

O-130-19

TRADE MARKS ACT 1994

**IN THE MATTER OF UK REGISTRATION NO. 3033021
IN THE NAME OF UK MARNICOUNT COMPANY LIMITED
OF THE TRADE MARK**



MarniCount

IN CLASS 25

AND

**THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO. 502006
BY MARNI GROUP S.R.L.**

Background and pleadings

1. On 2 December 2013, UK MARNICOUNT COMPANY LIMITED (“the registered proprietor”) filed trade mark application number UK00003033021 for the mark detailed on the cover page of this decision, for “clothing; ready-made clothing; shoes; hosiery; gloves [clothing]; neckties; hats; scarfs; layettes [clothing]; waterproof clothing” in class 25.

2. The application was published in the Trade Marks Journal on 28 February 2014. No opposition was received, and the mark was registered on 9 May 2014.

3. On 7 March 2018, Marni Group S.R.L. (“the cancellation applicant”) filed application number CA000502006 to have the registration of the registered proprietor’s mark declared invalid (for all of the goods for which it is registered), relying upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

4. Under sections 5(2)(b) and 5(3) the cancellation applicant relies upon European Union trade mark (“EUTM”) number 1756048, **MARNI**, which has a filing date of 14 July 2000 and a registration date of 3 January 2008. The mark is registered in classes 3, 9, 14, 18, 21, 25 and 27; for the purposes of these proceedings, the cancellation applicant relies upon all of its goods¹ under section 5(3) and the following goods under section 5(2)(b):

Class 25: Clothing, footwear, headgear.

5. With regard to its section 5(2)(b) ground, the cancellation applicant refers to the logo element of the registered proprietor’s mark but submits that the words MarniCount speak louder than the device. It also submits, in relation to the two words Marni and Count, that they are deliberately separated and that because the latter is a common English word, more focus will be placed on Marni such that there exists a likelihood of confusion with its MARNI mark in relation to identical goods.

¹ Detailed at Annex 1 to this decision

6. The cancellation applicant's case under section 5(3) is that its mark has a reputation in the UK (although I highlight here that the reputation threshold in relation to the earlier mark must be met in the EU, because it is an EUTM) such that use of the contested mark would cause the relevant public to believe that there is an economic connection between the cancellation applicant and the registered proprietor, where no such connection exists. It claims that use of the contested mark would allow the registered proprietor to take unfair advantage of the cancellation applicant's reputation, and that use of the contested mark would cause detriment to the reputation and the distinctive character of the earlier mark.

7. The mark relied upon under sections 5(2)(b) and 5(3) qualifies as an earlier mark in accordance with section 6 of the Act. Given its registration date, it is also subject to the proof of use provisions contained in section 47(2A) of the Act. To this extent, the cancellation applicant made a statement of use corresponding to the goods upon which it relies.

8. Under section 5(4)(a), the cancellation applicant relies on the use of the sign **MARNI** which it states has been used throughout the UK since 2003 in respect of "clothing and footwear; retailing of clothing and footwear".

9. The cancellation applicant claims that it has established goodwill in association with the sign and that use of the contested mark would amount to a misrepresentation to the relevant public that the registered proprietor is connected to, authorised by, or the same as, the cancellation applicant. The goodwill of the cancellation applicant would, it claims, be damaged as a consequence, in turn causing a loss of business.

10. The registered proprietor filed a counterstatement in which it denies the grounds essentially on the basis that the marks are not similar enough to engage the various grounds of invalidity. In addition, the registered proprietor requested the cancellation applicant provide proof of use of all goods and services covered by its EUTM (I note here that there are not actually any services covered by the registration, so I say no more about the request to show use on services).

11. The cancellation applicant filed evidence, the letter accompanying which contained some brief written submissions. The registered proprietor did not file evidence or comment on the cancellation applicant's evidence. Neither party requested a hearing, nor did they file written submissions in lieu of a hearing. The cancellation applicant is represented by Murgitroyd & Company. The registered proprietor is represented by Mei-Leng Fong.

Preliminary issue

12. The cancellation applicant originally relied upon a further EUTM, number 16412728, for its case under sections 5(2)(b) and 5(3). The registered proprietor highlighted in its counterstatement that the EUTM relied upon did not constitute an earlier mark for the purposes of those sections of the Act. The cancellation applicant subsequently amended its pleadings to rely upon EUTM number 1756048 only.

Evidence

13. The cancellation applicant's evidence consists of a witness statement and three exhibits from Stefano Biondo, the cancellation applicant's Chief Executive Officer. He has held this position since 15 May 2018. Mr Biondo's witness statement is dated 12 July 2018, the salient points from which are as follows:

14. Clothing bearing the MARNI mark was first put on sale in the UK in 2001 through the retailer Joseph Ltd, which sold MARNI clothing in its London store.

15. During the summer of 2003, the cancellation applicant opened its first retail shop in London's Sloane Street under the trading name Marni Retail UK.

16. Subsequently, the cancellation applicant opened other retail stores in London and a retail outlet in Bicester. It also has wholesale outlets in Belfast, Brighton and other parts of the UK.

17. The cancellation applicant has continuously sold clothing in the UK under the MARNI mark from 2001 to date.

18. In 2013, Marni Retail UK changed its name to Marni Group S.R.L.

19. The annual turnover for clothing sold in the UK under the MARNI mark has been as follows:

Year	Amount (€)
2013 (January not included)	6,254,348.00
2014	5,216,437.00
2015	7,874,530.00
2016	6,707,098.00
2017	5,632,200.00

20. Between 2001 and 2015, the cancellation applicant did not actively promote its clothing sold under the MARNI mark, but relied upon “word of mouth”. However, the clothing was covered by UK editions of international fashion magazines from 2001 onwards. From 2015 onwards, the cancellation applicant actively advertised the clothing in the UK through these magazines. The amount spent on advertising between 2015 and 2017 was as follows:

Year	Amount (€)
2015	164,842.00
2016	271,975.00
2017 (first quarter only)	131,047.00

Exhibits

21. Exhibit SB1 is described by Mr Biondo as copies of invoices for clothing and accessories sold under the MARNI mark in the UK in 2001 and 2003.

22. The exhibit contains one invoice (number 000488/A) from 2001, dated 21 November. The invoice consists of 12 pages of items sold from MARNI INTERNATIONAL S.A., Luxembourg to Joseph Ltd, London. A total of 694 items were

sold to the retailer at a total cost of £71,893.00. The items listed in the invoice include a variety of clothing, shoes and bags.

23. The exhibit also contains one invoice (number 000741/A) from 2003, dated 25 July. The invoice consists of 50 pages of items sold from MARNI INTERNATIONAL S.A., Luxembourg to MARNI RETAIL UK LTD, London. A total of 3612 items were sold to the retailer at a total cost of £399,798.00. The items listed in the invoice include a variety of clothing, shoes, headwear, bags and accessories.

24. Exhibit SB2 is described by Mr Biondo as a list of the cancellation applicant's wholesale customers in the UK. The exhibit contains an undated list of 16 different company names and shipping addresses in several locations across the UK including Surrey, London, Belfast, Kent, Kettering, Swadlincote, Brighton, Birmingham and Swindon.

25. Exhibit SB3 is described by Mr Biondo as samples of international fashion magazines and press reviews covering the cancellation applicant's clothing sold under the MARNI mark. The exhibit contains 141 pages of magazine articles dated between January 2008 and January 2018 from 45 different magazines. The articles show a range of men's and women's clothing, shoes, bags, headwear and accessories.

26. A lengthy press review of clothing bearing the MARNI mark was published in Wallpaper's September 2014 edition and reads as follows:

"Marni is so integrated into our fashion conscience that you'd be forgiven for thinking it's been around forever. In fact, the fashion house, headed up by the Swiss-born, Milan-based Consuelo Castiglioni, is only just reaching adulthood, turning 20 during Milan fashion week this September. Instrumental in taking us away from the figure-following forms of the 1990s, teaching us that clashing prints handled masterfully can be beautiful, and introducing volume to clothing in all sorts of inventive ways, Marni is possessed of independent thought, and the sort of confidence and composure that would usually belong to a brand with a far longer legacy. The birthday celebrations on 21 September will take the shape of a flower market installation in Milan's Rotonda della Besana (the

colonnaded grounds of the 18th-century deconsecrated church of San Michele ai Sepolcri). After a preview for fashion's great and good, the market, which will mix flower arrangements with nature-inspired Marni products, will be open to the public for the duration of the day.”

27. As the proprietor filed no evidence, that concludes my summary of the evidence, insofar as I consider it necessary.

Decision

Proof of use

28. The first issue is whether, or to what extent, the cancellation applicant has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

“47 Grounds for invalidity of registration

(1) [...]

(2) The registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtains, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration 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) it has not been used, but there are proper reasons for non-use.

(2C) 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.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) 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.

29. Section 100 of the Act is also relevant, which reads:

“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.”

30. The relevant period in the current case, in which the cancellation applicant must prove use of its mark (no claim for proper reasons for non-use having been made), in accordance with section 47(2B) of the Act, is 8 March 2013 to 7 March 2018.

31. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. In *Walton International Ltd & Anot v Verweij Fashion BV*², Arnold J. summarised the case law on genuine use of trade marks:

“114. The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Behher BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

² [2018] EWCH 1608 (Ch) (28 June 2018)

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

32. It is clear at the outset that the earlier mark relied upon by the cancellation applicant is a plain word mark. Use of a mark registered as a plain word includes use in upper or lower case, as per Professor Ruth Annand’s comments, sitting as the Appointed Person in *Bentley Motors Limited v Bentley 1962 Limited*³:

³ BL O/158/17

“16. A word trade mark registration protects the word itself (here BENTLEY) written in any normal font and irrespective of capitalisation and, or highlighting in bold (see e.g. Case T-66/11, *Present-Service Ullrich GmbH & Co. KG v. OHIM*, EU:T:2013:48, para. 57 and the cases referred to therein, BL O/281/14,).”

33. The invoices at Exhibit SB1 are dated more than ten years prior to the relevant period and so, whilst they are evidence of when the cancellation applicant began trading, they do not prove use of the mark within the period set out under section 47(2B).

34. The list of 16 wholesale customers at exhibit SB2 is not dated, however, it is described by Mr Biondo in his witness statement as a list of current outlets. I therefore accept the exhibit to be correct as at the date of the witness statement (being 12 July 2018). Whilst this is outside the relevant period, I find it reasonable to conclude, on the balance of probabilities, that some of those were customers of the cancellation applicant's company during the relevant period given the fairly short period of time between the end of the relevant period and the filing of the witness statement.

35. The numerous magazine articles contained within exhibit SB3 are not evidence of sales but do support Mr Biondo's witness statement in that goods under the MARNI mark were clearly available to the public during the relevant period. This is further supported by the turnover figures set out in the witness statement, which have not been challenged by the registered proprietor and, as such, will be taken as fact.

36. Overall, the evidence shows commercial use of the mark which identifies the origin of the goods (being the goods for which the mark is registered) and creates or preserves an outlet for these goods. Putting all the evidence together provides me with a picture which is sufficient to establish that the cancellation applicant has genuinely used its MARNI mark in the relevant period at least in the UK.

37. However, as the earlier mark is an EUTM, the relevant territory in which use is required to be shown is the European Union (section 47(2D) of the Act). However, use of an EUTM in one Member State may be sufficient to constitute genuine use of an

EUTM⁴. Given the scale and frequency of the use shown (particularly from the magazine articles), the steady turnover figures and the fairly wide geographical spread across the UK, I am satisfied that there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods at issue in the EU during the relevant period.

Fair specification

38. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*⁵, Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because

⁴ See the General Court's comments in Case T-398/13, *TVR Automotive Ltd v OHIM*

⁵ [2016] EWHC 3103 (Ch)

he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

39. The cancellation applicant has not shown use of its MARNI mark in relation to any goods in any class other than 25. In relation to clothing, footwear, headgear I refer to *Animal Trade Mark*⁶, where Jacob J. (as he then was) held:

“23. So, should “clothing” in the specification be qualified in some other way? The term covers a very wide spectrum of different sorts of garments. But putting aside such specialist things as diving suits, wetsuits, bullet-proof vests and so on, there is a core of goods which are likely to be bought by ordinary consumers for different purposes in their daily wear. The same woman or girl is likely to own T-shirts, jeans, dresses, both formal and informal. Both parties’ goods could easily end up in the same wardrobe or drawer. He or she knowing of the range of goods for which use has been proved would, I think, take “clothing” to be fair as a description. He or she might limit the clothing to “casual clothing” but I have concluded in the end that “clothing” is appropriately fair.”

⁶ [2004] F.S.R. 19

40. Applying this to the case before me, I come to the same conclusion. Although clothing, footwear, headgear is a wide specification, I find that the goods for which use is shown is so varied in nature that the specification is justified.

41. The cancellation applicant has not shown use for the more specialist goods⁷ within their class 25 specification and, as such, the specification will be limited accordingly.

42. The cancellation applicant may rely upon its earlier MARNI mark in relation to clothing, footwear, headgear in class 25 for the purposes of its application for invalidation under sections 5(2)(b) and 5(3).

Section 5(2)(b)

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

“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,

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

44. Section 47 states:

⁷ Babies' diapers of textile; babies' napkins of textile; boot uppers; cap peaks; dress shields; fittings of metal for shoes and boots; footwear uppers; hat frames [skeletons]; heelpieces for boots and shoes; heelpieces for shoes; heelpieces for stockings; heels; inner soles; iron fittings for boots; iron fittings for shoes; non-slipping devices for boots; non-slipping devices for boots and shoes; non-slipping devices for shoes; pockets for clothing; shirt yokes; soles for footwear; studs for football boots [shoes]; tips for footwear; visors [hatmaking]; welts for boots; welts for boots and shoes; welts for shoes; heel pieces for stockings; heelpieces for boots; ready-made linings [parts of clothing]; shirt fronts.

“(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (2) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

The principles

45. The following principles are gleaned from the judgments 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 C3/03, *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.

(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 the 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 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

46. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*⁸, that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier trade mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

47. The goods to be compared are as follows:

Earlier mark (as relied upon)	Later mark
Class 25: Clothing, footwear, headgear	Class 25: clothing; ready-made clothing; shoes; hosiery; gloves [clothing]; neckties; hats; scarfs; layettes [clothing]; waterproof clothing

48. It is self-evident that the parties’ clothing in class 25 are identical goods. Given that the proprietor’s ready-made clothing; hosiery; gloves [clothing]; neckties; scarfs; layettes [clothing]; waterproof clothing all fall within the scope of clothing, I find that they are identical (in accordance with *Meric*) to the cancellation applicant’s clothing. Similarly, shoes fall within the scope of footwear and hats within the scope of headgear. The parties’ class 25 goods are identical.

⁸ Case T-133/05

The average consumer and the nature of the purchasing act

49. It is necessary for me to determine who the average consumer is for the respective parties' goods. 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*⁹, 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.”

50. 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 or services in question: *Lloyd Schuhfabrik Meyer*¹⁰.

51. The average consumer of clothing, footwear and headgear is a member of the general public. Such goods are likely to be purchased fairly frequently and whilst the cost can vary quite markedly, they are not prohibitively expensive. The goods will be inspected for style, size, colour etc. In my view, the average consumer will pay an average degree of care and attention to the purchase. The consumer will, for the most part, encounter the marks visually, by browsing through products in physical stores, in catalogues or using the internet. However, I do not completely discount an aural element to the purchase.

⁹ [2014] EWHC 439 (Ch)

¹⁰ Case C-342/97


Comparison of marks

52. It is clear from *Sabel BV v Puma AG* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*¹¹ 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.”

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

54. The trade marks to be compared are as follows:

Earlier mark	Later mark
<p>MARNI</p>	 <p>MarniCount</p>

¹¹ Case C-591/12P

55. Both the cancellation applicant and the registered proprietor have commented on the comparison of the marks, primarily in their statements of case, comments which I will refer to where relevant.

Overall impression

56. In its statement of grounds, the cancellation applicant submits the following:

“The mark for which invalidation is sought contains a logo element with the letters “M” and “C”, together with the words “MarniCount”. It is accepted case law that in the case of marks consisting of words and logo, the word element “speaks” more loudly, as it is by the word element that customers will order goods under the mark. As the word “count” is a common English word with multiple meanings, and has been deliberately separated in meaning in the mark from the word “Marni” by virtue of the capitalisation of the letter “C”, the attention of customers will thus be more closely focused upon the distinctive and wholly pronounceable word “Marni”, which is, as mentioned before, the mark of the Applicant for Invalidation.”

57. The registered proprietor, in its counterstatement, submits the following:

“The [later] mark [...] is formed by a distinctive device occupying about 80% of the area, with the words “MarniCount” located below the distinctive device formed by the letters “M” and “C”. In contrast, all the earlier marks of the Cancellation Applicant consist of the word “MARNI” only.

58. The cancellation applicant’s mark consists solely of the word MARNI. No part of the mark is stylised or emphasised in any way. There are no other elements to contribute to the overall impression, which rests in the single word MARNI.

59. The registered proprietor’s mark consists of two elements: a black, tilted, square-shaped device formed of the stylised letters M (x4) and C; and, beneath the device, the two (conjoined) words Marni and Count in a standard typeface. I consider the device to be the element which has the greatest relative weight in the overall

impression of the mark. However, despite the words being smaller and having less relative weight in the overall impression than the figurative component, they still make a reasonable contribution to the overall impression of the mark which is far from negligible.

Visual comparison

60. The registered proprietor submits the following:

“Visually, the [later] mark is significantly different from the earlier marks as a large portion of the subject mark is occupied by the distinctive device formed by the letters “M” and “C”.

61. I accept that the device element creates a noticeable difference. However, the words MarniCount do make a reasonable contribution to the overall impression of the later mark, one of which (Marni) is identical to the earlier mark as whole. Overall, I find the marks at issue to be visually similar, albeit to only a low degree.

Aural comparison

62. The earlier mark will be articulated in its entirety as the two syllables MAR and NI (most likely pronounced ‘mar-nee’). The device in the later mark, despite containing the letters M and C, is very unlikely to be pronounced by the average consumer: the mark will be referred to as MarniCount, with Marni being pronounced identically to the corresponding word in the earlier mark. I consider the marks to be aurally similar to a medium degree.

Conceptual comparison

63. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and

the CJEU including *Ruiz Picasso v OHIM*¹². The assessment must be made from the point of view of the average consumer.

64. In relation to the concept of its mark, the registered proprietor submits the following:

“Conceptually, “Count” in the subject mark has various meanings such as the action to determine the total number of a collection of items, include and so forth, yet there is no such meaning in the earlier marks. In view of the above, the [later] mark is not similar to the earlier marks.”

65. I also find that Count is an ordinary dictionary word which, to the average consumer, will have various meanings, including those suggested by the registered proprietor. However, both marks at issue contain the word Marni which, in my view, will be seen as an invented word. The word Count, preceded by Marni does not create a concept that will be immediately grasped by the average consumer. With neither mark conjuring a clear concept, I conclude that the marks are conceptually neutral.

Distinctive character of the earlier trade mark

66. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). In *Lloyd Schuhfabrik* the CJEU stated that:

“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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

¹² [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

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).”

67. I have found that the earlier mark will be seen by the average consumer as an invented word. This affords the mark a higher than average degree of inherent distinctive character. However, a mark may have an enhanced distinctive character because of the use that has been made of it. With this in mind, I need to assess whether the use made by the cancellation applicant of its mark has improved its inherent distinctiveness level. I have been provided with annual turnover figures and the amount spent on advertising between 2015 and 2017. I do not know how many products have been sold under the MARNI mark or the market share of MARNI goods. As such, I am not satisfied that the evidence filed is sufficient to show an enhanced level of distinctiveness, which, in any event, remains at higher than average.

Likelihood of confusion

68. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

69. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the

marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertaking being the same or related).

70. The marks have been found to be visually similar to a low degree, aurally similar to a medium degree and conceptually neutral. The goods at issue have been found to be identical.

71. During the selection process the visual impact of the marks will carry the most weight in the mind of the average consumer, however, the aural and conceptual impacts of the marks cannot be dismissed.

72. Due to the clear and obvious visual differences between the marks at issue, I am satisfied that direct confusion will not occur. The average consumer will not mistake one of these marks for the other.

73. In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*¹³:

“16. 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 simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the 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’.

¹³ BL 0/375/10

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

74. These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach¹⁴.

75. I go on now to consider whether the average consumer, having recognised that the marks are different, considers the common element of both marks and determines, through an instinctive mental process, that the marks are related and originate from the same, or an economically linked undertaking.

76. Notwithstanding that there is only a low degree of visual similarity, there are stronger phonetic similarities.

¹⁴ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]

77. I refer to *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*¹⁵, where it was held at paragraphs [29]-[32] that:

“In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

However, beyond the usual case where the average consumer perceives a mark as a whole and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.”

78. Applying this case law to the matter before me, I find that the words MarniCount in the earlier mark play an independent distinctive role in the later mark, even though they are not the most dominant element.

¹⁵ Case C-120/04

79. Taking all of this into consideration and bearing in mind the interdependency principle, I consider that the use of the word Marni in both the earlier mark and the later mark on the identical goods at issue will create an expectation on the part of the consumer that the goods come from the same or economically linked undertakings. I come to this view because the word MARNI has a higher than average degree of distinctiveness, and even though it is combined with the word Count in the contested mark, its inclusion as a part of an independently distinctive element which contributes reasonably to the overall impression of the mark means that the average consumer would assume that no one else other than the brand owner of the competing mark would be using it. There is, therefore, a likelihood of indirect confusion. In reaching this decision I have borne in mind the guidance of Mr James Mellor Q.C.¹⁶ that a finding of indirect confusion should not be made merely because the two marks share a common element. However, in this case I consider that the common element is so strikingly distinctive that confusion will arise.

80. The cancellation applicant's case under section 5(2)(b) has been successful.

Section 5(4)(a)

81. I will now assess the cancellation applicant's case under section 5(4)(a) of the Act, under which it relies on the unregistered sign MARNI.

82. Section 5(4)(a) states:

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

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

(b) [...]

¹⁶ Sitting as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

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.”

83. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 IPEC, HHJ Clarke, sitting as a Deputy Judge of the High Court stated that:

“55. The elements necessary to reach a finding of passing off are the ‘classic 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 three 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).”

84. 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 attached 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.”

85. In regards to the cancellation applicant’s case under section 5(4)(a), the only submissions I have from the registered proprietor are as follows:

“2. As the [later] mark is not similar to the earlier marks, even if the goods / services of the [later] mark and the earlier marks are similar, use of the [later] mark [...] would not be contrary to law, in particular, the law of passing off.”

86. Given the cancellation applicant's turnover in 2013 of €6,254,348.00 (for clothing sold in the UK under the MARNI sign), evidence of trade since 2001 and extensive magazine articles between January 2008 and January 2018, I am satisfied that it had goodwill at the relevant date (2 December 2013), being the filing date of the contested trade mark¹⁷. Based on the similarities between the marks and the identity of the goods, I come to the view that a substantial number of the relevant public are likely to be deceived, believing that the goods offered by the registered proprietor are those of the cancellation applicant. Since the parties are in the same field of activity (the clothing industry), it follows that there is a risk of damage to the cancellation applicant's business in that customers of the cancellation applicant will be lost to the registered proprietor.

87. The cancellation applicant's case under section 5(4)(a) has been successful.

Section 5(3)

88. 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 European Union trade mark or international trade mark (EC), in the European Union) 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.

89. 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*

¹⁷ There is no evidence or claim by the registered proprietor that their mark has been used prior to this date. Accordingly, the matter need only be assessed as of 2 December 2013.

[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 29a 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*).

90. If I am correct in my finding under sections 5(2)(b) and 5(4)(a), it is difficult to see how the cancellation applicant’s case under section 5(3) would put them in a better position. This is especially so because the claimed basis for tarnishment by the cancellation applicant refers to its lack of control over the quality of the goods sold by the registered proprietor. It further submits that tarnishing would occur if the registered proprietor’s goods sold under the later mark were cheaper or of lower quality.

91. Tarnishment was dealt with by Rose J. in the *Cristalino* case¹⁸:

¹⁸ *Champagne Louis Roederer v J Garcia Carrion SA & others* [2015] EWCH 2760 (Ch)

“89. Detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, is caused when the goods or services for which the offending sign is used may be perceived by the public in such a way that the trade mark’s power of attraction is reduced. The concept was described by Arnold J in *Red Bull v Sun Mark* [2012] EWHC 1929 (Ch) at [93] where he quoted the relevant passage from Kerly’s *Law of Trade Marks and Trade Names* (15th ed) at para 9-131. Detrimental effect occurs where the later mark is used for goods or services which provoke a reaction of annoyance or displeasure whether through their intrinsic nature or because of the unpleasant mental association with the goods for which the earlier mark is reputed. It may also occur when the trade mark applied for is used in an unpleasant, obscene or degrading context, or in a context which is not inherently unpleasant but which process to be incompatible with the earlier mark’s image. This leads to tarnishment whereby “the reputed mark ceases to convey desirable messages to the public: hence the detriment to its distinctive character.”

92. Damage by way of tarnishment is not simply about the quality of the goods/services. Rather, there must be something about the later mark and/or the goods/services which the mark is applied to which spoils the image of the earlier mark or creates negative associations in the mind of the earlier mark’s consumers. The cancellation applicant’s position is just hypothetical and is to be rejected.

93. In relation to the claims of unfair advantage and dilution, the basis for these claims is a presumed likelihood of confusion. The cancellation applicant submits as follows:

“The registered mark, MarniCount & Device, covering the identical or similar goods, is likely to be considered to originate from the same proprietor by customers, given the distinctive nature of the word MARNI, and thus the use by the proprietor of the mark MarniCount & Device for such goods will piggyback upon the goodwill and reputation of the MARNI mark...”

and

“As the mark MARNI is very distinctive, [...] having another mark covering the identical or similar goods and containing the identical word is only going to dilute the distinctiveness of the [later] mark, as it then raises questions in the minds of prospective purchasers as to who owns the marks beginning with or containing MARNI, and confuses them as to the origin of goods sold under such marks.”

94. As these claims for damage rest on the customer believing that the marks are from the same or related undertaking, if my finding of a likelihood of confusion is incorrect under section 5(2)(b) and there is in fact no likelihood of confusion, the cancellation applicant’s case could not possibly succeed. As the section 5(3) rests or falls with section 5(2)(b), (or is dismissed in so far as tarnishing is concerned) it is not necessary to comment further.

Conclusion

95. The cancellation applicant’s case under sections 5(2)(b) and 5(4)(a) have been successful. The registered proprietor’s mark will be declared invalid.

Costs

96. As the cancellation applicant has been successful, it is entitled to an award of costs in its favour. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. Using that TPN as a guide, I award costs to the cancellation applicant on the following basis:

Official fee:	£200
Preparing a statement and considering the other side’s statement:	£200
Preparing evidence (and accompanying submissions):	£500

Total:

£900

97. I order UK MARNICOUNT COMPANY LIMITED to pay Marni Group S.R.L. the sum of **£900**. 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.

8th of March 2019

Emily Venables

For the Registrar,

The Comptroller-General

Annex – cancellation applicant's goods (as relied upon for section 5(3))

Class 3: Perfumery, namely perfume, eau de parfum and eau de toilette.

Class 9: Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data-carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; Animated cartoons; apparatus for changing record player needles; asbestos clothing for protection against fire; asbestos gloves for protection against accidents; breathing apparatus for underwater swimming; breathing apparatus, except for artificial respiration; bullet-proof vests (Am); bullet-proof waistcoats; bullet-proof waistcoats [vests (Am)]; cabinets for loudspeakers; cases especially made for photographic apparatus and instruments; cases fitted with dissecting instruments [microscopy]; cleaning apparatus for phonograph records; cleaning apparatus for sound recording discs; clothing for protection against accidents, irradiation and fire; clothing for protection against fire; computer keyboards; computer operating programs recorded; computer operating programs, recorded; computer peripheral devices; computer programmes [programs], recorded; computer software [recorded]; containers for contact lenses; containers for microscope slides; divers' apparatus; divers' masks; diving suits; earplugs for divers; eyeglass cases; eyeglass chains; eyeglass cords; eyeglass frames; filters for respiratory masks; fire beaters; fire blankets; fire boats; fire engines; fire hose nozzles; floats for bathing and swimming; furniture especially made for laboratories; garments for protection against fire; gloves for divers; gloves for protection against accidents; gloves for protection against X-rays for industrial purposes; holders for electric coils; interfaces [for computers]; juke boxes [for computers]; knee-pads for workers; magnets; masts for wireless aerials; micrometer screws for optical instruments; monitors [computer programs]; motor fire engines; nets for protection against accidents; oxygen transvasing apparatus; pince-nez cases; pince-nez chains; pince-nez cords; pince-nez mountings; plotters; protection devices against Roentgen rays, not for medical purposes; protection devices against X-rays [Roentgen rays], not for medical purposes; protection devices

against X-rays, not for medical purposes; protection devices for personal use against accidents; protective helmets; protective masks; protective suits for aviators; push buttons for bells; railway traffic safety appliances; reflecting discs for wear, for the prevention of traffic accidents; reflecting discs, for wear, for the prevention of traffic accidents; respirators [other than for artificial respiration]; respirators for filtering air; respiratory masks [other than for artificial respiration]; retorts' stands; road signs, luminous or mechanical; safety nets; safety restraints [other than for vehicle seats and sports equipment]; safety tarpaulins; shoes for protection against accidents, irradiation and fire; signs, luminous; solderers' helmets; spark-guards; spectacle cases; spectacle frames; stands for photographic apparatus; steering apparatus, automatic, for vehicles; swimming belts; swimming jackets; teeth protectors; tripods for cameras; water wings; workmen's protective face-shields; turnstiles, automatic; vehicle breakdown warning triangles.

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; Agates; anchors [clock and watch-making]; barrels [clock- and watchmaking]; cases for clock- and watchmaking; cases for watches [presentation]; clock cases; clock hands [clock- and watchmaking]; clockworks; coins; copper tokens; dials [clock- and watchmaking]; jet, unwrought or semi-wrought; key rings [trinkets or fobs]; medals; movements for clocks and watches; objects of imitation gold; olivine [gems]; ormolu ware; ornaments of jet; pearls made of ambroid [pressed amber]; pendulums [clock- and watchmaking]; semi-precious stones; spinel [precious stones]; straps for wristwatches; watch bands; watch cases; watch chains; watch crystals; watch glasses; watch springs; watch straps.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; Attaché cases; backpacks; bandoliers; beach bags; briefcases; card cases [notecases]; chain mesh purses, not of precious metal; collars for animals; covers for animals; dog collars; gold beaters' skin; goldbeaters' skin; gut for making sausages; handbag frames; handbags; haversacks; horse blankets; knee-pads for horses; music cases; muzzles; net bags for shopping; nose bags [feed bags]; pocket wallets; purses; purses, not of precious

metal; rucksacks; school bags; school satchels; shopping bags; sling bags for carrying infants; straps for skates; straps for soldiers' equipment; suitcase handles; umbrella covers; umbrella handles; umbrella or parasol ribs; umbrella rings; umbrella sticks; vanity cases [not fitted]; walking cane handles; walking stick handles; walking stick seats; wheeled shopping bags; frames for umbrellas or parasols; game bags [hunting accessory].

Class 21: Household or kitchen utensils and containers (not of precious metal or coated therewith); unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

Class 25: Clothing, footwear, headgear; Babies' diapers of textile; babies' napkins of textile; boot uppers; cap peaks; dress shields; fittings of metal for shoes and boots; footwear uppers; hat frames [skeletons]; heelpieces for boots and shoes; heelpieces for shoes; heelpieces for stockings; heels; inner soles; iron fittings for boots; iron fittings for shoes; non-slipping devices for boots; non-slipping devices for boots and shoes; non-slipping devices for shoes; pockets for clothing; shirt yokes; soles for footwear; studs for football boots [shoes]; tips for footwear; visors [hatmaking]; welts for boots; welts for boots and shoes; welts for shoes; heel pieces for stockings; heelpieces for boots; ready-made linings [parts of clothing]; shirt fronts.

Class 27: Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile); Artificial turf; wallpaper.