

O/645/21

TRADE MARKS ACT 1994

**IN THE MATTER OF:
TRADE MARK APPLICATION NO. 3508962
BY MISS SPARROW LTD. TO REGISTER**

mr heron

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 421908
BY HERNO S.P.A.**

BACKGROUND AND PLEADINGS

- Miss Sparrow Ltd ('the applicant') applied to register trade mark No. 3508962 "*mr heron*" in the United Kingdom (the 'contested mark') on 7 July 2020. It was accepted and published in the Trade Marks Journal on 31 July 2020 in respect of the following goods:


Class 25: *Clothing, footwear, headgear.*

- On 30 October 2020, HERNO S.p.A. ('the opponent') opposed the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). This is on the basis of its trade marks listed in the table below and the opposition is directed against all goods in the application. The trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act because they were applied for at an earlier date than the contested mark. The details of the earlier marks and the goods relied upon are as follows:


First Earlier Trade Mark	European Union Trade Mark ('EUTM') no. 13132477 ¹ for 
Goods relied upon	Class 25: <i>Clothing for gentlemen, ladies and children in general, including clothing in leather; Shirts; Chemisettes; Skirts; Skirt suits; Jackets [clothing]; Pants (Am); Trousers shorts; Jumpers; Undershirts; Pajamas (am); Stockings; Vest tops; Corsets; Suspenders; Pants (Am); Brassieres; Underwear; Headgear; Headscarves; Ties; Mackintoshes; Topcoats; Jackets; Swimming costumes; sportsuits; Wind resistant jackets; Ski trousers; Waist belts; Pelisses; Sashes for wear; Gloves; Dressing gowns; Footwear in general, including slippers, shoes, sports</i>

¹ Although the UK has left the European Union ('EU') and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice ('TPN') 2/200 for further information.

	<i>shoes, boots and sandals.</i>
Relevant dates	Filing date: 31 July 2014 Date of entry in register: 22 December 2014

Second Earlier Trade Mark	 <p>EUTM no. 181700888 for</p>
Goods relied upon	<p>Class 18: <i>Animal skins, hides; Leather, unworked or semi-worked; Imitation leather; Purses; Clutches [purses]; Handbags; Casual bags; Shopping bags made of skin; Textile shopping bags; Canvas shopping bags; Handbag frames; Beach bags; Sport bags; Satchels; Backpacks; Rucksacks on castors; Wallets; Credit card cases [wallets]; Business card cases; Key cases made of leather; Luggage tags; Vanity cases, not fitted; Leather shoulder belts; Music cases; Attach~ cases; Boxes of leather or leatherboard; Briefbags; Hat boxes of leather; Carry-on bags; Suitcases; Trolley duffels; Travelling bags; Duffel bags; Traveling trunks; Garment bags for travel; Business cases; Small bags for men; Trimmings of leather for furniture; Umbrellas; Umbrella covers; Parasols; Walking sticks; Whips; Leather leashes; Stirrups; Harness fittings; Saddlery; Clothing for pets; Bags [envelopes, pouches] of leather, for packaging.</i></p> <p>Class 25: <i>Jackets [clothing]; Rainproof jackets; Down jackets; Coats; Topcoats; Rainwear; Parkas; Suits; Sweaters; Waistcoats; Shirts; Tee-shirts; Polo shirts; Shirt fronts; Dinner jackets; Sports singlets; Cuffs; Trousers; Trousers shorts; Briefs; Underwear; Brassieres; Leg warmers; Pyjamas; Pockets for clothing; Linings (Ready-made -) [parts of clothing]; Layettees [clothing]; Babies' pants [clothing]; Bathrobes; Swimming costumes; Combinations [clothing]; Belts [clothing]; Suspenders; Robes; Masquerade costumes; Ski jackets; Ski trousers; Ski gloves; Maillots; Wedding</i></p>

	<i>dresses; Gowns; Evening wear; Skirts; Theatrical costumes; Footwear; Footwear for men; Fittings of metal for footwear; Shoe uppers; Snow boots; Gaiters; Footwear soles; Heels; Training shoes; Tips for footwear; Dance shoes; Gymnastic shoes; Bath sandals; Bath slippers; Boots; Booties; Football boots; Lace boots; Ski boots; Mules; Beach shoes; Running shoes; Socks; Stockings; Berets; Bonnets; Cap peaks; Hats; Frames (Hat-) [skeletons]; Ear muffs [clothing]; Neckties; Sashes for wear; Shawls; Ascots; Gloves [clothing]; Mittens; Fur stoles; Chasubles; Bathing caps; Shower caps; Sleep masks; Aprons [clothing].</i>
Relevant dates	Filing date: 20 December 2019 Date of entry in register: 22 May 2020

Third Earlier Trade Mark	 <p>EUTM no. 13313366 for</p>
Goods relied upon	Class 25: <i>Clothing for gentlemen, ladies and children in general, including clothing in leather; Shirts; Chemisettes; Skirts; Skirt suits; Jackets [clothing]; Pants (Am); Trousers shorts; Jumpers; Undershirts; Pajamas (am); Stockings; Vest tops; Corsets; Suspenders; Pants (Am); Brassieres; Underwear; Headgear; Headscarves; Ties; Mackintoshes; Topcoats; Jackets; Swimming costumes; Sports overalls; Wind resistant jackets; Ski trousers; Waist belts; Pelisses; Sashes for wear; Gloves; Dressing gowns; Footwear in general, including slippers, shoes, sports shoes, boots and sandals.</i>
Relevant dates	Filing date: 30 September 2014 Date of entry in register: 20 February 2015

3. Given the date on which the opponent's First Earlier Trade Mark and Third Earlier Trade Mark were registered, both are subject to proof of use pursuant to section 6A of the Act. The opponent made a statement of use corresponding to the goods

on which it relies as set out above. The relevant period is 8 July 2015 to 7 July 2020.

4. The opponent contends that their earlier marks and the contested mark are similar, since “*the respective distinctive elements HERNO and HERON are highly similar*” and the title “*MR*” in the contested mark is of low distinctive character. They submit that the respective parties’ goods are identical or similar and, thus, there exists a likelihood of confusion. The opponent requests that the contested mark is refused registration and that they are awarded costs.
5. The applicant filed a counterstatement denying the grounds of opposition. They submit that the first element of their word mark (“*mr*”) is most dominant, whilst “*heron*” is distinctive and a reference to the bird. In contrast, the opponent’s marks are figurative and consist of a different word(s). They agree the respective parties’ goods are similar, though of a low level. The applicant requested that the opponent prove use of their three earlier marks. They submit that the opposition should fail and they request that an award of costs is made in their favour.
6. The opponent informed me that there are ongoing parallel opposition proceedings at the EUIPO and that negotiations taking place relating to the settlement. I am not aware of any request for the proceedings to be stayed and, thus, I continue with the decision as below.
7. Only the opponent filed evidence in these proceedings. The evidence will be summarised to the extent that it is considered appropriate. Both parties filed written submissions. I will refer to the evidence and submissions as and where appropriate during this decision.
8. No hearing was requested. This decision is therefore taken following a careful perusal of the papers.
9. Both parties are professionally represented. Potter Clarkson LLP represents the opponent and JMW Solicitors LLP represents the applicant.

10. Although the United Kingdom ('UK') has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with European Union ('EU') law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

EVIDENCE

11. The opponent's evidence is in the form of a witness statement of Claudio Marenzi, which is accompanied by 14 exhibits. The witness statement is dated 30 April 2021. Mr Marenzi is the CEO of the opponent and has held that position since 2007, in addition to the position of President since 2011.

12. Whilst I only summarise part of the evidence below, I have nonetheless taken all of the evidence and submissions into consideration in reaching my decision.

13. Mr Marenzi states that the opponent is an Italian family-owned business founded in 1948 that first marketed raincoats under the "*HERNO brand*" before extending to various other clothing products in the 1960s. Exhibit CM01 is a series of webpage screenshots that also state this along with background information about the opponent, including that "*Herno in homage to the river, as the venture was inspired by water and the surrounding environment, still a steadfast point of reference in the Herno world today*". Although the screenshots do not display the webpage or date from which the screenshots were taken, Mr Marenzi states that the information was reproduced from https://corporate.herno.com/brand_en. The fifth screenshot notes "*Man AW 20/21*", "*Woman AW 20/21*" and "*SS20*" available under the heading "*SHOP ONLINE*", from which I consider may indicate that the screenshots were taken in 2020-2021, to coincide the fashion collections from this point in time (for instance AW 20/21 meaning Autumn/Winter 2020-2021).

14. Mr Marenzi states that "*as well as during the Relevant Period, the products offered by my company include a wide range of clothing articles, including coats, jackets, blazers, shirts, T-shirts and hoodies*". Exhibit CM02 contains a few undated images

of trainers and male and female clothing worn on the upper body. The goods bear

HERNO and/or HERNO *Lamina* on the clothing/footwear itself or on the tag of the clothing behind the neck or a removable tag attached to the clothing. I am not provided with information on where or when these products were available. I have produced an example of these images below.



15. Mr Marenzi also adduces Exhibit CM03. This exhibit includes excerpts from the opponent's Autumn/Winter 2019-2020 and Spring/Summer 2020 product collections/look books. They show the Opponent's First Earlier Trade Mark as



registered on the first page and throughout, in addition to *Lamina*,



. The products depicted include outdoor jackets for males, females and children, I provide an example below. I am not informed where these collections were available nor where/if the look books were disseminated.

HERNO



STYLE PI0958D | ART 12004

| 12 |

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HERNO

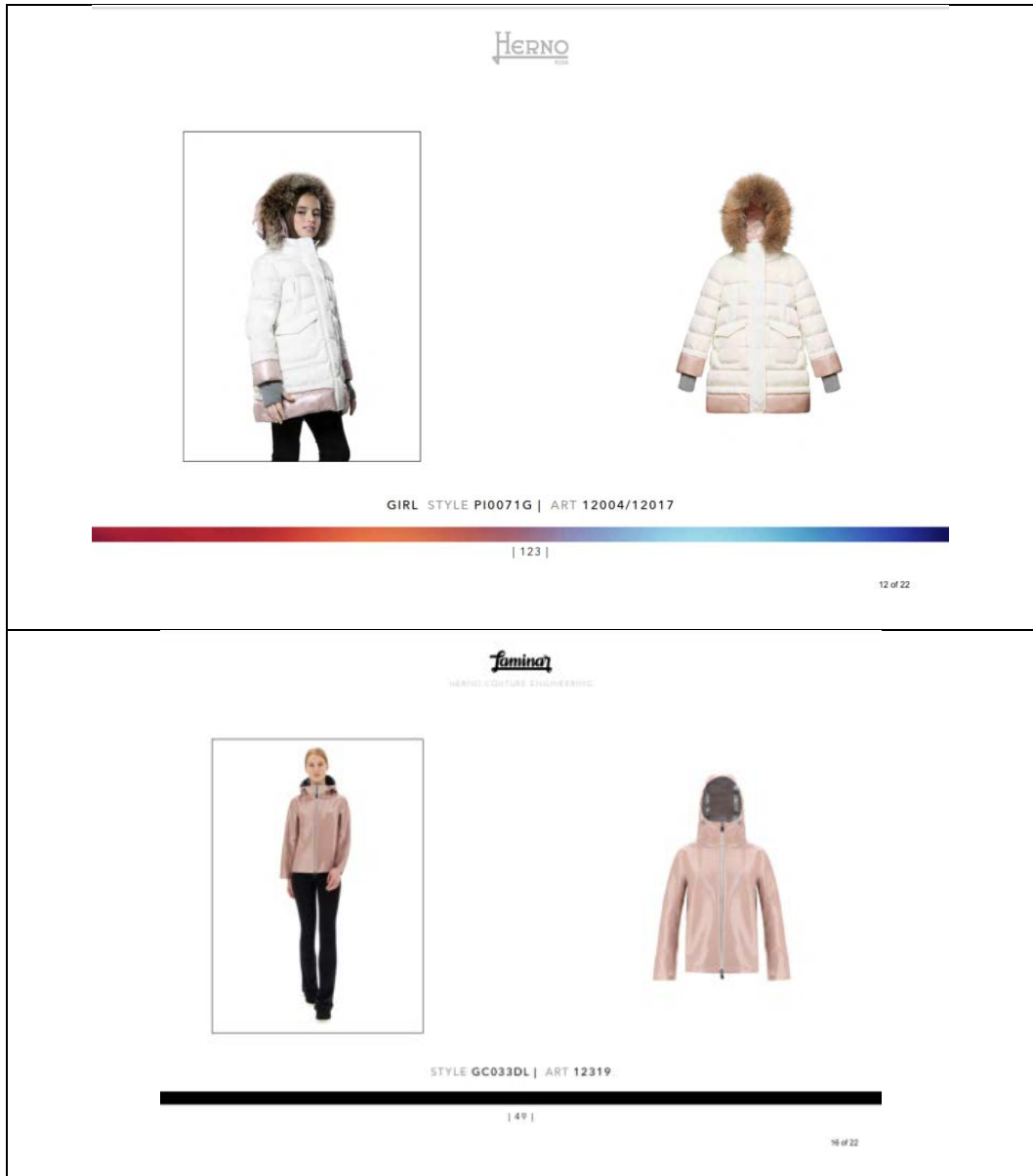
femina



STYLE PI101DL | ART 11121

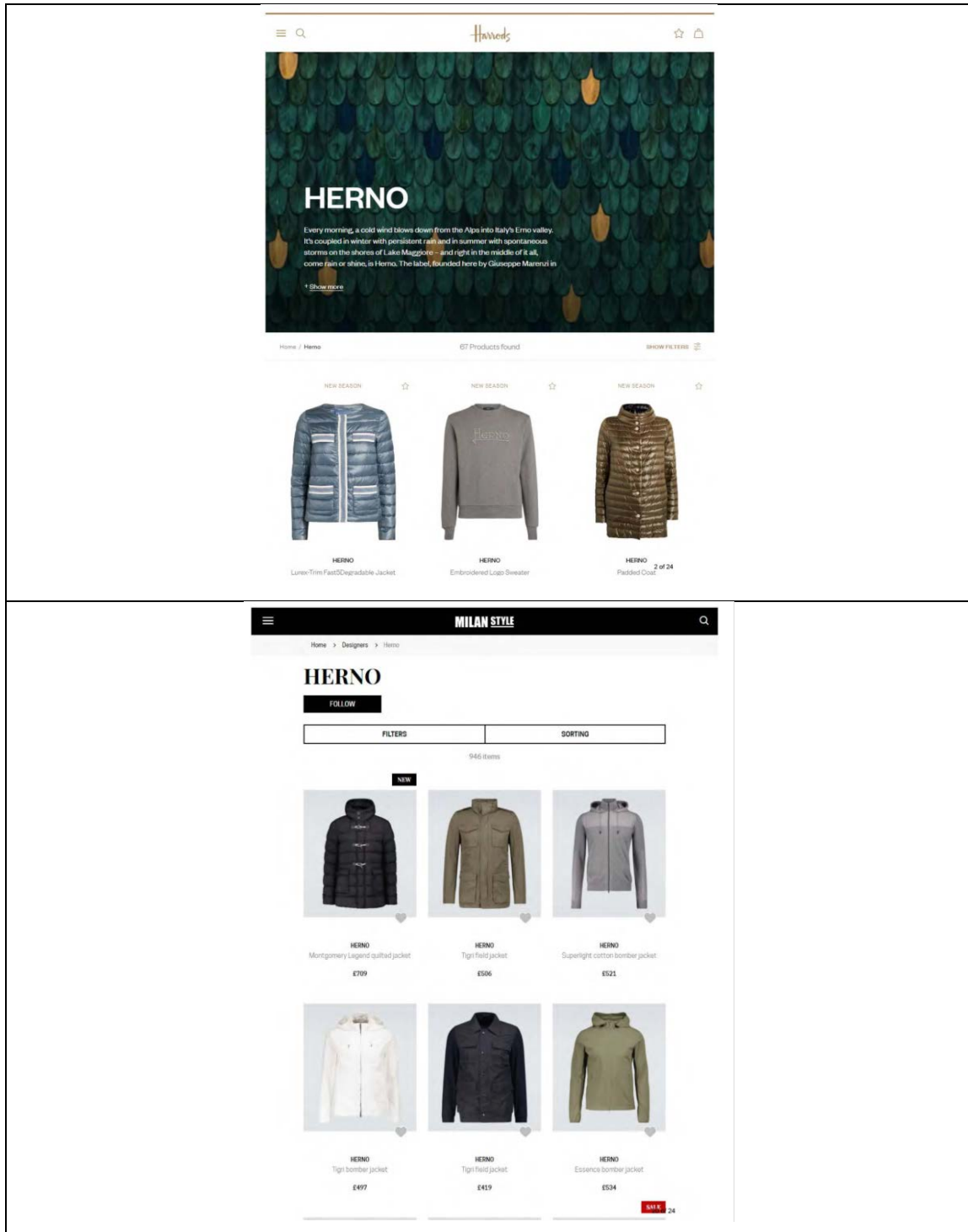
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5 of 22

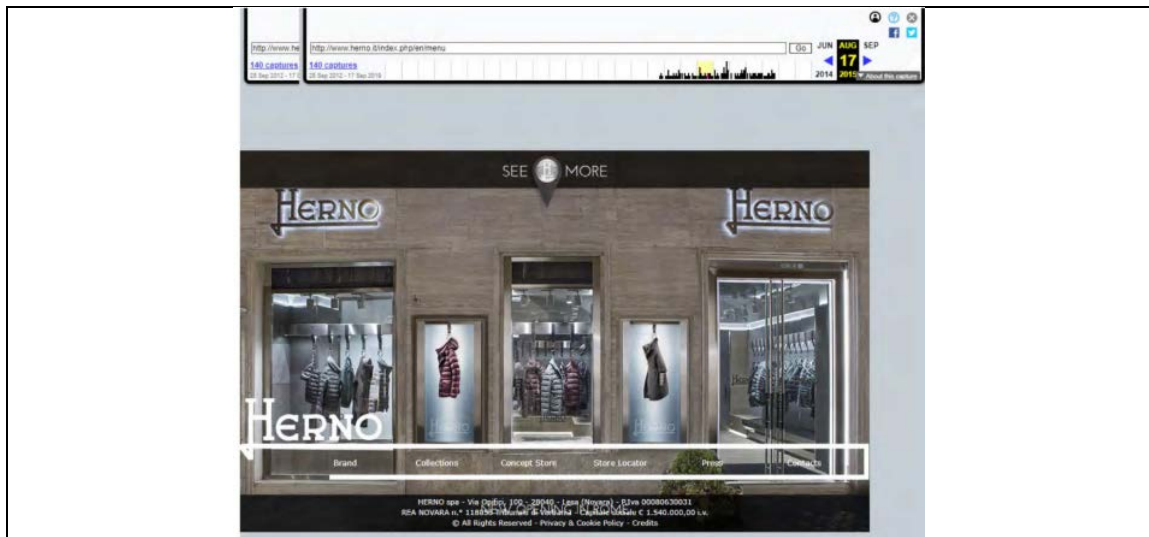


16. Mr Marenzi states that the opponent's products are sold directly by the opponent via their website (<https://www.herno.com/en/>) and through physical retail outlets, in addition to "various other retailers across the EU and the UK". Exhibit CM04 is a series of undated screenshots from the websites of various third parties that appear to offer HERNO branded clothing for sale. The third parties are Harrods, Italist, Atterley, Shopenauer and Milan Style, though the website addresses are not provided. Each website displays the word/mark 'HERNO' above or below the goods, and some of the goods also depict the opponent's First Earlier Trade Mark on the goods in some way (for instance, on the front of a sweater or on the inside tag). I provide a few examples below. The price of the goods available at Harrods, Atterley and Milan Style are in pounds whereas Italist goods are shown in euros,

with pound equivalent. Shopenauer lists everything in euros only. The products shown include coats, jackets, sweaters, parkers, gilet, t-shirt, tops and hoodies. The clothing on Harrods, Italist, Atterley and Shopenauer appears to be for women whereas the clothing on Milan Style appears designed for both men and women.



17. Mr Marenzi states the opponent has additionally offered goods for sale during the relevant period via www.herno.it. Exhibit CM05 contains extracts reproduced from the Wayback Machine dated 2015-2020 showing this website displaying the First Earlier Trade Mark at various instances, such as on a retail shop front and on a webpage featuring a 2016 and 2017 collection of coats and jackets for women, men and children. I provide an excerpt below.



18. Mr Marenzi states that the opponent has various stores in the UK and EU Member States, including the following:

Country	Number of stores
UK	3
France	3
Germany	3
Italy	6
Spain	1

Mr Marenzi supplemented this with Exhibits CM06 and CM07. Exhibit CM06 is a series of undated website screenshots from an undisclosed website, though seemingly belonging to the opponent. The screenshots show the opponent's First Earlier Trade Mark and a heading stating "STORES", with various EU and UK-wide stores plotted across several maps. I have not been provided with information about when the opponent opened any of their stores.

19. Exhibit CM07 is an undated series of photos/graphics with wording that Mr Marenzi describes as containing “a presentation of the stores, including details of when they were opened ... and examples of store displays referencing the Trade Marks”. I provide a few excerpts below. One of the pages provides history about the ‘HERNO’ mark, detailing how “The company’s name is inspired by the Erno river that ows [sic] through the town of Lesa” and that “The H was added to Erno to give the Brand an international touch”. Another page provided states when and where the opponent opened some of their stores – including that their first flagship store opened in Milan in September 2012 and that a “free standing store” was opened in Rome in September 2015 and in Cannes in 2016. It also states that the opponent’s Madrid, Harrods (London) and Munic stores were opened in 2017. The images of the stores are all undated. The evidence displays various instances of the opponent’s First Earlier Trade Mark and some occasional use of the opponent’s Third Earlier Trade Mark.



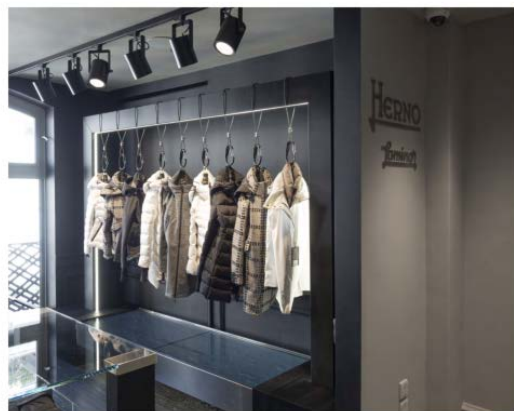
MILANO



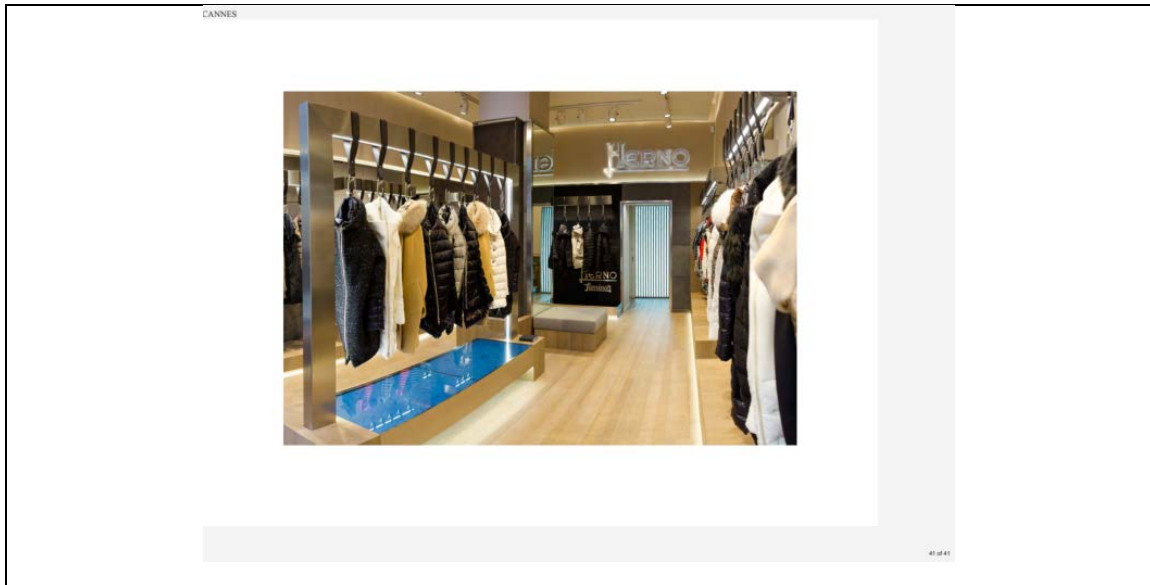
LONDON



LONDON



23/041



20. Mr Marenzi states the opponent's wholesale turnover figures in the period of 2017-2020 are as follows:

CURRENCY	REGION	YEAR 2017	YEAR 2018	YEAR 2019	YEAR 2020
€	EU total (m)	38,361.448	41,532.852	43,657.454	45,037.047
€	EU HERNO LAMINAR	4,493.276	4,625.507	6,966.404	7,987.138
€	EU HERNO	33,868.172	36,907.345	36,691.050	37,049.909
€	UK total (m)	1,584.447	2,263.826	2,800.227	1,838.339
€	UK HERNO LAMINAR	238,925	208,151	244,644	174,244
€	UK HERNO	1,345.522	2,055.675	2,555.583	1,664.095
€	Total (m)	39,945.895	43,796.678	46,457.681	46,875.386
€	Total HERNO LAMINAR (m)	4,732.201	4,833.658	7,211.048	8,161.382
€	Total HERNO (m)	35,213.694	38,963.020	39,246.633	38,714.004

Exhibit CM08 contains various samples of invoices dated 7 July 2015 (of which is outside the relevant period so I will not discuss further) to 29 June 2020 issued from the opponent at an address based in Italy. The invoices display the opponent's First Earlier Trade Mark at the top right hand corner and then list various goods within the item description. I very briefly summarise a few of the invoices as follows:

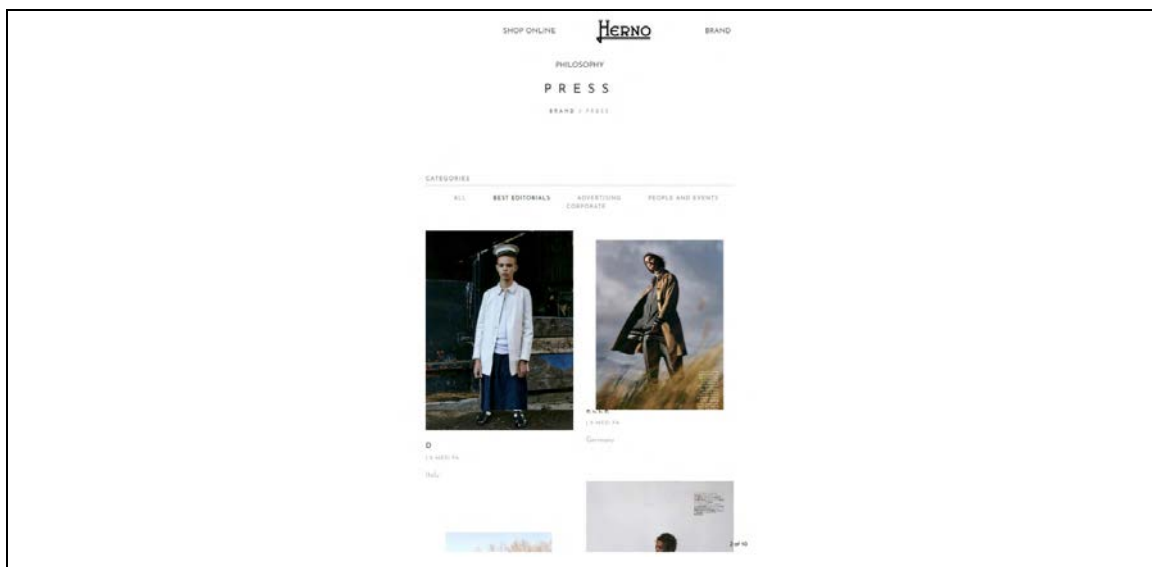
- The second invoice is dated 29 July 2016 and is issued to "MATCHESFASHION LIMITED THE SHARD" of the UK. It is for a sum of

“12.750,65 EUR” comprising of 55 “*Woman’s Woven Half Coat*” as the goods which were made in Romania.

- The third invoice is dated 13 December 2016 and is issued to “*HARVEY NICHOLS & COMPANY LIMITED*” of the UK. It is for a sum of “26.669,35 EUR” for 151 goods comprising the following “*Woman’s Woven Half Coat*”, “*Woman’s Woven Vest*”, “*Woman’s Woven Jacket*”, “*Woman’s Woven Coat*”, “*Woman’s Knitted Coat*”, “*Woman’s Woven Raincoat*”. 137 of the goods were made in Romania and 14 were made in Italy.
- The fourth invoice is dated 19 January 2016 and is addressed to “*HARVEY NICHOLS & COMPANY LIMITED*” of the UK. It is for a sum of “12,541.20 EUR” for 54 goods comprising “*Woman’s Woven Half Coat*” and “*Woman’s Woven Coat*” that were made in Italy.
- The fourth invoice is dated 25 January 2017 and is addressed to “*VAATTURILIIKE SAUMA OY*” of Finland. It is for a sum of “12.120,50 EUR” for 66 goods comprising “*Men’s Woven Jacket*” and “*Men’s Woven Raincoat*”. 51 of the goods were made in Romania, 6 in Italy and 9 in China.

HARVEY NICHOLS & COMPANY LIMITED, UK	5 July 2017	16.786,50 GBP
SILVA CORREIA & CA LDA, Portugal	5 July 2018	13.324,00 EUR
HARVEY NICHOLS & COMPANY LIMITED, UK	8 May 2018	45.134,50 GBP
URDAMPILLETA SL, Spain	10 December 2019	19.953,00 EUR
LINEA OF HAMPSTEAD, UK	31 January 2019	10.299,00 GBP
LODENFREY VERKAUFSHAUS GMBH & CO KG, Germany	2 July 2020	32.396,00 EUR
MATCHESFASHION LIMITED THE SHARD	29 June 2020	49.061,63 EUR


21. Mr Marenzi states that the opponent and its products are “*constantly featured in fashion editorials across the world*”. Exhibit CM09 is a series of undated website screenshots of links to editorials that Mr Marenzi states is from the webpage www.corporate.herno.com/brand_en/press/editorials. I provide an example below. The date and content of the editorials themselves are not provided.




22. Mr Marenzi also adduces Exhibit CM10, which comprises various undated screenshots from third party websites featuring articles (some of which are dated) that refer to the opponent. They refer to the opponent as 'Herno' and some of the articles also feature the opponent's First and Third Earlier Trade Marks (see below). I briefly summarise the screenshots as follows;


- a. An undated article from Coggles (described by Mr Marenzi as "*a UK fashion retailer founded in 1974 whose website contains a 'LIFE' section which covers news about, amongst other, the best in fashion*"), reproduced from www.coggles.com". The article is titled "*The Italian coat brand you need to know*" and states that "*decades of research and innovation have led Herno to become one of the best outerwear brands in the world*". The article refers to "*building up your Autumn/Winter '17 wardrobe*", thereby indicating it was written around this period of 2017.
- b. An article dated 16 June 2017 that Mr Marenzi submits is "*from the UK publication Fashion Network (www.uk.fashionnetwork.com)*". The article is titled "*Herno grows in double figures, opens stores In New York and St Petersburg*". Mr Marenzi is featured in the article and states "*We are regularly growing at double-digit rates, approximately 12-13% year-on-year, and we expect to exceed the €90 million revenue mark in 2017 [...] Our growth is well-balanced across all regions, in Europe, Asia and North America*". He also states "*the Herno Lamina Bike range has also been well received: it features apparel designed specifically for bike-riding in an urban context, for the time being men alone, though we aren't ruling out producing a women's version the future [sic]*".

9880 / NEWS / RETAIL

BY

 Elena Passeri


TRANSLATED BY
 Nicola Mira

PUBLISHED
 Jun 16, 2017

READING TIME
 2 minutes

Herno grows in double figures, opens stores in New York and St Petersburg

Italian luxury sportswear label Herno is busy on the international retail scene, with two openings scheduled by the end of the summer, in New York and St Petersburg. In addition, it will renovate the Aoyama store in Tokyo, extending it to 280 m2, twice its current size.



The 180-m2 New York store will be located in SoHo and will showcase all of the label's collections. The St Petersburg store, the first Herno monobrand shop in the city, will be smaller, about 80 m2.

"We are regularly growing at double-digit rates, approximately 12-13% year-on-year, and we expect to exceed the €90 million revenue mark in 2017," said Herno's boss Claudio Marenzi to FashionNetwork. "Our growth is well-balanced across all regions,

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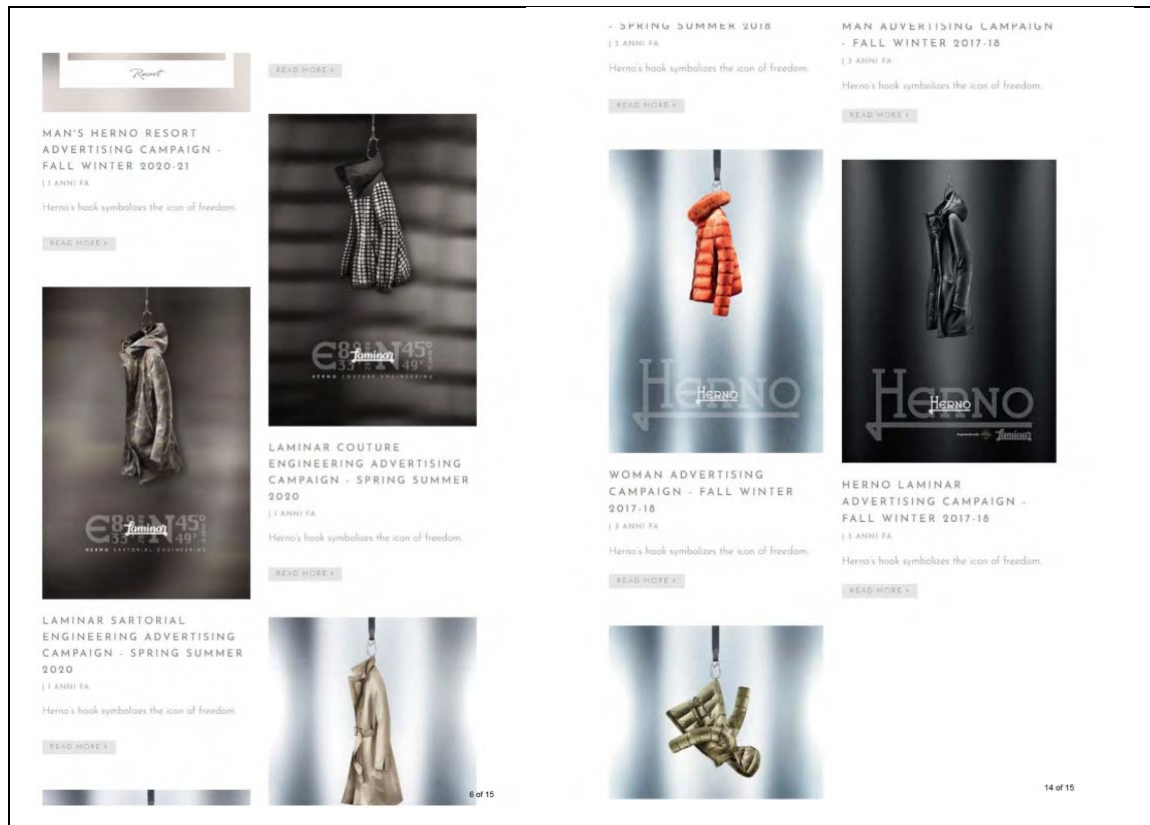
- c. An article from the Wall Street Journal Magazine that the opponent submits is available at www.wsj.com/news/magazine and is "a leading world-wide publication". The article is dated 5 November 2019 and entitled "Winter's New Eco-Status Symbol: A Recycled Coat". It states that "Herno, Italian makers of luxury outerwear, are making puffers with recycled nylon and reused down for sustainability". The article discusses how "Herno" jackets are made of sustainable materials and that it has evolved from a manufacturing model to their own brand, within which has "since evolved to include the waterproof, wind-stopping Laminar lines ...". The article states that Herno's annual revenue has risen from \$7.7 million in 2007 to \$124.7 million in 2018.
- d. An article dated 23 December 2018 from W Magazine, which Mr Marenzi notes is a "high-end fashion publication" available at www.wmagazine.com". The article is entitled "12 Chic Coats That Will Keep You Warm All Winter", listing a "Herno" puffer coat in 11th position. I note that the date is listed as

“12.23.18”, which is not a date format typical of the UK or the EU; when I coincide this with the currency of the coat listed in dollars, the webpage does not appear to be aimed at UK or EU consumers.

- e. An article dated 13 November 2019 that Mr Marenzi states is from the “*UK publication Fashion Network (www.uk.fashionnetwork.com)*”. The article is entitled “*Urban outerwear brand Herno opens store on London’s Old Bond Street*”. The article features photographs of the store that show the opponent’s First Earlier Trade Mark in various places on the shop front. It states that the store showcases “*the signature items from Herno’s men’s and women’s collections [and] the entire womenswear range and the Herno Kids line*”. It also states that the store displays the “*the Laminar activewear line [which was] introduced in 2012 in collaboration with Gore*”. It further states that “*in 2018, Herno generated a revenue of €111.3 million, up 15% over 2017, and is forecasting double-digit growth for this year too.*” And that there are “*11 monobrand stores worldwide, of which three In Italy (Milan, Rome and Forte dei Marmi), two In France (Paris and Cannes) and the others in London ... and Sylt, Germany.*”
- f. An article dated 23 February 2020 from what Mr Marenzi states is “*leading fashion journal WWD (www.wwd.com)*”. The article is written in English and entitled “*Herno RTW Fall 2020*”. The use of ‘fall’ infers that this webpage is likely not directed at UK consumers.
- g. An article dated 27 July 2020 (and thus outside the relevant period) from Forbes magazine . is entitled “*Herno: Functionality Beyond Aesthetic Sustainability, 70 Years Of Made-In-Italy Craftsmanship*”. This discusses the brand’s high standards, 70 year history and international growth. Mr Marenzi notes this is available at www.forbes.com. Mr Marenzi is also quoted as stating “*We ... don't have to rely on logos to promote the Brand. No other imagery is necessary. This allows the consumer to focus on the garment*”.

23. Mr Marenzi also adduces Exhibit CM11. This exhibit comprises various undated website screenshots that Mr Marenzi describes as showing “*advertising campaigns*” carried out by the opponent “*during the period 2017-2021 to promote*

the Trade Marks ... [and] can be accessed at https://corporate.herno.com/brand_en/press/publicita". I note that some of the articles appear to reference campaigns from 2017 to 2021, though I am not provided with the content of these campaigns. I provide an excerpt below.



24. Mr Marenzi describes Exhibit CM12 as "a list containing examples of various events attended by my Company during the Relevant Period reproduced from www.corporate.herno.com/brand_en/press/events". Exhibit CM12 is a series of undated website screenshots referring to a variety of undated information under the subheading "PEOPLE AND EVENTS" that appears to refer to various events (such as new store openings and attendance at fashion shows and award ceremonies). Only a snapshot of very limited information is provided, as shown below.

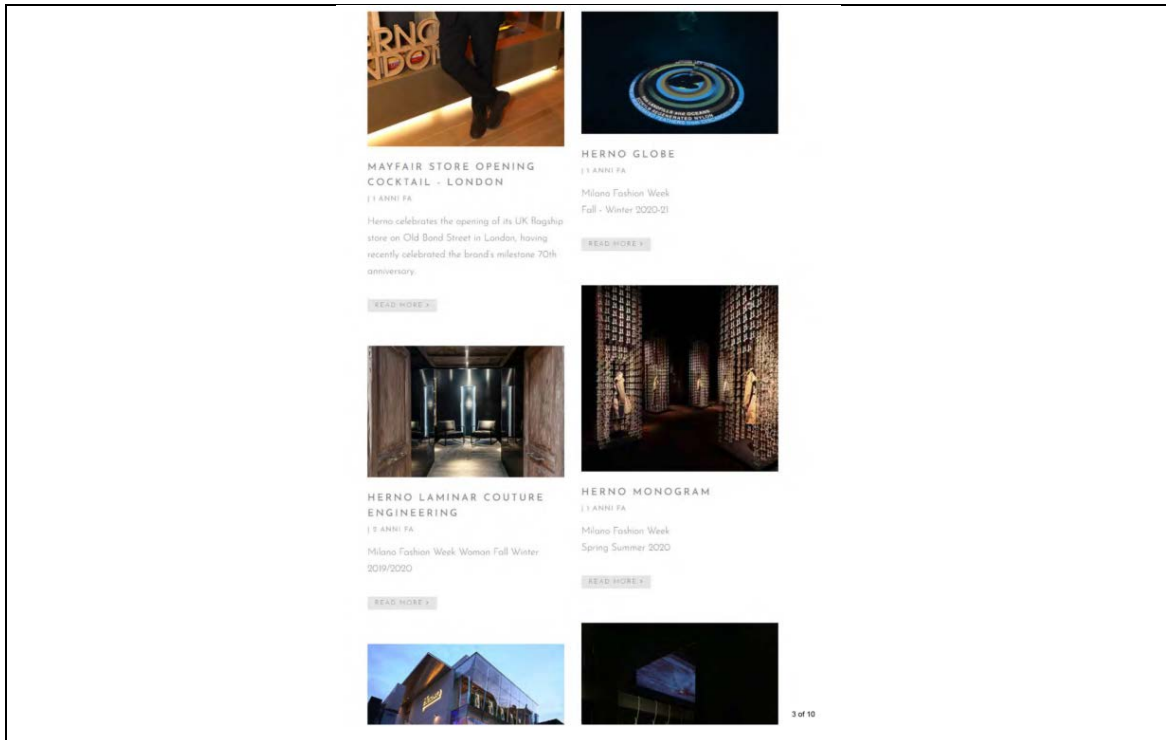


Exhibit CM12 also encloses an article from their website discussing Milan Fashion Week in 2017/2018 and 2018/2019. Regarding the 2017/2018 fashion week, the article states that “*Herno chooses the Mudec and a special video ... to tell about its history*”. The article also states that “*Herno believes in details and chooses to be “no logo”, it acquires its brand awareness through specific features us shapes, manufactory, fabrics and details that make each garment unique, recognisable and inimitable: details make the difference.*” The articles do not state any further information about their presence at the fashion week.

25. Exhibit CM13 contains various undated screenshots referring to examples of awards received by the opponent. This includes a screenshot posted by “*Herno*” dated 23 February 2018 in which the opponent received “*the Leonardo Qualità Italia award*”, which they self-describe as “*the most prestigious form of recognition in the entrepreneurial field, through which the Leonardo Committee honours the talent of businesses and businessmen, managers and men of culture, with the aim of giving both national and International exposure to the excellence of Made in Italy*”. There is also reference to Mr Marenzi receiving “*the Lifetime Achievement Award for ecology and sustainability*” and also the “*WALLPAPER DESIGN AWARDS 2020*”; though little further information is provided about these awards.

26. Exhibit CM14 contains extracts of followers on social media platforms. They show that @herno_official has 209k followers on Instagram, @HernoSpa has 71,346 likes on a Facebook page that was created on 1 July 2020 and 883 followers on a Twitter account of @Herno_official. Each of these platforms display the opponent's First Earlier Trade Mark as its profile picture. Mr Marenzi states that the Twitter posts/tweets "*reference various press publications which mention my Company and the products offered under the Trade Marks*"; however, I note that the content of the tweets is in Italian and I am not provided with a translation.

DECISION

Proof of Use

27. The proof of use provisions are found in section 6A of the Act, which state:

“(6)(1) This section applies where

- a) an application for registration of a trade mark has been published,*
- b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and*
- c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.*

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- a) within the relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and*
- b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.*

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

28. In his witness statement, Mr Marenzi (CEO of the opponent) incorrectly states that the relevant period for assessing whether there has been genuine use of the opponent’s mark is “7 July 2015 and 6 July 2020”. As the date of the application in issue is 7 July 2020, taking this date back 5 years, the relevant period is 8 July 2015 to 7 July 2020.

29. Section 100 of the Act is also relevant, which reads:

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

Thus, the onus is on the opponent, as proprietor of the earlier mark, to show use of it.

30. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

*“114...The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks**

and Designs) [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

The principles established by these cases may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an

outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

31. As both the First Earlier Trade Mark and Third Earlier Trade Mark are EUTMs, the opponent must show use of those marks in the EU². In accordance with the


² For instance, see the CJEU at paragraph [36] in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11

relevant case law³, whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the EU during the relevant 5 year period.


32. Proven use of a mark which fails to establish that “*the commercial exploitation of the marks is real*” because the use would not be “*viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark*” is, therefore, not genuine use.

Form of the mark

33. Prior to conducting an analysis of the evidence filed in order to determine if there has been genuine use of the registered marks, it is necessary to review the instances where the opponent has used the mark in conjunction with additional elements, or in a varying form to the mark as shown on the register, in order to determine if these instances should be classed as use ‘of the mark’ for the purpose of the assessment.

34. The opponent’s First Earlier Trade Mark is registered as  and the Third



Earlier Trade Mark is registered as . The evidence as shown on the exhibits accompanying the opponent’s witness statement demonstrate use of the mark in the form it is registered and, thus, such use can be relied upon.

35. The opponent’s evidence also contains use of the sign “*HERNO*”/“*Herno*” and “*HERNO LAMINAR*”/“*LAMINAR*” in a form that is not stylised, and use of







and



³ In particular, this includes that summarised by Arnold J (as he then was) in *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) at paragraphs [114-115]

36. Section 46(2) of the Act states that:

“... use of a trade mark includes use in a form (“the variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it is registered...”

37. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“CJEU”) found that:

“32. ... the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark”,

And

“35 ... as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”.

38. Where the issue is whether the use of a mark in a different form, rather than with, or as part of, another mark, constitutes genuine use of the mark as registered, the decision of Mr Richard Arnold QC (as he then was), sitting as the Appointed Person, in *Nirvana Trade Mark*, BL O/262/06, is relevant⁴. He summarised the test under s.46(2) of the Act as follows:

"33. ... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period..."

⁴ See paragraphs [33] – [34].

34. *The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."*

Although this case was decided before the judgment of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The case of *Colloseum* is relevant when considering the use of one mark with, or as part of, another mark.

39. I will now consider each of the signs in turn.

Sign 1: "HERNO"/"Herno"

40. As this is an alteration to the mark as registered, I must bear *Nirvana* in mind. I find that use of the sign(s) "HERNO" and "Herno" do not qualify as acceptable variants of either of the opponent's earlier marks. Although the word is the same – the stylisation used in the opponent's First Earlier Trade Mark adds to the distinctive character, and removing this stylisation alters the distinctive character of the mark. Thus, use of the sign "HERNO" and/or "Herno" in a word only and non-stylised manner are not acceptable variant uses.

41. The same rationale applies when I consider whether the signs are acceptable variant uses of the opponent's Third Earlier Trade Mark; except there is a further difference to the distinctive character in that the signs used neither contain the heavily stylised and cursive "*Laminar*" element. I do not find use of the above word marks to be acceptable variants of the opponent's Third Earlier Trade Mark.

Signs 2 and 3: "HERNO LAMINAR" and "LAMINAR"

42. These are alterations to the mark as registered, so I bear *Nirvana* in mind. I find that use of the sign “*HERNO LAMINAR*” and “*LAMINAR*” do not qualify as acceptable variants of either of the opponent’s earlier marks. Following a similar reasoning to that I explored above, these are word only signs that very clearly differ to the opponent’s First and Third Earlier Trade Marks. My finding is irrespective that these signs contains one or both word elements contained in the opponent’s Third Earlier Trade Mark. The overall differences alter the distinctive character of the registered marks and, thus, they are not acceptable variants.



Sign 4: *Laminar*

43. This device mark fully incorporates the opponent’s First and Third Earlier Trade Marks, with the addition of the rectangular black edged box around the first word element. I consider that the use meets the *Colloseum* test in that the “*HERNO*” and “*Laminar*” elements retains their independent distinctive role and continue to indicate origin. I find that this is use of the marks as registered, upon which the opponent can rely.

44. In making this finding, I have also borne in mind the decision of *Hyphen GmbH v*



EU IPO, Case T-146/15 where the General Court held that use of



constituted use of the registered mark () since the addition of a circle did not alter the distinctive character of the mark as registered.

Sign 5: *Laminar*

45. Whilst this mark incorporates part of the opponent’s Third Earlier Trade Mark, it does not incorporate all of the mark as registered in accordance with *Colloseum*. I

neither find that this sign qualifies as an acceptable variant in accordance with *Nirvana*; the distinctive character of the opponent's Third Earlier Trade Mark is altered.



46. This device mark fully incorporates the opponent's First Earlier Trade Mark, in addition to a proportionately much smaller word element ("*KIDS*") in the bottom right corner. I consider that the use meets the *Colloseum* test in that the "*HERNO*" element retains its independent distinctive role and continues to indicate origin. I find that this is use of the mark as registered, upon which the opponent can rely.

Sufficient Use

47. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself⁵.

48. The opponent has not provided any figures for the size of the EU market for any of the goods registered (i.e. largely those in relation to clothing, footwear and headgear), though I would believe the size to be reasonably large. I first find it important to highlight that the evidence could have been better in some respects, additional information surrounding sales, and regarding advertising and promotional material would have been particularly helpful. Nevertheless, when I consider the evidence in its totality, I am satisfied that the opponent's use of its First Earlier Trade Mark as registered in various EU countries is sufficient for creating or preserving a market share in respect of some of the goods registered. I make the following key points:

- a. The opponent's invoices example the opponent's First Earlier Trade Mark in use by way of its depiction in the top left of the sample invoices amounting

⁵ See *New York SHK Jeans GmbH & Co KG v OHIM*, T-415/09

to figures I extrapolate in the table below. Those invoices were in respect of various types of outerwear and vests.

Year	Figure invoiced
2016	€51,961.20
2017	€23,623.00 + £16,786.50
2018	€13,324.00 + £45,134.50
2019	€19,953.00 + £10,299.00
2020	€81,457.63

I combine this information with the wholesale turnover figures that Mr Marenzi provided; though I acknowledge that the opponent did not clarify upon which goods the turnover figures pertain. I also only know the brand name (“HERNO” and “HERNO LAMINAR”, neither of which are use of the marks registered) respective of the figures and I am not informed about the marks displayed during the sales.

- b. The opponent’s invoices and list of stores indicates their exposure in several EU countries since 2016. This includes the UK, France, Germany, Italy and Spain. When I corroborate this evidence with the various photographs I have of the opponent’s EU retail outlets, I have evidence that the First Earlier Trade Mark has been used on and advertising various clothing products within the relevant period. I also bear in mind the look books displaying clothing from the opponent’s Autumn/Winter 2019-2020 and Spring/Summer 2020 collections; albeit I do not know where such clothing was available.
- c. The opponent has received some EU-wide press from third parties. Many of the articles discuss the opponent’s success providing luxury, sustainable outerwear and its increasing revenue throughout the Relevant period. The First Earlier Trade Mark is displayed in the majority of the articles evidenced.
- d. The opponent has a considerable following on various social media platforms advertising their goods. Whilst the evidence is undated, when I

consider the number of followers/likes amassed and the creation date of the Facebook page, I expect that many of the followers/likes were obtained within the relevant period.

- e. None of the exhibits submitted by the opponent show their First Earlier Trade Mark being used in relation to shirts, chemisettes, skirts, suits, pants, trousers, shorts, undershirts, pajamas, stockings, corsets, suspenders, brassieres, underwear, headgear, headscarves, ties, swimming costumes, sportsuits, ski trousers, waist belts, pelisses, sashes, gloves and dressing gowns. The only evidence pertaining to footwear is in relation to undated images of a selection of trainers, which I am unsure of their availability during the relevant period. As a result of the lack of examples of use, and in the absence of any other evidence from the opponent as to how the mark has been used on these goods, I find that the opponent is unable to rely on such goods in support of its opposition.

- f. The evidence shows use of the First Earlier Trade Mark in respect of several types of clothing. This use shown is predominantly in respect of clothing for adults, though I note there is also some use of the mark on coats for children. The evidence mainly includes jackets, coats, vests/gilets, puffer coats and overcoats. There is also some evidence of the use of the mark in respect of t shirts, but like the footwear this comprises undated images only. There is also limited evidence of the mark being used in relation to sweatshirts. I note the goods shown on the invoices primarily show sales of coats and jackets and vests⁶ for both men and women. The opponent is described in the articles provided as an outerwear brand. The images provided of the shops show jackets and coats on display, the goods shown in the look books provided are all outerwear, as are the goods shown in the advertising campaigns. Whilst the sales figures provided by the opponent have not been broken down, it is clear that at least a significant portion of these figures may be attributed to the sale of outerwear in the EU. However,

⁶ From the sum of the evidence I take this to be the sale of 'vests' as outerwear as there is no evidence to support the sale of these goods as vests for wearing under clothing.

it is less clear what portion of these sales, if any, may be attributed to any other type of clothing offered by the opponent.

49. However, in regard to the opponent's Third Earlier Trade Mark, I have very little evidence of the mark being used. Whilst I bear in mind that use of the mark need not always be quantitatively significant for it to be deemed genuine⁷, the evidence is too vague and inconclusive to prove genuine use in respect of any of the goods concerned. I do not have any evidence demonstrating the amount of sales generated in respect of the mark. Although I have some minimal evidence of the mark displayed in retail shops and on some clothing, I am not certain this is within the relevant period and the only other evidence I have advertising goods under the mark is in relation to look books, which I also have limited information about. The level of use evidenced is insufficient to create or maintain market under the mark. Consequently, as I do not find genuine use, the opponent's Third Earlier Trade Mark cannot be relied upon for the purposes of its opposition.

Fair Specification

50. Having concluded that the opponent has made genuine use of its First Earlier Trade Mark, I must now decide what constitutes a fair specification. In this regard, I am guided by the following cases. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

⁷ See *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55]

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

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

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

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in Pan World Brands v Tripp Ltd (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; Thomas Pink at [53].

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

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of

protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46.”

52. Whilst I do not find it appropriate to limit the specification of goods down to only the individual items shown by the opponent, I do find that clothing may be broken up into various subcategories. Bearing in mind the assessment I have made above and the evidence provided, I find the consumer would fairly describe the opponent as selling outerwear. I therefore find the following to be a fair specification:

Class 25: *Clothing, namely outerwear.*

DECISION

Section 5(2)(b)

53. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

(a) ...

(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”.

54. The opponent has based their opposition on three earlier marks. However, for the reasons explained above, the opponent can only rely on its First and Second Earlier Trade Marks. Since the Second Earlier Trade Mark reproduces the First Earlier Trade Mark with additional elements that are not present in the contested

mark, I will begin my assessment by first considering the opponent's First Earlier Trade Mark.

55. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) ('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

- (a) The likelihood of confusion must be appreciated, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

Comparison of goods

56. The opponent contends that the contested mark covers goods that are similar and/or identical to the goods their earlier mark protects.

57. The applicant accepts that there is a low level of similarity between the respective parties' goods.

58. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

59. In the judgment of CJEU in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*, Case C-39/97, the court stated at paragraph [23] of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

60. The relevant factors for assessing similarity were identified by Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At paragraph [296], he identified the following:

“(a) The respective uses of the respective goods or services;

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

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

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

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

61. In respect of the complementarity between goods, I point towards *Boston Scientific Ltd v OHIM*, Case T-325/06, where the General Court stated that ‘complementary’ means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

62. As I mentioned earlier, I will first compare the applicant’s contested mark with the opponent’s First Earlier Trade Mark. With the above factors in mind, the goods for comparison are as follows:

Opponent’s goods	Class 25: Clothing, namely outerwear.
Applicant’s goods	Class 25: Clothing, footwear, headgear.

Clothing

63. The applied for specification broadly covers clothing. I have found that a fair specification of the opponent is “*Clothing, namely outerwear*”. As the opponent’s goods fall within the more general category of goods covered by the applicant, there is identity between the respective goods on the principle outlined in *Meric* above.

Footwear

64. The applicant has coverage for footwear, broadly. Although the nature, intended purpose and method of use of the applicant's footwear and those of the opponent's goods are likely to differ on one level, there are also some similarities at a broader level. Footwear will be shaped to encase a foot and will often be formed from a soft upper material with a rigid sole. It is primarily for the purpose of protecting the foot and providing comfort. On the other hand, outerwear will generally be shaped to encase the body and will be made of a flexible material. It is primarily for the purpose of keeping the wearer warm. However, there are some similarities in that they are both designed to be worn, to cover a part of the body and protect it from the elements. There is also likely overlap in, the users and trade channels. However, the goods are not competitive or complementary in a trade mark sense. There is a medium degree of similarity between the competing goods.

Headgear

65. The applicant has broad coverage of headgear. Following a similar vein to that I have explored above, the nature, intended purpose and method of use of the applicant's headgear share some general similarities yet some specific differences to the opponent's outerwear. Both goods can be made of various materials and are designed to protect and/or adorn the person wearing them, yet the former is shaped specifically to fit a person's head whilst the latter is shaped to encase their body. Whilst the users and trade channels likely overlap, the goods are not competitive or complementary. I find there to be a medium degree of similarity between the competing goods.

Average consumer and the purchasing act

66. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services (those I have held to be in conflict). I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade.

67. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question⁸. In *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), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

68. The goods at issue are clothing, footwear and headgear. The average consumer will be the general public. Such goods are neither an infrequent nor a daily purchase and whilst the cost varies depending on the exact goods, they are generally fairly inexpensive. The goods are most likely to be the subject of self-selection from retail outlets, websites or catalogues. Visual considerations are, therefore, likely to dominate the selection process. I nevertheless bear in mind that the marks are spoken. For example, they may be recommended by sales assistants in a retail establishment or when making a purchase from a catalogue over the telephone. However, in such circumstances, the consumer will have had an opportunity to view the goods, perhaps electronically via an app, website or online catalogue, or on paper in the traditional sense of catalogue shopping. When making a purchase, factors such as size, material, colour, cost (which will vary according to the item) and overall aesthetic impact are likely considered. The average consumer will therefore pay a medium degree of attention during their purchase of the goods.

⁸ See *Lloyd Schuhfabrik Meyer & Co. GmbH*


Comparison of marks

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

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

70. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

71. The respective trade marks are shown below:

First Earlier Trade Mark	Contested trade mark
	mr heron

72. The opponent submits that the dominant and distinctive element of their earlier marks is “*HERNO*”. They submit that the dominant and distinctive element of the contested mark is the word “*HERON*”, with the “*MR*” element being of low distinctive character and an abbreviation for the title “*Mister*”, which is a “*mere identifier of ... HERON*”. The opponent refers to the decision of the EUIPO’s Board

of Appeal in Case R3095/2014-4 to support their submission that “MR” has a lack of distinctive character. The opponent states that the marks are of a high aural, visual and conceptual similarity. The opponent states that “*Whilst some consumers may understand the element HERON as referring to a type of bird*”, the meaning of “MR HERON is not sufficiently clear to bring a concept in the minds of the relevant consumers” and, thus, the conceptual aspect cannot overcome the visual and aural similarities⁹.

73. The applicant submits that the parties’ marks are dissimilar. With regards to their mark, they submit that the “*mister*” element is dominant and that the “*heron*” element will likely “*provide the average consumer with an immediate conceptual allusion to the species of bird*”.

Overall impression

The applicant’s contested mark

74. The contested mark is a word only mark consisting of the phrase “*mr heron*” in normal font. The overall impression lies in the phrase “*mr heron*” in its totality.

The opponent’s First Earlier Trade Mark

75. The opponent’s mark is a device mark consisting of the word “HERNO” in uppercase rigid stylisation. The ‘H’ is slightly larger than the rest of the letters and it has an elongated underlining attached to it. The word plays a more dominant role in the overall impression whilst the stylisation plays a lesser, but not negligible, role.

Visual comparison

76. The contested mark contains the phrase/words “*mr heron*” without stylisation and the earlier mark contains the word “HERNO” in heavy stylisation. Whilst both marks

⁹ On this point the opponent refers to *Case C-361/04 P, Picasso Picaro*, at paragraph [56].

contain the letters “*HER*”/“*her*”, the beginnings and stylisation of the marks differ. Although the marks contain the letters ‘n’ and ‘o’ after the “*HER*”/“*her*” element, the order differs – the earlier mark is “*NO*” whilst the contested mark contains “*on*”. As the contested mark is filed as a word mark, it may be used in both upper and lower case lettering, as well as in a variety of standard fonts. However, for the avoidance of doubt, the font used by the opponent’s earlier mark falls outside of what could be considered fair use. Overall, I consider that the marks have a low to medium degree of visual similarity.

Aural comparison

77. I consider the earlier mark will be articulated as ‘her-no’ whilst the contested mark will be articulated as ‘mis-ter—heh-ron’. There is only a low degree of aural similarity between the marks.

Conceptual comparison

78. The earlier mark appears to be a made up word; I do not consider the average consumer will ascribe a conceptual meaning to it. The contested mark, however, is made up of two English words. The first is “*mr*”, which I consider will be viewed as an abbreviation for the male title, ‘mister’, which is usually used before a man’s full name or surname. I consider the second word, “*heron*”, will evoke a conceptual message surrounding the heron species of bird. When the two words are combined, I find it possible that the average consumer will consider both words hang together and allude to a ‘Mr Heron’ (albeit I am not aware of ‘Heron’ being a common surname) or a male bird. Either way, the parties’ marks are conceptually dissimilar.

Distinctive character of the earlier trade mark

79. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer & Co. GmbH* the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51).”

80. Registered trade marks can possess various degrees of inherent distinctive character, ranging from low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

81. Starting with the inherent characteristics, the opponent’s earlier mark consists of the word “HERNO” in a stylised font. Although I note the opponent’s evidence highlights that the word was “*inspired by the Erno river that ows [sic] through the town of Lesa*” and that the “*H was added to Erno to give the Brand an international touch*”, I do not consider that this meaning would be widely known by the UK consumer. The word does not have an English meaning and, thus, it would largely not be considered to have any specific connection to the goods for which it is

registered. I find that the mark has a relatively high degree of inherent distinctiveness.

82. The opponent has filed evidence of use of the earlier mark and submits that their mark has acquired an enhanced distinctive character. Enhanced distinctiveness is a measure of how strongly the mark identifies the goods of the opponent. The assessment needs to be made from the perspective of the UK average consumer, as that is who must be likely to be confused. Most of the evidence demonstrates the use of the mark in relation to clothing, namely outerwear. The breakdown figure indicates that between 2017 - 2020, the wholesale turnover figures for the 'UK HERNO' ranges from '€1,345.522(m)' to '€2,555.583(m)' per year. Whilst I have not been provided with evidence in respect of the size of the UK market for clothing, it is my view this will be substantial. In that context, the opponent's share of the clothing market for the UK is likely to be fairly modest. Whilst I accept that the market for outerwear may be smaller, I find this is still likely to be substantial and, without further evidence, I am unable to find that the opponent holds a substantial share of the market for outerwear in the UK. I have very little evidence regarding promotional and advertising activities nor any extensive media coverage. From the evidence provided, I do not find that the use made of the mark will have enhanced its distinctiveness to above the relatively high degree.

Likelihood of Confusion

83. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. I point particularly to the principles I referred above in paragraph 57. One of these is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

84. There are two types of possible confusion: direct (where the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). The distinction between these was explained by Mr Iain Purvis Q.C (sitting as the Appointed Person) in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C.:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.)

(c) *where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”*

For the avoidance of doubt, I acknowledge that these three categories are just illustrative – Mr Purvis QC stated that indirect confusion ‘tends’ to fall in one of them.

85. In *The Picasso Estate v OHIM, Case C-361/04 P*, the CJEU found that:

"20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

86. In *Nokia Oyj v OHIM, Case T-460/07*, the GC stated that:

"Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P Editions Albert Rene [2008] ECR I-0000, paragraph 98)."

87. I will first analyse whether there is a likelihood of direct confusion. Earlier in this decision I concluded, *inter alia*, that whilst some of the parties’ goods are identical, others are of a medium similarity. Although the earlier mark has a relatively high degree of distinctive character, the competing trade marks are of a low to medium visual similarity and low aural similarity. The marks are also conceptually different. Notwithstanding the similarities, the difference on account of the additional components (particularly the addition of ‘mr’ in the contested mark and heavy stylisation in the earlier mark) will likely be recalled by the average consumer

paying a medium attention to the goods concerned. I also find the contested mark has a strong conceptual message and, thus, I find the conceptual differences between the competing trade marks are simply too great to go unnoticed by the average consumer, even in relation to identical goods. Notwithstanding the possibility of imperfect recollection, I find that the marks are too dissimilar for there to be a likelihood of direct confusion.

88. I now turn to consider indirect confusion. The marks contain different words and elements, albeit share the letters “*HER*”/“*her*” (in that order). I am not persuaded that the average consumer would consider that the mere sharing of these letters alongside differing additional elements, stylisation and one mark having a strong conceptual message would indicate that the marks come from related economic entities. Rather, much more likely, in my view, is that the average consumer would assume that goods sold under the trade marks were from unrelated undertakings and the shared letters on identical goods are a mere coincidence, if this was noticed at all. Thus, I do not find that there is a likelihood of indirect confusion.

Comparison with the opponent’s Second Earlier Trade Mark

89. As the opponent’s First and Third Earlier Trade Marks lead to the opposition being unsuccessful, I will now consider the opponent’s Second Earlier Trade Mark upon which the opposition is based. I note that the applicant requested that the opponent prove use of this mark, however, for the avoidance of doubt, given that the mark had not been protected for five years or more at the filing date of the application, this mark is not subject to proof of use. In terms of whether the Second Earlier Trade Mark creates a likelihood of confusion, much of my earlier analysis is applicable. To summarise it briefly, my views are as follows:

- a. This mark has a slightly broader goods remit. Insofar as articles of clothing are concerned, the earlier goods analysis applies and the goods are identical. This earlier mark also covers, *inter alia*, “*Footwear*” in general and various items worn on the head (such as “*Hats*”) – these goods are also literally identical or identical on the *Meric* principle. Whilst I note the earlier

mark also covers various goods in class 18, due to the identity aforementioned, there is no need to analyse these further.

- b. The average consumer and the selection process remain the same.
- c. The opponent's mark is a device mark consisting of the word "*HERNO*" in uppercase rigid stylisation and an elongated underlining attached to the slightly larger 'H', with the word "*Globe*" in thinner stylisation beneath. The "*HERNO*" element plays a slightly greater role in the overall impression, with the "*Globe*" element playing a slightly smaller role due to its placement and size; and the stylisation playing the smallest (albeit not a negligible) role. Comparing this to the contested mark, there is an even greater disparity. The visual and aural similarity is low and there is conceptual dissimilarity since this earlier mark also evokes a conceptual reference surrounding the word "*GLOBE*" which is synonymous with the world/earth.
- d. The earlier mark has a relatively high degree of inherent distinctive character. I do not have enough evidence to find that the mark has enhanced distinctive character.

90. Although the opponent's Second Earlier Trade Mark contains some differences to the opponent's First Earlier Trade Mark, the factors and assessment from earlier does not materially change. Similarly, I still do not find a likelihood of confusion, whether direct or indirect. Quite simply, the marks are even further apart and the common presence of the letters "*HER*" "*her*" are not enough. The differing additional elements and conceptual message that each mark evokes are too strong to be overlooked.

CONCLUSION

91. The opposition under section 5(2)(b) of the Act has been unsuccessful. Subject to any successful appeal against my decision, the application can proceed to registration for the full range of goods applied for.

COSTS

92. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of TPN 2 of 2016. Using that TPN as a guide, I award the applicant the sum of £1600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement: £200

Considering the other side's evidence: £1000

Preparing submissions £400

93. I therefore order Herno S.P.A. to pay Miss Sparrow LTD the sum of £1600. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 6th day of September 2021

B Wheeler-Fowler

For the Registrar