

O/175/06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2363640 IN THE NAME OF
TANNER KROLLE LTD**

AND

OPPOSITION THERETO UNDER NO. 92989 BY MUNDI S.r.L.

TRADE MARKS ACT 1994

**IN THE MATTER OF application
No. 2363640 in the name of Tanner
Krolle Ltd and opposition thereto
under No. 92989 by Mundi S.r.L.**

Background

1. On 19 May 2004 Withers & Rogers, on behalf of Tanner Krolle Limited, filed an application under No. 2363640 for registration of the following mark:



TANNER KROLLE

2. The application was in respect of the following goods and services:

Class 18

Bags; belts; briefcases; cases; wallets; pouches; luggage; military straps; vanity cases; leather jewellery cases; hat boxes and shoe boxes of leather; night safe wallets; security cases; bullion bags; document cases; articles of leather; parts and fittings for all the aforesaid goods.

Class 25

Clothing; footwear; headgear.

Class 35

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail handbag, luggage and leather goods store; the bringing together, for the benefit of others, of a variety of handbags, luggage and leather goods, enabling customers to conveniently view and purchase those goods in a wholesale outlet; the bringing together, for the benefit of others, of a variety of handbags, luggage and leather goods, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order; sales promotion services, provision of advice, information and assistance to customers with regard to the selection and purchase of handbags, luggage and leather goods; advertising and promotion services relating to handbags, luggage and leather goods.

3. On 29 November 2004 Fry Heath & Spence LLP, on behalf of Mundi S.r.L. filed a notice of opposition. The grounds of opposition are, briefly:

- under section 5(2)(b) of the Act based on the close similarity of the mark to the emphasised element Kroll in the opponent's earlier community trade mark No. 544692; and
- under section 5(3) of the Act because in view of the reputation in the earlier mark, use of the mark applied for would take unfair advantage of or be detrimental to the distinctive character or reputation of the opponent's earlier mark.

4. The applicant filed a counter-statement essentially denying the opponent's claims and requesting proof of use of the opponent's claimed use. The applicant also claimed to have the benefit of substantial rights and goodwill in their mark due to its continued use since 1856.

5. Both parties filed evidence and both ask for an award of costs. Neither requested to be heard but both filed written submissions. After a careful study of all the papers, I give this decision.

Opponent's evidence

6. The opponent's evidence consists of two witness statements dated 30 June 2005 by Elena Gagliardi. In her first witness statement, Ms Gagliardi confirms she is competent in the English language and has translated the evidence in these proceedings. She certifies the translations as true translations to the best of her knowledge and belief.

7. Ms Gagliardi's second witness statement confirms she is the Manager of the opponent company, a position she has held since 12 May 2005. Ms Gagliardi confirms the facts in her statement come from her own personal knowledge or the records of her company and that she is authorised to speak on behalf of her company.

8. Ms Gagliardi states that the essential elements of Community Trade Mark No. 544692 have been used in the UK throughout the 5 year period ending with publication of the mark in suit on 27 August 2004.

9. Attached to her witness statement is one exhibit which introduces a number of photocopies of invoices and includes what are said to be translations thereof. The translations provided are merely translations of parts of blank invoices-they do not translate the totality of the information written on the photocopied invoices. The invoices themselves are said to show use of the essential elements of the earlier mark in the relevant period in various locations throughout the UK.

Applicant's evidence

10. The applicant's evidence consists of a witness statement of Thomas Bernard Manning Holcroft and is dated 25 October 2005. Mr Holcroft says he is a Director of

the applicant company, a position he has held since 22 April 2002. He is authorised to make the statement of behalf of the applicant and the facts he gives are from his own knowledge and the records of his company.

11. Mr Holcroft explains that his company was owned by the Krolle family until 1992 when ownership transferred to the Chanel Group. In April 2002, the business was purchased by the applicant company. At TBMH1 he exhibits an extract from the UK Trade Marks Register showing registration No. 1511219 which he says was “used during this time”. I am not sure what he means by this but note that the trade mark was applied for on 2 September 1992.

12. Mr Holcroft says that the trade mark Tanner Krolle was first used in the UK in 1856 in connection with English bridle leather luggage such as Gladstone bags, steamer trunks, hatboxes and vanity cases. At exhibit TBMH2 he exhibits a brief history of his company.

13. Mr Holcroft provides details of the sales figures of goods sold and services provided under the trade mark by his company as follows:

Year	Turnover (£,000)		Units sold	
	UK	Export	UK	Export
2000	1000	N/A	4500	N/A
2001	1080	50	4300	300
2002	655	50	2400	250
2003	750	75	3100	400
2004	350	75	1100	400

(to 19.05.04)

14. Figures for advertising and promotional spend for the same period are also provided as follows:

Year	Expenditure (approx) (£'000)
2000	1000
2001	500
2002	100
2003	460
2004	200

(to 19.05.04)

15. Mr Holcroft says the trade mark applied for has been used throughout the UK and gives details of the specific towns and cities involved throughout England, Ireland, Scotland and Wales. Mr Holcroft says the mark has been the subject of various articles in magazines and newspapers and at TBMH3 exhibits examples of these. He goes on to say that the mark has been displayed at various exhibitions and trade shows including the London Fashion Week 2000-2004 and Paris Fashion Show September 2004.

16. Mr Holcroft concludes by saying that the opponent’s and applicant’s marks have co-existed for many years. He says his company has manufactured similar items to

those available from the opponent with no cases of confusion over at least the last five years.

17. That concludes my summary of the evidence.

Decision

18. The opposition is based on objections under sections 5(2)(b) and 5(3) of the Act. Section 5(2) states:

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

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

(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

19. It is not disputed that the trade mark relied on by the opponent is an earlier trade mark within the meaning of Section 6 of the Act. The registration procedure for the earlier mark was completed on 3 March 1999 which is before the start of the period of five years ending with the date of publication of the application in suit, which was 27 August 2004. These proceedings are therefore also subject to the Trade Marks (Proof of Use, etc.) Regulations 2004. Section 4 of those Regulations amend section 6 of the Act by the addition of the following:

“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 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, and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) 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)
- (7)"

20. In its counter-statement, the applicant puts the opponent to proof of its use of its earlier mark. For its part, the opponent makes no claim to have used its earlier mark as registered and certainly there is nothing in the evidence which would have supported any such claim. What the opponent does claim, however, is to have used the “essential elements” of the mark. Although not explicitly pleaded, I take this to be a claim under section 6A(4)(a) as introduced by the Trade Marks (Proof of Use, etc.) Regulations 2004.

21. Also of relevance is section 100 of the Act which states:

“100. 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.”

22. The evidence filed by the opponent is not extensive. It consists of copies of thirteen invoices (A-M) and three letters. Although not all identical, each of the invoices has a similar layout. They each bear different dates ranging between September 1999 and March 2003. None show the opponent's earlier mark as registered. Each of them has been completed to include a description of the goods by what appears to be a catalogue number and style name. No explanation is provided to indicate to what particular products these catalogue numbers or style names refer. That said, the invoices also provide spaces for details of the number of "pairs" ordered, their sizes and the relevant price. The "sizes" correspond to what I know from my own knowledge to be continental footwear sizes. With the exception of invoices A and H the "sizes" and "pairs" boxes have been completed. Two of the invoices (G and I) are accompanied by letters which appear to be from the relevant customer and refer to orders for shoes although I note the second of these is undated. Despite the lack of precision, I am prepared to accept that the invoices (with the exception of invoices A and H) relate to footwear.

23. Each of the invoices appear to be issued by a company called Alba S.r.L. They each also refer to a showroom at or called Gagliardi Salvatore/Salvatore Gagliardi. None make any reference to the opponent company Mundi S.r.L. Of the letters which accompany the invoices, one appears to have been sent to a customer (D) and two to have received from customers (G and I). Again none make any reference to the opponent company. Letter D is on headed paper bearing the name Gagliardi. Letter G is addressed to "Alba Kroll, Gagliardi Salvatore" and letter I to "Kroll, Gagliardi Salvatore". All of the invoices and letters bear trade marks other than Kroll, although Kroll is of greater prominence on some than others.

24. In her witness statements, Ms Gagliardi gives no explanation of what relationship might exist between the opponent company and the companies whose names appear on the invoices and letters. Whilst she indicates that the essential elements of the mark have been used, she makes no claim as to who may have used it. Certainly, from the evidence, I cannot be sure that any use was made by or with the consent of the opponent company. And despite the commonality of Ms Gagliardi's surname with names appearing in the exhibits, I cannot be certain that she personally has a connection with the creation of this documentation other than exhibiting it in her role as a manager of the opponent company. I note that she says in her witness statement that she took up the role of manager approximately six weeks before she made that statement and therefore long after the dates the documentation forming the exhibit was created.

25. In *Laboratoire De La Mer Trade Marks* [2002] FSR 51, Jacob J stated:

"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 the i's dotted."

26. Proof of use by the proprietor of the earlier mark, or with his consent, must be a matter of fact to be established by evidence and not a matter of conjecture and speculation. It seems to me that it would not have been difficult for the opponent to file evidence explaining the relationship (if any) between it and the company who

issued the invoices. The onus is on the opponent; the opponent has failed to discharge that onus. In light of the provisions of section 6A(2) of the Act and the failure of the opponent to establish use of the trade mark on which the opposition is based, by it or with its consent, the opposition under section 5(2) fails.

27. I do not intend to go on to consider whether the evidence of use supports any claim made under the provisions of section 6A(4)(a) of the Act. In view of my decision under section 5(2) and my comments on the evidence filed, neither do I intend to consider the ground of opposition under section 5(3).

Costs

28. The opposition has failed and the applicant is entitled to an award of costs in its favour. I take into account that a decision was made without a hearing taking place. I order the opponent to pay the applicant the sum of £1800 as a contribution toward its costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of June 2006

**ANN CORBETT
For the Registrar
The Comptroller-General**