

O/604/18

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3242617 BY
FASHION ONE (EUROPE) NV
TO REGISTER:**

REDOTTO

AS A TRADE MARK IN CLASSES 9, 18, 20, 25 AND 35

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 410589 BY
REPETTO**

Background and pleadings

1. Fashion One (Europe) NV (“the applicant”) applied to register the trade mark **REDOTTO** in the United Kingdom on 10 July 2017. It was accepted and published in the Trade Marks Journal on 21 July 2017 in respect of the following goods and services:

Class 9

Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards; video films.

Class 18

Leather; trunks and suitcases; travelling cases; handbags; purses; wallets; umbrellas; parasols; walking sticks; whips; harness; saddlery.

Class 20

Divans; sofas; armchairs; beds; ottomans; tables; chairs; chaises longues; furniture; mirrors; picture frames.

Class 25

Clothing; footwear; headgear; swimwear; sportswear; leisurewear.

Class 35

Provision of information and advice to consumers regarding the selection of products and items to be purchased; exhibitions for commercial or advertising purposes; arranging of exhibitions for commercial purposes; demonstration of goods for promotional purposes; Publicity and sales promotion services; provision of business and commercial information; business consultancy services; assistance and advice regarding business organization and management; advertising; advertising particularly services for the promotion

of goods; arranging of contracts for the purchase and sale of goods and services, for others; market research and marketing studies; compilation of computer databases; office functions; risk management consultancy [business]; employment agency services; personnel recruitment services; temporary personnel employment services; placement of permanent personnel.

2. The application was partially opposed by Repetto (“the opponent”). The opposition is based upon Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and a claim that the application is not validly filed, because the applicant is not a legal entity. The opposition concerns all goods in Classes 18 and 25 of the application.
3. With regards to its claim based upon Sections 5(2)(b) and 5(3) of the Act, the opponent is relying upon two earlier trade marks. The first is EU (formerly Community) Trade Mark No. 5081484:

Repetto

The opponent is relying on this mark to oppose the applicant’s goods in Classes 18 and 25. The mark was applied for on 17 May 2006 and registered on 30 January 2011 in respect of the following goods, all of which the opponent states it is relying on under section 5(2)(b) of the Act:

Class 3

Soaps, perfumery, essential oils, cosmetics, hair lotions.

Class 14

Jewellery; jewellery, horological items and chronometric instruments; watches, bracelets, chains, necklaces, earrings, rings.

Class 18

Trunks and travelling bags; wallets; change purses; handbags; rucksacks; travel bags, beach bags, school bags; vanity cases (not fitted), bags or sachets (envelopes, pouches) for packaging (of leather), umbrellas; polishes, leather preservatives, cream for leather.

Class 25

Clothing, footwear (other than orthopaedic footwear), dance footwear, ballet slippers, headgear, tights and in particular dance clothing, belts, scarves, headbands, headdresses (headgear)

4. The second mark is UK registered trade mark No. 1395498:

Lepetto

In the Notice of Opposition, the opponent states that it is relying on this mark to oppose all the applicant's goods and services. The mark was applied for on 18 August 1989 and registered on 13 December 1991 in respect of the following goods, all of which the opponent seeks to rely on under section 5(2)(b) of the Act:

Class 25

Articles of sports clothing, underclothing, cycle clothing; dance, gymnastics and exercise clothing; footwear; trousers, shorts, pants, shirts, T-shirts; jackets, skirts, tank tops, pirate pants, bike pants, overalls, leotards, braces, suspenders, tights, tunics, briefs, belts, legwarmers, anklewarmers, tops, socks, stockings, sashes, head bands; pads, parts and fittings for shoes and for slippers; all included in Class 25.

5. The opponent claims that the marks are similar and that the goods covered by the earlier marks are the same as, or similar to, some of the goods covered by the

applicant's specification, leading to a likelihood of confusion under section 5(2)(b) of the Act. In its Written Submissions dated 9 March 2018, the opponent confirms that the opposition is limited to the goods contained in Classes 18 and 25.

6. For section 5(3) of the Act, the opponent claims that use of the applicant's mark for all the goods in Classes 18 and 25 of the application would take unfair advantage of the reputation of the earlier marks and cause detriment to the distinctive character of those marks. It claims that dilution of the distinctive character of the earlier mark will alter the perception of the mark and have an impact on the economic behaviour of the relevant public.
7. Under section 5(4)(a) of the Act, the opponent claims that use of the applicant's mark for all the goods in Classes 18 and 25 of the application is liable to be prevented under the law of passing off, owing to its goodwill attached to the sign **REPETTO**, which it claims to have used throughout the UK since August 1989, in respect of the following goods, which are also covered by the earlier marks:

Soaps, perfumery, essential oils.

Trunks and travelling bags; wallets; change purses; handbags; rucksacks; travel bags; beach bags; school bags; vanity cases (not fitted), bags or satchels (envelopes, pouches) for packaging (of leather); umbrellas; polishes, leather preservatives, creams for leather.

Clothing, footwear (other than orthopaedic footwear), dance footwear, ballet slippers, headgear, tights and in particular dance clothing, belts, scarves, headbands, headdresses (headgear).

8. The opponent also claims that the applicant has not been incorporated in the UK and "does not therefore appear to be a legal entity, entitled to own UK Trade Mark Application No. 3242617". Based on this reasoning, it claims that the application has not been validly filed.

9. The applicant filed a defence and counterstatement, denying all the grounds. It also requested that the opponent provide evidence of proof of use of the earlier EUTM for all goods in Classes 3 and 14.
10. The opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.
11. The opponent also filed written submissions, including written submissions in lieu of a hearing, on 9 March 2018 and 29 June 2018 respectively. These will not be summarised but will be referred to as and where appropriate during this decision.
12. In these proceedings, the opponent is represented by Potter Clarkson LLP and the applicant is self-represented.

Evidence

13. The opponent's evidence comes from Jean-Marc Gaucher-Holmann, President of Repetto since 1999. It is dated 20 March 2018. Exhibit 1 provides a history of the firm, taken from its website. I have summarised this below:

1947 Rose Repetto, mother of eminent ballet choreographer Roland Petit, created what Mr Gaucher-Holmann describes as “a new and innovative ballet shoe”, based on her son's advice. The company was founded.

1956 Brigitte Bardot asked the company to create what became the “Cendrillon” flat ballerina shoe, which she wore in Roger Vadim's film of the same year, *Et Dieu Créa la Femme (And God Created Woman)*.



1959 The company opened a shop in Paris.

1964 The logo was designed.

1970s Serge Gainsbourg became a brand ambassador.



a regalo
Gainsbourg

- 1984 Rose Repetto died.
- 1999 Jean-Marc Gaucher-Holmann took over the firm.
- 2000s Repetto entered partnerships with designers Issey Miyake, Yohji Yamamoto, Comme des Garçons and Karl Lagerfeld.
- 2005 The millionth pair of ballerina flats was made at the firm's factory in France. Repetto formed a partnership with the Université Technologique de Compiègne to design a "revolutionary" ballet shoe.
- 2007 Repetto created the foundation, "Danse pour la vie", to provide equipment to dance schools in developing countries.
- 2012 Repetto launched its first ready-to-wear women's clothing collection, inspired by dance.
- 2013 Repetto launched its first fragrance.
- 2015 Repetto became the official supplier to the Rome Opera Ballet.

14. Exhibit 2 is a print-out from the opponent's website, which is dated 5 March 2018 and provides further information about some of the firm's shoes: the Cendrillon, the Zizi (worn by Mr Gainsbourg) and the Michael, a loafer created in 2009. Exhibit 3 is a print-out which gives some more detail about the ballet shoes and the firm's approach. It is unclear where these pages come from and they are undated.
15. Mr Gaucher-Holmann states that the mark is used on a wide range of goods, available for purchase by mail order or from third party retailers. Exhibit 4 contains print-outs from the opponent's website, dated 8 March 2018, showing products offered for sale. Prices are in sterling. The goods comprise dance clothes, accessories, bags, shoes and boots, leather creams, oils and waterproof sprays, wallets, purses and other leather goods, and women's clothing.
16. Exhibit 5, an undated print-out from the firm's website, indicates the European stockists of Repetto goods. They can be purchased from shops in the following countries: France, Belgium, Italy, Germany, Luxembourg, Denmark, Spain, Sweden, Finland and the UK, and, outside the EU, Switzerland. The UK has four shops stocking the goods. These are located in London and Manchester. Exhibit 6

contains print-outs from one of these retailers: The Place, Connaught Street, London. The print-out showing Repetto shoes is undated. There are also undated print-outs from another stockist: Colibri in Islington, London. One of these print-outs states that as of 2011, the opponent produced 500,000 pairs of the Cendrillon a year.

17. Annual sales figures in the EU were as follows:

Year	Annual Sales (£)
2012	392,430
2013	390,702
2014	103,229
2015	88,802
2016	77,672
2017	87,660

Exhibit 7 contains a selection of invoices showing sales to UK retailers. These date from 5 August 2014 to 24 October 2017. The goods sold comprise dancewear, dance shoes and accessories, and shoes including the Cendrillon, Zizi and Michael.

18. Exhibit 9¹ contains a copy of a press article from *Forbes* magazine, dated 3 December 2014, and the start of an article from the summer 2014 edition of *Nuvo* magazine.

19. Exhibit 10 contains information from the opponent's website, dated 6 March 2018, about the relationship with the Rome Opera Ballet. Exhibit 11 also comes from the opponent's website, is dated 5 March 2018, and provides information on the "Danse pour la Vie" Foundation and an exhibition celebrating the firm's 60th anniversary.

¹ There is no Exhibit 8.

Relevant dates

20. The opponent's earlier marks had been registered for more than five years on the date on which the contested application was published. They are, therefore, subject to proof of use provisions under section 6A of the Act, and the applicant has, as I have already noted, requested such proof in respect of EUTM 5081484 for goods in Classes 3 and 14. The opponent has made a statement that it has made genuine use of the marks in the EU, including the UK, in the relevant period for some of the goods upon which it is relying. I will return to this point in due course. The relevant period for these purposes is the five years prior to and ending on the date of publication of the contested application: 22 July 2012 to 21 July 2017. The relevant date for the purposes of sections 5(2)(b) and 5(3) is the date the application was filed: 10 July 2017.
21. The opponent is also claiming an earlier right in relation to the applicant's mark, as provided for by section 5(4)(a) of the Act. The onus is on the opponent to satisfy the Tribunal that its unregistered sign would have been protectable by virtue of the law of passing off before the relevant date. The applicant has not claimed or filed any evidence that it has been using its mark before the date of application (10 July 2017), so this is the relevant date for the purposes of section 5(4)(a).

Proof of Use

22. Section 6A of the Act states that:

“(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 European Union 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 Union.

(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.”

23. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J summarised the principles guiding the assessment of whether there has been genuine use of a trade mark. These principles are drawn from the following case law: *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01), *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02), *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-416/04 P), *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft “Feldmarschall Radetzky”* (C-442/07), *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07), *Leno Merken BV v Hagelkruis Beheer BV*

(C-149/11), *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* (C-609/11), and *P Reber Holding & Co KG v OHIM* (C-141/13):

- (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].²

24. The onus is on the opponent, as the proprietor of the earlier mark, to show use. Section 100 of the Act states that:

“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.”

² Paragraph 219.

25. The opponent has stated that it has used the earlier EUTM 5081484 for the following goods:

Class 3

Soaps, perfumery, essential oils.

Class 18

Trunks and travelling bags; wallets; change purses; handbags; rucksacks; travel bags; beach bags; school bags; vanity cases (not fitted), bags or satchels (envelopes, pouches) for packaging (of leather), umbrellas; polishes, leather preservatives, creams for leather.

Class 25

Clothing, footwear (other than orthopaedic footwear), dance footwear, ballet slippers, headgear, tights and in particular dance clothing, belts, scarves, headbands, headdresses (headgear).

I note that this is not the complete list of goods for which the earlier EUTM has been registered and on which the opponent stated that it was relying. Under section 6A(3) of the Act, quoted in paragraph 22 above, the opponent may only rely on those goods that have been put to genuine use or where there are proper reasons it has not been used. The opponent has made no statement of use or proper reasons for non-use in relation to class 14 and has given no such reasons why, so for the purposes of these proceedings I shall consider that the earlier EUTM covers only the goods listed above.

26. The applicant has asked the opponent to show proof of use of the earlier EUTM for goods in Classes 3 and 14. As it has not asked for such proof for the goods listed above in Classes 18 and 25, the opponent is entitled to rely upon all these goods. It has also not asked for proof of use of UKTM 1395498. I will therefore at this point confine my consideration of proof of use to the following goods in Class 3: soaps, perfumery and essential oils.

27. The opponent has provided no evidence of use of the earlier EUTM on soaps or essential oils. As I have already noted in paragraph 13 above, it has claimed to have used the mark on perfumery in 2013 and 2014. This is within the relevant period. I am required to consider whether there is sufficient evidence for a finding that genuine use has occurred. As it is an EU trade mark, this use must be within the territory of the EU: see *Leno*, paragraph 36.
28. I recall the principles set out by Arnold J and reproduced in paragraph 23 above, particularly that genuine use is more than token use and must be consistent with the function of a trade mark to enable the consumer to distinguish goods or services from those which have another origin. Use must also be by way of real commercial exploitation. While there is no *de minimis* rule, I note that the opponent has supplied no details of actual sales of perfumery under the earlier EUTM during the relevant period. Consequently, I am unable to find that there has been genuine use.
29. For the section 5(2)(b) and 5(3) grounds, the opponent may therefore rely in this opposition on the goods listed in its statement of use under Classes 18 and 25.

Decision

30. Before I deal with the grounds under section 5 of the Act, I shall consider the claim that the application is not valid, because the applicant is not a legal entity. In the Statement of Grounds, the opponent states:

“It is submitted that the application has not been validly filed. The Applicant Fashion One (Europe) N.V. has not been incorporated in the United Kingdom, and does not therefore appear to be a legal entity, entitled to own UK Trade Mark Application No. 3242617.”

31. In its counterstatement, the applicant stated that the address on the application had been entered in error and that this information was in the process of being amended. It noted that the Act does not require a trade mark owner to be incorporated in the UK.

32. In its Written Submissions dated 9 March 2018, the opponent clarified its point:

“This application was first filed in the name of Fashion One (Europe) N.V. with a country of incorporation listed as the United Kingdom. No such company has been incorporated in the United Kingdom.

It is noted that the UK IPO have accepted an amendment of the Applicant details, which now show the Applicant as Fashion One (Europe) N.V. with a Belgium address and listing the country of corporation [sic] as Belgium.

The Opponent submits that at the time of the application, the Applicant was not a limited company, incorporated in the United Kingdom, as set out in the application form. Therefore, the Opponent submits that the application was not validly filed, in the name of a true legal entity at the time of application.”

33. The most plausible explanation seems to me to be that when the applicant entered “United Kingdom” as the country of incorporation on the application form, this was a genuine error. I see no reason to suppose otherwise. I dismiss this ground of opposition and proceed to consider the section 5(2) ground.

Section 5(2)(b) ground

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

“A trade mark shall not be registered if because –

...

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

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

35. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG* (C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (C-425/98), *Matratzen Concord GmbH v OHIM* (C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (C-334/05 P) and *Bimbo SA v OHIM* (C-519/12 P):

- (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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone 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 greater 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

36. When comparing the goods, all relevant factors should be taken into account, per *Canon Kabushiki Kaisha*:

“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 complementary.”³

37. The General Court clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, T-325/06:

“...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.”

38. A further factor to be considered is the channels of trade of the respective goods or services: see the guidance given by Jacob J (as he was then) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281.

39. The goods to be compared are shown in the table below:

Opponent’s goods	Applicant’s goods
<u>Class 18</u> Trunks and travelling bags; wallets; change purses; handbags; rucksacks; travel bags, beach bags, school bags; vanity cases (not fitted), bags or sachets (envelopes, pouches) for packaging (of leather), umbrellas; polishes, leather preservatives, cream for leather.	<u>Class 18</u> Leather; trunks and suitcases; travelling cases; handbags; purses; wallets; umbrellas; parasols; walking sticks; whips; harness; saddlery.

³ Paragraph 23

<p><u>Class 25</u> Clothing, footwear (other than orthopaedic footwear), dance footwear, ballet slippers, headgear, tights and in particular dance clothing, belts, scarves, headbands, headdresses (headgear).</p>	<p><u>Class 25</u> Clothing; footwear; headgear; swimwear; sportswear; leisurewear.</p>
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40. The opponent claims that applicant's goods are identical or similar to goods covered by the earlier marks. Some are self-evidently identical: trunks; handbags; wallets; umbrellas; clothing; headgear.

41. I also find that suitcases and travelling cases from the applicant's specification are identical to travelling bags in the opponent's specification. In coming to this finding, I have taken account of the comments of Floyd J in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158:

“...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) (IP TRANSLATOR)* [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 and 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.”

To conclude that the ordinary and natural meaning of “travelling bags” does not include travelling cases and suitcases would, in my view, be to strain the language unnaturally.

42. There is a further instance in which goods and services can be considered as identical. This is when the goods specified in the application are included in a more general category designated by the earlier mark(s), or vice versa: see *Gérard Meric v OHIM*, T-133/05, paragraph 29. In Class 18, the applicant's "purses" includes the opponent's change purses; in Class 25, the applicant's "footwear" includes the opponent's footwear (other than orthopaedic footwear), and the applicant's swimwear, sportswear, leisurewear are included in the opponent's "clothing, footwear and headgear".
43. The opponent states that the applicant's parasols are also identical to goods in its specification, presumably umbrellas. To my mind, the ordinary and natural meaning of these two terms is different. The method of use is the same: a textile or soft plastic covering is raised by ribs attached to a long pole with a handle. Their uses are not the same: an umbrella is made with waterproof material, and used to keep the rain off its user, while a parasol protects the user from the sun and may be more decorative. They share the same trade channels, but are not complementary or in competition. Taking all these factors together, I find that they are similar.
44. In its written submissions, the opponent claims that there is "a strong connection/association" between the Class 18 goods in its own specification and the applicant's whips; harness; saddlery, and that therefore they are similar goods. This is based on the reasoning that all these goods are made from leather; alternatively, that there is a complementary relationship between clothing and whips, harness and saddlery.
45. I do not find these arguments convincing. A table and a picture frame may be both be made from wood. In itself, this does not make them similar goods. Turning to the argument based on complementarity, I note the opponent's statement that "The average consumer is used to sporting goods being that clothing or equipment originating from the same source and utilising the same trade channels." The opponent has provided no evidence to support this assertion. It seems to me that whips, harness and saddlery are specialist goods and that the average consumer is unlikely to think that they originate from the same source as clothing, footwear

and headgear. Consequently, I find that whips, harness and saddlery are dissimilar to the goods in the opponent's specification.

46. The opponent does not put forward a view on the similarity of the applicant's leather and walking sticks with any of the opponent's goods. On leather, I note the decision of the Hearing Officer in *Lipsy Limited v S.M. Celestial Co Limited and Loving Hut International Limited*, BL O/074/12. There he said that the consumers of leather goods were different from the consumers of leather as a material. Leather goods are purchased by members of the general public, while the leather itself would be bought by a manufacturer or other trader. The purposes and trade channels are different. The Hearing Officer stated that "I do not see much force in the argument that a person who buys a leather bag would think of themselves as buying the leather in it."⁴ I agree with this, and find that leather is dissimilar to the opponent's goods.

47. In my view, umbrellas are the nearest comparison to walking sticks. The purported similarity between these goods was also considered in *Lipsy*. The Hearing Officer noted that the products were different in nature, with "a walking stick [being] a simple wooden or hard plastic product whereas an umbrella is a more complex product with a textile or soft plastic covering raised by metal ribs or arms". He accepted a modest degree of similarity of nature based upon the fact that they both have a handle and "a long solid pole-like core".⁵ I can find no other grounds of similarity. The users may be the same, but the intended purposes are different: one is designed to keep the user dry, the other is an aid to make walking easier for the old, infirm or otherwise unsteady on their feet. If there is any similarity between these goods, this is at a low level.

Average consumer and the purchasing act

48. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of

⁴ Paragraph 48

⁵ Paragraph 47

confusion, I must bear in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: see *Lloyd Schuhfabrik Meyer*.

49. 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:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”⁶

50. The average consumer of the goods I have just compared is a member of the general public, except in the case of leather, where the average consumer will be a manufacturer of goods that are to be sold by retailers or included as part of complex products such as motor vehicles. Organisations such as dance companies, dance schools and riding schools will also be relevant for some of the more specialised goods (such as ballet slippers and saddlery).

51. The goods that are bought by the general public will be purchased from physical shops or online. Goods designed for specific activities such as dancing or riding may be sold by specialist retailers, while more general clothing, shoes, headgear, bags, purses and wallets can be found in department stores or shops selling clothes, shoes or other leather goods. The consumer will see the marks, but may not see them together. Leather will be bought from specialist suppliers.

52. The goods are available at a wide range of prices, from a few to hundreds or even thousands of pounds. Whatever the price, though, the goods are unlikely to be an

⁶ Paragraph 60.

everyday purchase. I consider that the consumer will be paying an average level of attention when choosing what they will buy.


Comparison of marks

53. 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 the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, C-591/12 P, that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”⁷

54. 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 the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

55. The respective marks are shown below:

Earlier mark	Contested mark
EUTM and UKTM: 	REDOTTO

⁷ Paragraph 34.

56. The applicant's mark consists of the word "REDOTTO" in a standard font with no stylisation and presented in capital letters.⁸ The overall impression of the contested mark rests in this word.
57. The opponent's mark consists of the word "repetto" in lower case in a font that is reminiscent of text produced on a typewriter. The initial letter "r" is larger than the other letters. In my view, the font is not particularly original, so the word is the distinctive and dominant element of this mark.
58. The opponent claims that the marks are visually very similar, as the word is the dominant element of the mark. The words contain the same number of letters, and differ in only the 3rd and 4th. The beginning and ends of the words are therefore identical. The opponent's mark is in a stylised font, but I found the word to be the distinctive and dominant element of the mark. In my view, I consider there to be a medium degree of visual similarity between the marks.
59. The average consumer is likely to articulate the opponent's mark as RE-PET-OH and the applicant's mark as RE-DOT-OH. They may not be sure which of the three syllables to stress. If they stress the beginning of the word, the marks are aurally similar to a high degree, as the 3rd and 4th letters are articulated with relatively less weight. If the consumer stresses the second syllable (PET or DOT), I find the marks to be aurally similar to a medium degree, given the number of shared letters.
60. Conceptually, both marks are neutral. While "repetto" is a surname, the average consumer is unlikely to know this, and would be more likely to think that the word has been made up. They are also likely to think that "REDOTTO" is an invented word, although both have an Italianate feel. There is no conceptual similarity, as both words have no hooks on which the average consumer can hang a meaning.

⁸ Registration of a trade mark in capital letters covers use in a lower case, as stated by Professor Ruth Annand, sitting as the Appointed Person, in *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17.

Distinctiveness of the earlier mark

61. There is, as has already been noted, a greater likelihood of confusion if the earlier mark is highly distinctive. The CJEU provided guidance on assessing a mark's distinctive character in *Lloyd Schuhfabrik Meyer*.

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the 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 (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

62. I have already found it is the word element of the earlier mark that gives it its distinctive character. It is not a word to be found in an English language dictionary, and there is nothing about it that alludes to the goods that it covers. I have been provided with no evidence on market share or the amount that has been invested in promoting the mark. However, I find the mark to be inherently highly distinctive.

Conclusions on likelihood of confusion

63. Deciding whether there is a likelihood of confusion is not a scientific process. Rather, it is a matter of considering all the factors, weighing them and looking at their combined effect, in the light of the authorities set out earlier in this decision. As the CJEU stated in *Canon Kabushiki Kaisha*:

“A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.”⁹

64. Where there is no similarity between the goods or services, there can be no likelihood of confusion. I found that leather was a dissimilar good. Consequently, the opposition on the section 5(2)(b) ground fails in respect of leather.

65. There are two types of confusion that I must consider. The difference between them was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10:

“Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simply matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the

⁹ Paragraph 17.

later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.'¹⁰

66. I have already found that the earlier mark is highly distinctive for the goods in question and that some of the goods covered by the applicant's mark are identical to goods covered by this earlier mark. I must now consider whether it is likely that the average consumer will either mistake one mark for another, or, having noticed the differences, assume that the marks come from the same, or a connected, business.

67. These goods would, for the most part, be sold in self-service stores, although there may be some instances where a salesperson effects the transaction. The General Court had this to say about such circumstances in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03:

"If the goods covered by the mark in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs."¹¹

68. I consider it unlikely that the average consumer will remember the details of the font, which appears to be a relatively standard typewritten font. The beginning and the end of the words are the same, with only two letters different. Consequently, I find it likely that the average consumer, with imperfect recollection, would be

¹⁰ Paragraph 16.

¹¹ Paragraph 49

directly confused between the marks where they cover the goods that I found to be identical or highly similar: Trunks and suitcases; travelling cases; handbags; purses; wallets; umbrellas; parasols; clothing; footwear; headgear; swimwear; sportswear; leisurewear.

69. I consider that there is insufficient similarity between the goods and the marks for the average consumer to be directly confused in the case of the remaining goods: walking sticks; whips; harness; saddlery. The opponent claims that “the average consumer will assume that the marks emanate from the same entity or least from some form of economic association between them”; that, in other words, the average consumer will be indirectly confused. It is important to consider the circumstances in which indirect confusion might arise. It is not sufficient that a mark merely calls to mind another mark; this is mere association not indirect confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. As noted above in paragraph 65, a finding of indirect confusion requires the likelihood of the average consumer making a connection between the marks and assuming that the goods are from the same or economically linked undertakings. Given the differences in purpose, nature and trade channels, I consider that the average consumer would not make such an assumption.

Outcome of Section 5(2)(b) ground

70. The opposition succeeds under section 5(2)(b) with respect to the following goods:

Class 18

Trunks and suitcases; travelling cases; handbags; purses; wallets; umbrellas; parasols.

Class 25

Clothing; footwear; headgear; swimwear; sportswear; leisurewear.

71. The section 5(2)(b) ground fails with respect to the following goods:

Class 18

Leather; walking sticks; whips; harness; saddlery.

Section 5(3) ground

72. Section 5(3) of the Act states that a trade mark which 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”.

73. The conditions of section 5(3) are cumulative:

- 1) The opponent must show that the earlier mark has a reputation.
- 2) The level of reputation and the similarities between the marks must be such as to cause the public to make a link between the marks.
- 3) One or more of three types of damage (unfair advantage, detriment to distinctive character or repute) will occur.

It is not necessary for the goods to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

74. Reputation is founded on knowledge. In *General Motors v Yplon SA*, C-375/97, the CJEU held that:

“26. 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.

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

75. As the earlier mark is an EUTM, the relevant territory for an assessment of reputation is the EU. As I have set out in the evidence summary, the opponent has provided a narrative history of the company, some sales figures, print-outs from its website that show items for sale and a sample of invoices for UK-based companies. It has not, however, submitted figures that would enable me to make an assessment of whether the mark is known by a significant part of the public concerned by the goods covered by the trade mark, which, it will be recalled, are used by members of the general public. There is also a more specialist public that practises dance. However, the opponent has provided no data on the size of the market or information about the investment that the firm has made in promoting the mark. Consequently, I am unable to find that the earlier mark has a reputation and the ground fails.

Section 5(4)(a) ground

76. Section 5(4)(a) of the Act states that:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

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

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of ‘an earlier right in relation to the trade mark’.

77. In *Jadebay Limited, Noa and Nani Limited Trading as the Discount Outlet v Clarke-Coles Limited Trading as Feel Good UK* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL) namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all these limbs.

56. In relation to deception, the court must assess whether ‘a substantial number’ of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

78. *Halsbury’s Laws of England* Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309, it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

79. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

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

which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

80. The opponent must provide evidence to satisfy the tribunal that on 10 July 2017 (the date the applicant filed for registration) it had protectable goodwill in the United Kingdom. While there are no sales figures for the UK on its own, there is evidence of the opponent’s goods being sold to UK retailers. 33 invoices were supplied, covering 7 UK-based companies. Eight of these are later than 10 July 2017. The total amount invoiced on the remaining 25 invoices is €61,540.01, covering a period of just over 30 months. The goods sold comprise dance clothes, hair accessories (for use by dancers), and shoes (both for dance and everyday wear). No other evidence specifically shows use in the UK.
81. Each case turns on its own facts and goodwill may be protectable even when it has been built up over a relatively short time and where sales are relatively modest. In *Lumos Skincare Ltd v Sweet Squared Ltd, Famous Names LLC and Sweet Squared (UK) LLP* [2013] EWCA Civ 590, the Court of Appeal upheld a claim for passing off based on the claimant’s use of the mark “LUMOS” for around three years before the defendant’s use of the same mark, even though sales volumes and turnover were modest. The products in question were premium anti-ageing products, retailing at prices between £40 and £100 a bottle. The evidence provided by the opponent on the manufacturing process for the shoes demonstrates that these are not mass-market items. The amounts invoiced seem to me to be sufficient to find that the opponent has established protectable goodwill based on its sales of footwear, dance clothing and accessories.
82. I will now consider whether there is misrepresentation. The relevant test was set out by Morritt LJ in *Neutrogena Corporation and another v Golden Limited and another* [1996] RPC 473:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at page 407 the question on the issue of deception or confusion is:

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’ [product].

The same proposition is stated in Halsbury’s Laws of England 4th Edition Vol. 48 para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at page 175; and *Re Smith Hayden’s Application* (1945) 63 RPC 97 at page 101.”

83. The opponent has provided no evidence of actual deception. Indeed, I have been presented with no evidence that the applicant is using the mark within the UK. However, this is not decisive. As Mr Daniel Alexander QC, sitting as the Appointed Person, stated in *The Proper Pizza Company Limited v James Michael Alexander Hammond*, BL O-206-15:

“... the evaluation of whether there would be passing off in the context of trade mark registration must consider the notional fair use of the mark applied for.”¹²

84. In an opposition under section 5(4)(a) grounds, it is not necessary for the goods to be similar: see *Harrods Limited v Harroddian School Limited* [1996] RPC 697. In this case Millett LJ stated that:

“... in deciding whether there is likelihood of confusion, it is an important and highly relevant consideration

¹² Paragraph 47.

‘whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’.”

85. As I have noted above, the opponent has provided evidence of sales of footwear, dance clothing and hair accessories within the UK. It is, in my view, a stretch for a customer to assume, when they encounter the applicant’s mark on leather, walking sticks, whips, harness or saddlery, that this is the same company that sells shoes or dance clothes, or at the least there is a connection between the two. I find that the goodwill is not of a sufficiently high level to make such an association between those goods and the remaining opposed goods of the applicant: leather, walking sticks, whips, harness and saddlery. I do not find misrepresentation.

86. The section 5(4)(a) ground fails.

Conclusion

87. The partial opposition has been partially successful. The application by Fashion One (Europe) NV may proceed to registration in respect of the following goods and services:

Class 9

All goods in the specification

Class 18

Leather; walking sticks; whips; harness, saddlery

Class 20

All goods in the specification

Class 35

All services in the specification

Costs

88. Both parties have had some success in these proceedings, with the greater proportion of success being won by the opponent. In the circumstances, I award the opponent the sum of £1400 as a contribution towards its costs. The sum is calculated as follows:

Official fee for filing the notice of opposition: £200

Preparing a statement and considering the other side's statement: £150

Preparing evidence: £750

Preparation of written submissions: £300

Total: £1400

89. I therefore order Fashion One (Europe) NV to pay Repetto the sum of £1400. The above sum should 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 25th day of September 2018

Clare Boucher

For the Registrar,

Comptroller-General