

O-311-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 2561222  
IN THE NAME OF TRIPP LIMITED  
FOR THE FOLLOWING TRADE MARK IN CLASS 18:**

**TRIPP LITE**

**AND**

**OPPOSITION THERETO (NO. 101787) BY  
TRIPPE MANUFACTURING COMPANY**

## **THE BACKGROUND AND THE PLEADINGS**

1) The trade mark **TRIPP LITE** was filed by Tripp Limited (“the applicant”) on 12 October 2010. It was published in the Trade Marks Journal on 14 January 2011 for the following class 18 goods:

Leather and imitation of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; luggage, bags; suitcases, cabin bags; garment carriers; washbags; trolley bags; briefcases; pilot bags, attache cases; handbags, vanity bags; folio cases; duffel bags; back-packs; laptop computer bags; wheeled tote bags; shopper bags; garment carriers and bags; straps, money belts, bumbags, pouches.

2) Trippe Manufacturing Corporation (“the opponent”) opposes the registration of the above mark under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under the first two grounds, three earlier marks are relied upon, all of which consist of the words: **TRIPP LITE**:

i) Community trade mark (“CTM”) registration 1727627 which was filed on 27 June 2000 and which completed its registration process on 1 October 2001. The mark is registered for:

**Class 9:** Electrically operated apparatus; signalling lights comprising warning lights, rotating lights, flashing lights; power converters comprising direct-to-alternating inverters and battery chargers, auxiliary power supplies and line filters.

Under section 5(2)(b), the claim is made against the following goods of the application:

**Class 18:** Goods made of [leather and imitation leather] not included in other classes; travelling bags; luggage, bags; suitcases, cabin bags; trolley bags; briefcases; pilot bags, attache cases; handbags, vanity bags; folio cases; duffel bags; back-packs; laptop computer bags; wheeled tote bags; garment bags; shopper bags, bumbags and pouches.

The opponent relies on all of its goods and claims that the mark has been used in relation to all them; the statement of use is made because the proof of use provisions contained in section 6A of the Act are applicable. Put at its simplest, the basis of its claim is that the applicant’s specification contains bags, cases and pouches which can be used to house certain electrical products that are covered by the opponent’s specification.

Under section 5(3), the opponent claims a reputation (and use) for all its goods and attacks the same list of goods as per section 5(2)(b). Its claim

is based on free-riding and dilution, but in all instances the opponent states that this stems from the consumer assuming that the goods of the applicant originate from the opponent.

ii) International Registration (“IR”) 826935 which designated the UK for protection on 20 June 2008 with protection being conferred on 22 January 2009. The mark is protected in respect of:

**Class 9:** Electrically operated apparatus, namely power converters comprising direct-to-altering inverters and battery chargers; auxiliary power supplies and line filters; power converters for alternating current to direct current; power converters for direct current to direct current; uninterruptible power supplies; voltage surge suppressors; power converters for regulating/controlling alternating current; power distribution assemblies for multiple outlets; KVM (keyboard, video, mouse) switches; and USB (universal serial bus) hubs

Under section 5(2)(b), the opponent relies on this mark to oppose the same goods as per the first earlier mark. No statement of use is made because the proof of use provisions are not applicable to this earlier mark. The claim is made on a similar basis as per the first mark.

Under section 5(3), the opponent claims a reputation (and use) for all its goods and attacks the same list of goods as per section 5(2)(b). Its claim is based on free-riding and dilution, but in all instances the opponent states that this stems from the consumer assuming that the goods of the applicant originate from the opponent.

iii) IR 1028137 which designated the EU for protection on 18 January 2010 with protection being conferred on 23 December 2010. The mark is registered in respect of:

**Class 9:** Rack enclosures for computer equipment.

Under section 5(2)(b), the opponent relies on this mark to oppose the same goods as per the first mark. No statement of use is made because the proof of use provisions are not applicable to this earlier mark. The claim is made on a similar basis as per the first mark.

Under section 5(3), the opponent claims a reputation (and use) for all its goods and attacks the same list of goods as per section 5(2)(b). Its claim is based on free-riding and dilution, but in all instances the opponent states that this stems from the consumer assuming that the goods of the applicant originate from the opponent.

3) The opponent's pleading under section 5(4)(a) of the Act is based on the use of the sign TRIPP LITE "for many years" [this appears to be in relation to the types of goods pleaded under section 5(2) and 5(3)] but specific reference is also made to the sale of laptop bags since May 2008. It claims that the use of the applicant's mark would constitute passing-off for similar reasons to that relied upon under section 5(2).

4) The applicant filed a counterstatement denying the grounds of opposition. It notes that the claim has been made under section 5(2)(b) despite the marks being identical. It denies that the goods are similar. It denies that the earlier mark has a reputation or that any of the heads of damage relating to section 5(3) will arise. The opponent additionally claims a due cause defence as it states that it has been trading under its mark since 2005. It denies the ground under section 5(4)(a) stating that the opponent does not have an earlier right. The applicant did not put the opponent to proof of use. It specifically accepted that use had been made in relation to some of the goods, but did not seek proof in relation to anything else.

5) Both sides filed evidence. The matter came to be heard before me on 5 June 2014 at which the applicant was represented by Mr Michael Silverleaf QC, of Counsel, instructed by Jenson & Son; the opponent was represented by Mr Thomas Elias, also of Counsel, instructed by Barker Brettell LLP.

## **THE EVIDENCE**

### *Affidavit of Robert Mazalin dated 19 July 2013*

6) Mr Mazalin is the opponent's director of risk management. He sets out the opponent's history dating back to the 1920s. I do not consider it necessary to summarise this in detail, but it was founded in Chicago in 1922 and its business has moved from automobile accessories to rotating warning lights to inverters and power supplies. During the 1980s it became the first company to manufacture uninterruptable power supplies ("UPS") for personal computers. During the 90s further computer based products were introduced including switches, power distribution units and rack mount enclosures. It is stated that the growth of computer technology led to these computer related products being introduced, and a further example is given of a laptop bag. The opponent now sells 2,500 products in 60 countries. It has sold over 19 million electrical surge and noise suppressors and 9 million UPS systems.

7) In relation to the use of TRIPP LITE, Mr Mazalin states that it has been used in the EU and UK since 1998 in respect of "[the opponent's] goods". It is stated that the opponent has sold laptop computer bags since May 2008; a reference to laptop backpacks is also made. A web link is provided to the product, but it is not for the tribunal to follow web links, it is for the opponent to provide evidence in documentary form. It is stated that the opponent sells over 1000 products in the

UK under the mark including laptop accessories, such as cases and backpacks, laptop power protection, laptop cables and adaptors and other peripherals. Exhibit RM-1 contains prints from the opponent's website. The exhibit runs to 55 pages. TRIPP LITE is used on what appears to be the home page and is also used a number of times in addition to that. Most of the products are electrical in nature, primarily for use in computing e.g. power distribution, switches, cables etc. There is one example (page 44) of a "notebook bag" sold under the heading of "Tripp Lite Mobility Solutions". None of these prints can be placed before the relevant date. It is a .com website, but there is a reference to UK at the top of the page.

8) Mr Mazalin refers to the opponent's CTM 1727627 and asserts that it has been used for all its goods save for signaling lights comprising warning lights, rotating lights and flashing lights. He refers to the remaining goods of this registration, and those of the other earlier marks, as "the goods". Exhibit RM-2 contains copies of literature featuring photographs of some of the items upon which the mark is used. It is difficult to place the documents in this 236 page exhibit to time or locale. Most of the goods are those already described, UPS, power distribution apparatus, cables, etc. At page 39 is a brochure about notebook accessories including a notebook case, and a notebook case on wheels, a notebook backpack and "brief". Some of these are sold on the basis of also being able to store clothes. Notebook cases are also shown on page 52 of this exhibit.

9) Mr Mazalin identifies a number of distributors and resellers of the opponent's goods in both the UK and EU. He also refers to pages from the opponent's website which lists resellers and partners in the UK and EU. Pages containing downloadable brochures in other EU languages are provided – the electrical type goods are depicted but not laptop bags etc. The prints also contain pages from the website of certain resellers/distributors showing the electrical goods. I could find no laptop bags in this 191 page exhibit. Nor can any of the prints be placed in date context.

10) Between 2007 and 2012, worldwide sales have ranged between \$215 and \$350million, in the EU between \$3million and \$8.5million, and in the UK between \$195,000 and \$974,000. Advertising in the same period has, worldwide, ranged between \$3million and \$5million, in the EU between \$39k and \$2.7k, and in the UK between \$9k and \$2.7k. Sales of backpacks and bags in the UK are \$13,960 (2008), \$25,145 (2009), \$8,361 (2010), \$5,000 (2011) and \$3,500 (2012).

11) Various advertising and promotional methods are referred to such as magazines, brochures, direct marketing, promotional events and trade shows. The opponent's website has a newsroom page. Exhibit RM4 is a 285 page exhibit containing "copies of brochures dating back to 2005 showing use of the trade mark TRIPP LITE. Those and other brochures are or have been available for distribution in the UK". There is a long list of press releases dating from 2001

to 2012 with a global geographical context. There is a similar (it is perhaps the same document as referred to earlier) brochure about notebook accessories (including bags) at page 119 of this exhibit and another at page 135; neither can be dated.

12) TRIPP LITE is used on business stationary and examples of this are given in Exhibit RM-5. The material includes various invoices including some to UK businesses. In amongst others, one invoice (to a UK company) dated 21 May 2010 is for a universal table PC case, as is another (to a Dutch company) dated 8 December 2010. Exhibits RM-6 and RM-7 contain various details about trade mark registrations the opponent holds around the world. It is not necessary to summarise this. The rest of Mr Mazalin's evidence is, in the main, submission as to why the various claims the opponent has made should succeed. This is all borne in mind.

*Witness statement of Aidan Creedon*

13) Mr Creedon is the applicant's deputy chairman and finance director. The opponent was incorporated in July 1988 but underwent various changes of name until its current name was adopted in 2003. I will not detail all of this history, but I note that the company has been in the luggage business since 2000 and that one of its products, EQUATOR, had a quality issue which is why the name TRIPP was introduced as a new range of luggage in July 2001.

14) TRIPP has been used since 2001 in relation to a range of luggage. Mr Creedon states that sales are principally made through concessions in the Debenhams' department store. In addition, it has stand-alone outlets in Cheshire Oaks and three concessions in Boundary Mill stores and, "increasingly in the last few years [sales] via our website..". The prices of the luggage range from £20 (for a Tripp Essentials Holdall) to £219 (for a large Tripp Absolute Lite suitcase). Exhibit AC1 contains prints from the applicant's website for various Tripp branded luggage. There is nothing to place the print from before the relevant date. Various type of luggage is sold. The Tripp Lite is a suitcase and a number of these are shown. There is a page relating to business luggage, including laptop bags for the business traveler. There is also a page headed "Laptop friendly" which includes backpacks and other forms of bags and luggage which, given the name, are sold on the basis of the suitability for carrying laptops. None of these are named TRIPP LITE. A list of the various Debenhams stores around the country is also provided in this exhibit.

15) Mr Creedon sets out the details of the various trade marks the opponent owns (details in Exhibit AC2). This information is noted but I will only refer to them if it is necessary to do so.

16) Exhibit AC3 contains data from the September 2011 Gfk Quickview report for the luggage industry showing that the applicant has a 24.9% market share of

the UK luggage industry. Exhibit AC4 is a Mintel luggage industry report from 2006 which describes the applicant as “the most dynamic brand in the UK market”. Exhibit AC5 contains various extracts from magazine and newspapers where TRIPP luggage has been featured, often as part of product comparisons or recommended products. However, the prints are very unclear – it is certainly not possible to see whether any relate to TRIPP LITE. The TRIPP brand has also featured on some television programmes such as *This Morning*. There is also a reference to a TRIPP product appearing on *Emmerdale* when one of the characters is using a suitcase; this will have had little impact on anyone.

17) Mr Creedon explains that TRIPP LITE was introduced as a sub-brand at the end of 2004. It was intended to be a light product due to the restrictions airlines place on the weight of luggage. Exhibit AC6 contains a number of prints from the opponent’s website showing TRIPP LITE products (all suitcases) with reviews having been left which are generally positive. Exhibit AC7 contains sales data. The value of sales of what are identified as LITE 4W and LITE range from 39k in 2004 to £3 million in 2012. The LITE 4W was only introduced in 2007.

18) It is explained that although TRIPP LITE has been used since 2004, it was not considered necessary to register it because protection for TRIPP per se was being concentrated upon. This changed when the applicant became aware of a Turkish manufactured range of luggage called Triplite which led them to apply for the subject trade mark.

19) Mr Creedon states that he has no recollection of the opponent or its products prior to these proceedings. He states that the electrical products it sells are in no way competitive or complementary and are not sold through the same trade channels. He states that the opponent’s sales are low, particularly in the UK. He states that the sales figures for laptop bags and backpacks are exiguous. He comments upon the small level of advertising figures. It is observed that any laptop accessories must be a recent addition to the opponent’s range. He states that he is puzzled by the claim that the bags shown in Exhibit RM-8 are adapted for laptops etc. He states that they are simply bags with a laptop compartment rather than being a protective case specifically adapted to protect a laptop. He states that it has long been conventional for bags suitable for business use/travel to have such compartments and this is just a subsection of luggage, briefcases etc.

20) Mr Creedon is surprised that the opponent did not see the applicant’s products before it launched in the UK. He thinks that a customer presented with one of the opponent’s bags will believe that the product has in some way been licensed or approved by the applicant. He thinks this could damage the applicant and its relationship with Debenhams.

*Second affidavit of Robert Mazalin dated 9 December 2013*

21) In response to Mr Creedon's criticism of the opponent's evidence, Mr Mazalin makes a number of points. He notes that the applicant's TRIPP LITE products were not introduced until late 2004 and, in any event, they are for large suitcases or cabin luggage, not laptop bags. He highlights the lack of dates and that the 2011 report from GRK is not current; the same criticism applies to the Mintel report, which also contains no reference to TRIPP LITE. He states that TRIPP LITE is not promoted in any way and, in any event, the addition of LITE is just a descriptive addition. He highlights that the reviews in Mr Creedon's evidence do not mention TRIPP LITE, so they do not show public recognition. He states that the sales data is difficult to rationalize; he refers to LITE or lite 4w which could, it is stated, relate to other sub-brands that have the word LITE in them. He states that it is not explained by Mr Creedon how he came across the Turkish Triplite product, and, in any event, this shows that TRIPP LITE was not important enough to register until the applicant came across another party using it.

22) Mr Mazalin states that neither trade mark is limited to customer base, so the point made by Mr Creedon about the opponent's marketing is not relevant. He states that the confusion referred to by Mr Creedon (that the opponent's goods will be believed to be those of the applicant) could operate in reverse. He states that TRIPP LITE is one of the opponent's most valuable assets – the opponent company is known as TRIPP LITE, unlike the sub-brand usage of the applicant.

**SECTION 5(2) OF THE ACT**

23) The marks at issue in these proceedings are clearly identical, so the opponent's claim should have been made under section 5(2)(a) rather than section 5(2)(b) as pleaded. Mr Silverleaf took no issue with this irregularity. This is sensible. The approach I adopted at the hearing was to consider the pleadings as de facto amended with the matter being considered under section 5(2)(a). Both sides were content with this.

**Section 5(2)(a) - the legislation and the leading case-law**

24) Section 5(2)(a) of the Act reads:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected....

(b) .....



there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

25) The Court of Justice of the European Union (“CJEU”) has issued a number of judgments which provide guiding principles relevant to whether there exists a likelihood of confusion. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases<sup>1</sup>:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

Not all of the above factors are pertinent in these proceedings given the identity of the marks in question.

### **Comparison of goods**

26) When making the comparison, all relevant factors relating to the goods in the 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."

27) 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.”

28) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

29) In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

30) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”<sup>1</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>2</sup>. I also note the

---

<sup>1</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

<sup>2</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

31) The goods covered by the three earlier marks are:

**CTM 1727627** - Class 9: Electrically operated apparatus; signalling lights comprising warning lights, rotating lights, flashing lights; power converters comprising direct-to-alternating inverters and battery chargers, auxiliary power supplies and line filters.

**IR 826935** - Class 9: Electrically operated apparatus, namely power converters comprising direct-to-altering inverters and battery chargers; auxiliary power supplies and line filters; power converters for alternating current to direct current; power converters for direct current to direct current; uninterruptible power supplies; voltage surge suppressors; power converters for regulating/controlling alternating current; power distribution assemblies for multiple outlets; KVM (keyboard, video, mouse) switches; and USB (universal serial bus) hubs

**IR 1028137** - Class 9: Rack enclosures for computer equipment.

32) There was much discussion at the hearing about the term “electrically operated apparatus” covered by CTM 1727627. Although the term also appears in IR 826935, the use of the word “namely” in that specification limits the goods to those that follow the term. Therefore, the broader term is that listed in CTM 1727627.

33) Mr Elias argued that “electrically operated apparatus” was a broad term covering anything (in class 9) which was operated or powered by electricity. He argued that the term would encompass goods such as laptops which, he argued, must be regarded as similar (on a complementary basis) to laptop bags (a term listed in the applicant’s class 18 specification). Mr Silverleaf argued that this was too broad an interpretation. He submitted that the term should be interpreted in a

narrow fashion and would likely be perceived by the relevant public as covering goods which are driven by electricity such as electric motors; he also submitted that the rest of the specification (which does not cover laptops) provided some context upon which to gauge the meaning of the term.

34) Having considered the case-law identified above, I come to the view that it would be wrong to interpret the specification as covering laptops. It seems a strain of the language for a laptop (or similar product) to be described as “electrically operated apparatus”. The natural or core meaning would not cover laptops. *IP Translator* calls for clarity and precision in specifications and this is a further reason why the term should not be interpreted to cover everything that simply runs on electricity. If this approach were not right then in my view the term should be considered as so vague that a legitimate comparison of goods cannot be made and therefore the term not protected at all<sup>3</sup>. It is difficult to come up with an exhaustive list of what the term does cover, but I see nothing obvious that bears any real similarity with the various bags and luggage which are covered by the applicant’s specification.

35) The other goods covered by CTM 1727627 are: *signalling lights comprising warning lights, rotating lights, flashing lights; power converters comprising direct-to-alternating inverters and battery chargers, auxiliary power supplies and line filters*. There is no obvious similarity between such goods and the applied for goods. It is, of course, possible for bags to be manufactured specifically adapted to carry and protect such goods, however, there is no evidence of this and, in any event, such goods would fall in class 9 not in class 18. These findings extend to the goods covered by IR 1028137: Rack enclosures for computer equipment. The goods are not similar to the applied for goods; Mr Elias accepted that this earlier mark would not put the opponent in any stronger position than its other earlier marks.

36) That leaves IR 826935 which covers: *Electrically operated apparatus, namely power converters comprising direct-to-altering inverters and battery chargers; auxiliary power supplies and line filters; power converters for alternating current to direct current; power converters for direct current to direct current; uninterruptible power supplies; voltage surge suppressors; power converters for regulating/controlling alternating current; power distribution assemblies for multiple outlets; KVM (keyboard, video, mouse) switches; and USB (universal serial bus) hubs*. As I have already stated, the specification only really covers the goods listed after the word “namely”. Most of the goods fall to be assessed in the same manner as those in paragraph 34, so there is no similarity. The only goods that potentially introduce different considerations are goods such as USB hubs and certain forms of power supply which could, potentially, be used with a laptop and stored with it in a laptop bag. However, the following findings then arise: there is no similarity in nature, there is no similarity in purpose (one is for carrying a laptop the other is to power a laptop or provide USB ports for it),

---

<sup>3</sup> See, by way of example, the decision of the General Court in *Vogue* T-229/12

there is no similarity in method of use, the goods are not competitive, the goods are not complementary in that one is important for the use of the other. The users may be the same and it is possible for the goods to be sold through the same trade channels (a computer shop, for example), but they are unlikely to be sold in close proximity to each other in most scenarios. I feel that the strong differences outweigh the very superficial similarities to such an extent that the goods ought not be considered as similar.

37) In view of my findings, the opposition under section 5(2)(a) fails because there is no similarity between the goods. The CJEU has stated that there can be no finding of a likelihood of confusion if the goods/services in question are not similar. See, for example, *Waterford Wedgwood plc v OHIM* Case C-398/07. **The section 5(2)(a) ground is hereby dismissed.**

### **SECTION 5(3) OF THE ACT**

38) Section 5(3)<sup>4</sup> of the Act reads:

“5-(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 Community trade mark, 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.”

39) The earlier mark(s) must have a reputation. In *General Motors Corp v Yplon SA* (Chevy) [1999] ETMR 122 and [2000] RPC 572 the CJEU stated:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

40) In addition to having a reputation, a link must be made between the subject trade mark and the earlier marks. In *Adidas-Salomon*, the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them

---

<sup>4</sup> Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the CJEU in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (“Addidas-Salomon”) (C-408/01)).

(see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

41) In *Intel Corporation Inc v CPM (UK) Ltd* (C-252-07) (“*Intel*”) the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

42) If the hurdles of reputation and link are cleared, it is necessary to establish that at least one of the heads of damage that underpin section 5(3) is present (or that there is a foreseeable risk of such damage).

43) When summarising the opponent’s evidence, I detailed the following in terms of sales and advertising expenditure:

“Between 2007 and 2012, worldwide sales have ranged between \$215 and \$350million, in the EU between \$3million and \$8.5million, and in the UK between \$195,000 and \$974,000. Advertising in the same period has, worldwide, ranged between \$3million and \$5million, in the EU between \$39k and \$2.7k, and in the UK between \$9k and \$2.7k. Sales of backpacks and bags in the UK are \$13,960 (2008), \$25,145 (2009), \$8,361 (2010), \$5,000 (2011) and \$3,500 (2012).”

44) It is clear that the opponent’s business is primarily outside the EU (the evidence shows that it is US orientated) and that UK sales represent only a small

part of the opponent's worldwide business. However, this does not mean that the opponent cannot have a relevant reputation. In relation to reputation, the position in the UK is all that is really relevant. Even though the legal test for the opponent's CTM and IR (EU) is a reputation in the EU<sup>5</sup>, the operative effect of section 5(3) is to be measured from the perspective of the relevant public in the UK. To illustrate the point, if a CTM/IR(EU) has a reputation in, say, Germany and France, whilst this may qualify it as having a reputation in the EU, if the mark does not also have a reputation in the UK then the relevant public will not make a link and, furthermore, none of the heads of damage will arise. Therefore, whilst bearing in mind the wider aspects of the evidence, I will concentrate, primarily, on the position in the UK.

45) In terms of assessing the reputation, the following is relevant:

- The overall sales figures in the UK are not broken down by product type. The only exception is that separate figures for laptop bags are provided, but this is not helpful because the earlier marks do not extend to such goods.
- The brochures provided appear to focus on the sale of goods such as UPS and larger scale electrical apparatus such as surge protectors.
- No evidence has been provided as to the size of the relevant market(s).
- On the face of it, the sales of laptop bags are weak, but as stated already, the position with regard to laptop bags is not important.
- On the face of it, the sales in relation to the other types of goods are better, but still of only a modest level.

46) On the basis of the above, I conclude that the earlier mark has only a weak reputation in the UK in relation to its electrical products such as UPS.

47) In terms of establishing whether a link will be established, the following is relevant:

- The marks are identical and have a reasonable level of inherent distinctive character.
- The goods (the reputed goods compared to the applied for goods) are dissimilar and are, in fact, quite distant.
- That there would be no likelihood of confusion (as already held).

---

<sup>5</sup> See the judgment of the CJEU in Case C-301/07 *PAGO International GmbH v Tirolmilch registrierte Genossenschaft mbH*.



- The reputation of the earlier marks in the UK is weak.
- The relevant public is different but there is still potential for overlap because whilst UPS is a specialist product, the applied for goods are not and could be purchased by anyone (including consumers of UPS etc).
- That the applicant has sold luggage type products extensively since 2001 under the brand TRIPP and has sold TRIPP LITE products since 2004 (although I am not convinced that the latter will have had a significant impact upon the relevant public for the applied for goods).

48) Taking the above into account, I conclude that members of the relevant public of the applied for goods (including laptop bags), a relevant public which includes people who are familiar with the opponent's mark and reputation, are more likely to consider TRIPP LITE as a sub brand of TRIPP. The opponent's mark will not therefore be brought to mind. This means that the necessary link between the marks is not established. **The ground of opposition under section 5(3) is hereby dismissed.**

#### **SECTION 5(4)(A) OF THE ACT**

##### **Legislation and the leading case-law**

49) Section 5(4)(a) constitutes a ground of opposition in circumstances where the use of the mark in question 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..”

50) The elements of passing-off (often referred to as the classic trinity) can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position thus:

“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."

51) The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom."

52) To qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature<sup>6</sup>. However, being a small player does not prevent the law of passing-off from being relied upon<sup>7</sup>.

53) The test for misrepresentation was explained in *Reckitt & Colman Products Ltd v Borden Inc* thus:

"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"

54) In terms of misrepresentation, I must be satisfied that the goods offered under the applicant's mark would be taken (or likely to be taken) by a substantial number of the opponent's customers or potential customers to be the responsibility of the opponent (or that there is some form of connection between the opponent and the applicant). Although an intention to misrepresent would be a highly relevant factor, it is not a prerequisite. Misrepresentation can be found in innocent circumstances.

55) The goods must also be factored in. Although there is no requirement in passing-off for goods to be similar, or for there to be a common field of activity, it is nevertheless a highly relevant factor, as can be seen from the judgment in *Harrods Ltd v Harrodian School* [1996] RPC 697, where Millett LJ stated:

---

<sup>6</sup> *Hart v Relentless Records* [2002] EWHC 1984

<sup>7</sup> See, for instance, *Stannard v Reay* [1967] FSR 140, *Teleworks v Telework Group* [2002] RPC 27 and *Stacey v 2020 Communications* [1991] FSR 49

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

and

“The name "Harrods" may be universally recognised, but the business with which it is associated in the minds of the public is not all embracing. To be known to everyone is not to be known for everything.”

and

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

56) In relation to damage, although a direct loss of sales is often the most obvious form of damage to consider, damage can arise in other ways. In *Maslyukov v Diageo Distilling Ltd* Arnold J stated:

85 Secondly, counsel submitted that the hearing officer had wrongly failed to recognise that damage resulting from Diegeo's loss of control over the marks, including erosion of distinctiveness of the marks, was sufficient damage to sustain a passing off action, as shown by the following passage from McAlpine at [20] which the hearing officer himself quoted at para.128 of the decision:

“When it comes to considering damage, the law is not so naïve as to confine the damage to directly provable losses of sales, or ‘direct sale for sale substitution’. The law recognises that damage from wrongful association can be wider than that. Thus in *Ewing v Buttercup Margarine Ltd (1917) 34 R.P.C. 232* Warrington L.J. said:

‘To induce the belief that my business is a branch of another man's business may do that other man damage in all kinds of ways. The quality of the goods I sell; the kind of business I do; the credit or otherwise which I might enjoy. All those things may immensely injure the other man, who is assumed wrongly to be associated with me.’

In so saying, he was not limiting the kinds of potential damage to those listed by him. Rather, he was indicating that the subtleties of the effect of passing off extend into effects that are more subtle

than merely sales lost to a passing off competitor. In *Associated Newspapers Ltd v Express Newspapers* [2003] F.S.R. 909 at 929 Laddie J. cited this passage, referred to other cases and went on to say:

'In all these cases [that is to say, the *Clock Ltd* case referred to above and *Harrods v Harrodian School* [1996] R.P.C. 679 ], direct sale for sale substitution is unlikely or impossible. Nevertheless the damage to the claimant can be substantial and invidious since the defendant's activities may remove from the claimant his ability to control and develop as he wishes the reputation in his mark. Thus, for a long time, the common law has protected a trader from the risk of false association as it has against the risk of more conventional goods for goods confusion.'

The same judge expressed himself more picturesquely, but equally helpfully, in *Irvine v Talksport Ltd* [2002] 1 W.L.R. 2355 at 2366. Having pointed out the more familiar, and easier, case of a defendant selling inferior goods in substitution for the claimant's and the consequential damage, he went on to say:

'But goodwill will be protected even if there is no immediate damage in the above sense. For example, it has long been recognised that a defendant cannot avoid a finding of passing off by showing that his goods or services are of as good or better quality than the claimant's. In such a case, although the defendant may not damage the goodwill as such, what he does is damage the value of the goodwill to the claimant because, instead of benefiting from exclusive rights to his property, the latter now finds that someone else is squatting on it. It is for the owner of goodwill to maintain, raise or lower the quality of his reputation or decide who, if anyone, can use it alongside him. The ability to do that is compromised if another can use the reputation or goodwill without his permission and as he likes. Thus *Fortnum and Mason* is no more entitled to use the name *FW Woolworth* than *FW Woolworth* is entitled to use the name *Fortnum and Mason ...*' 'The law will vindicate the claimant's exclusive right to the reputation or goodwill. It will not allow others so to use goodwill as to reduce, blur or diminish its exclusivity.' (at 2368)

In *Taittinger SA v Allbev Ltd* [1994] 4 All ER 75 at 88, Peter Gibson L.J. acknowledged that:

‘Erosion of the distinctiveness of the name champagne in this country is a form of damage to the goodwill of the business of the champagne houses.’ The same view was expressed by Sir Thomas Bingham MR at 93.”

57) To illustrate the point further, I note that in *WS Foster & Son Limited v Brooks Brothers UK Limited* [2013] EWPC 18, Mr Recorder Iain Purvis QC stated:

“*Damage*

55 Although proof of damage is an essential requirement of passing off cases, it will generally be presumed where a misrepresentation leading to a likelihood of deception has been established, since such deception will be likely to lead to loss of sales and/or more general damage to the exclusivity of the Claimant's unregistered mark. Mr Aikens accepted that if there was a misrepresentation in the present case, then he had no separate case on damage. I hold that damage is inevitable, at least in the sense recognised in *Sir Robert McAlpine v Alfred McAlpine* [2004] RPC 36 at 49 (the ‘blurring, diminishing or erosion’ of the distinctiveness of the mark).”

58) Matters must be judged at a particular point(s) in time. 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 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.”

59) The relevant date at which the opponent must establish that its business had goodwill, and that the use of the applicant's mark was liable to be prevented under the law of passing-off, is 12 October 2010. In some cases it may be necessary to consider the position at other date(s). In *Croom's Trade Mark Application* [2005] RPC 2 Mr Geoffrey Hobbs QC, sitting as the Appointed Person, stated:

“45. I understand the correct approach to be as follows. When rival claims are raised with regard to the right to use a trade mark, the rights of the rival claimants fall to be resolved on the basis that within the area of conflict:

(a) the senior user prevails over the junior user;

(b) the junior user cannot deny the senior user’s rights;

(c) the senior user can challenge the junior user unless and until it is inequitable for him to do so.”

60) In *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 Mr Justice Pumfrey, when giving his conclusion on passing-off in that case, stated:

“67 Against these findings of fact, it is possible to deal with the complaint of passing-off shortly. It must fail. Mr Alavi has been trading under the style complained of since at least 1985. He had entered the market by 1978. He did not make any relevant misrepresentation then and he had not, down to 1997 essentially changed the manner of his trading. As Oliver L.J. (as he then was) said in *Budweiser (Anheuser-Busch v. Budejovicky Budvar [1984] F.S.R. 413 at 462)*:

“The plaintiffs’ primary submission is that the learned judge was wrong in regarding the material point of time at which he should consider the matter as the date of the writ. Obviously the plaintiffs must, to succeed, have a cause of action at that date, but Mr Kentridge submits, and Mr Jeffs does not contest, that it cannot be right to look simply at that date to see whether a passing off is established. In particular to test by reference to that date whether plaintiff and defendant have concurrent reputations would simply mean that no remedy lay against a defendant who had successfully passed off his goods as the plaintiffs’, so as to establish a reputation for himself.”

This is consistent with what was said by Lord Scarman, giving the opinion of the Board in *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Pty Ltd [1981] R.P.C. 429 at 494*: the relevant date in law is the date of the commencement of the conduct complained of. I should just add that there must come a time after which the court would not interfere with a continued course of trading which might have involved passing off at its inception but no longer did so: logically, this point would come six years after it could safely be said that there was no deception and independent goodwill had been established in the market by the protagonists. There must also be doubt as to the availability of injunctive relief if there is no passing-off at the date the action is commenced.”

61) Mr Recorder Iain Purvis QC gave his understanding of the position with regard to concurrent goodwill in *WS Foster & Son Limited v Brooks Brothers UK Limited* [2013] EWPCC 18, thus:

### **“Concurrent goodwill**

56 It is well-established that there are cases in which, despite the existence of the elements of the ‘classical trinity’ of goodwill, likelihood of deception and damage, a Claimant will not be able to restrain the use of a confusingly similar mark by a Defendant. One subset of these cases is where the Defendant can justify the use of his mark on the basis of his own goodwill built up independently of the Claimant. In *Phones 4U* at paragraph 21 Jacob LJ described such a case of ‘honest concurrent use’ as being an example of ‘tolerated deception or a tolerated level of deception’. The Defendant in the present case claims the benefit of such a defence.

57 The doctrine was explained by Lord Diplock in *General Electric* [1972] 1 *WLR* 729 at 743 as follows:

‘the interest of the public in not being deceived about the origin of goods had and has to be accommodated with the vested right of property of traders in trade marks which they have honestly adopted and which by public use have attracted a valuable goodwill.’

58 In *Hotel Cipriani v. Cipriani (Grosvenor Street) Ltd* [2009] *RPC* 9 , Arnold J at first instance noted at [232] that concurrent goodwill ‘*can in appropriate circumstances constitute a defence to a passing off claim*’. So far as I am aware, there are two recognised types of ‘appropriate circumstances’ in which a defence of based on honest concurrent use may exist.

59 The first type involves independent goodwill built up over the years in separate localities by different traders who then come into collision as a result of increased trade. This is the first instance given by Lord Diplock in *GE* after the passage quoted above. One example of this in the authorities (though strictly obiter) is the position of the Defendant in the *Hit Factory* case, see *Peter Waterman v CBS United Kingdom Ltd* [1993] *ETMR* 27 at 50.

60 The second are ‘common ancestor’ cases where both parties originally derived their use of the name legitimately from the same source and have since traded under the name alongside one another. The most famous example of this is the clockmaker case of *Dent v Turpin* (1861) 2 *J&H* 139 quoted by Jacob LJ in *Phones 4U* at 22 . There, father Dent had two clock

shops in London and had bequeathed one each to his two sons. Both traded legitimately as Dent, and it is clear that neither could have brought an action to stop the other. Either or both was entitled to bring an action to stop a third party, Mr Turpin, from using the Dent name. Other examples can be seen on the facts of *Habib Bank v Habib Bank [1982] RPC 1* and *Sir Robert McAlpine v Alfred McAlpine [2004] RPC 36*. McAlpine is also an illustration of one of the limits of the doctrine: if the Defendant starts to trade in a way which is materially different from the way in which he has legitimately built up his own goodwill, so as to cause confusion with the Claimant (in that case it involved a change in the use of the sign itself, by dropping the distinguishing identifier 'Alfred', but other instances might involve a change of business practice such as moving to a different geographical area), then the honest concurrent use defence will not help him."

62) In my view, the following factual picture existed when the applicant filed its trade mark in October 2010:

- i) The opponent had a goodwill associated with the name TRIPP LITE of 14 years standing in the field of electrical goods such as UPS.
- ii) The opponent had been selling laptop bags and backpacks since 2008 but the level of such sales meant that the sale of such goods was only weakly associated with the opponent's goodwill, and this was getting weaker as by the relevant date the sales had begun to decline.
- iii) The applicant had a strong goodwill associated with the name TRIPP of 11 years standing in the luggage field.
- iv) The applicant has also sold luggage (suitcases) under the name TRIPP LITE since 2004, but the impact of this name is not strong; it is a sub-brand of TRIPP and it does not appear to have been promoted heavily and is not used on the actual goods (although it does appear on websites identifying the products). Thus, the TRIPP LITE name was only weakly associated with the applicant's goodwill under TRIPP.
- v) The applicant has sold TRIPP bags specifically identified as being suitable to carry laptops, but it is not clear when this started.

63) It seems to me that the applicant's goodwill (under TRIPP) in the luggage field is significantly stronger and more established than the opponent's goodwill (under TRIPP LITE) in the laptop bag field. Furthermore, if the relationship between laptop bags and luggage is such that deception and damage is likely (as claimed by the opponent), it was the opponent's move, in 2008, into the sale of its particular type of bags under TRIPP LITE which caused this. In other words, any deception would likely have flowed the other way, against the opponent's



claim. Given the relatively small (and diminishing) scale and relatively recent nature of the extension of the opponent's business to laptop bags, the parties had not reached a point by 2010 where it would have been too late for the applicant to object to the opponent's use of TRIPP LITE for these bags. So, in fact, the applicant may have been in a position to prevent the opponent's use of its sign, particularly given that the addition of LITE will be seen simply as a light range of TRIPP product and that the expansion from luggage to laptop bags is a far more natural one than an expansion from UPS etc to laptop bags. I therefore consider that the applicant's position as the senior user of TRIPP in the luggage field means that it should prevail in these proceedings. Put simply, the factual matrix means that at the relevant date the opponent would not have been able to prevent the applicant from using its mark for any of the goods it wishes to register. **The ground of opposition under section 5(4)(a) is hereby dismissed.**

64) I should add that there is one piece of evidence that I have yet to refer to. This consists of a further affidavit from Mr Mazalin who describes an email exchange from what appears to be a customer of the applicant (she had purchased a suitcase) but when encountering a problem with her suitcase she sent an email to the opponent for advice on the problem encountered. The evidence was late but taken into the proceedings without objection from the applicant. Whilst I have borne the evidence in mind, it has had no material impact on my decision. The evidence relates to just one person so does little to evidence the reaction of a substantial proportion of customers. But, furthermore, its extremely limited weight is reduced to insignificance by the fact that the person who sent the email has not given evidence and the circumstances which led her to contacting the opponent are not known. Therefore, this evidence cannot be taken as either supporting or undermining any of the findings I have made.

### **COSTS**

65) The applicant has been successful and is entitled to a contribution towards its costs. My assessment is as follows:

*Preparing a statement and considering the other side's statement - £400*

*Considering and filing evidence - £1000*

*Attending the hearing - £800*

**Total - £2200**

66) I hereby order Tripp Manufacturing Corporation to pay Tripp Limited the sum of £2200 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 16th day of July 2014**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**

---

<sup>i</sup> The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 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, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).