

O-156-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2376996  
BY M.A.Y. TRADING (UK) LIMITED  
TO REGISTER THE TRADE MARK  
SILVER SEVEN  
IN CLASS 25**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 93428  
BY SEVEN S.P.A.**

## BACKGROUND



1) On 30 October 2004, M.A.Y. Trading (UK) Ltd, of 1 Lorenzo Street, London, WC1X 9DJ applied under the Trade Marks Act 1994 for registration of the following trade mark:


**Silver Seven**

2) In respect of “Clothing, headgear, footwear” in Class 25.

3) On 18 May 2005 Seven S.P.A. of Viale Italia 73, 10040 Leini (Torino), Italy filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

Mark	Number	Registration date	Class	Specification
	CTM 591206	02.05.01 (applied for 22.07.97)	16	Pen boxes, pencil boxes, pen cases, small cases for pens, exercise books, notebooks, folders, pastels, pencils, pens, acrylic pens, diaries, magazines, newspapers; printed matter; book binding material, photographs; stationery; adhesive (glues) for stationery or household purposes; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not including in other classes); playing cards; printers' type; printing blocks.
			18	Knapsacks and rucksacks, small knapsacks and rucksacks; school satchels; bags; multipurpose big bags; sling bags for carrying infants; pouches; camping sacks, beach bags; travelling bags; bags for climbers; school bags; leather and imitation of leather, wallets, purses, briefcases, cheque-book covers, keycases of leather or imitation of leather, paper-cases; hides; trunks and suitcases; umbrellas and walking sticks; whips, harness and saddlery.
			25	Woven and knitted clothing and underwear, boots, shoes and slippers, headgear.
	CTM 2305589	11.11.03 (applied for 06.07.01)	16	Paper, cardboard and goods made from these materials, not included in other classes; printed matter, newspapers, magazines, books; calendars and diaries; photographs, stationery, notebooks, memo boxes, pen cases, pencil cases, pens, pencils, document cases, passport holders; cheque book holders, cards with elastic, ring binders for notebooks, covers for books and notebooks, expanding cases, bags of paper or plastic, desk writing folders; paperweights; clips; paper knives; calendars; calender holders; photo holders; photo frames; bookbinding material, adhesives (adhesives

				for stationery or household purposes); artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.
			18	Goods made from leather and imitations of leather not included in other classes; knapsacks, rucksacks, school bags, bags, baby carriers, stroller bags, shopping bags, travelling bags and holdalls, sports bags and holdalls; handbags, bags for campers; beach bags; holdalls; bags for climbers; school satchels, portfolio bags, billfolds, purses not of precious metal; cases for keys, fanny packs, travelling bags, umbrellas and parasols; trunks, walking sticks, whips, harness and saddlery.
			25	Clothing (including underwear and beachwear), shoes, boots, slippers, sandals, belts; headgear.
	CTM 3489234	12.05.05 (applied for 30.10.03)	16	Paper, cardboard and goods made from these materials and not included in other classes; printed matter, newspapers, magazines, books; blank diaries; photographs, stationery, notebooks, memo boxes, pen cases, pencil cases, pens, pencils, document cases, passport holders; holders for cheque books, folders with elastic bands, ring binders for notebooks, covers for books and notebooks, bags of paper or plastic, desk folders; paper staplers; clips; paper cutters; calendars; calendar holders; photo holders; photo frames; bookbinding material, adhesives (adhesives for stationery or household purposes); artist' materials; brushes; typing machines and office accessories (excluding furniture); instructional and teaching material (excepts apparatus); plastic materials for packing (not included in other classes); printing types; printing blocks.
			18	Goods made from leather and imitations of leather not included in other classes; knapsacks, rucksacks, school bags, bags, baby carriers, stroller bags, shopping bags, travelling bags and holdalls, sports bags and holdalls; handbags, bags for campers; bags for climbers; school satchels, portfolio bags, billfolds, purses not of precious metal; cases for keys, fanny packs, travelling bags, umbrellas and parasols; trunks, canes; whips, harness, saddlery; briefcases of plastic.
			25	Clothing (including underwear and beachwear), shoes, boots, slippers, sandals, belts; headgear.

b) The opponent claims that its goods in Class 25 are identical and/or similar to the goods applied for and that the marks are confusingly similar. The mark therefore offends against Section 5(2)(b) of the Trade Marks Act 1994.

4) The applicant subsequently filed a counterstatement accepting that the “goods in the opponent’s CTMs fall in the scope of the current application” but denying the opponent’s claims re confusion.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard on the matter although both sides provided written submissions which I shall refer to as and when relevant.

### **OPPONENT’S EVIDENCE**

6) The opponent filed a witness statement, dated 9 May 2006, by Ross Timothy Manaton, the opponent’s Trade Mark Attorney. He provides at exhibits RTM1-3 computer print-outs of the opponent’s registered trade marks.

### **APPLICANT’S EVIDENCE**

7) The applicant filed two witness statements. The first, dated 10 August 2006, is by Suzanna Louise Cameron Hawkes the applicant’s Trade Mark Attorney. She provides, at exhibit SLCH1 a print-out of ninety three marks on the CTM Register which include the element “seven” for goods in Class 25. Also included in this exhibit is a list of thirty-two marks on the UK Register for goods in Class 25 which begin with the element “Seven”. She states that these results show that marks with the word “seven” in them are common with regard to Class 25 goods. Ms Hawkes also referred me to two cases by OHIM. However, neither of these seemed on all fours with the instant case.

8) The second witness statement, dated 10 August 2006, is by Jason Charles Marchant the Managing Director of the applicant company. He states that he has been in the fashion industry for 28 years and during this time has acquired some knowledge of trade marks and trade names. He states that he is not aware of exclusive use of the mark “seven” by one entity alone in the fashion industry. He states that there have been recent uses of the element “seven” such as by M&S with their mark “DB07”. At exhibit JCM1 he provides copies of pages from the Internet which show use of this mark in 2002. Also he refers to use by a company called “7 For All Mankind LLC” which launched a range of “seven jeans”. At exhibit JCM02 he provides details from the Internet which shows use, mainly in the USA, but also a UK outlet. Finally, he states that the term “seven” is used in the industry as a size guide for items such as hats, gloves and belts.

### **OPPONENT’S EVIDENCE IN REPLY**

9) The opponent filed a second witness statement, dated 13 November 2006, by Mr Manaton. He points out that most clothing is sized in relation to body measurements such as chest size, inside leg etc. Alternatively, he states that terms such as small, medium and large are used. He accepts that women’s clothing is sized by a scale but he states that it is in even numbers only. He provides exhibits which back up his contentions in relation to clothing (other than gloves, hats, footwear and belts).

10) That concludes my review of the evidence. I now turn to the decision.

## **DECISION**

11) The only ground of opposition is under section 5(2)(b) which reads:

“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.”

12) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK), international trade mark (EC) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

13) The opponent is relying upon its three CTMs which have effective dates of 22 July 1997, 6 July 2001 and 30 October 2003 all of which are clearly earlier trade marks.

14) The opposition was filed after 5 May 2004. I must therefore consider the position under The Trade Marks (Proof of Use, etc.) Regulations 2004. Paragraph six of which states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

- (3) The use conditions are met if-
- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
  - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes-
- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
  - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (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.
- (7) Nothing in this section affects –
- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or
  - (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

15) In the instant case the publication date of the application was 18 February 2005. Therefore, the relevant period for the proof of use is 19 February 2000- 18 February 2005.

16) The opponent’s marks did not complete their registration process five years prior to the publication date of the instant case. The registration dates of the opponent’s marks are set out in paragraph 3 above. Therefore, the proof of use conditions do not apply.

17) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC

199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux B.V.* [2000] E.T.M.R. 723.

18) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the marks relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

19) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

20) I also have to consider whether the marks that the opponent is relying upon have a particularly distinctive character either arising from the inherent characteristics of the marks or because of the use made of them. The opponent has not filed any evidence of use and so cannot benefit from an enhanced level of protection due to reputation. However, in my view the opponent's marks have a degree of inherent distinctiveness for items of clothing, headgear and footwear.





21) I shall first consider the specifications of both parties. For ease of reference these are as follows:

Applicant's specification	Opponent's specifications in Class 25
Clothing, headgear, footwear	591206: Woven and knitted clothing and underwear, boots, shoes and slippers, headgear.
	2305589: Clothing (including underwear and beachwear), shoes, boots, slippers, sandals, belts; headgear.
	3489234: Clothing (including underwear and beachwear), shoes, boots, slippers, sandals, belts; headgear.

22) In its counterstatement the applicant acknowledged that the opponent's goods "fall in the scope of the current application". In my comparison I shall be regarding the goods for each of the opponent's marks as identical to the goods in the applicant's specification.

23) I must also consider the average consumer for the types of goods covered by the specifications of both parties. In my opinion, the average consumer must be regarded as the general public who must be considered to be reasonably well informed and reasonably circumspect and observant. In my view, clothing, headgear and footwear are purchased after a degree of consideration. Although I must take into account the concept of imperfect recollection.

24) I now move onto consider the marks of the two parties which are as follows:

Applicant's mark	Opponent's marks
	<b>591206:</b> 
	<b>2305589:</b> 
	<b>3489234:</b> 

25) All three of the opponent's marks consist of the word "seven" written in a stylised manner with either underlining, a border or the number "7". Although the dominant characteristic of these marks is the word "seven" the stylisation involved in each of the marks ensures that it is not seen simply as an indication of the size. Such information is usually imparted in as plain a fashion as is possible. In any case clothing does not use the term "seven" in its sizing. It is clear from the evidence that gloves, hats and shoes do use the term "seven" in sizing. The applicant's mark is also



in a stylised font and so the same arguments apply. It also has the word “Silver” at its beginning.

26) Visually there is the similarity brought about by the word “seven” in each parties mark/s. The obvious visual difference other than the styling is the fact that the applicant’s mark starts with the word “Silver”.

27) Phonetically, the marks equally have a degree of difference and also identity.

28) Conceptually, the applicant argued that its mark was in “gothic” script and contended that this gave a “connotation of Punk and Rock” whereas the Old School and Bubble labels give the connotation of “preppie” and “cino” American styles. To my mind, neither sides marks conjure up a particular image and I do not accept the contention put forward by the applicant. There is also the possibility that consumers will view the applicant’s mark as referring to silver coloured clothing from the Seven company.

29) To my mind the similarities outweigh the differences. There is a degree of similarity between the marks.

30) Taking account of all of the above when considering the marks globally, I believe that there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore succeeds.

## **COSTS**

31) As the opponent was successful it is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £1,000. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 4th day of June 2007**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**