

**O-359-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3209088  
BY FASHION ONE (EUROPE) N.V. TO REGISTER:**

**Brianna**

**AS A TRADE MARK IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 409220 BY PETRA BAUERNFEIND**

## BACKGROUND & PLEADINGS

1. On 27 January 2017, Fashion One (Europe) N.V. (“the applicant”), applied to register the trade mark **Brianna** for: “Clothing; footwear; headgear; swimwear; sportswear; leisurewear” in class 25. The application was published for opposition purposes on 10 February 2017.

2. On 9 May 2017, the application was opposed in full by Petra Bauernfeind (“the opponent”). The opposition is based upon section 5(1) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon all the goods (i.e. “Clothing; footwear; headgear; swimwear; sportswear; leisurewear”), in the following United Kingdom trade mark registration:

No. 3223595 for the trade mark **Brianna** which was applied for on 7 April 2017 (claiming an International Convention priority date of 6 January 2017 from an earlier filing in Germany) and registered on 23 June 2017.

3. The applicant filed a counterstatement in which it states:

“6. The applicant concedes that the [competing trade marks] are visually, phonetically and conceptually identical.

7. In addition, the applicant also concedes that the specification of goods between the [competing trade marks] are identical.”

4. However, having reviewed the database of the German Patent and Trade Mark Office, the applicant notes that the:

“9...German Priority mark is not registered, and the application of the German Priority mark is deemed to have been withdrawn by the [German Office]”.

And:

“10. The effect of the opponent failing to complete the registration procedure at the [German Office] is that the German Priority Mark is now deemed withdrawn, and the opponent has failed to fulfil the requirements set out under section 35(1) of the Act. The deemed withdrawal of the German Priority Mark...causes the basis of the opponent’s earlier registration...no longer subsists. The effect is that the opponent’s opposition will ultimately fail...”

5. In these proceedings, both parties represent themselves. Although neither party filed evidence or written submissions during the course of the evidence rounds, both filed written submissions in lieu of attendance at a hearing. I will refer to these submissions, as necessary, later in this decision.

## **DECISION**

6. The opposition is based upon section 5(1) of the Act which reads as follows:

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

7. An earlier trade mark is defined in section 6 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,

(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.”

8. In these proceedings, the opponent is relying upon the UK trade mark registration shown in paragraph 2 above. Although applied for on 7 April 2017 (i.e. after the filing date of the application for registration), the opponent claims an International Convention priority date of 6 January 2017 from an earlier filing in Germany.

9. Having conceded that the competing trade marks and goods are literally identical, the applicant’s sole defence to the opposition is that because the German application from which priority was claimed has been deemed withdrawn, the priority date is no longer valid. Claims to priority are governed by rule 6 of the Trade Marks Rules 2008 (“the rules”) and sections 35 and 36 of the Act. Section 35 states:

“(1) A person who has duly filed an application for protection of a trade mark in a Convention country (a “Convention application”), or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the first such application.

(2) If the application for registration under this Act is made within that six-month period-

(a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application, and

(b) the registrability of the trade mark shall not be affected by any use of the mark in the United Kingdom in the period between that date and the date of the application under this Act.

(3) Any filing which in a Convention country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

A “regular national filing” means a filing which is adequate to establish the date on which the application was filed in that country, whatever may be the subsequent fate of the application.

(4) A subsequent application concerning the same subject as the first Convention application, filed in the same Convention country, shall be considered the first Convention application (of which the filing date is the starting date of the period of priority), if at the time of the subsequent application

(a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding, and

(b) it has not yet served as a basis for claiming a right of priority.

The previous application may not thereafter serve as a basis for claiming a right of priority.

(5) Provision may be made by rules as to the manner of claiming a right to priority on the basis of a Convention application.

(6) A right to priority arising as a result of a Convention application may be

assigned or otherwise transmitted, either with the application or independently.

The reference in subsection (1) to the applicant's "successor in title" shall be construed accordingly."

10. In an official letter dated 9 August 2017, the tribunal responded to the applicant's submission stating:

"The registry notes the applicant's comments with regard to the opponent's earlier mark. Section 35(3) states that the filing date of the priority mark is 'adequate to establish the date on which the application was filed in another country, whatever may be the subsequent fate of the application'. Therefore the priority date was established regardless of whatever subsequently happened to the German application so the opposition can proceed."

11. Attached to the counterstatement, is an extract obtained from the database of the German Office (in German) as it stood on 17 July 2017 and an English translation of that document obtained using the Google search engine. The translation appears to indicate that on 6 January 2017, the opponent filed, in Germany, an application for the trade mark Brianna in relation to goods in classes 9, 20 and 25, with the translation of the class 25 goods reading: "Clothing; Footwear; Headgear; Swimsuits; Clothing for Sports; Casual Clothes". The "Legal status of the application" is described as "Application deemed to have been withdrawn."

12. Thus, it appears that (i) the applicant for the German trade mark is the same as the opponent in these proceedings, (ii) the trade mark is identical (iii) the application date in Germany is the same as the priority date claimed when the United Kingdom trade mark relied upon in these proceedings was filed and, (iv) the filing date of the application in the United Kingdom was within 6 months of the earlier filing in Germany. Although the English translation of the goods applied for in Germany and those contained in the

United Kingdom registration relied upon by the opponent appear to differ slightly in respect of “swimsuits” (Germany) v “swimwear” (UK), “clothing for sports” (Germany) v “sportswear” (UK) and “Casual clothes” (Germany) v “leisurewear” (UK), as these are simply alternative ways of describing the same commercial articles, it does not affect the position.

13. Having reached those conclusions about the qualifying status of the opponent’s claim to priority and as section 35(3) of the Act makes it clear that priority remains irrespective of “whatever may be the subsequent fate of the application” (in this case deemed withdrawn), the opponent’s trade mark qualifies as an earlier trade mark under the above provisions. As this earlier trade mark had not been registered for more than five years at the date the application was published, it is not subject to the proof of use provisions contained in section 6A of the Act. As a consequence, the opponent is entitled to rely upon it in relation to the goods she has identified without having to demonstrate genuine use.

## **Conclusion**

14. As the opponent’s trade mark qualifies as an earlier trade mark under section 6 of the Act and as the applicant admits that the competing trade marks and goods are identical (as they plainly are), **the opposition based upon section 5(1) of the Act succeeds and, subject to any successful appeal, the application will be refused.**

## **Costs**

15. As the opponent has been successful, she is, in principle, entitled to a contribution towards her costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016.

16. As neither of the parties to these proceedings is professionally represented, at the conclusion of the evidence rounds the tribunal invited them, inter alia, to indicate

whether they intended to make a request for an award of costs, and if so, to complete a pro-forma indicating a breakdown of their actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the opposition; it was made clear to the parties that if the pro-forma was not completed “no costs, other than official fees arising from the action will be awarded”. Although in her submissions filed in lieu of a hearing the opponent asked this tribunal to: “impose the costs of the proceedings on the applicant”, she elected not to complete the costs pro-forma mentioned above. In those circumstances, she is only entitled to claim the official fee associated with the filing of the opposition i.e. £100.

17. I order Fashion One (Europe) N.V to pay to Petra Bauernfeind the sum of **£100**. 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 14<sup>th</sup> day of June 2018**

**C J BOWEN**  
**For the Registrar**