

TRADE MARKS ACT 1994

**IN THE MATTER OF UK trade mark application 2491277
by Icebreaker Ltd to register the mark
ICEBREAKER REALFLEECE in Classes 24 and 25**

**AND IN THE MATTER OF Opposition No. 98571
by Gilmar SpA**

**Appeal of the Applicant from the decision of
Mrs. Ann Corbett dated 26 May 2010**

DECISION

1. This is an appeal against a decision of Mrs Ann Corbett, the Hearing Officer for the Registrar, dated 26 May 2010, in which she rejected an opposition to the registration of the mark ICEBREAKER REALFLEECE for goods in Classes 24 and 25. The applicant was Icebreaker Limited, (“Icebreaker”) and the opponent Gilmar SpA (“Gilmar”).

Background

2. On 27 June 2008, Icebreaker applied under No. 2491277 for registration of the word trade mark ICEBREAKER REALFLEECE, claiming a priority date of 17 June 2008 based on an application in New Zealand, for “Fabrics, all being made wholly or principally of real woollen fleece” in Class 24 and “Clothing; footwear; headgear; all being made wholly or principally of real woollen fleece” in Class 35.
3. Notice of Opposition to the Class 25 goods was filed on behalf of Gilmar based on sections 5(2)(b) and 5(4) of the Act. The earlier registration upon which Gilmar relied was UK mark no. 1175324 for the word/device mark shown below, which mark is registered for “Articles of clothing; but not including footwear other than woven or knitted footwear” in Class 25.



4. In addition, Gilmar opposed the Icebreaker application pursuant to section 5(4)(a), on the basis of unregistered rights it claimed to have in a number of marks, ICEBERG, SPORT ICE, ICE JEANS, ICE ICE ICEBERG, ICE J, ICE B and ICE ICEBERG, all of which were said to have been used in relation to clothing.
5. Both parties filed evidence and written submissions, but no hearing was sought.
6. The Hearing Officer rejected the opposition and Gilmar (having changed its trade mark attorneys) appealed on the basis of both section 5(2)(b) and 5(4)(a). Icebreaker took no part in the appeal but Gilmar was represented at the hearing before me by Dr Peter Colley.

Grounds of Appeal

7. The main points on the appeal were
 - (a) that the Hearing Officer had failed to carry out a proper analysis of the relevant factors to be weighed in the global appreciation of the likelihood of confusion for section 5(2)(b), in particular in finding only a low level of visual, aural and conceptual similarity between them; and
 - (b) that she was wrong to find that there was no evidence of Gilmar's reputation in the UK in its various ICE marks.

Relevant parts of the Hearing Officer's decision

8. Gilmar's mark was subject to the Trade Marks (Proof of Use, etc.) Regulations 2004. The Hearing Officer therefore first considered whether genuine use had been proved by the witness statement of Massimo Marani, Gilmar's Chief Financial Officer, who stated that Gilmar first started using the mark ICEBERG in relation to clothing in the UK in 1982. He gave details of sales of both clothing and accessories, and of marketing expenditure, during the relevant period. The Hearing Officer found that there had been genuine use of the earlier mark in relation to "articles of outer clothing", albeit the evidence as to use appears to have shown use of the word Iceberg, rather than use of the mark in the form in which it was registered. That finding was not appealed by either side.
9. The Hearing Officer then considered the similarity of the goods, in the light of that finding as to the extent of use of the earlier mark. She found that "articles of outer clothing" is a subset

of “clothing” and could include clothing made wholly or principally of real woollen fleece, so the goods were identical.

10. Next, the Hearing Officer found that the relevant public for the goods was the general public and the goods were everyday consumer goods which may be bought in a variety of ways, e.g. in a retail store, online or by mail order, and with some, though not necessarily the highest, degree of care. She followed the usual approach of holding that by reason of the manner in which clothing is normally purchased, it is the visual impression of the marks that is the most important.

11. Moving on to consider the similarity of the marks and the likelihood of confusion, the Hearing Officer referred to the usual authorities and said:

“36. Icebreaker’s mark consists of two elements: the words ICEBREAKER and REALFLEECE. REALFLEECE naturally breaks down into the two descriptive words, REAL and FLEECE and thus the word ICEBREAKER is, in my view, the dominant and distinctive element within the mark ... Gilmar’s mark also consists of two elements: the word ICEBERG which is presented within a lozenge shaped border. ... the word ICEBERG is the dominant and distinctive element within this mark.

37. Both marks start with the letters I-C-E-B. Gilmar submits that “the next two letters in the mark ICEBERG, “E” and “R” are also found as the fifth and sixth letters of the mark applied for, albeit with their sequence reversed.” Whilst this is not disputed by Icebreaker, I do not think this increases the degree of similarity between the marks. Icebreaker’s mark consists of two, ten letter words whereas Gilmar’s mark is a single, seven letter word. In my view, whilst both marks start with the same four letters, and have a degree of visual similarity because of it, the degree is an extremely low one given the clear differences in the marks.

38. From an aural perspective, similar considerations apply. As both marks start with the same four letters there is a degree of aural similarity however Icebreaker’s mark consists of two separate words of three and two syllables respectively whereas Gilmar’s mark consists of a single two syllable word. The marks have an extremely low degree of aural similarity.

39. The word ICEBERG is an ordinary dictionary word with a well known meaning of a body of ice floating in the sea. ICEBREAKER is also an ordinary dictionary word. It may bring to mind a type of boat which is reinforced to enable it to clear a passage

through frozen waters or, alternatively may be recognised as something that eases the flow of conversation at e.g. a social event. REALFLEECE is not, as far as I know, a dictionary word but naturally breaks down into its component parts and brings to mind wool which has been sheared from a sheep or similar animal. When taken as a whole, Icebreaker's mark brings to mind something made of a fleece and which will keep out the cold in icy weather. To the extent that both marks have something to do with ice there is a degree of similarity from a conceptual viewpoint however in my view that similarity is again extremely low in the overall comparison of the respective marks."

The distinctive character of the earlier mark

40. The mark ICEBERG is said by Mr Marani to have been first used in the United Kingdom, in relation to clothing, in 1982. Turnover figures are given which range from €1,114,077 in 1998, generally staying around the €1.5m mark for the years 1999 to 2004 before dropping to €185,514 and €249,061 in 2007 and 2008 respectively. Whilst nothing has been provided which allows me to determine the size of the relevant market as a whole it is likely that Gilmar's share, based on the turnover figures given, is extremely small. Invoices provided at MM25 show sales to 3 stores in the London and Essex areas. Whilst advertising figures have been given, they are said to relate to a wide range of goods sold under the mark and do not allow me to establish how much, if any, was spent on marketing clothing as opposed to other goods. Whilst it is clear the mark has been used I am unable to say on the basis of the evidence filed that the distinctiveness of the mark has been enhanced through that use such that it has any reputation. That said, whilst the word ICEBERG is a dictionary word, it has no particular meaning in relation to the goods and is therefore inherently distinctive.

Likelihood of confusion

41. In reaching a decision on whether there is a likelihood of confusion, I must make a global assessment based on all relevant factors. I have found that identical goods are involved and that there is an extremely low degree of similarity from the visual, aural and conceptual viewpoints. On a global appreciation and considering all relevant factors including imperfect recollection, I consider the differences between the marks outweigh the similarities such that there is no likelihood of confusion. The

average consumer would not mistake one mark for the other nor be confused as to the economic origin of the goods sold under the respective marks. The opposition based on section 5(2)(b) of the Act therefore fails.”

12. The Hearing Officer then considered the section 5(4)(a) objection and the relevant law. It is not suggested that she misdirected herself. She noted that as the applicant had relied on use of its mark in advance of the filing date of his trade mark application, the relevant date for consideration of the objection was the filing date, 27 June 2008. Moving on to the evidence she held:

“46. Under this ground, Gilmar relies on seven earlier rights. In its Notice of Opposition, Gilmar refers to its earlier rights ICEBERG, SPORT ICE, ICE JEANS, ICE ICE ICEBERG, ICE J, ICE B and ICE ICEBERG. It says that each of these marks was first used in the UK in 1982 in relation to “a wide range of clothing and fashion accessories”. It goes on to say that “[a]s a result of its use of the marks containing the element “ICE”, the opponent has acquired a reputation in such marks and the mark applied for is likely to be taken as another mark in the opponent’s range. It is also likely to be confused with the mark ICEBERG for the reasons given in relation to the ground of opposition based on UK registration no. 1175324”.

47. I have already found, at paragraph 40 above, that Gilmar’s evidence of use of its mark ICEBERG is insufficient to find it has a reputation in respect of clothing. The reputation it claims under this ground is said to extend to “fashion accessories” but nowhere in its Notice of Opposition (nor indeed in its written submissions) does Gilmar set out what these “fashion accessories” might be nor is whatever Gilmar intends it to mean explained in any way.”

13. Having referred to the need for precision and clarity in a party’s pleaded case the Hearing Officer continued:

“49. The term “fashion accessories” is one that could cover any number of goods. Absent specific information I am left to guess at what goods are relied upon by Gilmar. That is not a position from which I can make a determination. Gilmar has failed to establish that its earlier right ICEBERG has the requisite goodwill or reputation and therefore the objection under section 5(4)(a) based on this right fails.

50. The remaining six marks relied upon under this ground, I will deal with together. Again, I have no idea what “fashion accessories” Gilmar relies upon, however, in respect of its claim to have a reputation for each of these earlier rights in relation to “clothing”, the evidence simply does not support it. Whilst there are some, very limited, references in the evidence to some of the earlier rights claimed, (see e.g. exhibit MM32, page 815 (ICE JEANS) and page 889 (ICE ICE ICEBERG), exhibit MM27 page 417 (ICE J), page 414 (ICE B) and page 550 (ICE ICEBERG)) I have no evidence of e.g. turnover or marketing expenditure for any of the individual rights relied upon nor any evidence of where, when or on what particular goods they may have been used. In view of this, Gilmar’s claim that “the mark applied for is likely to be taken as another mark in [Gilmar’s] range” does not even get off the ground. The objection under section 5(4)(a) fails in its entirety.”

The standard of review

14. The standard of review for this appeal is helpfully set out at paragraphs 5-6 of the decision of Daniel Alexander QC in *Digipos Store Solutions Group Limited v. Digi International Inc* [2008] RPC 24:

"5... It is clear from *Reef Trade Mark* [2003] RPC 5 ("*Reef*") and *BUD Trade Mark* [2003] RPC 25 ("*BUD*") that neither surprise at a Hearing Officer’s conclusion nor a belief that he has reached the wrong decision suffice to justify interference by this court. Before that is warranted, it is necessary for this court to be satisfied that there is a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong (*Reef*). As Robert Walker LJ (as he then was) said:

"...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle" (*Reef*, para. 28)

6. This was reinforced in *BUD*, where the Court of Appeal made it clear that it preferred the approach of the appellate judge but nonetheless held that there was no error of principle justifying departure from the Hearing Officer’s decision. As Lord Hoffmann said in *Biogen v. Medeva* [1997] RPC 1 at 45, appellate review of nuanced assessments requires an appellate court to be very cautious in differing from a judge’s evaluation. In the context of appeals from the Registrar relating to section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average

consumer or giving too much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference.”

The decision with regard to each of the issues in this case involved a multi-factorial assessment of the kind mentioned above.

The appeal on the 5(2)(b) grounds

15. Gilmar’s first major point on the appeal was that the Hearing Officer had been wrong to give any weight at all to the presence of the word "Realfleece" in Icebreaker's mark, because it consists merely of two descriptive words and has no trade mark significance. Dr Colley, who appeared for Gilmar, submitted that "Realfleece" should have been “effectively ignored” for the purpose of comparing the marks. That submission perhaps went further than the Grounds of Appeal, which suggested that "Realfleece" had only “*de minimis* trade mark significance.”
16. I do not accept that "Realfleece" should have been ignored by the Hearing Officer. It is well-established law (following *Sabel*, in particular) that the Hearing Officer was obliged to assess the visual, aural and conceptual similarities of the marks as a whole, and the overall impression of each of them, although she also had to bear in mind the distinctive or dominant component (if any) of each mark. In my judgment it is clear that she did both of these things. She would have been wrong to ignore “Realfleece” completely. Nevertheless, she found that "Realfleece" had less significance in Icebreaker’s mark than “Icebreaker” and that led to her findings in paragraph 36 as to the respective dominant elements of the two marks. In paragraph 6 of the Grounds of Appeal, Gilmar agreed that this was a correct analysis. In the circumstances, her analysis in relation to the impact of “Realfleece” does not seem to me to disclose any appealable error of principle.
17. In paragraph 7 of the Grounds of Appeal, Gilmar complained that the Hearing Officer failed to appreciate the dominance of "Ice" as the first syllable in both of the marks, and the visual, aural and conceptual significance of that syllable, such that she ought to have concluded that there was strong visual similarity, not the “extremely low” level of similarity found by the Hearing Officer.

18. The first difficulty with this submission is that it seems to me effectively to challenge the Hearing Officer's finding as to the dominant feature of each of the marks, which Gilmar had specifically accepted. Dr Colley referred me to the decision of the General Court in Case T-183/02 & T-184/02, *Mundicor/Mundicolor*, suggesting that this showed the proper approach to the assessment of the visual similarities between marks. That may be so, but it does not seem to me that the decision shows that approach taken by the Hearing Officer in this case was incorrect. She gave due consideration (as did the Court in *Mundicor*) to the importance generally attributed to the first part of the words, as well as due consideration to the differences between the words. In my judgment, there is nothing in the decision which suggests that there was any error of principle in the Hearing Officer's analysis in this case. Whether or not another hearing officer might have come to a different conclusion, there is no error of principle such that I should revisit the question of the level of visual similarity between the marks in this appeal.
19. Again, as to visual similarity, Gilmar submitted that it was wrong for the Hearing Officer to take into account the word "Realfleece" in comparing the length of the marks, but for the reason I have already given I do not accept that the Hearing Officer erred in this respect.
20. In addition, Gilmar complained about the Hearing Officer's assessment of the visual similarity of the marks because she was said to have disregarded a decision of the OHIM Fourth Board of Appeal of 15 January 2009 (R 1536/2007-4) drawn to her attention by Gilmar in its written submissions. This was a decision which related to an application by Icebreaker to register the word "Icebreaker" as a CTM for the same classification of goods, which was opposed by Gilmar on the basis of a number of earlier marks. The opposition succeeded on the basis of an Italian mark, Iceberg, and was upheld by the Board of Appeal. Icebreaker subsequently appealed to the General Court and the decision of the Board of Appeal was upheld (Case T-112/09, *Icebreaker Ltd v OHIM*, 8 September 2010). Gilmar had referred to the Board of Appeal's decision in its written submissions, and submitted to me not only that the Hearing Officer had erred in failing to refer to it, but that she should have considered the decision as offering helpful guidance for the approach to be adopted in this opposition.
21. On the one hand, it is right to say that the Hearing Officer did not refer to the Board of Appeal's decision and perhaps it would have been helpful had she explained why she did not

do so. On the other hand, it is a well-established rule that decisions on the same or similar marks made by OHIM or other registries are not binding upon the UK Registry (and *vice versa*), any more than is evidence of the state of the UK Register, because the circumstances relevant to an application even for the same mark may differ from one jurisdiction to another and from one time to another. See e.g. *British Sugar* [1996] RPC 281, Case C-238/06 *P Develey Holding GmbH & Co Beteiligungs KG v OHIM*, [2007] E.C.R. I-9375 and Case C-488/06 *P L&D SA v OHIM* [2008] E.T.M.R. 62.

22. Moreover, the marks in issue in the Case T-112/09 were not the same as the marks in this case: Icebreaker sought to register just the word “Icebreaker,” (which, oddly enough, it has successfully registered in the UK *inter alia* for goods in Class 25), not the two words “Icebreaker Realfleece.” On the basis that the Hearing Officer was right, as I think she was, not to ignore the second word of the mark now under consideration, it seems to me that the analysis of the similarity of the marks which she had to carry out was not the same as the analysis carried out by OHIM and approved on appeal.
23. In addition, the OHIM opposition centred on Gilmar’s Italian trade mark, in which it had acquired distinctiveness. OHIM and the Board of Appeal found “a considerable level of visual similarity” between the marks. The opposition division considered the marks would appear conceptually different to English speaking consumers, whilst the Board of Appeal found less than average aural similarity, and that for *Italian* consumers who did not understand English, a conceptual comparison could not be made. Each of these points was approved by the General Court. In the circumstances, I doubt that the decision of the Board of Appeal would have caused the Hearing Officer in this case to change her mind as to the similarities between *these* marks as perceived by the average *UK* consumer. In my judgment, therefore, even had the Hearing Officer considered the Board of Appeal decision, it would not have had any impact upon her assessment of the issue of the similarity of these marks.
24. Gilmar’s submissions as to the Hearing Officer’s findings on aural similarity were based on essentially the same points as those on visual similarity. Again, I do not find that the Hearing Officer erred in her approach to this point, and I do not consider it appropriate for me to revisit the point on appeal.

25. As to conceptual similarity, again, Gilmar argued that the Hearing Officer put too much emphasis on the impact of “Realfleece” as part of the mark applied for, and insufficient emphasis on the fact that the words Iceberg and Icebreaker both conjure an image of a bitterly cold environment. I accept that the conceptual similarity between the two words does not just reside in the first syllable, Ice, so that the marks are more similar than, for instance, “Iceberg” is to “Ice-lolly.” However, I do not think that there was any error of principle alleged, nor do I find that any such error was made by the Hearing Officer in the reasoning which she set out at paragraph 39 of her decision.
26. Dr Colley submitted, however, that the average consumer in the United Kingdom ought, in the light of the international nature of the market for clothing in London be deemed to include many whose understanding of English is not good, such that the distinction between an iceberg and an icebreaker might be less clear to them. If so, then the decisions of the Board of Appeal and the General Court in relation to Icebreaker’s CTM application arguably would have been of more relevance to this case. However, I do not accept that the average consumer for this purpose should be deemed to be someone whose mother tongue is not English. In Case C-421/04, *Matratzen Concord AG v Hukla Germany SA*, Case, [2006] E.C.R. I-2303; [2006] E.T.M.R. 48, the question was whether a mark registered in Spain for a variety of bedding goods including mattresses was invalid because it consisted of the German word “Matratzen,” which means mattress. The position under Spanish law is (or was) that names borrowed from foreign languages are seen as fanciful, unless they resemble a Spanish word, so that the average consumer would understand their meaning, or the mark had acquired a genuine meaning on the national market. The European Court of Justice essentially approved that position. The UKIPO’s position, as set out in Practice Amendment Notice 12/06 following *Matratzen*, is that marks consisting of a descriptive word in another European language will be refused registration only if the average UK consumer is likely to recognise them as such. In BL O/25/05, *Acqua di Gio*, Mr Geoffrey Hobbs QC sitting as the Appointed Person said at paragraph 29 “the impact of a word mark on speakers of English should be used to determine whether it is acceptable for registration in the United Kingdom on absolute and relative grounds.” In my view, therefore, the Hearing Officer was right to consider issues of similarity from the standpoint of the average English speaking member of the UK public, and the possibility that the concept of the two marks might not be assessed in the same way by non-English speaking consumers would have been irrelevant to the decision she had to make.

27. Next, Gilmar submitted that the Hearing Officer had erred in failing to find that its mark had acquired enhanced distinctiveness in the United Kingdom because of the use which had been made of it since 1982. For the reasons given below as to the appeal on the section 5(4)(a) grounds, in my view, that is a justified criticism of the HO's decision. However, it does not seem to me that this point was material to the Hearing Officer's assessment of the likelihood of confusion, as she found that Gilmar's word mark was in any event inherently distinctive.
28. For all these reasons it does not seem to me that there were material errors or errors of principle in the Hearing Officer's findings as to the likelihood of confusion and the appeal is refused in relation to the section 5(2)(b) objection.

The appeal under section 5(4)(a)

29. Gilmar's opposition pursuant to section 5(4)(a) was based upon a claim to earlier unregistered rights not just in the mark Iceberg, but also in the marks Ice Iceberg, Ice Ice Iceberg, Sport Ice, Ice Jeans, Ice J and Ice B, which it claimed to have acquired by use of those marks on clothing and fashion accessories. It relied in its statement of Grounds of Opposition upon the common element of the marks, namely ice, being contained in the Icebreaker mark, which it said was likely to lead to confusion. Gilmar filed evidence as to its UK sales and promotion, together with 5 full lever-arch files of exhibits, mainly copies of catalogues and press cuttings. Nevertheless, the Hearing Officer found that it had not proved that it had a reputation or goodwill in the United Kingdom in respect of either clothing or accessories in any of the marks. Gilmar challenged that finding in the light of the evidence which it had filed.
30. The Hearing Officer cited the decision of Mr Hobbs QC in *Wild Child trade mark* [1998] R.P.C. 455; it is also useful to bear in mind the guidance of Pumfrey J in *REEF Trade Mark* [2002] RPC 19 as to the difficulty of "assessing a passing off claim on paper" as will normally happen in the Registry. Pumfrey J's view was that the Registrar should be presented with evidence which at least raises a *prima facie* case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. Evidence of reputation would come "primarily from the trade and the public, and will be supported by evidence of the extent of use." More recently, Jacob LJ explained in *Phones4U Ltd v Phone4u.co.uk Ltd* [2007] R.P.C. 5

at [5], that a passing off claimant needs to establish that he has built up a goodwill which the defendant is invading by a misrepresentation and accordingly what matters is what the claimant did to create a goodwill. At [33], Jacob LJ said that showing what had actually been done to publicise the name or badge relied upon was the key evidence, and expert evidence was not required to infer from the proved use that the name must have been known to a substantial section of the public. As he explained, the test for establishing goodwill for the purposes of passing off is not the same as the test for establishing that a descriptive mark has acquired a distinctive character for the purposes of registration.

31. The Hearing Officer referred in paragraph 40 of her decision to the figures provided by Gilmar and commented that that its share of the clothing market in the UK was likely to be extremely small. That strikes me as a fair comment, given the enormous size of that market, a point on which there is no evidence filed, but which seems to me to be something of which both the Hearing Officer and I could take judicial notice.
32. Nevertheless, it seems to me that the Hearing Officer erred in failing to distinguish between the question of whether Gilmar had proved that it had enhanced the inherent distinctiveness of its Iceberg mark, for the purposes of the global appreciation of the likelihood of confusion for section 5(2)(b), and the question of whether Gilmar had goodwill in its Iceberg mark or any other "Ice" marks for the purpose of establishing goodwill sufficient to found a passing off action at the relevant date, for section 5(4)(a). Having found no such enhanced distinctiveness in paragraph 40 of her decision, the Hearing Officer simply extrapolated that finding into the consideration of goodwill in paragraph 47.
33. In paragraph 5 of his witness statement, Mr Marani referred to annual sales figures in Euros for the sales of clothing and accessories in the United Kingdom from 1998 to 2008. These are set out in his exhibit MM1, which consists of a table which separated out goods sold under the mark Iceberg and goods sold under the "Ice Lines" (although he did not explain into which of these categories "Ice Iceberg" or "Ice Ice Iceberg" fall). He also separated sales of "wear" from sales of "accessories." It is clear from his statement that references to sales of "wear" were to sales of clothing, and that is reflected by the figures set out under paragraph 23 and in paragraph 40 of the Hearing Officer's decision. The figures set out in the table show broadly increasing sales of clothing under the Iceberg mark between 1998 and 2002, the highest figure being €1.6 million for 2002, with declining sales from 2003 onwards; sales

dropped to a minimum level of €185,000 in 2007 and picked up a little in 2008 to €249,000. Sales of clothing in the "Ice Lines" also declined after 2002, the peak year for sales having been 2000 when the sales were €6.7 million. In 2003, sales had dropped to €4.5 million and thereafter continued to fall to €473,000 in 2007 and €299,000 in 2008. Turnover achieved in relation to accessories was at all times far less than sales of clothing.

34. Mr Marani produced a number of copy invoices, showing sales of modest numbers of goods, mainly but not solely to traders with addresses in London, and print-outs of lists of distributors showing some geographical spread. Customers included Harvey Nichols and Harrods.
35. Mr Marani also addressed the question of advertising, in terms both of the sums spent upon it, and the nature of the advertising which had been carried out. The Hearing Officer rightly commented that the figures given for amounts spent on advertising were not broken down, as sales figures had been, between clothing and accessories. Nevertheless, the overall amounts spent on advertising were not inconsiderable for a number of relevant years, whether the sums are given in Euros or in sterling (which Mr Marani did not say). Moreover, Mr Marani also produced, as I have said, numerous examples of advertisements and editorial coverage. These show advertisements or editorial coverage in magazines, dated and with circulation figures, some in publications with a substantial circulation such as Elle, Marie Claire, The Sunday Telegraph, and Harper's Bazaar.
36. In addition, Mr Marani produced copies of glossy brochures for Iceberg goods, which he said had been distributed to distributors and others in the UK. However, he gave no indication of how many such catalogues had been distributed, and it is impossible to tell whether they would have contributed meaningfully to building up a reputation or goodwill in the UK, and I note that some of them appear only to be in Italian and give no UK address.
37. A further factor which Dr Colley drew to my attention at the hearing was the evidence as to Gilmar's retail presence in the UK which could be ascertained by close scrutiny of the exhibits to Mr Marani's witness statement. For instance, exhibits MM3 and 5 were copies of the Iceberg catalogues for Spring/Summer 2000 and Spring/Summer 2002, which gave an address for an Iceberg boutique in Sloane Street and a showroom at 23 Old Bond Street. Later catalogues exhibited either do not include copies of pages listing the

shops/showrooms, or (as for the Fall/Winter 2003/4 and Spring/Summer 2006 collections) the lists show no London shop or showroom. Dr Colley showed me that the documents exhibited by Mr Marani continued to show goods being delivered to the same Bond Street address, but it is not possible, without an explanation from Mr Marani, to tell whether this amounted to a retail presence in the UK. The picture seems to me to follow the decline in Iceberg's turnover shown in Mr Marani's sales figures.

38. In my view, the evidence established that Gilmar had enjoyed a reasonable level of success in the UK with its Iceberg goods up to 2002, though its business had subsequently declined. As the Hearing Officer pointed out, its turnover was small in relation to the overall size of the clothing/accessories market. Gilmar failed to adduce any third party or trade evidence substantiating its claim to goodwill. However, the absence of trade evidence is not necessarily fatal if other evidence which has been adduced establishes that it had a sufficient goodwill. It seems to me that this is the case here, in relation to the Iceberg mark used in relation to clothing. In the light of the evidence of its turnover and advertising activities, it seems to me that Gilmar would have acquired some goodwill in relation to the Iceberg mark by around 2002 at least. Although sales peaked some years before the relevant date in June 2008, the evidence shows clearly that Gilmar continued to trade in the goods in the UK and to advertise them here, so it had not abandoned the goodwill, nor is the goodwill likely to have been lost. In the circumstances, it seems to me that the Hearing Officer was wrong to find that Gilmar had no goodwill in the Iceberg mark at the relevant date.
39. On the other hand, although Mr Marani set out the company's turnover and provided copy catalogues relating to each of the additional Ice/Iceberg marks, in my view the evidence fell far short of establishing clearly the extent to which each of Gilmar's other marks was used in the UK during the relevant period. Mr Marani accepted that use of "Sport Ice" had ceased as long ago as 1998, and that "Ice B" or "Ice J" (though not, I think, "Ice Jeans") were only used in conjunction with "Iceberg". In the circumstances, I do not think that it can be said that the Hearing Officer's comment in paragraph 50 of her decision was wrong; it seems to me that although there may have been substantial turnover in some of those marks, it is impossible to say which (if any) of them had acquired a goodwill of their own, independent of the Iceberg mark. Nevertheless, given the link between at least some those marks and Iceberg, it seems possible that use of them enhanced the goodwill in Iceberg.

40. The Hearing Officer took the view that Gilmar had not explained what goods it sought to describe as “fashion accessories” in its statement of grounds of opposition or its written submissions. That is correct. However, Mr Marani explained at paragraph 4 of his witness statement what was meant by accessories and at paragraphs 15-19 he referred to sales of accessories, especially sunglasses. His exhibit MM37 showed advertisements for Iceberg sunglasses on the side of London buses in 2008. The Hearing Officer had picked up that point at paragraph 25 of her decision but did not reflect it in paragraphs 47, 49 or 50, in which she reiterated that she had no idea what fashion accessories Gilmar relied upon. In this respect, therefore, in my judgment she erred in that respect also. However, the evidence shows a relatively modest turnover in relation to accessories and I cannot tell from the evidence how much, if any, of the sums spent on advertising related to accessories, apart from the one bus campaign. In the circumstances, it does not seem to me that Gilmar’s evidence established a separate goodwill in relation to accessories, nor is there any evidence to support the suggestion that any goodwill which might have accrued in respect of accessories, and especially accessories such as sunglasses, would have enhanced the goodwill in relation to clothing.
41. For these reasons, in my view, Gilmar has shown that it had goodwill by 27 June 2008 in respect of the Iceberg mark but not its other marks, and in relation to clothing but not accessories.
42. To succeed under section 5(4)(a), however, goodwill is not enough. Gilmar needs to show that use of the mark “Icebreaker Realfleece” would amount to a misrepresentation likely to lead the public to believe that clothing, footwear, or headgear ‘made wholly or principally of real woollen fleece’ is made by the opponent or connected in the course of trade with it. The Hearing Officer’s decision as to the similarity of the marks for the purposes of section 5(2)(b) is not decisive as to this issue, as the tests to be applied under sections 5(2)(b) and 5(4)(A) are not identical. Nevertheless, in my view, normal and fair use of the mark Icebreaker Realfleece would not be likely to amount to an actionable misrepresentation. In the absence of satisfactory evidence that Gilmar’s goodwill extends to some or all of its “family” of Ice and Iceberg marks, it seems to me that the applicant’s mark would not be likely to be confused by members of the relevant public with the Iceberg mark, nor would the public be likely to think that the goods bearing the Icebreaker Realfleece mark were connected in the course of trade with Gilmar.

43. In the circumstances, the appeal also fails in relation to the section 5(4)(a) grounds.
44. Icebreaker Ltd took no part in the appeal. In the circumstances, I will make no order as to the costs of the appeal.

Amanda Michaels
7 March 2011

Dr Peter Colley instructed by Potter Clarkson LLP appeared on behalf of the Appellant, Gilmar SpA

The Respondent did not appear and was not represented.