

**O/639/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003410207**

**BY G. & G. S.R.L.**

**TO REGISTER:**

**HARRINGTON G9**

**AS A TRADE MARK IN CLASSES 18 AND 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 418827 BY**

**FRED PERRY LIMITED**

## BACKGROUND AND PLEADINGS

1. On 28 June 2019, G. & G. S.r.l (“the applicant”) applied to register the trade mark shown on the cover of this decision in the UK for the following goods:

Class 18: Bags; Shoulder bags; Handbags; Evening handbags; Small clutch purses; Beach bags; Backpacks; School knapsacks; Satchels; Book bags; Gym bags; Sport bags; Holdalls for sports clothing; Haversacks; Suitcases; Trunks and travelling bags; Travel baggage; Duffel bags; Wheeled suitcases; Travelling sets; Travel cases; Garment carriers; Purses and pocket wallets; Banknote holders; Pouches; Leather credit card wallets; Business card cases; Key cases; Card wallets; Credit-card holders; Carrying cases for documents; Work bags; Briefbags; Attaché cases; Vanity cases, not fitted; Cosmetic purses; Small bags for men; Belt bags and hip bags; Storage cases; Umbrellas; Walking sticks; Saddlery, whips and apparel for animals; Clothing for pets; Collars for animals; Bags for carrying animals; Animal skins, hides; Furs.

Class 25: Clothing; Outerwear; Jackets; Bomber Jackets; Coats; Overcoats; Raincoats; Hosiery; Underwear; Beachwear; Nightwear; Footwear; Headgear; Belts; Shawls and stoles; Neckties; Foulards [clothing articles]; Kerchiefs [clothing]; Gloves; Neckwear; Sportswear; Sports footwear; Sports headgear.

2. The application was published for opposition purposes on 20 September 2019 and, on 19 December 2019, was opposed by Fred Perry Limited (“the opponent”). The oppositions are based on sections 3(1)(b) and 3(1)(d) of the Trade Marks Act 1994 (“the Act”). The opposition is aimed at the following goods only:

Class 25: Clothing; Outerwear; Jackets; Bomber Jackets; Coats; Overcoats; Raincoats; Sportswear.

3. In respect of its section 3(1)(b) opposition, the opponent states as follows:

“[T]he trade mark HARRINGTON G9 is non-distinctive for the following Class 25 goods for which the applicant seeks to register: Clothing; Outerwear; Jackets; Bomber Jackets; Coats; Overcoats; Raincoats; Sportswear. The Opponent submits that the terms 'HARRINGTON' and 'G9' are both known in the UK for being a style of men's jacket (namely a lightweight, waist-length jacket). The mark is therefore incapable of distinguishing the goods of the applicant's from those of other undertakings”

4. The opponent continues in respect of its opposition based upon section 3(1)(d):

“[T]he trade mark HARRINGTON G9 is a generic term for the following Class 25 goods for which the applicant seeks to register: Clothing; Outerwear; Jackets; Bomber Jackets; Coats; Overcoats; Raincoats; Sportswear. The Opponent submits that the terms 'HARRINGTON' and 'G9' have become synonymous with, and generic for, a style of men's jacket (namely a lightweight, waist-length jacket) in the UK. The mark is therefore incapable of distinguishing the goods of the applicant's from those of other undertakings.”

5. The applicant filed a counterstatement denying the claims made and claimed that “HARRINGTON G9” is wholly distinctive in respect of all of the goods covered by the application.

6. The opponent is represented by Osborne Clarke LLP and the applicant is represented by Bromhead Johnson LLP. Both parties filed evidence in chief with the opponent also filing evidence in reply. During the evidence rounds, the applicant also filed written submissions. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **PRELIMINARY ISSUES**

7. The applicant submits that:

“The Second Witness Statement of Katherine Walters is procedurally invalid. The aim of the Opponent in filing this additional evidence is apparently to shore up its argument that the G9 element of the Applicant’s mark is “known in the UK for being a style of men’s jacket” or has “become synonymous with, and generic for, a style of men’s jacket”. Not only does it obviously fail to achieve that objective (since there is no reference anywhere in the Witness Statement, or in any of the additional Exhibits, of use of G9 by anyone other than the Applicant) but it contravenes the requirement that this second round of evidence be limited strictly to evidence-in-reply to the Applicant’s evidence. The Opponent has made no effort to explain how and why this additional evidence is “in reply” and it self-evidently is not. The Applicant’s evidence raised no new issues that went substantively beyond the materials already on the public file for this Application and if the Opponent had wished to rely on this additional evidence, then it could and should have done so when filing its evidence in chief.”

8. While I note the applicant’s comments, I consider the opponent’s evidence in reply to be valid. Firstly, the applicant’s submissions, which it filed with its evidence, sets out that the opponent had filed “a large portion of evidence [...] devoted to examples of usage of ‘Harrington’.” Further, the applicant submitted that, the opponent’s “evidence relating to product code numbers is entirely unconvincing, insofar as it purports to say anything at all about the perception of the Applicant’s mark and formative element ‘G9’.” The opponent’s evidence in reply seeks to respond to this point and introduces further evidence regarding the ‘G9’ element. Further, I note that paragraph 4.8.7 of the Tribunal section of the Trade Mark Manual<sup>1</sup> states that:

“The aim of ‘evidence in reply’ is to achieve finality in the proceedings; evidence in reply must not involve a departure from a case put in chief, but may include comment on the other side’s evidence. It should not ‘seek to adduce additional evidence...’ (Ernest Scragg & Sons Ltd’s Application (1972) RPC 679).

---

<sup>1</sup> <https://www.gov.uk/guidance/trade-marks-manual/tribunal-section>

However, it should be noted that this is no longer a requirement of the Rules. The Tribunal has the power to direct what evidence should be filed and may specify that the evidence should be limited to evidence in reply. If the evidence is not in reply it may still be admissible as additional evidence.”

9. I do not consider that the opponent’s evidence in reply is a departure from the case put in chief and is, therefore, acceptable as evidence in reply.

10. In its submissions, the opponent states:

“2.7. The non-distinctive character of the word 'Harrington' is further supported by the 2016 decision of the EUIPO to **reject** the Applicant's application no. 15554116 to register the mark 'HARRINGTON' for Class 25 goods (namely, Clothing; Outwear; Sportswear) because the mark, for the same Contested Goods, is **"devoid of any distinctive character and is not capable of distinguishing the goods for which registration is sought within the meaning of Article 7(1)(b) EUTMR and Article 7(2)".**

2.8. The EUIPO stated that:

*"the mark [HARRINGTON] has a clear descriptive meaning in relation to the goods applied for, the impact of the mark on the relevant public will be primarily descriptive in nature, thus **eclipsing any impression that the mark could indicate a trade origin.**" (Annex 1).*

2.9. The EUIPO also noted that **"the word in question [HARRINGTON] is commonly used in the relevant market"** and identified a number of third party vendors, including in the UK, that use the word 'Harrington' in relation to the sale and advertisement of lightweight jackets as previously described (Annex 1)." (emphasis added by the opponent)

11. Firstly, I am not bound by the findings of the EUIPO. Secondly, the case referred to deals with the mark ‘HARRINGTON’ in solus and not ‘HARRINGTON G9’.

Therefore, the findings of the EUIPO were based on a different mark than the one at issue and are not applicable to the decision I must make.

12. The opponent also goes on to make submissions in respect of another EUIPO case that dealt with the mark 'G8' that was revoked due to being non-distinctive. Applying the same findings from paragraph 11 above, these submissions are not applicable to the decision I must make.

## **EVIDENCE**

13. The opponent filed evidence in the form of the witness statement of Ms Katherine Ngahina Goodall Walters dated 27 January 2021. Ms Walters is the Brand Protection Manager of the opponent, a position which she has held since September 2012. Ms Walters's statement was accompanied by 70 exhibits.

14. The applicant filed evidence in the form of the witness statement of Mr Ross Timothy Manaton dated 28 March 2021. Mr Manaton is a trade mark attorney and a partner at the applicant's representatives. Mr Manaton's statement was accompanied by three exhibits, one of which I note is the submission made on behalf of the applicant during the *ex parte* prosecution of the application at issue.

15. The opponent filed evidence in reply in the form of the second witness statement of Ms Walters dated 26 May 2021 which was accompanied by a further 39 exhibits.

16. I do not propose to summarise the parties' evidence and submissions here. However, I have taken them all into consideration in reaching my decision and will refer to them below, where necessary.

## **DECISION**

17. Section 3(1) of the Act provides as follows:

“3(1) The following shall not be registered –

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) [...]

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

18. The relevant date for determining whether the applicant’s mark is objectionable under sections (3)(1)(b) and 3(1)(d) is the date of the application at issue, being 28 June 2019.

### **Section 3(1)(d)**

19. I will first consider the opposition under section 3(1)(d) of the Act. It is the opponent’s claim that ‘HARRINGTON G9’ is a generic term that has become synonymous with, and generic for, a style of men’s jacket in the UK.

20. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by

analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (BSS, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (BSS, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and BSS, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and BSS, paragraph 40)."

21. In light of the case law above, the relevant question is whether, on the relevant date (28 June 2019), the mark 'HARRINGTON G9' had 'become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of the mark is sought'. That question must be based on the perception of the average consumer of the goods in the UK, who are considered to be reasonably well-informed and



reasonably observant and circumspect.<sup>2</sup> The goods in question are “clothing”, “outerwear”, “jackets”, “bomber jackets”, “coats”, “overcoats”, “raincoats” and “sportswear”. The average consumer for such goods in question will be a member of the general public in the UK who will consider such factors as style, fit and material. In my view, the degree of attention paid during the selection process for these goods is likely to be medium.

22. The parties have provided evidence regarding the word ‘HARRINGTON’ and the ‘G9’ element separately. I note that the evidence is extensive. While it is not my intention to address every individual piece of evidence, I will summarise it below insofar as I consider it necessary to do so.

23. Of the opponent’s evidence regarding the use of the word ‘HARRINGTON’, I note the following:

- a. The opponent has been using the word ‘HARRINGTON’ on jackets since 1990.<sup>3</sup> Evidence of the opponent’s use of ‘HARRINGTON’ for jackets is shown via copies of the opponent’s seasonal brochures showing ‘HARRINGTON’ style jackets being offered for sale in 21 of the 26 years between 1994 and 2019 in the UK and in other countries<sup>4</sup> and via print outs from the opponent’s website dated 2 February 2018;<sup>5</sup>
- b. Between June 2014 and 28 June 2019, the opponent sold 25,242 products in the UK with the word ‘HARRINGTON’ used in the product description. This amounted to total sales of £2,482,895.76;
- c. The history of the ‘HARRINGTON’ jacket is evidenced by way of a Wikipedia print out<sup>6</sup> that discusses the jacket’s style’s origins in the 1930s, its use in popular culture (notably being worn by Elvis Presley in the 1958 movie ‘King Creole’) and the origins of the ‘HARRINGTON’ name as a result of the jacket’s use by a character named Rodney Harrington in the 1960’s US soap opera

---

<sup>2</sup> *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

<sup>3</sup> Exhibit KNW1 of the First Witness Statement of Ms Katherine Walters

<sup>4</sup> Exhibit KNW2 of the First Witness Statement of Ms Katherine Walters

<sup>5</sup> Exhibit KNW4 of the First Witness Statement of Ms Katherine Walters

<sup>6</sup> Exhibit KNW6 of the First Witness Statement of Ms Katherine Walters

'Peyton Place'. The print out goes on to list various companies that have made 'HARRINGTON' jackets, such as Yves Saint Laurent, Ralph Lauren, Fred Perry, Tesco, Lacoste and Lonsdale, amongst others;

- d. A dictionary definition from 'Lexico.com' is provided which sets out that in the 'UK dictionary', Harrington is defined as 'A man's short lightweight jacket with a collar and a zipped front'.<sup>7</sup> It also refers to the origin of the name, being the same explanation given at point c. above.
- e. A print out from the Gentlemen's Gazette website of a guide entitled 'The Harrington Jacket Guide' is provided that discusses the history of the Harrington jacket.<sup>8</sup> While this is noted, it is a .com website and refers to products in dollars. It is not clear how this relates to the UK consumer;
- f. Third party retailers' use of the jacket is discussed in that 'HARRINGTON' jackets are sold by popular UK retailers such as John Lewis, House of Fraser, Marks & Spencer and others.<sup>9</sup> This evidence of the third parties' websites also shows 'HARRINGTON' as a selectable filter style. While some of these print outs are from prior to the relevant date, some are dated after. Given the fact that the print outs are dated some 20 months after the relevant date together with the seasonal nature of the clothing market means that, in my view, this evidence is not reflective of the position of the market as at the relevant date. Therefore, I will only consider the evidence from prior to the relevant date, namely:
  - i. A John Lewis print out dated 3 January 2017 showing two products referred to as 'HARRINGTON' jackets, one being John Lewis's own brand and the other being a brand called 'Carhartt WIP'. This print out shows 'HARRINGTON' as a selectable filter in the style column; and
  - ii. A Selfridges print out dated 6 November 2016 that does not show any products but does refer to 60 of 72 results for 'Harrington Jackets'. This

---

<sup>7</sup> Exhibit KNW7 of the First Witness Statement of Ms Katherine Walters

<sup>8</sup> Exhibit KNW8 of the First Witness Statement of Ms Katherine Walters

<sup>9</sup> Exhibits KNW9 to KNW17 of the First Witness Statement of Ms Katherine Walters

print out appears to be results of a filtered search for 'HARRINGTON JACKETS';

- g. Various print outs are also provided from popular brands that show them selling their own versions of the 'HARRINGTON' jacket. These retailers include Ben Sherman, Levi's, Lyle & Scott, Superdry and Tommy Hilfiger, amongst others.<sup>10</sup> All but two of these print outs are dated after the relevant date. For the same reasons as set out at point f. above, the evidence after the relevant date is of no assistance to the opponent. As for the print outs dated prior to the relevant date, I note the following:
- i. Two 'HARRINGTON' style jackets were listed for sale via Ben Sherman's website as at 4 November 2017.<sup>11</sup> While the prices are in euros, the website is a .co.uk website. I am content to conclude that it was aimed at the UK consumers; and
  - ii. A 'Harrington Red Raglan' jacket was listed for sale on JumpTheGun.co.uk, being a Brighton based retailer, on 16 June 2017.<sup>12</sup> While it is listed, the website shows it as being out of stock as at the print out date;
- h. A number of excerpts from books that were obtained via Google Books are provided that make mention of the 'HARRINGTON' jacket.<sup>13</sup> I note that all of these books were published prior to the relevant date. However, there is no evidence to suggest that these books have been sold or distributed in the UK; and
- i. Four articles from various online publications are provided regarding the 'HARRINGTON' style jacket.<sup>14</sup> While two of these are from American publications, the other two are from UK based publications. While one of the UK based articles are dated after the relevant date,<sup>15</sup> it does discuss the origins of the 'HARRINGTON' style jacket in the 1930s and its cult stature in the 1960s.

---

<sup>10</sup> Exhibit KNW18 to Exhibit KNW62 of the First Witness Statement of Ms Katherine Walters

<sup>11</sup> Exhibit KNW18 of the First Witness Statement of Ms Katherine Walters

<sup>12</sup> Exhibit KNW32 of the First Witness Statement of Ms Katherine Walters

<sup>13</sup> Exhibit KNW63 of the First Witness Statement of Ms Katherine Walters

<sup>14</sup> Exhibit KNW64 to Exhibit KNW68 of the First Witness Statement of Ms Katherine Walters

<sup>15</sup> Exhibit KNW65 of the First Witness Statement of Ms Katherine Walters

The second article is from popular UK retailer, ASOS, which is dated 11 May 2018<sup>16</sup> and, like the previously mentioned article, refers to the origins on the HARRINGTON style jacket and its cult stature in the 1950s and 1960s. It also refers to the jacket's position in present day counterculture. Further, it lists a number of 'HARRINGTON' jackets for sale.

24. The applicant's evidence consists of the submissions that were made to this Office during the examination stage of the application.<sup>17</sup> I note that the evidence refers to the 'G9' as the 'Original Harrington Jacket' in a 2016 catalogue. I also note that this evidence sets out that the 'G9' is the correct title of the 'HARRINGTON' jacket. The evidence goes on to demonstrate the applicant's "G9 Harrington Jacket" on various websites and in various articles. An additional article dated 7 March 2020 of the Telegraph is provided that shows the 'G9 HARRINGTON' jacket.<sup>18</sup> Finally, a photograph that was posted on social media on 3 May 2017 showing a large 'G9' sign in the window display of the applicant's store in London.<sup>19</sup>

25. Moving on to the evidence regarding the 'G9' element, I note that the opponent states that its own clothing "is identified by a product 'code' consisting of usually one but occasionally two letters, followed by one or more numbers".<sup>20</sup> The opponent gives examples of this by way of its brochure from the 1950s that shows use of a letter plus number code to identify various types of clothing items.<sup>21</sup> I note that this evidence shows products such as M1, M1A and M3, amongst others. Additional evidence showing the claimed use of letters and numbers as product codes is provided by way of print outs of the opponent's website dated 1 April 2019 that were taken from the internet archive facility, 'The WayBack Machine'.<sup>22</sup> I note that this evidence shows products called "M3600 – The Twin Tipped Fred Perry Shirt" and "M3 – The Original One Colour Fred Perry Shirt". The opponent's evidence also refers to a number of third-party products and their product numbers.<sup>23</sup> While these print outs are all dated after the relevant date, I note that

---

<sup>16</sup> Exhibit KNW67 of the First Witness Statement of Ms Katherine Walters

<sup>17</sup> Exhibit RTM1 of the Witness Statement of Mr Ross Manaton

<sup>18</sup> Exhibit RTM2 of the Witness Statement of Mr Ross Manaton

<sup>19</sup> Exhibit RTM3 of the Witness Statement of Mr Ross Manaton

<sup>20</sup> Paragraph 20 of the First Witness Statement of Ms Katherine Walters

<sup>21</sup> Exhibit KNW69 of the First Witness Statement of Ms Katherine Walters

<sup>22</sup> Exhibit KNW70 of the First Witness Statement of Ms Katherine Walters

<sup>23</sup> Paragraph 21 of the First Witness Statement of Ms Katherine Walters

they all show a wide range of product codes used by various brands. For example, this evidence shows a Fila 'Zaful Harrington Jacket' which has the style ID of LM037945-001<sup>24</sup> and a Paul Smith 'Men's Navy Recycled-Polyester Waterproof Harrington Jacket' as having a product code of 'M2R-244U-E20761-49'.<sup>25</sup>

26. The opponent provided further evidence in reply that sought to prove that "consumers would understand the term "G9" as a code to simply differentiate one particular design of a brand's from another particular design of that brand's, and would not perceive it as an indication of origin."<sup>26</sup> The opponent shows its own use of 'G' plus a number as a product code and sets out that it has sold more than 50,000 units of goods bearing the identifiers G2, G3, G4 and G12 since 2015. The opponent states that these identifiers are used to differentiate between clothing designs. Extracts from various sales brochures of the opponent's 'Women's Laurel Wreath' and 'Women's Reissue' ranges are provided as evidence of this.<sup>27</sup> The earliest brochure is labelled 'Autumn 2015' and they continue until a brochure that is dated October 2019, being after the relevant date. The opponent has also provided a number of print outs taken from 'The WayBack Machine' showing the opponent's website at 12 February 2016, 27 March 2016 and 2 February 2018.<sup>28</sup> I note that these websites show three different 'G12' polo shirts. The opponent confirms that these products are shipped to the UK and other countries.

27. A further explanation of the opponent's use of 'G' as a product code is provided in that 'G' refers to 'Girls' and the following numbers refer to the chronological order of the product. Since the opponent has produced so many womenswear designs over the years, the number following the 'G' has risen as high as G1142 and G1143, both of which being recently designed products shown on the opponent's website.<sup>29</sup> The opponent goes on to state that 'G9 HARRINGTON' will be understood as the ninth design iteration of a HARRINGTON style jacket.

---

<sup>24</sup> Exhibit KNW23 of the First Witness Statement of Ms Katherine Walters

<sup>25</sup> Exhibit KNW34 of the First Witness Statement of Ms Katherine Walters

<sup>26</sup> Paragraph 19 of the Second Witness Statement of Ms Katherine Walters

<sup>27</sup> Exhibit KNW71 of the Second Witness Statement of Ms Katherine Walters

<sup>28</sup> Exhibit KNW72 of the Second Witness Statement of Ms Katherine Walters

<sup>29</sup> Exhibit KNW73 of the Second Witness Statement of Ms Katherine Walters

28. The opponent introduces evidence by way of print outs from the applicant's website that it claims to be 'extensive use' of product identifiers in the format of the letter 'G' plus a number. This evidence shows use of the G4, G9 and G10 jackets that the opponent refers to as 'product codes'.<sup>30</sup> Also a social media post dated 18 December 2017 regarding two styles of jackets, being the Baracuta G9 and G4 which the applicant asks the consumer to compare.<sup>31</sup>

29. A significant amount of print outs showing third party brands using the letter 'G' in its product identification numbers.<sup>32</sup> I note that some of these include G9. I also note that a majority of these print outs are dated May 2021 (being almost two years after the relevant date). Only five of the print outs show products as being available prior to the relevant date, namely:

- a. a blog post from a website called Offspring.co.uk discuss the release of a new product called the 'Saucony G9 Shadow 5 Scoops' shoes;<sup>33</sup>
- b. two print outs from Amazon showing products referred to as 'Erima G10 5-Cubes Short' and 'Lico Unisex G1 Style Gymnastics Shoes' as being available from 2015 and 2017, respectively;<sup>34</sup>
- c. a Trek Inn print out which shows a German language review from 2017 of a product called 'Boreal G1 Lite' shoes;<sup>35</sup> and
- d. a nationalclubgolfer.com article discussing a new product called the 'Ecco Biom G3 Golf Shoe'.<sup>36</sup>

30. In respect of the 'G9' element, the applicant submits that:

"The Opponent's evidence relating to product code numbers is entirely unconvincing, insofar as it purports to say anything at all about the perception of the Applicant's mark and formative element G9. None of the examples provided by the Opponent is even remotely similar to the Applicant's G9 mark."

---

<sup>30</sup> Exhibit KNW74 of the Second Witness Statement of Ms Katherine Walters

<sup>31</sup> Exhibit KNW75 of the Second Witness Statement of Ms Katherine Walters

<sup>32</sup> Exhibit KNW76 to KNW109 of the Second Witness Statement of Ms Katherine Walters

<sup>33</sup> Exhibit KNW77 of the Second Witness Statement of Ms Katherine Walters

<sup>34</sup> Exhibit KNW79 and Exhibit KNW107 of the Second Witness Statement of Ms Katherine Walters

<sup>35</sup> Exhibit KNW90 of the Second Witness Statement of Ms Katherine Walters

<sup>36</sup> Exhibit KNW99 of the Second Witness Statement of Ms Katherine Walters

31. Based on the evidence provided (and for reasons I will come to discuss under the section 3(1)(b) grounds), I am satisfied that the 'HARRINGTON' element of the applicant's mark had become synonymous with or generic for a style of men's jacket at the relevant date. While this may be the case, the requirement for a successful opposition under section 3(1)(d) of the Act is that the applicant's mark consists *exclusively* of signs or indications that had become customary in the language or in the bona fide and established practices of the trade as at the relevant date. Therefore, in order for the section 3(1)(d) ground to succeed, I must be satisfied that the opponent has shown that the 'G9' element has also become synonymous with and generic for a style of men's jacket. Based on the evidence provided, I am not convinced that the opponent has satisfied this requirement. My reasons follow.

32. I note that the opponent's submissions set out that "'G9' has become synonymous with, and generic for, a way to differentiate one particular design of a brand from another design by that same brand." However, this is not how the claim was pleaded. Instead, the opponent pleaded that the 'G9' element had become synonymous with, and generic for, a style of men's jacket at the relevant date. The evidence does not show that this was the case. I make this finding on the basis that while the opponent's evidence shows various use of different letter/number combinations on a wide range of clothing products, it does not show any use of the combination 'G9' on men's jackets. Therefore, I am unable to find that 'G9' has become synonymous or generic for a style of jacket.

33. The opposition based on section 3(1)(d) of the Act fails.

### **Section 3(1)(b)**

34. I will now move to consider the opposition under section 3(1)(b) of the Act. Section 3(1)(b) prevents registration of marks which are devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the

CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the



same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37).”

35. The applicant’s mark is the word only mark of ‘HARRINGTON G9’. The opponent has pleaded that the applicant’s mark is non-distinctive and that ‘HARRINGTON’ and ‘G9’ are both known in the UK for being a style of men’s jacket and is, therefore, incapable of distinguishing the goods of the applicant from those of other undertakings.

36. The applicant submits, with reference to the cases of *Sabel BV v Puma AG*<sup>37</sup> and *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>38</sup>, that:

“It is therefore not legitimate to dissect the Applicant’s mark, as the Opponent attempts to do. The Applicant’s mark must therefore be regarded as a *whole*, for the purpose of judging compliance with the requirements of Sections 3(1)(b) and 3(1)(d) of the Act.”

37. The applicant then proceeds to submit that:

“It is irrelevant to these proceedings what HARRINGTON may or may not mean in relation to jackets or any other of the Opposed Goods – and the Tribunal need not trouble itself with making any decision on that question. The *only* point at issue is whether the Applicant’s mark HARRINGTON G9, as a whole, is “known in the UK for being a style of men’s jacket” or has “become synonymous with, and generic for, a style of men’s jacket”. Those are the only grounds pleaded against the Application and, for all of the Opponent’s efforts to throw up a smokescreen in relation to the isolated element HARRINGTON,

---

<sup>37</sup> Case C-251/95

<sup>38</sup> Case C-342/97

there is a glaring absence of any reference in the evidence to use of HARRINGTON G9 by anyone other than the Applicant.”

38. I appreciate that the cases cited above refer to the fact that average consumers normally perceive marks as wholes and do not proceed to analyse their various details. However, both cases make reference to the overall impression of marks whilst bearing in mind their distinctive and dominant components.<sup>39</sup> While it is wrong to artificially dissect the applicant’s mark, it is necessary to take into account the distinctive and dominant component of the marks and give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. As a result, contrary to the applicant’s submissions, I consider it necessary to assess the impressions of both the ‘HARRINGTON’ and ‘G9’ elements in solus before moving to assess their roles within the mark as a whole.

39. In my view, the opponent has provided sufficient evidence to show that at the relevant date ‘HARRINGTON’, when used on clothing, would have been known to the relevant public in the UK as a style of men’s jacket. I make this finding on the following basis:

- a. The opponent itself has sold ‘HARRINGTON’ style jackets since 1990 and between June 2014 and June 2019, sold 25,242 products bearing ‘HARRINGTON’ in the product description for a total of £2,482,895.76;
- b. The extensive history of the jacket and its current popularity in culture as set out by and the repeated references to ‘HARRINGTON’ throughout the evidence, including the Wikipedia article, the dictionary definition and the ASOS article;
- c. Major retailers, namely John Lewis and Selfridges, stocking ‘HARRINGTON’ jackets and having the style as a selectable filter;
- d. While the evidence of use of the term ‘HARRINGTON’ in literature shows no sales or coverage in the UK, it points to a wide-spread and popular understanding of the word ‘HARRINGTON’; and

---

<sup>39</sup> See paragraph 23 of *Sabel* and paragraph 25 of *Lloyd*

- e. The availability of 'HARRINGTON' jackets via popular third-party brands, being Ben Sherman and ASOS as well as via a Brighton based retailer, being JumpTheGun.co.uk.

40. In addition to the above, I have set out above that when selecting the opposed goods, the average consumer will consider the style of the clothing at issue and, therefore, will understand 'HARRINGTON' to be a reference to a style and not an indication of origin.

41. Turning to the 'G9' element, I make a similar finding here as I have under to the section 3(1)(d) ground above in that the evidence does not show that 'G9' would have been known to the relevant public of the UK, at the relevant date, to be a style of men's jacket. However, I do consider that it is possible for an average consumer to consider it a reference to a different iteration or variant style of a product, be that clothing or otherwise.

42. Assessing the mark as a whole, I consider that it will be dominated by the word 'HARRINGTON' with the 'G9' element being overlooked entirely by a significant proportion of the relevant public. I make this finding on the basis that (1) 'HARRINGTON' sits at the beginning of the mark, being where average consumers tend to focus<sup>40</sup> and (2) 'HARRINGTON' is significantly longer than the 'G9' element and will, in my view, overshadow it entirely. Alternatively, if I am wrong in this finding, I am of the view that 'HARRINGTON' will still dominate the mark for the same reasons set out above. Further, while I have found that 'G9' is not known as a style of men's jacket, it is entirely plausible that if it is noticed and viewed in conjunction with the 'HARRINGTON' element on the opposed goods, it will be seen by a significant proportion of the relevant public as a reference to a different iteration or variant style of 'HARRINGTON' jacket.

43. Taking the mark as a whole, and in relation to the goods at issue, I am of the view that the relevant public in the UK will see it as a reference to a style of men's jacket. It is not, in my view, capable of serving to distinguish the goods as originating from a particular undertaking over that of other undertakings or as an indication of origin

---

<sup>40</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

for the goods in question. As a result, I consider that the applicant's mark lacks any distinctive character. The applicant's mark is, therefore, objectionable under section 3(1)(b) of the Act for all of the goods against which the opposition is aimed.

44. The opposition based on section 3(1)(b) succeeds in its entirety.

## **CONCLUSION**

45. The opposition succeeds in its entirety. The application is, therefore, refused in respect of the following goods:

Class 25: Clothing; Outerwear; Jackets; Bomber Jackets; Coats; Overcoats; Raincoats; Sportswear.

46. The application can proceed for the following goods against which the opposition was not aimed:

Class 18: Bags; Shoulder bags; Handbags; Evening handbags; Small clutch purses; Beach bags; Backpacks; School knapsacks; Satchels; Book bags; Gym bags; Sport bags; Holdalls for sports clothing; Haversacks; Suitcases; Trunks and travelling bags; Travel baggage; Duffel bags; Wheeled suitcases; Travelling sets; Travel cases; Garment carriers; Purses and pocket wallets; Banknote holders; Pouches; Leather credit card wallets; Business card cases; Key cases; Card wallets; Credit-card holders; Carrying cases for documents; Work bags; Briefbags; Attaché cases; Vanity cases, not fitted; Cosmetic purses; Small bags for men; Belt bags and hip bags; Storage cases; Umbrellas; Walking sticks; Saddlery, whips and apparel for animals; Clothing for pets; Collars for animals; Bags for carrying animals; Animal skins, hides; Furs.

Class 25: Hosiery; Underwear; Beachwear; Nightwear; Footwear; Headgear; Belts; Shawls and stoles; Neckties; Foulards [clothing

articles]; Kerchiefs [clothing]; Gloves; Neckwear; Sports footwear;  
Sports headgear.

## **COSTS**

47. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,400** as a contribution towards its costs. The sum is calculated as follows:

Filing a notice of opposition and considering the counterstatement:	£200
Preparing evidence:	£700
Preparing submissions in lieu of a hearing:	£300
Official fees:	£200
<b>Total</b>	<b>£1,400</b>

48. I therefore order G. & G. S.r.l to pay Fred Perry Limited the sum of £1,400. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 27th day of August 2021**

**A COOPER**  
**For the Registrar**