

O-362-12

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 2496591
IN THE NAME OF
DEBENHAMS RETAIL PLC
IN RESPECT OF THE TRADE MARK**

OSBORNE

IN CLASS 25

AND

**IN THE MATTER OF AN APPLICATION FOR A DECLARATION OF INVALIDITY
THERETO
UNDER NO 83679
BY
GRUPO OSBORNE S.A.**


1) Debenhams Retail plc (“the registered proprietor”) is the registered proprietor of the mark **OSBORNE**. The application for registration was made on 02 September 2008 and the registration procedure was completed on 13 February 2009. The registration covers the following goods:

Class 25:

Articles of clothing, footwear and headgear; formal shirts, shirts, ties.

2) On 08 February 2010, Grupo Osborne S.A.(“the applicant”) applied for the registration to be declared invalid. The applicant claims that the registration offends under section 5(1) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Both grounds of invalidation are directed against all of the registered proprietor’s goods.

3) The applicant relies upon one earlier Community Trade Mark (CTM) in respect of both grounds of invalidation. Relevant details of the earlier mark are as follows:

Mark details	Goods relied upon
<p>CTM number: 002252997</p>  <p>Filing date: 07 June 2001</p> <p>Registration date: 05 June 2002</p>	<p>Class 14:</p> <p>Goods made of precious metals and alloys of precious metals; jewellery; rings, bracelets, jewellery, earrings and jewellery in general.</p> <p>Class 16:</p> <p>Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); loose-leaf binders; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.</p> <p>Class 25:</p> <p>Clothing, footwear, headgear; belts.</p>

4) The applicant’s earlier mark has completed its registration procedure and is therefore an earlier mark within the meaning of Section 6(1)(a) of the Act. The registration procedure was completed on 05 June 2002, being more than five years before the date of filing for the application for a declaration of invalidation and, as

such, the earlier mark is subject to the proof of use provisions (Section 47(2A) of the Act refers).

5) The registered proprietor subsequently filed a counterstatement in which it requested the applicant to provide proof of use of its earlier mark. It also requested that the instant invalidation proceedings be suspended pending resolution of an application for revocation for reasons of non-use filed at the Office for Harmonization in the Internal Market (OHIM) against the applicant's earlier CTM. In light of the proceedings at OHIM, the instant proceedings were suspended. The suspension was later lifted due to the application for revocation against the applicant's earlier mark being largely unsuccessful.

6) The applicant filed evidence in chief accompanied by submissions. The registered proprietor did not file evidence or submissions. Neither party requested to be heard and only the applicant filed written submissions in lieu of a hearing. I therefore make this decision after conducting a thorough review of all the papers and giving full consideration to all submissions and evidence submitted.

Applicant's evidence

7) The applicant's evidence consists of a witness statement dated 20 July 2011 in the name of Adela Lario Rivas, legal director of Grupo Osborne S.A.

8) At paragraph 17, Mr Rivas refers to cancellation proceedings (OHIM Cancellation Board Decision No 000003310) against the applicant's earlier mark in which, he states, OHIM concluded that the earlier mark is valid and had been put to genuine use in relation to the following goods:

Class 14: Watches, rings, bracelets, pendants, earrings and jewellery in general.

Class 16: paper, cardboard and goods made from these materials, not included in other classes; printed matter, bookbinding material, photographs; stationery, adhesives (glues) for stationery or household purposes; material for artists, brushes, typewriters and office requisites (except furniture); filling, instructional materials or teaching material (except apparatus), plastic materials for packaging (not included in other classes); cards, printed characters.

Class 25: clothing, footwear, headgear, belts.

9) The cancellation decision is exhibited at ALR2.

10) At paragraphs 20-28, Mr Rivas refers to exhibit ALR1 which he states shows evidence of the earlier mark used on all manner of goods, including shirts, t-shirts, polo shirts, sweaters, jackets, belts, ties, scarves, socks, caps, pin badges, key rings, earrings and cufflinks. He also refers to third party statements in the same exhibit which he states refer to the fact that the earlier mark is used and is well known for these goods. He goes on to say that the invoices provided in the same exhibit attest to both the manufacture of such goods and the sale of them in the EC.

Exhibit ALR1:

- Pages 9-25: A letter sent to OHIM, in support of the evidence filed by Grupo Osborne S.A., in the aforementioned cancellation proceedings.
- Document 1 (pages 43-44): Undated photographs of a red t-shirt with 'OSBORNE' (standard font) on the neck label.
- Document 2 (page 46): Undated photograph of a polo-shirt with **OSBORNE** embroidered on the collar.
- Document 3 (page 48): Undated photograph of a red polo-shirt. **OSBORNE** is present on the neck label together with the number 103. **OSBORNE** is also present on the chest area of the shirt accompanied by the device of a bull and the number 103.
- Document 4 (page 50): Undated photograph of a cap with 'OSBORNE' (standard font) on the inside label.
- Document 5 (page 53): Undated photograph of a pin and a key ring in the shape of a bull, both with the word **OSBORNE** imprinted thereon.
- Document 6: Pages 54-56 show a copy of a certificate issued by ANDEMA (National Association for the Defence of Trademarks) dated 1 June 2009. The certificate states that the applicant is the holder of more than 6, 500 registered trademarks including 'OSBORNE' and '**OSBORNE**+ bull device' and that the latter mentioned trademarks are being commercialised in more than 50 countries of Europe, America, Asia and Oceania; their first commercialisation having been carried out in Spain in 1920. It goes on to state that the OSBORNE trademark is notorious and renowned in the market both at national and international level. It is stated that the renown of the trademark is proved as a consequence of it satisfying the following factors: knowledge of the trademark by the general public; the quality level in all the goods featuring it; broad diffusion of the trademark; investments on advertising; sponsoring of cultural events; sponsoring of golf and sailing prizes; solidary actions with NGOs in the fight against famine.
- Document 6: Page 57 is entitled 'SALES OF "MERCHANDISING" GOODS IN "OSBORNE" OWNED SHOPS YEARS 2003 TO 2009'. Page 58-59 consists of un-sworn statements in the name of Antonio Abad Garcia, Director of Public Relations of the GRUPO OSBORNE, S.A. The first statement is dated 28 May 2009 in which Mr Garcia states that he certifies that the sales generated over the previous five years from shops open to the public amount to 3, 586, 904 Euros. The second statement is dated 5 April 2005 in which Mr Garcia states that he certifies that the sales generated over the previous three years amounted to 1, 623, 162.68 Euros.

- Document 6: Pages 60-61 show undated photographs of a shop floor. Goods visible include t-shirts and bottles of wine. **OSBORNE** is present on an ornamental border running around the walls of the shop. The image of a bull is also present on the border.
- Document 6: Pages 62 and 64-66 and 68 show undated photographs where the following mark is visible on the face of a watch, a t-shirt, sweatshirt, umbrella and caps:



OSBORNE is also visible on the rear of a cap. Pages 63 and 67 show undated photographs where the mark **OSBORNE** is visible on lighters and t-shirts accompanied by numerous images of bulls.

- Document 8 (page 75): Un-sworn statement in the name of Pedro Rojas Gomez, of Sociedad Espanola de Publicidad, S.L. (PUBLISOL), dated 1 June 2009. Mr Gomez states that he certifies that since approximately 2004, the aforementioned have been manufacturing and supplying waistcoats, undershirts and wristbands to Grupo Osborne, under the 'Osborne' trademark.
- Document 9 (page 76) : Un-sworn statement in the name of Daniel Higuera Eusebio, of D&L MERCHANDISING Y PUBLICIDAD, S.L. (PUBLISOL), dated 1 June 2009. Mr Eusebio states that he certifies that since approximately 2004 the aforementioned have been manufacturing and supplying watches, scarves, ties and cufflinks, to Grupo Osborne, under the "Osborne" trademark.
- Document 10 (page 77): Un-sworn statement in the name of Juan Ramon Gayan Pacheco, of PROMOCIONES Y MARKETING TEXTIL, S.L., dated 1 June 2009. Mr Pacheco states that he certifies that since 2004 the aforementioned have been manufacturing and supplying polo shirts to Grupo Osborne, under the "Osborne" trademark.
- Document 11(page 78): Un-sworn statement in the name of David Berenguer, of TEXTILES BERBEL, S.L. (PUBLISOL), dated 1 June 2009. Mr Berenguer states that he certifies that since approximately 2006 the aforementioned have been manufacturing and supplying towels and aprons to Grupo Osborne, under the 'Osborne' trademark.
- Document 12; Pages 79-89 show photographs, dated 7 July 2009, of goods at point of sale on shelves and racks. The following mark is visible on socks, bags, baseball caps and t-shirts:



The mark **OSBORNE** is also imprinted on socks, belts and on the collar of a polo-shirt. Pages 90-93 show undated photographs of goods, including scarves, a jacket, and polo-shirts which all also bear the same “**OSBORNE** + Bull device” mark as that shown above.

- Document 13 (pages 94-99): pages from a promotional catalogue dated 2008 showing key rings, watches, pins and ties. The following mark is present on the front cover of the catalogue and on the top of each page within the catalogue:



- Document 14 (pages 100-110): pages from a promotional catalogue dated 2005 showing ties, pins, t-shirts, key rings, caps, scarves and watches. **OSBORNE** is visible on the back of a cap. The following mark is present on the cover and at the top of each page of the catalogue and on scarves and t-shirts:



- Documents 15-25 (pages 111-121): Copies of eleven invoices issued by various companies in Spain to Osborne Distribuidora, S.A. for the supply of various goods including aprons, scarves, shawls, waistcoats, watches, ladies and gents t-shirts, socks and wristbands. The dates of the invoices range from 2006 through to 2009, the earliest date being 17 November 2006 and the latest date being 28 April 2009. The invoice dated 05 July 2006 refers to the supply of aprons with “OSBORNE” printed thereon. Invoice dated 17 November 2006 refers to the supply of scarves with “OSBORNE” embroidered thereon. Invoice dated 21 November 2006 refers to the supply of shawls with “OSBORNE” embroidery. Invoice dated 12 February 2007 refers to the supply of watches with ‘silk-screen printed logo with the Osborne trademark’. Invoice dated 09 April 2008 refers to the

supply of gents and ladies shirts with 'Osborne embroidery and label'. Invoice dated 07 July 2008 refers to the supply of t-shirts with 'Silk-screen printed mark: Osborne'. Invoice dated 26 June 2008 referring to the supply of wristbands with 'Bull-Osborne Embroidery'. Invoice dated 30 April 2008 refers to the supply of aprons with "OSBORNE" logo'.

- Document 26 (pages 122-125): Materials Catalogue dated 27 March 2009. The goods shown are described as 'Osborne' pins, t-shirts, ties, watches, umbrellas. The following sign is present at the top of each catalogue page:



11) This concludes my summary of the evidence insofar as I consider it necessary. The applicant also filed submissions which I will bear in mind but will not detail here.

DECISION

The legislation

12) Section 47 of the Act states:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground-

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

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

...

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Proof of use

13) The applicant’s mark was filed on 07 June 2001 and completed its registration procedure on 05 June 2002. As the registration date of the earlier mark is more than five years prior to the date of filing of the application for the declaration of invalidity, the earlier mark is subject to proof of use in accordance with Section 47(2A). The relevant part of the Act reads as follows:

47. –...

(2A)* But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2B) The use conditions are met if –

- (a) within the period of five years ending with the date of the application for the declaration 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) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

(2E) 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.

* *Note: Sub-sections 2A to 2E are an addition to the original Act, by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004 (SI 2004/946) which came into force 5th May 2004.*

14) Section 100 of the Act is also relevant and reads as follows:

“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.”

15) Accordingly, the onus is upon the registered proprietor to prove that it has made use of its mark, or that there are proper reasons for non-use.

Has there been genuine use within the relevant period?

16) In his witness statement, Mr Rivas states that it is his understanding that the relevant period for which genuine use must be proved is 12 June 2004 to 12 June 2009. Mr Rivas is mistaken. The relevant period for my assessment in the instant proceedings is the five year period ending on the date of filing of the application for declaration of invalidity, namely, **09 February 2005 to 08 February 2010**. The applicant is required to prove that during this period, and in relation to the relevant goods, there has been genuine use by it, or with its consent, of the earlier mark relied on in these proceedings. For reasons which will become apparent, Mr Rivas' error will not be detrimental to the applicant's case.

17) The requirements for “genuine use” have been set out by the Court of Justice of the European Union (“CJEU”) in the following judgements: *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”), *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”) and *Silberquelle GmbH v Maselli-Strickmode GmbH C-495/07* (“*Silberquelle*”). The principles established in these judgments have been conveniently summarised by Ms Anna Carboni, sitting as the Appointed Person, in BL O-371-09 *SANT AMBROEUS*:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle* where relevant:

- (1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].
- (2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].
- (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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].
- (4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].
 - (a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].
 - (b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].
- (5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].
- (6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

18) Taking account of this guidance, it is therefore clear that genuine use does not need to be quantitatively significant and, when considering whether the use is genuine, it is necessary to assess all surrounding circumstances.

19) Mr Rivas exhibits at ALR 2, a decision from the Office for Harmonisation in the

Internal Market (OHIM)(Decision No 000003310), in relation to a cancellation case (based on non-use) of the applicant's earlier mark relied upon in the instant case. Mr Rivas states, at paragraph 18 of his witness statement:

“...it is respectfully submitted that the UK IPO should reach the same decision as the OHIM in respect of the issue of proof of use”

20) The relevant five year period in the OHIM proceedings differs to that in the instant proceedings however, they do significantly overlap, and the evidence summary in that decision indicates that similar evidence to that filed in the instant case was submitted. OHIM largely dismissed the cancellation action, maintaining the registration for all goods in classes 16 and 25 and a portion of the goods in class 14. I am not bound to follow the decision of the Cancellation Division at OHIM but nor have I ignored it and I will keep it in mind when conducting my assessment in the instant case. In this regard I refer to the comments of Professor Ruth Annand, sitting as the Appointed Person in BL O/217/10, where she stated:

“35. The Hearing Officer rightly said that she was not bound to follow the decision of the Cancellation Division. However, that is not to say it should be ignored especially since the case involved essentially the same facts (*ZURICH PRIVATE BANKING*, BL O/201/04).”

21) In approaching the assessment of whether there has been genuine use of the earlier mark in the instant case, I will firstly establish whether there has been such use in relation to the applicant's goods in class 25. If the applicant can prove genuine use in relation to all, or even only some, of its goods in class 25 this will negate the requirement to also consider whether there has been genuine use in respect of classes 14 and 16. This is because the applicant's class 25 goods constitute its strongest case. If the grounds of invalidation under Section 5(1) and 5(2)(b) both fail in relation to the applicant's class 25 goods (whether this be for the current broad specification or a limited specification), the applicant can be in no stronger position in relation to any of its goods in classes 16 and 14 which are more dissimilar to those of the contested mark.

22) When discussing whether there has been genuine use, and for the sake of ease, I intend to refer to all forms of use of the mark (whether in the exact form it is registered or whether it is a variant form) as use of the OSBORNE mark(s), however, I will, of course, keep in mind the exact forms which have been used (specifically, those set out in the evidence summary) and will consider the issue of variant use later.

23) In his witness statement, Mr Rivas states, at paragraph 31, that the applicant's goods are sold “in the EC and, in particular, in Spain”. Numerous exhibits have been submitted in Spanish (with English translations), including invoices, certified statements and a catalogue dated 2005. However, two catalogues dated 2008 (document 13) and 2009 (document 26) showing use of the ‘OSBORNE’ mark in relation to ties, t-shirts and polo-shirts, are in the English language. On pages 15 and 17 of Exhibit ALR 1, it is explained that the reason these catalogues have been submitted in the English Language is that they show OSBORNE promotional material which is “to be sold mostly out of Spain and this is why the texts are worded

in English and why the expression “OSBORNE INTERNACIONAL” appears at the top left”. There is no further indication of exactly where these catalogues are distributed to outside of Spain. That said, as Mr Rivas refers to use “*in the EC and in particular, in Spain*” (my emphasis added) in his witness statement with no mention of any other nations outside the EC, this appears to indicate that the catalogues were intended for, at least, the English speaking territories within the EC. Whilst these exhibits intended to show use outside of Spain are far from overwhelming, when they are considered in conjunction with the comments of Mr Rivas, the ANDEMA certificate and the use shown in Spain, I am satisfied that the requirement of showing use in the EC has been satisfied.

24) Document 12 of exhibit ALR 1 shows photographs dated 7 July 2009 (being within the relevant period) of a variety of goods at point of sale bearing the OSBORNE mark. The mark is visible on socks, baseball caps, t-shirts and polo-shirts. The undated photographs in documents 1-4 are close-ups of t-shirts, polo shirts and baseball caps which clearly show the use of the word OSBORNE on the collars and labels of t-shirts and polo-shirts. These photographs appear to be very similar, if not identical, to the types of t-shirts, polo-shirts and baseball caps present in the dated photographs. Document 10 is an un-sworn statement and is therefore ‘hearsay’ evidence which, of itself, carries little weight. It states that a manufacturer in Spain has been supplying polo-shirts to the applicant company “under the “Osborne” trademark” since 2004. The figures indicate that in 2005 a total of 2490 polo shirts were supplied, in 2007 a total of 1564 polo-shirts were supplied, and in 2008 a total of 1008 polo shirts were supplied. The invoices at documents 20-22 also indicate that socks, ladies and gents shirts and t-shirts were manufactured and supplied to the applicant in 2008; the invoice showing supply of 396 shirts refers to “Osborne embroidery and label”; the invoice showing supply of 276 pairs of socks refers to “OSBORNE” under the heading ‘composition’; the invoice showing supply of 336 t-shirts refers to ‘Silk Screen printed mark: Osborne’ under the heading ‘description’. Further, documents 14 and 26 show use of the OSBORNE marks in catalogues dated 2005 and 2009 in relation to t-shirts, polo-shirts and baseball caps.

25) I bear in mind my comments regarding Document 10 being ‘hearsay’ however, when taking a *collective* view of *all* of the evidence, I am satisfied that the registered proprietor has made genuine use of its earlier mark in relation to *socks, baseball caps, t-shirts and polo-shirts* within the relevant period.

26) The evidence also shows use on, and in relation to, scarves and shawls. Document 14 showing a catalogue dated 2005 clearly shows the OSBORNE mark used on a scarf/shawl. Photographs in document 12 (although not dated) also clearly show use on scarves. The invoices dated 2006 present at documents 16-17 also show the supply of 174 scarves with the “OSBORNE” logo” and 100 shawls with “OSBORNE” and “Bull-Osborne” embroidery” to the applicant. Taking a *collective* view of the evidence, and whilst not all of it is dated, I am satisfied that there has been genuine use on *scarves and shawls* within the relevant period.

27) I now turn to consider if genuine use has been demonstrated in respect of *ties*. Document 9 is an un-sworn statement and is therefore ‘hearsay’ evidence. It states that a manufacturer supplied 1000 “Ties + cufflinks” to the applicant “under the “Osborne” trademark” in 2007. The photographs dated 7 July 2009 of ties at point of

sale in document 12 do not show use of the OSBORNE mark, however, documents 13, 14 and 26 consisting of catalogues dated 2008, 2005 and 2009 respectively all show use of the OSBORNE mark on pages showing ties. Whilst the catalogue pages do not show use of the mark on ties, there is use of the OSBORNE mark at the top of every page of the catalogue and upon other goods in the catalogue. Furthermore, there are no other trademarks present in the catalogues, either on the goods or on the catalogue pages. To this end, I note the comments of Daniel Alexander QC in *Aegon UK Property Fund Limited v The Light Aparthotel LLP* (BL O/472/11) where he stated (my emphasis added):

“...in considering whether use is in relation to given goods or services, the tribunal may take into account a number of factors, including whether the goods were in fact obtained from the proprietor, *the presence or absence of other branding on the goods*, how the goods were sold and so on.”

28) Accordingly, I conclude that the use of the OSBORNE mark on the catalogue pages showing ties is acceptable use *in relation to* ties. Further, whilst I am conscious that Document 9 is ‘hearsay’, I am satisfied that when viewing all of the aforementioned evidence *as a whole*, it is sufficient, in my view, to show that there has been genuine use in relation to *ties* within the relevant period.

29) In relation to *belts*, the evidence shows two photographs dated 7 July 2009 of belts bearing the OSBORNE mark at point of sale. Taking a collective view of the applicant’s evidence, and bearing in mind that there is no *de minimis* rule in terms of scale of use, I am satisfied that this use is not token. There has been genuine use on *belts* within the relevant period.

30) The evidence does not prove that there has been genuine use on any other goods in class 25. The evidence submitted in support of use on other items that would fall in this class is very thin. For example, there is evidence that aprons and wristbands were supplied to the applicant by manufacturers in 2006 and 2008 under, what is asserted to be, “the ‘Osborne’ trademark”, however, it is not clear which “Osborne” mark is being referred to and there are no images of the goods bearing the mark, or of the mark used in connection with the goods such as in catalogues or at point of sale, which would indicate that there has been real commercial exploitation of the mark on these goods. I am not satisfied that this evidence is sufficient to show genuine use.

31) In conclusion, the applicant has shown genuine use in the EC only for *socks, baseball caps, t-shirts, polo-shirts, scarves, shawls, ties and belts*.

Fair specification

32) Having established that the applicant has demonstrated genuine use in respect of *t-shirts, polo-shirts, socks, baseball caps, scarves, shawls, ties and belts*, I must now consider whether such use justifies the retention of the terms *Clothing, footwear, headgear: belts* listed in the class 25 specification of the earlier mark. In doing so, I keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 (“*Thomson*”) in relation to determining what constitutes a fair specification:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in Decon suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

33) The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 (“*Animal*”), are also relevant:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only

been use for three holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

34) I am also mindful of the guidance provided by the General Court (GC) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) ("ALADIN")* Case T-126/03:

"42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the

categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the subcategory or subcategories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

...

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

35) Finally, I also take account of the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

"... I adhere to the view that I have expressed in a number of previous

decisions. 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.”

36) I have already concluded that there has been genuine use in relation to *belts* and therefore this term can be retained.

37) The evidence has shown genuine use on a small number of other specific items rather than a wide breadth of goods. These items are *t-shirts, polo-shirts, baseball caps, socks, scarves, shawls* and *ties*. In this regard, I note the comments of Mr Justice Jacob in *Animal*, where he stated:

“34 I finally turn to other disputed items in Class 25. First “footwear.” The dispute is whether “casual” should qualify this. There has been use for casual shoes. It would seem to me here that it would be appropriate to cut the specification down to “casual footwear”—there is not the same breadth of use as for items of clothing. Next “headgear”, the only use has been in relation to knitted hats, fleece hats, and sun hats. The claimant wants to retain “headgear” in all its width, which would include all sort of headgear, for instance top hats, bowler hats and judges' wigs. Applying the Thomson test and I think “headgear” is too wide. The claimant offers no lesser specification and I accordingly accede to the defendant's suggestion to limit the specification to the three kinds of headgear for which use has been proved.”

38) Taking into account the above guidance, I conclude that genuine use in relation to *baseball caps* is not sufficient to retain the broad term *headgear*, which, as Mr Justice Jacob states, would include all manner of items such as top hats, bowler hats and wigs. Accordingly, it is my view that the term *headgear* is to be limited to the only subcategory for which use has been proved. To my mind, a fair description of the subcategory, taking into account the perception of the notional consumer, would be *caps*.

39) Similar considerations apply to the term *footwear*. This term would cover a diverse variety of footwear such as shoes, ski-boots and slippers. The applicant has only demonstrated use in relation to *socks*. To allow the applicant to retain the broad term *footwear* would be contrary to the guidance set out in *Thomson*. The term *footwear* is therefore to be limited to the only discrete subcategory of *footwear* for which use has been shown, namely, *socks*.

40) I now turn to consider the broad term *clothing*. This again is a broad term which would cover everything from tuxedos to boiler suits. The applicant has shown genuine use on *t-shirts, polo-shirts, scarves, shawls* and *ties*. Whilst I am conscious that a broad category may be retained even where use has not been shown on all items which would fall into said category (*Animal*), to my mind, the goods for which use has been shown in the instant case do not represent a broad spectrum sufficient to justify retention of the general term *clothing*. On the contrary, the goods for which

genuine use has been shown represent three subcategories of *clothing*. The first subcategory, in my view, is *casual tops* because, this is how I consider the “average, reasonably informed consumer” would collectively describe *t-shirts* and *polo-shirts*; the second is *scarves and shawls*; the third is *ties*.

41) Taking all of these findings into account, and bearing in mind my earlier comments at paragraph 21, the applicant’s specification is to be limited to read as follows, for the purposes of comparison with the registered proprietor’s goods:

Casual tops; socks; caps; scarves and shawls; belts; ties.

Variant Use

42) In order that my findings regarding a fair specification remain undisturbed, I must be satisfied that the variant use shown by the applicant is sufficient to demonstrate genuine use of the mark, as registered, across the range of goods listed in paragraph 31.

43) It is established case law that to qualify as genuine, use of a mark must be in the form registered or in a form which does not alter the distinctive character of the mark in the form in which it is registered. In *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc (BUD)* [2003] RPC 25, the Court of Appeal provided the following guidance on this issue:

“...The first part of the necessary inquiry is, what are the points of difference between the marks as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

44) I also refer to the decisions of Mr Richard Arnold QC, sitting as the Appointed Person, in *NIRVANA* (BL O/262/06) and in *REMUS* (BL O/061/08). In the latter case Mr Arnold QC stated:

“I do not consider that the subsequent developments discussed above undermine the correctness of the view which I articulated in *NIRVANA* 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...

‘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.”

45) The evidence has shown use of the following signs:

1) **OSBORNE**

2) OSBORNE

3)



4)

46) Sign 1) is the registered form of the applicant's mark and as such this is, of course, acceptable use. This mark has been shown on *t-shirts, polo-shirts, baseball caps* and *belts*.

47) The issue of variant use need only be considered in the event that the scope of such use would enable the applicant to retain a broader specification than that for which use of the mark as registered has been shown. Insofar as sign 2) is concerned, the use shown for this sign is more limited than for the mark as registered. This variant has been shown on the inside label of a *t-shirt* and a *baseball cap*. I have already stated that the mark, as registered, has been shown on *t-shirts* and *baseball caps* and as such it is not necessary to also consider use of the un-stylised variant mark. I will however briefly comment by stating that to my mind, use of this variant does constitute an acceptable variant of the registered mark. Both marks consist of the same word, albeit that the word is presented in a stylised font in the registered form and a standard font in the variant form. Whilst there is a noticeable visual difference between the mark as registered and the variant form, it is not to a degree which renders the marks different in terms of their distinctive character. To my mind, the distinctive character of both marks lies in the concept portrayed by the word OSBORNE; a concept which is likely to be perceived as a person's surname.

48) I now turn to signs 3) and 4). The former has been shown used on, and in relation to (on catalogue pages), *scarves and shawls, t-shirts, baseball caps, socks*. The latter has been shown on catalogue pages in relation to *ties* and *t-shirts*. In determining whether these are acceptable variants of the registered mark, I am mindful of the comments of the GC in *Castellblanch SA v OHIM. Champagne Louis Roederer SA* [2006] ETMR where the following was stated:

“33. In the contested decision the Board of Appeal found that there is no precept in the Community trade mark system that obliges the opponent to prove the use of his earlier mark on its own, independently of any other mark. According to the Board of Appeal, the case could arise where two or more trade marks are used jointly and autonomously, with or without the name of the manufacturer’s company, as is the case particularly in the context of the automobile and wine industries.

34. That approach must be followed. The situation is not that the intervener’s mark is used under a form different to the one under which it was registered, but that several signs are used simultaneously without altering the distinctive character of the registered sign. As OHIM rightly pointed out, in the context of the labelling of wine products joint affixing of separate marks or indications on the same product, in particular the name of the winery and the name of the product, is a common commercial practice.”

49) Applying the above guidance and, bearing in mind that it is a common commercial practice in the clothing industry to use joint trademarks to denote different ranges of goods, I am satisfied that the use of signs 3) and 4) are examples of acceptable variant use of the mark as registered. Both of the said marks contain the exact representation of the mark as registered together with other matter which does not alter the distinctive character of the mark **OSBORNE**. Insofar as sign 3) is concerned, this has the appearance of being two marks (being the device of a bull and the mark as registered) used “jointly and autonomously”. The only difference between sign 4) and sign 3) is the addition of the word 'Internacional' which is purely descriptive of the provider of those goods operating on an international basis and thus, this also has the appearance of joint use of essentially two distinctive marks, one being the bull and the other the word **OSBORNE**.

50) In light of my findings concerning variant use, my earlier conclusions regarding a fair specification remain undisturbed. I will therefore proceed to consider the grounds of invalidation brought under Section 5(1) and 5(2)(b) of the Act on the basis that the earlier mark’s specification is to be limited to read as follows:

Casual tops; socks; caps; scarves and shawls; belts; ties.

Section 5(1)

51) This section of the Act states:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

52) In *S.A. Societe LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00 [2003] FSR 34 (CJEU) it was held:

“52...the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be



reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between the signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of the goods or services in question (see to that effect, Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, para.26).

...

54...a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer”

Comparison of marks under Section 5(1)

53) For ease of reference, the respective marks are:

Applicant’s mark	Registered Proprietor’s mark
	

54) The applicant’s mark consists of the stylised word, **OSBORNE**. The registered proprietor’s mark consists of the same word, but in a standard font, presented as **OSBORNE**.

55) In light of both marks consisting of the same word, they are clearly phonetically identical. The stylisation in the applicant’s mark does not attribute the mark with any other, or additional, immediately graspable concept to that portrayed by the word **OSBORNE** alone, thus the marks are also conceptually identical. Turning to the visual aspect, the respective marks differ in the manner they are presented. However, the question is whether the difference is so insignificant that it is likely to go unnoticed by the average consumer. Whilst I am conscious that imperfect recollection is a factor which I must bear in mind, I have reached the conclusion that the visual impressions portrayed by the respective marks are sufficiently different to render the marks non- identical. The registered proprietor’s mark is in a very plain, standard font whereas the applicant’s mark is in a more stylised, embellished font. To my mind, this is a difference which is unlikely to go unnoticed. **Accordingly, the ground of invalidation based upon Section 5(1) of the Act fails.**

Section 5(2)(b)

56) This section of the Act states:

- “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.”

57) The leading authorities which guide me are from the CJEU: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,

(f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*,

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(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; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

Comparison of goods

58) In making an assessment of the similarity of the goods, all relevant factors relating to the goods in the respective specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro- Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“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.”

59) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

*“(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.”*

60) I also bear in mind the comments in *Gérard Meric v OHIM*, Case T-133/05, where the GC held:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark”

61) In the instant case, the goods to be compared are:

Applicant’s goods	Registered Proprietor’s goods
Class 25: <i>Casual tops; socks; caps; scarves and shawls; belts; ties.</i>	Class 25: <i>Articles of clothing, footwear and headgear; formal shirts, shirts, ties.</i>

62) The applicant’s *Casual tops; socks and caps* fall within the broader terms *Articles of clothing, footwear and headgear* in the registered proprietor’s specification, respectively. These goods are therefore identical.

63) The respective specifications both include *ties*; these are self-evidently identical.

64) The registered proprietor’s *shirts* would include casual shirts which are covered by the applicant’s term *casual tops*. These goods are also identical.

65) The registered proprietor’s *formal shirts* are similar to a good degree to the applicant’s *casual tops*. Whilst *formal shirts* are usually intended for smart or formal occasions and *casual tops* for more informal occasions, they are highly similar in nature and purpose in that both are intended to adorn the upper part of the person. They are also likely to share the same trade channels as many retailers commonly stock a variety of formal and informal clothing. The applicant’s *ties* are also similar to a good degree to the registered proprietor’s *formal shirts*. These goods are likely to be sold in close proximity to one another in retail establishments and are often worn together as part of a formal look.

Average consumer and the purchasing process

66) It is necessary to consider these matters from the perspective of the average consumer of the goods at issue (*Sabel BV v. Puma AG*). The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods.

67) The average consumer for both parties’ goods is the general public. The goods will vary greatly in price; the cost being dependent on factors such as their quality and the material from which they are made. The consumer may try on items to ensure that they are the correct fit and/or suitable for the intended purpose and occasion. A reasonable level of attention will therefore be paid to their purchase, but it will not be at the highest level. The purchasing act will be primarily visual as the goods in question are commonly bought based on their aesthetic appeal. However, I do not disregard aural considerations that may come into play.

Comparison of marks under Section 5(2)

68) In making a comparison between the marks under Section 5(2)(b) of the Act, I must take account of their visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*). However, I must not engage in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details. The respective marks have been set out at paragraph 53.

69) Both marks consist solely of a single word and thus the dominant and distinctive element of each mark lies in its totality. I have already concluded that, as a consequence of the same seven letter word being present in both marks, the marks are aurally and conceptually identical, with the concept portrayed likely to be that of a person's surname. The difference between the marks lies in the manner in which they are presented. The applicant's mark is presented in a more elaborate font than the registered proprietor's mark which results in a degree of visual dissimilarity. Nonetheless, there still remains a very high degree of visual similarity by virtue of both marks containing identical words.

70) In summary, I have found that the respective marks share a very high degree of visual similarity, and that they are aurally and conceptually identical. Overall there is an extremely high degree of similarity between the respective marks.

Distinctive character of the earlier mark

71) I must consider the distinctive character of the applicant's earlier mark. The more distinctive it is, either by inherent nature, or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE) Case T-79/00 [2002] ETMR 91*).

72) I have already concluded that the earlier mark is likely to be perceived as a person's surname. As such, whilst it does not enjoy the highest level of distinctive character in the way that an invented word does, it is nonetheless possessed of a reasonably high degree of inherent distinctive character. This is because the mark is not descriptive, allusive or suggestive of the goods in any way.

73) Earlier in this decision, I concluded that the mark has been used in Spain but there was also evidence to indicate that it had also been used in other countries within the EC, although the exact identity of those countries was unclear. It follows that the evidence is not sufficient to conclude that the mark has been used in the UK to an extent that it has acquired an enhanced degree of distinctive character. However, as the mark is inherently distinctive to a reasonably high degree, my conclusions with regard to a lack of enhanced distinctiveness will not alter my findings in respect of a likelihood of confusion which follow.

Likelihood of confusion

74) In determining the likelihood of confusion, I must take the global approach advocated by case law (*Sabel BV v. Puma AG*). I must also take account that the consumer rarely has opportunity to compare marks side by side but rather must rely on the imperfect picture of them that he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

75) In the instant case, I have found that the respective marks share a very high degree of visual similarity, and that they are aurally and conceptually identical. The combination of these factors results in an extremely high degree of similarity overall. I have concluded that the registered proprietor's goods are identical to the applicant's, with the exception of *formal shirts*, which are nevertheless similar to a good degree to the applicant's *casual tops* and *ties*. The average consumer of both parties' goods will be the general public who are likely to pay a reasonable level of attention during the purchasing act which is likely to be primarily visual. I have also found that the applicant's mark enjoys a reasonably high degree of inherent distinctive character.

76) Having taken into account all of the above factors, I have no hesitation in concluding that there is a likelihood of confusion on the part of the average consumer. In reaching this view I have taken account that the respective goods are either identical or similar to a good degree and that both marks consist of exactly the same word. Furthermore, I have borne in mind that in the clothing/fashion industry it is commonplace for a mark to be used in a variety of fonts to denote different ranges of goods or to reflect changes in trend.

77) The ground of invalidation based upon Section 5(2)(b) of the Act is, therefore, successful in its entirety.

COSTS

78) The application for invalidation having been successful, Grupo Osborne S.A. is entitled to a contribution towards its costs. I take account that no hearing has taken place but that the applicant filed evidence and written submissions in lieu. I award costs on the following basis:

Preparing the application for a declaration of invalidation (including the official fee) and considering other side's counterstatement	£500
Preparing and filing evidence	£500
Written Submissions	£300
TOTAL	£1300

79) I order Debenhams Retail plc to pay Grupo Osborne S.A. the sum of £1300. 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 27th day of September 2012

**Beverley Jones
For the Registrar,
the Comptroller-General**