O-0926-23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3715792

BY

MY BRAND LTD

TO REGISTER

Tamarin

AS A TRADE MARK IN CLASSES 3 & 5

AND

OPPOSITION THERETO (UNDER NO. 431036)

BY

WORTMANN KG INTERNATIONALE SCHUHPRODUKTIONEN

BACKGROUND

1) On 29 October 2021, My Brand Ltd ('the applicant') applied to register the word 'Tamarin', as a trade mark, in respect of the following goods:

Class 3: Cosmetics; Beauty lotions; Beauty creams; Beauty serums; Beauty care cosmetics; Sunscreen; Hair care preparations; Fragrances.

Class 5: Health food supplements made principally of vitamins; Health food supplements made principally of minerals; Nutritional supplements.

2) The application was published in the Trade Marks Journal on 12 November 2021 and notice of opposition was later filed by Wortmann KG Internationale Schuhproduktionen ('the opponent'). The opponent claims that the trade mark application offends under Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ('the Act').

3) In support of its ground under section 5(2)(b) of the Act, the opponent relies upon the following trade mark registrations and the underlined goods covered by the same, as shown below:

- **UKTM 911942141 ('mark 1')**

  Tamaris

  Class 3: Soaps, perfumery, essential oils, cosmetics, hair lotions.

  Filing date: 17 June 2013
  Date of entry in register: 28 October 2013

- **UKTM 906570204 ('mark 2')**

  TAMARIS

Class 3: Shoe care products, namely boot cream, shoe wax.

Class 21: Shoe horns, brushes for footwear, non-electric wax-polishing appliances for shoes, shoe trees (stretchers).

Class 25: Belts, stockings, inner soles.

Filing date: 17 December 2007
Date of entry in register: 14 October 2008

- **UKTM 911869377 ('mark 3')**

Class 3: Boot polish, namely shoe creams, shoe wax.

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

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; Trunks and travelling bags; Umbrellas and parasols; Walking sticks.

Class 21: Shoe brushes, shoe trees, shoe horns, shoe polishers (non-electric).

Class 25: Clothing, Footwear, Headgear for wear, Belts, Stockings, Shoe insoles.

Class 35: Retailing and online services, in each case for the goods: shoe care products, namely shoe creams, shoe wax, precious metals and their

alloys and goods in precious metals or coated therewith, jewellery, precious stones, horological and chronometric instruments, leather and imitations of leather, and goods made of these materials, trunks and travelling bags, umbrellas and parasols, walking sticks, shoe horns, shoe brushes, wax-polishing appliances, non-electric, for shoes, shoe trees, clothing, footwear, headgear, belts, stockings, shoe insoles.

Filing date: 17 May 2013
Date of entry in register: 11 October 2013

4) The above marks of the opponent are comparable marks (EU). Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

5) It is claimed that the respective goods are similar and that the respective marks are similar, such that there exists a likelihood of confusion under section 5(2)(b). The opposition under this ground, based upon mark 1, is directed against all of the applicant's goods; the opposition under this ground, based upon marks 2 and 3, is directed against class 3 of the application only.

6) In support of its case under section 5(3) of the Act, the opponent relies upon the three earlier marks shown above in relation to all of the goods and services covered by those registrations. It also relies upon the following two registrations, and goods covered by the same, as shown below:

- **UKTM 1496910 ('mark 4')**

  TAMARIS

  Class 25: Boots and shoes; all included in class 25.

Filing date: 07 April 1992
Date of entry in register: 07 July 1995

- **International Registration ('IR') 896489 ('mark 5')**

  Tamaris

  Class 25: Clothing, headgear.

  Designation date in the UK: 13 July 2006
  Date of protection in the UK: 23 March 2007
  Office of origin: Germany

7) It is claimed that the earlier marks have an extensive reputation in the UK in relation to all of the goods and services covered by them and that use of the contested mark will take unfair advantage of, or be detrimental to, the reputation and/or distinctive character of the earlier mark.

8) The trade marks relied upon by the opponent are earlier marks, in accordance with section 6 of the Act. As they all completed their registration procedure more than five years prior to the application date of the contested mark, they are subject to the proof of use conditions, as per section 6A of the Act.

9) The applicant filed a counterstatement. It puts the opponent to proof of use in relation to all of the earlier marks and all of the goods and services covered by them. It also denies all of pleaded grounds. I note, in particular, that the applicant disputes the claimed similarity between the respective goods and services.

10) The opponent is represented by Dummett Copp LLP. The applicant is represented by Trademarkit LLP. Only the opponent filed evidence (the applicant has filed nothing beyond the counterstatement). The opponent's evidence of use takes the form of a witness statement from Jens Beining with Exhibits 1 - 10 thereto. There is also a witness statement from Mirko Schober with exhibits MS1 -MS4

thereto, consisting of translations of some of the evidence of Jens Beining. Finally, there is a witness statement from Lewis Jones, the opponent's trade mark attorney, with exhibits LJ1 – LJ2 thereto, consisting of an excerpt from the EUIPO similarity tool (for goods and services) and the results of an Internet search for the term 'Tamarin'. That evidence was also accompanied by written submissions (received on 13 September 2022). Neither party requested a hearing nor filed written submissions in lieu. I now make this decision after careful consideration of the papers before me.

DECISION

11) Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. As the provisions of the Act relied upon in these proceedings are derived from an EU Directive, I will, therefore, take account of trade mark case law of the EU courts.

Comparable marks – relevance of evidence pertaining to the EU

12) Some of the earlier marks relied upon by the opponent are 'comparable marks' and the evidence before me purporting to show enhanced distinctiveness and reputation includes use in the EU. In this regard, I note that Tribunal Practice Notice 2/2020 states:

> **'Comparable marks – use and reputation**
>
> 4. Where, to the extent set out above, comparable marks are relied on in opposition/invalidation proceedings, there will be circumstances when the use provisions apply, or where a reputation is claimed under section 5(3) of the Act. Comparable marks may also be the subject of revocation claims based on non-use. In such circumstances, it may still be possible to rely on evidence of use in the EU, as set out below:
>
> - where all or part of the relevant five-year period for genuine use under sections 6A, 46(1)(a) or (b), or 47 falls before IP Completion Day, evidence of use of the corresponding EUTM in the EU in that part of the relevant period before IP Completion day will be taken into account in determining whether there has been genuine use of the comparable trade mark. For

that part of the relevant period, for the purposes of the genuine use assessment, the UK will be taken to include the EU.

- where it is asserted that a comparable mark has a reputation under section 5(3), and that reputation falls to be considered at any time before IP Completion Day, use of the corresponding EUTM in the EU will be taken into account in determining whether the comparable mark had a reputation at the relevant date.'

I will bear this in mind in the instant case.

Proof of use

13) All of the goods and services relied upon under sections 5(2)(b) and 5(3) of the Act are subject to proof of use. I find it convenient to set out, here, my findings on: i) whether the opponent has shown genuine use for any of the goods relied upon under section 5(2)(b) and, ii) whether genuine use has been shown for some of the goods which are relied upon under section 5(3), namely, 'footwear' covered by mark 3 and 'boots and shoes' covered by mark 4. For reasons which will become apparent, I will deal with the matter of genuine use for the other goods and services relied upon under section 5(3) of the Act when I come to assess that ground.

14) Section 6A of the Act states:

"(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), (aa) 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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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) – (5A) [Repealed]

(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."

15) Section 100 is also relevant, which 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."

Consequently, the onus is upon the opponent to prove that genuine use of the registered trade marks was made in the relevant period.

16) In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

> "114……The CJEU has considered what amounts to "genuine use" of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.
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> 115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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. Thu there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *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]."

17) As regards assessing use within the EU, I also bear in mind that in *Leno Merken BV v Hagelkruis Beheer BV,* Case C-149/11, the Court of Justice of the European Union ('CJEU') 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."

18) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited,* [2016] EWHC 52, Arnold J. (as he then was) 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.
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> 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."

19) 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 what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an 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 Union.

20) 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 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
iv) The geographical extent of the use shown

21) The relevant period in which genuine use must be established is the five-year period ending on the date of filing of the contested mark. In the case before me, that period is **30 October 2016 to 29 October 2021.**

Mark 1

22) I will first consider whether proof of use has been shown for mark 1 because the goods covered by that mark clearly offer the opponent the strongest prospect of success, subject to the proof of use requirement being satisfied. The goods covered by that mark are ‘Soaps, perfumery, essential oils, hair lotions’ in class 3.

23) The relevant evidence comes from Jens Beining (I also bear in mind the translations of certain parts of that evidence which are provided in Mirko Schober’s evidence). Having carefully reviewed that evidence it is clear that the overwhelming

majority of it pertains to use on footwear. There is also some evidence showing use in relation to other goods, such as preparations for cleaning shoes including shoe creams, gels, mousses and shoe wax (none of which are 'soaps', bearing in mind the natural and ordinary meaning of that term), inserts for shoes, sunglasses, jewellery items, watches and some items of clothing and bags. I can see no use at all in relation to 'Soaps, essential oils, hair lotions'. As regards 'perfumery', there is an image in a '2020 catalogue' of a product called 'barefoot spray'[1] (bearing mark 3) which, according to the witness, is a 'shoe fragrance'[2]. The same goods are listed in two of the invoices in the evidence[3]. However, the description of the product in the exhibit is that it is a 'protection spray' which 'protects feet from rubbing when walking barefoot in shoes'. Although the description also states that the spray 'refreshes and pampers the feet', there is no indication that it is perfumed/scented in any way and there is nothing else in the evidence before me to suggest that to be the case. I do not consider that such goods would naturally be considered an item of 'perfumery'. In any event, the scale of use shown before me, in relation to such goods, is insufficient to satisfy the requirements for genuine use (there are only two invoices relating to those goods before me in the relevant period and no sales or turnover figures relating to those goods).

24) I note that there is also reference in the evidence to goods described as 'Tamaris fresh up spray'[4]. However, this appears to be a spray for freshening up the leather/suede on shoes and/or to 'give a subtle shine' to the shoe[5]. That spray is not, therefore, an item of 'perfumery'.

25) For the reasons given above, I find that the opponent has not shown genuine use in respect of any of the goods covered by mark 1. It cannot, therefore, rely upon that mark under sections 5(2)(b) (or 5(3)) of the Act.

Goods in class 3 covered by Marks 2 and 3

[1] Exhibit 1, page 21
[2] Witness Statement of Jens Beining, [9]
[3] Exhibit 5, p.24 and p.42-43 (although the same goods are listed in the invoice at p.44-45, this is a duplicate of the invoice on page 42-43)
[4] Exhibit 5, p.24, 25, 28, 34 (for example)
[5] Exhibit 1, p. 15

26) Turning to marks 2 and 3, the opponent relies, for the purpose of section 5(2)(b), upon the following goods:

Mark 2: Shoe care products, namely boot cream, shoe wax in class 3.

Mark 3: Boot polish, namely shoe creams, shoe wax in class 3.

27) The presence of the word 'namely' in the specifications of the marks has the effect of limiting the goods covered by those registrations to 'boot cream, shoe wax' and 'shoe creams, shoe wax', respectively. I have no sales figures or advertising expenditure before me which relate specifically to those kinds of goods. However, I note that there are numerous references in the invoices to goods described as 'Tamaris shoe cream', 'Tamaris waterproofer' and 'Tamaris wax waterproofer' spanning the relevant period to countries in the European Union[6]. There are also images of such goods shown in the catalogue which is before me[7]. The goods themselves all bear mark 3, as registered. I also find that use to be acceptable variant use of mark 2, given that the stylisation is minimal and does not alter the distinctiveness of the word 'Tamaris' per se. I find that genuine use of marks 2 and 3 has been shown for footwear creams and footwear wax. The specification of those marks, as registered, is already quite specific and accurately reflects the use that has been shown before me. I find that the opponent is entitled to rely upon the specifications of marks 2 and 3, in class 3, as registered.

'Footwear' and 'shoes and boots' covered by marks 3 and 4, respectively

28) A table is provided which indicates that the opponent enjoyed sales of, on average, £3 million Euros per year between 2017 and 2021[8] in relation to footwear. There are also numerous invoices which are addressed to countries in the European Union and the UK[9], listing, what appears to be, pairs of shoes, spanning the relevant

[6] Exhibit 5, p. 18, 19, 20, 24, 25, 28, 32, 34, 42, 44-45 (for example)
[7] Exhibit 1, p.16-17
[8] Witness Statement of Jens Beining, [15]
[9] Exhibit 5

period. All of the invoices bear mark 3 (which I have already found also constitutes acceptable variant use of the word mark 'TAMARIS' and therefore constitutes use of mark 4). There are also images of various kinds of shoes and boots shown on the prints from the opponent's website[10] and the websites of third-party retailers who sell the opponent's shoes and boots in the UK[11]. Evidence showing a number of advertisements in magazines aimed at EU countries (and some specifically to the UK) is also provided. A number of these are dated within the relevant period and are in relation to 'Tamaris' shoes[12]. Further, there are details of numerous awards achieved by the opponent during the relevant period in relation to shoes in the EU[13]. I am satisfied that genuine use of marks 2 and 3 has been shown for shoes, boots and footwear generally. I find that the opponent is, therefore, entitled to rely upon 'footwear' for mark 3 and 'shoes and boots' for mark 4.

Section 5(2)(b)

29) This section of the Act 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.
>
> 5A. Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

[10] Exhibit 2
[11] Exhibit 3
[12] Exhibit 6
[13] Exhibit 10

trade mark is applied for, the application is to be refused in relation to those goods and services only."

30) The leading authorities which guide me are from the CJEU: *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

31) All relevant factors relating to the goods should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment that:

> "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."

32) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

(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 service;

(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 practice 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.

33) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

"It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.."

34) In *Sanco SA v OHIM* Case T-249/11, the GC found that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services was very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* (BL-0-255-13):

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

> ".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

35) The opposition under section 5(2)(b) of the Act, based upon marks 2 and 3, is not directed against Class 5 of the application. Accordingly, the only goods to be compared are:

Opponent's goods	Applicant's goods
Mark 2 **Class 3:** Shoe care products, namely boot cream, shoe wax. Mark 3	**Class 3:** Cosmetics; Beauty lotions; Beauty creams; Beauty serums; Beauty care cosmetics; Sunscreen; Hair care preparations; Fragrances.

Class 3: Boot polish, namely shoe creams, shoe wax.	

36) I will first consider the goods of the applicant which are underlined in the table above. I will then consider the remaining term, 'fragrances'.

37) I have no submissions before me from the opponent in support of its contention that its goods in class 3 are similar to the applicant's underlined goods. All of the applicant's underlined goods are for the purpose of beautification or care of the body. The opponent's goods are for the purpose of cleaning, protecting and caring for shoes. The respective goods are clearly different in nature, purpose and methods of use and any overlap in trade channels is likely to be minimal. They are also clearly not in competition or complementary. I find no similarity between the opponent's goods and the applicant's underlined goods.

38) Turning to the applicant's 'fragrances', the opponent contends that its goods are similar to those goods. It states that 'Given the very broad nature of this term, this could include fragrances for shoes and clothes which would be highly similar [to the goods of the earlier marks]'. The opponent provides no further submissions or evidence on the matter.

39) The applicant's term 'fragrances' in class 3 covers fragrances for use on the body, room fragrances and fragrances for laundry purposes. I can see nothing in the TMClass system[14] that refers to fragrances in class 3 which are specifically intended for use on shoes. The only fragrances I am aware of that are specifically for use on shoes would be 'shoe deodorisers' which fall within class 5, not class 3. The applicant's 'fragrances' do not, therefore, include 'shoe deodorisers'. It is also not obvious to me that the applicant's 'fragrances' in class 3 would, nevertheless, cover other kinds of fragrances that are similar to the opponent's goods. It seems to me

[14] Classification Assistance - TMclass (europa.eu)

that their respective nature, methods of use, intended purpose and trade channels are likely to be different and there is no competitive or complementary relationship in play and there is no evidence before to suggest otherwise. I find no similarity between the opponent's goods and the applicant's 'fragrances'.

40) **There cannot be a likelihood of confusion where there is no similarity between the respective goods[15]. Therefore, the opposition under section 5(2)(b) of the Act fails.**

Section 5(3)

41) Section 5(3) of the Act provides that:

> "(3) A trade mark which-
>
> (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

42) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows.

> (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

[15] *Waterford Wedgewood v OHIM*, Case C-398/07

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in

such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).*

43) The opponent has failed to satisfy the genuine use requirements for mark 1. It follows that it cannot rely upon that mark under this ground. As for the other marks relied upon, I have already found that the opponent has satisfied the genuine use requirements for some of the earlier goods (all goods in class 3 covered by marks 2 and 3, 'footwear' in class 25 covered by mark 3 and 'shoes and boots' covered by mark 4). In the interests of procedural economy, I intend to proceed on the assumption that the opponent has also shown genuine use in relation to all of the other goods and services relied upon under marks 2, 3, 4 and 5. This is because, what ultimately matters under this section of the Act, is that the earlier mark has the requisite reputation, not merely that the genuine use has been shown. It is clear, from the evidence before me, that the opponent does not have the requisite reputation in the UK in relation to all of the goods and services relied upon. Any reputation enjoyed by the earlier mark(s) in the UK is clearly, as explained below, in relation to footwear only.

Reputation

44) The opponent must show that it had the requisite reputation on the date the contested application was filed, being 29 October 2021. The evidence before me falls a long way short of establishing that the opponent has the requisite reputation in the UK in relation to all of the goods and services relied upon under this ground. Although I accept that there has been genuine use in relation to shoe wax and shoe creams, I have no evidence as to the turnover or advertising expenditure in relation to such goods and there is nothing in the evidence showing any recognition of the earlier marks in the form of awards or reviews or anything else of that nature (or similar) in relation to the same. There is also little in the way of advertising literature for those goods. The evidence in relation to the goods relied on in classes 14, 21, 18, 35 and 25 (other than footwear) is also deficient. While there is some evidence of advertising in catalogues and on the opponent's website of those goods, there is little else showing promotion of the earlier marks for those goods and services. Further, the 'income' figures provided[16], which relate to the whole of the EU, appear to be small in what is, undoubtedly a vast market. Bearing all of this in mind, I find no reputation in relation to any of the aforesaid goods or services. However, bearing in mind my earlier comments as to the use that has been shown in relation to footwear, there is sufficient evidence of sales, promotion and third-party recognition of the earlier mark in relation to 'footwear' and 'shoes and boots', covered by marks 3 and 4, respectively, to satisfy me that those earlier marks had a modest reputation in relation to those goods in the UK at the relevant date.

Link

45) Whether the public will make the required mental 'link' between the applicant's mark and either earlier mark must take account of all relevant factors. The relevant factors identified in Case C-252/07, *Intel* [2009] ETMR 13 are:

i) The degree of similarity between the conflicting marks

46) The respective marks are shown in the following table:

[16] Witness Statement of Jens Beining, [20]

Opponent's marks	Applicant's mark
Mark 3  Mark 4 TAMARIS	Tamarin

47) Both of the earlier marks are patently highly similar, both visually and aurally, to the contested mark despite the different final letter (I do not consider that the particular stylisation of mark 3, which is not present in the contested mark, disturbs this finding). Conceptually, the opponent submits that none of the marks have a concept. The applicant submits that, although the earlier mark is unlikely to evoke any concept, the contested mark has the concept of a type of monkey or a village in Mauritius. I do not agree that the latter concept of a place in Mauritius will be known by the average consumer in the UK. I accept that some average consumers may be aware that Tamarin is the name of a kind of monkey, but I would not expect those consumers to constitute a sufficiently significant proportion of average consumers. I would expect the vast majority of average consumers to perceive no meaning at all from the word Tamarin. It follows that I agree with the opponent that the marks must be considered to be conceptually neutral.

ii) The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

48) The relevant public is the general public.

49) I find that the goods in relation to which the earlier mark has a reputation are entirely dissimilar to all of the contested goods in classes 3 and 5. Their respective nature, intended purpose and methods of use differs, any overlap in trade channels

is likely to be minimal and they are not in competition nor complementary in the sense described in the case law.[17]

iii) The strength of the earlier mark's reputation

50) The earlier mark has a modest reputation for 'footwear' and 'shoes and boots' covered by marks 3 and 4, respectively.

iv) The degree of the earlier mark's distinctive character, whether inherent or acquired through use

51) The earlier marks will either be perceived as meaningless invented words or foreign words of unknown meaning. I find that they are both inherently highly distinctive in relation to the relevant earlier goods. I do not consider that that degree of inherent distinctiveness has been materially enhanced through use.

Conclusions on link

52) Whilst there is a high degree of visual and aural similarity between the respective marks and the earlier marks have a high degree of distinctiveness, the reputation enjoyed by the earlier mark is in relation to goods which are entirely dissimilar to those covered by the applicant's mark. Further, the strength of the earlier marks' reputation is only of a modest level and is insufficient, in my view, to bridge the gap between the respective goods. I find that neither earlier mark would be brought to mind when the relevant public is faced with the applicant's mark on the contested goods. The requisite link is not established. Without a link there can be no damage. I add here that I would have reached the same conclusion even supposing that I had found that the earlier marks had a reputation in relation to all/any of the other goods and services relied upon under this ground, bearing in mind that they are also obviously entirely dissimilar to the contested goods and any such reputation would, again, be no more than modest. I also would have come to the same conclusion even if I had found that the earlier marks' inherent distinctiveness had been

[17] See, for example, T-116/06, T-363/08 and T-435/17

enhanced through use in relation to ‘footwear’ and ‘shoes and boots’; any enhancement to the, already high, level of distinctiveness of those marks would not have disturbed my finding that there would be no link. **The opposition under section 5(3) of the Act fails.**

OVERALL OUTCOME

53) **The opposition fails.**

COSTS

54) As the applicant has been successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 2/2016, I award the applicant costs on the following basis:

Preparing a statement and considering the other side’s statement	£300

I order Wortmann KG Internationale Schuhproduktionen to pay My Brand Limited the sum of **£300**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of September 2023

Beverley Hedley
For the Registrar,
the Comptroller-General