

O-115-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2511020  
BY CBN ONE OF THE BOYS APPAREL INC  
TO REGISTER THE FOLLOWING MARK IN CLASS 25:**

**MIRACLE FIT**

**AND**

**OPPOSITION THERETO (NO. 99612) BY  
A&H SPORTSWEAR CO INC**

## **TRADE MARKS ACT 1994**

**In the matter of application no. 2511020 by CBN One Of The Boys Apparel Inc to register the trade mark MIRACLE FIT in class 25**

**and**

**Opposition thereto (no. 99612) by A&H Sportswear Co Inc**

### **The background and the pleadings**

1) Trade mark application 2511020 is for the mark MIRACLE FIT and it was filed on 13 March 2009 by CBN One Of The Boys Apparel Inc (“CBN”). The application was published in the Trade Marks Journal on 10 July 2009. CBN seeks registration in respect of the following goods in class 25:

Clothing; clothing, namely, jeans, pants, slacks, trousers, jumpers, overalls, sweat pants, jogging pants, track pants, shorts, suits, skirts, dresses, tops, shirts, t-shirts, polo shirts, blouses, camisoles, tank tops, halters, sweaters, vests, cardigans, jerseys, sweat shirts, uniforms, outerwear, coats, raincoats, trench coats, jackets, jean jackets, ponchos, blazers, pullovers, sportswear, exercise wear, shape wear, namely, body suits, brassieres, girdles, panties, waist cinchers, tummy tuckers, compression garments, tummy trimmers and waist trimmers, sleepwear, lingerie, nightgowns, robes, bathrobes, pyjamas, undergarments, undershirts, underwear, boxer shorts, socks, leggings, tights, swimwear, beachwear and bathing suits.

2) On 8 October 2009 A&H Sportswear Co Inc (“A&H”) opposed the registration of CBN’s application. It opposes the application in respect of all the goods sought to be registered. The opposition is under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). A&H relies on three trade marks of which it is the proprietor, namely:

UK registration 2019409 for a series of 2 trade marks consisting of the word MIRACLESUIT (stylised and plain words);

Community trade mark (“CTM”) 00043018 for the mark MIRACLESUIT;

CTM application 005981238 for the mark MIRACLEBODY which was converted (following withdrawal of the CTM) to UK application 2559441.

3) All of these marks have dates of filing prior to that of CBN’s application. They all qualify as earlier marks to that extent. The MIRACLEBODY mark has yet to achieve registration in the UK, this means that if I find in A&H’s favour to any material extent on the basis of this earlier mark then my decision will be

provisional pending the registration of that mark. It is not in dispute that both MIRACLESUIT registrations are subject to the proof of use provisions contained in section 6A of the Act<sup>1</sup>. A&H made a statement of use that it has used its marks in relation to all of the goods for which they are registered, namely:

2019409 - Underwear; hosiery; swimwear.

CTM 43018 - Clothing, namely swimwear, various items of underclothing and hosiery and shapewear, namely, girdles and other shape-controlling apparel; bodysuits, leotards and leggings.

4) The MIRACLEBODY mark has been advertised with the following specification which, subject to successful registration, must be taken into account without any requirement to prove use:

Clothing; footwear; headgear; women's jeans, slacks, trousers, skirts, dresses, blouses, tops and swimwear; and men's tailored clothing, suits, slacks, jeans and swimwear.

5) CBN filed a counterstatement denying the grounds of opposition. It asked A&H to provide proof of use in respect of its registered marks. Both sides then filed evidence and the matter then came to be heard before me on 3 February 2011. At the hearing A&H were represented by Mr Mark Engelman, of Counsel, instructed by Wildbore & Gibbons. CBN were represented by Mr John Groom of Groom Wilkes and Wright LLP.

6) In this decision the relevant date for assessing whether there exists a likelihood of confusion is the date of application of CBN's trade mark, namely 13 March 2009. The relevant period for the assessment of proof of use is the five year period ending on the day on which CBN's mark was published, namely, 11 July 2004 to 10 July 2009.

### **The evidence**

#### **Witness statement of Mr Mark Waldman dated 21 May 2010**

7) Mr Waldman is A&H's chief executive officer. His evidence relates, primarily, to the use that has been made of the MIRACLESUIT and MIRACLEBODY trade marks. Mr Waldman states that both marks have been in use in the UK since 2004. The MIRACLESUIT mark is said to be used in relation to underwear and swimwear and the MIRACLEBODY mark in relation to outer garments. It is clear from the evidence that the goods sold under both marks are manufactured in

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<sup>1</sup> The requirements relating to proof of use are contained in section 6A of the Act, which was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

such a way so as to shape the body, for example, to make the wearer look slimmer. At Exhibit MW2 there is an extract from the website of Patricia Eve Limited showing use of MIRACLESUIT swimwear, MIRACLESUIT shapewear (underwear with “extra firm control, bring you down by a dress size”), and MIRACLEBODY jeans (that apparently make the wearer look 10lbs lighter). Also included is an extract from [www.figleaves.com](http://www.figleaves.com) (the letters “UK” appear in the full URL which gives this webpage UK provenance) showing MIRACLESUIT shapewear (an underwear garment covering the waist and the thighs), MIRACLESUIT control swimsuits and MIRACLEBODY jeans. All of the pages making up this exhibit were printed on 17 February 2010. There is nothing to establish that these pages were in existence before the relevant date or during the relevant period. The Figleaves pages have copyright dates of 2010. The Patricia Eve prints have a copyright date of 2009 but when in 2009 is not known.

8) A large number of invoices are provided in Exhibit MW2. The invoices are from Mainstream International Corp (“Mainstream”), albeit sometimes using its trading name of Miraclesuit by Swim Shaper. The invoices are to various UK companies. Mainstream is described as a sister company of A&H. A&H engages in the manufacturing side and is the owner of all trade mark rights and registrations. Given that the context of the evidence relates to both MIRACLESUIT and MIRACLEBODY, it must be assumed that the invoices relate to both. There is, though, nothing contained in the invoices which enables me to differentiate between the two marks. All that is listed are various style numbers, colours and sizes. Although one of the invoices is from 2002 they date, in the main, from 2004 through to 2009. Sales figures are provided which are stated to be in respect of both marks. The figures are: £461 (2004), £135,212 (2005), £644,755 (2006), £830,865 (2007), £462,641 (2008) and £357,619 (2009).

9) Reference is made to advertising in various publications including: the Daily Mail, The Daily Express, Lingerie Buyer, OK Magazine, The Daily Telegraph, Underlines, The Daily Mirror, Womens Way, Good Housekeeping, Closer, Shape Up, Women & Home, The Sunday Independent and Swimwear Year Book. Exhibit MW4 contains what are said to be representative examples of such advertising. The exhibit contains:

- An undated advertisement for Patricia Eve Ltd which has a number of brands along the bottom of the page including MIRACLESUIT and MIRACLEBODY.
- Another undated advertisement for Patricia Eve Ltd showing a person wearing a swimsuit but the brand is not visible in full - the first word Miracle appears but the rest is cut off.
- Another Patricia Eve Ltd advertisement with a handwritten date of July 2008. It shows the stylized version of MIRACLESUIT alongside a person wearing a swimsuit.

- Another undated advertisement for Patricia Eve showing MIRACLESUIT (stylized and word only) next to people wearing underwear (shapewear).
- Page 5 of the exhibit contains a picture of two people wearing swimsuits. Page 6 simply contains the word MIRACLESUIT (stylized). There is no information to ascertain the relationship between these two pages, what the advertisement is or where and when it was placed.
- Another undated advertisement for Patricia Eve Ltd showing MIRACLESUIT (stylized) alongside some underwear.
- An extract from the Daily Telegraph dated June 2009 (after the material date but within the relevant period). The article recommends a number of swimsuits to its readers, one of which is “Avanti” by Miraclesuit.
- At page 9 there is a print of a tropical/beach scene (no people are present) headed MIRACLESUIT (stylized). The words “look 10 pounds lighter in 10 seconds” are shown as is “EUROPE 2009”.
- An extract from Closer magazine dated July 2005. The front page carries the words “MIRACLE SLIMSUIT [not Miraclesuit] LOSE 10LBS IN 10 SECONDS...JADE DID”. It then carries what I assume to be a before and after shot (presumably of Jade) wearing two different swimsuits.
- An undated advertisement from what appears to be Women on Sunday. The article refers to a shop in Kent (Josh Lingerie) being the first stockist of a particular product in Kent. The article relates to the MIRACLESUIT swimsuit and its slimming qualities.
- An undated extract from The Sun showing another before and after shot of a person wearing a swimsuit. The mark referred to in the article is, again, cut off, only the word Miracle can be seen.
- An extract from June 2005 from Expressyourself about the MIRACLESUIT swimsuit.
- An extract from the Daily Mail dated 21 June 2005. The front page is provided showing a before and after shot of a person wearing a swimsuit – the article is apparently going to inform the reader as to “... the truth about the swimsuit that promises to take 10lb off your figure”. There is no mention of any brand name.
- A feature with a handwritten date of July 2007 from the Mail on Sunday (handwritten). A swimsuit is recommended for readers who want to “smooth the bumps”. A&H’s marks are not used. In fact, an extract reads:

“This miracle swimsuit has all-over firm control.” The product is then simply described as a swimsuit available from Marks and Spencer.

- An editorial from Mimi Spencer in “Fashion for Life” where Ms Spencer highlights the “Miracle Suit”, its tagline (lose 10 pounds in 10 seconds) and that it is available from Figleaves and House of Fraser. The page has a hand written date of 2006.

10) Mr Waldman says that in May this year (2010) the Underlines Magazine conducted an annual survey and MIRACLESUIT products were voted number one for swimwear and shapewear.

11) Mr Waldman says that A&H has over 160 accounts in the UK selling MIRACLESUIT swimwear and considerably more selling MIRACLESUIT shapewear. He says that special promotions with the retailers and their staff are run – no details are provided.

12) Mr Waldman says that A&H’s products have featured on television programmes and in trade exhibitions – no dates of any of this are provided. Promotional expenditure (for both marks) is: £27,044 (2004), £24,101 (2005), £41,224 (2006) £45,992 (2007), £52,072 (2008), £71,047 (2009).

13) Mr Waldman states that A&H’s products are designed to control the figure and to shape and firm the body. He states (and provides a dictionary extract in support) that one of the definitions of the word FIT (a word appearing in CBN’s mark) is “the right measure, shape, and size of a person”. He states that members of the public may see the MIRACLE FIT mark as an extension of A&H’s products as it is conceptually similar.

*Witness statement of Ian Wilkes dated 24 August 2010 & Witness statement of Sarah Janella Barr dated 25 October 2010.*

14) Mr Wilkes is a trade mark attorney at Groom Wilkes & Wright LLP, the firm with conduct of the proceedings on behalf of CBN. His evidence relates, primarily, to the word MIRACLE and its distinctiveness for clothing. Ms Barr is a trade mark attorney at Wildbore & Gibbons, A&H’s representative. Her evidence responds to that of Mr Wilkes so it is worthwhile summarizing both sets of evidence together.

15) Mr Wilkes summed up his evidence by stating that MIRACLE on its own is not distinctive and is in common use for class 25 goods. He considers that the respective marks are only distinctive by virtue of the unusual combination with the other word in each mark and that confusion will not arise because of this. The evidence filed in support of this proposition is:

- i) Prints of 14 CTMs which cover goods in class 25 that contain the word MIRACLE;
- ii) Prints of 4 UK trade marks which cover goods in class 25 that contain the word MIRACLE;

Ms Barr highlights the above as simply state of the register evidence showing no use in the marketplace.

- iii) A print from [women.fashionbeans.com](http://women.fashionbeans.com) for a Jasmine Guinness miracle dress. The print was taken on 19 August 2010;
- iv) A print from [www.ultimo.co.uk](http://www.ultimo.co.uk) taken on 19 August 2010 (the page has a copyright date of 2010) for a Miracle T-Shirt Bra;
- v) A print from [www.zazzle.co.uk](http://www.zazzle.co.uk) for a range of Miracle T-Shirts. The t-shirts carry slogans such as “miracle worker”, “believe in miracles”, “expect miracles” etc. The print was taken on 19 August 2010.

Ms Barr highlights that in relation to v) this is neither trade mark use or descriptive use as the products are simply slogan carrying t-shirts.

- vi) A print from [www.yourbumpandbeyond.co.uk](http://www.yourbumpandbeyond.co.uk) for a Miracle Scarf – a scarf to be worn by a parent which contains toys for a child to play with whilst in the parent’s arms. The print was taken on 5 July 2010;
- vii) A print from [www.vouchercodes.com](http://www.vouchercodes.com) for Body Miracle Pinstripe Shorts sold by Marks and Spencer. The print was taken on 5 July 2010;
- viii) A print from [www.evans.co.uk](http://www.evans.co.uk) for a “miracle swimdress”. The print was taken on 5 July 2010.
- ix) A print from [www.miracledress.com](http://www.miracledress.com) for a Miracle Dress by Vanessa Lundborg. The print was taken on 5 July 2010. There is a copyright notice date of 2006.

Ms Barr states in respect of ix) that this is from a US website; she corroborates this with a print from the website which shows a US address.

- x) A print from [eBay.co.uk](http://eBay.co.uk) for an M&S Body Miracle black bra. The print was taken on 5 July 2010. The auction was due to end on 11 July 2010.

Ms Barr says that this is a listing by a private individual and is not evidence of normal trading circumstances.

- xi) A print from [www.ultravioletclubwear.co.uk](http://www.ultravioletclubwear.co.uk) for a Miracle Clubbing Dress By Passion. The print was taken on 19 August 2010.
- xii) A print from [www.grahamsanders.blogspot.com](http://www.grahamsanders.blogspot.com) taken on 19 August 2010. The print itself carries a date of Thursday, 1 April 2010. It contains an advertisement for a Miracle Shirt that assists in dealing with body odour. The advertisement is placed by a deodorant manufacturer who adds “Nice idea, but until miracles happen, try this [a deodorant product]. The Miracle Shirt is, therefore, a spoof product.
- xiii) A print from [www.valueplanning.com](http://www.valueplanning.com) for B-Three MIRACLE STRETCH PANTS. The print was taken on 19 August 2010.

Ms Barr states that this is a Japanese website and that there is no confirmation as to use in the UK. She highlights that the website refers to clothing sizes of 5-19 which are not used in the UK. She provides a copy of normal UK sizes which are 8-32 (even numbers only).

- xiv) A print from [www.miraclegloves.com](http://www.miraclegloves.com), which shows a pair of gloves used as a facial beauty treatment. The print was taken on 19 August 2010.

Ms Barr highlights a reference on this page to the Food and Drug Administration which is a US regulatory body. She states that this is not relevant to the UK.

- xv) A print from [www.chums.co.uk](http://www.chums.co.uk) for “LADIES MIRACLE THERAPY GLOVES”. The print was taken on 19 August 2008.
- xvi) A print from [www.articlebase.com](http://www.articlebase.com) containing an article about a product called SPANX which is described as a “weight loss underwear slimming miracle”. The print was taken on 19 August 2010.
- xvii) A print from [www.uk-catalogues.co.uk](http://www.uk-catalogues.co.uk) for “Spanx Miracle Shapewear”. The print was taken on 5 July 2010.
- xviii) A print from [www.instyle.co.uk](http://www.instyle.co.uk) for “The miracle £28 Tummy Tamer Dress”. The product is described as a miracle dress. The print was taken on 19 August 2010.
- xix) A print from [www.marieclaire.co.uk](http://www.marieclaire.co.uk) about the same product as above. The print was taken on 19 August 2010.
- xx) A print from [www.airport-sports.com](http://www.airport-sports.com) about “New Miracle Clothing” the product itself is called The SQUEEM. The print was taken on 19 August 2010.

- xxi) A print from [www.shopbutterbynadia.com](http://www.shopbutterbynadia.com) selling a dress which, apparently, many of those who have sold it have coined it “the “Miracle Dress”, “Magic Dress”, the “Revenge Dress””. The print was taken on 5 July 2010.
- xxii) A print from [www.celebritydietdoctor.com](http://www.celebritydietdoctor.com) about “Miracle Cellulite-Busting Pants”. The entry appears to be a posting by a user called Megan on 1 December 2009. The product itself is called the Peachy-Body.
- xxiii) A print from [www.dailymail.co.uk](http://www.dailymail.co.uk) about LipoCountor briefs which are described as Miracle pants. The print was taken on 19 August 2010 but there is a last update date of 16 June 2008.

In relation to xvi-xxiii, Ms Barr states that this is simply journalistic comment and does not detract from the distinguishing capability of A&H’s trade marks.

### **The proof of use provisions**

16) As stated in paragraph 3, the proof of use provisions apply to A&H’s MIRACLESUIT marks. The relevant legislation reads:

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

(1) This section applies where –

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

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

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

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

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the

United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

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

(4) For these purposes –

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

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

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

17) 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.”

18) In view of the above, A&H must show that it has made genuine use of its trade marks in the period 11 July 2004 to 10 July 2009. A&H has two earlier marks for the word MIRACLESUIT, one of which is a UK registration the other a CTM registration. Genuine use must, therefore, be established in the UK or the EC respectively. The CTM has a wider specification so the significance of UK/EC use may become relevant. I will, though, simply begin with an assessment of the evidence and determine if the mark has been used, where, and in respect of what goods. When doing so, I bear in mind the leading authorities on the principles to be applied in determining whether there has been genuine use of a trade mark, namely, the judgments of the European Court of Justice (“ECJ”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). It is also worth noting the Court of Appeal’s (“COA”) judgment ([2006] F.S.R. 5) in the latter of these cases when it had to apply the guidance given by the ECJ. From these judgments the following points are of particular importance:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to

guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*, paragraph 37);

- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);

- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);

- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);

- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);

- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);

- there is no requirement that the mark must have come to the attention of the end user or consumer (*La Mer* (COA), paragraphs 32 and 48);

- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*La Mer* (COA), paragraph 34);

-the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*La Mer* (COA), paragraph 44).

19) I also note i) *Kabushiki Kaisha Fernandes v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-39/01 [2003] ETMR 98 where the General Court ("GC") stated:

"47 In that regard it must be held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned."

and ii) *Laboratoire De La Mer Trade Mark* [2002] FSR 51 where Jacob J stated:

“9 In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye -- to ensure that use is actually proved -- and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted.”

20) In terms of the evidence, the sales figures are said to relate to the MIRACLESUIT marks and the MIRACLEBODY marks. There are no specific figures for MIRACLESUIT per se. The MIRACLESUIT marks are said to be used in respect of both swimwear and underwear (particularly shaping underwear). Whilst there are some exhibits demonstrating the use of MIRACLESUIT in respect of underwear these cannot be placed within the relevant period, most simply having been printed after the expiry of the relevant period. No archive prints have been provided. Of the material that can be placed within the relevant period, this appears to relate only to one particular product, a ladies swimsuit. A lot of this material is in the form of magazine/newspaper editorials etc. The evidence itself is not overwhelming, some of the exhibits do not even carry the mark. However, taken as a whole, including Mr Waldman's commentary (which is unchallenged), the evidence supports the proposition that MIRACLESUIT has been used from around 1995 onwards in respect of such goods. It shows that the use is not token use merely to have maintained the registration. There is no evidence of any other goods sold under the mark within the relevant period or of goods sold under the MIRACLEBODY mark in the relevant period. This deals, to an extent, with the concern regarding turnover figures as it is reasonable to infer that the MIRACLESUIT mark would represent a reasonable proportion of the sales figures. The context of the evidence relates only to the UK (see the invoices etc) which is, again, supported by the magazine/newspaper extracts. I consider the evidence sufficient to demonstrate that the mark (both stylized and word only – the two forms having been used) has been genuinely used in the UK in respect of a ladies swimsuit. The evidence is not sufficient to demonstrate use in relation to the other goods – this is particularly so when one bears in mind the guidance from the case-law referred to in paragraph 19 above.

21) In view of the above finding it is not necessary to debate whether the use in the UK that has been demonstrated is sufficient to find genuine use in the EC. Given the goods in respect of which I have found use, a product which appears in both the UK and CTM registrations, the opponent is in no better position with regards to its CTM. Having set out what goods the mark has been used upon, it is necessary to decide upon a fair description for the goods for which genuine use has been shown and which falls within the parameters of the specification. The description must not be over pernickety<sup>2</sup>. It is necessary to consider how the relevant public, which for these goods would be the public at large, describe the goods<sup>3</sup>. The GC in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03* held:

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<sup>2</sup> See *Animal Trade Mark* [2004] FSR 19.

<sup>3</sup> See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32.

“43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or

services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category.”

22) The specification includes the term swimwear. The product for which genuine use has been shown is a ladies swimsuit. Whilst the term swimwear covers items of swimwear for both men and women, I consider it too pernicky to restrict the specification. The product will be classed and categorized as swimwear and this is a fair specification on which to consider matters.

### **Section 5(2)(b) of the Act**

23) This section reads:

“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.”

24) In reaching my decision I have taken into account the guidance provided by the ECJ in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

25) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods are similar, other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person's eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of "imperfect recollection";

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc.*).

#### The average consumer

26) Clothing is bought by the public at large. The average consumer is, therefore, a member of the general public. This is so whether the clothing has shaping characteristics or otherwise. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on the particular goods in question (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). The average consumer may try the goods on and is likely to inspect them for colour, size, style etc. All of this increases the potential exposure to the trade mark. That being said, the purchase is unlikely to be a highly considered process as clothing is purchased relatively frequently and, although cost can vary, it is, generally speaking, not a highly expensive purchase. To the extent that both parties' goods include goods which have shaping characteristics, it is not considered that this materially increases the degree to which the purchasing process will be considered. The purchasing process is, therefore, a normal, reasonably considered one, no higher or lower than the norm.

#### Comparison of goods

27) All relevant factors relating to the goods in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23 of its judgment:

“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.”

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

- “(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.”

29) 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 Office for Harmonization in the Internal Market (Trade Marks and Designs)* (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* (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

30) Finally, when comparing the respective goods, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be held to be in play<sup>4</sup> even if there may be other goods within the broader term that are not identical.

31) The specification for the MIRACLEBODY mark includes clothing at large so all of the goods covered by the applied for mark fall within its ambit. The goods must be held to be identical.

32) The specifications for the MIRACLESUIT marks (after taking into account my proof of use findings) cover only swimwear. The goods sought to be registered by CBN are:

Clothing; clothing, namely, jeans, pants, slacks, trousers, jumpers, overalls, sweat pants, jogging pants, track pants, shorts, suits, skirts, dresses, tops, shirts, t-shirts, polo shirts, blouses, camisoles, tank tops, halters, sweaters, vests, cardigans, jerseys, sweat shirts, uniforms, outerwear, coats, raincoats, trench coats, jackets, jean jackets, ponchos, blazers, pullovers, sportswear, exercise wear, shape wear, namely, body suits, brassieres, girdles, panties, waist cinchers, tummy tuckers, compression garments, tummy trimmers and waist trimmers, sleepwear, lingerie, nightgowns, robes, bathrobes, pyjamas, undergarments, undershirts, underwear, boxer shorts, socks, leggings, tights, swimwear, beachwear and bathing suits.

33) Terms such as “swimwear”, “beachwear” and “bathing suits” must be identical to “swimwear” covered by the earlier mark. “Sportswear” and “exercise wear” would include swimwear, swimming being a sport and an exercise so they must be held as identical. The same can be said of the term “clothing” at large because included within its ambit would be swimwear. Even if I am wrong in relation to exercise wear and that such a term should be limited to goods such as shorts and tops for exercising in, I still consider there to be a reasonably high degree of similarity due to the purpose (both being sport/exercise related), users and channels of trade, as well as similarities in terms of nature etc.

34) The goods categorised in the application as shapewear are primarily forms of underwear. Underwear and swimwear are often of the same nature and of a similar form etc. All are items of clothing albeit underwear is worn underneath other clothing whereas swimwear is worn on its own whilst swimming. A key aspect of both parties’ cases, an aspect which the parties agree on, is that both sets of goods contain elements which shape the body. The potential for this increases the degree of similarity. I consider swimwear and shapewear to be similar to a reasonably high degree.

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<sup>4</sup> See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM) Case T-133/05 (“Gérard Meric”)*.

35) The remaining goods are more standard forms of clothing but there is, on the face of it, no reason why the goods cannot contain elements which shape the body. For example, it is clear that jeans (claimed to have been sold under the MIRACLEBODY mark) have this shaping feature. The exact nature of the applied for goods varies as does the degree of similarity. The fact that they all clothe the body, that they may be made of similar material and potentially could all shape the body (a potential which in the case before me is highly likely) means that the goods are all, at least, reasonably similar. Mr Groom indicated that these goods were not, in any event, of particular concern if CBN was unable to retain its application for its specifically listed shapewear products.

Comparison of marks

36) That leads to a comparison of the marks. The competing marks (I have depicted A&H's word mark as this must be its best case), for ease of reference, can be seen in the table below:

| CBN's mark  | A & H's mark               |
|-------------|----------------------------|
| MIRACLE FIT | MIRACLESUIT<br>MIRACLEBODY |

37) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

38) All of the trade marks consist of the word MIRACLE together with another word FIT/SUIT/BODY. In the case of A&H's marks the additional word is conjoined to the word MIRACLE. The evidence filed by CBN goes to the distinctiveness inherent in the word MIRACLE, the argument being that all of the marks are distinctive only on account of their combination. Applied to the factors I am considering here it would be difficult, if CBN were correct, to find that the word MIRACLE plays a dominant and distinctive role in any of the marks, or a distinctive role of any kind. In other words, there may be no dominant and distinctive elements in the respective marks other than the marks in totality. Mr Engelman, on behalf of A&H, did not disagree that the two words in each of the marks combined to create a lexical invention, but I did not understand him to

concede that the word MIRACLE could not be the dominant and distinctive element.

39) The MIRACLESUIT mark covers goods that include swimsuits. The word SUIT, is, therefore, entirely descriptive. The word is the name of the product. Similar things can be said of MIRACLEBODY and MIRACLE FIT. A body can be a type of underwear so in respect of those goods the mark is in the same position as MIRACLESUIT. Even for a product that is not a body, the mark suggests some form of miracle that will affect the body – in this context the word MIRACLE is bound to be the more dominant element of the mark, the part of the mark more likely to be recalled by the average consumer. The same can be said in respect of the MIRACLE FIT mark, the suggestive quality of this mark relates to some form of miraculous affect on how the clothing fits the wearer.

40) I do not consider the evidence filed by CBN demonstrates that the average consumer (from whose position these matters must be judged) has been educated to understand the word MIRACLE to be a common descriptor in trade denoting a form of clothing which will have a positive effect on the body. Much of its evidence is from after the relevant date and is therefore of dubious significance in terms of demonstrating the position at the relevant date. Some of the evidence is, furthermore, of dubious provenance, some coming (when Ms Barr's counter evidence is considered) from overseas sources. Some forms of use shown in the evidence use the word MIRACLE in a trade mark sense rather than a descriptive sense. There are some (post relevant date) examples where the word may be being used descriptively, but on the basis of the evidence in totality, given the observations made above, I am not satisfied that the average consumer in the UK will, at the material date, have been educated to know that the word MIRACLE is simply a descriptor of a particular type of clothing. (The "state of the register" evidence does little to support for reasons that have been given many times.) I use the word "educated" because from an inherent perspective the word MIRACLE would not in my view constitute an ordinary descriptive term. It has some clear suggestive qualities but that would not be enough to result in the word not being capable of performing a dominant and distinctive role in the marks.

41) Other parts of the evidence filed by CBN is of a more journalistic nature, much of which also has problems in terms of dating. Furthermore, use in journalistic language, where headline grabbing terminology may be used, has even less relevance than that assessed in the preceding paragraph. The distinctiveness of a mark (or in this case an element of a mark) depends on context. In the context of the use of a trade mark in the course of trade, the journalistic material is not considered to undermine the capability of the word MIRACLE to be considered as a dominant and distinctive element of the mark. A trade mark (or in this case an element of it) can send an informative/suggestive message but, at the same time, may also be capable of being understood as having trade mark meaning. In other words, an element of a trade mark may play

a dual role. An analogous finding can be seen in the judgment of the ECJ in *Audi AG v OHIM* (Case C-398/08 P). I come to the view that the word MIRACLE will be considered by the average consumer as the dominant and distinctive element of each of the marks. The element must, though, be considered as a weak element on account of its suggestive qualities.

42) In terms of the visual and aural similarities, the considerations are the same. From both perspectives there is a point of similarity due to the common presence of the word MIRACLE at the beginning of each of the marks. Each of the marks has, though, a point of difference in terms of the different second words. The second words do not look or sound like each other. However, the second words have, as assessed earlier, little by way of distinctiveness. I consider there to be a reasonable degree of visual and aural similarity. This is so despite the point of similarity residing in a weak element. This does not prevent the marks from being regarded as similar<sup>5</sup>.

43) In terms of concept, for a conceptual meaning to be relevant it must be one capable of immediate grasp<sup>6</sup>. Whilst there are slightly different contexts to each of the marks, there is a common theme running through them all, namely, that there is an aspect of miraculousness associated with the goods. I conclude therefore that there is a reasonably high degree of conceptual similarity.

#### Distinctiveness of the earlier mark(s)

44) The more distinctive the earlier mark (based either on its inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). I have already commented on the distinctiveness of the word MIRACLE. It is a word of only a weak degree of distinctiveness. In respect of the earlier mark, I do not consider that the overall degree of distinctiveness is significantly improved. MIRACLESUIT alludes to a suit (bathing) that has miraculous properties. MIRACLEBODY alludes to a body (a form of underwear) that has miraculous properties or clothing that will have a

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<sup>5</sup> In case C-235/05 P, *L'Oreal SA V OHIM*, the ECJ stated: "The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders."

<sup>6</sup> This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHIM* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

miraculous impact on the body of the wearer. The marks in totality have only a low degree of distinctiveness.

45) In respect of the use demonstrated, there is no real use that can be relied upon in relation to MIRACLEBODY given the lack of corroborative evidence from before the relevant date. The MIRACLESUIT mark may have been used and may have received some press attention, but I am far from satisfied that its use has been to the extent necessary to enhance the distinctive character of the mark. Neither mark is entitled to claim an enhanced degree of distinctiveness. My comments in relation to the MIRACLEBODY mark also impacts on any claim to there being a family of marks. Use of all the marks is required<sup>7</sup> – this has not been proven to my satisfaction.

#### Conclusions on the likelihood of confusion

46) It is clear that all the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

47) Considering firstly the conflict between MIRACLE FIT and MIRACLESUIT, I have found that some of the goods (swimwear or terms that include such goods) are identical, some (the specifically listed shapewear) are similar to a reasonably high degree, and some (the other goods) are reasonably similar. I have found the marks to be visually and aurally similar to a reasonable degree and for there to be a reasonably high degree of conceptual similarity. The earlier mark is, though, of only a low degree of distinctiveness and the point of similarity between the marks is itself of a low degree of distinctiveness. CBN's argument focuses on the distinctiveness issue, Mr Groom arguing that when adopting a mark such as MIRACLESUIT then they [A&H] may have to live with closer marks and that it should be open to the trade to use the word MIRACLE in its marks. A&H argued that confusion was still likely on account of the construction of the respective marks and their respective lexical inventions being so similar.

48) I have borne in mind all of the arguments made by the parties and the evidence filed, particularly in respect of the distinctiveness of the word MIRACLE. However, notwithstanding the low degree of distinctiveness possessed by the earlier mark and the low degree of distinctiveness inherent in the word MIRACLE, I consider that there is still be a likelihood of confusion. The concept of imperfect recollection may play a part in this. It is the miraculous concept that runs through the concepts underpinning the respective marks. This is the aspect that is most memorable. This is so even though the concept may not be particularly

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<sup>7</sup> See case C-236/04, *P Il Ponte Finanziaria S.p.A v OHIM*.

distinctive. To an extent, this ties in with A&H's argument. Whilst I do not express the argument in exactly the same way as Mr Engelman, the construction and invention of both marks is based on the word MIRACLE together with a non-distinctive word relating to the goods or to their fit – this means that the endings of the marks do little to assist the average consumer to distinguish between them. All of this applies to swimwear and to shapewear, the latter being similar to a reasonably high degree. In respect of the other goods, I accept that the argument is more finely balanced bearing in mind the interdependency principle. Mr Groom did not, though, press me on these goods. I think it sufficient for me to find that there is a likelihood of confusion here for similar reasons to that stated above particularly when one bears in mind that so many items of clothing can be manufactured in a way which shapes the body.

49) The above deals with the opposition. I would add, though, that I would also have made the same finding in terms of the MIRACLEBODY mark. I do not consider there to be any real difference between the assessment made above than the assessment to be made here. The argument is even stronger in respect of those goods not listed as shapewear as the earlier mark covers all types of clothing so all of the goods are identical. That being said, my finding in relation to MIRACLESUIT means that it is not necessary to suspend the implementation of my decision until the MIRACLEBODY mark achieves registration.

50) The opposition succeeds in its entirety.

### **Costs**

51) A&H has been successful and is entitled to a contribution towards its costs. I hereby order CBN One Of The Boys Apparel Inc to pay A&H Sportswear Co Inc the sum of £2100. This sum is calculated as follows:

Preparing a statement and considering the other side's statement  
£500

Opposition fee  
£200

Filing evidence and considering the other side's evidence  
£800

Attending the hearing  
£600

52) The above sum should 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 29 day of March 2011**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**