

O-059-11

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO 911245

IN THE NAME OF

BATASAN LIMITED

OF THE TRADE MARK:

CIPOLLINO

IN CLASSES 5, 14, 16, 18, 20, 25, 28, 29, 30, 32, 33, 35, 38, 39, 43, 44 AND 45

AND THE APPLICATION FOR THE GRANTING OF PROTECTION THEREOF

IN THE UNITED KINGDOM

AND

THE OPPOSITION THERETO

UNDER NO 71543

BY

THE WEST MIDLAND SHOE COMPANY LIMITED

Trade Marks Act 1994

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in the name of Batasan Limited
of the trade mark:**

CIPOLLINO

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by The West Midland Shoe Company Limited**

1) Batasan Limited (Batasan) is the holder of the international registration for the trade mark:

CIPOLLINO

The United Kingdom was designated in respect of the international registration on 06 May 2006. An international priority date, from the Russian Federation, is claimed from 10 January 2006. The international registration was published, for opposition purposes, on 12 October 2007.

2) On 10 January 2008 The West Midland Shoe Company Limited (WM) filed a notice of opposition to the granting of protection of the trade mark in the United Kingdom in respect of the class 18 and 25 goods of the specification, namely:

leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery;

clothing, footwear, headgear.

3) WM bases its opposition upon section 5(2)(b) of the Trade Marks Act 1994(the Act), which states:

“(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 association with the earlier trade mark.”

It relies upon two United Kingdom trade mark registrations:

- Registration no 2289023 of the trade marks (a series of two)



CAPOLLINI

The application for registration was made on 24 December 2001 and the registration process was completed on 7 June 2002. As the trade marks had been registered for more than 5 years at the date of the publication of Batasan's trade mark they were subject to the proof of use requirement under section 6A of the Actⁱ and article 10C of The Trade Marks (International Registration) (Amendment) Order 2004 (which was then in force). WM claims that it has used the trade marks in respect of *footwear* in the period of five years ending with the date of publication of Batasan's trade mark. Other goods are in the class 25 specification but there has been no claim to use of them and so they are not relevant to these proceedings. In its written submissions WM claims that as it has proved use in respect of footwear it can pray in aid the other goods of the specification. This is clearly not the case. The parameters of its claim cannot go outside those pleaded.

- Registration no 2058245 of the same trade marks as for no 2289023. The application for registration was made on 28 February 1996 and the registration process was completed on 1 April 1997. This registration is also subject to proof of use. It is registered *for bags, leather goods; goods made from imitation leather; luggage, briefcases, credit card holders, wallets, umbrellas*. WM claims that it has been used for *handbags*, so the parameters of the opposition cannot go outside this claim.

4) WM claims that its trade marks are similar to that of Batasan and that *footwear; scarves, belts; articles of clothing made of leather and imitation leather in class 25* are identical or similar to all of the class 18 and 25 goods of the international registration. As the only class 25 goods upon which WM relies and for which it claims there has been use are footwear, this claim is flawed. WM

also claims that *handbags* are identical or similar to all of the class 18 and 25 goods of the international registration.

5) Batasan filed a counterstatement. It denies that its trade marks and those of WM are similar. It requires proof of use of the class 25 registration in respect of *footwear*. It denies that all of the class 18 and 25 goods of its registration are identical or similar to *footwear*. WM's class 18 registration was added as a basis for the opposition on 19 April 2010. WM was invited to comment on the amendment to the grounds of opposition on 12 May 2010. On 10 June 2010 Batasan was advised that as it had not commented on the amendment to the grounds it was the registrar's preliminary view that the amendment should be allowed. Batasan was allowed until 24 June 2010 to request a hearing if it disagreed with the preliminary view. No response was received and so the amendment was allowed. Batasan did not file an amended counterstatement. There has been no request for WM to substantiate its claim that it has used its trade marks in relation to *handbags* in the material period. Consequently, it must be accepted that WM has used its trade marks in respect of *handbags* in the material period.

6) WM filed evidence and made written submissions. Batasan did not file any evidence or furnish any written submissions.

Witness statement of Keith Williamson

7) As proof of use in respect of *handbags* has not been requested, the summary of the evidence will concentrate on the claim that the trade marks have been used in relation to *footwear*.

8) Mr Williamson is the managing director of WM. Mr Williamson gives approximate annual turnover figures for what he describes as the "registered goods" rather than the goods for which it has been claimed that there has been use. He states that the trade mark CAPOLLINI (in the word only format) has been used in respect of the "registered goods". He then identifies these goods as being *bags, purses and briefcases in class 18 and footwear; scarves, belts; articles of clothing made of leather and imitation leather in class 25*. In fact the goods of the class 18 registration are: *bags, leather goods; goods made from imitation leather; luggage, briefcases, credit card holders, wallets, umbrellas*. The only goods that can be considered in these proceedings are those for which use has been pleaded ie footwear and handbags. The figures that he gives for class 25 goods are as follows:

2002	£1 million
2003	£1.2 million
2004	£1.35 million
2005	£1.35 million
2006	£1.15 million

2007 £1.1 million

He states that the annual amounts spent on promoting the “registered goods” during the period 12 October 2002 to 12 October 2007 were:

2002 £5,000
2003 £5,000
2004 £7,000
2005 £7,000
2006 £5,000
2007 £6,000

9) Mr Williamson states that the “registered goods” have been sold under the trade mark CAPOLLINI during the period 12 October 2002 to 12 October 2007 in approximately 300 shops throughout the United Kingdom. Mr Williamson refers to pages 337 and 338 of exhibit KW1 which he states show specimen labels used at point of sales. The material, in fact, shows use of the stylised trade mark and not the word only trade mark. He states that “the goods” were advertised in various publications, including *Fashion Extras*, *Footwear Today* and *Women’s Wear Buyer*. Mr Williamson refers to pages 26-336 of exhibit KW1, which consist of brochures dated 2002 to 2007. He states that these brochures have been distributed throughout the United Kingdom. The brochures show shoes for women and handbags. The trade mark that is used the most is the stylised CAPOLLINI, however the non-stylised version can also be seen being used throughout the material period eg pages 37, 53, 67, 264 and 331 of exhibit KW1. The trade marks are used within the catalogues and can also be seen on the insoles of shoes.

10) At pages 1-25 of exhibit KW1 are copies of invoices, the invoices from page 16 onwards emanate from after 12 October 2007 so will not be taken into account. Pages 1-15 cover the period 18 January 2005 to 24 August 2007. The details of the recipients of the invoices have been blocked out. However, the locations of the recipients can be seen: Accrington, Sheffield, Bury St Edmunds, Steeple Bumpstead, Long Eaton, Sheringham, Hoddesdon, St Andrews, Rye, St Neots, Norwich, Newmarket, Troon and Oswestry. The invoices do not refer to the trade marks, however, the stock codes on the invoices can be cross-referenced to the catalogues that have been exhibited, pages 339 and 340 of exhibit KW1 identify the cross-references.

Findings of fact re use in class 25 of the trade marks

11) WM claims that it has used the trade marks in respect of footwear.

12) Section 100 of the Act states:

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

Consequent upon section 100, the onus is upon the registered proprietor to prove that it has made genuine use of a trade mark, or that there are proper reasons for non-use.

13) A convenient summary of the criteria relating to genuine use was given by the General Court (GC) in *Anheuser-Busch Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-191/07*:

“99 In interpreting the concept of genuine use, account should be taken of the fact that the ratio legis of the requirement that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a trade mark application is to restrict the number of conflicts between two marks, in so far as there is no sound economic reason resulting from an actual function of the mark on the market (Case T-174/01 *Goulbourn v OHIM – Redcats (Silk Cocoon)* [2003] ECR II-789, paragraph 38). However, the purpose of the provision is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-2811, paragraph 38, and judgment of 8 November 2007 in Case T-169/06 *Charlott v OHIM – Charlo (Charlott France Entre Luxe et Tradition)*, not published in the ECR, paragraph 33).

100 There is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the registration (Case C-234/06 P *Il Ponte Finanziaria v OHIM* [2007] ECR I-7333, paragraph 72; see also, by analogy, Case C-40/01 *Ansul* [2003] ECR I-2439, paragraph 43). In that regard, the condition of genuine use of the mark requires that the mark, as protected on the relevant territory, be used publicly and externally (*Silk Cocoon*, paragraph 99 above, paragraph 39; *VITAFRUIT*, paragraph 99 above, paragraph 39; *Charlott France Entre Luxe et Tradition*, paragraph 99 above, paragraph 34; see also, by analogy, *Ansul*, paragraph 37).

101 When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector

concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (VITAFRUIT, paragraph 99 above, paragraph 40; Charlott France Entre Luxe et Tradition, paragraph 99, paragraph 35; see also, by analogy, Ansul, paragraph 100, paragraph 43).

102 As to the extent of the use to which the earlier trade mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use (VITAFRUIT, paragraph 99 above, paragraph 41, and Charlott France Entre Luxe et Tradition, paragraph 99 above, paragraph 36).

103 The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The characteristics of those goods and services, the frequency or regularity of the use of the trade mark, whether the mark is used for the purpose of marketing all the identical goods or services of the proprietor or merely some of them, or evidence of use which the proprietor is able to provide, are among the factors which may be taken into account (Case C-416/04 P Sunrider v OHIM [2006] ECR I-4237, paragraph 71).

104 To examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case (VITAFRUIT, paragraph 99 above, paragraph 42; Charlott France Entre Luxe et Tradition, paragraph 99 above, paragraph 37; see also, by analogy, Ansul, paragraph 100 above, paragraph 39).

105 Moreover, the Court of First Instance has held that genuine use of a trade mark could not be proved by means of probabilities or suppositions, but had to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (Case T-39/01 Kabushiki Kaisha Fernandes v OHIM – Harrison (HIWATT) [2002] ECR II-5233, paragraph 47).”

14) There has been consistent use of the trade marks during the five year period in relation to goods included in the registration, there has been genuine use of the trade marks. It is necessary to decide upon a fair description for the goods for which genuine use has been shown and which fall within the parameters of the specification. The description must not be over pickyⁱⁱ. It is necessary to consider how the relevant public, which for these goods would be the public at large, describe the goodsⁱⁱⁱ. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK)*

Limited BL O/345/10 Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

15) The use has clearly been for shoes for women and it is considered that such a description would accord with the perception of the average consumer for footwear. WM has shown genuine use in the material period for shoes for women.

Average consumer, nature of purchasing decision and standard for likelihood of confusion

16) The average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant”^{iv}. The average consumer for the goods in question is the public at large. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 the General Court (GC) stated:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

The above finding equally applies here. The respective goods, whether in class 18 or 25, vary widely in price and quality and so across the gamut of the goods there will not be a particularly careful and highly educated purchasing decision. (The specification after proof of use of the earlier trade marks has to be taken in its broad perspective, it cannot be restricted to the exact nature of the goods

shown^v.) Consequently, the possibilities of imperfect recollection are increased. In the same judgment the GC stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer 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.”

The goods in question will be on display in shops, catalogues and on websites and so primarily will be bought by the eye, consequently, visual similarity will be of more importance than aural similarity.

Comparison of trade marks

17) The trade marks to be compared are:



CAPOLLINI

WM cannot be in any better position in relation to the stylised trade mark than the non-stylised trade mark, consequently, the comparison of the trade marks will be made upon the basis of the non-stylised trade mark.

18) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^{vi}. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant

components^{vii}. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{viii}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{ix}.

19) There are no separate distinctive and dominant elements in either trade mark. However, in *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-336/03* the GC stated:

“75 It should be noted in this regard that the attention of the consumer is usually directed to the beginning of the word (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-0000, paragraph 83).”

This is not a case where that rule of thumb is broken and so the beginnings of the trade marks are more important than the endings.

20) There is a very slight degree of stylisation in Batasan’s trade mark but it is unlikely to have any effect on the perception of the average consumer; to all intents and purposes it is a word trade mark. Both trade marks consist of nine letters, 7 of which are not only the same but come in the same place. There is a high degree of visual similarity. The only difference in pronunciation of the two trade marks occurs in the first and last vowels, all the consonants and the remaining vowels will be pronounced in the same manner. There is a good deal of aural similarity. Both trade marks give the impression of Italian surnames, although there is no evidence as to whether they are Italian surnames the average consumer is likely to perceive them in this way. This likelihood is increased owing to the reputation Italy has in relation to clothing, footwear and leather goods.

21) The respective trade marks are highly similar.

Comparison of goods

22) The goods of WM that are to be considered are *shoes for women* and *handbags* (as per section 6A (6) of the Act). **The submissions of WM relate to the full specifications and neither to the claimed use or established use and so are of no assistance.** The goods of the international registration are:

leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery;

clothing, footwear, headgear.

23) The strongest case for WM must lay with the class 18 goods against the class 18 goods and the class 25 goods against the class 25 goods and so the comparison of goods will be made on this basis.

24) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade^{xv}”. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning^{xi}. Consideration should be given as to how the average consumer would view the goods or services^{xii}. The class of the goods and services in which they are placed may be relevant in determining the nature of the goods^{xiii}. In assessing the similarity of goods it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^{xiv}. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^{xv}. Goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application^{xvi}.

25) As footwear includes shoes for women the respective goods are considered to be identical.

26) In *AVEX Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-115/02* the GC stated

“26 As regards, more particularly, the relationship between the ‘clothing’ covered by the earlier trade mark and the ‘footwear and boots’ covered by the trade mark applied for, the Board of Appeal took the view that those goods were similar because they have the same purpose, they are often sold in the same places and several manufacturers and designers deal with both those types of goods (paragraph 32 of the contested decision). The generality of that assessment may be called in question in the light of the lack of substitutability of those goods and the absence of evidence to support the assessment. However, in view of the sufficiently close links between the respective purposes of those goods, which are identifiable in particular in the fact that they belong to the same class, and the specific possibility that they can be produced by the same operators or sold together, it may be concluded that those goods may be linked in the mind of the relevant public. In that connection, the various Community and national decisions concerning trade marks on which the applicant relies do

not detract from that conclusion in so far as the factual background to those decisions, as regards the signs and goods at issue, displays significant differences from the present case. The goods at issue must therefore be regarded as similar within the meaning of Article 8(1)(b) of Regulation No 40/94 even if they are so in only a limited way.”

The above proposition was followed by the GC in *Leder & Schuh AG v Harmonisierungsamt für den Binnenmarkt (Marken, Muster und Modelle) (HABM)* Rechtssache T-32/03. **The proposition is adopted here, in relation to both clothing and headgear, so there is a limited degree of similarity between shoes for women and clothing and headgear.**

27) Goods made of these materials (being leather and imitations of leather) and not included in other classes will include handbags and so the respective goods must be considered to be identical.

28) *Leather and imitations of leather, animal skins, hides* are raw materials that are made up into completed goods. *Handbags* are often made of such materials, however, many goods are made of metal, this does not make the finished product similar to steel. ***Leather and imitations of leather, animal skins, hides* do not coincide within any of the parameters of the case law with *handbags*. They are dissimilar to *handbags*.**

29) There is no coincidence within the parameters of the case law between whips, harness and saddlery and handbags. The respective goods are dissimilar.

30) *Trunks and travelling bags* are all used for carrying objects, as are *handbags*. They can be made of the same materials. The goods can be found in the same shops or the same areas of large shops ie shops or departments selling luggage and/or leather goods. Consequently, the respective goods have the same general nature and purpose and have the same channels of trade. The respective goods are not fungible, they are not in competition. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the GC explained when goods are complementary:

“82 It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and

Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

The respective goods are not indispensable or important to each other. There is no evidence that any aesthetic harmony may be sought between the respective goods. If this were the case it would not necessarily establish that the respective goods are complementary, as the GC stated in *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-116/06:

“86 The intervener’s argument that eyewear, jewellery and watches could be similar or complementary to items of clothing cannot succeed, since, as correctly pointed out by OHIM, the relationship between those goods is too indirect to be regarded as conclusive. It must be borne in mind that the search for a certain aesthetic harmony in clothing is a common feature in the entire fashion and clothing sector and is too general a factor to justify, by itself, a finding that all the goods concerned are complementary and, thus, similar (*SISSI ROSSI*, paragraph 49 above, paragraph 62).”

The respective goods are not complementary. **There is a reasonable, but not overwhelming, degree of similarity between *trunks and travelling bags and handbags*.**

31) *Umbrellas, parasols and walking sticks* do not share the same nature as *handbags*. The respective goods have completely different purposes. The respective goods are not fungible, they are not in competition. Taking into account the judgments of the GC in relation to complementary goods, see above, the respective goods cannot be considered to be complementary. There is no evidence that that the respective goods appear in the same shops or areas of shops. ***Umbrellas, parasols and walking sticks are not similar to handbags.***

Conclusion

32) There can only be a likelihood of confusion where the goods are similar or identical. Consequent upon the findings above, the likelihood of confusion can only exist in relation to:

clothing, footwear, headgear, goods made of these materials (being leather and imitations of leather) *and not included in other classes and trunks and travelling bags.*

33) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{xvii}. In this case the trade marks are highly similar. The respective trade marks have no conceptual hook for the

consumer to hang onto other than that they have the appearance of Italian surnames. This absence of a conceptual hook and the unfamiliar nature of the respective trade marks increase the effects of imperfect recollection.

34) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{xviii}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xix}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings^{xx}. The earlier trade mark is neither descriptive nor allusive of the goods for which use has been claimed/established. It enjoys a reasonable degree of distinctiveness.

35) Owing to the similarity of the respective trade marks and the likely effects of imperfect recollection, even where there is only a low degree of similarity between the respective goods there will be a likelihood of confusion. The application for protection of the international registration in the United Kingdom is to be refused in respect of:

goods made of these materials and not included in other classes;

trunks and travelling bags;

clothing, footwear, headgear.

Costs

36) WM has been more successful than Batasan in these proceedings and so will receive a contribution towards its costs, a contribution that is at the lower end of the scale owing to the partial failure in respect of class 18 goods and the misconceived submissions in relation to the comparison of goods. It is also taken into account that the class 18 registration was added at a late stage in the proceedings. Costs are awarded on the following basis:

Opposition fee:	£200
Preparing a statement and considering the other side's statement:	£200
Preparing evidence:	£500
Written submissions	£100

Total £1,000

Batasan Limited is to pay The West Midland Shoe Company Limited the sum of £1,000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21 day of February 2011

**David Landau
For the Registrar
the Comptroller-General**

ⁱ Section 6A of the Act reads:

“(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration)."

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

"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."

ⁱⁱ *Animal Trade Mark* [2004] FSR 19:

"20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor

blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

ⁱⁱⁱ *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32:

"29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

^{iv} *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* Case C-342/97.

^v See by analogy with the trade mark to be considered: *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 147/03.

^{vi} *Sabel BV v Puma AG* Case C-251/95.

^{vii} *Sabel BV v Puma AG* Case C-251/95.

^{viii} *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

^{ix} *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^x *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

^{xi} *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

^{xii} *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

^{xiii} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^{xiv} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{xv} He considered that the following should be taken into account when assessing the similarity of goods and/or services:

(a) The respective uses of the respective goods or services;
(b) The respective users of the respective goods or services;
(c) The physical nature of the goods or acts of service;
(d) The respective trade channels through which the goods or services reach the market;
(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

^{xvi} See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05 paragraph 29:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

^{xvii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{xviii} *Sabel BV v Puma AG* Case C-251/95.

^{xix} *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

^{xx} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.