

**O-007-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 3063667  
BY EDDIE HANDMADE LTD  
TO REGISTER THE TRADE MARK  
EDDIE  
IN CLASSES 9, 16, 18, 24, 25, 40 & 42  
AND**

**IN THE MATTER OF OPPOSITION  
THERE TO UNDER No. 403443 BY  
MRS DALILA OSSAI**

## BACKGROUND

1) On 10 July 2014, Eddie Handmade Ltd (hereinafter the applicant) applied to register the trade mark EDDIE in respect of the following goods and services:

**Class 9:** Leather cases for mobile phones; leather laptop and computer carrying cases; leather sleeves for laptops and tablet computers; laptop and computer carrying cases; sleeves for laptops and tablet computer; cases for mobile phones.

**Class 16:** Printed matter, stationery; photographs; advertising posters, publications, signs of paper or cardboard; promotional publications; passport holders.

**Class 18:** Bags; handbags; briefcases; wallets; pouches; purses; satchels; credit card wallets; credit card holders; document cases; clutch bags; holdalls; articles of luggage; luggage; luggage tags; umbrellas; covers for umbrellas; travelling sets and bags; leather and goods made of these materials namely, leather bags, handbags, cases, briefcases, wallets, pouches, purses, straps, satchels, credit card wallets, credit card holders, document holders, document cases, clutch bags, envelopes, holdalls, articles of luggage; travelling sets and bags [leatherware]; luggage tags [leatherware]; textile shopping bags; parts and/or fittings for all the aforesaid goods.

**Class 24:** Fabrics; textiles and textile goods, not included in other classes; linens; household textile goods; textile piece goods including those for making into cushion covers and those for use in manufacture of shoes and boots; fabrics being textile piece goods; textile goods for use as bedding.


**Class 25:** Shoes; boots; belts [clothing]; leather belts [clothing]; handkerchiefs; textile handkerchiefs; scarfs.

**Class 40:** Custom manufacture of goods.

**Class 42:** Custom design services.

2) The application was examined and accepted, and subsequently published for opposition purposes on 26 September 2014 in Trade Marks Journal No.2014/040.

3) On 18 December 2014 Mrs Dalila Ossai (hereinafter the opponent) filed a notice of opposition, subsequently amended. The opponent is the proprietor of the following trade mark:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
	2461827	19.07.07 14.12.07	25	Clothing, Footwear and Headgear

- a) The opponent contends that her mark and the mark applied for are very similar and that the goods in class 25 for which her mark is registered are identical and/or very similar to those applied for by the applicant in class 25. She also contends that the following items in class 18 applied for by the applicant are similar to her goods in class 25: "Bags, handbags, wallets,

purses, luggage, holdalls, leather goods". She contends that the application offends against Section 5(2)(b) of the Act.

- 4) On 5 March 2015 the applicant filed a counterstatement, basically denying that the marks are similar, and claiming an "own name" defence. The applicant requested proof of use.
- 5) Both sides filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard. Both sides provided written submissions which I shall refer to as and when necessary in my decision.

## OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 27 April 2015, by Edmund Ossai who describes himself as the Director and owner of Eddie O Ltd. He states that he is authorised to speak on behalf of his wife (the opponent). He states that in 2006 he and his wife started a company to sell a range of men's and women's clothing and shoes. They decided to start by offering underwear to establish the brand in the market before introducing other ranges. They decided upon the name EDDIE O and registered the name in 2007. He and his wife started trading under this mark in 2006 and in 2011 they incorporated the limited company with his wife as the company secretary. The mark was first used in 2007 and has been in continuous use in the UK since in relation to underwear and T-shirts for men and boys. He provides the following annual sales and promotional figures:

Year	Sales £	Promotional expenditure £
2012	11,124	10,000
2013	31,636	13,000
2014	14,593	13,000

7) Mr Ossai states that the promotional expenditure has been with digital media marketing and sponsoring local football clubs and football celebrities. He states that goods have been sold throughout the UK and Northern Ireland. He provides a number of exhibits:

- EO1: A T shirt, which has the mark in suit on the neck label and also the plastic packaging. However, instead of being white letters on a black background the letters are black on a white background. Mr Ossai states that such items have been available since 2006.
- EO2: A T shirt, which has the mark in suit on the neck label and also the plastic packaging. However, instead of being white letters on a black background the letters are black on a white background. Mr Ossai states that such items have been available since 2006.
- EO3: A pair of boxer shorts which have the mark in suit printed numerous times in large type on the waistband, as well as on the inside label and on the packaging. Whilst the labelling on the packaging has white letters on a black background the garment has black letters on a white background. Mr Ossai states that such items have been available since 2006.
- EO4: A pair of briefs which have the mark in suit printed numerous times in large type on the waistband, as well as on the inside label and on the packaging. The garment has black letters on a white background whilst the packaging has white letters on a neutral background (see annex 1). Mr Ossai states that such items have been available since 2006.
- EO5: A pair of briefs which have the mark in suit printed numerous times in large type on the waistband, as well as on the inside label and on the packaging. The garment has black letters

on a white background whilst the packaging has white letters on a neutral background (see annex 1). Mr Ossai states that such items have been available since 2006.

- EO6: A pair of boxer shorts which have the mark in suit (white letters on a black background) printed once in large type on the waistband, as well as on the inside label and on the packaging. Mr Ossai states that such items have been available since 2006.
- EO7: A photograph of the Dagenham and Redbridge Football team, dated 2009, advertising the mark in suit (white letters on a black background). The advertisement appeared in the club programme at the time.
- EO8: Pages from various web sites showing the mark in suit being used. The page shows the mark being used on underwear and T-shirts which are offered for sale. The images show both white letters on a black background and black letters on a white background. Although undated it does have a copyright date of 2014.
- EO9: Pages from sites such as Facebook, twitter, instagram, pinterest and google which show the mark being used. However, none of these pages are dated.
- EO10: Customer feedback from websites such as Amazon and eBay. These are after the relevant date, The website does show the profile of the company which shows the number of comments in the past 30, 90 and 365 days, however even taking 90 days off the comment date does not equate to a date prior to the relevant date.
- EO11: Pages from the applicant's website which shows the name EDDIE at the top of the page and pictures of men in clothing. Mr Ossai comments that the website is similar to the opponent's website.

## **APPLICANT'S EVIDENCE**

8) The applicant filed a witness statement, dated 11 August 2015, by Imogen Francis a solicitor. She states that she researched the name EDDIE on the Internet in respect of clothing and came up with a number of hits. However, these are all dated 11 August 2015, after the relevant date. Another minor drawback is that four of the sites are American, one is Canadian and another based in Eire. The only other site is a range of T-shirts with slogans upon them said to have inspired by a comedian called Eddie.

9) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## **DECISION**

10) The only ground of opposition is under section 5(2)(b) which reads:

“5.-(2) A trade mark shall not be registered if because -

- (a) .....
- (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.”

11) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

12) The opponent is relying upon her trade mark listed in paragraph 3 above which is clearly an earlier trade mark. The applicant requested that the opponent provide proof of use and, given the interplay between the date that the opponent’s mark was registered (14 December 2007) and the date that the applicant’s mark was published ( 26 September 2014), the proof of use requirement bites. Section 6A of the Act states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark 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).”

13) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its mark has been made. In the instant case the publication date of the application was 26 September 2014, therefore the relevant period for the proof of use is 27 September 2009 – 26 September 2014. In *Stichting BDO v BDO Unibank, Inc.*, [2013] F.S.R. 35 (HC), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

14) Although minimal use may qualify as genuine use, the Court of Justice of the European Union (CJEU) stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

15) Also in *Laboratoire de la Mer* Trade Mark [2006] FSR 5, the Court of Appeal held that sales under the mark to the trade may qualify as genuine use. Mummery L.J. stated that:

“31. After some hesitation I have reached a different conclusion from Blackburne J. on the application of the Directive, as interpreted in *Ansul* and *La Mer* , to the rather slender facts found by Dr Trott.”

32. Blackburne J. interpreted and applied the rulings of the Court of Justice as placing considerably more importance on the market in which the mark comes to the attention of *consumers and end users* of the goods than I think they in fact do. I agree with Mr Tritton that the effect of Blackburne J.'s judgment was to erect a quantitative and qualitative test for market use and market share which was not set by the Court of Justice in its rulings. The Court of Justice did not rule that the retail or end user market is the only relevant market on which a mark is used for the purpose of determining whether use of the mark is genuine.

33. Trade marks are not only used on the market in which goods bearing the mark are sold to consumers and end users. A market exists in which goods bearing the mark are sold by foreign manufacturers to importers in the United Kingdom. The goods bearing the LA MER mark were sold by Goëmar and bought by Health Scope Direct on that market in arm's length transactions. The modest amount of the quantities involved and the more restricted nature of the import market did not prevent the use of the mark on the goods from being genuine use on the market. The Court of Justice made it clear that, provided the use was neither token nor internal, imports by a single importer could suffice for determining whether there was genuine use of the mark on the market.

34. There was some discussion at the hearing about the extent to which Goëmar was entitled to rely on its intention, purpose or motivation in the sales of the goods bearing the mark to Health Scope Direct. I do not find such factors of much assistance in deciding whether there has been genuine use. I do not understand the Court of Justice to hold that subjective factors of that kind are relevant to genuine use. What matters are the objective circumstances in which the goods bearing the mark came to be in the United Kingdom. The presence of the goods was explained, as Dr Trott found, by the UK importer buying and the French manufacturer selling quantities of the goods bearing the mark. The buying and selling of goods involving a foreign manufacturer and a UK importer is evidence of the existence of an economic market of some description for the goods delivered to the importer. The mark registered for the goods was used on *that* market. That was sufficient use for it to be genuine use on the market and in *that* market the mark was being used in accordance with its essential function. The use was real, though modest, and did not cease to be real and genuine because the extinction of the importer as the single customer in the United Kingdom prevented the onward sale of the goods into, and the use of the mark further down, the supply chain in the retail market, in which the mark would come to the attention of consumers and end users.”

16) Whilst Neuberger L.J. (as he then was) stated:

“48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be “genuine”, the use of the mark has to be such as to be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be “consistent with the essential function of a trademark” as explained in [36] and [37] of the judgment in *Ansul*, it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler.”

17) The applicant contends in its submissions that the use shown has been in a form differing in elements which alter the distinctive character of the mark in the form in which it is registered. In particular it points out that the letters shown are solid rather than having shading round the edges and in many instances the black background or line is absent. In determining this issue I look to *Nirvana Trade Mark*, BL O/262/06, where Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

"33. .... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character



identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

18) I also take into account the following cases; *Remus Trade Mark* – BL O/061/08 (Appointed Person); *OAO Alfa-Bank v Alpha Bank A.E.* - 2011 EWHC 2021 (Ch) and *Orient Express Trade Mark* - BL O/299/08 (Appointed Person). Although these cases were decided before the judgment of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, they remain sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

19) None of the exhibits filed has any shading around the letters as shown in the registered mark. However, such shading is a minor stylisation and in my opinion does not affect the distinctive character of the mark. Similarly use of the negative image (black letters on a white background) amounts to use of the mark in suit. Therefore, the images shown on the various exhibits amount, in my opinion, to use of the mark as registered.

20) On the issue of the evidence in general the applicant contended:

"10.....no evidence is given of any actual sales or advertising to support the figures quoted and so the figures are irrelevant and should be dismissed."

&

"12. The applicant notes that no invoices showing sales of the opponent's products in the UK have been submitted, no receipts showing money being spent on advertising have been submitted and no other proof of sale or advertising of the opponent's goods has been submitted at any substantial level, if at all. Therefore, overall, the evidence submitted by the opponent is insufficient to successfully demonstrate use of their mark in the UK in the last five years. As such, we ask that the opposition is dismissed in respect of all the opponent's goods as claimed."

21) When considering the evidence filed I take into account the comments in *Awareness Limited v Plymouth City Council*, Case BL O/230/13, where Mr Daniel Alexander Q.C. as the Appointed Person stated that:

"22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

and further at paragraph 28:

"28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as "tuition services", is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to "tuition services" even by compendious

reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

22) I also look to the case of *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, where Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

23) The opponent’s evidence was not challenged by the applicant nor was cross examination sought. I accept the criticism of the opponent’s evidence, but given that sales would have been to individuals and likely to relate to a single item of relatively low cost the absence of sales invoices is understandable, as copies may not have been kept as payment would have been made prior to shipping. Equally most of the promotion has been via social media and sponsorship. The sales figures claimed are very modest and believable. Taking the evidence in its entirety it shows that the opponent has made a small but genuine number of sales of underwear and T shirts under the mark registered.

24) I must now consider the goods on which use has been shown. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“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.”

25) In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky 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 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.”

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that 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 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. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any

real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

26) The opponent’s mark is registered for “clothing, footwear and headgear”. It has clearly not used its mark on footwear or headgear and has only used it on underwear and T shirts which I believe are acceptable and recognisable subsets of “clothing”. This finding also accords with the applicant’s submissions should genuine use be found. Therefore, in the ensuing comparison of goods the opponent can only rely upon underwear and T-shirts.

27) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions 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 C-3/03, *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 a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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.

### **The average consumer and the nature of the purchasing decision**

28) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“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.”

29) The applicant contends:

“16. The average consumer of the relevant goods pay a high level of attention when purchasing clothing, as they buy clothing both as a status symbol and to look good. As such, the average consumer in this instance when faced with goods both bearing a commonly used name on clothing, where the marks are only weakly similar and the goods are dissimilar (or only weakly similar at most) would not be confused.”

30) Both parties have specifications, broadly speaking, of clothing although the applicant's includes footwear and headgear. Such goods will be sold in, inter alia, traditional retail outlets on the high street, through catalogues and on the Internet. The specifications of both parties are unlimited, and so I must keep all of these trade channels in mind. The average consumer of the goods at issue is a member of the general public (including businesses) who is likely, in my opinion, to select the goods mainly by visual means. I accept that more expensive items may be researched or discussed with a member of staff. In this respect I note that in *New Look Ltd v OHIM Cases- T-117/03 to T-119/03 and T-171/03*, the General Court (GC) said this about the selection of clothing:

“50. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

31) In the same case the Court also commented upon the degree of care the average consumer will take when selecting clothing. It said:

“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 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.”

32) Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of clothing such as underwear, the average consumer will pay attention to considerations such as size, colour, fabric and cost. Overall the average consumer is likely to pay a medium degree of attention to the selection of such items of clothing.

### **Comparison of goods**

33) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

34) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

35) In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-325/06, the General Court stated that “complementary” means:

“...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”.

36) As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

37) The goods of the two parties are:

Applicant's goods	Opponents' goods
Class 18: Bags, handbags, wallets, purses, luggage, holdalls, <i>leather goods</i> [I accept that this term does not appear in the applicant's specification but it is the specification used by the opponent in its statement of grounds.]	Class 25: Underwear and T-shirts
Class 25: Shoes; boots; belts [clothing]; leather belts [clothing]; handkerchiefs; textile handkerchiefs; scarfs.	

38) Regarding the similarity between goods in classes 18 & 25 I take into account *Gitana SA, v OHIM*, Case T-569/11, where the General Court stated that:

“45. Moreover, in respect of the relationship between the ‘goods in leather and imitations of leather’ in Class 18 covered by the trade mark sought and the goods in Class 25 covered by the earlier mark, it is apparent also from settled case-law that the ‘goods in leather and imitations of leather’ include clothing accessories such as ‘bags or wallets’ made from that raw material and which, as such, contribute, with clothing and other clothing goods, to the external image (‘look’) of the consumer concerned, that is to say coordination of its various components at the design stage or when they are purchased. Furthermore, the fact that those goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and support the impression that the same undertaking is responsible for the production of those goods. It follows that some consumers may perceive a close connection between clothing, footwear and headgear in Class 25 and certain ‘goods made of these materials [leather and imitations of leather] and not included in other classes’ in Class 18 which are clothing accessories. Consequently, clothing, shoes and headgear in Class 25 bear more than a slight degree of similarity to a category of ‘goods made of these materials [leather and imitations of leather] and not included in other classes’ in Class 18 consisting of clothing accessories made of those materials (see, to that effect, *PiraÑAM diseño original Juan Bolaños*, paragraph 42 above, paragraphs 49 to 51; *exē*, paragraph 42 above, paragraph 32; and *GIORDANO*, paragraph 42 above, paragraphs 25 to 27).”


39) Only in the most general terms could there be said to be any similarity between handkerchiefs/scarfs and underwear/T-shirts, in that they are articles of clothing. Whilst it may be the case that items such as shoes, boots, belts and bags may be considered complementary and as a consequence similar to a degree to clothing this usually relates to articles of outwear such as dresses, coats, jackets or suits. **To my mind, the goods of the two parties are not similar nor are they complementary.**

### Comparison of trade marks

40) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Case C-591/12P, Bimbo SA v OHIM*, 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.”

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

Opponents' trade mark	Applicant's trade mark
	EDDIE

42) The applicant contended:

“15. Additionally, the name EDDIE is a common first name and is commonly used by both designers of clothing and clothing retailers, please see enclosed witness statement of Imogen Francis. As such, the distinctiveness of the common component of the applicant's and the opponent's marks [sic], being EDDIE, in relation to clothing is average. Therefore, the similarity between the marks is very low as the opponent's mark is highly stylised in a distinctive and dominant manner, which would not be overlooked by the average consumer, and has a dominant and distinctive letter “O” at the end of the mark, all of which act to differentiate the marks. Whereas the applicant's mark is not stylised in such a manner at all. Therefore, the marks are only weakly similar at best.”

43) The applicant has failed to show that the name EDDIE is either a common first name in the UK or that it is commonly used by the trade. None of the evidence filed showed use of the name EDDIE by others in the UK. Nor do I accept that the mark is highly stylised such that the stylisation is distinctive and dominant. Whilst the opponent's mark clearly has a letter “O” at the end, the other differences are marginal and so the marks are similar to at least a medium degree.

### Distinctive character of the earlier trade mark



44) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

45) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

46) The opponent’s mark consists of the well known first name EDDIE. It also has the letter “O” after it suggesting a particular individual. As the applicant’s evidence has shown the name is not particularly common in the UK or in the trade. The mark has no meaning in respect of the goods on which it has been used. The mark is inherently distinctive to a medium degree. Although the opponent has shown use of its mark it has been at a low level and is not enough for the opponent to benefit from enhanced distinctiveness.

## **Likelihood of confusion**

47) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public (including businesses), who will select the goods by predominantly visual means, although not discounting aural considerations and that the degree of care and attention they pay will vary depending upon cost but they are likely to pay a medium degree of attention to the selection of such items.
- the goods of the two parties which form part of the comparison test are not similar.
- the marks of the two parties are similar to at least a medium degree.
- the opponent's mark has a medium level of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.

48) In view of the above, and allowing for the concept of imperfect recollection, there is no likelihood of consumers being confused into believing that the goods applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to her. **The opposition under Section 5(2) (b) therefore fails completely.**

## **CONCLUSION**

49) As the opposition in relation to the goods in classes 18 and 25 has failed completely, the application can now be registered for all of the goods and services applied for.

## **COSTS**

50) As the applicant has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Preparing evidence and considering the other side's evidence	£300
Preparing submissions	£200
<b>TOTAL</b>	<b>£800</b>

51) I order Mrs Dalila Ossai to pay Eddie Handmade Ltd the sum of £800. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 7<sup>TH</sup> day of January 2016**

**George W Salthouse**  
**For the Registrar,**

**the Comptroller-General**

**Annex 1**

