

O-086-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2150775B
IN THE NAME OF MR & MRS ALDRIDGE**

AND

**IN THE MATTER OF OPPOSITION NO. 92464
THERE TO BY MAX MARA FASHION GROUP S.r.l.**

TRADE MARKS ACT 1994

IN THE MATTER OF

**application No. 2150775B
in the name of Mr & Mrs Aldridge
and in the matter of opposition No. 92464
thereto by Max Mara Fashion Group S.r.l.**

Background

1. Application No. 2150775 was filed on 14 November 1997 by Mr & Mrs Aldridge, now at Royal Leamington Spa, Warks, for the following mark:



2. The application proceeded to publication and notice of opposition was filed against it. As a result of that opposition, the application was subsequently divided. The opposition against divisional application No. 2150775A was resolved, that application proceeded to registration and I need say no more about it.

3. The opposition against divisional application 2150775B continued and led to the issuing of a decision dated 25 September 2001 by a registry Hearing Officer. The circumstances of that decision and the basis on which it was taken were subsequently the subject of an appeal to the Appointed Person under Section 76 of the Act. The decision of Professor Ruth Annand, sitting as the Appointed Person and dated 6 September 2002 can be found under the reference O/378/02. It is not necessary for me to set out fully that decision; it suffices to indicate that Professor Annand set aside the Hearing Officer's decision in part and remitted the application back to the Registrar where it was subject to re-examination.

4. Following the re-examination, application No. 2150775B was published for opposition purposes. The application was published for the following specification of goods:

Wallets in Class 18, and;
Bags in Class 25.

Thereafter, notice of opposition was filed by Marks & Clerk on behalf of Max Mara Fashion Group S.r.l. and this decision is written in relation to it.

5. The opposition is based on the following grounds:

- under section 5(2)(b); the mark is said to be virtually identical or similar to the opponent's earlier registrations,
- under section 5(3); because of the reputation in the earlier rights; and
- under section 5(4)(a) by virtue of the law of passing off.

6. The opponent relies on the following registrations.

Application No.	Mark	Specification
1407596	PENNYBLACK	Articles of clothing for women; capes, raincoats, jackets, skirts, trousers, shorts, waistcoats, bush-shirts, shirts, jump-suits, dresses, knitted articles of clothing, sweaters and cardigans, bathing suits, bathrobes, belts, gloves, caps, scarves and foulards; all included in Class 25.
2000788	PENNYPLUS	Articles of luggage, bags, briefcases, handbags, rucksacks, holdalls, travelling bags and trunks, key fobs, card cases and holders, wallets and purses; all being articles made of leather or imitations of leather; umbrellas and parasols. Class 18 Jackets, skirts, dresses, shirts, trousers, shorts, blouses, T-shirts, coats, rain-coats, belts, cardigans, pullovers, stockings, underwear, hats and caps, shoes, sandals, boots, nightwear, swimwear. Class 25
1483345	PENNYPULL	Articles of outerclothing for women; knitwear, headwear, stockings, gloves, neckties, belts, sportswear, sports clothing and socks; all included in Class 25.
1273937	NEWPENNY EASY WEAR	Articles of clothing for women, but not including boots, shoes, slippers and sandals.

7. The applicants filed a counter-statement denying each of the above grounds. The opponent subsequently filed evidence. Neither party requested to be heard but the applicants filed written submissions. After a careful study of all the papers, I give this decision.

Opponent's evidence

8. The opponent's first piece of evidence is a witness statement of John Arthur Slater dated 26 May 2005. Mr Slater is a partner in Marks & Clerk, the opponent's legal representatives. He confirms that the facts in his statement come from his own personal knowledge and from the records kept by his firm, by the opponent and by the Patent Office.

9. Mr Slater refers to the previous opposition proceedings, including the decision and subsequent appeal and comments on them. He exhibits, at JAS 1, copies of the papers from those proceedings. Whilst I am required to look at matters afresh and in light of the application as now published and opposed, Mr Slater indicates his reliance on submissions made in those earlier proceedings. I will take the material into account as appropriate.

10. Much of Mr Slater's witness statement is given to submission and commentary which I do not intend to summarise here but will again take into account as appropriate. He provides details of the background to this opposition and gives full details of the marks relied on by the opponent.

11. At JAS 2, Mr Slater exhibits numerous excerpts said to be from various catalogues and fashion magazines. Whilst some of the (unnumbered) pages are dated and bear identification of some sort, most do not. Some of the material is very poor photocopy and the pages are not collated in any way, consequently I cannot be sure of the source or date of much of this material. Where the material is dated, some of it is shown to have been published after the relevant date.

12. Mr Slater contends that the material filed shows that bags and wallets, as accessories to clothing, are offered for sale to the same consumers by the same producers and via the same media. Bags and wallets are, he says, a natural extension of any fashion label and are promoted and sold in conjunction with clothing and are therefore closely linked or associated. He exhibits at JAS 3 excerpts from a book published in 1996 to support this claim.

13. In respect of the opponent's trade mark PENNYBLACK, Mr Slater says it has acquired distinctiveness through the use made of it. He says that since 1983 there have been significant sales and high profile advertising under the trade mark in the UK and that it is well known throughout the world for clothing and accessories.

14. Mr Slater claims the opponent's trade mark PENNYPLUS has also acquired distinctiveness because of the "pre-existing reputation of the PENNY BLACK mark" in the UK. Mr Slater says the evidence shows that at the relevant date the opponent had a substantive reputation in what he refers to as PENNY prefixed trade marks.

15. Mr Slater concludes his witness statement by alleging that the application in suit should not have been accepted because of two errors which took place prior to publication of the application. I will return to his points later in this decision.

16. The witness statement of Luigi Maramotti is dated 5 September 2005. Mr Maramotti is the vice president of Max Mara Fashion Group S.r.l and has held that position since 1990. The information in his statement comes from his own knowledge or the records of his company or their predecessors in business. He also confirms that he is authorised to make the statement on behalf of his company and that he is fully conversant with the English language.

17. Mr Maramotti says his company is incorporated in Italy and was founded on 3 November 1980. He gives details of various marks owned by his company, including Community Trade Marks not relied on in these proceedings. Mr Maramotti gives details of the countries where his company's PENNYBLACK, PENNYPULL and NEWPENNY EASY WEAR trade marks have been used.

18. In relation to the mark PENNYBLACK, Mr Maramotti explains that the registration was originally owned by Manifatture del Nord S.p.A, which merged into Finmar S.p.A. on 29 March 1990. That same day, Finmar S.p.A then merged into his company, Max Mara Fashion Group S.r.l. He goes on to say that the trade mark was used by Manifatture del Nord S.p.A from 1983 until the mergers occurred. After the mergers a new company, Manifatture del Nord S.r.l, was appointed licensee of his company's trade marks both in the UK and throughout the world. He says the trade marks have been used throughout the world and have become well known in the women's clothing industry for fashionable clothing and clothing accessories.

19. Details are given of the areas where the trade marks have been used. These include towns and cities throughout England, including London, as well as Northern Ireland, Scotland and Wales though no specific details are given of the nature of that use.

20. Mr Maramotti states that PENNYBLACK has been used in the UK since 1983 in relation to women's clothing and clothing accessories. PENNYPULL was first used in the UK in relation to women's clothing in 1992 and NEWPENNY for the same goods since 2001. Whilst NEWPENNY is one of the marks he says is owned by his company, it is not one of the marks relied on in these proceedings. At LM1, he exhibits samples of labels and swing tags which he says show how the three trade marks "are being used". I take this to relate to use at the date the witness statement was prepared as the labels are not dated in any way.

21. Mr Maramotti gives details of the approximate net annual turnover of goods sold under the trade mark PENNYBLACK in the UK since 1992 as follows:

Year	Annual Turnover (euros)
1992	784,657.10
1993	677,928.67
1994	859,690.54
1995	872,451.16
1996	1,005,409.89
1997	963,232.71

22. Figures are also provided for subsequent years but as they relate to periods after the relevant date, I have not recorded them here. I also note that some of the figure for 1997 is likely to relate to a period after the relevant date. I note that the figures are given in euros. The pound (sterling) was at all relevant times and indeed remains the monetary unit of the UK so sales in the UK are unlikely to have been made in euros. But no indication is given of the "conversion rate(s)" which may have been used to arrive at the turnover figures provided. Mr Maramotti also gives details of the annual advertising spend for the mark PENNYBLACK. I have not included them here as they are worldwide figures only and all relate to periods after the relevant date.

23. In relation to use of the mark PENNYPLUS, Mr Maramotti says that sales of women's clothing and accessories were substantial until the line was discontinued.

There is no indication given of the date on which use of this trade mark ceased although I note that the registration under No. 2000788 expired some six months after the opposition was filed. Mr Maramotti provides figures for the approximate turnover under the mark in the UK and worldwide between 1995 and 1998. Where figures for the UK are given, they relate to periods after the relevant date; I have not included them in my summary of the evidence.

24. In relation to the trade mark PENNYPULL, Mr Maramotti explains that sales of women's clothing and clothing accessories under this mark have been seasonal. Again he gives figures of approximate net annual turnover for sales under this mark in the UK. Insofar as the figures relate to periods before the relevant date they are:

Year	Turnover (euros)
1992	42,385.62 (Autumn/Winter)
1994	2,630.83 (Spring/Summer)

Again no conversion rates are provided.

25. Mr Maramotti also gives details of sales made under his company's NEWPENNY and NEWPENNY EASY WEAR trade marks. These are consolidated figures for both trade marks however only the latter of these marks is relied on as an earlier mark in these proceedings. In any event, the figures given all relate to periods after the relevant date.

26. At LM2 Mr Maramotti exhibits what he says are representative samples of advertisements placed in women's fashion magazines and catalogues available from concessions in department stores and retail outlets in the UK selling clothing and clothing accessories under the PENNYBLACK, PENNYPULL AND NEWPENNY trade marks. I have already commented above that NEWPENNY simpliciter is not a mark relied on by the opponent. All of this material is somewhat poorly presented. It consists of hundreds of photocopied loose-leaf and unnumbered pages. Because of this, I cannot for the most part be sure of their source or date. Where dates are given in the evidence, many are after the relevant date. Few pages seem to carry any examples of the trade marks relied on and even fewer of those are dated.

27. At LM3 Mr Maramotti exhibits samples of invoices issued by his company's predecessors in title during the period 1992 to 2004 to customers in the UK. Again, of the several hundred pages filed, much of it dates from after the relevant date. Mr Maramotti indicates that the invoices bear code numbers which identify the trade marks under which the goods were sold. It is not clear, even with Mr Maramotti's explanation of the codes, that they all refer to the earlier marks relied on in these proceedings.

28. Mr Maramotti comments on the likelihood of confusion between the respective marks. He states his company has built up a substantive reputation in, as he puts it, PENNY prefixed marks. He states that women's clothing accessories such as belts, scarves, shoes, wallets and bags are promoted with women's clothing and sold with orders for clothing. Items such as belts can often be an integral part of a garment or sold separately but as an optional extra. He goes on to say that belts, handbags, briefcases, travelling and other types of bags are natural product extensions for a fashion label. He exhibits at LM4 printouts of trade marks registered in the UK to support his claim that other fashion houses provide these goods under their trade marks. This is no more than state of the register evidence: all these hundreds of pages

show me is that their owners have registered trade marks for a variety of goods; they do not show the marks to be used in the market place for these goods nor are they evidence of the trading practices in operation in that market.

29. A third witness statement is that of Ugo Medici, dated 5 September 2005. Mr Medici is the Managing Director of Manifatture del Nord S.r.l. a position he has held since 1990. Again he states that the facts and matters come from his own knowledge or the records of his company, he is authorised to make the statement on behalf of his company and is fully conversant with the English language.

30. Mr Medici explains that his company was incorporated in Italy and was founded on 1 January 1990 for the purpose of manufacturing and distributing women's clothing and accessories bearing the trade marks PENNYBLACK, PENNYPULL and NEWPENNY, owned by the opponent. His company is a subsidiary of the opponent and was appointed as licensee in the UK and elsewhere to sell women's clothing and accessories. Mr Medici lists details of seven marks under which trade was carried out and which include the four trade marks relied on by the opponent in these proceedings.

31. Mr Medici says that the opponent's trade marks have been used throughout the world and as a result have become well known in the clothing industry for women's clothing and accessories. He states that the opponent is one of, if not the largest producers of women's clothing and accessories in Italy. He gives no information to support this claim nor does he give any indication of what the position might be in the UK. Mr Medici confirms that his company and its predecessors in title have used the PENNYBLACK trade mark in the UK since 1983 for women's clothing and clothing accessories with PENNYPULL first used in the UK in 1992 and NEWPENNY in the UK in 2001.

32. Mr Medici states that he has read the witness statement of Mr Maramotti and confirms that he concurs with it and that the invoices, facts and figures referred to by him are true and accurate. Mr Medici says he is not aware of any other company that produces and sells women's clothing and clothing accessories in the UK under the trade marks PENNYBLACK, PENNYPLUS, PENNYPULL and NEWPENNY (EASY WEAR).

33. Mr Medici states that over 27 years he has gained knowledge and experience of the women's clothing industry throughout the world and that based on his experience, women purchase clothing accessories such as bags, wallets and belts to match their clothing. Sales assistants will often, he says, encourage customers to accessorise their clothing with matching shoes, bags, belts and wallets. From his experience and active participation in the fashion clothing and accessories industry, he asserts that bags, belts and wallets have been closely associated with clothing for many years. At UM1 he exhibits a number of Internet printouts. They are said to be an example of how an ensemble of clothing and accessories, including bags and belts are sold under the same trade mark. I note with some concern that the printouts post-date Mr Medici's witness statement and could not therefore have been in his possession when he signed that document and referred to them. However, as the printouts also bear a download date which is after the relevant date, they have not had any bearing on my decision in these proceedings and I therefore propose to say no more about this.

34. The final witness statement is a second statement of John Arthur Slater and is dated 13 September 2005. Mr Slater makes comments on the findings made in the earlier decision which was later appealed. At JAS 5 he exhibits details of the opponent's trade marks as referred to by Messrs Maramotti and Medici.

35. That completes my summary of the evidence.

DECISION

Preliminary issue

36. As I indicated at paragraph 15 above, Mr Slater alleges that two errors took place during the re-examination process. The first error, he says, occurred when the Trade Marks Registry allowed the applicants a further period of time in which to reply to a letter having previously failed to respond within the period allowed. The second error occurred because, having raised an objection to the application under section 5(2)(b), the application was allowed to proceed to advertisement without amendment.

37. In the *Adrenaline Trade Mark* case reported at O/440/99, Mr Simon Thorley QC sitting as the Appointed Person stated:

“6. Many of the functions of the Registrar relate to his duties in respect of the prosecution of trade mark applications for registration. These proceedings are ex parte in the sense that the applicant deals directly with the Registrar (through his various officers) and those officers are acting in an administrative capacity.”

He went on to say:

“10. [I]n relation to opposition [-] proceedings, the Registrar's officers cease to perform an administrative function and act solely in a judicial (or quasi judicial) capacity. The distinction is I believe an important one, particularly in the circumstances of the present case. When acting in an administrative capacity, the Registrar has to enter the debate with the applicant, has to reason with him and necessarily will engage in correspondence or in conversations with the applicant in order to seek to resolve any matters arising. If this can be done to the applicant's satisfaction, there is no need for a hearing.

11. Once the Registrar begins to perform his judicial function, the position is different. The Registrar or his officer is acting as a judge. The proceedings are adversarial, the issues are circumscribed by the pleadings and the parties are free to adduce the evidence and the arguments that they wish. It is the Registrar's duty to adjudicate upon the issues raised. It is not his duty and, indeed, it would be wrong for him, when exercising this function, to enter into a debate with either party as to the validity or otherwise of the contentions put forward on any of the issues raised in the proceedings.”

38. Mr Slater has filed, at JAS 4, a copy of the papers from the Registry's application file. Whatever took place during examination is, as Mr Thorley QC stated, an ex parte matter. I do not intend to revisit the decisions the registrar made during that process but would, however, make the following comments. In relation to the first alleged error, the registrar has both a statutory power to grant extensions of various time

periods and an inherent power to regulate practice and procedure. It is not unusual for the registrar to grant a party further time if the circumstances justify it even where the initial period has expired. In relation to the second alleged error, from the papers submitted in evidence, it seems the application in suit was subject to an amendment of the specification before it was allowed to proceed to publication. In any event, the grounds of opposition now before me include objections under section 5(2)(b) of the Act and I will consider the matter on the basis of the law and precedent, taking into account the submissions made by the parties.

39. The first ground of opposition is based on an objection under Section 5(2)(b) of the Act which states:

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

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

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

The term “earlier trade mark” is defined in section 6 of the Act as follows:

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

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

40. The opponent’s registrations are earlier trade marks within the definition of Section 6 of the Act. As I indicated at paragraph 23 above, the opponent’s registration No. 2000788 for the mark PENNYPLUS has subsequently expired but the registration was extant at the relevant date.

41. In determining the question under Section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723.

42. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

43. The trade mark PENNYBLACK is not descriptive of the goods for which it is registered. Although it could be seen as a woman's name, I believe it would more readily be seen as the name of a famous postage stamp. I am of the opinion that the mark is, per se, of a high distinctive character.

44. The trade mark PENNYPLUS is not quite so distinctive. Whilst the word PENNY is the name of a coin, it is also a female forename. Female forenames are commonly used in relation to the market for women's clothing. From my own knowledge, I am aware that the suffix "PLUS" is regularly used to denote a superior range of clothing or clothing intended for the larger lady and is not particularly distinctive.

45. The registration of the mark PENNYPULL was made subject to separate disclaimers of the words PENNY and PULL. The mark, as a whole has a distinctive character.

46. As for the registration of the mark NEWPENNY EASY WEAR, here the words EASY WEAR are subject to a disclaimer. The word NEWPENNY would, I believe, be taken by the average consumer to relate to a coin and be distinctive for the goods for which it is registered.

47. The opponent claims that the trade marks relied on have an enhanced distinctive character because of the use made of them. The trade mark PENNYBLACK is said to have been used since 1983. Turnover figures are provided and range from a low of 677k euros to a high of just over a million euros. In respect of the mark PENNYPLUS, there is no evidence of any sales having been made in the UK before the relevant date. Turnover figures are given for the mark PENNYPULL but the figures cover just one year and amount to less than 50k euros. There is no evidence which allows me to apportion any turnover to the NEWPENNY EASY WEAR mark relied on. Where turnover figures are given, they are given in euros but no explanation is provided to show the "conversion rate" used so I cannot be sure of the volume of sales in the UK in £ sterling.

48. In respect of all four earlier marks relied on by the opponent, I have no evidence of advertising and promotional expenditure or the coverage of any advertising which relates to a period before the relevant date which can be apportioned to any individual mark relied on within the UK.

49. No evidence has been provided to indicate the size of the UK market in relation to the relevant goods, however, on any estimation it is likely to be extremely large. On the basis of the evidence as filed, I am unable to say that any of the earlier trade marks relied on by the opponent has any enhanced distinctiveness because of the use made of it.

50. I turn to the comparison of the respective trade marks. For ease of reference I set these out below:

Applicants' trade mark	Opponent's trade marks
	PENNYBLACK
	PENNYPLUS
	
	NEWPENNY EASY WEAR

51. The application in suit consists of the word PENNY to the left of the word BLACK, both in block capitals with the word BLACK presented in a bolder, thicker font than the word PENNY. Behind these two words is what appears to be a target device with the bull of the target forming a circle between the last letter of the word PENNY and the first letter of the word BLACK. The target device has a horizontal diameter which extends from the middle of the second letter “N” in the word PENNY to the middle of the letter “L” in the word BLACK.

52. I consider first the opponent’s NEWPENNY EASY WEAR trade mark. Whilst the mark in suit contains a device element, which I must take into account, the device is somewhat secondary to the words PENNY and BLACK. Whilst there is a degree of visual similarity in that the respective marks both contain the word PENNY, the positions of the word and the presence of other elements within each mark mitigates against any overall visual similarity. Aurally, similar considerations apply. Conceptually the opponent’s mark brings to mind a coin, the mark in suit, a postage stamp. The respective marks have no conceptual similarity. Despite the presence in each mark of the word PENNY and taking into account the fact that the average consumer rarely has the chance to make a direct comparison but must rely instead on the imperfect picture of them (s)he has kept in mind, I find that when considered as a whole the respective marks are not similar and there would be no likelihood of confusion even if identical goods were involved.

53. The opponent’s trade mark PENNYPULL also has a degree of visual and aural similarity with the mark in suit in that both contain the word PENNY, this time positioned at the beginning of (the word element of) the marks. The marks also contain the words BLACK and PULL respectively and there is the device element within the mark in suit. The opponent’s mark is presented in a “stencilled” font however the mark is still clearly seen as PENNYPULL. Whilst the commonality of PENNY cannot be ignored, I have to consider the marks as wholes. Conceptually, the mark PENNYPULL has no particular meaning. Again, even considering imperfect recollection, I find that the respective marks are not similar and there would be no likelihood of confusion even if identical goods were involved.

54. Similar considerations apply to the opponent’s mark PENNYPLUS. Whilst there is a degree of visual and aural similarity with the mark in suit because they both start with the word PENNY, that is the extent of the similarity. Conceptually, there is no similarity. Again, taking all matters into account, I do not find the respective marks to be similar and there would be no likelihood of confusion even if identical goods were involved.

55. Finally, there is the opponent’s mark PENNYBLACK. Despite the presence of the device element in the mark in suit, the respective marks are visually highly similar and, given that the average consumer is likely to place primary attention on the words, they are aurally and conceptually identical. I go on, therefore, to consider the respective specifications of goods.

56. For ease of reference, I set out the specifications of goods of the respective marks below:

Applicants’ specification	Opponent’s specification
Class 18 Wallets Class 25 Bags	Articles of clothing for women; capes, raincoats, jackets, skirts, trousers, shorts, waistcoats, bush-shirts, shirts, jump-suits, dresses, knitted articles of clothing, sweaters and cardigans, bathing suits, bathrobes, belts, gloves, caps, scarves and foulards; all included in Class 25.

57. In determining whether the goods covered by the application are similar to the goods covered by the opponent’s trade mark, I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 as set out below:

“[T]he following factors must be relevant in considering whether there is or is not similarity:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of services;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in particular they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who, of course, act for industry, put the goods or services in the same or different sectors.”

58. I acknowledge that in view of the judgement of the ECJ in *Canon*, the above case may no longer be wholly relied upon. However, the ECJ said the factors identified by the UK government in its submissions, which are those listed above, are still relevant in respect of a comparison of goods. I proceed on that basis.

59. The opponent’s specification covers goods which are everyday items and I take the average consumer to be the ordinary (female where appropriate) member of the public. The opponent’s specification includes “articles of clothing” (for women), a

somewhat generic term, as well as specific, named articles of clothing (not limited in any way), e.g. shirts and cardigans. It also includes a number of articles which, it seems to me, would not, on any reasonable interpretation be described as clothing but would be described as accessories to clothing e.g. belts, scarves, foulards. “Articles of clothing” and “clothing accessories” have, it seems to me, different purposes but are used by the same users and may be made of similar if not identical materials. The specification of the application in suit is for wallets and bags. These terms are not limited in any way and I have to consider the matter on the basis of normal and fair use. The terms wallets and bags include goods which may also be described as clothing accessories. As such, they are used by the same users and may be made of similar if not identical materials. Such articles are frequently bought either to match, co-ordinate with or, in some instances, to contrast with clothing. As the evidence shows, they may be sold through the same channels. Someone seeking to buy an article of clothing is not going to achieve that purpose by buying a clothing accessory but it seems to me that whilst “clothing” is not in competition with “accessories” they are or may be complementary.

60. As the ECJ made clear in *Canon*, the closer the respective marks, the less similarity is required between the respective goods in finding there to be a likelihood of confusion. There is a very high degree of similarity between the respective marks and the marks have a high distinctive character. The goods, whilst not identical, are complementary. Taking all these considerations into account, I believe there is a likelihood of confusion and the objection under section 5(2)(b) succeeds.

61. Having found in favour of the opponent under section 5(2)(b), it is not strictly necessary for me to go on to consider the objections raised under sections 5(3) and 5(4)(a). For the benefit of any appellate tribunal, however, I would make the following comments. The evidence filed by the opponent is substantial in volume but I have already made a number of criticisms of that evidence. Having reviewed that evidence in some detail, it does not enable me to apportion any reputation or goodwill to any of the individual earlier marks relied on by the opponent.

Costs

62. The opponent, having been successful, is entitled to an award of costs. Whilst a substantial volume of evidence was filed, much of it was poorly presented and of limited, if any value, in reaching my decision. The applicants filed no evidence and the decision has been reached without a hearing. I order the applicants to pay the sum of £900 to the opponent as a contribution towards its costs. 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 23rd day of March 2006

**Ann Corbett
or the Registrar
The Comptroller-General**