

**O/089/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION NO. 3173652**

**BY HOLZER Y CIA, S.A. DE C.V.**

**TO REGISTER:**

**ANN TAYLOR**

**AS A TRADE MARK**

**IN CLASS 14**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 407845**

**BY ANNCO, INC**

## Background and Pleadings

1. On 8 July 2016 Holzer y cia, s.a. de c.v. (“the applicant”) applied to register the trade mark ANN TAYLOR in the UK. The application was accepted and published in the Trade Marks Journal on 5 August 2016 in respect of the following goods:

**Class 14:** Watches and jewellery.

2. Annco, Inc (“the opponent”) filed a notice of opposition on 7 November 2016 on the basis of Sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (the Act).<sup>1</sup> The opponent relies on the trade marks shown below:<sup>2</sup>

**EU010004265** (“the first earlier mark”)

ANNTAYLOR

**Filing date:** 13 May 2011

**Date of entry in register:** 13 October 2011

Relying on goods in class 14<sup>3</sup>

**EU011958436** (“the second earlier mark”)

ANN TAYLOR

**Filing date:** 04 July 2013

**Date of entry in register:** 03 April 2020

<sup>1</sup> The opposition initially included other grounds, namely Sections 5(3), 5(4) and 3(6). No evidence was filed to support those grounds and the opponent confirmed in a letter dated 16 September 2020 that they withdrew the other grounds of opposition.

<sup>2</sup> Although the UK has now left the EU, as these proceedings were commenced before 31 December 2020, the UK’s departure from the EU does not impact upon the opponent’s ability to rely upon the IR that designates the EU and the EUTMs.

<sup>3</sup> The opponent originally relied upon other goods in class 3 and 9, but in a letter dated 16 September 2020 it confirmed that it relies only on class 14.

Relying on goods and services in classes 3, 9, 14, 18, 25 and 35.

**EU003700101** (“the third earlier mark”)

ANNTAYLOR

**Filing date:** 16 March 2004

**Date of entry in register:** 29 March 2007

Relying on goods and services in classes 18, 25 and 35.

**WO0000001184854** (“the fourth earlier mark”)

**ANN TAYLOR**

**International registration date:** 12 July 2013

**Designation date:** 12 July 2013

**Date of protection of the international registration in UK:** 26 March 2020

Relying on goods and services in classes 3, 9, 14, 18, 25, and 35.

**UK00002340228** (“the fifth earlier trade mark”)

ANNTAYLOR

**Filing date:** 11 August 2003

**Date of entry in register:** 02 January 2004

Relying on goods in class 25.

3. The opponent submits that there is a likelihood of confusion because the marks are identical or highly similar and the respective goods and services are identical or similar.

4. The applicant filed a counterstatement. The main points emerging from the counterstatement are as follows:

- As regards the first earlier mark, the applicant denies that the marks are identical because the latter is written as two words whereas the first earlier mark is written as one word;
- As regards the second earlier mark, the applicant admits that the marks are identical. Whilst it denies that the opponent's goods in class 3, 9, 18, 25 and most of the opponent's services in class 35 are similar to the contested goods, the applicant also admits that the contested goods are identical to, inter alia, the opponent's jewellery and watches. On that basis the applicant states: "as such Section 5(1) is denied in part";
- As regards the third and the fifth earlier mark, the applicant requested that the opponent provides proof of use;
- The applicant also denies that the third, the fourth and the fifth earlier marks are identical to the contested mark.

5. The applicant also makes some admissions as regards the similarity between the contested goods and the goods covered by the specification of the first, the third, the fourth and the fifth earlier marks.

6. All of the marks relied upon by the opponent were subject to a number of revocation, invalidation and opposition proceedings brought by the applicant before the EUIPO. These proceedings were suspended until the outcome of the EUIPO proceedings were known. On 30 April 2020 the opponent informed the Tribunal that all of the proceedings were concluded, and the proceedings were resumed.

7. The opponent is represented by Mishcon de Reya LLP and the applicant is represented by Forresters IP LLP. Neither party filed evidence or written submissions.

No hearing was requested, and no submissions were filed in lieu of a hearing. The decision is taken following a careful perusal of the papers.

## **Decision**

8. Section 5(1) of the Act is as follows:

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

9. Section 5(2)(a) and (b) is also being relied upon and is as follows:

(2) A trade mark shall not be registered if because –

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

(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.”

10. An earlier trade mark is defined in Section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for

registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

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

11. The opponent’s marks qualify as earlier marks within the meaning of Section 6(1) of the Act because they have an earlier filing date than the contested application. The third and fifth earlier marks completed their registration procedure more than five years before the publication date of the application in suit and, as a result, are subject to the proof of use provisions contained in Section 6A of the Act. The applicant requested proof of use for the third and fifth earlier mark, however, no evidence to this effect was provided by the opponent. Therefore, these marks cannot be relied upon by the opponent in this decision.

12. For the sake of procedural economy, I will proceed with one mark, the second earlier mark. This mark is not subject to proof of use and the applicant has accepted that it is identical to the contested mark and that covers goods which are identical to those for which the contested mark seeks registration. I will therefore limit my decision to the opposition based on Section 5(1) grounds.

### **Sections 5(1)**

13. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

14. It is a prerequisite of Sections 5(1) that the respective trade marks and the respective goods (and/or services) are identical.

15. The applicant's mark consists of the words ANN TAYLOR. The second earlier mark consists of the words ANN TAYLOR. The marks are self-evidently identical, and the applicant has also accepted that they are identical.

16. The application covers *watches* and *jewellery* in class 14. The second earlier mark covers '*Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewelry, precious stones; horological and chronometric instruments; parts for horological and chronometric instruments; watches; clocks; watch straps; watch bands; watch fittings; electrical clocks; non-electric clocks; electric watches; non-electric watches; pendant chains for watches; bracelets for watches; cases for clocks; cases for watches*' in class 14. The term 'watches' is identically contained in both specifications. Despite the different spelling of the words, the applicant's *jewellery* is identical to the opponent's *jewelry*. The goods at issue are self-evidently identical and the applicant has also accepted that they are identical.

17. Under Section 5(1) of the Act a mark shall not be registered if it is identical to an earlier mark and the goods for which it seeks registration are identical to the goods for which the earlier mark is protected. I have concluded that both the marks and goods at issue in these proceedings are identical. Therefore, the opposition based on Section 5(1) of the Act succeeds accordingly. That being the case, there is no need for me to consider the additional grounds or the other earlier marks.

## **OUTCOME**

18. The opposition has succeeded under Section 5(1). The application is refused.

## **Costs**

19. The opponent has been successful and it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Note 2/2016. In the circumstances, I award the opponent the sum of £300 as a contribution towards its costs. The sum is calculated as follows:

Preparing a statement and considering the applicant's statement:	£200
Official fee:	£100
<b>Total</b>	<b>£300</b>

20. I therefore order Holzer y cia, s.a. de c.v. to pay Annco, Inc the sum of £300. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 5<sup>th</sup> day of February 2021

A Klass

For the Registrar,  
the Comptroller - General