

O-007-04

DECISION OF THE TRADE MARKS REGISTRY

TRADE MARKS ACT 1994

APPLICANT: MULLER & EILBRACHT B.V.

OPPOSITION N^o. 70738

AND

OPPONENT: FIN.ING S.R.L.

APPLICATION N^o. 761893

CLASSES 3, 14, 18 & 25

REPORT Collection

TRADE MARKS ACT 1994

BACKGROUND

1. The mark is REPORT Collection. Its date of designation in the UK is 13th June 2001; its international priority date is 13th June 2001. The mark was applied for by MULLER & EILBRACHT B.V. 45, Van Ruysdaellaan NL-2264 TK, Leidschendam, Netherlands, for the following goods:
 - Class 3: Cosmetics, soaps, perfumery, essential oils, deodorants for personal use, sun tanning preparations.
 - Class 14: Precious metals and their alloys and goods in precious metal or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; watches.
 - Class 18: 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.
 - Class 25:
2. Registration of the mark is opposed by FIN.ING S.r.l. under ss. 5(2)(b), 5(3) and 5(4)(a) of the Act on the basis of the earlier marks and an earlier right. The registrations and applications are listed in the Annex.
3. A Counterstatement was provided by the applicant denying the grounds asserted. Both parties ask for costs to be awarded in their favour.

HEARING

4. The hearing was heard over the video link in Newport and London. The applicant was represented by Ms. D MacFarland of Counsel, instructed by the Kings Patent Agency, while Mr. P Hiller of Marks & Clerk) appeared on behalf of the opponent.

EVIDENCE

The opponent's Evidence

5. This is presented in the form of two Witness Statements. The first is by Mr. Jonathan Judah, the Managing Director of Prelude Trading Limited, London W1, a clothing wholesaler, and the UK distributor of goods sold under the trade mark REPORTER – a role it has performed for the past 17 years. Mr. Judah states that he has held his current position throughout the whole of this time and consequently has first-hand knowledge of the trading history of the mark in the UK.

6. He states that the mark has been used by the Proprietor (and its predecessor-in-title) in the UK continuously since at least 1986 in relation to all categories of men's clothing and accessories. He believes that the mark was used in the United Kingdom prior to this date, but claims no first hand knowledge of this, nor has any corroborative evidence.
7. He states that in January 1986, a distribution agreement was set up between Confezioni F.G.S.p.A., the owner of the mark REPORTER prior to FIN.ING S.r.l. and his Company, so that goods sold under the REPORTER brand could be imported from Italy and sold in the United Kingdom. Apparently his company has distributed throughout the whole of the UK continuously and successfully since the distribution agreement was set up.
8. Mr. Judah explains that, in the early days, the brand was aligned with the likes of Hugo Boss and Giorgio Armani and it was promoted and sold accordingly through exclusive outlets like Harrods and Harvey Nichols. He states:

“At this time, in the late 1980s and early 1990s sales, were in the order of 12,000 (twelve thousand) units a year, corresponding to annual wholesale figures typically in excess of half a million pounds. However, the brand's image suffered in the early 1990s when Confezioni F.G. S.p.A went into liquidation. It was this that prompted the purchase of the mark REPORTER by FIN.ING S.r.l. This was in 1994. At this time, FIN.ING. S.r.l appointed a licensee, SANREMO MODA UOMO S.p.A, to manufacture goods under the REPORTER mark, and my Company continued to act as United Kingdom distributor of the goods.”
9. Mr. Judah adds that the total wholesale turnover 'in the said goods' sold within the UK under the mark REPORTER since the date of first use has amounted to not less than approximately £7,110,400.00. He provides what he calls approximate annual wholesale turnover in the UK:

During the year 1996: not less than approximately £274,971.00
During the year 1997: not less than approximately £221,611.00
During the year 1998: not less than approximately £278,215.00
During the year 1999: not less than approximately £125,543.00
During the year 2000: not less than approximately £184,758.00
10. The annual turnover figures are stated to correlate to the following numbers of items of clothing and clothing accessories:

During the year 1996: not less than approximately 5308 units
During the year 1997: not less than approximately 4527 units
During the year 1998: not less than approximately 5363 units
During the year 1999: not less than approximately 2511 units
During the year 2000: not less than approximately 3695 units
11. The mark has had, according to Mr. Judah, considerable exposure in well-known national (and international) magazines, with advertisements and advertising features in, for example, Vogue, GQ, FHM, Arena and Esquire.
12. Mr. Judah states that further advertisements in the form of posters have, apparently, been placed on bill boards in towns and cities throughout the UK.

13. Copies of advertisements in GQ and FHM magazines are attached in Exhibit JJ-1 (dated 2000/2001) and (October 2000) respectively, along with photographs of a belt and shoes bearing the REPORTER mark. It is pointed out that the FHM advertisement appears in a supplement entitled 'FHM Collections'.
14. Finally, Mr. Judah states that the 'applicant' (by this I assume he means opponent) has received enquiries about, and supplied customers with, goods advertised and sold under the Mark throughout all areas of the United Kingdom and gives examples of geographical spread:

North-west England	Manchester
Midlands	Birmingham, Oxford
East Anglia	Norwich
South-west England	Bath
London	Central London
Scotland	Glasgow
Wales	Cardiff
Northern Ireland	Belfast

15. Exhibit JJ-2 contains example invoices, all showing trade in men's clothing before the relevant date, via the UK distributor, in Guildford, Southgate, Leeds and Bolton. The quantity of trade indicated is not large.
16. The opponent's second Witness Statement is from Victor Ivan Caddy, a Registered Trade Mark Agent with Marks & Clerks. There is little evidence associated with this Statement. However, Mr. Caddy points out that the word 'collection' is commonly associated with the goods sold in Classes 3, 14, 18 and 25. As evidence of this he refers to Exhibit VIC-4 of his Statement, which contains a search of the Register showing some 885 marks containing the word 'collection'. He states that a disproportionate number of these (45%) are in classes 3,14, 18 and 25. He also refers to information from the internet that cites the applicant's mark as 'Reporter collection' (Exhibit VIC-5), with a small 'c'.
17. The rest of Mr. Caddy's Statement is argument and submission, inappropriate to the evidence stages of an action in the Registry.

The applicant's evidence

18. James Bertram King, a trade mark attorney acting for the applicant, provides a Witness Statement with five Exhibits. I will comment on each, if only to demonstrate why I will not be referring to this material again.

Exhibit JBK 1: Parallel proceedings in France (a translation is enclosed) came to the conclusion that ‘there exists no risk of confusion for the public’. I was encouraged by Ms. McFarland to treat this decision as of ‘persuasive’ value. I do not believe that I can. The differences in the perception of the words amongst francophones make that decision no measure of the reaction to the marks on behalf of anglophones. In fact, this case is a prime example of this (see paragraph 9 in the Decision section of the translation).

Exhibits JBK 2, 3 and 4: Again, the co-existence of the marks on the registers of Canada, Italy and the USA proves nothing: the approach to the law in those countries may be different. Without evidence, I have no way of knowing the manner and extent of use of the signs at issue in those countries, if at all.

Exhibit 4: As I point out below, that the opponent’s CTM applications (see the Annex) are subject to opposition is irrelevant to the decision I come to here.

Exhibit 5: Use of the applicant’s mark on websites in Canada and the Netherlands.

LAW

19. The relevant sections of the Act are:

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

(a) ... , or

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

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

5(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark,

in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

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

....,

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

DECISION

20. Initially, at least, I considered that all three grounds pleaded by the opponent, would require a consideration of the notoriety of their mark in this country: under s. 5(2)(b) an enhanced reputation can increase the protection enjoyed by a mark (see *Canon*, paragraph 17, cited below), under s. 5(3) a reputation is required such that a mark is known by ‘..a significant part of the public concerned by the products or services covered by that trade mark’ (paragraph 26 of the ECJ’s judgment in *Chevy*, cited below) and under s. 5(4) the goodwill under the name is the protectable earlier right. However, in the opponent’s skeleton argument, received the day before the hearing, the grounds under s. 5(3) and that under s. 5(4)(a) were withdrawn. At the beginning of the hearing, Mr. Hillier, for the opponent, stated that the ‘...circumstances of this case are rather unusual in that neither side seems to have provided a great deal in the way of evidence, and he did not refer to his client’s use of their mark in his submissions on the surviving s. 5(2)(b) ground at all. The discussion of s. 5(2)(b) was almost purely of law.
21. I find it rather unsatisfactory that the opponent should leave it so late in the day to thus amend his attack on the application, particularly in the case of s. 5(3), where it must have been apparent some time ago that the evidence was too weak to support a finding of the reputation required. This is a point I will return to in costs.
22. As a final point, before the substantive considerations of this matter, I note that two of the opponent’s earlier marks are at the application stage only (the CTMs). Any decision I base on these earlier rights will be provisional only, dependent on those applications maturing into registrations. I will return to the implications of this below, as it has the potential to complicate the outcome of this decision.

S. 5(2)(b)

23. In approaching s. 5(2)(b) I am mindful of the following decisions of the European Court of Justice (ECJ) on this provision (equivalent to Article 4(1)(b) of Directive 89/104/EEC) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV*, paragraph 23, 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; *Lloyd*, paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV*, paragraph 23;
- (d) 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; *Sabel BV*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and *vice versa*; *Canon*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel*, paragraph 26;
- (h) further, 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; *Marca Mode*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon*, paragraph 29.

Similarity of marks

24. The mark in suit is REPORT Collection. The cited earlier marks are:

REPORTER

and



25. It is clear that the opponent's best case lies with the first of these two marks: the second, on any reasonable assessment, is possessive of less similarity: it is dominated by the letters RJ and though these are an acronym for 'reporter jeans' (which might be argued to focus attention onto the word 'reporter') the overall appearance, as against the mark in suit, is one of greater difference than the REPORTER mark.
26. I think, in view of this, I will confine the significant part of my considerations to the latter; if the opponent is unable to establish a resemblance to REPORT Collection for this sign, they will not be able to do so for the other.
27. I note that three of the registrations for REPORTER (Nos. 1387022, 1387024 and 1387025) are in specific (but unremarkable) fonts, and contain some trivial stylisation in terms 'fuzziness' at the edges of the letters. I do not regard this as significant, and treat all the marks as word marks, without distinguishing additions. The marks to be compared are:

REPORTER

REPORT Collection

28. I was referred, in the course of argument, to the *Torremar Trade Mark* [2003] R.P.C. 4 case, and I think it is useful to quote the following passage, in relation to whether there are similarities (in terms of marks and goods) which might create a likelihood of confusion,

“21 When (as contemplated by s.5(2)(b) of the Act) the marks in issue are not identical, they need to be *distinctively similar* in order to be capable of inducing such a belief in the mind of the average consumer of the goods concerned.”

29. It follows from this that dissimilarities between marks will not influence the ability of the average consumer to distinguish them where they are *non-distinctively different*. I believe that the word 'collection', by and large, falls into this category. Even without evidence, I think I would be able to take 'judicial notice' of the fact that the word 'collection' is not uncommonly applied to clothing, particularly designer clothing (or those who might wish to suggest an elite image for less than 'up-market' products) in Class 25. There is also evidence to that effect (see Exhibit JJ-1 and the reference to 'FHM Collection', and also the reference to the applicant's mark as 'Reporter collection' (Exhibit VIC-5), with a small 'c'). And the applicant provides evidence of this as well. In Exhibit JBK 5, the following appears, downloaded from a Canadian website:

“The REPORT Menswear Collection is a reverse success story. Sold successfully around the world, *REPORT* is now on show for the first time in North America. Created by Quebec designer Rose Arabian and backed by Montreal based powerhouse Modextil, *REPORT* is sold in Amsterdam and London, as well as Edinburgh, New York, L.A., Singapore and Moscow! *REPORT* is a complete sportswear line for men, Mix-and-match knitwear, wovens, leathers, shirts and pants offer today's man-about-town a selection to match his corporate surroundings. Quality finishing for the 200 pieces in the Fall 2002 *collection*..”

The italics are mine. What this shows is the ease with which the 'Collection' element within the sign is likely to be dropped by English speakers. It also shows descriptive use of the word.

30. In terms of the other the goods specified with the application – that is, precious metals and their alloys and goods in precious metal or coated therewith, precious stones, jewelry, horological and chronometric instruments, watches, non-clothing items made of leather and imitations of leather and animal skins or hides, e.g. trunks and travelling bags, and also umbrellas, parasols and walking sticks; whips, harness and saddlery – there is no evidence to show that such items are so commonly associated with the word ‘collection’ in the way that clothing is. And the same must be said for the goods in Class 3. All the same, the word ‘collection’ means an accumulation or stock of items gathered together, and I believe it is likely to be taken as a descriptive element within the applicant’s mark. As a consequence, any effect it has as a difference between the latter and the opponent’s REPORTER is thus reduced and, I think, for clothing – where use of this word is not unexpected – pretty much non-existent.
31. Against this background, not forgetting the counsel of the ECJ to compare the whole of the marks, I am thus left with the word REPORT as against the word REPORTER. On this, Mr. Hillier stated:
- “The marks differ in that one consists of the word ‘reporter’, a word which has the meaning of one who reports as a matter of common knowledge. The word has a strong conceptual connection with reports and reporting. This is, we submit, obvious to any English-speaking native or indeed foreigner who speaks English. The other mark consists of ‘REPORT Collection’, two words, one of which, ‘REPORT’, is in upper case and, therefore, intended to be the most significant part of the mark.”
32. Mr. Caddy made a similar point in his evidence, that is:
- “Conceptually, a REPORT is an account or statement, or the verb to make or give account of, whilst a REPORTER is one who reports, or gives account of. Thus, both elements have very similar, interrelated meanings and, allowing for imperfect recollection, may well be conceptually confused by consumers.”
33. Ms. McFarland responded by referring me to the *Torremar* case, and the observation there that the link with the concept of a tower was etymological rather than real. Mr. Hillier dismissed the latter case, saying that ‘two tower logos were compared and found not to be particularly similar’. To be fair to Ms. McFarland, that was not actually what took place in that decision: words *were* compared. Nevertheless, we are dealing, here, with two common English words, and there must be some conceptual link between the REPORT and REPORTER. Ms. McFarland stated that I should not lose sight of the significance of the ‘Collection’ element in the applicant’s mark, as this would introduce, *inter alia*, a semantic difference to the latter, compared to REPORTER. I was not told what this was and, anyhow, I am not sure it does: I have found the word ‘Collection’ to be of limited significance within the mark, particularly with clothing. I have not forgotten it – the marks must be compared as a whole (*Sabel*, paragraph 23) – but it is not the distinctive and dominant component (*Sabel*, paragraph 23).
34. Similar comments result from a visual comparison of the marks. For clothing, the word more or less becomes invisible in the application. As has been pointed out, this effect is enhanced by presentation of the word ‘Collection’ in ‘sentence’ case.

35. In terms of an oral connection between them, though Mr. Caddy's comments in relation to pronunciation and 'Italian accents' are risible (paragraph 7.2 of his Witness Statement), I must admit to accepting a verbal similarity between the words. Of course, this is distinguished by the extra 'ER' syllable at the end of the opponent's mark, but there is the received wisdom, oft and only quoted by those to whom it might advantage, in *Tripcastroid* [1925] 42 RPC 264 at 278 where the importance of a prefix is stressed in pronunciation.
36. In summary, I believe that I must conclude that there is a fair degree of similarity between the signs at issue. The question remains as to whether it is a confusing similarity.

Distinctiveness of the opponent's mark

37. In consideration of the fact that though the opponent's mark is not invented, it is arbitrary for the goods at issue, and has I believe a significant inherent capacity to distinguish.

Similarity of goods

38. Mr. Hillier encouraged me to find that 'Cosmetics, soaps, perfumery, essential oils, deodorants for personal use, sun tanning preparations' in Class 3 were similar goods to that of the opponent, on the basis that:

"It is a matter of common experience that designers and manufacturers of expensive goods of the kind which we are involved with, clothing and luggage, often branch out into other spheres such as cosmetics."

39. He also referred to 'vanity cases' in Class 18, as a link to cosmetics, as they are used to store the same. I think this is tenuous stuff. On the basis of the criteria in *Canon*, where the ECJ stated:

"23. 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 end users and their method of use and whether they are in competition with each other or are complementary"

40. I am unable to find the goods in Class 3 to be similar to those as specified with the opponent's mark. Though one might observe that Ralph Lauren market clothing and cosmetics, there is no evidence that the opponent has a business of the same extent and nature: most clothing producers do not also sell cosmetics, even the better quality ones (to which the opponent clearly believes they belong).
41. Turning, now to the other goods at issue, these are:

Class 14: Precious metals and their alloys and goods in precious metal or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; watches.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and traveling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Clothing, footwear, headgear.

Class 25:

In Class 14, I find that 'Precious metals and their alloys and goods in precious metal or coated therewith, not included in other classes' to be different to the opponent's goods in Class 14, for their registration No. 1387022: 'Watches; jewellery; parts and fittings for all the aforesaid goods'. However, the latter are similar or identical to 'jewellery, precious stones; horological and chronometric instruments; watches'.

42. However, the CTM applications specify: 'Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments' which are identical to the applicant's goods.
43. As for the items in Class 18, I consider that 'Leather and imitations of leather, and goods made of these materials and not included in other classes' subsume the opponent's goods, and are thus identical to 'trunks and traveling bags' specified with REPORTER registration No. 1387024. The application also details the same items. However, I do not believe, applying the principles in *Canon* that '.. animal skins, hides; .. umbrellas, parasols and walking sticks; whips, harness and saddlery' are the same as 'trunks and traveling bags', or even similar.
44. Nevertheless, the specification for the CTM applications share complete identity with the applicant's specification.
45. Finally, for clothing in Class 25, the opponent's UK registration No. 952063 stipulates 'Articles of clothing for men and youths'. These are to be compared with 'Clothing, footwear, headgear'. Again, the application does not exclude the opponent's goods. I do not believe that the similarity I have identified, here, will allow me to propose an amendment to the application that excludes the overlap between the goods at issue. I think I must find that these items are the same or similar.
46. But for footwear, the applicant's goods are identical for the opponent's registration No. 2171627, and the two CTM's. Nonetheless, I find footwear to be similar to clothing. It is not unusual, these days, for shoes to be sold in garment stores, and within the 'garment' section in supermarkets.

The Average Consumer

47. Will be ordinary members of the public. We all buy the items listed in the specifications.

Likelihood of confusion

48. I do not believe that confusion will occur with the opponent's registrations 2711627 and 1731413. The, essentially device mark, retains too many differences with the application and, even where the goods are identical, I do not believe that confusion is likely. Certainly the word 'reporter' appears in the opponent's mark, but it is swamped by the presence of the other material in the sign and, even if observed, the semantic substance of the sign focuses on a certain type of clothing (jeans), tending to weaken the connection between REPORT and REPORTER.
49. However, I have found a 'fair degree of similarity' between REPORT and REPORTER. It seems to me that when the goods at issue are the same or closely similar, against the background of the inherent capacity to distinguish I have found in the earlier mark, and the imperfect recollection of the average consumer, that confusion is likely between the signs at issue.
50. This decision is complicated, however, by the reliance of the opponent on CTMs which are, as yet, unregistered and, possibly may not be (I was told at the hearing – and this was not denied by Mr. Hillier – that the CTM applications are opposed). In other words, where I fail to find for the opponent on the basis of their UK registrations, but do so for their CTM applications, this will make that part of my decision of provisional nature only. In the interests of certainty, I will begin with the UK registrations first, and only proceed to consider the opponent's CTMs if their case is improved by doing so. My eventual decision will be final in respect of the UK registrations, but provisional in respect of those elements that are decided by the CTMs.
51. Taking the goods one by one, the opposition fails in respect of the items in Class 3. There is not enough similarity between the marks at issue to overcome the differences I have identified with the opponent's goods.
52. In Class 14, I find that confusion is likely for 'jewellery, precious stones; horological and chronometric instruments; watches', for the opponent's earlier UK mark No. 1387022. I am unable to find the same for 'Precious metals and their alloys and goods in precious metal or coated therewith, not included in other classes', which I have determined to be dissimilar goods to 'Watches; jewellery..' etc.
53. However, the opponent's CTM 1731389 lists goods identical to that of the applicant, and for these I find the opposition has succeeded. This element of my decision is conditional on that CTM proceeding to registration.
54. An analogous result occurs for the Class 18 element of the application. I find that the opposition succeeds for 'Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and traveling bags', in relation to the UK registration No. 1387024, but fails for '..umbrellas, parasols and walking sticks; whips, harness and saddlery.'
55. Nevertheless, the opponent succeeds by virtue of its CTM for REPORTER.

56. Finally, in relation to clothing, I am reminded of the decision by the Appointed Person in the *React Trade Mark* [2000] R.P.C. 285 case. In this case, no confusion was found, largely because of the device elements within the application and conceptual differences between the marks. Nevertheless, the original decision of the Hearings Officer ([1999] R.P.C. 529), with which the Appointed Person agreed, stated that (page 535) ‘..a majority of the public rely *primarily* on visual means to identify the trade origin of clothing’. This seems to me to be the case here. I have found the applicant’s goods to be the same or similar to the opponent’s UK registrations in Class 25 (Nos. 952063 and 1387025).

CONCLUSION

57. As I have said, this decision has a provisional element to it. But it is final where based on the opponent’s UK registrations. The opposition to the applicant’s mark is thus successful in relation to the goods in Class 25, but fails in respect of the goods in Class 3:

‘Cosmetics, soaps, perfumery, essential oils, deodorants for personal use, sun tanning preparations.’

58. However, it should be noted that the opponent’s success for:

Class 14: ‘Precious metals and their alloys and goods in precious metal or coated therewith, not included in other classes’ and

Class 18: ‘..umbrellas, parasols and walking sticks; whips, harness and saddlery’

depends on their CTMs. This part of my decision is an interim one: if CTM No. 1731389 fails to proceed to registration, the above goods will be added to the following for which the application here is allowed to proceed, that is for the Class 3 goods. It is the responsibility of the parties, in particular opponent, to inform me of the fate of the CTM applications. I will then produce a final decision on this element of my judgment, where I will also determine the issue of costs (see below).

COSTS

59. As I have stated, owing to the provisional nature of elements of my decision, I will refrain from making a costs order at this stage. However, I want to make the following comments in relation to costs.
60. Ms. McFarland cited the withdrawal of the grounds under s. 5(4) and 5(3) the day before the hearing as something that should be factored into the costs assessment. I note from her skeleton argument that significant effort had been expended by the applicant in dealing with

61. these withdrawn grounds. I think Ms. MacFarland is right in this: in particular, the ground under s. 5(3) was never supportable, and should have been withdrawn at an early stage. I will make a costs order as part of my finalised decision when the fate of the CTMs is known.

Dated this 7th Day of January 2004.

**Dr W J Trott
Principal Hearing Officer
For the Registrar**

ANNEX

UK TRADE MARKS OWNED BY THE OPPONENT

Mark	Number	Date of application	Goods/services
REPORTER	952063	5 th Dec. 1969	Class 25: Articles of clothing for men and youths.
	1387022	8 th Jun. 1989	Class 14: Watches; jewellery; parts and fittings for all the aforesaid goods; all included in Class 14.
	1387024	8 th Jun. 1989	Class 18: Trunks, traveling bags, suitcases, wallets, purses, handbags, vanity cases, key-holders, card cases parts and fittings for all the aforesaid goods; all included in Class 18.
	1387025	8 th Jun. 1989	Class 25: Jackets, jerkins, dresses, shirts, blouses, coats, waistcoats, trousers, shorts, overcoats, raincoats, mantles, T-shirts, sweaters, pullovers, cardigans, scarves, neckties, shawls, hats, caps; articles of underclothing, shoes; all included in Class 25.
	2171627	9 th Sep. 1998	Class 25: Clothing, footwear, headgear.

CTMs OWNED BY THE OPPONENT

Mark	Number	Date of application	Goods/services
REPORTER	1731389	29 th Jun. 2000	<p>Class 9: Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for reproduction of sound or images; magnetic data-carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus, spectacles, spectacle frames, spectacle lenses, spectacle cases.</p> <p>Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.</p>
	1731413	29 th Jun. 2000	<p>Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.</p> <p>Class 24: Textiles and textile goods, not included in other classes; bed and table covers.</p> <p>Class 25: Clothing, headgear.</p>