who is the Opponent's Chief Legal Officer. His statement is supported by **Exhibits DTK1 - DTK18**. The Opponent's representatives acknowledged that the volume of evidence exceeded the normal limit of 300 pages, but requested that the registrar exercise his discretion to allow all 390 pages. They stated that the evidence involves a mark used over several decades, in many countries across the world, and that the evidence was marshalled to show use during the relevant period in EU, including the UK. While it seems to me that the evidence might have been brought within the normative limit (for example, Exhibit DTK6 includes around 220 individual illustrative invoices relating to numerous EU countries), the compilation and presentation of the evidence was orderly, and the relevance of the material was explained in the 12 pages of Dr Kircher's witness statement. The evidence was admitted in full ahead of this decision and I say no more about the volume of evidence.

## **PROOF OF USE**

9. The Opponent must show that during the 5 years up to the date when the Applicant's mark was published for opposition purposes the Opponent's earlier mark EUTM No. 10222396 had been put to genuine use in relation to the goods on which it relies. The "**relevant period**" is therefore **7 June 2013 to 8 June 2018**.
10. Section 6A of the Act states that the use conditions are met if:
  - " ... (3) (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) ....
- (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) ....”

- 11. Section 100 of the Act makes it clear that the burden of proof falls on the Opponent to show that it has used its marks.
- 12. The case law principles on genuine use were recently summarised by Arnold J in *Walton International*<sup>2</sup>. It is unnecessary here to set out the full wording, but I note that the requirement for genuine use of the earlier trade mark will be satisfied if the evidence shows that: there has been **actual** use of the trade mark by the proprietor (or authorised third party) in relation to marketed goods; the use is **more than merely token** (i.e. is more than serving solely to preserve the rights conferred by the registration of the mark); the use is **consistent with the essential function** of a trade mark, which is to guarantee the identity of the origin of the goods to the consumer or end user by enabling her/him to distinguish the goods from others which have another origin; and that the use is by way of **real commercial exploitation** of the mark on the market for the relevant goods, 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 that bear the mark.
- 13. In the same case, Arnold J stated that 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 in question; (b) the nature of the goods; (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 covered

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<sup>2</sup> *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch) - at paragraph 114.

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. He also highlighted that 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.

14. Since the Opponent's marks are registered in respect of the European Union, I also bear in mind judicial comment in leading cases that have considered the geographic extent of the use required to be shown to satisfy genuine use in the European Union. Such case law affirms that the territorial scope of the use within the European Union is not a separate condition for genuine use, but is 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<sup>3</sup>; territorial borders of the Member States should be disregarded and the assessment remains to take account of all relevant facts and circumstances, as stated in the paragraph above.
15. In making my determination as to whether the evidence presented shows the necessary genuine use, I also take account of judicial comment as to probative and evidential issues in such cases. For example, in *Dosenbach-Ochsner*<sup>4</sup>, Mr Geoffrey Hobbs QC sitting as the Appointed Person stated that:
  - “22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”
16. In addition to the above case law directly concerning proof of use, it is also relevant to note here the case law principles relating to the framing of a fair specification in light of the extent of use that may be established by the evidence.

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<sup>3</sup> See the Court of Justice of the European Union in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, in particular at paragraphs 36, 50 and 55. See too *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, where Arnold J. reviewed the case law since the *Leno*, in particular at paragraphs 228-230.

<sup>4</sup> *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13

17. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC sitting as the Appointed Person explained that "... 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."
18. I also note the following from Mr Justice Carr at paragraph 47 of the *Titanic Spa* case<sup>5</sup>:
- "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."

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<sup>5</sup> *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch).

19. Dr Kircher explains at paragraph 6 of his witness statement that **Exhibit DTK1** includes a page from the Opponent's UK 2016 catalogue; this shows that the Opponent is well established as a maker of luggage, and particularly shows that it produces a range of grooved, aluminium luggage. The evidence shows the Opponent's luggage branded under the RIMOWA house brand, but with TOPAS serving as a collection name<sup>6</sup>, where the word is used alone, or coupled with another, particularly as TOPAS TITANIUM or TOPAS STEALTH. To the extent that the evidence shows the TOPAS mark with any minor stylisation of the word, such is certainly fair and reasonable use of the registered word mark.
20. Various of the exhibits show images and descriptions of goods in the TOPAS luggage collection available in different sizes and models. For example, **Exhibit DTK2** shows, through use of the Internet Archive Wayback Machine, the Opponent's website as it was in 2017. **Exhibit DTK4** shows the locations of the Opponent's retail stores across the EU, including the UK, at which Dr Kircher states that products were sold and advertised under the TOPAS mark during the relevant period. **Exhibit DTK5** shows various third-party retailers offering the Opponent's goods for sale, including a page from the website of *Selfridges & Co*, which department store has outlets in three UK cities. That web page is undated, which limits its evidential value, but it shows images of various of the Opponent's goods including one identified as "RIMOWA Topas multi-wheel suitcase 55 cm". Other exhibits include brochures and catalogues (in various languages) stated to have commonly been provided with TOPAS products during the relevant period and which show the TOPAS mark used in relation, for example, to a cabin suitcase, a cabin trolley and a beauty case.
21. Dr Kircher states at paragraph 18 of his witness statement that annual turnover in the EU for "TOPAS products" in each of the years 2012-2018 was in excess of 25 million euros. **Exhibit DTK6** shows over 220 invoices across the years of the relevant period and covering many EU countries (albeit with a strong emphasis on Germany). The invoices are marked under the Opponent's company brand (RIMOWA) but the product descriptions include references to TOPAS (solus, although many with Stealth and Titanium). I noted only seven invoices to the UK (England); of these, three (at pages 115, 181 and 210) referred to TOPAS solus, and in amounts totalling around 15,000 euros.

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<sup>6</sup> For example, Exhibits DTK5 and DTK7.

22. Marketing and advertising of the Opponent's goods are shown in **Exhibit DTK17**, which includes extracts from various English-language magazines, including *Condé Nast Traveller*, *Harper's Bazaar* and *GQ*, from 2015 – 2017, showing images of what are discernibly the aluminium cases of the Opponent, identified in other exhibits as being the Topas range. In some instances the mark is also discernible. **Exhibit DTK18** provides further evidence of advertisements in the *Harrods* magazine and other magazines such as *Vogue Living*, *Le Monde* and *Grazia* in various other EU countries during 2016-2017.
23. In its written submissions in lieu of a hearing, the Opponent submits that it has shown genuine use of the mark TOPAS for all of the goods of EU Trade Mark Registration No. 10222396, with the exception of "pouches", "handbags", "rucksacks of textile material", "purses", "toiletry bags" and "holdalls". The Opponent submitted that the average consumer would fairly describe all of the goods for which the mark has been used as "luggage". Noting the specific references in the evidence to, *inter alia*, a cabin suitcase, a cabin trolley and a beauty case, and taking into account the principles outlined above at paragraphs 12 – 18, I largely agree with the submissions. However, although the *Pan World* and *Thomas Pink* cases (mentioned above<sup>7</sup>) held that use in relation to 'holdalls' justified a registration for 'luggage' generally, I do not find that use in relation to 'luggage' justifies a registration in relation to 'bags' generally. As the Opponent itself submitted, the evidence of use excludes holdalls and handbags, and I consider that it will likewise also exclude other types of bag. I find that the Opponent is therefore able to rely on that earlier mark in relation to the following fair specification of its goods in Class 18:

*Travel luggage, Luggage boxes, In particular trunks and Suitcases, Trunks, Beauty cases, Attaché cases, Suitcases, Trolley cases, Pilot bags, All the aforesaid goods being entirely or partly of metal or plastics or fabric material or a combination of the aforesaid materials; And pouches, bags, handbags, rucksacks of textile material, holdalls, toiletry bags, purses, travel cases, travelling sets, included in class 18.*

## **DECISION**

### **The applicable law:**

24. Section 5(2)(b) of the Act, reads as follows:

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<sup>7</sup> *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch)

“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”.

25. Determination of a section 5(2)(b) claim must be made in light of the following principles, which 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. The principles include the following:

- i. The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- ii. 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;
- iii. the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- iv. 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;

- v. nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- vi. 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;
- vii. 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;
- viii. 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;
- ix. mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- x. 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;
- xi. if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of the goods**

<b>The opposed goods applied-for</b>
<b>Class 18:</b> <i>Bags; Valises; Business card cases; Shopping bags; Shoulder belts [straps] of leather; Umbrellas</i>

**A fair specification of Opponent's goods under EUTM 10222396  
(the TOPAS mark)**

**Class 18:** *Travel luggage, Luggage boxes, In particular trunks and Suitcases, Trunks, Beauty cases, Attaché cases, Suitcases, Trolley cases, Pilot bags, All the aforesaid goods being entirely or partly of metal or plastics or fabric material or a combination of the aforesaid materials; And travel cases, travelling sets, included in class 18.*

**The Opponent's goods under EUTM No. 11591633 (the Topas Titanium mark)**

**Class 18:** *Luggage boxes, Travelling trunks, Valises, Travelling bags, Trolley cases, Vanity cases, not fitted, Attaché cases, Cases and parts therefor, included in class 18, in particular suitcase handles, telescopic handles for cases, case wheels; Briefcase; Backpacks, Money holders, Pocket wallets, Belt bags, Travelling sets [leatherware], Garment bags for travel, Bags for sports, Travel kit bags sold empty, Waist pouches, book bags; Leather and imitations of leather, and goods made of these materials and not included in other classes; Luggage straps, luggage tags; Luggage and umbrellas.*

26. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*<sup>8</sup>, the General Court stated that goods can be considered as *identical* when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (and vice versa). And in considering the extent to which the goods may be *similar*, I take account of the factors identified by the CJEU in *Canon*<sup>9</sup> where it stated that:

*“In assessing the similarity of the goods ... all the relevant factors relating to those goods .. 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”*.<sup>10</sup>

<sup>8</sup> Case T- 133/05 at paragraph 29 of that judgment.

<sup>9</sup> Case C-39/97, at paragraph 23.

<sup>10</sup> The essence of case law points on similarity made in relation to goods applies correspondingly to services.

27. In *Boston Scientific*<sup>11</sup>, the General Court described goods as “complementary” in circumstances where “... *there is a close connection between [the goods], 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*”. I also take note that in *Kurt Hesse v OHIM*<sup>12</sup>, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.
28. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case<sup>13</sup> 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.
29. Considering first the goods under the **TOPAS mark (EUTM 10222396)**:
- a) The Applicant’s “Bags; Valises”: A “valise” may be considered as a small travelling bag or suitcase. On the basis of the principle in *Gérard Meric* I find the Applicant’s “*Bags; Valises*” to be **identical** to the Opponent’s “*Travel luggage, Suitcases, Pilot bags, All the aforesaid goods being entirely or partly of metal or plastics or fabric material or a combination of the aforesaid materials; And travel cases, travelling sets, included in class 18*”, as protected in its fair specification.

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<sup>11</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

<sup>12</sup> Case C-50/15 P

<sup>13</sup> *British Sugar PLC v James Robertson & Sons Ltd* [1996] R.P.C. 281

- b) The Applicant's "Business card cases": I find **no similarity** with the Opponent's goods under its TOPAS mark. The evidence included material and statements to make the point that retailers selling luggage also sell business card cases, along with wallets and umbrellas. Even if I take that point as established, any similarity that may consequently arise on the basis of shared channels of trade would be of a **very low level** when weighed in the balance with the other relevant factors for similarity (noting, for example, that the respective goods are different in nature and purpose and are not in competition).
- c) The Applicant's "Shopping bags": While there is a degree of similarity inasmuch as the Opponent's luggage goods are also bags, there is a clear difference between, on the one hand, goods that are luggage, which are used for packing clothes and belongings for travel purposes (and which are designed accordingly, factoring in criteria such as the need to be suitably robust and securely closable), and, on the other hand, bags that are typically carried empty to supermarkets and other stores in order to take home shopping items. The goods differ in key aspects of nature, purpose, method of use, are not in competition and not complementary in the sense that one is indispensable or important for the use of the other. I find the goods similar only to a **low degree**.
- d) The Applicant's "Shoulder belts [straps] of leather": I understand this term to include or refer to a strap of leather that may be attached, for example, to an item of "travel luggage" enabling it to be carried more easily. The specified goods differ in key aspects of nature, purpose, method of use, and are not in competition. However, the goods are solidly complementary in the sense described in *Boston Scientific* and would likely be sold alongside one another and through common trade channels. I find the goods may be considered similar to a **medium degree**.
- e) The Applicant's "Umbrellas": I find **no similarity** with the Opponent's goods under its TOPAS mark, or else, again, if there is an overlap in channels of trade any similarity on that basis would be of a **very low level**, given the clear differences in nature, purpose, users, method of use, and lack of competition and of complementarity.

30. Turning now to the goods under the **Topas Titanium mark (EUTM 11591633)**:

- a) The Applicant's "Bags; Valises": Both parties have specified "Valises", which are self-evidently **identical**. The Opponent's specification also includes, for example, "*Travelling*

*bags, Garment bags for travel, Bags for sports, book bags*” and on the basis of the principle in *Gérard Meric* those are identical goods to the Applicant’s “Bags”.

- b) The Applicant’s “Business card cases”: These goods overlap with the Opponent’s registration for “*Pocket wallets*”. Pocket wallets commonly have slots to accommodate cards of various sorts, including business cards, so they have something centrally in common in purpose and nature. A consumer may choose to buy a wallet capable of carrying business cards sufficient to their needs, so there is also an element of competition, and the goods are likely to be sold through the same outlets and alongside one another. I find them similar to a **high degree**.
- c) The Applicant’s “Shopping bags”: The Opponent’s specification includes, for example, “*Backpacks; book bags*”. I find that bags of this type may be bought and used for various purposes, which may include use as a shopping bag. There are thus clear overlaps in uses, users, purpose, nature and method of use and channels of trade. I find these goods **highly similar**.
- d) The Applicant’s “Shoulder belts [straps] of leather”: The Opponent’s specification includes “*Cases and parts therefor included in class 18, in particular suitcase handles,*” and “*Luggage straps*”. These goods may be considered **identical**.
- e) The Applicant’s “Umbrellas”: Both parties have specified “umbrellas”, which are self-evidently **identical**.

### **The average consumer and the purchasing process**

31. In *Hearst Holdings Inc*,<sup>14</sup> Birss J. explained that “... *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 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 word “average” denotes that the person is typical ...*”.
32. The notional average consumer in this case will be a member of the public at large, who will purchase the goods in shops, via the internet or, possibly, through catalogues. They will

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<sup>14</sup> *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), at paragraph 60.

see the marks used as labelling or branding on the goods and/or in advertising. Customers are likely to select the goods on the basis of a visual perusal of items in a store or on-line and I therefore consider the purchase to be a primarily visual one<sup>15</sup>, but aural considerations may also play a part, such as on the basis of word-of-mouth recommendations, so I also take into account the aural impact of the marks in the assessment.

33. The price of the goods may vary from cheap to expensive, but I find that the consumer will be engaged in the purchasing process at least to a degree to ensure suitability in terms of size, functionality and styling preference. I consider it fair to characterise as ‘**normal**’, or ‘**medium**’, the level of attention of the average consumer in buying the goods specified in this case.

**Comparison of the marks**

34. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* 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.”
35. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

<b>The Applicant’s contested trade mark:</b>	TORRAS
<b>The Opponent’s earlier trade marks:</b>	TOPAS TOPAS TITANIUM

<sup>15</sup> See paragraphs 49 and 50 of the judgment of the General Court in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03.

36. The overall impression of the Applicant's mark "TORRAS" derives from that single word, which carries no meaning in English and which therefore inevitably represents the distinctive and dominant component of the mark.
37. The overall impression of the earlier mark "TOPAS" derives from that single word, which inevitably represents the dominant component. The word carries no meaning in English, has no descriptive resonance for the goods at issue, and is distinctive in respect of such.
38. The two words of the earlier mark "TOPAS TITANIUM" contribute to the overall impression of that mark; however, because TOPAS appears an invented word in English, and is the first word in the mark, it may be considered more dominant in the mark (although to different degrees, according to the goods in question). I will say more about the "TITANIUM" aspect of the mark in the overall impression, where I consider the conceptual aspects of similarity between the marks - and which, for convenience therefore, I deal with first below.

#### *Conceptual similarity*

39. TORRAS cf TOPAS: It was submitted on behalf of the Applicant that the word "TOPAS" is a German word, the English translation of which is "topaz", and that those equivalent words are similar. It was stated that topaz *"is a precious stone, typically colourless, yellow, or pale blue consisting of an aluminium silicate that contains fluorine."* The Applicant argued that *"bearing in mind that the Opponent is German company, the public at large will understand the mark "TOPAS" as a version or an alternative spelling of the word "topaz" and its connotation as described above."* I find, however, firstly that it cannot be presumed that the average consumer would be aware of the Opponent's national origin; secondly, that given the inherent transferability of property rights, the nationality of the proprietor of a registered mark is anyway liable to change; and, thirdly, it cannot be assumed that the average consumer would perceive the word as signifying the equivalent of the English word "topaz". Instead, I find that the average consumer, or at any rate a substantial part of the relevant public, would fail to perceive any meaning in the word in English. I therefore accept the submission put forward by the Opponent that there can be **no relevant conceptual analysis** as between the marks TOPAS and TORRAS, because neither mark has a readily graspable meaning. The position in relation to the conceptual similarity of those marks is therefore **neutral**.

40. TORRAS cf TOPAS TITANIUM: In respect of the earlier mark TOPAS TITANIUM, the Opponent's position was that the word "Titanium" "... *is not significant and would not assist the consumer in differentiating between the marks*". It argued that the word "Titanium" is descriptive of products which may be made from the material titanium, have the appearance of titanium or which may have the benefit of being strong and robust (my emphasis). The Opponent's representatives stated in submissions that in the case of its own goods, "Topas Titanium" is the name given by the Opponent to a line of luggage products in its collection "*which are made of titanium anodized aluminium*" giving the "... *range a sleek, titanium finish*"; it was argued that the "*notably different appearance*" of the Titanium range from the other TOPAS luggage ranges can be seen in the evidence filed. On that point, although the small print of **Exhibit DTK12** (page 3) refers to the cases having "*an elegant titanium appearance*", I noted no reference in the evidence to (even these particular) goods of the Opponent actually featuring titanium in their composition, such that the word could in that way be directly descriptive<sup>16</sup>. The submissions of the Opponent also concluded that the word "*TOPAS forms the dominant and distinctive part of the mark "Topas Titanium" and the word "Titanium" would be ignored or would go unnoticed by the consumer*".
41. In my view, the Opponent's submissions on this point involve a degree of overstatement. I find that the extent to which the word "TITANIUM" will play a distinctive role in the TOPAS TITANIUM mark, will vary according to the particular goods in question. I find that the average consumer will recognise the word, "TITANIUM", as a standard English word referring to a particular metal; as to any further level knowledge of the metal on the part of the average consumer, the matter is less clear, and the Opponent filed no evidence on the point. I am not, for example, satisfied that the average consumer would have clear knowledge of the colour of that element. However, viewing the matter as a member of the general public, I find that the average consumer would recognise that it is a somewhat uncommon metal and would attribute to it certain qualities that would include strength, robustness and a degree of luxury. Thus, for goods that are evidently made of metal (of some kind), then the word TITANIUM is likely in the perception of many among the relevant public to be understood in connection to that material and will therefore bear a strong degree of allusiveness (if not descriptiveness). However, not all of the goods in Class 18 are apt to be made of metal and I shall distinguish those goods later in this decision where I consider

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<sup>16</sup> The submissions referred also to Exhibit DTK8 (pages 20 and 23); Exhibit DTK9 (page 3); Exhibit DTK10 (page 3); and Exhibit DTK11 (page 3).

matters of likelihood of confusion. Therefore, as between the marks “TORRAS” and “TOPAS TITANIUM”, there is a **conceptual difference** in that the latter contains the graspable concept of an English word signifying a metal; however, that will **not be an operative difference where the goods at issue are apt to be made of metal** such that the word may be considered to lack distinctiveness.

#### *Visual similarity*

42. TORRAS cf TOPAS: The word “TORRAS” is one letter longer than “TOPAS”, but the words are of similar length, and both words begin and end alike, with “TO” and “AS”. The Applicant’s submissions in lieu acknowledged “some similarities” but argued that the differences were “obvious” and outweighed the similarities. The marks differ in their middle letters, between “P” in the earlier mark and “RR” in the Applicant’s mark. Fair and ordinary use of the word marks would of course include their use in upper case, and I find that visually the capital letters “P” and “R” are similar. Although I note the additional point of difference of the doubling of the middle letters in the Applicant’s mark, I find that overall, the marks are **visually similar to a degree** that may be considered **at least medium**.
43. TORRAS cf TOPAS TITANIUM: The presence of the longer second word, entirely absent from the Applicant’s mark creates a notable visual difference. However, I have found that in the overall impression of the mark, the word “TOPAS” is dominant in the perception of the average consumer. I have also found that in relation to **such of the goods at issue that are apt to be made of metal**, the allusive/descriptive potential of the word “TITANIUM” significantly reduces its distinctiveness in the overall impression of the mark; the word “TOPAS” retains an independent distinctive role and the word “TITANIUM” would be taken as some reference to the material of which those goods are made. In those circumstances, taking due account of their distinctive aspects, I find the marks “TOPAS TITANIUM” and “TORRAS” to be **visually similar to medium degree**. In relation to goods not apt to be made of metal, the distinctiveness of the word “TITANIUM” increases accordingly in the overall impression and **the notable visual difference of the word reduces to low the degree of visual similarity between the marks**.

#### *Aural similarity*

44. TORRAS cf TOPAS: Some members of the UK public may pronounce “as” to sound “az”, even when those two letters form part of each of these two non-English, seemingly

meaningless words. Thus, such people would voice the words as TOE-PAZ (or TOP-AZ) and TOR-RAZ. However, I find it more likely that in the UK most consumers, unfamiliar with the words, would pronounce them in the fashion submitted by the Opponent, with a more sibilant sound - as TOP-ASS and TORR-ASS. I find the marks share a degree of aural similarity, but to a degree that is no higher than **medium**.

45. TORRAS cf TOPAS TITANIUM: In line with the analysis for visual similarity, and thus necessarily factoring in variations in distinctiveness for the TITANIUM component of this earlier mark according to the goods in question, I find that in relation to **such of the goods at issue that are apt to be made of metal**, the marks “TORRAS” and “TOPAS TITANIUM” are aurally **similar** to a degree that is a little lower than **medium**. In relation to goods not apt to be made of metal, the additional four syllables of **the second word reduce the aural similarity between the marks to a degree that can be considered no higher than low**.

#### **Distinctiveness of the earlier mark**

46. The distinctive character of the earlier mark must be assessed, as, potentially, the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion.<sup>17</sup> In *Lloyd Schuhfabrik*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of

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<sup>17</sup> *Sabel* at [24]

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)".

47. The earlier mark "TOPAS": As previously noted, "TOPAS" carries no meaning in English, and will strike the average consumer as an invented word that has no descriptive resonance for the goods in the fair specification. I find that the earlier mark may therefore be considered to be inherently distinctive to a high degree.
48. The earlier mark "TOPAS TITANIUM": The first word remains inherently distinctive to a high degree. The second word is not an invented word, but in relation to goods where it has no descriptive message, it has its own degree of inherent distinctiveness. In relation to goods made of metal (of some kind), then the distinctiveness of the word "TITANIUM" is significantly reduced because in the perception of many among the relevant public it is likely to be understood in connection to that material. Nonetheless, since the first word is inherently distinctive to a high degree, the additional word does not materially reduce the overall distinctiveness of the mark as a whole, which I find may likewise be considered to be inherently distinctive to a high degree.

### **Conclusion as to likelihood of confusion**

49. Determining whether there is a likelihood of confusion is not a scientific process; rather it involves taking account of my findings thus far in this decision— around the marks, the goods, the purchasing process - and of the authorities and principles I have set out, in particular at paragraph 25 above. Matters must be considered from the perspective of the average consumer, who is deemed to be reasonably well informed and reasonably circumspect; the factors have a degree of interdependency and must be weighed against one another in a global assessment<sup>18</sup> as to whether the average consumer is likely to be confused.
50. The opposition relies on two different earlier marks which share a common component ("TOPAS") which gives the earlier marks an inherently high degree of distinctiveness. This is significant inasmuch as, potentially, the more distinctive the earlier mark, the greater will

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<sup>18</sup> *Canon* at [17]; *Sabel* at [22].

be the likelihood of confusion. Yet, the additional word “TITANIUM” in the other earlier mark, may in some circumstances differentiate it from the Applicant’s mark; on the other hand, there will also be circumstances in which the additional word will not materially differentiate the marks, because it will be understood as descriptive or directly allusive of the material from which goods in question are made, and thus of limited distinctive weight. A salient consideration in deciding whether there is a likelihood of confusion is therefore whether or not the goods in question are apt to be made of a material (metal) to which the average consumer will perceive the word “TITANIUM” to refer directly.

51. Before assessing a likelihood of confusion under each of the earlier marks separately, which involve different degrees of similarity both in terms of the marks themselves and their goods, I note that the average consumer and the purchasing process are common to both marks, featuring members of the public at large, who will pay a normal/medium level of attention in buying the goods, and where visual considerations are primary, although aural considerations also factor.

*Earlier mark “TOPAS”*

52. I have found the Applicant’s mark “TORRAS” to be visually similar to the earlier mark “TOPAS” to at least a medium degree, and aurally similar to a degree that is no higher than medium. (Conceptual considerations here play no relevant part.) I have found some of the goods under that earlier mark to have only low or no/very low similarity with the goods applied for – namely “shopping bags”, “business card cases” and “umbrellas”. In relation to these goods, I find that no confusion is likely – the level of similarity between the marks is not sufficiently great to offset the low level of similarity between the goods.
53. However, I have found higher degrees of similarity for other goods under that earlier mark, where I found “shoulder belts [straps] of leather” to have a medium degree of similarity and that “bags” and “valises” are identical with goods under the earlier mark. In relation to these goods, I find that confusion is likely. I reach this conclusion weighing in the balance factors such as the offsetting effect of the level of similarity between the goods, the role of imperfect recollection on the part of the consumer, and the highly distinctive character of the earlier mark. I also note the submission by the Opponent as to the visual similarity between the letters “R” and “P” which may *“easily be misread or confused by the consumer, particularly where the marks appear on items of luggage or bags, are glanced at, seen at a distance, or*

*where they appear in a stylised font*". There is, in my view, a likelihood that at least a significant proportion of the relevant public may directly confuse the marks (mistake one for the other) applied on or in relation to identical or strongly complementary goods.

*Earlier mark "TOPAS TITANIUM"*

54. In considering this earlier mark, I have found that the addition of the meaningful English word gives rise to a conceptual difference, but that it will only be an operative difference where the goods at issue are not apt to be made of metal. This consideration also informed my assessment of visual and aural similarity, in that where the goods at issue are not apt to be made of metal, the distinctiveness of the word "TITANIUM" increases accordingly in the overall impression; in those circumstances I find the marks "TORRAS" and "TOPAS TITANIUM" to be visually and aurally similar only to a low degree. Conversely, where the goods are apt to be made of metal, the word "TITANIUM" may be considered to lack distinctiveness and the levels of visual and aural similarity are not significantly different from my assessments in relation to the other earlier mark (TOPAS solus) – around medium (or a little lower than medium aurally).
55. This is significant in the assessment of likelihood of confusion because the goods under this earlier mark are either identical or highly similar to the goods applied for. That said, I have already found, in relation to three of the goods applied for, that the opposition succeeds on the basis of the earlier mark "TOPAS", namely "bags", "valises" and "shoulder belts [straps] of leather". Although each of those goods is identical to goods under the TOPAS TITANIUM mark, the Opponent will be in no stronger position on the basis of that mark, so I shall direct my analysis of a likelihood of confusion under the TOPAS TITANIUM mark only in relation to the remaining goods – namely "shopping bags", "business card cases" and "umbrellas".
56. In my experience (as a member of the general public), although there may be different types of business card case, one such may be a card-sized container to hold a dozen or so business cards for distribution at meetings or similar events. Such a container is apt to be made of metal. Similarly, umbrellas are apt to involve metal in their construction, notably in the shaft, and where an implication of strength in that material would be especially pertinent. However, I do not find that shopping bags are apt to be made of metal.
57. Taking all this into account, I conclude firstly that the average consumer will not overlook the additional word "TITANIUM" in this earlier mark and so will not mistake the Applicant's mark

“TORRAS” as being the same as this earlier mark “TOPAS TITANIUM”. However, while I thus find no direct confusion, I must also consider the prospect of indirect confusion.

58. The nature of indirect confusion was considered by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,<sup>19</sup> where he noted that indirect confusion “... *only arises where the consumer has actually recognised 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.”*
59. As noted by Mr James Mellor QC in *Eden Chocolat*<sup>20</sup>, this is in line with rulings of the Court of Justice of the European Union that a likelihood of indirect confusion exists where the average consumer forms the view that the goods come from economically linked undertakings. Mr Mellor QC re-emphasised case law’s central focus on a global assessment, effectively emulating what happens in the mind of the average consumer on encountering, for example, the mark applied for with an imperfect recollection of the earlier mark in mind. He stated that this is not a process of analysis or reasoning, but an impression or instinctive reaction.
60. I conclude that in relation to the goods that are identical or highly similar and are apt to be made of metal (i.e. umbrellas and business card cases), given the similarity that exists between the distinctive word “TOPAS” and the applied-for “TORRAS”, the presence in this earlier mark of the additional word “TITANIUM” is not sufficiently distinctive in those circumstances to avoid giving rise to the existence of a likelihood of confusion if the marks were used concurrently as trade marks. I also note the loose steer in case law that the average consumer generally pays greater attention to the beginning of a mark than to the end.<sup>21</sup> The average consumer paying an average degree of attention may be likely to

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<sup>19</sup> Case BL-O/375/10, para 16-17.

<sup>20</sup> Case BL O-547-17 *Eden Chocolat be more chocstanza (word & device) v Heirler Cenovis GmbH* (27 October 2017), paragraph 81 onwards.

<sup>21</sup> For example, paragraph 24 of the ruling of the European Court of First Instance in *L’Oreal v OHIM Case T-21/07*, [2009] ETMR 49

perceive the “TITANIUM” component as sub-branding, referring in some way to the material from which the goods are made, and wrongly believe that the respective goods come from the same or economically linked undertakings.

61. However, in relation to “shopping bags”, which I have found are not apt to be made of metal, the word “TITANIUM” will have a far higher distinctive role. Taking into account that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, I find that even though the goods at issue may be considered highly similar, the similarity between the marks as a whole is low and in a global assessment is sufficient to avoid a likelihood of confusion.

## **OUTCOME**

62. The opposition succeeds in relation to the following goods: *Bags; Valises; Business card cases; Shoulder belts [straps] of leather; Umbrellas*. Registration of the Applicant’s mark may therefore not proceed in respect of those goods.
63. The opposition fails in respects of *Shopping bags*. Registration of the Applicant’s mark may therefore proceed in respect of those goods and the other goods that were not the subject of this opposition decision.
64. Consequently, the application may proceed to registration in respect of the following goods in Class 18:

*Leather, unworked or semi-worked; Imitation leather; Moleskin [imitation of leather]; Fur; Shopping bags; Leather laces; Umbrella rings; Canes; Mountaineering sticks; Covers for animals; Harness fittings; Muzzles; Leather leashes; Trimmings of leather for furniture.*

## **COSTS**

65. This opposition has largely succeeded (at least with respect to the amended selection of goods limited by the Opponent in its letter of 29 March 2019) and the Opponent is entitled to a contribution towards its costs. Taking into account that the Opponent succeeded only in relation to five of the six goods specified, and based on the guidance in Annex A of Tribunal Practice Notice (“TPN”) 2/2016, I award costs as follows:

Official fee for Form TM7	£100
Preparing a statement and considering the other side's counterstatement	£200
Preparation of evidence	£550
Preparation of submissions in lieu of a hearing	£350
<b>Total</b>	<b>£1200</b>

66. I order Shenzhen Torras Technology Co., Ltd to pay RIMOWA GmbH the sum of £1200 (one thousand two hundred pounds) which, in the absence of an appeal, should be paid within 21 days of the expiry of the appeal period.

**Dated this 28<sup>th</sup> day of October 2019**

**Matthew Williams**

**For the Registrar**

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