

O-008-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2315914
BY CRAIGDON LIMITED
TO REGISTER THE TRADE MARK
ICE MOUNTAIN
IN CLASS 25**




**AND IN THE MATTER OF OPPOSITION THERETO
UNDER No. 91688
BY GILMAR S.P.A.**



BACKGROUND

1) On 15 November 2002, Craigdon Limited of 30 West High Street, Inverurie, Aberdeenshire, AB51 3QR applied under the Trade Marks Act 1994 for registration of the trade mark "ICE MOUNTAIN" in respect of "Clothing; footwear; headgear; outerclothing; underclothing; leisurewear; outdoorwear; sportswear; casualwear; skiwear; hosiery, socks, stockings and tights; belts and braces; gloves; all the aforesaid goods being technical goods for skiing, climbing and mountaineering" in Class 25.

2) On 14 May 2003, Gilmar S.p.A. of Via Malpasso 723/725, 47048, S.Giovanni in Marignano, Rimini, Italy filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following earlier trade marks:

Mark	Number	Effective Date	Class	Specification
 <p>Registration of this mark shall give no right to the exclusive use of the letter "I" and a device of a motorcyclist.</p>	1393219	28.07.89	25	Articles of outer and inner clothing, footwear, headgear; all for men, women and children, and all included in Class 25.
	1175324	20.05.82	25	Articles of clothing; but not including footwear other than woven or knitted footwear.
 <p>Registration of this mark shall give no right to the exclusive use, separately, of the words "Sport" and "Ice".</p>	1392841	25.07.89	25	Rainwear; coats, sports coats; suits; skirts; dresses; shirts, sports shirts; sweaters; leisure wear; swimwear; tennis wear; ski wear; tracksuits; underwear; sleep wear; socks and stockings; head wear; neck wear; footwear; all included in Class 25.

 <p>Registration of this mark shall give no right to the exclusive use of the words "Sport-Ice".</p>	1291773	14.11.86	25	Articles of clothing and footwear, all included in Class 25 for men and for women.
	1291768	13.06.86	25	Jeans; all for men and for women; all included in Class 25.

- b) The mark in suit is similar to the opponent's marks as are the goods. All of the marks contain the word ICE as a distinctive element of the mark. Three of the marks contain the word ICEBERG. Conceptually icebergs and ice mountains are very similar. The mark in suit offends against Sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement denying the grounds of opposition.

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 13 October 2005 when the opponent was represented by Ms Szell of Messrs Lloyd Wise. The applicant chose not to be represented but did supply written submissions which I will refer to as and when relevant.

OPPONENT'S EVIDENCE

5) The opponent filed a witness statement, dated 22 October 2004, by Silvano Gerani the President of the opponent company a position he has held since 1980. He states that his company began using the ICEBERG trade mark in the UK in relation to clothing in 1982. He provides the following turnover and marketing expenditure for the UK, which are said to relate to the ICEBERG line:

Year	Wear Turnover Euros €	Accessories Turnover Euros €	Marketing Euros €
1998	5,251,000	118,000	263,000
1999	6,121,000	120,000	105,000
2000	8,414,000	245,000	412,000
2001	5,328,000	232,000	607,000
2002	6,494,000	223,000	352,000
2003	6,098,000	233,000	390,000

6) Mr Gerani states that his company also uses a range of marks containing the word ICE, in conjunction with the ICEBERG mark. These are said to include ICE JEANS, ICE J and ICE B. He provides the following turnover and marketing figures for the UK relating to the use of the mark ICE JEANS ICEBERG:

Year	Wear Turnover Euros €	Accessories Turnover Euros €	Marketing Euros €
1998	4,137,000	75,000	51,000
1999	4,569,000	74,000	60,000
2000	6,788,000	173,000	226,000
2001	4,042,000	116,000	292,000
2002	4,382,000	99,000	159,000
2003	4,588,000	109,000	79,000

7) Mr Gerani provides a number of exhibits which are detailed below:

- Exhibit 1: copies of photographs of examples of the products sold under the ICEBERG mark. These include coats, T-shirts, bags, belts, trousers blouses and hats. Most of which have the word “ICEBERG” printed across them, but not encapsulated by a device as in trade mark 1175324. None of which are dated.
- Exhibit 2: Copies of photographs of examples of the products sold under the mark ICEBERG combined with other ICE marks. These include coats, jackets, blouses, T-shirts, trousers, jumpers, skirts, boots, shoes, hats, scarves, bags, gloves, and hats. Most of the pictures of clothes show use of the mark “ICE J” or “ICE JEANS” only the boots and shoes show use of “ICEBERG” but not encapsulated by a device as in trade mark 1175324. None of the photographs are dated.
- Exhibit 3: Samples of catalogues used to promote ICEBERG goods and goods sold under other ICE marks within the UK. A number of the publications are dated after the relevant date, others are not dated. Of those that are before the relevant date they show pictures of a range of clothing including coats under the word ICEBERG but not encapsulated by a device as in trade mark 1175324.
- Exhibit 4: Examples of billboard advertisements displayed in London. These show the word ICEBERG (but not encapsulated by a device as in trade mark 1175324) with models wearing a range of casual clothing including jackets and coats. Although not individually dated these would appear to have been part of a campaign in 1998.
- Exhibit 5: Examples of advertisements together with the front page of the magazine in which the advertisement appeared. On a number the date is not clear. Those clearly dated prior to the relevant date show reference to the words “ICEBERG”, “ICE JEANS ICEBERG”, “ICEBERG JEANS” and “JEANS ICEBERG” in plain type alongside photographs of models in various

items of clothing. None of the “ICEBERG” marks are encapsulated by a device as in trade mark 1175324.

- Exhibit 6: Examples of editorial advertising in which the opponent company is mentioned by name and/or Iceberg Jeans. Again none of the instances of use are encapsulated by a device as in trade mark 1175324.

8) Mr Gerani claims that as a result of this activity his company has a strong reputation and goodwill in the mark ICEBERG and marks containing the term ICE in the UK.

APPLICANT’S EVIDENCE

9) The applicant filed a witness statement, dated 18 February 2005, by Gordon Lee the Managing Director of the applicant company a position he has held since 2000 although he has worked for the company since 1989. Mr Lee states that he has worked in the clothing industry for 35 years. As a result of his experience he states that he is aware of the major manufacturers of technical clothing for sports and is also aware of the design, materials and properties of such clothing.

10) He states that his company was formed to manufacture and market a quality outdoor brand of goods and “has never been involved in, or aimed their goods at, the high fashion industry marketplace or the general High Street fashion trade or general clothing marketplace”. He states that the goods his company produces are technical in nature and have become known by outdoor sports enthusiasts for their quality products. He states that his company first used the mark ICE MOUNTAIN in the UK in December 2000. He states that in November 2002 searches of the UK Trade Mark Register were made and a number of marks incorporating the words ICE and MOUNTAIN in relation to goods in Class 25 were found. However, none incorporated both. At exhibit GL1 he provides printouts of the marks found. Mr Lee states that as part of the negotiations with the opponent his company amended their specification to its current format.

11) Mr Lee gives his opinion on the similarity of the two parties marks, which I have not detailed here as they do not assist my decision. He states that the terms “Iceberg” and “Ice mountain” have different meanings. The first term, he claims, relates to a large piece of ice floating in the sea which can be the habitat for polar bears, as indicated in some of the opponent’s trade marks. He claims that the second term refers to a mountain made up of rock and earth which is covered by snow and which mountaineers scale and skiers and snowboarders slide down. He states that these activities cannot be undertaken on an iceberg as its edges are at extreme angles and fall directly into the sea.

12) At exhibit GL2 he provides copies of prints showing the mark in suit used on clothing. These prints show two marks which include a device element and are different to the mark in suit. At exhibit GL3 he provides copies of swing tags used which again are different to the mark in suit. Mr Lee states that the items manufactured and sold under these labels are technical in that many are made of a breathable fabric and others will protect the wearer against low temperatures, rain,

sleet and snow. The products are not designed as fashion products but have specific applications which provide protection under various conditions.

13) Mr Lee states that his company's products are sold via his company's shops or by mail order/online from his company. His company sells other brands but the shop deals only with outdoor sporting goods. He contrasts this to the opponent's goods which he claims are "aimed at the trendy fashion marketplace, and above all to the high fashion end of the marketplace".

14) Mr Lee also makes various comments regarding the opponent's evidence which do not assist my decision.

OPPONENT'S EVIDENCE IN REPLY

15) The opponent filed two witness statements in reply. The first dated 18 May 2005 is by Mr Gerani who provided a statement earlier in these proceedings. He states that the average unit price in the UK of the goods under the trade marks ICE JEANS and ICEBERG are as follows:

Year	ICE (JEANS) €		ICEBERG €	
	Clothing	Accessories	Clothing	Accessories
1998	45	23	108	54
1999	44	20	112	43
2000	51	21	98	56
2001	53	22	107	48
2002	54	27	107	60
2003	54	30	100	49

16) The second witness statement, dated 24 May 2005 is by Kasturi Lahiri employed as a technical assistant by the opponent's trade mark attorney. She states that she carried out a search on the internet using the "Google" search engine. At exhibit KL1 she provides excerpts from the National Geographic Adventure Magazine (July 2002 edition) and also the National Geographic Explorer (student/classroom magazine) which she claims shows that the term "ice mountain" would be understood as referring to "icebergs".

17) At exhibit KL2 she provides printouts from a glossary of terms used in recent issues of National Geographic Explorer where "iceberg" is described as a "floating mountain of ice".

18) Ms Lahiri also states that the applicant's own evidence shows that the applicant sells other brands such as QUIKSILVER and at exhibit KL3 she provides a printout that shows that this brand (Quicksilver) is not confined to use on technical mountaineering products but appear to be used on similar goods to those sold by the opponent.

19) At exhibit KL4 Ms Lahiri provides details of a company Craigdon Business Gifts which has the same address as the applicant and offers for sale a range of clothing including sportswear, corporate wear, leisure wear and school uniforms.

20) That concludes my review of the evidence. I now turn to the decision.

DECISION

21) I will first consider the ground of opposition 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.”

22) 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,”

23) The opponent’s five trade marks have effective dates between 20 May 1982 and 28 July 1989 and all are plainly “earlier trade marks”.

24) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998] R.P.C. 199, *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 Bv v Puma AG* ;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG*, 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 Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG*;

(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 v Puma AG*;

(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 Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*;

(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 Bv v Puma AG*;

(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 Bv v Puma AG*;

(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 CV v Adidas AG*;

(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 Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

25) In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's mark on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

26) The opponent's marks are inherently distinctive when used on the goods for which they are registered. However, I must also consider the use of the marks and whether the marks have acquired distinctiveness as a result of this use. The opponent has provided sales figures for goods sold in the UK under the trade marks ICEBERG and ICE JEANS ICEBERG. The assumption is that these goods are items of clothing but the evidence refers to the "Iceberg line" which could include a range of other goods. I will proceed on the assumption that the figures provided relate only to clothing and shoes as shown in the various exhibits. However, these turnover figures relate to both the registered trade marks and a number of unregistered trade marks. None of the exhibits provided show use of four of the trade marks (1393219, 1392841, 1291773 & 1291768). From the exhibits provided the word ICEBERG is not usually encapsulated in a device mark such as in trade mark 1175324, although I am willing to accept that this is use of the registered trade mark 1175324. The average annual turnover on clothing under the term ICEBERG is claimed to be approximately

£4 million. It is also claimed that the opponent has an average annual turnover of approximately £3 million under the mark ICE JEANS ICEBERG. However, the opponent provided no evidence of market share or the extent of the market for clothing. The various exhibits provided are in the main not dated. Those that are dated prior to the relevant date show use of the word ICEBERG (without the device element as shown in trade mark registration 1175324), ICE JEANS ICEBERG, ICEBERG JEANS and JEANS ICEBERG on general items of clothing. Therefore, although I accept that the opponent has shown some goodwill in the mark, I do not accept that the opponent's trade mark has acquired a reputation in relation to clothing under its ICEBERG or ICE JEANS ICEBERG marks such that it can benefit from an enhanced level of protection.

27) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was recently considered by David Kitchin Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

28) I now turn to the comparison of the specifications of the two parties and take into account the factors referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

“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.”


29) At the hearing Ms Szell stated that her strongest case was in relation to the opponent's mark 1175324 and I agree with her on this. For ease of reference the specifications of the two parties are reproduced below:

Opponent's specifications	Applicant's specification
Articles of clothing; but not including footwear other than woven or knitted footwear.	Clothing; footwear; headgear; outerclothing; underclothing; leisurewear; outdoorwear; sportswear; casualwear; skiwear; hosiery, socks, stockings and tights; belts and braces; gloves; all the aforesaid goods being technical goods for skiing, climbing and mountaineering

30) Clearly, the opponent's specification encompasses the applicant's specification with the exception of footwear (other than knitted or woven footwear). The applicant had contended that its specification restriction of "all the aforesaid goods being technical goods for skiing, climbing and mountaineering" creates clear blue water between its goods and the fashion items that the opponent produces. Whilst at the moment the opponent clearly is engaged in producing fashion items for the high street rather than technical clothing their specification would allow them to produce such clothing if they wished. The specifications of the two parties must be regarded as identical for clothing and similar with regard to the footwear and headgear which form part of the applicant's specification.

31) In referring to the average consumer in this decision I am referring to the general UK public as clothing is purchased by virtually everyone. As stated above the specifications are, in my view, identical or quite similar. The applicant's specification has a restriction referring to "technical clothing" for particular sports. However, the term "casualwear" appears in the specification and to my mind this undermines the restriction and means that the more general view should be applied that the specification covers clothing in general. This provides the opponent with a stronger case.

32) I now turn to consider the two marks which for ease of reference are:

Opponent's mark	Applicant's mark
	ICE MOUNTAIN

33) Clearly, the first three letters which form the word ICE are common to both marks. Thereafter, they are visually and aurally different. The opponent claims that there is a conceptual similarity between the marks. It provides exhibits from National Geographic that the term "ice mountain" has been used to describe icebergs. I accept that this magazine is sold in the UK although it is of American origin. However, the fact that an iceberg can be described as "a mountain of ice" or even "an ice mountain" does not necessarily mean that the average consumer would bring such an image to mind. To my mind the opponent's mark would bring to the mind of the average consumer a very large piece of ice floating in the sea, the majority of which is hidden beneath the surface of the water. In contrast the applicant's mark would, in my opinion, conjure up to the average consumer an image of a peak within a range of mountains which is covered in ice. The applicant's mark does not have any

connection with the sea, but would be firmly linked in the average consumers mind with being part of a land mass usually remote from the coast.

34) Examples of use of the applicant's mark have been provided. These show that the actual use differs from the mark now sought to be registered. However, I will consider the use shown and compare against the opponent's mark to determine whether the opponent's position under Section 5(2)(b) is stronger. For ease of reference the applicant has used its mark as follows:



35) The issue of normal and fair use was dealt with by Geoffrey Hobbs QC, sitting as the Appointed Person, in *Croom's Trade Mark Application* [2005] RPC 2, where he stated:

“31 When assessing the objections to registration in the present case, it is necessary to assume normal and fair use of the marks for which registered trade mark protection has been claimed. The context and manner in which the marks have actually been used by the applicant and the opponent in relation to goods of the kind specified may be treated as illustrative (not definitive) of the normal and fair use that must be taken into account. However, the protection claimed by the opponent independently of registration (*i.e.* under s.5(4)(a) of the Act) must relate to the actual and anticipated use of the rival marks.”

36) The opponent contends that the use shown places more emphasis on the initial word in the mark “ICE”. I do not accept this contention. The fact that the word “ICE” is above the word “Mountain” does not give it greater status than when the two words are printed alongside each other. The size of the print in the example shown is the same. The twin peaks are typical of a land based mountain range, whereas an iceberg is usually thought of as a single peak floating in the sea. Ms Szell commented that some of the opponent's marks include images of icebergs with numerous points and that there was therefore a conceptual similarity. I note however that the opponent's marks include a depiction of the sea and in two also have a polar bear lounging on them. I do not believe that the actual use made of the mark increases the conceptual similarity by a significant degree.

37) In considering the issues I also take into account the views of Mr S Thorley sitting as the Appointed Person in the *REACT* case [2000] RPC 285 where he said:

“[*Counsel*] ...drew my attention to the fact that in relation to clothing of the type for which the mark is to be registered, anybody using the mark aurally would be informed to some extent of the nature of the goods they were proposing to purchase; they will therefore know of a mark; and they will know what they want. I think there is force in this in the context of purchasing clothes. The Hearing Officer was prepared of his own experience to hold that the initial selection of goods would be made by eye, and I believe this is correct. I must therefore, in taking into account the likelihood of aural confusion, bear in mind the fact that the primary use of the trade marks in the purchasing of clothes is a visual act.”

38) I also note the comments of Mr Hobbs Q.C. sitting as the Appointed Person in *Raleigh International* (BL O/253/00) where he stated:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and services cannot eliminate differences between marks. So the purpose of the assessment under Section 5(2) must be to determine the net effect of the given similarities and differences.”

39) In summary having regard to visual, aural and conceptual considerations, the concept of imperfect recollection, the actual use made of the mark in suit and making due allowance for the fact that there is, for the most part identity of goods, I have come to the view that there is no likelihood of confusion. I have also considered whether the public might nevertheless have reason to think that goods offered under the marks came from the same or economically linked undertakings. But again I have come to the view that this is unlikely to be the case. Accordingly the opposition fails. In failing in its strongest case it is clear that the opponent fails in relation to all its registered trade marks.

40) I now turn to the other ground of opposition which is under Section 5(4)(a) of the Trade Marks Act 1994 which reads:

“5. (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.”

41) In deciding whether the mark in question “ICE MOUNTAIN” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in *Halsbury's Laws of England* (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnik BV v. J. Townend & Sons (Hull) Ltd* [1979] A.C. 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of “passing off”, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.””

42) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced – as per the comments in *Cadbury Schweppes Pty Limited v. The Pub Squash Co Pty Ltd* [1981] RPC 429. In the counterstatement the applicant's claim to have first used their ICE MOUNTAIN mark continuously since December 2000.

43) With these considerations in mind I turn to assess the evidence filed on behalf of the parties in the present proceedings as set out earlier in this decision.

44) In *South Cone Inc. v. Jack Bessant, Dominic Greensmith, Kenwyn House, Gary Stringer (a partnership)* [2002] RPC 19 Pumrey J. in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd’s Application (OVAX)* [1946] 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus, the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

45) This cannot be interpreted in a prescriptive fashion. There will be occasions when the evidence does not fall within the above parameters but still establishes goodwill for passing off purposes - see the decision of Professor Annand, sitting as the Appointed Person, in *Loaded* (BL O/191/02).

46) The opponent accepted that it had shown no evidence of use of four of the trade marks referred to in its statement of grounds (1393219, 1392841, 1291773 & 1291768). The evidence of use filed all related to use of the marks “ICEBERG” and “ICE JEANS ICEBERG” but not with the device mark as shown in trade mark registration 1175324 which was referred to in the statement of grounds. At the hearing the opponent sought to widen the scope to refer to use of various “ICE” marks such as “ICE J”. To my mind the statement of grounds was clear in that the opponent was relying upon its five registered trade marks which it mentioned specifically. In my view the opponent can only rely upon its mark 1175324 under this ground. I have accepted that although the use shown does not include the device mark as registered the use of the word “ICEBERG” *simpliciter*, can be accepted as use of the mark registered. I have already found that the opponent has goodwill in this trade mark but concluded that this was not enough to result in a likelihood of confusion under Section 5(2). It seems to me that the necessary misrepresentation required by the tort of passing off would not occur here, either. The ground of opposition under Section 5(4)(a) therefore fails.

47) In case I am wrong regarding the pleadings I shall consider the position under Section 5(4)(a) with regard to the opponent’s “ICE” mark, which incorporates use of marks such as, *inter alia*, “ICE J” and “ICE JEANS ICEBERG”. I accept that the opponent has shown goodwill under these marks. Clearly, the mark “ICE” forms the initial part of the applicant’s mark so there is a degree of visual and aural similarity just as in the ICEBERG mark. Conceptually, there is a tenuous link in that an ice mountain is a land or rock mass covered in ice but the two marks overall create a very different mental image. Most people would visualise ICE as either an ice cube or a covering of ice on an object. There are those who might see the mark as referring to “In-Car Entertainment” or even see it as the slang term for the drug Methamphetamine. However, considering the issue overall I do not believe that there

is likely to be any misrepresentation. The opposition fails under Section 5(4)(a) in relation to the opponent's use of the mark "ICE".

48) As the applicant has been successful it is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £1000. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of January 2006

**George W Salthouse
For the Registrar,
the Comptroller-General**