

O-078-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS. 3126273 & 3126277 BY
RAPHAEL'S FURNITURE LIMITED TO REGISTER:**

RAPHAEL HOME

&

RAPHAEL

AS TRADE MARKS IN CLASSES 20, 24, 25, 35 & 40

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER NOS. 405926 & 405927 BY
MARIO ARCANGELI**

BACKGROUND & PLEADINGS

1. On 9 September 2015, Raphael's Furniture Limited ("the applicant") applied to register the trade marks shown on the cover page of this decision. The applications were published for opposition purposes on 30 October 2015 for the following goods and services:

No. 3126273 – RAPHAEL HOME

Class 20 - Furniture; wooden furniture; cane furniture; indoor furniture; bedroom furniture; storage furniture; dressers [furniture]; furniture cabinets; leather furniture; benches; glass furniture; padded furniture; shelves; seating furniture; mirrors [furniture]; tables; desks; dining room furniture; cushions [furniture]; beds; bed heads; bed frames; wardrobes; chests of drawers; chairs; sofas; outdoor furniture; cabinets; bookcases; sideboards.

Class 24 - Household textiles; soft furnishings; bedroom textile fabrics; fitted sheets; textile sheets; curtains; textiles in the form of window furnishings; table cloths; towels; dining linens of textile; quilted blankets [bedding]; bed clothes and blankets; bed linen; table linen; comforters [bedding]; duvets; covers for duvets; covers for pillows; cushion covers; silk [cloth]; silk blankets; silk fabrics for furniture; woollen blankets; textiles made of wool; textiles made of cotton; textiles made of synthetic materials.

Class 35 - Retail store services and online retail store services relating to furniture, wooden furniture, cane furniture, indoor furniture, bedroom furniture, storage furniture, dressers [furniture], furniture cabinets, leather furniture, benches, glass furniture, padded furniture, shelves, seating furniture, mirrors [furniture], tables, desks, dining room furniture, cushions [furniture], beds, bed heads, bed frames, wardrobes, chests of drawers, chairs, sofas, outdoor furniture, cabinets, bookcases, sideboards, custom furniture, household textiles, soft furnishings, bedroom textile fabrics, fitted sheets, textile sheets, curtains, textiles in the form of window furnishings, table cloths, towels, dining linens of textile, quilted blankets [bedding], bed clothes and blankets, bed

linen, table linen, comforters [bedding], duvets, covers for duvets, covers for pillows, cushion covers, silk [cloth], silk blankets, silk fabrics for furniture, woollen blankets, textiles made of wool, textiles made of cotton, textiles made of synthetic materials.

Class 40 - Custom manufacture of furniture.

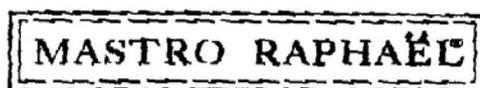
No. 3126277 – RAPHAEL

This application was published in classes 20, 24, 25, 35 and 40; the specifications in classes 20, 24 and 40 are identical; class 35 is also identical, save for the fact that it also includes the following goods at the end of the specification: “clothing, footwear, headgear, baby clothing, children's clothing.” The specification in class 25 is as follows:

Class 25 - Clothing, footwear, headgear; baby clothing; children's clothing.

2. The applications are opposed by Mario Arcangeli (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The oppositions are directed against all of the goods and services in the applications with the opponent relying upon all the goods (shown below) in the following European Union Trade Mark (“EUTM”) registration:

No. 959429 for the trade mark (shown below) which was applied for on 5 November 1998 (claiming an International Convention priority date of 18 September 1998 from an earlier filing in Italy) and entered in the register on 7 January 2000:



Laboratorio Decorazione

“Mark Description - The trade mark consists of MASTRO RAPHAEL in upper case Raphael printers' type, framed by two rectangles. The outer rectangle is

outlined by a thicker line than that of the inner rectangle. Underneath is written LABORATORIO DECORAZIONE in Casper printers' type.”

Class 20 - Furniture.

Class 22 - Curtains and accessories for curtains.

Class 24 - Textiles and textile goods, not included in other classes; household linen; face towels, sheets, quilts, bedspreads, blankets, duvet covers, cushions, dressing gowns, table covers, tablecloths; furnishing fabrics; beach towels.

Class 25 - Clothing and clothing accessories.

Class 26 - Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.

Class 27 - Carpets of textile.

In relation to the competing trade marks the opponent states:

“4. The distinctive element of the earlier right is MASTRO RAPHAEL. The element LABORATORIO DECORAZIONE is merely descriptive and translates to DECORATION WORKSHOP. Although not all consumers may have an understanding of Italian, it is correct to say that the average consumer upon seeing the wording LABORATORIO DECORAZIONE as being a reference to a place where creation and/or design of something occurs.

5. The earlier right incorporates the name MASTRO RAPHAEL, which will be viewed by the average consumer as a designer's name. The mark within the application takes part of this name, RAPHAEL. The mark within the application is visually, phonetically and conceptually similar to the mark protected by the earlier right.”

3. The applicant filed counterstatements in which the basis of the oppositions were denied. Although the applicant reserved its position in relation to any similarity in the competing goods and services until the opponent filed its evidence, it did comment upon the competing trade marks. In relation to the application for the word RAPHAEL alone, it stated:

“2. The Applicant’s mark is RAPHAEL. The Opponent’s mark consists of four Italian words, MASTRO RAPHAEL LABORATORIO DECORAZIONE and a rectangular device around the words MASTRO RAPHAEL. The only similarity between the Opponent’s mark and the Applicant’s mark is the word RAPHAEL. The word RAPHAEL in the Opponent’s mark is only one of four words all of which have equal prominence in the Opponent’s mark.

3. The word RAPHAEL in the Opponent’s mark is not the dominant and most distinctive element of the mark and the Applicant denies that the Italian words MASTRO RAPHAEL are any more distinctive to a UK consumer than the words LABORATORIO DECORAZIONE. The Opponent’s trade mark registration is for the words MASTRO RAPHAEL LABORATORIO DECORAZIONE and not for the single word RAPHAEL or the term MASTRO RAPHAEL and any similarity with the Applicant’s mark RAPHAEL must be assessed in relation to the whole of the Opponent’s mark and all its word elements.

4. Italian is not a language widely spoken by the majority of the general public in the UK and the words in the mark are not the sort of Italian words sometimes found in use in the UK that might readily be understood by non-Italian speaking UK consumers. The Applicant denies that the words LABORATORIO DECORAZIONE will be understood by a UK consumer as being merely descriptive or that the average UK consumer would understand those words as having the meaning of “Decoration Workshop” or “a reference to a place where creation and/or design of something occurs”. The Applicant puts the Opponent to proof of this statement.

5. The Applicant denies that the term MASTRO RAPHAEL will be seen by the average UK consumer as a designer name. The average UK consumer may understand the word RAPHAEL as being a name but will not have any understanding of the Italian word MASTRO or the term MASTRO RAPHAEL particularly when assessed as part of the whole mark of MASTRO RAPHAEL LABORATORIO DECORAZIONE.

6. Therefore visually and aurally the only element of similarity is the word RAPHAEL and conceptually there is no similarity between the marks for a UK consumer. The marks are therefore only similar to a very low degree.”

4. Its submissions in relation to the RAPHAEL HOME trade mark were substantially the same, modified only to the extent necessary to take into account the additional element i.e. the word HOME which appears in the applicant’s trade mark. I will not repeat these submissions here, but will take them into account in reaching a decision.

5. In these proceedings, the opponent is represented by Saunders & Dolleymore LLP and the applicant by Venner Shipley LLP. Following the filing of the counterstatement, the proceedings were consolidated. Only the opponent filed evidence. Although no hearing was sought, the opponent filed written submissions in lieu of attendance at a hearing. I will bear these submissions in mind, referring to them, as necessary, below.

Opponent’s evidence

6. This consists of a witness statement from the opponent, Mario Arcangeli, accompanied by three exhibits. I will return to this evidence below.

DECISION

7. The oppositions are based upon sections 5(2)(b) of the Act which reads as follows:

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

(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.”

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this earlier trade mark completed its registration process more than 5 years before the publication date of the applications in suit, it is subject to proof of use, as per section 6A of the Act. In his Notice of opposition, the opponent states his earlier trade mark has: “been put to use in the EU, in respect of the majority of goods...” adding that with the exception of “Clothing accessories” in class 25 and “buttons, hooks and eyes, pins and needles; artificial flowers” in class 26, his trade mark has been used upon all of the goods for which it is registered. In its

counterstatements, the applicant asked him to make good this claim. The relevant sections of the Act read 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 in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

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

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Section 100 of the Act is also relevant and reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Proof of use

10. In reaching a conclusion, I must apply the same factors as I would if I were determining an application for revocation of a trade mark registration based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of the publication of the applications for registration i.e. 31 October 2010 to 30 October 2015. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He stated:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice:

Ansul at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

11. As the opponent’s earlier trade mark is a EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are relevant, where it noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was

registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark 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 (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

12. In *The London Taxi Corporation Limited* case mentioned above, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in

Leno are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule

and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

13. The General Court (“GC”) restated its interpretation of *Leno Merken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of a EUTM. Consequently, in trade mark opposition and cancellation proceedings it continues to entertain the possibility that use of a EUTM in an area of the European Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of a EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the European Union. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the European Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- v) The geographical extent of the use shown

14. In his statement, Mr Arcangeli explains that he began using the trade marks MASTRO RAPHAËL and MASTRO RAPHAËL Laboratorio Decorazione in Italy in 1968. He states that at that time:

“3...the marks were used in respect of the sale and promotion of bed linens, sheet sets, duvet covers, quilted bedspreads, decorative cushions, towels, bathrobes, throws, upholstery fabrics, decorative accessories, curtain panels.”

He adds that by 2013:

“3... I was providing collections of these goods, under my trade marks, through an Italian network of independent retailers and internationally to major markets.”

And:

“7...more recently use has been extended to the United Kingdom, Austria, Germany, Belgium, Denmark, Greece, Spain, France, Finland and the Netherlands.”

15. He explains that exhibit MA1:

“9...is a selection of price lists circulated during the period of October 2012 through to September 2014 as well as copies of press releases, advertisements and photographs showing use of the mark in the EU.”

16. The extracts from the price lists to which Mr Arcangeli refers are dated October 2012 and October 2013 and contain, inter alia, the words “Retail Export”; although the third price list provided appears to be undated, in view of Mr Arcangeli’s comments above, I infer it is from September 2014. The index for the first price list from 2012 contains references to the following goods:

Quilt, quilted bedspread, bedspread, sheet-set, duvet- covers, pillow-cases, towels, bathrobes, fingertips, table-linens, plaid.

The price list also contains references to “pillow cover” and “cushions”.

17. The price list from 2013 contains the same goods save for the fact that it lists “table cloths and napkins” as opposed to “table-linens.” Both of these price lists bear the following at the top centre of each page:

MASTRO RAPHAËL

18. The third price list contains the words “Home couture”, “EU Retail Price List €” and the email address: mastro@mastroraphael.com. It also bears the image shown above. It includes references to goods which would be encompassed by the terms shown above as well as to a number of other goods, for example: “nackroll” (the meaning of which is unknown).

19. This exhibit also contains extracts obtained from a range of websites (the quality of many of which is very poor). The extracts are in the Italian language and are intermittently accompanied by partial translations into English; the extracts are dated between 14 October 2010 and June 2014. Although it can be discerned that many of the extracts contain references to, inter alia, Mastro Raphaël and/or MASTRO RAPHAËL, as far as I can tell, none of the extracts provided bear the trade mark in the form in which it is registered. Page 28 of the exhibit consists of an article dated 10 March 2011 obtained from edilportale.com. It contains the following text:

“Le novità del Laboratorio di Decorazione Mastro Raphaël”.

The translation provided indicates that this means:

“The news of the Mastro Raphael Laboratorio Decorazione”.

Within the body of the article there is further text which is said to translate as:

“This is the first work of Mastro Raphael Laboratorio Decorazione during the first exhibition of “SALONE DEL MOBILE” celebrates 15 years of the Company and its excellence.”

20. Mr Arcangeli states that in the period 30 October 2010 to 30 October 2015 the earlier trade mark has been used in: Italy, Germany, France, Austria, Finland, Belgium, UK, the Netherlands, Denmark, Spain, Greece, Romania, Slovenia,

Bulgaria, Ireland, Czech Republic, Malta, Latvia, Sweden, Portugal and Cyprus. He adds that the trade mark has been used in relation to the following goods:

Sheet-sets, duvet-covers, pillow-cases, cushions, towels, bathrobes, quilted bedspreads, quilts, blankets, bathmats, rugs, curtain panels, decorative fabrics, curtain hardware, beds, armchairs, headboards and sofas.

21. Exhibit MA2 consists of a range of invoices dated between 19 October 2010 and 29 October 2015 which have been issued to undertakings based in France, Romania, Bulgaria, Germany, the United Kingdom, Spain, Finland, Austria, Czech Republic, Portugal and Ireland. All bear either the image above or the image shown below in the top left hand corner of the page and are accompanied by www.mastroraphael.com, Mastro Raphael S.r.l. and the e-mail address mentioned above.



Partial translations have, once again, been provided. All but one of the invoices provided are within the relevant period; the invoices provided relate to some of the goods referred to by Mr Arcangeli. Turnover under the earlier trade mark in the European Union was, states Mr Arcangeli, as follows:

Year	Amount - €
2010	3,198, 660
2011	5,260,932
2012	4,634, 332
2013	4,139,183
2014	3,642,114
2015	3,198,660
Total	24,073,881

22. Mr Arcangeli explains that on 28 January 1998, he registered the domain name www.mastroraphael.com. He states that:

“11. I have 2902 unique users in average per month in the period on this website.”

He explains that the website is available in Italian, English and French adding that it:

“11...enables consumers to see the current products and collections available, ranging from soft furnishing such as bedding, curtains, cushions, throws, decorative fabrics, to bath linen, towels and face cloths, carpets, tablecloths and bath robes.”

23. Exhibit MA3 consists of: (i) a Google Analytics printout showing the “Audience Overview” for the opponent’s website between October 2010 and October 2015 which includes, inter alia, the number of “Sessions” (342,150), “Users” (261,842), “Page Views” (1,885,538) and “% New Sessions” (76.03%), (ii) a page from the WHOis.net website showing that the website was created in 1998 and (iii) pages obtained using the Internet archive waybackmachine showing how the website looked between 2010 and 2013. The images shown below are examples taken from the website:



And:



Is the use with consent?

24. Although Mr Arcangeli is the registered proprietor of the earlier trade mark, his evidence indicates that the use has been conducted through a corporate entity i.e. Mastro Raphael S.r.l. Page 39 of exhibit MA1 (from June 2014) and the accompanying translation, indicate that “Mario Arcangeli” is the “owner of Mastro Raphael”. As the applicant has not challenged any aspect of Mr Arcangeli’s evidence, I am satisfied that as required by section 6A 3(a) of the Act, any use made has been by the proprietor or with his consent.

In what form has the earlier trade mark been used?

25. As to the form in which the earlier trade mark has been used, I begin by reminding myself that it is registered as follows:



26. On the basis of the evidence provided, there is, as least as far as I can tell, no evidence of the opponent’s trade mark being used in the above format. However, what is shown in the evidence, is the use in the various formats I have identified above. The closest the opponent gets to use in the form registered is that shown at paragraph 19 above. That is, however, one isolated example and even in that example, the use is not by the opponent but in an article which refers to the opponent. I am, as a consequence, not satisfied that the evidence provided discloses any use of the trade mark in the form in which it is registered. It is, therefore, necessary for me to consider whether the use that has been demonstrated falls within section 6A(4)(a) of the Act which indicates that: “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”.

27. In approaching this issue, I bear in mind the guidance provided by Mr Richard Arnold Q.C. (as he then was) as the Appointed Person in *Nirvana Trade Mark*, BL O/262/06 when he summarised the test under the equivalent provisions of section 46(2) of the Act as follows:

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

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

28. The examples mentioned above provide the answer to the first question. The first part of the second question requires me to consider what constitutes the distinctive character of the registered trade mark. The registered trade mark consists of a number of components i.e. two rectangular devices within which appears the words "MASTRO RAPHAËL" (with an umlaut above the letter "E") below which appears the words "Laboratorio Decorazione"; the word components are presented in differing (but unremarkable type-faces) and in upper and title case respectively. In his statement, Mr Arcangeli states:

"12. The element MASTRO translates in English to MASTER. The element RAPHAEL is an Latin male name. The elements Laboratorio Decorazione translate to laboratory decoration. A Laboratorio Decorazione is a craftman workshop, place where products are customised and personalised."

29. The two rectangular devices act as a border for the words which appear within them; they have very little, if any, distinctive character. As to the words which appear

within this border i.e. “MASTRO RAPHAËL”, as I mentioned earlier, the type-face in which these words are presented is unremarkable and the umlaut above the letter “E” is, in my view, likely to go largely unnoticed. As to the words themselves, given the obvious visual similarities between the Italian word “MASTRO” and English word “MASTER”, and as the word “RAPHAËL” will be well-known as either a given or family name, the words form a unit, the meaning of which is different to the individual meanings of the words themselves. Given its size and positioning within the trade mark, this unit will make a significant contribution to its distinctiveness.

30. The words “Laboratorio Decorazione” appear below the device element and words “MASTRO RAPHAËL” and are, in my view, somewhat subordinate to them. They are, however, clearly significant within the trade mark as a whole. As to the distinctiveness of these words, in his written submissions, the opponent states:

“18...Further the term Laboratorio Decorazione, is close enough to the words Laboratory and Decoration, that the average consumer will see this as descriptive and a reference to the place where the products that the mark is used upon are designed or manufactured.”

31. In its submissions, the applicant denies that in this country these words are descriptive/any less distinctive than the words “MASTRO RAPHAËL”. In order for the opponent’s argument to succeed, the words “Laboratorio Decorazione” would: (i) need to be understood as meaning “Laboratory Decoration” (or, as the opponent initially suggested, “Decoration Workshop”), (ii) once understood in that manner to be seen as a reference to a place where the opponent’s goods are designed or manufactured and (iii), as a consequence of (i) and (ii), to then be considered descriptive and non-distinctive. However, even if the words are understood as “Laboratory Decoration” or “Decoration Workshop” (both of which are arguable), I am not convinced that even then these words would be considered either descriptive or non-distinctive of the goods for which the opponent’s trade mark is registered; what, one might ask, is a “Laboratory Decoration” or “Decoration Workshop”? Although subordinate to the words which appear above them, in my view, these words make a distinctive contribution to the registered trade mark.

32. The second part of the second question requires me to consider what the differences are between the trade mark used by the opponent and its registered trade mark. The answer to that question is that other than the journalistic reference mentioned earlier (which does not assist the opponent), the trade mark used does not include the words “Laboratorio Decorazione.”

33. I must now decide whether the differences I have identified alter the distinctive character of the trade mark registered. Although a subordinate component, in my view, the words “Laboratorio Decorazione” make a distinctive contribution to the overall impression the opponent’s trade mark conveys; the absence of this component from the trade mark used, alters its distinctive character.

34. Having concluded that the evidence provided discloses neither use of the opponent’s trade mark as registered nor use in a form differing in elements which do not alter its distinctive character, the oppositions fall at the first hurdle and are dismissed accordingly.

Conclusion

35. The oppositions have failed and, subject to any successful appeal, the applications will proceed to registration.

Costs

36. As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide, but bearing in mind the consolidated nature of these proceedings and that the Notices of oppositions and counterstatements were substantially similar, I award costs to the applicant on the following basis:

Preparing statements and considering the opponent’s statements:	£300
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Considering the opponent’s evidence:	£200
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Total:

£500

37. I order Mario Arcangeli to pay to Raphael's Furniture Limited the sum of £500. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of February 2017

A handwritten signature in black ink, appearing to be 'C J Bowen', written in a cursive style.

C J BOWEN

For the Registrar