

O/140/12

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1045622 IN THE
NAME OF MATTHIEU VAXELAIRE**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 72255 BY JOJO MAMAN BÉBÉ LIMITED**

BACKGROUND

1. On 3 June 2010 (claiming priority from a filing in the Benelux dated 8 January 2010), Matthieu Vaxelaire (“MV”) requested protection in the United Kingdom of the International Registration (IR) of the following:

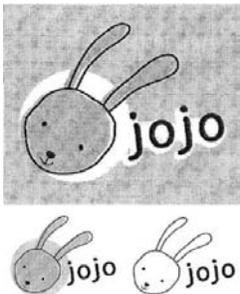


2. The United Kingdom Trade Marks Registry (“TMR”) considered the request satisfied the requirements for protection and particulars of the IR were published on 17 December 2010 for the following goods:

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; trunks and traveling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25: Clothing, footwear, headgear.

3. On 16 March 2011, JoJo Maman Bébé Limited (“JMB”) filed a notice of opposition which consisted of grounds based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (as amended) (“the Act”). JMB’s opposition under section 5(2)(b) of the Act is based upon the following trade marks:

Trade Mark	No.	Application Date	Registration Date	Goods and services relied upon
 <p>Series of 3</p>	2349755	24.11.2003	7.1.2005	<p>25: Articles of clothing, footwear and headgear; bibs; children's clothing and footwear; nappies and napkins; infants' clothing and footwear.</p> <p>28: Toys, balls, games and playthings; gymnastic and sporting articles; ornaments and decorations all for Christmas trees; parts and fittings for all the aforesaid goods.</p>

JoJo Maman Bebe	2134348	22.5.1997	16.10.1998	25 – Maternity wear, children's and infants wear.
JOJO MAMAN BÉBÉ	E6387757	23.10.2007		18 - Bags; backpacks; changing bags; travel bags; baby carriers, infant carriers; umbrellas, parasols. 25 - Clothing, footwear and headgear for babies, children and adults; bibs, clothes protectors; maternity wear; swimwear. 35 - Retail services in the field of maternity goods and merchandise for babies, infants, children, and parents namely... bags, backpacks, changing bags, travel bags, baby carriers, infant carriers, umbrellas, parasols.. clothing, footwear and headgear for babies, children and adults, bibs, clothes protectors, maternity wear, swimwear, sun protection clothing.

4. JMB's opposition is directed against all of the goods contained in MV's application. JMB adds that it has used trade mark Nos. 2349755 and 2134348 in relation to all of the goods upon which it relies.

5. Insofar as its objection based upon section 5(4)(a) of the Act is concerned, JMB indicates that it has used the signs JOJO and JOJO MAMAN BÉBÉ in the UK since 1993 in relation to, inter alia, goods in classes 18 and 25. It adds that the business conducted under these signs has achieved a significant and extensive reputation and goodwill in the UK, such that use by MV of his trade mark on the goods of his designation would amount to a misrepresentation likely to lead to confusion and dilution of JMB's goodwill.

6. On 30 May 2011, MV filed a counterstatement (subsequently amended) which, in essence, consists of a denial of the grounds upon which the opposition is based. As these are the only comments I have from MV in these proceedings, they are reproduced below in full. MV said:

“[JMB’s] opposition is based on his UK mark 2349755.

With respect to section 5(2)(b)

[JMB’s trade mark] is composed of a bunny head and of JOJO. It looks quite different than [MV’s] logo mark JOJO. It puts the accent on the bunny’s head, i.e. a clear reference to childhood ([JMB’s] business being cloth wear (sic) for children). The marks concerned are not similar enough and the risk of confusion is not demonstrated. [MV’s] mark is not similar to [JMB’s] earlier mark.

With respect to section 5(4)(a)

It is up to [JMB] to prove its rights under that section. That proof is not established. In any event [JMB’s] earlier use consists of a use for shoes for children, which does not conflict with [MV’s] use of his logo mark JOJO.”

I note that MV only refers to one of the trade marks upon which JMB relies in these proceedings and, in addition, does not ask JMB to provide proof of use.

7. Only JMB filed evidence. Neither party asked to be heard; JMB filed written submissions in lieu of attendance at a hearing. I will refer to these submissions as necessary below.

JMB’s evidence

8. This consists of a witness statement, dated 11 October 2011, from Harriet Blanchet, JMB’s Buying Director. Ms Blanchet explains that JMB owns and operates a chain of retail premises in the UK and has been trading in the UK under the names JOJO MAMAN BEBE and/or JOJO since 1993. The business was, she explains, established by Laura Tenison and initially sold specialist maternity wear and baby clothing; it now employs over 300 people in the UK. She goes on to say that JMB and Ms Tenison personally have been the recipients of a range of awards. For example, I note that Ms Tenison was awarded the MBE in 2005 and the *Veuve Clicquot Business Woman of the Year award* in 2010. JMB has been awarded the *Practical Parenting Maternity Fashion and Baby & Toddler Fashion Awards 2007*, the *Prima Baby*: (i) Pregnancy Reader Awards Best Buy, Mail Order 2007, (ii) Fashion Awards, Best Catalogue/Mail Order Service 2008, (iii) Reader Awards, Best Maternity Lingerie 2010, and (iv) Reader Awards, Best Children’s Wear Website 2010, the *Pregnancy & Birth Best for Underwear Bloom Award 2007* and the *Drapers Children’s Wear Retailer of the Year 2009*.

9. Ms Blanchet explains that in addition to 36 retail premises in the UK, JMB sells its goods via both a mail order catalogue and the Internet at www.jojomamanbebe.co.uk. Ms Blanchet states that JMB sells a wide variety of goods in its shops via catalogues and through its website including [broadly speaking] a range of clothing, bags, nursery products, soft toys etc. Ms Blanchet states that JMB uses the trade mark JOJO and is often referred to as JOJO by its customers. Exhibit HB2 consists of a range of catalogues from Autumn & Winter 2008, Christmas 2009, Spring 2010, High Summer 2010 and Winter 2010. The front cover of each catalogue bears the name: JoJo Maman Bébé below which appears the wording “maternity, baby and child, nursery and toys”. Also included on the front cover is a reference to the website mentioned above. The back page of each catalogue lists JMB’s stores which, I note, increased from 22 stores in 2008 to 31 stores in 2010. The inside cover of the Autumn & Winter 2008 catalogue contains, inter alia, the following text:

“We are often asked, why we are called JoJo Maman Bébé? The answer is simple. Before JoJo I was running a business in Brittany, France and was impressed by two things: 1) the chic style in which French women dressed when pregnant. 2) The totally adorable and practical nautical clothing worn by children at the seaside.

...JoJo was the brand name chosen to represent the collections. Maman and Bébé described our market sector.”

10. I note that in its submissions, JMB points to the use of the word JOJO on numbered pages of catalogues from Autumn & Winter 2010 and Spring 2011. While neither of these catalogues can be found in the evidence provided, some of the examples mentioned by JMB can be found in other catalogues within exhibit HB2. For example, JoJo Sleeping bags (page 124, Autumn & Winter 2008), JOJO wellies and JOJO Summer clogs (pages 25 and 67, Christmas 2009), JOJO cotton-rich tights (page 62, Christmas 2009) and JoJo gift vouchers (page 194, Christmas 2009).

11. Turnover from 2001 to 2009 (helpfully split by category) is provided and is as follows:

Year	Total (£)	Maternity (£)	Baby & Childrenswear (£)	Nursery products (£)
2009	17,758,792	3,108,995	6,925,929	7,813,868
2008	16,680,580	3,002,504	5,504,591	8,173,484
2007	14,762,026	3,556,051	3,939,190	7,176,785
2006	11,486,404	2,870,903	3,611,464	5,004,037
2005	7,917,865	2,057,281	2,157,889	3,702,695
2004	7,751,297	2,182,619	2,142,562	3,426,098
2003	7,750,911	2,182,515	2,142,461	3,425,936
2002	5,974,421	1,682,288	1,651,414	2,640,720
2001	4,492,549	1,265,020	1,241,804	1,985,726

12. In the same period JMB spent the following amounts promoting the business in the UK:

Year	Amount spent (£)
2009	1,623,270
2008	1,702,176
2007	1,581,420
2006	1,664,426
2005	1,647,644
2004	1,404,647
2003	1,812,380
2002	1,466,275
2001	1,102,586

13. Exhibit HB4 consists of what Ms Blanchet describes as:

“9...samples of use of the mark on e.g. swing tickets, in advertisements, showing details of unregistered marks using the element JOJO, website banners, photo of shop frontage, headed notepaper, discount promotional postcards, neck labels, and compliment slips...”

14. I note that page 25 of this exhibit consists of a page of JoJo Maman Bébé headed note paper which has been date stamped 13 September 2011 and which includes, inter alia, the following handwritten text (the writer appears to be Lee Stone) although who Mr/Ms Stone is is not explained.

“Some examples of JoJo Ads from Spring/Summer 09 up until present...”

15. The above suggests that at least some of the documents in this bundle originated after the priority date of MV’s designation. All of the documents provided contain, inter alia, the words JoJo Maman Bébé presented in a range of formats but, as far as I can tell, only one refers to JOJO alone.

16. Finally, exhibit HB5 consists, inter alia, of extracts taken from websites which mention JMB’s business; all of the extracts were downloaded on 12 September 2011 and the vast majority refer to JMB’s business as JoJo Maman Bébé. That said, there are intermittent references to JMB’s business as JoJo examples of which are:

“JoJo offers everything you need from pregnancy to pre-school”;

“Laura Tenison – Hands on Mum and Full Time MD of JoJo.”

(from www.speakerscorner.co.uk);

“All clothes and JoJo products are designed in house...”

(from www.timeandleisure.co.uk);

“She called the brand JoJo...”

from (www.popularebay.co.uk).

17. That concludes my summary of the evidence provided to the extent I consider it necessary.

DECISION

18. The first ground of opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

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

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

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

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

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

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

20. In these proceedings JMB are relying on the three trade marks shown in paragraph 3 above; all of which qualify as earlier trade marks under the above provisions. Whilst trade mark Nos: 2349755 and 2134348 are, in principle, subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004, as I noted above, MV has not asked JMB to provide proof of use.

Section 5(2)(b) – case law

21. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 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; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing decision

22. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services; I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. Although JMB relies upon goods in class 28 in its notice of opposition (in relation to registration No. 2349755), it makes no mention of these goods in its submissions. Broadly speaking then, the goods at issue are leather and imitations of leather and goods made of these materials, bags of one sort or another etc. in class 18, articles of clothing in class 25 and retail services associated with these goods in class 35. In its submission JMB said:

“10. The average consumer of the goods and services of both [parties] would be the ordinary member of the public, in particular a woman who is pregnant or who has a baby or child or children or someone who is purchasing goods for such people, e.g. as a gift on the birth of a baby or for a birthday or Christmas. The goods are commonly purchased items and are not highly technical or specialised items which require a technical or specialised knowledge or expertise to be demonstrated prior to purchase. In the marketplace concerned, the goods are everyday purchases and are also purchases which are made all year round and by consumers the length and breadth of the UK...”

23. Although some of JMB's goods, for example, “Bibs, children's clothing and footwear, nappies and napkins, infant's clothing and footwear” (No. 2349755), “Maternity wear, children's and infants wear” (No. 2134348) and “Changing bags, baby carriers, infant carriers” and “Clothing, footwear and headgear for babies, children..., bibs, maternity

wear” (No. 6387757) are specifically directed at the particular average consumer JMB identifies in its submissions, not all of its goods are so limited and the scope of its registrations would encompass, inter alia, bags and articles of clothing at large. Given the nature of the goods and services at issue, and bearing in mind that MV’s goods are also unlimited, the average consumer must be considered to be a member of the public at large rather than the particular sub-set identified by JMB. As to the manner in which the goods will be selected, I agree with JMB that the goods at issue are, generally speaking, everyday items which will (as the evidence demonstrates) be selected in either a retail environment, from a catalogue or on-line. In *New Look Ltd v OHIM* - T-117/03 to T-119/03 and T-171/03 the General Court (GC) said:

“Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

24. The evidence provided, and my own experience, indicate that similar considerations are also likely to apply to the selection of the majority of the goods in class 18. As to the degree of care that the average consumer will display when selecting articles of clothing, the GC said:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

25. While I agree that the average consumer’s level of attention is likely to be heightened when selecting, for example, a bespoke gown or suit, an expensive handbag or perhaps, insofar as class 18 is concerned, a baby carrier (where safety issues will be in play), it is also, in my view, likely that the same average consumer’s level of attention will diminish when selecting, for example, a pair of socks or a routine bag for shopping. While these examples demonstrate that the average consumer’s level of attention will vary considerably depending on the cost and nature of the goods at issue, I think that when selecting even routine items of the type mentioned that the average consumer is likely to be conscious of factors such as the size, colour, material

and price of the item concerned. Overall, I think they are likely to pay at least a reasonable degree of attention to the selection of the goods at issue.

26. Insofar as the retail services are concerned, once again the average consumer will, in my experience, be a member of the public who is likely to select the retail outlet concerned by primarily visual means having encountered the trade mark in, for example, signage on the high street, in magazines and on the internet. As to the degree of care that is likely to be taken when selecting a retail outlet, once again this is likely to vary depending on the nature of the retail outlet and the goods which are being retailed. For example, the average consumer is likely, in my view, to be much more attentive when selecting a retail outlet selling, for example, bags and associated goods and clothing (where brand image is a relevant consideration) than they would when selecting a retail outlet to purchase an inexpensive item such as a newspaper. Considered in the context of the goods at issue and, much like the selection of the goods themselves, I think the average consumer will pay at least a reasonable level of attention to their selection.

Comparison of the goods and services

27. The goods and services to be compared are:

MV's goods	JMB's goods and services (best case)
<p>Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; trunks and traveling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.</p> <p>Class 25: Clothing, footwear, headgear.</p>	<p>No. 2349755</p> <p>25: Articles of clothing, footwear and headgear; bibs; children's clothing and footwear; nappies and napkins; infants' clothing and footwear.</p> <p>No. 2134348</p> <p>25 – Maternity wear, children’s and infants wear.</p> <p>No. 6387757</p> <p>18 - Bags; backpacks; changing bags; travel bags; baby carriers, infant carriers; umbrellas, parasols.</p> <p>25 - Clothing, footwear and headgear for babies, children and adults; bibs, clothes protectors; maternity wear; swimwear.</p> <p>35 - Retail services in the field of maternity goods and merchandise for babies, infants, children, and parents namely... bags, backpacks, changing bags, travel bags, baby carriers, infant carriers, umbrellas, parasols..</p>

	clothing, footwear and headgear for babies, children and adults, bibs, clothes protectors, maternity wear, swimwear, sun protection clothing.
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28. In its submissions JMB said:

“7. The goods of the application in class 18 are identical or similar to those covered by JMB’s application No. 6387757. Most of these goods would be fashion goods and so they would also be similar to the class 25 goods in all three of [JMB’s] trade marks. They have the same nature and purpose and would be purchased in the same kinds of shopping outlets which could include by mail order catalogue or by means of e-commerce over the Internet.

8. The goods in class 25 of the application are identical or similar to the goods in class 25 of all of [JMB’s] trade marks and also, being fashion goods, could be similar to the goods in class 18 of [JMB’s] application No. 6387757. They also have an identical nature or purpose and would be purchased in the same kinds of shopping environments as [JMB’s] goods.”

29. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the Treat case were:

- (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.

30. In relation to complementary goods and services, I note the comments of the Court of First Instance (now the General Court) in *Boston Scientific Ltd v OHIM* case T-325/06 i.e.

“82 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).”

Class 25:

31. JMB’s registration No. 2349755 includes in class 25 the phrase “Articles of clothing, footwear and headgear” which is identical to the goods in class 25 of MV’s designation. Similarly, application No. 6387757 includes the phrase “Clothing, footwear and headgear for babies, children and adults” which again is identical to MV’s goods in class 25. No. 6387757 also includes “Retail services in the field of maternity goods and merchandise for babies, infants, children, and parents namely... clothing, footwear and headgear for babies, children and adults, bibs, clothes protectors, maternity wear, swimwear, sun protection clothing”.

32. Insofar as the retail services contained in JMB’s application are concerned, I note the comments of the Court of First Instance (now the General Court) in *Oakley, Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-116/06. In that case the conflict was between an earlier mark which was registered for goods in classes 18 and 25 and a later mark which had been registered for “Retail and wholesale services, including on-line retail store services; retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks and wallets”. The GC upheld OHIM’s decision that the goods in classes 18 and 25 were similar to “retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks, and wallets” as there was a complementary relationship between the retail of the goods and the goods themselves. The Court said:

“54 Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bau-und Heimwerkermärkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the

Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.”

33. Finally, registration No. 2134348 is registered for “Maternity wear, children’s and infants wear” which must, in view of the following comments in *G rard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05, and in the absence of a fall-back specification from MV, also be considered to be identical. The GC said:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut f r Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

Class 18

34. Clearly JMB’s application No. 6387757 offers them the best prospect of success in this class as it contains both goods in class 18 and retailing of such goods in class 35. It is self-evident that the “bags”, “travel bags”, “umbrellas” and “parasols” in JMB’s application in class 18 are identical to the similarly worded goods in MV’s designation in that class. In the absence of a fall-back specification from MV, the “bags” in JMB’s application must also be considered identical or highly similar to “Leather and imitations of leather and goods made of these materials and not included in other classes” in MV’s designation as this phrase would include, inter alia, bags made of these materials. The “trunks” in MV’s designation must, in my view, given their nature, intended purpose, method of use and channels of trade be considered highly similar to the bags in JMB’s application. Finally, MV’s goods mentioned above are, for the reasons, outlined in *Oakley Inc*, complementary and thus highly similar to JMB’s retail services in class 35 insofar as those services relate to the retailing of bags, umbrellas, parasols etc.

35. That leaves “animal skins”, “walking sticks”, “whips, harness and saddlery.” While the users of the respective goods may be the same, and while some of the goods may be made from the same raw material as the goods in JMB’s goods in class 18 (leather for example), and while some of the competing goods will inevitably be sold in the same commercial establishments these factors alone are not, as the GC pointed out in *EI Corte Ingl s* (see below) sufficient to establish that the goods are similar. Beyond the factors identified above, I can see (on the basis of the relevant case law) no meaningful

commercial relationship between JMB's goods and services and MV's "animal skins", "whips, harness and saddlery". However, there is, I think, given their nature, channels of trade and to a lesser extent their intended purpose and method of use, a degree of similarity between "walking sticks" and "umbrellas" and "parasols", albeit, in my view, a relatively low degree.

36. What then of the clash between JMB's goods in class 25 and MV's goods in class 18? In this regard, I note that in *El Corte Inglés SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-443/05) the GC considered the clash between goods in classes 18 and 25. The court said:

"42. First, the goods in class 25 and those in class 18 are often made of the same raw material, namely leather or imitation leather. That fact may be taken into account when assessing the similarity between the goods. However, given the wide variety of goods which can be made of leather or imitation leather, that factor alone is not sufficient to establish that the goods are similar (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 55).

43. Second, it is apparent that the distribution channels of some of the goods at issue are identical. However, a distinction must be made according to whether the goods in class 25 are compared to one or other of the groups of goods in class 18 identified by OHIM.

44. On the one hand, as regards the second group of goods in class 18 (leather and imitations of leather, animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery), the Board of Appeal rightly held that the distribution channels were different from those used for the distribution of goods in class 25. The fact that those two categories of goods may be sold in the same commercial establishments, such as department stores or supermarkets, is not particularly significant since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin (see, to that effect, Case T-8/03 *El Corte Inglés v OHIM – Pucci (EMILIO PUCCI)* [2004] ECR II-4297, paragraph 43).

45. On the other hand, as regards the first group of goods in class 18, namely leather and imitation leather goods not included in other classes such as, for example, handbags, purses or wallets, it should be noted that those goods are often sold with goods in class 25 at points of sale in both major retail establishments and more specialised shops. That is a factor which must be taken into account in assessing the similarity of those goods.

46. It must be recalled that the Court has also confirmed the existence of a slight similarity between 'ladies' bags' and 'ladies' shoes' (SISSI ROSSI, paragraph 42 above, paragraph 68). That finding must be extended to the relationships

between all the goods in class 25 designated by the mark applied for and the leather and imitation leather goods not included in other classes, in class 18, designated by the earlier mark.

47. In light of the foregoing, it must be held that there is a slight similarity between the goods in class 25 and the first group of goods in class 18. Consequently, the Board of Appeal could not conclude that there was no likelihood of confusion on the part of the relevant public solely on the basis of a comparison of the goods concerned.

48. As to whether clothing, footwear and headgear in class 25 are complementary to 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18, it must be recalled that, according to the case-law, 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 the production of those goods lies with the same undertaking (SISSI ROSSI, paragraph 42 above, paragraph 60).

49. Goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image ('look') of the consumer concerned.

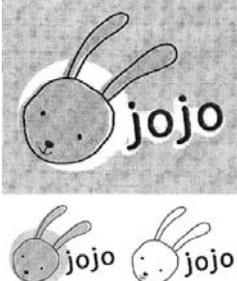
50. The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in class 25 and the various clothing accessories which complement them such as handbags in class 18. Any such coordination depends on the consumer concerned, the type of activity for which that look is put together (work, sport or leisure in particular), or the marketing strategies of the businesses in the sector. Furthermore, the fact that the goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and strengthen the perception that the same undertaking is responsible for the production of those goods.

51. It is clear that some consumers may perceive a close connection between clothing, footwear and headgear in class 25 and certain 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which are clothing accessories, and that they may therefore be led to believe that the same undertaking is responsible for the production of those goods. Therefore, the goods designated by the mark applied for in class 25 show a degree of similarity with the clothing accessories included in 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which cannot be classified as slight."

37. Given the breadth of their specifications in class 25 it is JMB's earlier trade marks Nos: 2349755 and 6387757 which, in my view, offers them the best prospect of success. Applying the logic in *El Corte Inglés* to these proceedings, there is a degree of similarity between JMB's "(Articles of) clothing, footwear and headgear" in class 25 and "Leather and imitations of leather, and goods made of these materials and not included in other classes, traveling bags" in MV's designation (insofar as they may be clothing accessories and form part of a coordinated look). As to the remaining goods in MV's designation i.e. "Animal skins, trunks, umbrellas, parasols and walking sticks, whips, harness and saddlery", as I mentioned above, while the users of the respective goods may be the same, and while some of the goods may be made from the same raw material as JMB's goods in class 25 (leather for example), and while some of the competing goods will inevitably be sold in the same commercial establishments, these factors alone are not sufficient to establish that the goods are similar. Given what I consider to be the very different intended purposes and methods of use of the goods which remain and JMB's goods in class 25, combined with the fact that they are not, in my view, either in competition with nor are they complementary to JMB's goods in class 25, I am led me to conclude that the remaining goods are not similar to JMB's goods in class 25 or to JMB's services in class 35 insofar as they relate to the retailing of clothing.

Comparison of trade marks

38. The trade marks to be compared are:

MV's trade mark	JMB's trade marks
	
	<p style="text-align: center;">JoJo Maman Bebe</p>
	<p style="text-align: center;">JOJO MAMAN BÉBÉ</p>

39. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

40. In *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, the ECJ said:

“29. In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34. This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35. Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as

an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36. It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark. “

41. In its submission JMB said:

“4. [MV’s] trade mark consists of the single word JOJO in a lower case typeface. The dominant and distinctive feature of [this trade mark] is the word element and this is the element by which [MV’s] goods would be referred to by the average consumer.

5. The dominant and distinctive feature of all of [JMB’s] trade marks is the word JOJO. This is the most memorable part of [JMB’s] trade marks and is the element which would be most readily identified by the average consumer as indicating the source of the goods and services in question...

6. When comparing the dominant and distinctive elements, JOJO v JOJO, it is clear that these are visually, phonetically and conceptually identical. The element JOJO is the element which would make the greatest impression on the average consumer of the goods in question and is the element most likely to be remembered by that consumer and to indicate to that consumer the origin of the goods and services in question. In relation to the term Maman Bébé appearing in two of [JMB’s] trade marks, it is submitted that in relation to certain goods those elements would be non-distinctive, e.g. in relation to clothing for pregnant women and babies as the words are well-known French terms for “Mummy” and “Baby” and would be recognised as such by a significant number of average consumers. The device of the rabbit in No. 2349755 does not form the dominant element of that mark and consumers would refer to the goods as being from JoJo without making any reference to the rabbit device...”

42. In his counterstatement, MV refers to his use of “his logo mark JOJO”; there is, therefore, no argument that MV’s trade mark is intended to be understood as jojo. MV’s trade mark consists of the word jojo presented in lowercase in an interlinking, cursive but otherwise unremarkable script. As no element of the trade mark is highlighted or emphasised in any way, the distinctiveness of MV’s trade mark must lay in its totality.

43. JMB relies upon three earlier trade marks in these proceedings. The first, trade mark No. 2349755, consists of a series of three trade marks in each of which the word jojo is presented in lower case and is accompanied by the stylised device of what MV describes as a “bunny head”. In my experience, clothing (and children’s clothing in particular) are often decorated with images of, inter alia, animals in all shapes and forms. While the device of a rabbit’s head (if that is indeed what it is intended to be) is

far from an ordinary representation, it is, in my view, unlikely to be seen by the average consumer as a highly distinctive element of JMB's trade mark (if indeed it is distinctive at all). As to the word jojo, although there is no evidence on the point, jojo is, in my experience, an affectionate name given to a female whose first name is either Joanne or Joanna (although there may also be other feminine forenames to which the name jojo may also be applied). As far as I am aware, as it neither describes nor is non-distinctive for the goods for which it is registered, it is a distinctive element of the trade mark. In terms of dominance, while the device element appears first and is somewhat larger than the word jojo, this factor is, in my view, offset by its weaker distinctive character and the importance of verbal elements in composite trade marks such as this. In short, I think that the distinctiveness of the trade mark lays primarily in the jojo element which will, for the reasons indicated above, also be the dominant element of the trade mark.

44. Trade mark Nos. 2134348 and 6387757 are for, essentially, the same trade mark i.e. JOJO MAMAN BEBE, albeit that one is presented in block capitals with accents above the letters E and the other is presented in an unremarkable font in title case and absent the accents above the letters e (which are likely to be overlooked by the average consumer). I have already concluded above that the word jojo neither describes nor is non-distinctive for goods in (essentially) class 25 and there is nothing to suggest that the same is not true of the goods in class 18 and services relied upon in class 35; it is, therefore, a distinctive element of the two trade marks. As to the words Maman Bebe and MAMAN BÉBÉ, JMB argues that for certain goods the words would be less distinctive as they would be well-known to a significant number of average consumers as French words meaning "Mummy" and "Baby" (which, as Ms Tenison points out in her evidence, describes JMB's "market sector"). While there is no evidence on the point, as French is (i) a language widely taught in the United Kingdom, (ii) as many UK citizens visit France for work or recreational purposes, and (iii) as the words have a similar look and feel to the English words Mummy and Baby, I am prepared to accept that a significant number of average consumers in the UK will either know the meaning of the words or will instinctively make an educated guess at to their meaning (in this regard, I do not think the presence or not of the accents above the letters e/E will have a significant impact one way or another). Of course to some average consumers the words will be meaningless. On balance, I am inclined to agree with JMB that given its distinctive credentials combined with its positioning as the first word in JMB's trade marks, it is the word JoJo/JOJO that is likely to be the more distinctive and dominant element of these trade marks and I will approach the comparison with these conclusions in mind.

Visual similarity

45. While the jojo element in trade mark No. 2349755 is the most similar to the trade mark in MV's designation, the manner in which the JoJo/JOJO element is presented in the other trade marks upon which JMB's relies, combined with my conclusions above regarding distinctive and dominant elements results, in my view, in at least a reasonable degree of visual similarity between all the competing trade marks.

Aural similarity

46. It is highly unlikely, that as it is accompanied by the verbal element jojo, the average consumer will try and describe the device element present in trade mark No. 2349755. The competing trade marks would thus be aurally identical. Insofar as the remaining trade marks are concerned, and even if the whole of JMB's trade marks were articulated, the presence of JOJO in all of the trade marks would, in my view, result in a reasonably high degree of aural similarity. That said, the evidence suggests that in actual use these trade marks are shortened to simply JOJO (perhaps because of their length or because they are understood as relating to the area of trade in which JMB operates). Such an approach would result in the competing trade marks having aural identity.

Conceptual similarity

47. While JMB's trade mark No. 2349755 contains a device element and Nos. 2134348 and 6387757 the additional words mentioned above, given my comments on the distinctive character present in these additional elements, the conceptual message sent by all the competing trade marks is likely, in my view, to be of a female who is affectionately known as JOJO and, insofar as JMB's trade marks are concerned, a female called JOJO whose business is directed at mothers and babies. As both parties' trade marks are likely to be dominated by the word JOJO they are, in my view, conceptually similar to a high degree.

Distinctive character of JMB's earlier trade mark

48. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

49. I have already concluded that JMB's trade marks are dominated by the word JOJO and that this word neither describes nor is non-distinctive for the goods and services upon which JMB relies in these proceedings. In view of these conclusions, but bearing in mind that the word JOJO is likely to be well-known to the average consumer as an affectionate name for a female, JMB's trade marks are in my view, and absent use, possessed of a reasonably high degree of inherent distinctive character.

50. JMB's unchallenged evidence is that it began trading in the UK under, inter alia, the trade mark JOJO MAMAN BÉBÉ in 1993. I note that before the priority date of MV's designation i.e. 8 January 2010, JMB operated 23 stores (the Christmas 2009 catalogue refers) in a range of locations i.e. seven stores in London, one in Wales and the remainder elsewhere in England and that its goods were also sold through both its catalogue and website. Total turnover in the period 2001-2009 amounted to some £94m with some £51m of this relating to sales of maternity, baby and children's wear. A number of the goods (particularly those in the category "Nursery products") appear to be sold under third party brands such as Beaba, Fisher-Price and BabyTec. During the same period JMB spent £14m promoting its business.

51. As to the manner in which the trade mark has been used, it is, I think, fair to say that the vast majority of the use is of the words presented in title case with the word JoJo presented with upper case letters J and with the accents above the letters e in Bébé. If there is any use of trade mark No. 2349755 I have been unable to find it. However, taking JMB's evidence as a whole, I have no hesitation finding that the use JMB have made of its trade mark JoJo Maman Bébé (regardless of its presentation in upper and lower case and with or without the accents), has resulted in this trade mark acquiring an enhanced distinctive character in relation to maternity, baby and children's wear and to the retailing both of these goods and to a range of nursery products which include, for example, a range of bags, baby carriers etc.

Likelihood of confusion

52. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of JMB's trade marks as the more distinctive these trade marks are, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

53. Earlier in this decision I concluded that:

- the average consumer was a member of the public who will select the goods and services primarily by visual means and who will pay at least a reasonable level of attention to their selection;
- leather and imitations of leather and goods made of these materials and not included in other classes, traveling bags, umbrellas and parasols in MV's designation in class 18 are identical or highly similar to the similarly worded goods in class 18 of JMB's application No. 6387757 and highly similar to the

retail services associated with the sale of such goods in class 35 in the same application;

- trunks in MV's designation are highly similar to the bags and related retail services in JMB's application;
- there is a low degree of similarity between the walking sticks in MV's designation and the umbrellas and parasols in JMB's application in class 18;
- there is no similarity between animal skins, whips, harness and saddlery in MV's designation and any of the goods and services in JMB's application;
- there is a degree of similarity between leather and imitations of leather and goods made of these materials and not included in other classes, traveling bags in MV's designation and JMB's clothing, footwear and headgear;
- none of the goods which remain in MV's designation i.e. Animal skins, trunks, umbrellas, parasols and walking sticks, whips, harness and saddlery are similar to JMB's goods in class 25 or its associated retail services in class 35;
- MV's goods in class 25 are identical to the goods contained in class 25 in all of JMB's registrations and are similar to JMB's retail services in class 35 insofar as those services related to the retailing of clothing footwear and headgear;
- the distinctiveness of MV's trade mark lay in its totality;
- JMB's trade marks are dominated by the element jojo/JoJo/JOJO;
- the competing trade marks are visually similar to a reasonable degree;
- the competing trade marks are aurally identical/highly similar;
- the competing trade marks are conceptually highly similar;
- absent use, JMB's trade marks are possessed of a reasonably high degree of inherent distinctive character;
- the use JMB had made of its JoJo Maman Bébé trade mark has (regardless of its presentation) resulted in it acquiring an enhanced distinctive character in relation to maternity, baby and children's wear and to the retailing both of these goods and to a range of nursery products which include, for example, a range of bags, baby carriers etc.

54. In summary, I have found MV's trade mark to be either highly similar or identical to the distinctive and dominant element of JMB's trade marks and, insofar as class 25 of MV's designation is concerned, I have found the goods to be identical to the goods

contained in class 25 of both of JMB's registrations. When considered in combination, these factors lead to a finding of, at the very least, a likelihood of indirect confusion i.e. where the average consumer assumes the goods originate from undertakings which are economically linked.

55. As to the class 18 element of MV's designation, the same considerations apply in relation to the comparison of the respective trade marks. As to the competing goods and services, I have found that leather and imitations of leather and goods made of these materials and not included in other classes, traveling bags in MV's designation are similar to JMB's clothing, footwear and headgear in class 25. Although the degree of similarity in the goods is limited, this is offset by what I consider to be the high degree of overall similarity in the competing trade marks, such that once again a finding of, at least, indirect confusion is appropriate.

56. However, JMB are in an even stronger position in class 18 in relation to its earlier trade mark No. 6387757 which would, on the basis indicated above, also result in, at least, indirect confusion in relation to trunks, umbrellas, parasols and walking sticks as well as the goods mentioned above. However, that trade mark is still at the application stage and will not become an "earlier trade mark" under the provisions of section 6(1)(a) of the Act until such time as it becomes registered (section 6(2) of the Act refers).

57. Finally, although I have found a high degree of similarity in the respective trade marks, I have found no similarity between JMB's goods and services and animal skins, whips, harness and saddlery in MV's designation. As there must be at least some degree of similarity between the respective goods and services to engage the test for likelihood of confusion, JMB's opposition under section 5(2)(b) against these goods must fail.

Conclusion under section 5(2)(b)

58. JMB's opposition based upon registration Nos: 2349755 and 2134348 succeeds in relation to the class 25 element of MV's designation and in relation to the following goods in class 18: Leather and imitations of leather and goods made of these materials and not included in other classes, travelling bags." If and when application No. 6387757 is registered, and assuming the specification in class 18 survives in its current form JMB's opposition will also succeed in relation to trunks, umbrellas, parasols and walking sticks. JMB's opposition has failed in relation to: animal skins, whips, harness and saddlery.

The opposition based upon section 5(4)(a)

59. JMB's opposition is also based upon section 5(4)(a) of the Act under which they rely upon the use they have made of the signs JOJO and JOJO MAMAN BÉBÉ since 1993 in relation to a range of goods (including those in classes 18 and 25) but which also extends to a range of other goods such as baby products, maternity products, household containers, household products, toys, games, sporting articles, car seats,

baby seats, textile products, bedding and blankets, rails and stair guards, child safety apparatus, clocks, music boxes, light and lamps and the retail services associated with these goods. I only intend to consider this ground to the extent that JMB have not already succeeded in these proceedings i.e. in relation to: animal skins, whips, harness and saddlery. Section 5(4)(a) states:

“5.(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

60. In reaching a conclusion, I note the comments of the Appointed Person, Mr Geoffrey Hobbs QC, in *Wild Child Trade Mark* [1998] RPC 455. In that decision Mr Hobbs said:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

61. First I must determine the date at which JMB's claim is to be assessed; this is known as the material date. In this regard, I note the judgment of the General Court in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07. In that judgment the GC said:

"50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000."

62. The priority date of MV's designation, 8 January 2010 is, therefore, the material date. However, if MV has used his trade mark prior to this, then this use must also be taken into account. It could, for example, establish that he is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed; any of which could mean that MV's use would not be liable to be prevented by the law of passing-off – the comments in *Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer. As MV has not filed any evidence in these proceedings, the material date is that mentioned above.

63. Given my comments earlier in this decision on the evidence filed by JMB, I have no hesitation accepting that the business conducted by them using the trade marks JOJO MAMAN BÉBÉ and to a lesser extent JOJO is sufficient for them to have generated a protectable goodwill in these signs in the sector of the market they themselves describe in their own catalogues as "maternity, baby and child, nursery and toys". I have already found that the competing signs are sufficiently similar for misrepresentation to occur and I accept that in relation to the same or similar goods and services damage may be inferred were MV to use the trade mark the subject of his designation. Of course, in actions for passing off, there is no need for a common field of activity - the comments in *Lego System Aktieselskab and Another v Lego M. Lemelstrich Ltd* [1983] FSR 155 refer. However, in *Harrods v Harrodian School* [1996] RPC 697, the difficulty in establishing confusion where there is a distance between the fields of activities was considered by Millet LJ who stated:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

In the same case Millet LJ held:

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

64. It is clear from the above, that the proximity of trade is a highly relevant factor. In my view, the area of trade in which JMB operates and the area of trade in the objectionable goods which remain, are simply too different for, in the words of Millet LJ, the public to suppose that JMB has made itself responsible for the quality of MV’s animal skins, whips, harness and saddlery. JMB’s opposition based upon section 5(4)(a) to the remaining objectionable goods, fails.

Overall conclusion

65. JMB’s opposition under section 5(2)(b) of the Act has succeeded to the extent indicated above in classes 18 and 25 based upon its registered trade marks. Insofar as JMB’s opposition has succeeded in relation to the additional goods in class 18, it will be necessary to await the registration of No. 6387757.

Costs

66. JMB has been largely successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, and irrespective of the outcome of application No. 6387757, I award costs to JMB on the following basis:

Preparing a statement and considering MV’s statement:	£300
Preparing evidence :	£500
Official fee:	£200
Written submissions:	£300
Total:	£1300

67. I direct that JMB advise the tribunal of the outcome of application No. 6387757 within one month of its registration or refusal. I will then issue a supplementary decision from which the appeal period for both the substantive and costs issues will commence.

Dated this 27th day of March 2012

**C J BOWEN
For the Registrar
The Comptroller-General**