

O-036-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2596856

BY

NUTTERS (HOLDINGS) LTD

TO REGISTER THE TRADE MARK:

TOMMY NUTTER

IN CLASS 25

AND

THE OPPOSITION THERETO

UNDER NO 102807

BY

TOMMY HILFIGER LICENSING, LLC

1) On 5 October 2011 Nutters (Holdings) Ltd (Holdings) filed an application to register **TOMMY NUTTER** as a trade mark. The application was published for opposition purposes on 28 October 2011 with the specification:

clothing; footwear; headgear; underclothing; nightwear; socks; swimwear; scarves; belts; braces; suspenders; gloves; men's formal wear; suits; blazers; jackets; sports jackets; formal jackets; trousers; formal trousers; shirts; formal shirts; dress shirts; ties; coats; raincoats.

The above goods are in class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) Tommy Hilfiger Licensing, LLC (Hilfiger) filed a notice of opposition. Hilfiger relies upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act).

3) Section 5(2)(b) of the Act states:

~~2)~~ A trade mark shall not be registered if because -
.....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Section 5(3) of the Act states:

~~3)~~ A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

Section 5(4)(a) of the Act states:

~~4)~~ A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented——

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade”.

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

—The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

4) In relation to sections 5(2) and 5(3) of the Act, Hilfinger relies upon two trade mark registrations:

- United Kingdom trade mark registration no 2292693 of the trade mark TOMMY. The application for registration was filed on 14 February 2002 and the registration procedure was completed on 29 July 2005. It is registered for:

clothing, footwear, headgear; clothing for men, women and children; shirts, golf shirts, T-shirts, sweatshirts, tank tops, sweaters, jerseys, turtle-necks; shorts, sweatpants, warm-up suits, pants, trousers, jeans, skirts, suits, overalls; blazers, sport coats, vests, waistcoats, jackets, coats, parkas, ponchos; swimwear, bikinis, swim trunks; overcoats, rain wear, wind resistant jackets; sleepwear, pyjamas, robes, bathrobes; underwear, lingerie, hosiery, boxer shorts, socks; hats, wool hats, caps, visors, scarves, head bands, ear muffs; wristbands; shoes, boots, sneakers, beach shoes, sandals, slippers; gloves; cloth bibs; ties; belts; suspenders (braces);

The above goods are in class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. As the trade mark had been registered for five years or more at the date of the publication of the application, it is subject to proof of genuine use¹. Hilfiger claims that genuine use of the trade mark had been made for all of the goods of the registration for the period of five years ending with the date of publication of the application, ie from 29 October 2006 to 28 October 2011. Hilfiger claims, for the purposes of section 5(3) of the Act, that the trade mark had a reputation for all of the goods of the registration.

- Community trade mark registration no 2922250 of TOMMY.COM. The application for registration was filed on 6 November 2002 and the registration procedure was completed on 6 July 2007. The trade mark is registered for:

clothing for men, women and children, shirts, golf shirts, t-shirts, sweatshirts, tank tops, sweaters, jerseys, turtle-necks, golf shirts, shorts, sweatpants, warm-up suits, blazers, sport coats, pants, jeans, skirts, suits, overalls, vests, jackets, sleepwear, robes, underwear, lingerie, boxer shirts, belts, ties, hats, wool hats, caps, visors, scarves, headbands, earmuffs, wristbands, bathrobes, boxer shorts, pajamas, cloth bibs, ties, socks, hosiery, shoes, boots, sneakers, beach shoes, sandals, slippers, gloves, and suspenders;

computerized on-line retail store services in the fields of apparel, household accessories, cosmetics, eyewear, music and entertainment, and related accessories; mail order catalog services featuring apparel, household accessories, cosmetics, eyewear, records, compact discs, cassettes, videos, books, art pictures, photos, cards, calendars, posters, prints, stickers and cartoon prints, and related accessories; promoting the goods and services of others in the fields of fashion, music and entertainment by preparing and placing advertisements, in an electronic magazine, accessed by a global network;

providing an Internet information platform in the field of fashion, lifestyles, music and entertainment and other topics of general interest.

The above goods and services are in classes 25, 35 and 42 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. In relation to section 5(2)(b) of the Act Hilfiger relies upon the goods and services of classes 25 and 35. In relation to section 5(3) of the Act, Hilfiger claims that it has a reputation in respect of all of the goods and services of the registration.

5) In relation to section 5(3) of the Act, Hilfiger claims that it has used the trade mark TOMMY throughout the United Kingdom either alone or as part of the trade mark TOMMY HILFIGER since 1997. It claims that potential customers would be misled into thinking that Holdings' products originated from Hilfiger. Hilfiger claims that any variation of the quality of the goods sold by Holdings under its trade mark could be detrimental to its reputation. It claims that confusion could also lead to loss of sales for Hilfiger. Hilfiger claims that, as a result, use of the trade mark of Holdings would take unfair advantage of and be detrimental to the distinctive character and repute of its trade marks. Hilfiger does not claim any use of the trade mark TOMMY.COM in its grounds of opposition.

6) In relation to section 5(4)(a) of the Act Hilfiger claims that it has used the sign TOMMY since 1997 in the United Kingdom either alone or as part of TOMMY HILFIGER for clothing, footwear and headgear. It claims that it has acquired a valuable reputation and goodwill in the sign TOMMY. Hilfiger claims that use of the trade mark of Holdings is liable to lead to a misrepresentation to potential customers so that the products of Holdings are linked to those of Hilfiger; leading to potential damage to the reputation of Hilfiger and loss of sales.

7) Holdings filed a counterstatement. It admits that the class 25 goods of the earlier trade mark registrations are identical to the goods of its application. It denies that its trade marks are similar to those of Hilfiger. Holdings denies that the TOMMY and TOMMY.COM trade marks —~~share~~ any reputation in the trade mark TOMMY HILFIGER. It denies that use of TOMMY HILFIGER engenders rights in the sign TOMMY for the purposes of the law of passing-off.

8) Initially Holdings did not request proof of use of the United Kingdom trade mark. On 14 June 2012 it requested proof of use of this trade mark. Part of Hilfiger's evidence had been filed but an extension of time had been granted for Hilfiger to file further evidence. The request for the amendment of the counterstatement, so that proof of use was required, was granted by the Intellectual Property Office.

9) Only Hilfiger filed evidence. Hilfiger filed written submissions. Holdings filed two sets of written submissions.

Evidence of Hilfiger

Witness statement of David Pyne of 15 May 2012

10) Mr Pyne is the United Kingdom country manager for Tommy Hilfiger UK Limited (UK), part of the Tommy Hilfiger group that includes Hilfiger.

11) Mr Pyne states that Hilfiger has sold products under the trade marks TOMMY and TOMMY HILFIGER in the United Kingdom since 1997, when it opened a store in Sloane Street. He states that products bearing the two trade marks have

been sold throughout the United Kingdom. Mr Pyne states that Hilfiger currently has 125 shops and retail and wholesale customers throughout the United Kingdom. He states that customers throughout the United Kingdom can view Hilfiger's products on the websites tommyhilfiger.co.uk and <http://europe.tommy.com>. Hilfiger's wholesale and retail net sales (excluding VAT) have been:

2004/05	£19,635,000
2005/06	£26,128,000
2006/07	£20,616,000
2007/08	£25,990,000
2008/09	£35,020,000
2009/10	£37,949,000
2010/11	£41,799,000
2011/12	£55,074,000

(up to February 2012)

12) Exhibited at DP2 are copies of invoices. The only invoice that has a reference to TOMMY without HILFIGER is exhibited at pages 20 and 21, it was issued on 27 March 2011 by Tommy Hilfiger Europe BV – Childrenswear Division to the Celtic Manor Resort in Newport, South Wales. Upon the invoice the following appears: —~~tommy~~ polo s/s” and —~~tommy~~ vn sweater l/s”.

13) Mr Pyne states that Hilfiger spent the following in promotion of goods bearing the two trade marks:

2004	€917,027
2005	€1,740,000
2006	€1,198,251
2007	€2,236,520
2008	€2,062,000
2009	€1,351,000
2010	€2,209,000

14) Mr Pyne states that goods bearing the two trade marks have been advertised and promoted in a wide variety of ways; including advertising hoardings, point of sale promotions, magazine advertisements, bus advertisements and via its websites. Exhibited at DP3 are copies of pages from *Harper's Bazaar* of September 2010 and *Elle* of September 2009. The pages show use of:

TOMMY  HILFIGER

At the top of the two pages TOMMY.COM appears. Copies of covers for *Vogue* for March (year unknown) and *Elle* for March 2010 are exhibited; no trade mark of Hilfiger appears on the pages exhibited.

15) Exhibit DP4 contains pictures of advertising upon hoardings and on London buses all of which bear the trade mark:

TOMMY  HILFIGER

or HILFIGER.

16) Exhibit DP5 contains pictures of advertising on London buses, London taxis, and at tube stations. The trade mark shown on the advertising is:

TOMMY  HILFIGER


At page 65 the advertisement on the London bus includes the words —SHOP TOMMY.COM” (it is indicated that this bus campaign began on 5 September 2011).

17) Mr Pyne states that exhibit DP6 shows the history of Hilfiger. For the most part the pages are illegible. The trade mark:

TOMMY  HILFIGER

can be seen be seen on the pages.

18) Exhibit DP7 consists of examples of press clippings:

- A promotion from *FHM* for a joint promotion between Hilfiger and USC. TOMMY HILFIGER is used in the promotion.
- A page from *Evening Standard* of 15 September 1999. Most of the page is illegible. The headline reads —Sticcko T-shirts Tommy, fashion’s out of your league”.
- An article from the *Herald Tribune* of 16 September 1999 in which there is a reference to TOMMY HILFIGER; most of the article is illegible.
- An article from the *Herald Tribune* of 18 September 1999. Parts of the article are illegible. There is a reference to TOMMY HILFIGER and to —an American eagle logo with the words —Tommy Rocks”.
- A page from *The Independent* of 22 September 1999. Most of the page is illegible. At the bottom of the page TOMMY HILFIGER with an address in Fulham appears.
- A page from *The Independent* of 16 September 1999 in which there are references to —Hfiger’s cowgirls”, TOMMY HILFIGER and HILFIGER. Parts of the article are illegible.
- Pages from *GQ* for June 1999. On the cover there is a reference to Hilfiger & Schumacker. The cover also bears the legend ~~in~~ association with **TOMMY  HILFIGER**”. Inside the magazine a section headed —elements of style” is dedicated to TOMMY HILFIGER. The article is

headed "TomTomclub". There is reference to TOMMY aftershave. In the article Mr Hilfiger is referred to on a number of occasions as Tommy.

- An article from *FHM* of January 2000 headed "Q&A Tommy Hilfiger". Parts of the article are illegible. The following appears:

"I love cars too, but a Tommy car would be a little funny. We had an idea in the office that designers should make condoms would you fancy making one so people can say – I did it with a Tommy?"

Witness statement of Helene Michelle Whelbourn of 15 June 2012

19) Ms Whelbourn is a trade mark attorney acting for Hilfiger.

20) Ms Whelbourn exhibits at HMW1 a list of advertisements and press releases from January 2011. Publications listed include *Elle*, *Grazia*, *FHM*, *GQ*, *Harper's Bazaar* and *Marie Claire*. A selection of the advertisements and press releases is also exhibited; all references in the advertisements are to TOMMY HILFIGER. Exhibit HMW2 consists of a list of advertisements and press releases for February 2011. In *The Guardian* of 15 February 2011 an article is headed "Tommy's rock opera Hilfiger harks back to days when supergroups ruled". There are various references to TOMMY HILFIGER in the article and also the following: "The new collection is entitled Bohemian Prep and is meant as a riff on the Tommy aesthetic". An article from red.co.uk of 14 February in which there is a reference to "Tommy H" and "Tommy girls", as well as to TOMMY HILFIGER. An article from stylist.co.uk of 15 February in which there are references to TOMMY HILFIGER and a reference to "the backstage area at Tommy". In an extract from *The Guardian* of 14 February as well as a reference to TOMMY HILFIGER the following appears: "The Tommy label excels at all things preppy". Exhibits HMW3 and HMW4 are lists of advertisements from March and April 2011 (respectively) and copies of some of the advertisements. All references in the advertisements and press releases exhibited are to TOMMY HILFIGER. Exhibit HMW5 is a list of advertisements and press releases from May 2011 and a selection of the advertisements and press releases. An article from *Grazia* of 13 May 2011 is headed "It's totty at Tommy!" There is then a reference to a TOMMY HILFIGER launch. An article from *Retail Week* from May 2011 begins "TOMMY BOY Luxury label Tommy Hilfiger...". A page downloaded from Aizak Buyondo Blog from 9 May 2011 where "Tommy Preppy pop up shop" appears, above this in larger print "Get prepped up at Tommy Hilfiger Preppy pop up store!". The piece goes on to refer to the "Tommy Preppy pop up house" and refers to the "quirky Tommy twist". A page downloaded from *Harper's Bizarre Online* of 6 May 2011 refers to "Tommy's preppy pop-up". The article refers to TOMMY HILFIGER. The following also appears "Today Tommy on tour has set up shop in the East Piazza in Covent Garden for a ten day stint". Further lists of advertising and press releases and examples thereof are exhibited for June, July, August and September 2011 (HMW6 – HMW9). The goods shown are all described as being from TOMMY HILFIGER. On page 81 there is a reference to

tommy.com, on page 82 to tommyhilfinger.com, on page 85 there is a reference to tommy.com.

Witness statement of Helene Michelle Whelbourn of 10 August 2012

21) Exhibited at HMW10 is a press positioning report from Nielsen in relation to advertisements run from 1 January 2011 to 31 December 2011. Ms Whelbourn describes this as an overview of TOMMY advertisements. In fact the brand in all of the advertisements is identified as TOMMY HILFIGER.

22) Ms Whelbourn describes exhibit HMW11 as showing swing tags showing use of TOMMY on its own. In some of the pictures TOMMY on its own cannot be seen. On others the trade mark **TOMMY HILFIGER** can be seen but not TOMMY on its own. Pages 10 and 20 appear to show the same pictures. Page 11 shows a label shown on pages 10 and 20. No trade mark can be seen in the picture on page 12. Pages 13 14, 15 16, 18 and 19 do not show TOMMY on its own. The examples of use of TOMMY can be seen as follows:

- Swing tag for TOMMY mini knit (page 17). tommy.com appears on the label. The label bears a copyright year of 2011 and is marked Europe. There is no indication of the provenance of the label by date or location, other than Europe.
- Three swing labels (page 20) showing GBP upon them. One label is for TOMMY black California jacket. A label which is for HILFIGER denim and bears the words TOMMY black. The final label is for new TOMMY knit LS. There is no indication as to the dates from when the labels emanate.

The labels do not have clear provenance by both date and jurisdiction.

23) Ms Whelbourn states that exhibit HMW12 is an advertising report for the 2011 United Kingdom campaign which —strongly features the —SHOP TOMMY.COM” slogan”. The report was compiled by Nielsen. The advertisements ran from 1 March 2011 to 2 December 2011. The advertisements shown on pages 40, 41, 42, 43 and 45 were seen after 28 October 2011 ie after the dates of application and publication. The advertisements show pictures of people. At the bottom of the advertisement there is a bar. On the right hand side of the bar the trade mark **TOMMY HILFIGER** appears and on the left hand side —shop tommy.com”. The rubric from Nielsen in relation to the advertisements states that the advertisements promote TOMMY HILFIGER or a particular range of goods by TOMMY HILFIGER (in one case it refers to promotion of Prep World Pop-Up). There is reference in the rubrics to —Reply by Web, www.tommy.com” or, on one occasion —Reply by Telephone, www.tommy.com”.

24) Ms Whelbourn states tht exhibit HMW13 is a list of style names used by Hilfiger in 2010/2011. The styles referred to are —Tommy fitted polo”, —Tommy

Regular Polo” and “Tommy Washed Fitted Polo”. So all of the styles referred to are polo shirts. There is no indication as to actual sales within the United Kingdom or to which jurisdiction(s) the list relates.

25) Ms Whelbourn states that exhibit HMW14 shows examples of how TOMMY is used on various items of apparel. Page 51 shows a design for t-shirts which bear TOMMY above denim. The rubric states that they are for “ALL 12” and so would not have been on the market prior to 28 October 2011. Page 53 appears to show a picture of one of the t-shirts, the design of which is at page 51. Page 54 shows a woman’s top with TOMMY JEANS on an arm. There is no indication as to when or where this was put on the market. Page 55 appears to show the same top, in a different colour, with TOMMY JEANS on the back. Again there is no indication as to when and where the top was put on the market. Page 56 shows a bag, so not an item of clothing. There is no indication as to where and when this bag was put onto the market.

Findings of fact

26) In relation to sections 5(2)(b) and 5(3) of the Act, the material dates are the dates of the filing of the application of Holdings, 5 October 2011. In relation to proof of use of registration no 2292693, Hilfiger must establish genuine use of the trade mark TOMMY during the period from 29 October 2006 to 28 October 2011.

27) A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20, 1993. This was the subject of consideration by the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07, in which the GC stated:

—50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.”

The reasoning of the GC, *mutatis mutandis*, is followed in relation to the Act. As there is neither evidence nor indication of the use of the trade mark of Holdings, it is not necessary to consider a date other than the date of application which

relates to the behaviour complained of. The material date for the purposes of section 5(4)(a) of the Act is 5 October 2011.


28) The evidence of use of the trade marks/sign upon which Hilfiger rely must be identifiable as being relevant to the material periods and to jurisdiction. In the case of TOMMY.COM, the reputation claimed for the purposes of section 5(3) must be in the European Union. However, as per *PAGO International GmbH v Tirol Milch registrierte Genossenschaft mbH* Case C-302/07ⁱⁱ, reputation in one member state may be sufficient to establish the requisite reputation.

29) The evidence of Mr Pyne exhibits the invoices of 27 March 2011 from the Childrenswear Division to the Celtic Manor Resort for goods which are described as —tommy polo s/s” and —tommy vn sweater l/s”. The invoice is for 80 items in all (DP2). The copies of pages from *Harper’s Bazaar* of September 2010 and *Elle* of September 2009 show use of TOMMY.COM at the tops of the pages (DP3). An advertisement on a London bus, for a campaign that begun on 5 September 2011, has the legend SHOP.TOMMY.COM (DP5). In the copies of press coverage (DP7) there is a reference to TOMMY aftershave (*GQ* for June 1999) and Mr Hilfiger comments on a Tommy car and the journalist to a Tommy condom (*FHM* of January 2000).

30) The summary of the evidence of Ms Whelbourn’s first witness statement is given at paragraph 20. In total there are eight pieces referring to TOMMY. In all of the pieces there is reference to TOMMY HILFIGER. The pieces are, of their nature, journalese. There is nothing to suggest that the use of TOMMY in the context of the pieces was with the consent of the proprietor. None of this use is in the form of advertisements. Also in the evidence of Ms Whelbourn are copies of pages from *Elle* of June 2011 and *The Financial Times* of 27 August 2011, tommy.com is given for contact purposes.

31) Owing to the lack of identification by date and/or jurisdiction, the second witness statement of Ms Whelbourn is of little assistance to Hilfiger in relation to claims of use of TOMMY on its own; despite Hilfiger stating in its written submissions that this second witness statement —~~as~~ filed with a view specifically to show use of the trade mark TOMMY subject of UK registration No. 2292693”. Exhibit HMW12 does show use of SHOP TOMMY.COM in a number of advertising campaigns in 2011 in the United Kingdom.

32) In considering use of TOMMY on its own it is necessary to bear in mind that, in relation to genuine use of a trade mark, that use must be by the proprietor or with its consent. Use in a press article, even if prompted by a PR department, is not necessarily use by the proprietor or with its consent per se; if it is use with the consent of the proprietor in such a context that is a matter of evidence. Use in an advertisement is by its nature use by the proprietor or with its consent; as it will have the final say in the copy.

33) In its submissions Hilfiger claims that use of TOMMY HILFIGER and use of **TOMMY  HILFIGER** is use of TOMMY. In relation to the latter trade mark Hilfiger submits that the presence of the device between TOMMY and HILFIGER means that TOMMY and HILFIGER are separate trade marks. Use of TOMMY HILFIGER is not use of TOMMY on its own, nor is use of TOMMY in the word and device trade mark; they are simple facts. In relation to proof of genuine use the issue is whether use in the two forms which Hilfiger prays in aid is use in a form which does not alter the distinctive character of the mark in the form in which it was registered. In *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25 Lord Walker stated:

—43 have no wish to be overcritical of the way in which the deputy judge expressed himself, especially since I think he was a little overcritical of the way in which the hearing officer had expressed himself. But I am inclined to think that the deputy judge made the issue rather more complicated than it is. The first part of the necessary inquiry is, what are the points of difference between the mark 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 The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

"Bare ruin'd choirs, where late the sweet birds sang"

is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vaultlike trees in winter, and the dissolution of the monasteries).

45 Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of "whose eyes?-- registrar or ordinary consumer?" is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgment, to analyse the "visual, aural and conceptual" qualities of a mark and make a "global appreciation" of its likely impact on the average consumer, who "normally perceives a mark as a whole and does not proceed to analyse its various details."

In *Boura v Nirvana Spa & Leisure Ltd* BL O/262/06 Mr Richard Arnold QC, sitting as the appointed person, stated:

—15It is clear from BUD and BUDWEISER BUDBRÄU and the four Court of First Instance cases that the normal approach to the assessment of distinctive character applies in this context. As the European Court of

Justice has reiterated in numerous cases, the distinctive character of a trade mark must be assessed (i) in relation to the goods or services in question and (ii) according to the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect.”

He went on to state:

—34The 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.”

In *Atlas Transport GmbH v Harmonisierungsamt für den Binnenmarkt (Marken, Muster und Modelle)* (HABM) the GC held:

—42Aus alledem ergibt sich, dass die zusätzlichen Elemente der Briefköpfe der von der Klägerin vorgelegten Rechnungen nicht als ein untrennbar mit dem Element „Atlas Transport—verbundenes Ganzes angesehen werden können, dass sie eine untergeordnete Stellung im Gesamteindruck einnehmen, den die streitige Marke so, wie sie in den Briefköpfen benutzt wurde, hervorruft, und dass die meisten von ihnen eine schwache Unterscheidungskraft haben. Folglich ist entgegen den Ausführungen der Beschwerdekammer in der angefochtenen Entscheidung die Unterscheidungskraft der eingetragenen Marke bei ihrer Benutzung auf den zu den Akten gereichten Rechnungen nicht im Sinne von Art. 15 Abs. 2 Buchst. a der Verordnung Nr. 40/94 beeinflusst worden.”


In *Fruit of the Loom, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-514/10 the GC stated:

—28It must be observed that Article 15(1)(a) of Regulation No 207/2009 relates to a situation where a national or Community registered trade mark is used in trade in a form slightly different from the form in which registration was effected. The purpose of that provision, which avoids imposing strict conformity between the form of the trade mark used and the form in which the mark was registered, is to allow its proprietor in the commercial exploitation of the sign to make variations which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services

concerned. In accordance with its purpose, the material scope of that provision must be regarded as limited to situations in which the sign actually used by the proprietor of a trade mark to identify the goods or services in respect of which the mark was registered, constitutes the form in which that same mark is commercially exploited. In such situations, where the sign used in trade differs from the form in which it was registered only in insignificant respects, and the two signs can therefore be regarded as broadly equivalent, the abovementioned provision envisages that the obligation to use the trade mark which was registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade. However, Article 15(1)(a) does not allow the proprietor of a registered trade mark to avoid his obligation to use that mark by relying on his use of a similar mark covered by a separate registration (Case T-194/03 *Il Ponte Finanziaria v OHIM – Marine Enterprise Projects (BAINBRIDGE)* [2006] ECR II-445, paragraph 50).

29 Thus, a finding of an alteration of the distinctive character of the mark as registered requires an assessment of the distinctive and dominant character of the added elements, carried out on the basis of the intrinsic qualities of each of those elements, as well as of the relative position of the different elements within the arrangement of the trade mark (see judgment of 10 June 2010 in Case T-482/08 *Atlas Transport v OHIM – Hartmann (ATLAS TRANSPORT)*, not published in the ECR, paragraph 31 and the case-law cited).”

34) In relation to the underlined part of *Fruit of the Loom* above, Hilfiger is not precluded from relying on use of the trade mark in a form which differs from the form in which it was registered, without the differences between the two forms altering the distinctive character of that trade mark, even though that different form is itself registered as a trade markⁱⁱⁱ.

35) The distinctive character of TOMMY lies in the one word, which will normally be seen as a forename. TOMMY HILFIGER will be seen by the average consumer, owing to the presence of the forename at the beginning, as a full name. As a full name it has an indissoluble entity (see *Atlas Transport*). The presence of the device between TOMMY and HILFIGER in **TOMMY  HILFIGER**, owing to the forename surname construction, will be seen as a full name by the average consumer. It will not be seen as two or three separate trade marks. HILFIGER is an unusual surname and highly distinctive. The addition of HILFIGER or device and HILFIGER alter the trade mark TOMMY immensely. HILFIGER becomes the more/most distinctive component. The two forms of the trade mark upon which Hilfiger prays in aid do alter the distinctive character of the trade mark TOMMY in the form in which it was registered. Hilfiger cannot rely upon them.

36) Hilfiger adduced no evidence as to the turnover of goods using the trade mark TOMMY. With computerised accounting this should have been a relatively easy task. The actual evidence of sales of goods described as TOMMY and used by the proprietor or with its consent, which can be identified in the jurisdiction and material period, rests on one invoice from the Childrenswear Division to the Celtic Manor Resort on 27 March 2011. This is for 80 items of clothing, polo shirts and sweaters. There is nothing to indicate what trade mark appeared on the items of clothing. However, this use is to a third party and so is external use of the trade mark in relation to some of the goods of the specification.

37) The Court of Justice of the European Union (CJEU) in *Ajax Brandbeveiliging BV v Ansol BV* Case C-40/01 considered what is meant by genuine use of a trade mark. It held:

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 the GC stated:

—32To examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. In addition, the turnover and the volume of sales of the product under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market. As a result, the Court has stated that use of the earlier mark need not always be quantitatively significant in order to be deemed genuine. Even minimal

use can therefore be sufficient to be deemed genuine, provided that it is viewed as warranted in the economic sector concerned in order to maintain or create a share in the market for the goods or services protected by the mark (*VITAFRUIT*, paragraph 27 above, paragraph 42, and *LA MER*, paragraph 26 above, paragraph 57; see, by analogy, *Ansul*, paragraph 24 above, paragraph 39, and the order in Case C-259/02 *La Mer Technology* [2004] ECR I-1159, paragraph 21).”

There is, therefore, no de minimis level of use to establish genuine use (also see inter alia *Sonia Rykiel création et diffusion de modèles v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-131/06* and *The Sunrider Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-416/04 P*). It is necessary to establish whether the use –si viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark”. In *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-234/06 P* the CJEU stated:

—73The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The frequency or regularity of the use of the trade mark is one of the factors which may be taken into account (see *Sunrider v OHIM*, paragraph 71; see also, to that effect, *La Mer Technology*, paragraph 22).”

The clothing market is an enormous market in the United Kingdom. The sole evidence of use by the proprietor, or with its consent, in the United Kingdom in the material period is one invoice for 80 items of clothing. One invoice for 80 items in the five year period cannot be considered to be use that is warranted in the economic sector concerned to maintain or create a share in the market for the goods. It may be that the trade mark only appeared upon the invoice and not the clothing, further limiting the effect of the use. Owing to the absence of evidence, it is not possible to know. The onus is upon Hilfiger to establish use. —G]enuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned” (*Kabushiki Kaisha Fernandes v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-39/01*). **Hilfiger has not established genuine use of the trade mark TOMMY in the material period.** (Also see paragraph 40 re use as part of a registered trade mark.)

Section 5(3) reputation

38) The issue of reputation of the trade mark TOMMY for the purposes of section 5(3) is redundant following the above finding. However, the claims to reputation in respect of the two trade marks will be considered. Hilfiger must establish that its trade marks were known by a significant part of the public concerned by the products or services covered^{iv}. The CJEU in *General Motors Corporation v Yplon SA* stated how a party would establish this reputation:

—27In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

No data have been supplied in relation to any of the above factors in relation to either of the two trade marks upon which Hilfiger relies.

39) There has been some use of TOMMY.COM shown. However, this has been limited and as use for a web address rather than a trade mark. There is nothing to suggest that the average consumer would see TOMMY.COM as used as anything other than a name to be typed into a web browser to go to a website. It is, of course, possible for a domain name or an indication of a domain name (ie a word followed by .com, .co.uk and the like) to be a trade mark with a reputation. That is a question of fact. It is not a fact that Hilfiger has established. TOMMY.COM does not have the requisite reputation to be able to rely upon section 5(3) of the Act.

40) In *Société des produits Nestlé SA v Mars UK Ltd* Case C-353/03 the CJEU held :

—29The expression ‘use of the mark as a trade mark’ must therefore be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking.

30 Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.”

Consequently, if Hilfiger had established genuine use of the TOMMY trade mark it potentially could benefit from use of a trade mark(s) including that element.

(Indeed, it might be that genuine use could be established in such a context.) However, this is a matter that has to be established by evidence; evidence that will go to the perception of the average consumer of the goods. The evidence filed by Hilfiger does not allow such a conclusion to be drawn. (The same could potentially apply to TOMMY.COM but again there is no evidential basis to draw such a conclusion.)

41) Hilfiger has not established that either of the two trade marks upon which it relies has a reputation such that it can rely upon section 5(3) of the Act.

Likelihood of confusion – section 5(2)(b) of the Act

Average consumer and the purchasing process

42) Hilfiger's best case will lay with its class 25 goods. The parties agree that these goods are identical. The average consumer for the goods is the public at large. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined Cases T-117/03 to T-119/03 and T-171/03 the GC stated:

—43t should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected

The nature of the goods will not militate greatly against the effects of imperfect recollection. In the same case the GC stated:

—49However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the

image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

The goods will be primarily bought from displays or rails in stores, from mail order catalogues and via the Internet. Consequently, they will be bought primarily by the eye and visual similarity will have greater weight than aural similarity in the consideration of likelihood of confusion.

Comparison of goods

43) The parties have agreed that the class 25 goods are identical.

Comparison of trade marks

44) Owing to the presence of .COM in the Community trade mark, the position of Hilfiger will be better in relation to the United Kingdom trade mark. It has been decided that Hilfiger has not established genuine use of the trade mark TOMMY in the material period. However, in the event that this finding is found to be incorrect, the comparison will be made with this trade mark.

45) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^v. 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^{vi}. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{vii}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{viii}.

46) In its written submissions Hilfiger states that there is not one reference to the surname Nutter in the London telephone directory. This is an evidential point, a point that through evidence would have given Holdings the possibility of a response. It submits that NUTTER has a meaning, outwith any surnominal significance. It is the form that gives surname significance to the NUTTER element, a common forename followed by a word that could be a surname. The perception of the average consumer will be that TOMMY NUTTER is a full name. My surname is a city in the Rhineland-Palatinate and a type of carriage but with a forename before it is clearly used as a surname and forms a full name. My surname does not appear in my local telephone directory. HILFIGER is an unusual name for the United Kingdom. It is the presence of TOMMY before it

that creates the perception of a surname. It is the construction of a forename followed by the word NUTTER that gives the perception of the trade mark of Holdings being a full name.

47) There are far fewer forenames than surnames and so in identifying a person or goods or services provided by a person, in a full name the surname will have more significance. As Hilfiger submits NUTTER will be seen as an unusual surname. The more distinctive and dominant component of TOMMY NUTTER is the NUTTER component. The trade mark of Hilfiger consists of a well-known forename, the average consumer will not divide it up. There is no separate distinctive and dominant component. (It is noted that TOMMY has other meanings but its primary meaning in the context of the goods will be that of a forename.) Visually and aurally the trade marks coincide in the TOMMY element. Conceptually the trade mark of Holdings identifies a particular individual whilst the trade mark of Hilfiger is simply a common forename.

48) There are similarities between the trade marks owing to the TOMMY element. However, owing to both the dominance and the effect of the NUTTER element, there is only a limited degree of similarity.

Conclusion

49) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^x. The respective goods are identical. However, it is not an automatic sequitur that because goods are identical that the trade marks have to be very different to avoid a finding of likelihood of confusion^x. There is a limited degree of similarity between the trade marks. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{xi}. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xii}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the services for which it has been registered as coming from a particular undertaking, and thus to distinguish those services from those of other undertakings^{xiii}. Holdings has submitted that Hilfiger has not claimed in respect of section 5(2)(b) that its trade marks have enhanced distinctive character through use. As Hilfiger has claimed that its two trade marks have a reputation for the purposes of section 5(3) of the Act, it would be captious to consider that there is not de facto such a claim. However, as per the findings in respect of section 5(3) of the Act, Hilfiger has not established that either of its trade marks have enhanced distinctiveness through use. TOMMY is a common forename in the United Kingdom and so will have a limited capacity to identify the

goods of one particular undertaking. TOMMY has a low degree of distinctiveness.

50) The respective goods are not necessarily the subject of a careful purchasing decision and so the effects of imperfect recollection are increased. It is to be borne in mind that visual similarity has greater importance than aural similarity.

51) In *El Corte Inglés, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-39/10, the GC held:

—54As the applicant asserted in its pleadings, according to the case-law, the Italian consumer will generally attribute greater distinctiveness to the surname than to the forename in the marks at issue (Case T-185/03 *Fusco v OHIM – Fusco International (ENZO FUSCO)* [2005] ECR II- 715, paragraph 54). The General Court applied a similar conclusion concerning Spanish consumers, having established that the first name that appeared in the mark in question was relatively common and, therefore, not very distinctive (Case T-40/03 *Murúa Entrena v OHIM – Bodegas Murúa (Julián Murúa Entrena)* [2005] ECR II-2831, paragraphs 66 to 68).

55 Nevertheless, it is also clear from the case-law that that rule, drawn from experience, cannot be applied automatically without taking account of the specific features of each case (judgment of 12 July 2006 in Case T- 97/05 *Rossi v OHIM – Marcorossi (MARCOROSI)*, not published in the ECR, paragraph 45). In that regard, the Court of Justice has held that account had to be taken, in particular, of the fact that the surname concerned was unusual or, on the contrary, very common, which is likely to have an effect on its distinctive character. Account also had to be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known (Case C- 51/09 *P Becker v Harman International Industries* [2010] ECR I- 5805, paragraphs 36 and 37). Likewise, according to the case-law cited in the previous paragraph, the distinctive character of the first name is a fact that should play a role in the implementation of that rule based on experience.”

In the United Kingdom greater significance will be given to a surname than a forename. If the trade mark of Holdings was to be identified by one element it would be the surname element, NUTTER and not the TOMMY element. It is also to be taken into account, as per paragraph 55 of the judgment, that NUTTER will be seen as an unusual surname. It will stick in the mind of the average consumer.

52) The trade mark of Holdings will not be directly confused for the trade mark TOMMY. The average consumer will not have any reason to believe that there is any economic link between the business of Holdings and that of Hilfiger, owing to

the differences between the trade marks and in particular the effects of the NUTTER element. There will not be indirect confusion. TOMMY NUTTER will not be seen as a sub-brand of TOMMY.

53) This comparison has been made on the basis that Hilfiger had established genuine use of TOMMY, which it has not. Its position cannot be any better in relation to TOMMY.COM owing to the second element.

54) The ground of opposition under section 5(2)(b) of the Act is dismissed.

Section 5(4)(a) of the Act – passing-off

55) That Hilfiger has not established genuine use in the material period does not mean automatically that it does not have goodwill that is associated with the sign TOMMY. Such an association can be the result of use by others. The cars of Mercedes Benz and BMW are referred to as Mercs and Beamers/Beemers/Bimmers in the United Kingdom, although not necessarily by the producers of the cars. The goodwill of the businesses of those two undertakings is clearly associated with signs that they may never use themselves. If there is goodwill associated with the sign TOMMY owing to the nature of the use it is also inextricably linked to the Hilfiger name, owing to the nature of the use, and so the position in relation to misrepresentation is even weaker than the position in relation to likelihood of confusion. The relevant consumer would not think that those behind TOMMY HILFIGER were also behind TOMMY NUTTER. Owing to the difference in the sign and the trade mark and the nature of the use by Hilfiger there would not be a misrepresentation.

56) The ground of opposition under section 5(4)(a) of the Act is dismissed.

Costs

57) In its written submissions Holdings seeks an award on an indemnity basis or at the upper boundary of the scale. It does this on the basis that Hilfiger was unsuccessful in another set of proceedings: BL/O/009/10. This case did not involve Holdings, it also related to a different trade mark, TOMMY DILLINGER. It also related to the position at 16 January 2008. It is not seen how the findings in that case should affect an award of costs. There is nothing in the behaviour of Hilfiger that would even bring into consideration an award of costs on an indemnity basis as per rule 44.4 of the Civil Procedure Rules. The evidence furnished by Hilfiger has not been excessive. The only hiccup in the proceedings was Holdings requesting at a late stage that Hilfiger provide proof of use of its TOMMY trade mark. Owing to the stage that Hilfiger was in filing its evidence and the nature of the evidence that was filed, this did not give rise to an excessive burden. However, it is impossible to know what the position of Hilfiger would have been if the request had been made at the commencement of the proceedings. Hilfiger also had to consider its response to the amendment of the pleadings to take into account this late request. The amount of costs to be

awarded to Holdings, as the successful party, is reduced by £200 because of this late amendment; in order to compensate Hilfiger.

58) Costs are awarded on the following basis:

Preparing a statement and considering Hilfiger's statement:	£200
Considering the evidence of Hilfiger:	£500
Written submissions ¹ :	£300
	-£200
Total:	£800

Tommy Hilfiger Licensing, LLC is ordered to pay Nutters (Holdings) Ltd the sum of £800. This sum is 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 24th day of January 2013

**David Landau
For the Registrar
the Comptroller-General**

ⁱ Section 6A of the Act reads:

-(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 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 –

¹ This figure takes into account the amount given in relation to considering the evidence.

(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).”

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

–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.”

ⁱⁱ –30 The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.”

ⁱⁱⁱ *Rintisch v Eder* Case C-553/11.

^{iv} *General Motors Corporation v Yplon SA* Case C-375/97.

^v *Sabel BV v Puma AG* Case C-251/95.

^{vi} *Sabel BV v Puma AG* Case C-251/95.

^{vii} *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

^{viii} *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{ix} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^x See *Meda Pharma GmbH & Co KG c Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI)* Affaires jointes T-492/09 et T-147/10:

« 50 La requérante soutient que, en cas d'identité de produits, il est nécessaire, pour exclure tout risque de confusion, que les signes présentent une plus grande différence que dans une situation où l'écart entre les produits est important. Or, dans les circonstances de l'espèce où l'identité des produits n'est pas contestée, la chambre de recours aurait dû conclure au risque de confusion, à l'instar de ce qui a été considéré dans la décision R 734/2008-1 de la première chambre de recours de l'OHMI, du 14 septembre 2009 (Alleris et Allernil). Selon la requérante, plusieurs décisions de l'OHMI démontrent que les décisions attaquées s'écartent de la pratique décisionnelle de l'OHMI, ce qui viole les principes d'égalité et de non-discrimination.

51 Il ressort de la jurisprudence que l'OHMI est tenu d'exercer ses compétences en conformité avec les principes généraux du droit de l'Union. Si, eu égard aux principes d'égalité de traitement et de bonne administration, l'OHMI doit prendre en considération les décisions déjà prises sur des demandes similaires et s'interroger avec une attention particulière sur le point de savoir s'il y a lieu ou non de décider dans le même sens, l'application de ces principes doit toutefois être conciliée avec le respect du principe de légalité. Au demeurant, pour des raisons de sécurité juridique et, précisément, de bonne administration, l'examen de toute demande d'enregistrement doit être strict et complet afin d'éviter que des marques ne soient enregistrées de manière indue. C'est ainsi qu'un tel examen doit avoir lieu dans chaque cas concret. En effet, l'enregistrement d'un signe en tant que marque dépend de critères spécifiques, applicables dans le cadre des circonstances factuelles du cas d'espèce, destinés à vérifier si le signe en cause ne relève pas d'un motif de refus [voir, en ce sens, arrêt de la Cour du 10 mars 2011, *Agencja Wydawnicza Technopol/OHMI*, C-51/10 P, non encore publié au Recueil, points 73 à 77, et la jurisprudence citée, et arrêt du Tribunal du 22 novembre 2011, *LG Electronics/OHMI (DIRECT DRIVE)*, T-561/10, non publié au Recueil, point 31).

52 Or il apparaît que, dans la présente affaire, la chambre de recours a correctement pris en compte les circonstances de l'espèce. À cet égard, elle a, à juste titre, constaté l'identité des produits concernés en l'espèce, elle a aussi retenu une similitude très faible des signes en cause sur les plans phonétique et visuel et une impossibilité de comparaison de ces mêmes signes sur le plan conceptuel, comme il ressort des points 40, 41 et 46 ci-dessus. Dès lors, comme le soutient à juste titre l'OHMI, l'identité entre les produits désignés est compensée par un très faible degré de similitude entre les signes en cause et la chambre de recours a pu conclure à bon droit à l'absence de tout risque de confusion, d'autant que le degré d'attention du public est accru et qu'il n'est pas démontré que la marque antérieure présente un caractère distinctif élevé. »

^{xi} *Sabel BV v Puma AG* Case C-251/95.

^{xii} *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

^{xiii} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.