

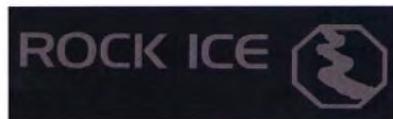
O-038-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOs: 2463222, 2463223A and 2463223B
BY HIGHLAND WOOLLEN COMPANY LTD TO REGISTER THE TRADE
MARKS**



AND (AS A SERIES OF TWO TRADE MARKS):



AND

ROCK ICE

IN CLASS 25

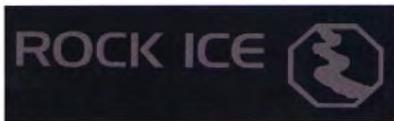
**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER NOs: 96661, 96920 AND 96673
BY GILMAR S.P.A.**

TRADE MARKS ACT 1994

**IN THE MATTER OF application nos: 2463222, 2463223A and 2463223B
by Highland Woollen Company Ltd to register the trade marks:**



and, as a series of two trade marks:



and

ROCK ICE

**IN THE MATTER OF consolidated oppositions thereto under Nos: 96661,
96920 and 96673
by Gilmar S.p.A.**

BACKGROUND

1) On 6th August 2007, Highland Woollen Company Ltd, 29-31 High Street, Fort William PH33 6DH ("Highland") applied under the Trade Marks Act 1994 ("the Act") for registration of the trade marks:

(a) Application 2463222



(b) Application 2463223A



(c) Application 2463223B

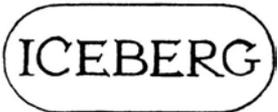
ROCK ICE

2) All three applications are in respect of the following goods:

Class 25: Clothing; headgear; footwear; accessories (clothing); gloves; scarves; mittens; waterproof clothing and outdoor clothing.

3) The marks were published on 4th January 2008, 25th January 2008 and 11th January 2008 respectively. On 20th March 2008 and 22nd April 2008, Gilmar S.p.A. ("Gilmar") of Via Malpasso 723/725, 47048, Italy filed notices of opposition to the applications. These were duly consolidated. The grounds of opposition are summarised as follows, namely:

- a) registration of the applications would offend under Section 5(2) (b) of the Act. Gilmar claims that Highland's trade marks are similar to its earlier marks and are for identical or similar goods. Gilmar relies upon the following earlier marks:

Marks, filing and registration dates	Goods and services covered (or goods and services relied upon if narrower)	Goods and services being opposed
<p>1175324 Filing date: 20th May 1982</p>  <p>Date of registration: 22nd February 1984</p>	<p>Class 25: <i>Articles of clothing; but not including footwear other than woven or knitted footwear.</i></p>	<p>All of the Class 25 goods.</p>
<p>M832107 ICE B 27th May 2004</p> <p>Date of protection: None recorded</p>	<p>Class 18: <i>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.</i></p> <p>Class 25: <i>Clothing, footwear, headgear.</i></p>	<p>All of the Class 25 goods</p>

b) Gilmar also claims that it has used the mark “ICE” and other marks starting with the word “ICE” in the UK in relation to a wide range of clothing and fashion accessories since 2000. On the basis of this use, Gilmar claims that registration of Highland’s marks would be contrary to Section 5(4) (a) in respect of all of the goods in class 25.

4) Highland filed counterstatements on 27th June 2008 denying Gilmar’s claims and requesting Gilmar to provide proof of use in respect of all goods and services for which the earlier mark 1175324 was registered.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither party requested to be heard but both filed written submissions. After careful consideration of the papers I give the following decision.

Opponent's Evidence

6) Gilmar's evidence is in the form of a witness statement dated 5th November 2008 by Mr Massimo Marani, who is Chief Financial Officer of Gilmar and has been since 1994. Exhibit MM1 comprises a witness statement and accompanying exhibits by Mr Silvano Gerani, President of Gilmar. Mr Gerani's witness statement dated 5th September 2005 was prepared and filed in respect of an earlier opposition against application 2358107 PINK ICE, published as BL O-257-06 ("the PINK ICE opposition"). It details the use made of ICEBERG and other ICE marks up to 2005. This was summarised by the Hearing Officer at that time. That summary is provided as an annex to this decision and I adopt it insofar as it is relevant to the current proceedings. It is worth mentioning that this evidence has been recycled in several cases to my knowledge and invariably criticised for its poor quality, eg lack of clarity and pagination, most recently before the Appointed Person in Case BL O-284-09 (see para 7).

7) Mr Marani says that Mr Gerani's statement in September 2005 only provided annual turnover figures for the marks ICEBERG and ICE JEANS, although it did give 'information' on 'other marks' containing the word "ICE", such as ICE ICE ICEBERG. However, those figures and information naturally only go up to 2005. Mr Marani says that since then, sale of goods under the ICEBERG and ICE JEANS marks have continued alongside other "ICE" marks, such as ICE ICE ICEBERG, ICE J and ICE B. The annual turnover (in Euros) for the years 2006 and 2007 in the UK for goods sold under the ICEBERG mark and the various other "ICE" lines (collectively) is provided as follows:

Lines	2006 (Euros)	2007 (Euros)
Iceberg		
Wear	267, 869.00	185, 514.00
Accessories	25, 294.00	19, 354.00
Total	293, 163.00	204, 868.00
ICE Lines		
Wear	981, 197.00	473, 688.00
Accessories	77, 923.00	40, 213.00
Total	1,059,120.00	513, 901.00

Applicant's Evidence

8) This takes the form of a witness statement dated 10th April 2009 by Asif Mohammed Rasul, who is Managing Director of Highland and has been since its date of incorporation on 12th August 2002. Whilst Highland are the firm in whose name the applications are made, he says that the marks applied for are actually used by: Country Outlet Ltd, TF Trading Ltd and The Firm of Top Fashion. Mr

Rasul is Managing Director of the first two limited liability companies and Managing Partner of the third, which is a Partnership under Scottish law.

9) Mr Rasul says his companies run 18 clothing retail outlets throughout the UK. Exhibit AMR1 shows details of where in the UK those outlets are based. These locations are predominantly in Scotland with, eg 6 locations in the Highlands and 4 in Perthshire. In England there are just three locations and all are National Parks: The Lake District, Yorkshire Dales and Peak District.

10) Mr Rasul says he has been using the trade marks through his companies since 1996. The ROCK ICE and ICE CROSS marks have been used on a variety of clothing accessories, gloves, scarves, waterproof and outdoor clothing. ROCK ICE has also been used on footwear. Approximate turnover over the past ten years is given as follows:

Year	£Amount
1996	361,646.00
1997	374,792.00
1998	375,819.00
1999	439,630.00
2000	550,221.00
2001	794,609.00
2002	1,059,799.00
2003	1,440,334.00
2004	1,326,121.00
2005	1,952,848.00
2006	1,705,892.00
2007	1,875,076.00
2008	2,010,220.00

11) Promotion and advertising figures in relation to the marks are given as averaging around £70,000 - £90,000 per annum. Advertising is by way of posters, newspaper articles and over the radio. Exhibit AMR2 comprises copies of invoices from radio stations, eg REAL RADIO, CAPITAL RADIO, RADIO CLYDE and RADIO TAY in respect of advertising.

12) Exhibit AMR3 comprises various posters advertising clothing under the ROCK ICE and ICE CROSS marks. According to Mr Rasul, some of the posters date from around 1997 (showing use of both the ROCK ICE and ICE CROSS marks), and some are said by Mr Rasul to be still in use today. The dates are not evident from the posters themselves. The posters depict a variety of outdoor clothing for use in outdoor pursuits such as walking, skiing and cycling.

13) Mr Rasul calculates that his marks were seen by a total of 9,075,000 customers in 2007. This is based on detector (an in-store device) figures,

designed to calculate footfall in his outlets. There were 5,550,000 visits to outlets in Scotland and 3,525,000 to outlets in England.

14) Exhibit AMR4 is a collection of invoices, the earliest date being 11th April 2000, from suppliers based in China for shipments of clothing to Mr Rasul's firms. The marks ROCK ICE and ICE CROSS are shown prominently on some of these, eg:

invoice for mens' jackets dated 11th April 2000 from Quanzhou Westex Garments Co Ltd;

invoice (from the same company) dated 11th April 2002 for mens' and womens' jackets; and

invoice (again from the same company) dated 11th April 2003 for t-shirts;

but not all the invoices show the marks. Where the marks are evident they are shown within a plain diamond shape border. The invoices show sales up to March 2007.

15) Exhibit AMR5 comprises stock lists for the years 2003- 2007, showing clothing items (including footwear) and accessories such as, eg rucksacks, stocked under the marks ROCK ICE and ICE CROSS. The lists detail a wide variety of items, including for children, sold under a wide variety of secondary marks such as, eg "COLLEGE", "TERMTIME", "STORMBREAK" and so forth. Exhibit AMR6 comprises a selection of swing ticket labels showing the marks as applied for. Mr Rasul then details the unit sales of clothing sold under the marks, ranging from 105,979.00 units in 2002 through to 264,502.00 in 2008. Exhibit AMR7 comprises photographs (some in close-up) of items of clothing, showing the marks in use prominently on, or in relation to, clothing sold in Mr Rasul's shops. The clothing includes footwear such as walking boots, mens' trousers, t-shirts and fleeces. Mr Rasul says that some of the items span the last five years and all are available from all his outlets.

16) He concludes his evidence by saying that despite the long-standing and high profile use of his marks, ICE CROSS and ROCK ICE, he has not known or been advised of any instances of confusion with Gilmar's trade marks. The remainder of his evidence details searches he has made, and knowledge he has, in respect of other clothing brands which incorporate the word "ICE".

Opponent's Evidence in reply

17) This takes the form of a witness statement dated 14th July 2009 by Sarah Kate Széll, a partner with Venner Shipley LLP, representatives of Gilmar. As reply evidence, this mostly constitutes critique of Mr Rasul's evidence which I shall briefly summarise, and also sets out in detail the action taken by Gilmar

against many of the “ICE” marks located by Mr Rasul in his searches. Ms Széll says, in summary, that the evidence of advertising produced by Mr Rasul only relates to the radio and does not in any event clearly show that the marks ROCK ICE and ICE CROSS are the subject of the advertising. She notes that the turnover figures have no supporting documentation and may not wholly be attributable to the marks ROCK ICE and ICE CROSS. Similarly, the invoices do not all show the marks and are not evidence of the date on which the goods arrived in the UK or were put on sale in the UK. The stock lists moreover do not demonstrate that the goods actually put on sale bore the relevant marks, given in particular that most items identify secondary brands.

DECISION

Proof of use

18) The Trade Marks (Proof of Use, etc) Regulations 2004 apply in respect to the Section 5(2) (b) grounds of this case. The provision reads as follows:

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

(1) This section applies where –

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

...

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

19) The requirements for “genuine use” have been set out by the European Court of Justice (“ECJ”) in its judgment in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 (“*Ansul*”) and in its reasoned Order in Case C-259/02, *La Mer Technology Inc. v Laboratoires Goemar S.A.* [2005] ETMR 114 (“*La Mer*”).

20) In *Ansul*, the ECJ held as follows:

“35. ... ‘Genuine use’ therefore means actual use of the mark....

36. ‘Genuine use’ must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user...

37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of its enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns...

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant

to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

21) In *La Mer* the ECJ also held:

21. ... it is clear from paragraph [39] of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case by case assessment which it is for the national court to carry out....

...

25. In those circumstances it is not possible to determine *a priori*, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down.

22) Gilmar relies on just one earlier registered right, the ICEBERG mark, which plainly qualifies as an earlier mark as defined by Section 6 of the Act. This mark completed its registration procedure on a date (22nd February 1984) that predates by more than five years the publication of Highland's marks, namely: 4th January 2008, 25th January 2008 and 11th January 2008 respectively. Gilmar has been asked to prove use of the mark ICEBERG. The second of Gilmar's earlier rights, the ICE B mark, is an international registration under the Madrid Protocol. This has a filing date of 27th May 2004 and so would not have been subject to proof of use requirements.

23) The evidence by Mr Gerani (as filed in the PINK ICE opposition case and summarised in the annex to this decision) provides instances of ICEBERG being used in normal and stylised script. There is no use shown in the form as registered in 1175324. In this registration the word ICEBERG appears inside a simple line drawing of a “lozenge shape”. It is established case law that to qualify as genuine, use of a mark must be in the form registered or in a form which does not alter the distinctive character of the mark in the form in which it is registered. The leading English authority on the issue is the Court of Appeal decision in *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25. This dealt with genuine use within the context of interpreting Section 46(2) of the Act but is equally applicable here. More recently, the same issue has been considered by both the Court of First Instance (“CFI”) and the ECJ. These cases have been reviewed by Richard Arnold QC, sitting as Appointed Person, in *NIRVANA Trade Mark* (BL O/262/06) and *REMUS Trade Mark* (BL O/061/08). He summarised his review in *NIRVANA* (and reiterated it in *REMUS*) in the following way:

“33. The first question is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period....

34. The second question is whether the sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all...”

24) Applying this guidance to the current proceedings, the distinctive character of the registered mark is, overwhelmingly, the word ICEBERG and the difference between this registered mark and the form used is the absence of the lozenge-shaped line border and absence of the minimal stylisation of the letters. It is my view that these differences will not alter the distinctive character of the registered marks. The use therefore satisfies the requirements set out in Section 6A(4)(a) of the Act.

25) Next, I must consider the scope of goods that genuine use has been shown within the relevant date, that is, use as between the period between January 2003 and January 2008. There are exhibits from Mr Gerani’s witness statement of September 2005, filed in the PINK ICE opposition, eg:

- Exhibit 1 in relation to invoices to retailers from 2003 which use the designations:- HISTORY ICEBERG UOMO (invoice of 20th February 2003

to LINEA OF HAMPSTEAD in respect of sweaters, invoice of 25th July 2003 to REPORT CLOTHING of London in respect of sweaters, sweat shirts, t-shirts, jeans and knitted caps and invoice of 19th November 2003 to PROHIBITION UK LTD of London in respect of sweaters, gilets and sports jackets); HISTORY ICEBERG DONNA (invoice of 19th November 2003 to PROHIBITION UK LTD of London in respect of sweaters) and ICEBERG UOMO (invoice of 20th February 2003 to LINEA OF HAMPSTEAD in respect of sweaters, t-shirts and shirts);

- Exhibit 3 which (although undated) shows use of ICEBERG displayed prominently on womens' anoraks and both mens' and womens' t-shirts;

- Exhibit 10 in relation to catalogues for Autumn/Winter 2002/2003 and Spring/Summer 2003. The mark ICEBERG is sometimes used alongside ICE JEANS but as an independent element in these catalogues. There is also use alone, as in "ICEBERG: The Movie" and "ICEBERG THE TOUR";

- Exhibit 12 in relation to advertising in FASHION and ESQUIRE magazines, both published in late 2002 which shows use of the mark ICEBERG;

- Exhibit 13 which is an assortment of editorial advertising appearing in, eg DAZED AND CONFUSED, ELLE, THE FACE, MAXIM, ARENA HOMME, I-D, MARIE CLAIRE, VOGUE, GQ, LOADED, HARPERS AND QUEEN, all taken from the period 1st February 2003 – 1st October 2004;

which all show, during or immediately before, the relevant period, genuine use of the mark ICEBERG, either alone, or (independently) with other designations (mostly ICE JEANS). As far as the marks: HISTORY ICEBERG UOMO, HISTORY ICEBERG DONNA, and ICEBERG UOMO on the invoices are concerned, I am prepared to conclude that either goods were either sold under the ICEBERG name, or that alternatively, if sold under the name on the invoice, that ICEBERG nonetheless constitutes a separate and independently distinctive element within the totalities. Such a conclusion is based on the fact that a predominantly English-speaking consumer will be unable to make sense of the longer phrases and therefore separate the words in their minds. When the evidence of the invoices then is seen in the context of the other evidence of genuine use from Mr Gerani, I think it a distinct probability that only the mark ICEBERG would have appeared on the goods.

26) The years 2006-2007 are covered by Mr Marani's later witness statement, but only in broad terms relating to UK sales of ICEBERG and "ICE" products. Mr Marani has not however supplemented or corroborated these sales figures with actual exhibits of the mark ICEBERG in use, and as such, his evidence adds little to the evidence of Mr Gerani on the question of deciding the nature of the genuine use and upon what goods it has been shown.

27) I have not found genuine use on “ *woven or knitted footwear* “, claimed in the specification of the earlier mark. I am assuming that the description used is another way of saying ‘socks’ or ‘soft- slipper’ style footwear. I have not found any use on such items. Neither have I found any illustrations of any use on *headgear* at large, but there are invoices to a company called REPORT CLOTHING of London dated 20th February 2003 and 25th July 2003, which refer to ‘caps’ and ‘knitted caps’, listed under the name HISTORY ICEBERG UOMO.

28) I must now consider what would be a ‘fair specification’, reflecting the goods in respect of which genuine use has been shown. The starting point for a fair specification must be Gilmar’s original specification which I cannot expand in any way. In this regard, even though I have found use of ICEBERG on, eg footwear, and accessories like belts or bags, it is not open to me to include such items within the scope of a fair specification. This is because footwear is expressly excluded (except for woven or knitted footwear) by Gilmar, and accessories are not included in the original specification.

29) Taking account of the case law provided by *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03* and *Animal Trade Mark* [2004] FSR 19, clothing is readily and often sub-divided between outer clothing and under clothing. These two terms represent clearly definable sections of the trade and the goods. Consequently, an appropriate specification for the goods of registration no 1175324, which includes also other specific items for which I have found use in the evidence, is:

articles of outer clothing; womens’ swimwear; caps; jeans, t-shirts and shirts, vests, pullovers, jumpers, outer-coats.

Section 5(2) (b)

30) Section 5(2) (b) reads:

“(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.”

31) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). 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) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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.*

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

32) I should say at the outset that, as regards the earlier mark M 832107, this application, which is properly called a 'designation' under the Madrid Protocol, has not as I understand it yet been protected in the UK, and accordingly cannot be regarded as being registered¹. To my knowledge however, it has been the subject of an opposition by another party and subsequent appeal (case refs BL O-008-09 and BL O-284-09), which has resulted in the class 25 goods of this designation being removed.

33) In the circumstances, my approach in this case will necessarily involve a comparison between both earlier marks (which cannot be treated as essentially the same), and the three subject applications separately. As far as the respective specifications to be compared are concerned, I have already determined on what goods genuine use has been shown in respect of the ICEBERG mark, during the relevant period(s), and this finding will be taken into account in relation to the required comparison of goods. As far as the ICE B mark is concerned, I will assume that it is protected in both class 18 and 25 for the purposes of my comparison of goods and services. My decision would, however, necessarily have to be provisional in the event that, or insofar as, the opposition based on the ICE B mark were to be successful. This is because that mark has to be

¹ See, to that effect, Para 3 of The Trade Marks (International Registration) Order 2008, SI 2008 No 2206.

registered (or in the case of an international registration, to be protected in the UK) to comprise an earlier mark in accordance with section 6 of the Act.

Comparison of goods

34) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v.Metro-Goldwyn-Mayer* the ECJ stated at paragraph 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 intended purpose and their method of use and whether they are in competition with each other or are complementary.’

35) Other factors may also be taken into account such as, for example, the trade distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281)

36) Taking account of my finding in respect of genuine use, the goods to be compared are listed below:

The ICEBERG mark

Gilmar’s relevant goods	Highland’s goods (all three applications)
Class 25 <i>Articles of outer clothing; womens’ swimwear; caps; jeans, t-shirts and shirts, vests, pullovers, jumpers, outer-coats.</i>	Class 25 <i>Clothing; headgear; footwear; accessories (clothing); gloves; scarves; mittens; waterproof clothing and outdoor clothing.</i>

The ICE B mark

Gilmar’s goods	Highland’s goods (all three applications)
Class 18: <i>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;</i>	Class 25 <i>Clothing; headgear; footwear; accessories (clothing); gloves; scarves; mittens; waterproof clothing and outdoor clothing.</i>

whips, harness and saddlery. Class 25: Clothing, footwear, headgear.	
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37) In the case of *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 133/05 (“Meric”)*, it is said at para 29 that:

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

The ICEBERG mark

38) Applying this guidance in respect to this case, I find that the terms “clothing”, “waterproof clothing and outdoor clothing”, “gloves; scarves; mittens” and “headgear” in Highland’s applications are all identical to Gilmar’s “articles of outer-clothing ” and “caps”. “Footwear” and “accessories (clothing)” in Highland’s applications are highly similar to “articles of outer-clothing” in Gilmar’s relevant goods. That is to say that the nature and intended purpose of these respective items is the same, namely to be worn and to functionally protect the body from the elements and/or to be worn as fashion items. As such, the users also are the same. Footwear and accessories (clothing) may (but, admittedly, not necessarily) also contribute to an ‘overall look’ and as such, aesthetically complement other items of clothing. Reference is made in this regard to the discussion in, eg CFI cases of *SERGIO ROSSI (Case T-169/03) [2005] ECR II 685*, and *EL CORTE INGLES SA (Case T-443/05)* which discusses how clothing and ‘accessories’ can contribute to an overall look. Moreover, in terms of channels of trade, in many retail outlets (admittedly, only one of the channels of trade), footwear and accessories (clothing) are sold alongside clothing.

The ICE B mark

39) “Clothing; headgear; footwear; gloves; scarves; mittens; waterproof clothing and outdoor clothing” are all identical to “clothing, footwear and headgear” in

Gilmar's specification. "Accessories (clothing)" are highly similar to "clothing, footwear and headgear" for the reasons I have discussed above in para 36.

The average consumer

40) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, para 23) it is important that I assess who the average consumer is for the goods and services at issue. In respect to "clothing", "waterproof clothing and outdoor clothing; gloves; scarves; mittens" and "headgear", I found identity as regards the ICEBERG mark, and it follows that the consumers of both parties' goods are identical in respect of these goods. Likewise, I found identity for those goods as far as the ICE B mark is concerned and also, in that case, footwear was found to be identical.

41) All these goods are ordinary consumer items and it follows that the respective consumers are the general public. The purchasing act will involve a reasonable degree of care and attention, but not the highest degree of attention that is associated with more specialised goods.

42) In relation to "accessories, clothing", I have found these to be highly similar to articles of outer clothing as regards the ICEBERG mark, and likewise for the ICE B mark, which has clothing at large. The same finding in respect to the average consumer will nonetheless be true; the respective consumers will be drawn from the same pool as clothing at large, namely the general public. Likewise the purchasing act will require a reasonable degree of care, but not the highest degree of attention. The same finding would be true as regards "footwear" in connection with the ICEBERG mark.

43) I am also mindful of the comments of the CFI in cases such as *Société provençale d'achat and de gestion (SPAG) SA v OHIM Case T-57/03* and *React Trade Mark* [2000] RPC 285, as regards the nature of the purchasing act, to the effect that bearing in mind the manner in which clothing goods will normally be purchased, it is the visual impression of the marks that can be the most important. This would normally be from a clothes rail, a catalogue or a web-site, rather than by oral request. These cases do not however provide any authority for ignoring the role that aural considerations may play in the purchasing act.

Comparison of marks

44) Each of the three applications must be compared separately to each of the two earlier marks.

45) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23).

The ICEBERG mark

46) The first marks to be compared are:

Gilmar's mark	Highland's mark
	

47) Beginning with the visual comparison, both respective marks begin with the word/syllable ICE. This is the limit of the similarity as all other components of the respective marks are different. Gilmar's mark has the second, conjoined element BERG and the lozenge-shaped border. In terms of the verbal element, the overall impression is that of a single word of seven letter length. Highland's mark has a second word "CROSS", and is plainly a two word mark. The first and second words are separated by a large black diagonal cross, each arm comprising an inward- pointing pencil shape. The script or font used in the respective marks is not the same; for the ICEBERG mark it is a relatively plain script in capitals; the ICE CROSS mark is slightly italicised and emboldened, but again in capitals. Both the word ICE and the word CROSS are equal in their size and presentation, neither being dominant in the overall mark. The single, shared visual element is thus the word/syllable, 'ICE'. Noting this sole similarity and the numerous differences, I conclude that the level of visual similarity is low, as between these two marks.

48) From an aural perspective, both marks share the same syllable ICE (pronounced AYE-SS) but differ in that the second syllable is BERG in Gilmar's mark, but in Highland's mark there is a second word CROSS. Taking the similarities and differences into account, I find the respective marks share only a low level of aural similarity.

49) In respect of the conceptual comparison, ICEBERG has an ordinary meaning in the minds of the consumer, namely "a large mass of ice floating in the sea"². As regards the ICE CROSS mark, this has no common conceptual meaning. By this I mean that I am not aware that the two words 'ice' and 'cross' together and in that order have any recognisable meaning, or point of reference above and beyond the fact that the average consumer will simply see them as referring to a cross which is made of ice. It is important in this finding to be aware of ECJ case

² www.oxfordreference.com

law which has developed the notion, in composite marks, of individual elements which may have independently distinctive character (see, eg . Case C-120/04, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*). In other words, I have to factor in, when considering marks necessarily as wholes, whether elements within the totalities of the marks may nonetheless ‘stand out’ or present to the consumer as being independently distinctive. Another way of putting this in relation to this case is to ask whether the words ICE and CROSS linguistically ‘hang together’ as a concept, or whether they naturally separate, resulting in the average consumers’ perception being conditioned to the fact that the *distinctive* element in the composite is either the word ‘ICE’ or the word ‘CROSS’. In my opinion, taking the mark as a whole, (including the device of the cross), the equal prominence of the two words, the fact that neither ICE nor CROSS can be regarded as descriptive terms in relation to clothing and the fact that both ICE and CROSS do ‘hang together’ in linguistic terms, I find that the ‘concept’ which will be perceived by the average consumer is that of an ICE CROSS. On that basis I conclude that the respective marks are conceptually dissimilar.

50) Taking these findings together, my conclusion is that these respective marks are share a very low level of similarity.

51) The next marks for comparison are:

Gilmar’s mark	Highland’s marks
	

52) The respective marks share the same word/syllable ‘ICE’. Gilmar’s mark is a single, seven letter word, ICEBERG, surrounded by a lozenge border. Highland’s marks, which are a series of two, one being in red, comprises two separate words, ‘ROCK’ and ‘ICE’ in that order. In Highland’s marks the words are equal in size and prominence, neither one nor the other being larger. The words are accompanied by a prominent eight-sided shape and device to the right hand side, together against a black or red background. Within the shape is what appears to be a wiggly line device, being broader at the bottom than the top. Visually, this is a minimalist device, being not obviously representative of anything. The device neither imparts, nor varies, any meaning in the words. The same is true vice versa, and as such the device and the words are to be

regarded as independently distinctive within the totality. Taking into account the context in which Highland's marks will be seen, and in particular the nature of the goods being sold under the mark (outdoor clothing), I can envisage many (but not necessarily all) consumers seeing the device as a footpath, wending its way into the distance. Taking all the similarities and numerous differences into account I conclude that, visually, the respective marks share only a low level of similarity.

53) From an aural perspective, both respective marks share the same word/syllable ICE (pronounced AYE-SS). In Gilmar's mark, ICE is the first syllable and this is accompanied by a second syllable BERG, together making up the single word ICEBERG. In Highland's mark, the ICE element is a separate word, preceded by the word ROCK, pronounced R-OC. It is a factor that the ICE element in Highland's mark comes second to the word ROCK. Taking the similarities and differences into account, I find the respective marks share only a very low level of aural similarity.

54) ICEBERG has, as I have said, a clear conceptual meaning. In submissions, Gilmar's attorneys say that the respective marks are highly conceptually similar since an iceberg is, in fact, a rock of ice. Respectfully, I do not agree. Upon seeing the words ROCK and ICE used in relation to outdoor clothing, will the average consumer really believe that the concept of an iceberg underlies those words? I would reiterate that it is the words that matter here; the device element, as I have said, neither imparts nor varies any meaning to the words ROCK ICE. The words ROCK and ICE together have no clear concept, in terms of recognisable meaning or other point of reference which may lie behind them. There is no such thing as 'ROCK ICE'; rock and ice are completely different materials and the juxtaposition of these words does not have any clear conceptual reference point at all, let alone point in the conceptual direction of an iceberg. I think it more likely in relation to the goods on which the marks are used that the average consumer may see a separation in the words, as in ROCK *and* ICE, being two outdoor 'environments' in which the clothes may be suited to be worn. Whether the average consumer sees the marks as 'ROCK ICE' or 'ROCK *and* ICE' I do not believe any conceptual link will be made to the word 'iceberg', and as such I find that there is no conceptual similarity as between the respective marks. I should add for the sake of completeness that, as with the ICE CROSS mark analysed above, I have looked at the possibility that the words ROCK and ICE may, in accordance with the case law of the ECJ, possess *independently* distinctive meaning within the totality, such that either word may be seen as being the element which indicates origin, and by definition, the other word merely descriptive. As with ICE CROSS, I have concluded that the words are more likely to 'hang together' as far as the consumer is concerned and that neither can be said to dominate in a distinctive capacity.

55) Taking these findings together, I find that the respective marks share only a low level of similarity.

56) The last two marks for comparison in this section are:

Gilmar's mark	Highland's mark
	ROCK ICE

57) In my considerations above in respect of the ROCK ICE, plus device, mark (“the device mark”), I concluded that the words ROCK ICE and the device are, in effect, independently distinctive. To the extent then that my analysis and conclusions relate to the words ROCK ICE alone, in plain script, such analysis and conclusions, at least as far as the aural and conceptual comparisons are concerned, can directly be applied here. In terms of visual comparison, any colours used in the device marks (including the background), together of course with the device element itself, in Highland’s device mark comprise additional points of difference as between those marks and Gilmar’s.

58) I conclude that, visually, the respective marks share only a low level of similarity. Aurally, the respective marks share only a very low level of similarity as discussed in para 51 above. Finally, there is no conceptual similarity as between the respective marks as discussed in para 52 above.

59) Taking these findings together, I find that the respective marks share only a low level of similarity.

The ICE B mark

60) The first two marks for comparison are:

Gilmar's mark	Highland's mark
	

61) Visually, Gilmar’s mark comprises the word ICE followed by the single letter B. There is clear separation between the two elements and they are not stylised in any way. The only complete word is the word ICE; the letter B has no clues as to its meaning or significance. Highland’s mark shares the word ICE and has a second word, “CROSS”; it is plainly a two word mark. The first and second words are separated by a large black diagonal cross, each arm comprising an inward-

pointing pencil shape, creating at its centre and in 'negative' image, the outline of a Maltese cross. The script or font used in the respective marks is not the same; for the ICEBERG mark it is a relatively plain script in capitals; the ICE CROSS mark is slightly italicised and emboldened, but again in capitals. Both the word ICE and the word CROSS are equal in their size and presentation, neither being dominant in the overall mark. The single, shared visual element in the respective marks is thus the word, ICE. Taking into account the similarities and differences I conclude that the level of visual similarity as between these respective marks is low.

62) Aurally, Gilmar's mark will be pronounced as ICE (AYE-SS) B (BEE). Highland's will be pronounced as ICE (AYE-SS) CRO-SS. Taking the similarities and differences into account, I find the respective marks share only a low level of aural similarity.

63) Conceptually, neither mark has any clear 'concept' behind or underlying it. Whilst both share the word ICE, there is no such thing as an ICE B. Absent any context, the letter 'B' conveys no clear meaning at all when juxtaposed after ICE. Putting the mark into a particular context, such as use on babies' clothing, it could well be that the average consumer would link the letter 'B' to being short for 'babies' but I cannot be certain on that point; the mark applied for is ICE B and not 'ICE BABIES' and the assessment must be made on the mark applied for and in its totality. It is at least equally plausible that the mark was intended to have been seen as a shortened version of ICEBERG. This is speculation; I repeat that there is no such thing as an ICE B. Likewise, as I have already said, there is no such thing as an ICE CROSS and thus these words will be seen as nothing more than a CROSS made of ICE. On that basis, and in contrast to my finding in relation to the ICEBERG mark, I find that these respective marks are neither similar nor dissimilar conceptually. As with my comparisons on the ICEBERG mark, I have factored in the possibility that elements in either mark may be seen as being independently distinctive but have concluded that this is not the case.

64) Taking these findings together I find that the respective marks share only a low level of similarity.

65) The next marks for comparison are:

Gilmar's mark	Highland's marks
	

66) Visually, Gilmar's mark comprises the word ICE followed by the single letter B. There is clear separation between the two elements and they are not stylised in any way. The only complete word is the word ICE. Highland's marks, which are a series of two, one being in red, comprises two, separate, words, ROCK and ICE in that order. The words are equal in size and prominence, neither one nor the other being larger. The words are accompanied by a prominent eight-sided shape and device described earlier. The device neither imparts, nor varies, any meaning in the words. The same is true vice versa, and as such, the device and the words are to be regarded as independently distinctive within the totality. As I have discussed earlier, I can envisage many (but not necessarily all) consumers seeing the device as a footpath, wending its way into the distance. The device possesses no visual connection with the letter 'B'. Taking all the similarities and numerous differences into account, I conclude that visually the marks share only a low level of similarity.

67) Aurally, Gilmar's mark will be pronounced as ICE (AYE-SS) and B (BEE). In Highland's marks, the ICE element is a separate word, preceded by the word ROCK, pronounced R-OC. It is a factor that the ICE element in Highland's marks comes second to the word ROCK. Taking the similarities and differences into account, I find the respective marks share only a very low level of aural similarity.

68) Conceptually, neither mark has any clear 'concept' behind or underlying it. Whilst both share the word ICE, there is no such thing as an ICE B. The letter B conveys no clear meaning at all when juxtaposed after ICE. Likewise, as I have already said, there is no such thing as ROCK ICE. The words ROCK ICE together have no clear concept, in terms of recognisable meaning or other point of reference, which may lie behind them. Rock and ice are completely different materials and the juxtaposition of those words does not have any conceptual reference point at all, other than, as I have already said, to possibly describe the environments where the clothing may be worn. On that basis, and in contrast to my finding in relation to the ICEBERG mark, I find that these respective marks are neither similar nor dissimilar conceptually. Again, I should stress that I have considered the possibility that elements within either mark may be perceived as being independently distinctive within the totalities but in my view this is unlikely.

69) Taking these findings together I find that the respective marks share only a low level of similarity.

70) The final marks for comparison are:

Gilmar's mark	Highland's mark
ICE B	ROCK ICE

71) In my considerations above in respect of the ROCK ICE, plus device, marks (“the device marks”), I concluded that the words ROCK ICE and the device are, in effect, independently distinctive. To the extent then that my analysis and conclusions relate to the words ROCK ICE alone, in plain script, such analysis and conclusions, at least as far as the aural and conceptual comparisons are concerned, can directly be applied here. In terms of visual comparison, any colours used in the device marks (including the background), together of course with the device element itself, in Highland’s device marks comprise additional points of difference as between those marks and Gilmar’s.

72) I conclude that, visually, the respective marks share only a low level of similarity. Aurally, the respective marks share only a very low level of similarity as discussed in para 67 above. Finally, conceptually, the respective marks are neither similar nor dissimilar as discussed in para 68 above.

73) Taking these findings together, I find that the respective marks share only a low level of similarity.

Distinctive character of the earlier trade marks

74) I have to consider whether Gilmar’s marks have a particularly distinctive character, either arising from their inherent characteristics or because of the use made of them. The first mark consists essentially of the word ICEBERG. This has a clear meaning in English, as already identified above, but in respect of the relevant goods the word has no connection. As such, the mark enjoys a reasonably high degree of inherent distinctive character.

75) The second mark ICE B has no clear meaning in English as a totality. As such the mark enjoys a high degree of inherent distinctive character.

76) I must also consider the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act. This was considered by David Kitchin Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at para 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 distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

77) Here I must assess the impact of use upon the earlier marks. The evidence illustrates that ICEBERG has been used in respect of those items of clothing I have already listed. The scale of this use is small when considered in the context of these clothing markets as a whole. Whilst no evidence is provided regarding the size of this overall market and Gilmar’s market share, I believe my conclusion is well founded in light of the visibly huge scale of the industry in the UK. As regards any evidence of use of the mark ICE B I can find no evidence as to its possible use in that form. Reference is made in the evidence to the PITTI BIMBO Fashion Show in Florence in an article in DRAPER’S RECORD, published on 25th January 2003. The show is evidently a children’s fashion show and attracted what is called a ‘debutant brand’, alongside the more established brands, ELLE and NIKE, and that brand was ICE ICE BABY. It is conceivable then that the ICE B mark is derived from ICE ICE BABY, with the letter ‘B’ denoting ‘BABY’. Alternatively, the letter B could have been intended to signify the second syllable BERG as in ICEBERG. Whatever the situation, there is no evidence of the mark ICE B in use in the UK.

78) In conclusion, I find that the already reasonably high degree of inherent distinctive character as regards the ICEBERG mark, and the high degree of distinctive character as regards the ICE B mark, are not enhanced to any significant extent as a result of any use of the marks.

State of the register evidence; use of the word ICE in relation to other brands and possible concurrent usage.

79) Mr Rasul details the results of searches of marks on the UK and Community registers in class 25 containing or comprising the word ‘ICE’. He also identifies in his evidence, usage by others, such as ICE PEAK CLOTHING, of marks which contain the word ICE. He has located these instances by use of the internet. Ms Széll counters this by advising of the action taken by Gilmar to prevent registration of some of those marks, and also that usage by some of those brands identified by Mr Rasul may not be UK based, or primarily UK, based. In some cases she says that companies identified by Mr Rasul are no longer trading.

80) Insofar as these issues concern marks which are on the respective registers of the UK and Community, I do not intend to address this further, other than to refer to the CFI case T-135/04, *GfK AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM):

“68 ..., the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. ...”

81) Likewise, in the current proceedings, claims as to the existence of the word ICE in various registers in relation to clothing do not assist me in relation to the question of likelihood of confusion.

82) Mr Rasul also mentions the fact that he is unaware of any instances of confusion in the years of ‘co-existence’ by the respective marks. This raises the question of whether any possible concurrent usage should be a factor in my overall assessment. It is well established that the tribunal is charged with assessing likelihood of confusion. The fact that there is no evidence of actual confusion may in certain circumstances be a relevant factor in this assessment, in cases for example of ‘peaceful co-existence’ or ‘parallel trading’. If the evidence establishes that the respective marks have actually been put to use in the same market (as opposed to the notional use which is normally considered), without the consumer being confused regarding economic origin, then this can inform the tribunal’s decision. Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18 gave weight to an absence of confusion in the marketplace, however, this should be tempered by a number of decisions which express caution about the circumstances in which it is appropriate to give these factors weight (see the Court of Appeal in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45.) In the first of the above cases, Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

In this case there simply is no evidence from either side by which I may conclude that the respective marks have, in fact, peacefully co-existed *in the same market* without confusion. The notional position has to prevail and so this factor carries no weight.

Likelihood of confusion

83) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly, with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

84) My assessment is based upon notional and fair use of the respective marks and in respect of the relevant goods and not on use of the earlier mark in a form significantly different to that registered or in a form that includes additional marks. I will detail my conclusions for each of the applications and in respect of each of the earlier marks. I need first to preface my conclusions with some case law.

85) I am mindful of the comments of the ECJ, regarding the weight to be given to conceptual differences, in *Claude Ruiz-Picasso et al v OHIM (PICASSO)* C-361/04 P, it commented:

“20. ...where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them...

21. ...such a finding is, in this case, entirely part of the process designed to ascertain the overall impression given by those signs and to make a global assessment of the likelihood of confusion between them”

86) I am also mindful of the comments of the CFI in cases such as *Société provençale d'achat and de gestion (SPAG) SA v OHIM* Case T-57/03 and *React Trade Mark* [2000] RPC 285, where it provides the guidance that, bearing in mind the manner in which clothing goods will normally be purchased, it is the visual impression of the marks that can be the most important. This would normally be from a clothes rail, a catalogue or a web-site rather than by oral request.

87) Notwithstanding this, it is important to bear in mind that neither the *PICASSO* case, nor the other cases I have referred to above, provides authority for *either* the proposition that conceptual differences are determinative, *or* that in the case of clothing, visual selection and comparison dominates over aural and conceptual differences (see, the criticism levelled against that proposition in, eg para 21 and following of *TECHNICS* (BL O-131-09) before the Appointed Person). Rather, all these cases reflect, in each of their individual circumstances, what factors may have, in the minds of the respective decision makers, particular importance *in the overall assessment of likelihood of confusion*.

The ICEBERG Mark

88) I found this earlier mark to have a reasonably high level of inherent distinctive character and that this distinctive character is not enhanced further through use.

89) As against the ICE CROSS mark I found the respective marks share only a very low level of similarity although the respective goods were either identical or highly similar.

90) Taking *all* factors into account and giving due notice to the fact that the purchasing act for the relevant goods may involve a reasonable degree of care and attention, I nevertheless believe the total absence of conceptual similarity is sufficient *in the particular circumstances of this case* to overcome any (low level) of visual or aural similarity arising from the presence of the shared syllable or word ICE. Therefore, having consideration for *all* the relevant factors, I conclude that there is no likelihood of confusion in respect of any of the relevant goods. Such similarities as there are would not lead the relevant public into believing that the respective goods originate from the same or economically linked undertaking and, as such, there is no direct or indirect confusion.

91) Next, I shall consider the ROCK ICE plus device mark. I found the respective marks to share only a low level of similarity although the respective goods were either identical or highly similar.

92) Taking *all* factors into account and giving due notice to the fact that the purchasing act for the relevant goods may involve a reasonable degree of care and attention, I nevertheless believe the total absence of conceptual similarity is sufficient *in the particular circumstances of this case* to overcome any (low level) of visual or aural similarity arising from the presence of the shared syllable or word ICE. Therefore, having consideration for *all* the relevant factors, I conclude that there is no likelihood of confusion in respect of any of the relevant goods. Such similarities as there are would not lead the relevant public into believing that the respective goods originate from the same or economically linked undertaking and, as such, there is no direct or indirect confusion.

93) Next, the ROCK ICE (word only mark). I found the respective marks to share only a low level of similarity although the respective goods were either identical or highly similar.

94) Taking *all* factors into account, and giving due notice to the fact that the purchasing act for the relevant goods may involve a reasonable degree of care and attention, I nevertheless believe the total absence of conceptual similarity is sufficient *in the particular circumstances of this case* to overcome any (low level)

of visual or aural similarity arising from the presence of the shared syllable or word ICE. Therefore, having consideration for *all* the relevant factors, I conclude that there is no likelihood of confusion in respect of any of the relevant goods. Such similarities as there are would not lead the relevant public into believing that the respective goods originate from the same or economically linked undertaking and, as such, there is no direct or indirect confusion.

The ICE B Mark

95) I found that this mark has a high degree of inherent distinctive character which is not enhanced through use.

96) As against the ICE CROSS mark, I found that the respective marks share only a low level of similarity, although the goods are either identical or highly similar.

97) Taking *all* factors into account, and giving due notice to the fact that the purchasing act for the relevant goods may involve a reasonable degree of care and attention, I nevertheless believe my neutral finding as to conceptual similarity is sufficient *in the particular circumstances of this case* to overcome any (low level) of visual or aural similarity arising from the presence of the shared syllable or word ICE. Therefore, having consideration for *all* the relevant factors, I conclude that there is no likelihood of confusion in respect of any of the relevant goods. Such similarities as there are would not lead the relevant public into believing that the respective goods originate from the same or economically linked undertaking and, as such, there is no direct or indirect confusion.

98) As against the ROCK ICE plus device mark, I found the respective marks to share only a low level of similarity, although the goods are either identical or highly similar.

99) Taking *all* factors into account, and giving due notice to the fact that the purchasing act for the relevant goods may involve a reasonable degree of care and attention, I nevertheless believe my neutral finding as to conceptual similarity is sufficient *in the particular circumstances of this case* to overcome any (low level) of visual or aural similarity arising from the presence of the shared syllable or word ICE. Therefore, having consideration for *all* the relevant factors, I conclude that there is no likelihood of confusion in respect of any of the relevant goods. Such similarities as there are would not lead the relevant public into believing that the respective goods originate from the same or economically linked undertaking and, as such, there is no direct or indirect confusion.

100) Finally, as regards the ROCK ICE (word only) mark I found the respective marks to share only a low level of similarity although the respective goods are either identical or similar.

101) Taking *all* factors into account and giving due notice to the fact that the purchasing act for the relevant goods may involve a reasonable degree of care and attention, I nevertheless believe my neutral finding as to conceptual similarity is sufficient *in the particular circumstances of this case* to overcome any (low level) of visual or aural similarity arising from the presence of the shared syllable or word ICE. Therefore, having consideration for *all* the relevant factors, I conclude that there is no likelihood of confusion in respect of any of the relevant goods. Such similarities as there are would not lead the relevant public into believing that the respective goods originate from the same or economically linked undertaking and, as such, there is no direct or indirect confusion.

102) In conclusion, Gilmar's oppositions against both applications based upon its Section 5(2) (b) grounds are unsuccessful in their entirety.

Section 5(4)(a)

103) I will go on to consider the grounds under Section 5(4) (a). That section reads as follows:

“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

(b)

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”.

104) Given my findings under section 5(2)(b) in relation to the absence of any likelihood of confusion as regards the earlier marks, ICEBERG and ICE B, even if I were to find any protectable goodwill in those marks which may be enforceable at the date of filing, the opponent's case under section 5(4)(a) is unlikely to be any stronger than under section 5(2)(b). That is, notwithstanding that in considering a notional passing-off action I am not simply making a sign against sign comparison, as with section 5(2)(b) of the Act. Under section 5(4)(a) I must consider all the signs upon which Gilmar relies and factor in everything surrounding them, everything that will affect the reaction of the average consumer who knows of the sign and its use (see *Wild Child Trade Mark* [1998] RPC 455 (“*Wild Child*”). Even taking account of the ‘broader’ approach under section 5(4)(a), there is nothing in the evidence or submissions which persuades me that that my finding of an absence of likelihood of confusion in relation to ICEBERG and ICE B would be anything different under section 5(4)(a). Absence of likelihood of confusion under section 5(2)(b) in these cases can be taken to

mean an absence of misrepresentation under section 5(4)(a). My focus must then be on exactly what *other* ICE marks Gilmar may claim to have any protectable goodwill in, any known surrounding circumstances, and whether they put Gilmar in any better position under section 5(4)(a). I will further discuss this question in para 108 below after my introductory comments.

105) The requirements for a section 5(4)(a) ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Wild Child*. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponents' 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 applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents; and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

106) To the above I add the comments of Pumfrey J (as he then was) in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case [2002] RPC 19, in which he 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 Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 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 at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence

to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

107) The relevant date for determining the opponent’s claim will be the filing date of the applications in suit, that is to say 6th August 2007 (see, CFI case *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Joined Cases T-114/07 and T-115/07 (“*Last Minute*”). The earlier right(s) must have been acquired prior to that date (Article 4.4(b) of First Council Directive 89/104, on which the Act is based). I should also say that the applicant is claiming use of the marks the subject of the applications, and in such a circumstance the applicant may be said (assuming the evidence establishes it) to have its own ‘independent reputation’ (as it is termed in the *Last Minute* case), such that the opponent may not on the date of application have succeeded in any notional passing off action. That is to say that the applicant may be found to be ‘senior user’ or, if that is not the case, the applicant may have acquired its own goodwill for such a period of time that it would be inequitable for it to be able to prevent the applicant from further use (see *Croom’s Trade Mark Application* [2005] RPC 2).

108) As regards a protectable goodwill in *other* ICE signs, the evidence is especially hard to assess. Plainly, the hearing officer in BL O/008/09 (appealed as BL O/285/09) was faced with the same problem. Only a conflated figure for “wear” for all “ICE” signs is given for the years 2006 and 2007 of , 1, 059, 120.00 and 513, 901.00 euros respectively. This is of no assistance in reaching any conclusion on each of the ICE signs separately. I will however adopt the findings of the hearing officer in BL O/008/09 as her decision clearly has to contend with the same evidence of Mr Gerani, as has been filed in this case. She found protectable and independent goodwill in ICEBERG, reinforced by use of ICE ICE ICEBERG, but I have already said that my Section 5(4)(a) analysis in relation to ICEBERG will be no better placed than under Section 5(2)(b). In para 53 of BL O/008/09, the hearing officer concludes that no protectable goodwill exists in respect of ICE J, ICE ICE BABY BY ICEBERG, or ICEBERG HISTORY. She found small-scale use of SPORT ICE, taking place in 1992 and ceasing in 1997, without any residual goodwill. As regards ICE JEANS, she found some use of that mark solus, but also of ICE JEANS ICEBERG, ICE JEANS By ICEBERG or ICEBERG ICE JEANS. The hearing officer concluded that it was likely that Gilmar had gained some ‘recognition’ for ICE JEANS solus, even though some of its use was with the ‘house mark’, ICEBERG, which formed according to the hearing officer the ‘core brand’ or ‘thematic link’ for the applicant’s branding as a whole. Despite the Appointed Person casting some doubt on that finding in para 9 of BL O/284/09, especially in view of the difficulty in establishing a date for the commencement of any goodwill from the evidence, I do not understand her to be saying the hearing officer was wrong in her finding. In the PINK ICE opposition, the hearing officer found that a protectable goodwill existed in relation to the sign ICE JEANS. Not without some hesitation on my part, I am prepared to make the same finding based upon the same evidence. The evidence plainly shows use of

ICE JEANS prior to the relevant date on, eg the invoices comprising Exhibit 1 to Mr Gerani's witness statement in respect of various items of outer-clothing and Exhibit 13 of the same witness statement showing advertising in various UK magazines such as DAZED AND CONFUSED, ELLE, THE FACE, ARENA HOMME, again all prior to the relevant date.

109) My further analysis under section 5(4)(a) is therefore restricted to protectable goodwill which may exist in the sign "ICE JEANS", based upon the goodwill I have found to exist in this mark. Specifically, I have not been able to conclude from the evidence that Gilmar has any protectable goodwill in the sign ICE *solus*. At first sight there may appear to be some tension in these positions, on the basis that 'jeans' is plainly a descriptive term in relation to clothing, so that on the face of it a finding of protectable goodwill in 'ICE JEANS' amounts to a finding that ICE *solus* has a protectable goodwill. The evidence however establishes use of ICE JEANS in relation to the sign, 'ICE JEANS', rather than as a pure descriptor. In other words it is used on clothing other than jeans. Based on the evidence, I find that Gilmar's protectable goodwill, at the relevant date, in ICE JEANS extends to the following:

articles of outer clothing; womens' swimwear; jeans; caps; t-shirts and shirts, vests, pullovers, jumpers, outer-coats, footwear and accessories such as bags and belts.

110) Moving on to the issue of misrepresentation, the claim, made in submissions by Gilmar's representatives, and quoting from an OHIM Decision 2106/2005 dated 12th June 2005, is that:

"It is common, in the clothing sector, for the same mark to be configured in various different ways, according to the type of product it designates. It is also common for the same clothing manufacturer to use sub brands, that is to say signs that derive from a principal mark and which share with it a common dominant element, in order to distinguish his various lines from one another (women's, men's use). In such circumstances, it is conceivable that the targeted public may regard the clothing designated by the conflicting marks as belonging, admittedly, to two distinct ranges of products, but as coming, nonetheless from the same manufacturer."

On that basis, OHIM concluded that the marks ICE and ICEBERG were successful against the mark ICE AGE.

111) In the PINK ICE opposition this approach was taken by the hearing officer, but he was at pains to stress in para 38 of his decision that the colour PINK could well signify a sub-brand *only* because it could indicate a descriptive characteristic of a product bearing the ICE brand. In the cases before me, I do not believe that the average consumer is likely to perceive any of the marks at issue as sub-brands of ICE JEANS. As I have already discussed in the context of section

5(2)(b), the words ICE and CROSS conceptually ‘hang together’ in such a way that neither word will be seen as comprising the distinctive element (and the other, purely descriptive) - at least as far as the goods at issue are concerned. The same is true of the ROCK ICE marks. Whilst I conceded that the consumer may read the mark as ROCK *and* ICE (as an alternative to ROCK ICE), this does not lead me to the conclusion that the marks as totalities will be seen as sub-brands of ICE JEANS. Based upon the presentation of the ROCK ICE marks, it cannot be assumed that either word is the distinctive component, with the other word relegated to descriptive significance only. Furthermore, based upon the evidence, Highland are plainly operating in a specialised outdoor clothing market, providing clothing suitable for rugged outdoor pursuits such as mountaineering, biking, hiking and so forth, with the emphasis upon functionality. The marks ROCK ICE and ICE CROSS should be seen in that particular context. In contrast, Gilmar are in the fashion market, where functionality perhaps plays a less important role and image is key. In that context, the mark ICE JEANS is unlikely to convey any reference or relevance to the environment in which the clothes may be suitable for use, unlike Highland’s marks. Against these very different respective backgrounds, the sub-brand argument carries even less force.

112) For the avoidance of any doubt, I would have rejected the sub-brand argument for the reasons I have given above if (which I do not accept in any event) Gilmar had demonstrated protectable goodwill in the word ICE *solus*.

113) In conclusion, I find there is no misrepresentation leading to damage of Gilmar’s goodwill. Use of any of the signs applied for at the relevant date will not have resulted in trade being diverted from Gilmar to Highland, in damage to Gilmar’s reputation in the case of any failings in the Highland’s goods, or in it being wrongly regarded by the relevant consumer that the two companies are connected. I would just add, finally, that even if Gilmar had succeeded in persuading me that there would have been misrepresentation at the material date in relation to any or all their marks, I would have had to look at whether Highland were nonetheless the ‘senior user’ or had, by the material date, generated their own goodwill such that it would have been inequitable to have allowed Gilmar to prevent them from further use. Whilst it is strictly unnecessary for me to make any findings on these matters, once again I would stress that the poor evidence presented by Gilmar would inevitably have hindered their case.

114) Therefore, the grounds for opposition based upon Section 5(4) (a) of the Act fail in their entirety.

COSTS

115) The oppositions having failed, Highland are entitled to a contribution towards their costs. I award costs on the following basis, taking account of the

fact that the cases were consolidated immediately after the counterstatements were filed:

Considering Notices of Opposition and preparing Statements of case in reply	£600
Preparing, considering and filing evidence	£800
Filing submissions	£400
TOTAL	£1800

116) I order Gilmar S.P.A. to pay Highland Woollen Company the sum of £1800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 03 day of February 2010

**Edward Smith
For the Registrar,
the Comptroller-General**

ANNEX – Extract from Decision BL O/257/06

EVIDENCE OF GILMAR

7) This consists of a witness statement by Silvano Gerani. Mr Gerani is the president of Gilmar, a position that he has held since 1980. The majority of the exhibited evidence shows use of the trade mark ICEBERG. There does not seem to have been use in the lozenge form of the trade mark registration. However, there has been considerable use of ICEBERG in standard font. The exhibits show use of ICEBERG in relation to outer clothing for men and women as well as for headgear and footwear. There is much use shown of ICEBERG in various magazines. Mr Gerani gives the following turnover figures for goods sold under the ICEBERG trade mark in the United Kingdom:

	1998	1999	2000	2001	2002	2003	2004
	€000	€000	€000	€000	€000	€000	€000
Wear	1,114	1,552	1,626	1,286	1,662	1,586	1,647
Accessories	43	46	72	116	124	124	75
Total	1,157	1,598	1,698	1,402	1,786	1,710	1,722

Marketing expenditure for the years 1998 to 2004 was €105,000, €412,000, €607,000, €352,000, €390,000 and €328,000 respectively. Mr Gerani states that Gilmar has used the trade marks ICE JEANS and ICE ICE ICEBERG. He states that the annual turnover in the United Kingdom in relation to goods bearing the trade mark ICE JEANS is as follows:

	1998	1999	2000	2001	2002	2003	2004
	€000	€000	€000	€000	€000	€000	€000
Wear	4,137	4,569	6,788	4,042	4,382	4,588	3,943
Accessories	75	74	173	116	99	109	78
Total	4,212	4,643	6,961	4,158	4,481	4,697	4,021

Marketing expenditure for the years 1998 to 2003 was €51,000, €60,000, €226,000, €292,000, €159,000 and €79,000 respectively. At exhibit 1 are various invoices; nine of these emanate from prior to 26 September 2003 and are for the United Kingdom (another invoice relates to Jersey). There are twelve United Kingdom invoices in all. The trade marks referred to upon the invoices are: Ice Jeans, Iceberg Uomo, History Iceberg Donna and History Iceberg Donna. The majority of the goods on the invoices are described as Ice Jeans; the goods so described are: jeans, t-shirts, shirts, sweaters, belts, knitted vests, sports jackets, skirts, sweatshirts, dresses, leather jackets, scarves, leather blousons, coats and pants.

8) Mr Gerani states that ICEBERG, ICE JEANS and ICE ICE ICEBERG goods are distributed throughout the United Kingdom. At exhibit 2 is a list of what Mr Gerani describes as distributors. The names would appear to indicate that the undertakings are retailers rather than distributors in the sense of wholesalers/importers eg Harvey Nichols, Moss Bros, Harrods and Selfridges.

9) Mr Gerani describes exhibit 4 as showing copies of photographs of examples of products sold under the trade mark ICEBERG combined with other ICE trade marks. The photographs

show use of Ice J, ICE JEANS, ICEJ, ICE jeans, Ice Jeans, ice j, icejeans. The majority of the use of these signs is for tops or various kinds, although there is also use for jeans, a purse, belts, a scarf and a key fob. Items of luggage are also, shown but the quality of the copy does not allow for identification of the trade mark. There is no provenance, with one exception, for the photographs. The writing opposite one picture of luggage is in Italian. The exception is a copy of a page from "FHM" for August 2001; it shows various sandals, including sandals by ICEBERG. From the angle of the picture it is not possible to see what is actually written upon the sandal. Mr Gerani states that exhibit 5 shows advertisements for goods sold under the trade mark ICE ICE ICEBERG. There are seven clippings from 'Vogue' from 1 July 2004. As these emanate from after the international priority date they are not pertinent to the use of Ice Ice Iceberg in relation to this case. There are copies of pages from 'Junior' magazine. However, from the quality of the copy it is only possible to read that it emanates from July 20--. The only material clearly emanating from prior to the international priority date is a copy of an article from 'Drapers Record' of 25 January 2003 about the Pitti Bimbo kidswear exhibition in Florence. It states that 379 brands were shown at the exhibition. The article includes the following:

"Debutants included Ice Ice Baby by Iceberg and the new Joop collection.

Gerry Myers, UK agent for the new Ice Ice Baby collection, said:.....

A further article from what might be the same edition of 'Drapers Record', comments on key trends at Kids' Fashion, Brussels and Pitti Bimbo, Florence. The following appears in the article:

"**Iceberg's** new **Ice Ice Baby** kids' range included padded ski outfits, *faux* shearlings and parkas."

Exhibit 6 shows pictures of tags showing ICE ICE and ICE ICE ICEBERG. There is no indication as to from when the tags emanate. Exhibit 7 has several pictures showing use of ICE ICE ICEBERG and one showing use of ICE; again there is no indication of their provenance. Exhibit 8 shows a photograph of the ICE ICE ICEBERG stand at Pitti in Florence. Mr Gerani omits to state when the picture was taken. Exhibit 9 shows pictures of footwear and tops bearing ICE ICE ICEBERG, again there is no indication of provenance. (I note that one top bears the Castellano wording "su nombre aqui" (sic) (your/his/her name here). Mr Gerani states that exhibit 10 consists of sample catalogues to promote ICEBERG goods which are sold under the ICE trade marks in the United Kingdom. The quality of the copy is poor, making it difficult to make out details. The first catalogue bears the words "ice jeans" and at the bottom appear to be the words "look back" or "look book". Various items of clothing for men and women appear; ICEJ and ICEJEANS can be seen upon some of the items. There is no indication as to when the catalogue was produced. The end of the catalogue shows the name and address of Gilmar in Italy. A catalogue for Ice Jeans bears the wording "autunno inverno 03/04", various items of clothing are shown. At the end of the catalogue there is a list of show rooms, including one in London. A catalogue for ICE JEANS ICEBERG for spring/summer 2003 is included; a range of clothing is shown, some of it bearing ICE JEANS. There are pages from 'ICEBERG THE MOVIE' which features the spring summer collection for 2003, this includes one page bearing the name ice jeans. A copy of a catalogue entitled 'ICEBERG THE TOUR' has what appears to be a photocopied Post-it® upon it bearing the writing "CATALOGUE WINTER 2003". There is a reference to ICE

JEANS. At the end of the exhibit is a page which is headed Autumn Winter 2003 – 2004, this includes a list of boutiques and showrooms across the world; one is in the United Kingdom.

10) Exhibit 12 consists of copies of advertisements; the majority are for ICEBERG products. However, there are advertisements from 'Vogue', 'Loaded' 'i-D' magazine, 'marie-claire', 'Elle', 'Dazed' 'FHM', 'Esquire', 'Nova', 'The Face', 'Red' 'Arena+' and 'Maxim Fashion' all bearing the name ice jeans ICEBERG; the ice jeans is the dominant element of the trade mark that is shown (ICEBERG appearing below in much smaller type). Exhibit 13 contains more copies of advertisements. Virtually all of the emanate from after the international priority date. The exceptions are two advertisements from 'Dazed & Confused' of 1 September 2003 and one from 'Dazed & Confused' of 1 February 2003. They are for ice jeans ICEBERG. Exhibit 14 consists of examples of editorial advertising; again the quality of the copying makes it difficult to see details in parts of the material; to make matters worse, where the relevant part of a page had been highlighted, the copying of the highlighting has blotted out the pertinent part. There is a large amount of material relating to ICEBERG. The only matter relating to Ice Jeans is as follows:

'In Style' June 2002 - strapless dress by IceJeans by Iceberg;
'Glamour' July 2002 - sleeveless shirt – Ice Jeans by Iceberg;
'In Style' December 2002 "cream and chocolate edged wool scarf, £85, by Ice Jeans".

There are also three advertisements from 'Daze & Confused' of November 2002 which go under the title of "Ice Ice Baby", these are advertising Iceberg products also. All of the material in exhibit 14 emanates from prior to the international priority date.

11) Mr Gerani states that Gilmar has acquired a strong reputation and goodwill in the trade marks ICEBERG, ICE JEANS and ICE ICE ICEBERG in the United Kingdom; because of the way that the trade marks are presented, the ice element of the trade marks is particularly associated with Gilmar's goods.