

O-158-16

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS 3057421 AND 3063545
IN THE NAME OF TARA BYRNE
FOR REGISTRATION OF THE TRADE MARKS

ERiS

ERiS

AND

ERIS

AND

CONSOLIDATED OPPOSITIONS THERETO UNDER NOS 403033 AND 403331
BY ERES (SOCIÉTÉ PAR ACTIONS SIMPLIFIÉE)



Background

1. On 9 July 2014, Tara Byrne (“the applicant”) sought registration of the following:

Application No 3057421 for a series of two marks as shown on the cover page of this decision. Registration is sought in respect of goods in classes 1, 3, 10, 11, 16 and 18. The application was published in *Trade Marks Journal* 2014/029 on 11 July 2014.

Application No 3063545 for the trade mark ERIS for goods in classes 1, 3, 10, 11, 16 and 18. The application was published in *Trade Marks Journal* 2014/037 on 5 September 2014.

2. Following publication, notices of opposition were filed against each application by Eres (Société par Actions Simplifiée) (“the opponent”) relying on grounds under section 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). In each case, the opponent relies on the following UK and European Union (formerly Community) trade marks (“EUTM”):

Mark	Dates
2163133 ERES (under sections 5(2)(b) and 5(3))	Filing date: 2 April 1998 Date of entry in register: 13 November 1998
EUTM 9084286  (under sections 5(2)(b) and 5(3))	Filing date: 6 May 2010 Date of entry in register: 17 February 2012
EUTM 4980579  (under section 5(2)(b))	Filing date: 27 March 2006 Date of entry in register: 31 May 2007

3. The applicant filed counterstatements denying the grounds of opposition. Both parties filed evidence with the applicant also filing written submissions. The matter came before me for a hearing on 4 February 2016. At that hearing, the opponent was represented by Ms Marisa Broughton of Withers & Rogers LLP. Skeleton arguments were filed by Mr John Hanna of Hanna IP who had represented the applicant throughout, though neither the applicant nor any representative attended.

The evidence

4. I do not intend fully to summarise the evidence here but will refer to it as necessary in this decision. It consists of the following:

Opponent's evidence

5. This takes the form of a witness statement of Jennifer Pickett dated 18 May 2015 with exhibits JP1 to JP8. Ms Pickett is Global Head of Trade Mark Protection for Chanel and has power of Attorney for all Intellectual Property matters for the opponent company. She states that Chanel bought the opponent in 1996.

Applicant's evidence and submissions

6. This takes the form of a witness statement of John Hanna dated 16 October 2015 along with exhibits 1 to 7.

Decision

The objections under section 5(2)(b) of the Act

7. Section 5(2)(b) of the Act states:

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

8. An earlier mark is defined in section 6 (1) of the Act which states:

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

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

(b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), (ba) a registered trade mark or international trade mark (UK) which-

(i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.”

The objections under section 5(2)(b) based on earlier trade mark nos 2163133 and EUTM 4980579

9. The trade marks relied on by the opponent are each earlier marks within the meaning of the Act. Their registration procedures were completed before the start of the period of five years ending with the date of publication of the applications opposed therefore the provisions of section 6A of the Act are relevant. It states:

“6A. - (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 -

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

(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.”

10. In its counterstatement, the applicant puts the opponent to proof of use of these earlier marks. That being so, section 100 of the Act is also relevant. It states:

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

11. As set out above, whilst the two applications under opposition were filed on the same day, they were published on different dates. The relevant five year periods within which the opponent must prove use of the two earlier marks, one of which is an EUTM, are 6 September 2009 to 5 September 2014 (3063545) and 12 July 2009 to 11 July 2014 (3057421). These two periods substantially overlap. The opponent relies on its earlier trade marks under this ground only insofar as they are registered for *beach bags*.

12. The question of what constitutes genuine use of a mark is well established. In *The London Taxi Corporation Limited t/a The London Taxi Company v Frazer-Nash Research Limited and Ecotive Limited* [2016] EWHC 52(Ch) Arnold J stated as follows:

“219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the

consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

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

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

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

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

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

13. As one of the earlier marks relied on by the opponent is an EUTM, I also take note that in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union (“CJEU”) stated:

“36.It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining

genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods

or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

14. With the above in mind, I go on to consider the evidence filed by the opponent insofar as it relates to *beach bags*. The opponent’s evidence consists of a witness statement of Jennifer Pickett. Part of Ms Pickett’s witness statement and exhibit JP1 attached to it have been made subject to an order for confidentiality directing that it should not be made available to the public.

15. Ms Pickett gives no evidence as to any use of the earlier marks anywhere other than in the UK. She states that both earlier marks were first used in the UK in respect of beach bags in mid-2011. TEXT REDACTED.

16. Ms Pickett states that the opponent “has been able to partake in mutually beneficial collaborations with other well-known fashion brands, including Longchamp.” She states that Longchamp “designed a beach bag to bear the ERES trade mark, in return for [the opponent] designing a floral bikini...”. She states that this “bi-coloured beach bag design...was called RIVAGE and was made available for sale by [the opponent] in 2011.

17. At JP5, Ms Pickett exhibits a number of press articles and screenshots from the opponent’s website which, she states, show the Rivage bag on sale. At pages 265 and 266 are copies of the same page from *Vogue* from February 2011. I can see that the short article on the page refers to a joint venture between the opponent and Longchamp and a bag is shown beside the text but the text itself is illegible on both copies. At page 267 is a screenshot from the champagneandheels.com website. The text refers to the collaboration for spring summer 2011 between the opponent and Longchamp with the latter company “creating the Rivage beach bag” for the opponent. The text states that “The Rivage bag will be available at [the opponent’s] boutiques just in time for winter break starting in January. At page 268 is a screenshot from the mabqueen and globalblue websites. The former shows a “Longchamp Pliage bag for Eres SS11”. The latter is headed Longchamp and refers to its “most iconic bag Le Pliage [which] is reinvented in spring/summer 2011’s creative collaboration with [the opponent]”. It describes the Rivage as having “subtle details including the Eres logo and having “enough space to carry all those summer necessities, from towels and swimwear to sunscreen and flip-flops.” The picture of the bag shows ERES in what appears to be the stylised form on the handle attachment. The website gives contact details of the Longchamp company at a Dusseldorf address. At page 269 is a screenshot from the opponent’s French website. Showing the Rivage beach bag it describes it as a “Two-color foldable beach bag...” the page indicates it was printed on 24 January 2011.

18. At JP4 are exhibited a collection of catalogues which include swimwear catalogues. None of them show any bags being offered for sale but I note that the opponent’s boutiques are listed on some of them, one of them being in London.

19. At JP6, page 271, Ms Pickett exhibits a screenshot from the eresparis website. Dated 22 May 2012, it is headed “News” and refers to “Eres beach accessories” including bags. At pages 272 and 273 are similar screenshots dating from April and May 2014 which show a similar bag.

20. TEXT REDACTED

21. TEXT REDACTED. Whilst there is some evidence that beach bags have appeared on the opponent's (French) website, there is no evidence that they were for sale through that website nor is there any evidence as to who may have accessed that website. There is evidence of collaboration with another company whereby the two worked to their mutual benefit with that other company designing a beach bag for the opponent, however, there is no evidence of any advertising of beach bags under the earlier marks in the UK within the relevant periods. Taking the evidence as a whole, I do not consider that the opponent has shown genuine use of either earlier mark within the relevant periods in relation to beach bags.

22. In *Guccio Gucci SPA v Gerry Weber International* O-425-14, Mr Daniel Alexander Q.C. sitting as the Appointed Person stated:

“The Registrar says that it is important that a party puts its best case up front –with the emphasis both on “best case” (properly backed with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of procedural error. It is particularly important for undertakings which rely on brands and trade marks which are instruments against counterfeiting and other infringement to bear this in mind. The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it-and file the best evidence first time round- or lose it”.”

23. Whilst those comments were made in relation to an application for revocation, the same principles hold true in relation to proof of genuine use. If a party has used its mark(s) in relation to certain goods, it should be easy enough for it to get the evidence together to show it. As Mr Alexander also stated:

“The burden lies, and lies wholly, on the proprietor to get it right. That is clear from the terms of the Trade Marks Act (s.100) and the rules made under it.”

24. As I have found the opponent has not shown that it has made genuine use of its mark in relation to the goods on which it seeks to rely, its objection to the applications under section 5(2)(b) based on its earlier trade marks no 2163133 and EUTM 4980579 fail.

The objection under section 5(2)(b) based on EUTM 9084286

25. Whilst the opponent's mark is an earlier mark within the meaning of the Act, it is not subject to the proof of use requirements set out above and so it is entitled to rely on it in respect of each of the goods for which it is registered and as specified in its notice of opposition.

26. In determining whether there is a likelihood of confusion between the respective marks, the European courts have provided guidance. The following principles are

gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated 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 be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the respective goods

27. The goods to be compared are as follows:

Goods relied on by the opponent	Applicant's goods
<p>Class 3 Preparations for application to or care of nails; soaps; perfumes; essential oils; cosmetics; non-medicated toilet preparations</p>	<p>Class 1 Raw materials [chemical] for the formulation of cosmetic products; Ultraviolet absorbing agents for use in cosmetic products; Collagen based ingredients for cosmetic preparations (3057421)</p> <p>Chemical preparations for use in cosmetic products; Emulsifiable beeswax derivative for use in the manufacture of cosmetic preparations; Polymeric chemicals for use in the cosmetic industry; Raw materials [chemical] for the formulation of cosmetic products; Ultraviolet absorbing agents for use in cosmetic products; Collagen based ingredients for cosmetic preparations (3063545)</p> <p>Class 3 Cosmetic oils; Cosmetic rouges; Rose oil for cosmetic purposes; Cocoa butter for cosmetic purposes; Cotton balls for cosmetic purposes; Cotton swabs for cosmetic purposes; Pre-moistened cosmetic tissues; Pre-moistened cosmetic towelettes; Pre-moistened cosmetic wipes; Artificial nails for cosmetic purposes; Body paint (cosmetic); Collagen preparations for cosmetic application; Cosmetic eye gels; Cosmetic eye pencils; Cosmetic moisturisers; Cosmetic powder; Cosmetic preparations for use as aids to slimming; Essential oils for cosmetic purposes; Facial cleansers [cosmetic]; Facial creams [cosmetic]; Facial lotions [cosmetic]; Facial moisturisers [cosmetic]; Facial scrubs</p>

	<p>[cosmetic];Facial toners [cosmetic];Facial washes [cosmetic];Impregnated cloths for cosmetic use; Lacquer for cosmetic purposes; Lint for cosmetic purposes; Lip coatings [cosmetic];Lip protectors [cosmetic];Mineral oils [cosmetic];Moist wipes impregnated with a cosmetic lotion; Moisturising body lotion [cosmetic];Moisturising concentrates [cosmetic];Moisturising gels [cosmetic];Moisturising skin creams [cosmetic];Moisturising skin lotions [cosmetic];Natural oils for cosmetic purposes; Ointments for cosmetic use; Pencils for cosmetic use; Self tanning creams [cosmetic]; Self tanning lotions [cosmetic];Skin balms [cosmetic];Skin care creams [cosmetic];Skin care lotions [cosmetic];Skin cleansers [cosmetic];Skin creams [cosmetic];Skin lightening compositions [cosmetic];Skin whitening preparations [cosmetic];Temporary tattoo's for cosmetic purposes; Tonics [cosmetic];Toning creams [cosmetic];Cosmetic preparations; Slimming aids [cosmetic], other than for medical use; Glitter for cosmetic purposes; Eyelashes (Cosmetic preparations for -);Baths (Cosmetic preparations for -);Cotton sticks for cosmetic purposes; Cotton wool for cosmetic purposes; Cosmetic kits; Kits (Cosmetic -);Pencils (Cosmetic-) ;Creams (Cosmetic -);Petroleum jelly for cosmetic purposes; Jelly (Petroleum -) for cosmetic purposes; Greases for cosmetic purposes; Skin care (Cosmetic preparations for -);Lotions for cosmetic purposes; Oils for cosmetic purposes; Hydrogen peroxide for cosmetic purposes; Almond milk for cosmetic purposes; Dyes (Cosmetic -);Pomades for cosmetic purposes; Adhesives for cosmetic purposes; Tissues impregnated with cosmetic lotions; Lotions (Tissues impregnated with cosmetic -);Cosmetic preparations for slimming purposes; Slimming purposes</p>
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	(Cosmetic preparations for -); Bleaching preparations [decolorants] for cosmetic purposes; Astringents for cosmetic purposes; Transfers (Decorative -) for cosmetic purposes; Aloe vera preparations for cosmetic purposes. (both applications)
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28. In the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated, at paragraph 23:

“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”.

29. The relevant factors identified by Jacob J. in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods and services, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

30. In comparing the respective goods, I also bear in mind the following guidance provided by the General Court (“GC”) in *Gérard Meric v OHIM*, Case T-133/05:

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

31. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

32. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods and/or services is to assess whether the relevant public are liable to believe that responsibility for them lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....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.”

33. The opponent’s goods in class 3 are, broadly speaking, perfumes, essential oils, cosmetics and toiletries. The applicant’s goods in class 1 are, broadly speaking, raw materials and ingredients for use in the manufacture of cosmetic products and preparations.

34. Attached to his witness statement filed on behalf of the applicant, Mr Hanna, at exhibit 6, has filed a copy of part of what he states are “OHIM’s Guidelines for Examination in the OHIM Office” and submits that “they consider that, other than in certain limited circumstances, class 1 goods are not considered similar to class 3 goods”. He does not provide anything to explain what the “certain limited circumstances” might be but whilst I note the guidelines, I am not bound by them and will make my own determination in line with the above case-law.

35. In its notices of opposition, the opponent submits that “the greater the significance of the raw material to the end product, the more likely the goods will be considered similar”. In her witness statement, Ms Pickett submits that “cosmetic companies often brand the active ingredients within their Class 3 products and that consequently, the consumer is educated to know that the active ingredients and end product originate from the same or an economically linked undertaking”. At JP15 Ms Pickett exhibits what she states are “details of the active ingredients that have been developed and registered as trade marks” by a number of companies. The exhibits contains of a number of pages which refer to the development of certain goods by cosmetic companies for use in their products. There are further pages which show cosmetic products and highlight the “active ingredients” they contain. Finally, there are printouts from the respective registers showing UK and EUTM registrations

which cover both raw ingredients (chemicals) for use in cosmetics and cosmetic products themselves.

36. The fact that the same trade mark may be registered by a company in respect of goods in more than one class does not make those goods similar. Furthermore, as was stated in *Les Éditions Albert René V Office for Harmonisation in the Internal Market (Trade Marks & Designs) (OHIM) T-336/03*:

“The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

37. The applicant’s goods as covered by the specifications in class 1 are each raw materials for use as ingredients to make cosmetic products. As raw materials, they will be used with other ingredients by manufacturers of cosmetics to create a finished article for onward sale to the end consumer. The opponent’s goods are finished products that will be used by the end consumer to beautify or otherwise enhance personal appearance. The users, uses and natures of the respective goods therefore differ. Neither do the trade channels overlap: raw materials are likely to reach the market through specialist trade suppliers whilst cosmetics will be retailed in e.g. supermarkets, pharmacies and specialist cosmetic stores. One is not a substitute for another even though the raw ingredient is specified as being for use in cosmetic products. Whilst I accept that some cosmetics are marketed with reference to an ingredient within them, I do not consider, and there is no evidence to show, that the relevant public are liable to believe that responsibility for the respective goods lies with the same undertaking or with economically connected undertakings. These respective goods are not similar.

38. Each of the applicant’s goods in class 3 is stated to be a cosmetic or for cosmetic purposes. The opponent’s goods in Class 3 include cosmetics as well as non-medicated toilet preparations. In my view, each of the goods within the applicant’s specification are included within that of the opponent and are therefore identical goods on the basis set out in *Meric*.

39. I have found that the applicant’s goods in class 1 are dissimilar to the goods relied on by the opponent. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

“49... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

40. I therefore continue with the consideration of likelihood of confusion in respect only of the applicant’s goods in class 3.

The average consumer and the nature of the purchasing process

41. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and/or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

42. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

43. The respective goods are such as are bought by the general public. They are each goods that are widely available whether from a store (physical or virtual) or catalogue. The purchase will be primarily visual and will involve a reasonable degree of care given that the goods will be used on the person.



Comparison of the respective marks

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

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

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

46. The marks to be compared are as follows:

Opponent's earlier mark	Applicant's marks
	 <p data-bbox="930 633 1265 667">(3057421-series of two)</p>
	<p data-bbox="1026 819 1169 887">ERIS (3063545)</p>

47. The opponent's earlier mark consists of four characters. There is a degree of stylisation in the individual letters E-E-S within the word however that degree is extremely slight. The second character within the word is not a standard letter and is a distinctive element, however, despite the absence of the upright, it is most likely to be taken to be a representation of the letter R. It follows that this mark will be seen as the word ERES and this is the overall impression conveyed by the mark.

48. The applicant's mark no 3063545 consists of the word ERIS. Presented in plain block capitals with no part of it highlighted or emphasised in any way, its distinctiveness rests in its whole. The applicant's mark no 3057421 consists of a series of two marks which differ from each other in that the one is presented in black and the other in 'shaded' style but both consist of the word ERIS in a standard font albeit with the tittle of the letter 'i' replaced with the device of an apple. Whilst the apple device may be a distinctive element (I say 'may' given that some cosmetic products may e.g. have an apple fragrance) the overall impression conveyed by the mark is in the word ERIS.

49. On a visual consideration, each of the respective marks consists of four letters (or what will be seen as four letters in the case of the earlier mark). Three of the four letters are the same and in the same position. In the case of the earlier mark, the third letter is the vowel "E" whilst in the applicant's marks the third letter is the vowel "i" with the tittle replaced by the device of an apple. The marks are visually similar to a reasonably high degree.

50. Aurally, each of the respective marks consist of two syllables most likely pronounced as "err-es/err-is". The first syllable is identical. Whilst the second syllables begin with different letters, both are vowel sounds which, in ordinary speech will be all but indistinguishable given their positions within the marks. If not identical, the respective marks are aurally similar to the highest degree.

51. In the counterstatement, the applicant submits:

“The opposed mark is the name of the Greek Goddess of discord while the opponent’s word mark Eres has no meaning in the English language but translates to the Spanish verb “you are”.”

52. In addition, at his Exhibit 5, Mr Hanna exhibits what he says is the British Film Institute’s UK box office figures relating to the film *Sinbad; Legend of the Seven Seas* which he downloaded from their website on 25 August 2015. Mr Hanna’s evidence does not explain the relevance of this information though it appears to be put forward on the basis that the relevant UK consumer would be aware of the meaning of ERIS by virtue of the character bearing that name in the Sinbad movie.

53. The opponent submits:

“A conceptual comparison of the marks must be determined having regard to the linguistic knowledge of the relevant public...The Opponent does not believe that the average consumer would recognise that ERIS is the name of the Greek Goddess of Discord and would not be aware that ERES translates to the Spanish verb “you are”. On the contrary, the Opponent believes that the conceptual meanings of the trade marks will not be apparent to the relevant consumer...”

54. I have no personal knowledge of the Sinbad film and no evidence is provided about it other than that outlined above, however, even if it contained a character with the name Eris, there is no evidence that the average consumer would have been aware of it either then or at the relevant date in these proceedings, more than a decade after the film was said to have been released. Neither is there any evidence that the average consumer would know it to be the name of a Greek goddess or indeed as a name at all. Whilst there are some who will have varying degrees of knowledge of the Spanish language, I do not consider and there is no evidence to show that the average consumer will assume the opponent’s mark is derived from a Spanish verb. In my view, neither of the respective marks has any clear and immediate conceptual meaning and it is much more likely that the average consumer will see them both as invented words. The conceptual position is therefore neutral.

The distinctiveness of the earlier mark

55. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade 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 trade mark to identify the goods or services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods or services from those of other undertakings – *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

56. In relation to the use made of the earlier mark relied upon, in her witness statement Ms Pickett states:

“ERES has been in use in the United Kingdom in respect of...nail polish since 2012...”

She later states:

“Eres launched three nail varnishes with its Spring/Summer 2012 collection, directly inspired by the key colours of their swimwear collection, orange, pink and brown. The nail varnish products were available in ERES boutiques and the online boutique store.”

57. Ms Pickett does not provide any details of turnover figures for these goods but, at JP3, she exhibits “copies of various UK fashion and lifestyle editorials regarding the launch of the ERES ...nail polish.” The exhibit consists of five pages. The first (page 50) makes no reference to any of the goods relied upon by the opponent under this ground. At page 51 is an extract said to have appeared in *The Independent* in May 2012. Whilst the quality of the print is poor, I can see there is an advertisement for “polish from Eres” available from its shop in London. At page 52 is an extract from *Red* also from May 2012 which shows a number of nail polish colours from various suppliers. Again the quality of the print is poor but one of them appears to be an ERES polish. Page 53 is a print of a very short extract dated November 7, 2011 which appears to have been downloaded from the wwd.com website. It is headed “Eres Sets Nail Polish Range” and announces that the company will “dip into the nail polish market for the first time next spring” through a “launch worldwide in its own stores and franchises [of] a limited-edition line of three nail varnishes...”. The article gives details of the price of these items in euros and dollars. The final page is taken from *Glamour*, May 2012 edition, and includes a picture of a bottle of “Nail Lacquer in Soufi” which has the stylised mark imprinted on the bottle.

58. The earlier mark is relied upon for a wide range of cosmetic and toiletry items as well as perfumes but the only evidence is in relation to a very limited edition of three nail polishes during May 2012 which were shown in a few magazines. I have no details of advertising or turnover figures for any of the goods relied upon. On the basis of the evidence, I am unable to find that the distinctiveness of the mark has been enhanced because of the use made of it. The mark has a relatively high degree of inherent distinctive character.

Likelihood of confusion

59. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the

opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them (s)he has retained in mind.

60. Earlier in this decision I concluded:

- The respective goods are identical;
- The average consumer of those goods is a member of the general public with the purchase being primarily visual and made with a reasonable degree of care;
- The overall impression of the respective marks rests in the words ERES/ERIS;
- The respective marks share a reasonably high degree of visual similarity and if not identical then they share the highest degree of aural similarity. The conceptual position is neutral;
- The earlier mark has a relatively high degree of inherent distinctive character which has not been shown to have been enhanced through its use.

61. Taking all factors into account, I consider there is a likelihood of direct confusion with one mark being mistaken for the other. The opposition to the applications insofar as they seek registration for goods in class 3 therefore succeed under section 5(2)(b) of the Act based on the earlier EUTM 9084286.

The objections under section 5(3) of the Act

62. Under this ground, the opponent objects to the applications insofar as they seek registration of the following goods in class 1, class 3 and class 18.

Class 1:

Raw materials [chemical] for the formulation of cosmetic products; Ultraviolet absorbing agents for use in cosmetic products; Collagen based ingredients for cosmetic preparations (3057421)

Class 1:

Chemical preparations for use in cosmetic products; Emulsifiable beeswax derivative for use in the manufacture of cosmetic preparations; Polymeric chemicals for use in the cosmetic industry; Raw materials [chemical] for the formulation of cosmetic products; Ultraviolet absorbing agents for use in cosmetic products; Collagen based ingredients for cosmetic preparations (3063545)

Class 3:

Cosmetic oils; Cosmetic rouges; Rose oil for cosmetic purposes; Cocoa butter for cosmetic purposes; Cotton balls for cosmetic purposes; Cotton swabs for cosmetic purposes; Pre-moistened cosmetic tissues; Pre-moistened cosmetic towelettes; Pre-moistened cosmetic wipes; Artificial nails for cosmetic purposes; Body paint (cosmetic); Collagen preparations for cosmetic application; Cosmetic eye gels; Cosmetic eye pencils; Cosmetic moisturisers; Cosmetic powder; Cosmetic preparations for use as aids to slimming; Essential oils for cosmetic purposes; Facial cleansers [cosmetic]; Facial creams [cosmetic]; Facial lotions [cosmetic]; Facial moisturisers [cosmetic]; Facial scrubs [cosmetic]; Facial toners [cosmetic]; Facial washes [cosmetic]; Impregnated cloths for cosmetic use; Lacquer for cosmetic

purposes; Lint for cosmetic purposes; Lip coatings [cosmetic]; Lip protectors [cosmetic]; Mineral oils [cosmetic]; Moist wipes impregnated with a cosmetic lotion; Moisturising body lotion [cosmetic]; Moisturising concentrates [cosmetic]; Moisturising gels [cosmetic]; Moisturising skin creams [cosmetic]; Moisturising skin lotions [cosmetic]; Natural oils for cosmetic purposes; Ointments for cosmetic use; Pencils for cosmetic use; Self tanning creams [cosmetic]; Self tanning lotions [cosmetic]; Skin balms [cosmetic]; Skin care creams [cosmetic]; Skin care lotions [cosmetic]; Skin cleansers [cosmetic]; Skin creams [cosmetic]; Skin lightening compositions [cosmetic]; Skin whitening preparations [cosmetic]; Temporary tattoo's for cosmetic purposes; Tonics [cosmetic]; Toning creams [cosmetic]; Cosmetic preparations; Slimming aids [cosmetic], other than for medical use; Glitter for cosmetic purposes; Eyelashes (Cosmetic preparations for -); Baths (Cosmetic preparations for -); Cotton sticks for cosmetic purposes; Cotton wool for cosmetic purposes; Cosmetic kits; Kits (Cosmetic-); Pencils (Cosmetic-); Creams (Cosmetic-); Petroleum jelly for cosmetic purposes; Jelly (Petroleum -) for cosmetic purposes; Greases for cosmetic purposes; Skin care (Cosmetic preparations for -); Lotions for cosmetic purposes; Oils for cosmetic purposes; Hydrogen peroxide for cosmetic purposes; Almond milk for cosmetic purposes; Dyes (Cosmetic-); Pomades for cosmetic purposes; Adhesives for cosmetic purposes; Tissues impregnated with cosmetic lotions; Lotions (Tissues impregnated with cosmetic-); Cosmetic preparations for slimming purposes; Slimming purposes (Cosmetic preparations for -); Bleaching preparations [decolorants] for cosmetic purposes; Astringents for cosmetic purposes; Transfers (Decorative-) for cosmetic purposes; Aloe vera preparations for cosmetic purposes. (Both applications)

Class 18:

Cosmetic bags sold empty; Cosmetic purses; Cosmetic bags; Cosmetic bags [not fitted]. (Both applications)

63. The opponent relies on its earlier marks no 2163133 and EUTM 9084286 insofar as they are registered for:

swimwear; bathing suits; beachwear; leisure wear; lingerie (2163133)

Women's wear, namely swimwear, bathing suits, beachwear, leisure wear, lingerie (CTM 9084286)

64. I note that the latter specification includes the word "namely". This must be approached, as indicated in the Trade Mark Registry's classification guidance, on the basis shown below:

"Note that specifications including "namely" should be interpreted as only covering the named goods, that is, the specification is limited to those goods. Thus, in the above "dairy products namely cheese and butter" would only be interpreted as meaning "cheese and butter" and not "dairy products" at large. This is consistent with the definitions provided in Collins English Dictionary which states "namely" to mean "that is to say" and the Cambridge International Dictionary of English which states "which is or are"."

65. Section 5(3) 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.”

66. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

67. The first issue to be determined is whether there is the necessary reputation. One of the two marks relied upon is an EUTM. In *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, the CJEU held that:

“20. By its first question, the national court in essence asks the Court, first, to clarify the meaning of the expression ‘has a reputation in the Community’, by means of which, in Article 9(1)(c) of the regulation, one of the conditions is laid down which a Community trade mark must fulfil in order to benefit from the protection accorded by that provision and, second, to state whether that condition, from a geographical point of view, is satisfied in a case where the Community trade mark has a reputation in only one Member State.

21. The concept of ‘reputation’ assumes a certain degree of knowledge amongst the relevant public.

22. The relevant public is that concerned by the Community trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector (see, by way of analogy, *General Motors*, paragraph 24, with regard to Article 5(2) of the directive).

23. It cannot be required that the Community trade mark be known by a given percentage of the public so defined (*General Motors*, by way of analogy, paragraph 25).

24. The degree of knowledge required must be considered to be reached when the Community trade mark is known by a significant part of the public concerned

by the products or services covered by that trade mark (*General Motors*, by way of analogy, paragraph 26).

25. In examining this condition, 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 (*General Motors*, by way of analogy, paragraph 27).

26. In view of the elements of the main proceedings, it is thus for the national court to determine whether the Community trade mark at issue is known by a significant part of the public concerned by the goods which that trade mark covers.

27. Territorially, the condition as to reputation must be considered to be fulfilled when the Community trade mark has a reputation in a substantial part of the territory of the Community (see, by way of analogy, *General Motors*, paragraph 28).

28. It should be noted that the Court has already ruled that, with regard to a Benelux trade mark, it is sufficient, for the purposes of Article 5(2) of the directive, that it has a reputation in a substantial part of the Benelux territory, which part may consist of a part of one of the Benelux countries (*General Motors*, paragraph 29).

29. As the present case concerns a Community trade mark with a reputation throughout the territory of a Member State, namely Austria, the view may be taken, regard being had to the circumstances of the main proceedings, that the territorial requirement imposed by Article 9(1)(c) of the regulation is satisfied.

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.”

68. In her witness statement, Ms Pickett states that the earlier marks have been in use in the United Kingdom in respect of swimwear and lingerie since at least 1999, in respect of leisure wear since 2008 and beachwear since 2011. TEXT REDACTED.

69. Ms Pickett states these are wholesale figures “so the retail price will be significantly higher”. Although no details are given of how much higher such figures might be, I note that there are references in the exhibits to the retail cost of various items. These include an article from the fashionunited.co.uk website dated 31 March 2014 which refers to items of swimwear and lingerie being available through the net-a-porter website with prices ranging from £150 to £890” (see exhibit JP9 page 302).

TEXT REDACTED.

70. Ms Pickett states that authorised ERES retailers such as Fenwick, Harrods, Selfridges, Harvey Nichols and Liberty have all sold ERES products “within the last five years”. Given that her witness statement is dated May 2015, it is not possible to determine whether, and if so how many, such sales were made before the relevant date but, in any event, she gives no further details of what particular goods may have been sold by any of them at any particular time or the volume of such sales.

71. At JP10, p305 is exhibited an article from *Drapers* dated November 2011 which reports on the “swimwear and lingerie brand Eres” making “its first foray into UK retail with the opening of a standalone store in London last week”. Further articles at pp310 and 311 refer to the opponent’s intention to open another boutique but these are dated November 2014 and so post-date the relevant date. Ms Pickett also states that goods are available through the net-a-porter website and the eresboutique.com website which was launched in 2011 but again, no details are given to show what may have been sold and to whom or the volume of such sales at any particular date.

72. Ms Pickett states that the opponent “continues to expand its online presence” and, at JP14, exhibits multiple pages showing screen shots from its “official Eres UK website” (boutique.eresparis.com/en) and the net-a-porter website. All were downloaded on 10 April 2015 and so post-date the relevant date. At JP6 p273 is a screenshot from the eresparis website dated April 2014. It shows a woman wearing a wrap and carrying a handbag but other than a tagline “summer looks” no other details are shown. Ms Pickett states that the opponent also has a facebook, Instagram, Pinterest and YouTube presence. Although no further details of the opponent’s introduction into these social media sites are given, at page 450 of the same exhibit is a screen shot of the facebook page. It shows it was downloaded in 2015.

73. At JP4 Ms Pickett exhibits copies of what she describes as “swimwear, lingerie and leisure wear catalogues for 2010, 2011, 2012, 2013 and 2014”. The exhibit consists of over 200 pages. Most do not show anything but photographs of women modelling various items of clothing though a few give very brief details of some of the products in several languages including in English and some others give details of stockists. Some of these latter pages include details of a single store located in London. No details are given of the number of catalogues distributed or how and to whom they may have been distributed.

74. At JP9 Ms Pickett exhibits copies of what she describes as UK editorials. They include:

p289: an article dated 26 October 2009 from *Elle* magazine stating that “Eres, the fabulously chic French label....is taking residence in Selfridges with its first-ever UK boutique” and refers to its “impeccably fitting swimsuits” and its lingerie.

P295: an article dated 19 October 2009 from *independent.co.uk* which refers to the forthcoming opening of a new Eres concession at Selfridges in

November. It also states that “Eres’ swimming costumes are loved by every fashion editor for their sculpting and ergonomic designs”.

p296: an article dated January 2011 from *Sunday Express* showing an advertisement for an Eres swimsuit on sale at Harvey Nichols for £350.

75. At JP2, is exhibited an article dated 8 August 2011 published in the New York Times. Ms Pickett states that the paper has an average daily circulation in the UK of 7686 print copies. The article quotes “fashion critic Hilary Alexander” as saying “Eres makes the best little black swimsuits in the world [which are] incredibly expensive”. It also makes reference to the opponent’s business and its having “20 stores around the world with more openings planned for later this year” though there is no reference to the UK.

76. At JP11 and JP13, Ms Pickett exhibits details of what she refers to as “press coverage in various UK fashions and lifestyle magazines”. The exhibit consists of pages dated between December 2009 and December 2013 which show extracts from magazines and newspapers including *Vogue*, *Men’s Health*, *Elle*, *The Independent*, *Easy Living*, *InStyle* and *The Evening Standard*. The extracts are presented in the form of advertorials. Whilst I can see that many show swimsuits or underwear, the quality of many of the prints make the text illegible. That said, I can see that some make reference to an Eres swimsuit (see exhibit JP13 p429 which describes it as a “must-have”) and many show photographs of such goods from a number of suppliers including the opponent.

77. As indicated earlier in this decision, Ms Pickett states that the opponent was bought by Chanel in 1996. She states that the opponent has undertaken “co-branding” with Chanel” which consists “of a series of photographs shot by Karl Lagerfeld of models wearing Chanel clothing and Eres’ 2010 Spring/Summer swimsuit and lingerie collections”. She states that the campaign was featured on the opponent’s website in May 2010 as well as on Chanel’s website. She states that the Chanel website had over 2.5 million visitors from the UK in 2010 and, at JP12, she exhibits screenshots from the “Chanel News” website page dated 6th May 2010. Whilst they are headed “CHANEL ERES PRIVATE CO-BRANDING BY KARL LAGERFELD” there is no further explanation of what this “private co-branding” means. There is some further text on the screenshot, however, it is in French.

78. Mr Hanna, on behalf of the applicant, has filed a witness statement. It acts as a vehicle to introduce a number of documents which include:

Exhibit 1: a screenshot which “provides a market analysis of the UK Swimwear market size by “Mode City...an organisation running a Swimwear and Lingerie fair in France...”;

Exhibit 2: a screenshot which “provides a market analysis of UK Swimwear market size in 2013.2014 by NPD Group dated 21st October 2014”;

Exhibit 3: a screenshot of a “news article carried and reported by Bloomberg Business dated 6th February 2013 [which] estimates the UK market size for

lingerie, pyjama and Hoisery (sic) market in 2013 at 6.9 billion US\$ [which] converts to a staggering 4.37 billion sterling”;

Exhibit 4: a screenshot which “provides a market share analysis of just the lingerie market as carried out by Drapers dated 8th September 2012 [and which] estimates the annual market in 2012 for lingerie only at 1.59 billion sterling”.

79. Whilst one of the earlier marks relied on is an EUTM, the opponent has provided no evidence to show use of either of its marks other than in the UK. In relation to this use, wholesale turnover figures are provided broken down to swimwear, lingerie and leisurewear. No details are given of the volume of sales to which these figures relate, however, given the large size of the relevant markets, they are highly unlikely to constitute anything other than an extremely small share. Whilst various catalogues are said to have been produced, no information is given about their distribution. There is some evidence that some of the opponent’s goods have been promoted alongside those of others in advertorials within the relevant period and there is some evidence that its swimming costumes are well regarded by some fashion editors, however, when considering the evidence as a whole, this is not sufficient, in my view, to show a reputation with the relevant consumer for any of the goods on which the opponent relies. That being the case, the objection under this ground fails.

Summary

80. The objections under section 5(2)(b) of the Act against both applications succeed insofar as they seek registration for goods in class 3.

The objections under section 5(2)(b) of the Act against both applications fail insofar as they seek registration for goods in class 1.

The objections under section 5(3) of the Act against both applications fail.

Subject to any successful appeal, the applications will proceed to registration for all goods except those in class 3.

Costs

81. Whilst the opponent has succeeded in its objection under section 5(2)(b) of the Act in relation to the applications for registration in class 3, it has failed in respect of all other objections. That being so, the applicant has had the far greater measure of success and is entitled to an award of costs in its favour. Taking that into account and noting that these are consolidated proceedings, I make the award on the following basis:

Preparing a statement and reviewing that of the other side:	£400
Evidence:	£800
Preparation of skeleton argument for the hearing:	£200

Total:

£1,400

82. I order Eres (Société par Actions Simplifiée) to pay Tara Byrne the sum of **£1,400**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29TH day of March 2016

**Ann Corbett
For the Registrar
The Comptroller-General**