

O/124/21

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3317771
IN THE NAME OF GLH IP HOLDINGS LIMITED**

**AND IN THE MATTER OF OPPOSITION No. 413968 THERETO
BY FASHION BOX SPA**

**IN THE MATTER OF REGISTRATION No. 3318723
IN THE NAME OF GLH IP HOLDINGS LIMITED**

**AND IN THE MATTER OF INVALIDATION No. 502283 THEREOF
BY FASHION BOX SPA**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY FASHION BOX SPA
AGAINST A DECISION BY MS S WILSON
DATED 17 FEBRUARY 2020**

DECISION

Background

1. GLH IP Holdings Limited (“GLH”) applied on 14 June 2018 under number 3317771 to register the designation represented below for use as a trade mark in the UK:

RE:PLAY
BAR

2. GLH is also the proprietor of UK Registration number 3318723 which was applied for on 18 June 2018 and entered on the Register on 21 September 2018 and concerns the following trade mark:

RE:PLAY

3. Both of GLH’s RE:PLAY BAR/RE:PLAY figurative trade marks were applied for/registered in the UK for the same specification of services, namely:

Class 43

Bar services; restaurant, café and catering services; hiring of bar, catering and restaurant equipment and facilities; temporary accommodation reservations; hotel and motel services; rental of temporary accommodation; preparation of food, meals and beverages for the consumption on or off the premises; provision of food and drink; rental of rooms for holding functions, conferences, conventions, exhibitions, seminars and meetings.

4. On 5 October 2018, Fashion Box SpA (“Fashion Box”) filed: (1) Notice of opposition and statement of grounds against Application number 3317771 under Section 5(3) and 5(4)(a) of the Trade Marks Act 1994; and (2) Application to declare invalid Registration number 3318723 under Section 47(2) and Section 5(3) and 5(4)(a) of the Act.
5. In other words the grounds for refusal/invalidity of registration were to all intents and purposes the same. First, Section 5(3) precluded from registration a trade mark which was identical or similar to an earlier trade mark with reputation in the UK/EU where the use of the former without due cause took unfair advantage of, or was detrimental to, the distinctive character or repute of the latter. Second, Section 5(4)(a) denied the registration of a trade mark whose use in the UK was liable to be prevented by the law of passing off.
6. In the current proceedings, the applicable dates for determining those grounds of refusal/invalidity of registration were 14 June 2018 (Application number 3317771) and 18 June 2018 (Registration number 3318723).
7. Under Section 5(3), Fashion Box relied on the following earlier trade marks in its ownership:

Mark	Filing/registration dates	Class of goods
UK 1551752 – REPLAY	27.10.93/21.10.94	25
UK 1487709 – REPLAY	08.01.92/12.02.93	18
UK 1201267 – REPLAY	05.08.88/28.10.88	25
EU 520080 – REPLAY	18.04.97/31.01.06	18, 25

8. GLH took issue with the grounds for refusal/invalidity in Notices of defence and counterstatement filed on 11 July 2019 (opposition) and 13 December 2018 (invalidation), and in both cases put Fashion Box to proof of use of its earlier trade marks.
9. Only Fashion Box filed evidence¹. Neither side requested a hearing. The Hearing Officer decided the opposition/invalidity proceedings on the basis of the papers on file and the written submissions of Fashion Box.

¹ The opposition and invalidation proceedings were consolidated by the UKIPO on 5 September 2019.

10. Throughout these proceedings Fashion Box have been represented by D Young & Co LLP, and GLH by HGF Limited.

Hearing Officer's decision

11. Ms S Wilson, acting for the Registrar, issued her written decision on 17 February 2020 under reference number O/098/20.

12. In that decision, the Hearing Officer's findings were in summary:

1) Fashion Box had successfully established genuine use in the UK/EU for its 4x earlier trade marks to the following extent (paras. 36 – 47):

Earlier trade mark	Goods	Class
UK 1551752	Coats, overcoats, jackets, trousers, shirts and blouses, sweaters, sweatshirts, hats shoes	25
UK 1487709	Handbags	18
UK 1201267	Coats, jackets	25
EU 520080	Handbags Clothing, footwear, hats	18 25

- 2) The REPLAY brand had a reasonable reputation in the UK for clothing (para. 52).
- 3) The respective marks were visually similar to between a medium and high degree. The marks were aurally identical or aurally similar to a high degree (if BAR were pronounced in Application number 3317771). Conceptually, the respective marks were identical (Registration number 3318723) or highly similar (Application number 3317771) (para. 53, pp. 24 – 25).
- 4) The respective goods (clothing, footwear, hats, handbags) and services (bar, restaurant, accommodation, conference services) were dissimilar (para. 53, pp. 25-26).
- 5) The earlier trade marks were inherently distinctive to a medium degree, which had been enhanced through use in relation to clothing in the UK to a higher than medium degree (para. 53, pp. 26 – 27).
- 6) In view of the dissimilarity of the respective goods and services, there was no likelihood of confusion (para 53, p. 27).
- 7) No “link” between the respective marks would be made by the relevant public:

“54. I recognise that the parties’ respective marks are aurally and conceptually identical or highly similar, and visually similar to

between a medium and high degree. However, Fashion Box has demonstrated only a reasonable reputation in relation to clothing. This, combined with the dissimilarity between the goods and services for which the marks are registered, leads me to conclude that no link will be made by the relevant public. If any link is made, it would be too fleeting for the image of the earlier marks to transfer to the later marks in such a way that would give them an unfair advantage.”

- 8) The opposition and invalidation under Section 5(3) failed (para. 55).
- 9) Fashion Box had demonstrated a good degree of goodwill in the UK for clothing, hats, footwear, and handbags. The earlier signs were distinctive of that goodwill (para. 63).
- 10) Particularly because of the dissimilarity in the goods and services there was no likelihood of deception (paras. 66 – 67):

“67. Taking all of the above factors into account, I consider that similarities between the marks will be offset by the differences between the goods and services and the fact that Fashion Box only has a good degree of goodwill in the UK. I can see no reason, particularly given the dissimilarity between the goods and services, why the relevant public would view the use of the word REPLAY in relation to GLH’s services to be a reference to Fashion Box or its trade marks.”

- 11) The opposition and invalidation under Section 5(4)(a) failed (para. 68).
- 12) Fashion Box was ordered to pay GLH a contribution on the Registrar’s scale towards its costs of the proceedings in the sum of £900 (paras. 72 – 73).

The appeal

13. Fashion Box gave Notice to appeal to the Appointed Person under Section 76 of the Act, dated 16 March 2020.
14. The grounds of appeal were stated to be threefold:
 - 1) The Hearing Officer erred in her assessment of the similarity of goods and services. She should have concluded that the goods in the earlier trade marks (clothing, footwear, hats, handbags) on the one hand, and the services in the trade mark applied for (bar, restaurant, accommodation, conference services) on the other hand, were in fact similar (not as the Hearing Officer found, dissimilar).
 - 2) The Hearing Officer incorrectly held that the earlier trade marks enjoyed: (a) a reasonable reputation in the UK for clothing; and (b) a good degree of goodwill in the UK in relation to clothing, hats, footwear, and handbags, whereas she should instead have found that such reputation was extraordinary and such goodwill extensive.

- 3) The Hearing Officer incorrectly ordered Fashion Box to pay to GLH the sum of £500 for considering Fashion Box's evidence.
15. The Statement of grounds of appeal included a request to adduce fresh evidence into the proceedings in the form of a Second Witness Statement of Eligio Volpi, the Managing Director of Fashion Box, dated 31 March 2020, plus Exhibits EV11 to EV16, and confidential Exhibit EV17.
16. An oral hearing by video conference was appointed and notified to the parties, at which I directed that I would hear Fashion Box's request to adduce fresh evidence as a preliminary to the appeal.
17. Neither party wished to attend or be represented at the scheduled video hearing. In response to my further directions issued on 20 January 2021, both parties confirmed in writing that they were content for the request and the appeal to be decided by me on the papers on file, and any written submissions in lieu of attendance. Only Fashion Box filed written submissions dated 25 January 2021.

Request to admit fresh evidence

18. The principles governing the admission of fresh evidence on appeal were summarised by Henry Carr J in *Consolidated Developments Ltd v. Cooper* [2018] EWHC 1727 as follows:

“33. The cases to which I have referred establish the following principles in respect of the admissibility of fresh evidence in trade mark appeals, sought to be introduced for the first time on appeal:

- i) the same principles apply in trade mark appeals as in any other appeal under CPR part 52. However, given the nature of such appeals, additional factors may be relevant;
- ii) the *Ladd v Marshall* factors are basic to the exercise of the discretion, which are to be applied in the light of the overriding objective;
- iii) it is useful to have regard to the *Hunt-Wesson* factors;
- iv) relevant factors will vary, depending on the circumstances of each case. Neither the *Ladd v Marshall* factors nor the *Hunt-Wesson* factors are to be regarded as a straightjacket;
- v) the admission of fresh evidence on appeal is the exception and not the rule;
- vi) the *Gucci* decision does not establish that the Court or the Appointed Person should exercise a broad remedial discretion to admit fresh evidence on appeal so as to enable the appellant to re-open proceedings in the Registry; and

vii) where the admission of fresh evidence on appeal would require that the case be remitted for a rehearing at first instance, the interests of the parties and of the public in fostering finality in litigation are particularly significant and may tip the balance against the admission of such evidence.”

19. The 3 conditions in *Ladd v. Marshall* [1954] EWCA Civ 1 that are central to the appeal tribunal’s discretion to allow new evidence are (Denning LJ at p. 4):

“In order to justify the reception of fresh evidence or a new trial, three conditions must be fulfilled: first, it must be shown that the evidence could not have been obtained with reasonable diligence for use at the trial: second, the evidence must be such that, if given, it would probably have an important influence on the result of the case, though it need not be decisive: thirdly, the evidence must be such as is presumably to be believed, or in other words, it must be apparently credible, though it need not be incontrovertible.”

20. The additional factors in *Hunt-Wesson Inc’s Trade Mark Application* [1996] 1 RPC 233 at 242 that may be relevant include: (a) the nature of the mark; (b) the nature of the objection to it; (c) whether or not the other side will be significantly prejudiced by the admission of the new evidence in a way which cannot be compensated, for example, by an order for costs; (d) the desirability of avoiding multiplicity of proceedings; and (e) the public interest in not admitting onto the Register invalid marks.

Further evidence in suit

21. Fashion Box intimated that the need for the further evidence sought to be introduced arose from the observation of the Hearing Officer underlined by Fashion Box in the passage below (decision, para. 53, p. 26):

“Clearly, the goods and services differ in nature and method of use. I also consider that they differ in purpose and trade channels. Fashion Box submits that it [is] not uncommon for hotels and bars to have retail outlets within their premises or associated with them, citing the Hard Rock Café as an example. I disagree. To my mind, this is far from common practice. In the absence of any evidence filed by Fashion Box to support this submission, I see no reason to conclude that there is an overlap in trade channels.”

22. Fashion Box argued that:

- (a) Fashion Box did not previously file evidence in support of its assertion that it was “*not uncommon for bars and hotels to often have retail outlets within the premises, or associated therewith*” because Fashion Box believed that judicial notice could be taken of that fact;
- (b) the assertion was made in the context of proving a “link” for 5(3) (not comparing goods/services under 5(2)(b));

- (c) the fresh evidence was sought to be introduced specifically in support of the submission that it was not uncommon for bars and hotels to often have retail outlets within the premises, or associated therewith;
- (d) the admission of the evidence at this stage would avoid the multiplicity of proceedings and save time and costs.

23. As I said, the evidence sought newly to be introduced comprised a Second Witness Statement of Eligio Volpi, the MD of Fashion Box, dated 31 March 2020, referring to the following exhibits:

- (1) EV11 – copies of articles entitled “*Replay inaugurates The Stage restaurant inside its Milan store*” by Maria Christina Pavarini, dated 30 March 2015, downloaded from <https://www.sportswear-international.com> and “*Replay launches store-restaurant*” by Dominique Muret, published on 27 March 2015 on <https://www.fashionnetwork.com>. Mr Volpi explains that these concern Fashion Box’s flagship clothing store in Milan which incorporates a restaurant, café, and bar. The articles describe these facilities (The Stage restaurant and the Octavius bar) as occupying the top floor of the store. The owner of Fashion Box is quoted as saying that two more “one of a kind” single store concepts will also open in New York and London although no final decisions had been taken. [There is no evidence that the latter plans had materialised.]
- (2) EV12 – EV13 – copy press articles in the period 2015 - 2020 appearing in <https://www.businessoffashion.com>, <https://www.cntraveller.com>, <https://www.standard.co.uk> and <https://www.frivolette.com> which Mr Volpi submits show that the fashion/restaurant concept is increasingly common in the fashion industry. Mr Volpi lists from the articles the following examples:
 - Burberry’s all-day café ‘Thomas’s’ at its London flagship on Regent Street
 - Ralph Lauren’s ‘Ralph’s Coffee’ in New York
 - Club Monaco’s ‘Toby’s Estate Coffee’ in New York
 - Gucci’s bistro ‘Gucci Café’ in Shanghai
 - Prada’s ‘Bar Luce’ in Milan
 - Ralph Lauren restaurant ‘Ralph’s’ in Paris
 - DSquared2’s restaurant ‘Ceresio 7’ in Milan
 - Armani’s ‘Armani Ristorante’ in New York and Milan
 - Prada’s ‘Marchesi 1824’ in London
 - Tiffany’s ‘The Tiffany Blue Box Café’ in London
- (3) EV14 – copy downloaded pages from the ‘Hard Rock Café’ website on 10 March 2020 showing t-shirts for sale within the venue. There is a web page introducing ‘OUR NEW HERITAGE COLLECTION ... incorporating our original logo’ showing a branded t-shirt and two branded sweatshirts.
- (4) EV15 – undated copy photographs showing staff wearing uniforms with the legend ‘Replay for Blue Marlin Ibiza’ which Mr Volpi describes as being part

of a sponsorship agreement between Fashion Box and the ‘Blue Marlin’ restaurant, bar, and club in Ibiza.

- (5) EV 16 – undated photographs showing similar ‘Replay’ sponsorship arrangements with Bellvue Beach, Jesolo, Italy, El Nacional restaurant, Barcelona, Spain, Laganini bar, Croatia, Nammos, Mykonos.
- (6) EV17 – this confidential exhibit was said by Mr Volpi in his Second Witness Statement to comprise copies of marketing and sponsorship agreements. The exhibit was filed in Italian but at my request an English translation was supplied. EV17 was explained by Mr Volpi to show that the Blue Marlin arrangement lasted from July 2014 – December 2017. In fact the translated exhibit referred to another organisation and was expressed to run from June – September 2013. I have read the said translation of EV17 in full but say nothing further in view of Fashion Box’s request for confidentiality.

Consideration

24. Guided by the principles listed in *Consolidated Developments* the following points are *inter alia* relevant (in no particular order):

- 1) The fresh material all appears to me to have been available to put to the Hearing Officer at the proper time, and Fashion Box has not sought to argue to the contrary.
- 2) In my judgment, it was not an excuse to argue that Fashion Box thought that judicial notice could be taken by the Hearing Officer of Fashion Box’s assertion that it was: “*not uncommon for bars and hotels to often have retail outlets within the premises, or associated therewith*”. The onus was on Fashion Box to prove its cases and to do so at the correct time. As Lewison LJ observed in *Fage UK Limited v. Chobani UK Limited* [2014] EWCA Civ 5 at paragraph 114:

“The trial is not a dress rehearsal. It is the first and last night of the show.”
- 3) The additional evidence did not in the main do what Fashion Box claimed, that is, support Fashion Box’s assertion that it was: “*not uncommon for bars and hotels to often have retail outlets within the premises, or associated therewith*”. Instead, for the most part, it concerned a different scenario of some large international fashion houses/jewellers accommodating eateries in their flagships – at times trading under different names.
- 4) On the other hand, the material downloaded from the website of the *Hard Rock Café* did concern Fashion Box’s assertion, albeit after the relevant dates. However, as I understand it from the decision, the Hearing Officer accepted Fashion Box’s example of the *Hard Rock Café*. What she did not accept was that this was common practice.
- 5) The present proceedings involve an opposition and invalidation against a UKTM application and registration in which the relative grounds of

refusal/invalidity needed to be judged against the perceptions of the average consumer in the UK. Much of the new evidence sought to be introduced purported to relate to other jurisdictions.

- 6) Whilst the evidence was credible, its importance to the outcome of the proceedings was doubtful since in my view it tended to affirm rather than contradict the Hearing Officer's finding that Fashion Box's assertion was far from common practice.
25. For the above reasons, I decided not to allow the new evidence into the proceedings. I was unpersuaded that this was an appeal in which I should exercise my exceptional power, nor that my refusal to admit the requested evidence would *per se* lead to the multiplicity of proceedings Fashion Box suggested.

The appeal

26. Fashion Box accepted that the appeal was by way of review not rehearing and that I should be reluctant to interfere in the absence of error of principle on the part of the Hearing Officer ((*REEF Trade Mark* [2002] EWCA Civ 763, para. 28).
27. Fashion Box referred me to the summary of applicable principles set out by Mr Daniel Alexander QC sitting as the Appointed Person in *TALK FOR LEARNING Trade Mark*, BL O/017/17 at paragraph 52, which were reviewed more recently by Lord Hodge in *Actavis Group PTC v. Icos Corporation* [2019] UKSC 15, at paragraphs 78 – 81.
28. Lord Hodge in *Actavis* especially cautioned against interference in a value judgment made by the decision maker below:

“80. What is a question of principle in this context? An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. What is the nature of such an evaluative error? In this case we are not concerned with any challenge to the trial judge's conclusions of primary fact but with the correctness of the judge's evaluation of the facts which he has found, in which he weighs a number of different factors against each other. This evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible ...”

Ground 1 – similar goods and services

29. The first ground of appeal was that the Hearing Officer should have found that the goods covered in the earlier trade marks in Classes 18 and 25 were similar to at least the “*Bar services; restaurant, café and catering services; hotel and motel services; rental of temporary accommodation; preparation of food, meals and beverages for the consumption on or off the premises; provision of food and drink*” covered by the contested marks in Class 43.

30. I had difficulty in discerning any basis for this ground of appeal.
31. The complaint was said to be based on the Hearing Officer's rejection of Fashion Box's assertion that it was: "*not uncommon for bars and hotels to often have retail outlets within the premises, or associated therewith*", which led her wrongly to conclude that Fashion Box's goods were not complementary to GHF's services.
32. I think that this argument rests on a fallacy.
33. Goods and services are only complementary for the purposes of trade marks law where they are closely connected in the sense that one is indispensable or important for the other in such a way that consumers may think that the same undertaking is responsible for manufacturing those goods or for providing those services (Case T-249/11, *Sanco SA v. OHIM*, EU:T:2013:238, para. 36; and see the observations of Mr Geoffrey Hobbs QC sitting as the Appointed Person in *MISSBOO Trade Mark*, BL O/391/14, paras. 14 – 22, and *BURN Trade Mark*, BL O/074/19, pp. 12 – 13).
34. Irrespective of distribution channels, the Hearing Officer was not persuaded that the relevant public would view the manufacture of clothing, footwear, hats, and handbags as being indispensable or important to the provision of bar, restaurant, café, and accommodation services in the required sense, and neither do I.
35. I do not accept the first ground of appeal that the Hearing Officer erred in not finding that the respective goods and services (at least to the extent as specified in the Statement of grounds of appeal) were similar.

Ground 2 – reputation and goodwill

36. The second ground of appeal was that the Hearing Officer incorrectly assessed on the evidence the degree of reputation and goodwill enjoyed by Fashion Box in its REPLAY marks.
37. The Hearing Officer reviewed the evidence of Fashion Box (First Witness Statement of Eligio Volpi + Exhibits EV1 – EV10, dated 31 May 2019) at paragraphs 10 – 20 of her decision. She set out her findings taking the evidence as a whole, on reputation at paragraph 52, and on goodwill at paragraph 63, concluding in relation to the former "*a reasonable reputation for clothing*" and the latter "*a good degree of goodwill in relation to clothing, hats, footwear and handbags*".
38. Fashion Box did not suggest that the Hearing Officer misdescribed or omitted from her consideration any of the evidence. Further Fashion Box did not seek to criticise the Hearing Officer's findings other than her overall assessments thereon.
39. Accordingly, in contending that the Hearing Officer should have found "*an extraordinary reputation*" and "*extensive goodwill*" in the REPLAY marks and redirecting me to the evidence and written submissions before the Hearing Officer, it appears to me that Fashion Box was inviting the Appointed Person to re-evaluate the evidence and effectively re-hear the opposition/invalidation, which the case law

makes clear is not my role (reference the comments of the Appointed Person in *NICE LONDON Trade Mark*, BL O/338/20 and *TITANIC GIN Trade Mark*, BL O/050/21).

40. I have reviewed the papers on file including the evidence and written submissions before the Hearing Officer. I am satisfied that the Hearing Officer was entitled to make the findings and conclusions that she did.

Ground 3 – costs

41. The Hearing Officer made a costs award in favour of GLH for successfully defending the opposition and invalidation in the sum of £900.
42. Fashion Box contended that the Hearing Officer erred in including in her award, the sum of £500 for considering Fashion Box’s evidence. The reasons were said to be: (a) as the Hearing Officer noted: “*Only Fashion Box filed evidence. No hearing was requested and only Fashion Box filed written submissions in lieu*”; and (b) GLH filed no observations in reply to Fashion Box’s evidence.
43. GLH took issue with the grounds of refusal/invalidity of registration in Notices of defence and counterstatement, and lawfully called upon Fashion Box to prove genuine use of its earlier trade marks.
44. Fashion Box filed evidence in support of its earlier trade marks and its grounds of opposition/invalidation running to around 450 pages. GLH was under no obligation formally to respond to that evidence.
45. I have been shown no justifiable cause for interfering in the Hearing Officer’s discretionary costs award.

Conclusion

46. In the result, the appeal failed.
47. GLH, although the successful party, took no active part in the appeal.
48. I will order that in addition to the costs ordered below, Fashion Box do pay GLH costs in the sum of £100 in respect of reviewing the appeal and the request to admit further evidence. The total sum of £1,000 is to be paid by Fashion Box to GLH within 28 days of the date of this decision.

Professor Ruth Annand, 26 February 2021

D Young & Co LLP represented the Opponent/Applicant for invalidity/Appellant.

HGF Limited represented the Applicant/Proprietor/Respondent