

O/199/12

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF REGISTRATION NO 2136062

IN THE NAME OF WARDROBE (BEAUTIFUL CLOTHES) LIMITED

AND THE APPLICATION FOR A DECLARATION OF INVALIDITY

BY MEEMI LTD

THERE TO UNDER NO 83702

AND REGISTRATION NOS 2536245 AND 2536246

IN THE NAME OF MEEMI LTD

AND THE APPLICATIONS FOR DECLARATIONS OF INVALIDITY THERE TO

UNDER NOS 83888 AND 83889

BY WARDROBE (BEAUTIFUL CLOTHES) LIMITED

1) Trade mark no 2136062 is registered for the trade mark WARDROBE for:

bags for women;

suits, jackets, trousers, evening wear, knitwear, shoes, headgear; all for women.

The above goods are in classes 18 and 25 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. It is owned by Wardrobe (Beautiful Clothes) Limited (WBC). The application for registration was filed on 16 June 1997 and the registration process was completed on 17 December 1999. The application proceeded to advertisement on the basis of distinctiveness acquired through use and trade evidence. It also proceeded on the basis of honest concurrent use with other earlier registrations.

2) Trade mark no 2536245 is registered for the trade mark MY-WARDROBE.COM. Trade mark no 2536246 is registered for the trade mark:



my
wardrobe.com

Both trade marks are registered for:

bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; after-shave lotions; bath salts (not for medical purposes); baths (cosmetic preparations for); cosmetic kits; hair colorants; hair spray; nail care preparations, polish and varnish; make-up; skin care (cosmetic preparations for); toiletries;

precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; chronometric instruments; watches and clocks; bracelets; brooches; necklaces; clock cases; cuff links; earrings; rings; tie clips; tie pins; Jewellery cases; watch cases; keyrings; belt buckles of precious metals; hat ornaments of precious metal; watch straps; watch bands; watch springs; watch cases; parts and fittings for all the aforesaid goods;

leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; bags;

handbags, beach bags, sports bags, backpacks; briefcases, suitcases, holdalls; purses and wallets; vanity cases (not fitted); luggage; garment bags for travel; shopping bags; shoulder bags; clutches;

clothing, footwear, headgear; shirts; skirts; dresses; blouses; sweatshirts; jackets; hats; caps; t-shirts; rainwear; sportswear; leisurewear; underwear; coats; neckwear; scarves; gloves; belts; boots; shoes; socks; stockings; tights; bras; garments for women; garments for men; garments for children; neckties; outerclothing; suits; trousers; pants; jeans; corduroy trousers; shorts; boxer shorts; parkas; overcoats; scarves; shawls; ear muffs; pullovers; jumpers; cardigans; knitwear; evening wear; beach clothes; hosiery; pyjamas; bathrobes; dressing gowns; lingerie, bodices, brassieres, camisoles, corsets, slippers; swimwear; sandals; slippers; trainers; sports shoes; parts and fittings for the above mentioned goods;

advertising; business management; business administration; office functions; administration of the business affairs of retail stores; the bringing together, for the benefit of others of a variety of goods, namely, clothing, footwear, headgear, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, chronometric instruments, leather and imitations of leather, and goods made from these materials, animal skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddlery, enabling customers to conveniently view and purchase those goods in a retail store; the bringing together, for the benefit of others of a variety of goods, namely, clothing, footwear, headgear, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, chronometric instruments, leather and imitations of leather, and goods made of these materials, animal skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddlery, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order or by means of telecommunications; the bringing together, for the benefit of others, of a variety of goods, namely, clothing, footwear, headgear, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, chronometric instruments, leather and imitations of leather, and goods made of these materials, animal skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddlery, enabling customers to conveniently view and purchase those goods from an Internet website or other communications network.

The above goods and services are in classes 3, 14, 18, 25 and 35 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The applications for registration were filed on 14 January 2010 and the registration processes were completed on 18 June 2010. Both registrations are in the name of Meemi Ltd (Meemi).

3) On 2 March 2010 Meemi filed an application for the invalidation of WBC's registration. It seeks invalidation of the registration on the basis of sections 3(1)(b) and (c) of the Trade Marks Act 1994 (the Act). The relevant provisions of the Act are:

"47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered."

"3. - (1) The following shall not be registered –

.....

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

.....

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

Meemi states that the trade mark of WBC consists exclusively of the ordinary English word WARDROBE. It states that because of this the registration of the trade mark was contrary to sections 3(1)(b) and (c) of the Act. Meemi states that the evidence submitted by WBC at the examination stage did not establish that

the trade mark had acquired a distinctive character as a result of the use made of it.

4) WBC denies that its trade mark lacks distinctive character. It states that during the prosecution of the application it put forward evidence to demonstrate that the trade mark had acquired distinctive character through use. It states that there is no direct and specific relationship between WARDROBE and the goods of the registration and so no basis for the ground of invalidation under section 3(1)(c) of the Act. WBC denies that the trade mark is devoid of any distinctive character, as per section 3(1)(b) of the Act.

5) On 25 October 2010 WBC filed applications for the invalidation of the two trade mark registrations of Meemi. It relied upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act. However, at the hearing in relation to these proceedings the grounds of invalidation under section 5(3) of the Act were dropped. In relation to section 5(2)(b) it relies upon the registration the subject of Meemi's application for invalidation.

Section 5(2)(b) of the Act states:

“(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.”

Section 5(4)(a) of the Act states:

“(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”.

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing

public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

6) As WBC's trade mark had been registered for more than five years at the date of the filing of the applications for invalidation, proof of genuine use of it is required (if requested by the other party)ⁱ for the period from 26 October 2005 to 25 October 2010. WBC claims that it made genuine use of its earlier trade mark during this period for all of the goods of the registration.

7) WBC claims that all of the goods and services of the registrations of Meemi are identical or similar to the goods of its earlier registrations. It claims that through use, its trade mark has acquired increased distinctive character

8) In relation to section 5(4)(a) of the Act, WBC claims that it first used WARDROBE in 1973 in London. It claims that it has used WARDROBE in respect of clothing, clothing accessories and related fashion items; retail services connected with the sale of clothing, clothing accessories and fashion items; style consultancy services.

9) Meemi requires WBC to prove genuine use of its earlier trade mark within the material period. It denies that its trade marks and that of WBC are similar and that there is any degree of overlap between the respective goods and services. Meemi denies that WBC's trade mark has acquired increased distinctive character through use. Meemie denies that the registration of its trade marks was contrary to section 5(4)(a) of the Act.

10) Meemi claims that WARDROBE is inherently descriptive and will not be seen by relevant consumers as an indicator of origin. However, when wardrobe is used with the other elements of its trade marks, these trade marks are distinctive. Meemi states that it has used its trade marks for a number of years in connection with the goods and services of its registrations.

11) In *Premier Luggage and Bags Ltd v. Premier Co (UK) Ltd & Another* [2002] ETMR 69 Chadwick LJ stated:

“51 The relevant question, therefore, is whether the trade mark had acquired a distinctive character through use in connection with products supplied by Premier Luggage either by the date of application, or (if not) by the date of the trial. The judge did not differentiate between those dates -because, as he said at paragraph 21 of his judgment:

"Although the proviso [to section 3(1) of the Act] refers to the mark acquiring distinctiveness prior to the date of the application for registration, section 47 of the 1994 Act provides that, if it is sought to obtain a declaration of invalidity where a mark has already been registered, it is sufficient if a distinctive character has been acquired since registration."

52 There is, I think, a danger in that approach, because it fails to recognise where the burden of proof lies in the two cases. The position was explained by Jacob J. in the *British Sugar* case, at page 302 (lines 7-12). After pointing out that section 72 of the Act provided that registration of a person as proprietor was prima facie evidence of the validity of the original registration, Jacob J. went on to say this:

"This clearly casts the onus on he who wishes to attack the validity of the original registration. But once the attacker can show the registration was wrongly made (particularly for non-compliance with section 3(1)(b)-(d)) and the proprietor wishes to rely on the proviso to section 47(1) it is for the proprietor to show that is [sic] mark is distinctive."

The inherent distinctiveness of WBC's trade mark must be considered at the date of the filing of the application, 16 June 1997. Any distinctiveness acquired through use must be first considered at the same date. As per the judgment of Chadwick LJ, Meemi must establish that the registration was incorrectly made; this must take into account both the nature of the trade mark and the evidence which was submitted which allowed the mark to proceed to publication, as the latter formed the basis for the registration of the trade mark. As per section 47(1) of the Act, WBC can rely upon use of its trade mark after registration to establish distinctiveness, if necessary. Mr Engelman submitted that WBC could not rely upon use after the date of registration. He based this upon the judgment of the General Court (GC) in *eCopy Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-247/01*. However, that case relates to an application for registration which was refused by OHIM, not a registration. Mr Engelman submitted that the proviso to section 47(1) of the Act is outwith the provisions of Directive 2008/95/EC of the European Parliament and

the Council of 22 October 2008 (the Directive). Article 3(3) of the Directive states:

“3. A trade mark shall not be refused registration or be declared invalid in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character. **Any Member State may in addition provide that this provision shall also apply where the distinctive character was acquired after the date of application for registration or after the date of registration.**”

(emphasis added)

The United Kingdom, through the proviso, has adopted the option. (Even if the proviso were outwith the provisions of the Directive, which it is not, it would be necessary to apply it as it is primary legislation.)

12) Mr Malynicz submitted that the cut-off date should be the date of the application for invalidation; otherwise parties could delay hearings in order to benefit from further use. It is possible that use up to the date of the hearing could be taken into account; there is nothing in the legislation prohibiting this. However, as Mr Malynicz has limited the time that WBC relies upon, the decision will use the date of the application for invalidation, 2 March 2010. In the event, nothing turns upon whether the evidence of use is considered at 2 March 2010 or at the date of the hearing.

13) WBC must establish genuine use of its earlier trade mark in relation to the goods and services of its registration during the period 26 October 2005 to 25 October 2010.

14) A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20, 1993. This was the subject of consideration by the General Court (GC) 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 which the GC stated:

“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.”

The reasoning of the GC, *mutatis mutandis*, is followed in relation to the Act. Consequently, the first thing that WBC must establish is that there was a protectable goodwill at the date of the filing of Meemi’s registrations.

15) In BL O/090/11 the hearing officer stated:

“40) However, under the law of passing-off it is necessary to consider what the position was as of the earliest date of the behaviour complained ofⁱⁱ. In this case the evidence shows that Mr Thorpe was running an event he described as ROBOT WARS on 7 April 2007 at Colchester Leisure Centre. Prior to this Mr Thorpe had publicised robot fighting events by reference to machines from *ROBOT WARS* rather than describing the events as ROBOT WARS. The publicity would have been issued prior to this date and so the behaviour complained of would have first occurred prior to this date but it is not possible to ascertain how much earlier. Whatever the date it will have been well after the date of application, 17 June 2006, so the first date of the behaviour complained of is the date of the application for registration.

41) This is an application for invalidation which gives rise to further matters for consideration. Professor Annand, sitting as the appointed person, in BL O/227/05 stated:

“36. My own view is that the starting point for assessing relative invalidity under section 47(2) is the date of the application for registration of the attacked mark. This is because Article 4 of the Directive: (i) defines “earlier trade marks” for the purposes of relative invalidity as trade marks with a date of application for registration which is earlier than the date of application for registration of the attacked mark; and (ii) requires other earlier rights to have been acquired before the date of the application for registration of the attacked mark. However, I believe the wording of Article 4 (section 47(2)) may allow the tribunal to take into account at the date when invalidation is sought, matters subsequently affecting the earlier trade mark or other earlier right, such as, revocation for some or all of the goods or services, or loss of distinctiveness or reputation. I do not find the fact that the Directive specifically provides for defences to invalidation of non-use, consent and acquiescence indicative either way. A further question concerns the cut-off date for taking into account subsequent events. Is this the date of the application for a declaration of invalidity or the date when the invalidity action or any appeal is heard? The Opinion of Advocate General Colomer in Joined Cases

C-456/01 P and C-457/01P Procter & Gamble v. OHIM, 6 November 2003, paragraphs 43 – 44, and the Court of First Instance decision in Case T-308/01 Henkel KGaA v. OHIM (KLEENCARE), 23 September 2003, paragraph 26, although concerned with registrability and opposition respectively, indicate the latter. There are indications that timing issues under the harmonised European trade marks law are beginning to be brought to the attention of the ECJ (see, for example, the questions referred in Case C-145/05 Levi Strauss & Co. v. Casucci SPA).”

In *Levi Strauss & Co v Casucci SpA* Case C-145/05 the CJEU stated:

“17 The proprietor’s right to protection of his mark from infringement is neither genuine nor effective if account may not be taken of the perception of the public concerned at the time when the sign, the use of which infringes the mark in question, began to be used.

18 If the likelihood of confusion were assessed at a time after the sign in question began to be used, the user of that sign might take undue advantage of his own unlawful behaviour by alleging that the product had become less renowned, a matter for which he himself was responsible or to which he himself contributed.

19 Article 12(2)(a) of Directive 89/104 provides that a trade mark is liable to revocation if, after the date on which it was registered, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered. Thus, by balancing the interests of the proprietor against those of his competitors in the availability of signs, the legislator considered, in adopting this provision, that the loss of that mark’s distinctive character can be relied on against the proprietor thereof only where that loss is due to his action or inaction. Therefore, as long as this is not the case, and particularly when the loss of the distinctive character is linked to the activity of a third party using a sign which infringes the mark, the proprietor must continue to enjoy protection.

20 In the light of all the foregoing, the answer to the first and second questions must be that Article 5(1) of Directive 89/104 must be interpreted as meaning that, in order to determine the scope of protection of a trade mark which has been lawfully acquired on the basis of its distinctive character, the national court must take into account the perception of the public concerned at the time when the sign, the use of which infringes that trade mark, began to be used.....

36 Accordingly, after revocation in the particular case has been established, the competent national court cannot order cessation of the use of the sign in question, even if, at the time when that sign began to be used, there was a likelihood of confusion between the sign and the mark concerned.

37 Consequently, the answer to the fourth question must be that it is not appropriate to order cessation of the use of the sign in question if it has been established that the trade mark has lost its distinctive character, in consequence of acts or inactivity of the proprietor, so that it has become a common name within the meaning of Article 12(2) of Directive 89/104 and the trade mark has therefore been revoked.”

The House of Lords considered at what date the question to be decided was to be considered in relation to section 46(1)(d) of the Act in *Scandecor Development AB v Scandecor Marketing AB* [2002] FSR 7. In that judgment Lord Nicholls stated:

“49 The claim in these proceedings is that, in consequence of the use made of the marks by Scandecor Marketing and Scandecor Ltd with the consent of Scandecor International, the marks are "liable to mislead the public". That is essentially a question of fact. That question of fact must be answered having regard to matters as they now are, not as they were at some time in the past. In deciding this issue of fact the court must have due regard, as I have been at pains to emphasise, to the message which a trade mark conveys. But since the question is whether the marks are currently liable to mislead, the message which is relevant is the message which use of the marks conveys today, not the message it would have conveyed to the public in the past.”

42) The decision of Professor Annand and the judgments of the CJEU and the House of Lords give rise to the conclusion that in an application for invalidation it is necessary to consider whether at a date after the filing of the application for registration it is appropriate to invalidate a registration. The considerations are not the same as those in relation to an opposition to registration. If a different approach was adopted one could, for example, arrive at the situation that an application for invalidation could succeed on the basis of an earlier trade mark that was registered at the date of the application for registration but which had expired ten years prior to the date of application for invalidation. In the absence of establishing acquiescence by the respondent, the registration would have to be invalidated. If a claim was made under the law of passing-off if the respondent had used the trade mark for 6 years then the Limitations Act

1980 might come into play. This was a matter considered by Pumfrey J in *Daimlerchrysler AG v Javid Alavi* (T/A Merc) [2001] RPC 42:

“67 Against these findings of fact, it is possible to deal with the complaint of passing-off shortly. It must fail. Mr Alavi has been trading under the style complained of since at least 1985. He had entered the market by 1978. He did not make any relevant misrepresentation then and he had not, down to 1997 essentially changed the manner of his trading. As Oliver L.J. (as he then was) said in *Budweiser (Anheuser-Busch v. Budejovicky Budvar* [1984] F.S.R. 413 at 462):

"The plaintiffs' primary submission is that the learned judge was wrong in regarding the material point of time at which he should consider the matter as the date of the writ. Obviously the plaintiffs must, to succeed, have a cause of action at that date, but Mr Kentridge submits, and Mr Jeffs does not contest, that it cannot be right to look simply at that date to see whether a passing off is established. In particular to test by reference to that date whether plaintiff and defendant have concurrent reputations would simply mean that no remedy lay against a defendant who had successfully passed off his goods as the plaintiffs', so as to establish a reputation for himself."

This is consistent with what was said by Lord Scarman, giving the opinion of the Board in *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Pty Ltd* [1981] R.P.C. 429 at 494: the relevant date in law is the date of the commencement of the conduct complained of. I should just add that there must come a time after which the court would not interfere with a continued course of trading which might have involved passing off at its inception but no longer did so: logically, this point would come six years after it could safely be said that there was no deception and independent goodwill had been established in the market by the protagonists. There must also be doubt as to the availability of injunctive relief if there is no passing-off at the date the action is commenced.”

43) Taking these matters into account, the position in relation to section 5(4)(a) of the Act must also be considered at the date of the filing of the application for invalidation. At that date could the respondent be prevented from using the trade mark under the law of passing-off?

44) To summarise, in relation to the claim under the law of passing-off LLC must establish that there was a protectable goodwill at both of the following dates:

- The date of application for registration (which in this case is also the date of the behaviour complained of): 17 June 2006.
- The date of the filing of the application for invalidation: 22 April 2009.

If LLC fails to establish a protectable goodwill at either of these dates its case under section 5(4)(a) will fail”

This reasoning is adopted in these proceedings^{*}, consequently, WBC must establish that it could have prevented use of Meemi’s trade marks both at the date of the application for registration, 14 January 2010, and the date of the applications for invalidation, 25 October 2010. (The only use in relation to Meemi that is exhibited are reviews of my-wardrobe.com, downloaded on 11 August 2011, consequently, any use by Meemi cannot affect the considerations in these proceedings.)

16) The evidence filed by the parties needs to be considered in relation to the following matters:

- Whether registration of WBC’s trade mark was contrary to sections 3(1)(b) and/or (c) of the Act at the date of filing; taking into account use up to the date of filing.
- Whether registration of WBC’s trade mark is contrary to sections 3(1)(b) and/or (c) of the Act; taking into account use after registration and up to the date of the filing of the application for invalidation.
- Whether at the date of the filing of Meemi’s registrations, WBC’s trade mark had increased its distinctiveness through use.
- Whether at the date of the filing of Meemi’s registrations and at the date of the filing of the applications for invalidation, WBC had a protectable goodwill in relation to WARDROBE for the purposes of the law of passing-off.
- Whether WBC had made genuine use of its trade mark in respect of the goods of the registration from 26 October 2005 to 25 October 2010.

17) The objection raised by the examiner, in relation to WBC’s application, on 3 July 1997 was phrased in the following terms:

“The application is not acceptable in Classes 18 & 25: there is an objection under Section 3(1)(b) & (c) because the mark consists exclusively of the word WARDROBE, being a sign which may serve to designate the kind of goods (eg. wardrobe trunks and cases in Class 18).”

The hearing officer’s report of 8 April 1998 states:

^{*} The reasoning is followed on the basis of the logic. The decision of the hearing officer is, owing to its status, neither persuasive nor represents precedent.

"I advised the agent that for Class 25 the mark appeared to be unregistrable given that the word seems to be simply an alternative for "Clothes". I agreed to consider any strong independent evidence regarding recognition but did not encourage it. (Comments regarding evidence in TREAT RPC referred to – "soap" for "soap" unlikely even to be distinctive). Similar evidence also needed for Class 18 although objections would seem less strong here."

18) Definitions of wardrobe downloaded on 27 February 2010 have been adduced. In the context of these proceedings the following definitions are pertinent:

"all of the clothes that a person owns";

"a collection of clothes: esp.,

- a. the complete supply of clothes of a person
- b. a supply of clothes for a particular season or purpose a spring wardrobe
- c. the collection of costumes of a theatre or theatrical company";

"a stock of clothes or costumes, as of a person or of a theatrical company";

"a collection of wearing apparel (as of one person or for one activity) < a summer wardrobe>";

"Garments considered as a group, especially all the articles of clothing that belong to one person";

"collection of clothes belonging to one person".

19) Copies of the accounts of WBC have been adduced by Meemie. The accounts do not show turnover.

20) Meemie has adduced evidence in relation to the value of the United Kingdom apparel industry from Datamonitor Group. The figures presented by Datamonitor relate to retail selling price and include all taxes. The following figures are given in £ billion:

2005	37.6
2006	39.1
2007	40.3
2008	40.6
2009	40.5

Datamonitor states that womenswear represents 54.6% of the market; menswear 32.1% and childrenswear 13.3%.

The female population of the United Kingdom, in thousands, was as follows:

1971	28,761
1981	28,943
1991	29,562
1995	29,878
1996	29,946
1997	30,019

(Figures from the Office for National Statistics.)

21) Parts of the evidence have been given, on behalf of both parties, in the form of statements in the same words by a number of witnesses. Lord Esher MR in *Re Christiansen's TM* [1885] 3 RPC 54 at 60 stated:

"Now, to my mind, when you have evidence given upon affidavit, and you find a dozen people, or twenty people, all swearing to exactly the same stereotyped affidavit, if I am called upon to act upon their evidence, it immediately makes me suspect that the affidavits are then not their own views of things and that they have adopted the view of somebody who has drawn the whole lot of the affidavits, and they adopt that view as a whole and say 'I think that affidavit right' and they put their names to the bottom."

This evidence has been given by persons involved with the fashion industry. Lloyd J stated in *Dualit Ltd's Trade Mark Application* [1999] RPC 890:

"33. The five trade witnesses include such people as a buyer of toasters for Harrods and a director of the relevant trade association, the Association of Catering Equipment Manufacturers and Importers. These five witnesses were asked, in January to April 1996, whether they associated the two designs, represented in two dimensions as in the application for registration, with any and if so what maker. They all said that they associated the design with the applicant. These, however, are people whose business it is to know the applicant's products and the products of other manufacturers in the market. The fact that they knew their job and could recognise the shapes as being those of the applicant's products does not seem to me to begin to show that "the relevant class of persons, or at least a significant proportion thereof, identify [the] goods as originating from a particular undertaking because of the trade mark". The relevant class of persons is not trade buyers such as these witnesses but customers."

22) Neither party has furnished evidence from the customers for WBC's goods, which will be the female public at large. The expert witnesses can speak for their own knowledge, they cannot speak for the relevant public and the state of knowledge of the relevant public.

23) Meemi has filed such evidence from Alexandra Fullerton of *Stylist Magazine*, Sarah Angus of *Stylist Magazine*, Lucie Green a freelance writer, Harry Briggs, an associate at Balderton Capital, Bhanita Mistry of Creative Coaching Lab and Claire Troughton of Ciaret Showroom. All of the witnesses state that they have had many years of experience in the fashion and clothing industries. They all state that at all times since 15 June 1997 they have identified the word wardrobe, on its own, as an ordinary English word and not as a trade mark identifying the goods of WBC's registration as originating from any particular undertaking, in particular WBC or any of its licensees. The witnesses state that they believe that wardrobe is entirely descriptive of the goods of WBC's registration and never has been distinctive of any undertaking in relation to such goods.

24) Meemi exhibits, at JRO-1, material downloaded from the Internet showing wardrobe being used by a number of undertakings in relation to goods:

ASOS – downloaded on 4 May 2011. This site promotes itself by the words “welcome to the world's biggest wardrobe”.

Brook Taverner – downloaded on 3 March 2011. The site refers to its WARDROBE stock collection, which is only available from specialist corporate clothing suppliers.

A page from “The Contemporary Wardrobe Collection rare & exotic street fashions 1947 – 2006” - downloaded on 11 July 2011. There is no indication as to what this refers or if it is from the United Kingdom, the domain name ends .com.

Total Wardrobe Care – downloaded on 11 July 2011. This is the name of an undertaking that supplies goods and services for the care of clothes.

Bigwardrobe.com – downloaded on 11 July 2011. It describes itself as a worldwide fashion exchange. There is no indication as to jurisdiction.

Classicwardrobe.co.uk – downloaded on 11 July 2011. It appears that various traders sell their wears through this website.

Joanna's Wardrobe – downloaded on 11 July 2011. It describes itself as a luxury lingerie boutique.

Wardrobe Costumes – downloaded on 11 July 2011. This is a website for the hire and sale of fancy dress costumes. (A copyright year of 2010 appears.)

Fancydresswardrobe.co.uk – downloaded on 11 July 2011. This describes itself as an online guide to fancy dress hire and fancy dress shops in the United Kingdom. (It bears a copyright year of 2005.)

Wendy's Wardrobe – downloaded on 11 July 2011. A fancy dress website.

Wacky Wardrobe – downloaded on 11 July 2011. A supplier of costumes, fancy dress and props.

25) Sir Stuart Rose, previously chief executive of Marks and Spence Plc, gives evidence for Meemi. From 2004 to 2008 Sir Stuart was chairman of the British Fashion Council. His experience in fashion retail began in 1971. Sir Stuart states that prior to being requested to give evidence in these proceedings he had not heard of WBC, its proprietors or its trade mark WARDROBE. Sir Stuart states:

“While I respect and encourage the enterprise of independent businesses and designers, especially those that seek to establish their own lines of clothing and promote the British fashion industry, this does not justify the monopolisation of a descriptive term such as WARDROBE, which should be available for all traders to use within the fashion industry.”

26) Ms Angus has given a second witness statement. Ms Angus was a features writer for *Instyle Magazine*, *Sylist Magazine*, *Net-a-Porter.com* and *Elle*. Ms Angus states that prior to her involvement in these proceedings she was not aware of the existence of WBC or its trade mark WARDROBE. Ms Green has given a second witness statement in which, other than in relation to her experience, she states the same as Ms Angus. Ms Angus, inter alia, has been freelance fashion contributor to *The Financial Times*, *Telegraph Newspaper*, *Vogue*, *Women’s Wear Daily*, *In Style UK* and *The Mail on Sunday*. Ms Melanie Rickey, fashion editor of *Grazia*, has given evidence. Ms Rickey had previously been fashion news director of *Grazia*, a freelance contributor to *Vogue*, *ES* and *Elle* and a fashion feature director of *Nova*. Ms Rickey considers wardrobe as identifying the goods of WBC’s registration and not as indicating the goods of a particular undertaking. Ms Rickey states that prior to her involvement in these proceedings she was not aware of the existence of WBC or its trade mark WARDROBE. Similar evidence is given by Mark McMahon, who is fashion stylist for the band JLS. He has previously worked with Kate Moss, Juliette Binoche, Christian Slater and Marco Pierre White and “as a stylist for advertising agents including *Vanity Fair*, *Vogue*, *Jaeger* and *Topman*”. Ms Troughton has given another witness statement in which similar evidence is given. Prior to being a director of Claret Showroom, Ms Troughton worked for Ferragamo and Paul Smith. Malene Majlund gives similar evidence. Ms Majlund is director and founder of InExcess Fashion Ltd; she previously worked for Bruuns Bazaar, an independent fashion label. Sonal Patel gives similar evidence. Ms Patel is country manager at Day Birger et Mikkelsen. Ms Patel had previously worked for InWear, Saint Tropez and IC Companys. Mr Eric Musgrave gives similar evidence; except that he does not state that until these proceedings he had never heard of WBC. Mr Musgrave was previously editorial chief of *Drapers Magazine*, editor of *Fashion Weekly* and chief executive of UK Fashion & Textile Association.

27) All of the witnesses referred to in the last two paragraphs give their views as to the likelihood of confusion. Millett LJ in *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283 stated:

“The evidence of confusion or no confusion consisted of (i) evidence of witnesses purporting to testify to actual confusion; (ii) evidence of witnesses who had responded to a survey carried out on behalf of the plaintiff; and (iii) evidence of trade witnesses who gave their opinion of the likelihood of confusion. I agree with the judge that the last category of evidence was almost entirely admissible on the present issue. The function of an expert witness is to instruct the judge of those matters which he would not otherwise know but which it is material for him to know in order to give an informed decision on the question which he is called on to determine. It is legitimate to call evidence from persons skilled in a particular market to explain any special features of that market of which the judge may otherwise be ignorant and which may be relevant to the likelihood of confusion. It is not legitimate to call such witnesses merely in order to give their opinions whether the two signs are confusingly similar. They are experts in the market, not on confusing similarity.”

No weight is given to the opinions of the witnesses as to whether there is a likelihood of confusion which is a jury question.

28) Reviews of my-wardrobe.com, downloaded on 11 August 2011, are exhibited at JRO-4. The items reviewed all bear the trade marks of others. my-wardrobe.com is described as “one of the UK’s leading online retailers of accessible designer fashion, with carefully selected pieces from the world’s leading designers as well as new, exciting labels”.

29) Exhibited at JRO-8 is a page from the website of brooktaverner.com/uk, downloaded on 3 March 2011. The page includes: “[o]ur Brook Taverner and Wardrobes stock collections are only available from specialist corporate clothing suppliers”.

30) The evidence that was filed during the examination process is exhibited at VAF3. Susan Elaine Faux filed a statutory declaration dated 13 November 1997. Ms Faux was the managing director of WBC. She states that WBC is in the business of “selling exclusive top quality, classical business clothes and accessories, including bags, for women in connection with which my Company provides consultations and advice to customers as to which clothes and accessories would coordinate well. The clothes sold by my Company are selected from a wide range of top designers of tailored business wear”. A compliments slip is exhibited at page 5 with the name Wardrobe Consultancy upon it.

31) She states that WARDROBE was first used in relation to the goods sold in November 1973. Turnover figures were as follows:

1997	£1,223,055
1996	£1,050,510

1995	£941,143
1994	£883,367
1993	£658,815
1992	£757,800
1991	£867,597

32) Ms Faux states that WBC has advertised and promoted itself widely since 1973 by means of “extensive radio and T.V. interviews, substantial advertising expenditure, public relations and graphic design and printing and articles in quality national newspapers and magazines”.

33) At page 8 a description of WARDROBE appears. It is described as “a unique shopping experience”. The description includes the following:

“We will help you evolve a small, cleverly co-ordinated wardrobe to suit all occasions and we keep all the information you give us on record so no matter where you are in the world you are never too far away for us to be able to help you.

One of the most exciting things at Wardrobe is that you will find clothes that are not available anywhere else in England.”

At page 10 clothes are identified as being by Jil Sander, Erreuno, Wardrobe Italia, Titolo by Basile, Marina Rinaldi, Adrienne Vittadini, Ursula Conzen, Comma and Trixi Schober. At page 12 there is an advertisement for Wardrobe Consultancy, advertising the opportunity of “[f]ocusing on improving your self (sic) presentation”. The advertisement gives details of shops in Chiltern Street and Grosvenor Street, both in London W1. At page 14 is a copy of an article from *The Independent* about the Wardrobe Shop in Conduit Street, London W1. The article advises that the shop offers clothes, beauty treatment and a clothing consultancy. The article refers to clothes by Mani, Strenese, Jil Sander and Tagliaferri. Invoices for advertising and promotion are exhibited for, inter alia, *Harpers & Queen*, *Vogue*, *Elle*, *Evening Standard*, *Executive Woman*, *Times*, *Financial Times* and London Transport. At page 64 is a copy of a *Harpers & Queen* promotion that lists comments from customers. The customers comment on many of the labels being sold being unique to the shop and to private consultation. On page 66 in a *Vogue* promotion, reference is made to the various brands that are sold in the shop.

34) Ms Faux states that WBC published a book entitled *Wardrobe* in 1988, which has sold 25,000 copies worldwide. Ms Faux exhibits an advertising schedule and states that since 1980 approximately £771,309 has been spent on advertising and public relations and approximately £110,964 on printing and graphics.

35) Ms Faux states that goods have been sold under the trade mark by means of labels on the clothes, bags, packaging, receipts and correspondence. She states examples of labels and bags are exhibited at SEF4 but they are not included in the evidence adduced into these proceedings. Ms Faux states that WBC has a mailing list of 6,000 customers located throughout the United Kingdom. No further information is given in relation to the locations of these customers.

36) Four statutory declarations were also submitted as part of the evidence. Other than in relation to the personal details of the declarant all are written in the same words. The declarations are from Marcelle d'Argy Smith, who was the editor of *Womans Journal* and had previously been editor of *Cosmopolitan*; Clare Crocker, who worked for *Vanity Fair*, Jane Procter, who was editor of *Tatler* and Fiona Macpherson, who was editor of *Harpers & Queen*. They all state:

"I am aware that the term "wardrobe" appears in dictionaries and that the word is defined as "place where clothes are kept" or "person's stock of clothes".

Whilst I am familiar with the dictionary definition, I am also aware that bags and clothing, etc., sold under the WARDROBE Trade Mark are very well-known in the fashion field as products emanating from Wardrobe (Beautiful Clothes) Limited, and that the company has traded in the United Kingdom under the Trade Mark WARDROBE for the past 25 years. Thus, if I were to see WARDROBE used in a Trade Mark sense this would convey to me, and in my opinion, to everyone in the fashion field only goods emanating from Wardrobe (Beautiful Clothes) Limited. In particular the Trade Mark is well-known to me in connection with [designer] suits, jackets, trousers, evening wear, knitwear, bags, shoes and headgear.

I know of no other person, firm or company that would be entitled to use WARDROBE as a Trade Mark in the area of fashion and I am not aware that any other party would be inconvenienced by registration of the Trade Mark WARDROBE for clothing and related goods, in that non-Trade Mark use would not be affected."

The declarants might know of the trade mark; they cannot know if it is well-known.

37) The witnesses also give evidence in the final paragraph on trade mark law; not a matter in relation to which they are experts.

38) There is no exhibited evidence to show that the trade mark had been used for the class 18 and 25 goods of the registration. Ms Faux refers to carrier bags bearing the name. As Jacob J stated in *Euromarket Designs Inc v Peters* [2000] ETMR 1025 Jacob J stated:

“57. In this connection it should be borne in mind that the Directive does not include an all-bracing definition of “use”, still less of “use in relation to goods”. There is a list of what may *inter alia* be specified as infringement (Article 5(3), corresponding to section 10(4)) and a different list of what may, *inter alia*, constitute use of a trade mark for the purpose of defeating a non-use attack (Article 10(2), equivalent to section 46(2)). It may well be that the concept of “use in relation to goods” is different for different purposes. Much may turn on the public conception of the use. For instance, if you buy Kodak film in Boots and it is put into a bag labelled “Boots”, only a trade mark lawyer might say that that Boots is being used as a trade mark for film. Mere physical proximity between sign and goods may not make the use of the sign “in relation to” the goods. Perception matters too. That is yet another reason why, in this case, the fact that some goods were sent from the Crate & Barrel United States shops to the United Kingdom in Crate & Barrel packaging is at least arguably not use of the mark in relation to the goods inside the packaging. And all the more so if, as I expect, the actual goods bear their own trade mark. The perception as to the effect of use in this sort of ambiguous case may well call for evidence.”

The evidence shows that WARDROBE was being used as a retailer for the goods of others, primarily clothing for women. It was acting as clothing and style consultants for women. It does not show that the trade mark was being used to identify the goods of the registration. There is not a shred of evidence to support such use. The evidence all goes the other way. There is no indication as to turnover in relation to WARDROBE being used in relation to a bag or an item of clothing for women. If at the date of application, the trade mark was subject to objection under sections 3(1)(b) and/or (c), WBC could not pray in aid the use that it had made of its trade mark up to the date of the filing of the application for registration.

39) Mr Victor Anthony Faux, giving evidence for WBC, states that turnover for the WARDROBE brand has been as follows:

2010	£1,975,955
2009	£1,894,792
2008	£2,178,221
2007	£2,042,924
2006	£1,887,322
2005	£1,807,673
2004	£1,801,098
2003	£1,786,464
2002	£1,724,031
2001	£1,529,987
2000	£1,392,398

He does not state how these turnover figures are broken down in relation to specific goods and services.

40) Mr Faux states that WBC has around 6,000 customers throughout the United Kingdom on its mailing lists; again there is no identification as to from where they hail within the United Kingdom. He gives the following figures in relation to expenditure on advertising and promotion:

2010	£138,456
2009	£187,708
2008	£137,767
2007	£109,875
2006	£95,301
2005	£102,867
2004	£125,940
2003	£80,765
2002	£81,740
2001	£74,577
2000	£53,336

41) Mr Faux states that Ms Faux has advised women on clothes, hair, accessories and make-up for more than 37 years. She has published two books: *Wardrobe Develop your Style and Confidence*, English edition 1988 and Swedish edition 1991 and *Susie Faux – Wardrobe Solutions*, English edition 1999 and Spanish edition 2000. At VF1 matter relating to these books is exhibited. In the introduction to the former book, Ms Faux states: “You will have a smaller wardrobe than the one you own now...” At page 12 of the exhibit there is a reference to Ms Faux championing certain designers in her shop. At page 15, in a copy of an article from *The Times* of 24 November 1999 about the latter book, there are several references to wardrobe in the context of it describing an individual’s collection of clothes. An article at page 18 describes Ms Faux’s business as being a “one-stop style shop at 42 Conduit Street, London”. At page 20 an article refers to Ms Faux’s buying experience of 20 years.

42) Mr Faux states that “[n]umerous clothing and fashion ranges have adorned the WARDROBE label over the years, and from time to time, other well-known fashion labels have designed clothing and fashion accessories specifically for WARDROBE. On these occasions, the clothing has generally been co-branded with WARDROBE’s and the label’s own brand.” He describes material exhibited at VAF2 as a small selection of womenswear and fashion accessories, including jeans, belts, skirts, tops, suits and knitwear, provided under the trade mark WARDROBE. There is no indication of from when the examples emanate. Some of the reproductions are of too poor a quality to make out any detail. However, WARDROBE, on its own, appears as a sewn in label on a suit, a dress, trousers, a jacket and a skirt; all for women. Other sewn in labels show the name of an undertaking and WARDROBE: Piazza Sempione per

WARDROBE and Luciano Barbera per WARDROBE, WARDROBE by stefania carrera (a belt), Belrest? (the name is not clear) per WARDROBE. Price tags bearing the name WARDROBE are shown on various of the goods. As the shop is selling goods from a number of undertakings, its name appearing on price tags, in itself, is not indicative of a business outside of retailing.

43) Mr Faux states:

“All of the clothing items and related services provided by my Company have therefore been provided, either directly or by association, under the WARDROBE brand since the company’s inception.”

It is not understood what “by association” means. There is clear evidence that the brands of others have been sold at the premises: Jil Sander, Erreuno, Wardrobe Italia, Titolo by Basile, Marina Rinaldi, Adrienne Vittadini, Ursula Conzen, Comma and Trixi Schober. A retailer does not gain goodwill or rights in the products of others that have been sold under their names. Ms Faux states at page 66 of VAF3:

“Our style is sexiness, sophistication and confidence and that means not being stuck on one label.”

After this the following appears:

“The new shop still has Wardrobe’s classics, such as (illegible) Fusco’s wonderful tailoring, but there are new, exciting designers such as Flying Feeling (illegible) out its funky zip jacket), Marco Tagliaferri....”

On page 67 of VAF3 the following appears:

“Wardrobe has the Jil Sander version in creamy wool. It you need sharp suits try the perfect tailoring at Joop! and State of Claude Montana. Wardrobe’s eveningwear includes sensational dresses from Galiano as well as some slimming, skimming pieces from Benny Ong.”

44) Exhibited at VAF5 is a copy of a sales receipt dated 5 July 2010. The sales receipt bears the name WARDROBE. A number of clothing and footwear items appear on the receipt. There is no indication as to the trade marks used in relation to the items appearing on the receipt.

45) Exhibited at VAF6 are pages from the website wardrobe.co.uk from 10 May 2000 onwards. On the first page the visitor is advised that one can purchase pieces from Kiton, Luciano Barbera, Cividini, Piazza Sempione, Sergio Rossis “and many more”. The only premises identified are at 42 Conduit Street. At VAF7 are pages from the website for spring/summer 2011. The sole premises

are identified as Conduit Street. The introduction to the web site includes the following:

“As usual, our entire collection is sourced entirely from Italy from the best new designers and the best of the established ones – 85% of it exclusive to Wardrobe.”

There is reference to the stylists of Wardrobe. The dropdown menu to the left of the page has a button for Sfera.

46) Exhibited at VAF8 are details of web traffic for the website. Mr Faux refers to the number of hits for the web site. The Advertising Standards Agency considered the relevance of hits on a web site in its ruling in the Cool Diamonds.com Ltd case:

“The ASA noted Cool Diamonds kept a log of all the 'hits' to their website on their servers. We noted they had used the 'hits' figure because they believed it was an accurate reflection of the interest generated by their website. We acknowledged their point that a previous ASA adjudication had considered that the term 'hits' was unlikely to mislead readers.

We noted 'hits' referred to the number of items, such as files or images, retrieved from a website and that it was not equivalent to the number of pages viewed by a user or the number of visitors. We noted the more files or images present on a certain webpage, the more 'hits' the website received, which meant that one visitor could generate a high number of hits. We understood that 'hits' was not recognised as a measurement of website traffic by the Joint Industry Committee for Web Standards in the UK (JICWEBS); it only recognised measurements of unique users, page impressions or visits. We also noted the Institute of Direct Marketing website stated "Hit - a highly contentious term that rarely indicates the number of visitors to a website ... So from a marketing point of view, the bottom line is that the hits are misleading - they are never synonymous with the number of site visitors or page-views".

We considered that readers were likely to understand that the claim "5 million hits" was a reference to the websites popularity and that hits was a reliable measure of that popularity. We considered that some readers might go so far as to infer that each month Cool Diamonds had five million visitors or that five million web pages had been viewed by visitors. Because the number of hits a website received was unlikely to reflect, or be a reliable measure of, the number of visitors to the site or pages viewed, we concluded that the claim was likely to mislead readers into thinking the website was more popular than it was.”

In 2010 the website had 40,558 unique visitors who made 47,617 visits; so very few visitors returned. 50.7% of the visits were for less than 30 seconds. The majority of visits were from the United Kingdom (page 5). There is no indication that products can be bought from the website. The most common key word that led to the website was wardrobe, 55.3%. Other key words were uk, London, shop and clothes.

47) Ms Faux also has a blog which is hosted at confidencetricks.susiefaux.com. A copy of the blog is exhibited at VAF9. Ms Faux is described as being of WARDROBE and there are references to WARDROBE. There is also use of wardrobe in the context of meaning an individual's collection of clothes. At page 105, along with clothes, Ms Faux lists the following as forming part of what she calls a capsule wardrobe: a bag, a belt and jewellery. In no part of the blog is there reference to WARDROBE being used for clothes or bags. Ms Faux does refer to her own brand for clothing, Sfera.

48) Mr Faux states that the client mailing list is a key part of WBC's marketing strategy. No indication of the actual geographical spread of the mailing is given. He states that subscribers to the mailing list receive advanced notification of "new arrivals of WARDROBE clothes to the WARDROBE store, upcoming sales, exclusive fashion events and special offers". Exhibited at VAF10 are examples of this promotional material. At page 1 is the front cover of material for spring/summer 2008. The cover bears the names of various brands/designers. At page 61 reference is made to Dusan showing and discussing his collection for spring/summer 2006. At page 60 the reader is advised that "the shop will be hung with the new Luciano Barbera Collection". The material also has reference to the Sfera collection. The exhibit does not show any use of WARDROBE in respect of goods but use in respect of retailing clothes for women.

49) Exhibited at VAF11 are examples of promotions from *Harpers* magazine. Ms Faux is described as being the "inspiration behind the store and consultancy services Wardrobe". The promotion shows various articles of clothing, all of which are identified with brands other than WARDROBE.

50) Exhibited at VAF12 are copies of many press cuttings. The use of WARDROBE as a trade mark for goods is as follows:

Page 7- June 1974 – Wardrobe from Wardrobe.

Page 13 - 24 June 1974 - sweater, cardie and scarf from Wardrobe.

Page 14 - August 1974 – belt/necklace and scarf from Wardrobe.

Page 16 - 30 August 1974 – shirt.

Page 28 - leather bag, bangles, scarf.

Page 33 - umbrella and accessories.

Page 39 - scarf.

Page 40 - December 1974 - Handbag, scarf, jacket, pyjamas, baby doll, t-shirt, bandeau, trousers, lingerie and underwear, belts, skirt, "peasant gowns by Wardrobe". Shawl glass necklace, dress, blouse, shorts.

Page 334 - March 1983 - "Her won Wardrobe label is a source of pride to her".

Page 331 - Winter 1982/83 - "New in Wardrobe this season are some styles from Susie Gold herself, working with British fabric designers, using silk or cashmere, simply styled and impeccably cut."

Page 358 - Overcoat by Wardrobe – October 1983.

Page 383 "Crocodile bag, £1,210, Wardrobe" – June 1984.

Page 403 – hat – 5 December 1987.

Page 426 - 9/10 July 1988 – "Sketched here is a Wardrobe Italia cotton piqué suit".

The Lady for 5 to 11 June 1990: "WARDROBE also has its own label of Italian-styled tailored separates..."

Page 493 – "has now launched her own label, Wardrobe Italia" – December 1990.

Page 506 - 22 October 1988 refers to the launch of "a diffusion (cheaper) own-label line".

Page 514 – "she has her own label, Wardrobe Italia".

Consequently, the last exhibited evidence of use of WARDROBE in relation to goods was in 1990.

51) The following examples from the cuttings are illustrative of the nature of the WARDROBE business, as portrayed in the press:

The Times of 18 May 1978: "Wardrobe was started five years ago by a pretty young woman called Susie Gold. The merchandise is mainly imported and includes such luminous names as Christian Aujard, Georges Rech, Jill Sander, Jacques Gilles, and Viviane Viterbo."

Country Life of 11 December 1980 pages 277 to 279 – no mention of any articles under the name WARDROBE, all about the goods of others that it sells.

Page 483 – “WARDROBE, 17, (935 4086). The aim is a small, cleverly co-ordinated wardrobe; the look is soft-edged executive woman, moderate to expensive”.

Page 492 – “Their philosophy is to evolve a small, co-ordinated wardrobe to suit all occasions.”

Page 495 – “Working wardrobe”.

Page 504 – “but it is Jill Sander and Erre Uno on whom the bulk of Wardrobe’s business is based”.

Page 573 - “Wardrobe currently stocks Faux’s own-label Sfera Italia, which comprises separates, coats, knits, dresses, bags and accessories, as well as the Sfera perfume collection.”

Page 710 – “The very best – from recognised labels such as Richard Tyler, Strenesse, and Sergio Rossi to names that are exclusive to Wardrobe such as Kiton, Barbera, and Fabbri.”

52) There are references to WARDROBE as style consultants and giving image consultancy. A number of the articles concentrate on Ms Gold/Faux. Much of the coverage is simply identifying WARDROBE as the shop where the products of other are available.

53) Mr Faux states that WBC has run advertising campaigns on the London Underground system. Copies of the advertisements are exhibited at VAF13. The advertisements advertise the retail and style consultancy services of WBC. The campaigns had posters at the following number of sites:

1998 September/October	16 sites
2000 March/April	16 sites
September/October	16 sites
November	12 sites
2001 February/March	16 sites
September/October	16 sites
2002 February/March	15 sites
September/October	16 sites
2003 February/March	17 sites
September/October	17 sites
2004 February/March	17 sites
September/October	17 sites
2005 February/March	16 sites

Mid September/October/mid November	16 sites
2006 February/March/mid April	16 sites
Mid September/October	16 sites
2007 mid February/March	25 sites
Mid September/October	29 sites
2008 mid February/March	25 sites
Mid September/October	n/k
2009 mid February/March	25 sites
Mid September/October	25 sites
2010 mid February/March	25 sites
October	25 sites

Sites had also been booked for 2011.

54) From the invoices, it can be deduced that there was one poster at each site. Taking into account the size of the London Underground system, the length of platforms, the length of passenger tunnels, this represents a very limited presence

55) Ms Faux has appeared on radio and television programmes. Mr Faux states that she appeared as follows:

LBC London Times – November 1999
 Radio Derby – November 1999
 Look Sharp – 1995
 Woman's Hour – 1995
 London Talk Radio – 1995
 LBC Radio Works – December 1988
 Radio Newcastle
 LBC (five separate recordings)
 BBC Breakfast – 1996

56) Exhibited at VAF14 are 3 discs. It is not particularly clear at times from where the recordings emanate. The interviews primarily relate to Ms Faux giving advice on what to wear.

Disc 1

Advertisement for Sfera available in a store.
 Advertisement for Sfera created by Susie Faux.
 Advertisement for Wardrobe shops before Christmas, reference to Sfera.
 Clothes and accessories available at Wardrobe shops

Disc 2

Interview by Susie Faux about her book. Her one store in London is referred to.

Bristol – interviewer talking about her wardrobe and what she should wear.
Susie Faux advising people what to wear and talking about her book.
Susie Faux talking, references to the premises at Grosvenor Street and Chiltern Street.
Five Live - Power dressing/confidence dressing – founder of Wardrobe Susie Faux talking about this. Minimum of £300 for a jacket. Her authorship of a book is mentioned.
Susie Faux is identified as the owner of a clothes shop. There to talk about her book *Wardrobe*. Susie Faux author of book.
Woman's Hour – Susie Faux talking about what to wear; also others speaking, including Clare Short.

DVD

Breakfast Time – Susie Faux owner of two fashionable boutiques in London, talking about makeover for Sarah Ferguson on her marriage.
(Also included a recording of Ceefax pages, *Alphabet Zoo* and QPR playing Liverpool from many years ago – Lawrenson, Rush and Hansen were playing.)

57) In none of the recordings is there reference to WARDROBE as a trade mark for goods.

58) An advertisement for WARDROBE appeared on a London taxi, a picture of the taxi is exhibited at VAF15; no dates are given in relation to this promotion.

59) Exhibited at VAF16 is a sales directory from fashion.telegraph.co.uk for 2009. WARDROBE is included in the list of designer shops/boutiques. A sales directory of designers, from dailmail.co.uk, lists WARDROBE. A listing of WARDROBE from allinlondon.co.uk is exhibited.

60) Exhibited at VAF17 are letters from Jil Sander (July 1993), Antonion Fusco (20 September 1995), Kikit Ltd (21 September 1995), *Harpers & Queen* (31 May 1988 and 25 June 1997), *Vogue* (24 June 1997) and the Midland Bank (18 September 1998).

61) Exhibited at VAF18 are:

- Pictures of carries bags.
- Copies of business cards of staff of Wardrobe Limited.
- A blank letter with the WARDROBE name.
- A compliments slip with the WARDROBE name.
- A customer information sheet with the WARDROBE name.
- Swing tags from 1975 with the name of a designer and the words designed by..... specially for The Wardrobe Collection 1975.

62) In 1999 WARDROBE was awarded Womenswear Retailer of the Year by *Drapers Record*.

63) Exhibited at VAF20 are copies of letters sent to WARDROBE or Ms Faux.

64) Mr Faux states that there have been several instances of confusion involving the parties. He states that WBC “frequently” receives telephone calls intended for Meemi. Mr Faux states that most recently an assistant working on a programme hosted by Gok Wan asked whether a dress was ready. He states that in another instance an item was inadvertently returned to WBC by a magazine. A model arrived at the premises of WBC in the belief that she was at a casting for one of Meemi’s photo shoots.

65) Six witness statements are given on behalf of WBC, all use the same wording. The statements are given by the following:

George Remmier who worked for DAKS Simpson Group London from 1974 to 1998, Piombo of Italy from 1998 to 2001 and GianFranco Lotti of Italy from 2001 to 2005. He is a director of Fashion Innovation Ltd.

Richard Harry Froemberg who worked for Fairdale Textiles Ltd from 1958 to 1970, and London and County Securities Ltd from 1970 – 1974. He is managing director of GF (Clothing) Ltd.

Giacoma Ivana Silvestri who worked for Escada from 2003 to 2005, for Myla from 2001 to 2003 and for Harrods from 1999 to 2002. He is employed at Freedom Recruitment Ltd.

Joy Brannigan who was the owner of The Joy Brannigan Agency.

Giorgio Imperadori who works for Luciano Barbera. He worked for Carlo Barbera from 1986 to 1993.

Caroline Pile who runs a marketing company. Ms Pile undertook work for WARDROBE from 2006 to 2007.

They all state:

“Given my background and experience in the fashion sector, I am familiar with the WARDROBE womenswear brand of Wardrobe (Beautiful Clothes) Limited, as well as other brands and labels used in the industry.

My understanding is that Wardrobe (Beautiful Clothes) Limited’s UK registration for the trade mark WARDROBE is being challenged on the grounds that it is not distinctive of the following goods covered by the registration:-

Class 18: *Bags for women.*

Class 25: *Suits, jackets, trousers, evening wear, knitwear, shoes, headgear; all for women.*

Whilst I appreciate that the term WARDROBE has a certain significance when it comes to fashion, the term has been also been used by Wardrobe (Beautiful Clothes) Limited as a unique identity and a niche womenswear brand, specifically business attire for professional women, since the early 1970's. As a result of this use, and the promotional activities the company has undertaken over the years, if the name WARDROBE is used in connection with the types of womenswear indicated above, I would naturally associate it with the Wardrobe (Beautiful Clothes) Limited and I believe that the same would be true for the buying public in this niche market."

66) Both parties have filed state of the register evidence. In the case of Meemi this relates to the presence of wardrobe in trade marks. In relation to class 25, in particular, the following trade mark registrations (excluding those of the parties) are shown: THE LION, THE WITCH AND THE WARDROBE,



5

**P I E C E
W A R D
R O B E**

PERFECT WARDROBE

KYRA. K WARDROBE

THE
WARDROBE
My clothes. My life.



MY DAZZLING WARDROBE & KNIGHTS OF THE LEAGUE TABLE

YOUR CHILDREN'S WARDROBE

CASUALTEE.CO.UK FIRST AID FOR YOUR WARDROBE

Capsule Wardrobe Builder

67) Mr Faux states that, in a search, 430 applications or registrations for trade marks were found with the prefix my. He exhibits part of the search at VAF21. In a number of these my is not likely to be seen as a separate element eg. mylèle, MYDDFAI , myeko, MYRURGIA, MYMY, MYRO THE SMALLEST PLANET IN THE WORLD, MYLENE FARMER, MYSTERIOUS GIRL, MYLA. The search is not limited by class and no specifications are shown. A number of these are Community trade marks so there is no indication of desire to use the trade mark in the United Kingdom.

68) The evidence shows that WARDROBE has primarily been used as a trade mark in relation to an establishment in London which retails expensive clothes for women and is a style consultant for women. At one time WARDROBE was used as a trade mark for goods. This was clearly a minor element of the business. The business has always been based in W1, at one time it had two premises but for many years has had the one set of premises in Conduit Street. There is no evidence of use of WARDROBE in relation to goods since 1990; and that evidence is not detailed. The expert witnesses for WBC refer to the goods of the registration, however, the evidence shows that use in relation to goods was a minor part of the business and no part of the business for 20 years up to the date of the filing of the application for invalidation.

69) The vast majority of the press clippings relate to the goods of others that are available at WARDROBE.

70) Mr Malynicz submitted that Mr Faux stated that the trade mark WARDROBE had been used with the names of designers. There are undated exhibits supporting this. He continued that the clothes of these designers are still supplied by WARDROBE, consequently, it could be inferred that sometimes the name of the designer was still used with WARDROBE. This cannot be categorised as inference, it cannot even fall into the realm of conjecture. There is a total absence of evidence to support the submission and the submission is contrary to the evidence furnished which shows use of designers' labels on their own; WARDROBE being a retailer of the goods. Mr Malynicz referred to the advertisements for the London Underground which did not make reference to the goods of others. The absence of a reference to the goods of others is hardly use of the trade mark in relation to goods. Mr Malynicz also relied upon WARDROBE being listed amongst what he claimed were shops for individual designers in a directory exhibited at page 6 of VAF16. That a third party has listed WARDROBE amongst what Mr Malynicz claims are shops for individual designers, hardly indicates that the trade mark is being used for goods. The CJEU in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 stated:

“36. “Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant

to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

There is a complete and total absence of evidence of use of the trade mark WARDROBE for goods between 26 October 2005 and 25 October 2010. In no way, shape or form has WBC satisfied the *Ajax Brandbeveiliging BV v Ansul BV* criteria. **In relation to the grounds of invalidation under section 5(2)(b) of the Act, WBC has not proved genuine use of its earlier trade mark and so cannot rely upon it. Consequently, the grounds of invalidation under section 5(2)(b) are dismissed.**

71) The application for registration was filed on 16 June 1997. The best that can be said of the evidence is that there was some use of WARDROBE in relation to goods up to 1990. The primary business was always retail and style advice. By the time of the application for registration, there is nothing to indicate that there had been any use in relation to goods for 6 years. It has not been possible to purchase via the Internet or normally by mail order. (One advertorial from the 1970s refers to a belt being available by post if an extra charge is made.) There are no turnover figures in relation to the goods. At the most there have been two premises; for the most of the time one. Consequently, customers have had to go to the shop or shops. Shop or shops that are based in W1. There is no evidence as to the shop or shops attracting persons from outside of the Home Counties, or even, generally within London. If goods are sold only in one location it is of necessity generally going to restrict the number of customers and potential customers. (There are exceptions such as Harrods.)

72) In *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* Joined Cases C-108/97 and C-109/97 the CJEU stated:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as

originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

In *Rautaruukki Oyj v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-269/06* the GC stated:

“43 Article 7(3) of Regulation No 40/94 provides that the absolute grounds for refusal do not preclude the registration of a trade mark if it has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it. In the circumstances referred to in Article 7(3) of Regulation No 40/94, the fact that the sign which constitutes the mark in question is actually perceived by the relevant section of the public as an indication of the commercial origin of a product or service is the result of the economic effort made by the trade mark applicant. That fact justifies putting aside the public-interest considerations underlying Article 7(1)(b) to (d), which require that the marks referred to in those provisions may be freely used by all in order to avoid conceding an unjustified competitive advantage to a single trader (*Shape of a bottle of beer*, paragraph 21 above, at paragraph 41, and *Shape of a sweet*, paragraph 21 above, at paragraph 55).

44 First, it is clear from the case-law that the acquisition of distinctiveness through use of a mark requires that at least a significant proportion of the relevant section of the public identifies the products or services as originating from a particular undertaking because of the mark. However, the circumstances in which the condition as to the acquisition of distinctiveness through use may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data, such as specific percentages (see *Shape of a sweet*, paragraph 21 above, paragraph 56, and case-law cited).....

46 Third, in assessing, in a particular case, whether a mark has become distinctive through use, account must be taken of factors such as, inter alia: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the significance of the investments by the undertaking to promote it; the proportion of the relevant class of persons who, because of the mark, identify the goods as

originating from a particular undertaking and statements from chambers of commerce and industry or other trade and professional associations. If, on the basis of those factors, the relevant class of persons, or at least a significant proportion thereof, identifies the goods as originating from a particular undertaking because of the trade mark, it must be concluded that the requirement for registering the mark laid down in Article 7(3) of Regulation No 40/94 is satisfied (see *Shape of a sweet*, paragraph 21 above, at paragraph 58, and case-law cited).”

In *Vibe Technologies Ltd's Trade Mark Application* [2009] ETMR 12, Mr Richard Arnold QC, sitting as the appointed person, considered the criteria for the establishment of distinctive character through use:

“64. Fourthly, in assessing whether a trade mark has acquired a distinctive character the competent authority must make an overall assessment of the relevant evidence, which in addition to the nature of the mark may include (i) the market share held by goods bearing the mark, (ii) how intensive, geographically widespread and long-standing the use of the mark has been, (iii) the amount invested by the proprietor in promoting the mark, (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor, (v) evidence from trade and professional associations and (vi) (where the competent authority has particular difficulty in assessing the distinctive character) an opinion poll. If the relevant class of persons, or at least a significant proportion of them, identifies goods or services as originating from a particular undertaking because of the trade mark, it has acquired a distinctive character: *Windsurfing Chiemsee v Huber* at [49]-[53], Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-1318 at [23], *Philips v Remington* at [60]-[62], *Libertel v Benelux-Merkenbureau* at [67], *Nestlé v Mars* at [31] and C-25/05P *August Storck KG v Office for Harmonisation in the Internal Market (Storck II)* [2006] ECR I-5719 at [75].

65. Fifthly, with regard to the acquisition of distinctive character through use, the identification by the relevant class of persons of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark. The expression “use of the mark as a trade mark” refers solely to use of the mark for the purposes of the identification, by the relevant class of person, of the product as originating from a given undertaking: *Philips v Remington* at [64], *Nestlé v Mars* at [26], [29] and *Storck I* at [61].”

In *Bovemij Verzekeringen NV v Benelux-Merkenbureau* Case C-108/05 the CJEU considered the geographical spread needed for acquired distinctiveness:

“23 Consequently, the answer to the first two questions must be that Article 3(3) of the Directive must be interpreted as meaning that the registration of a trade mark can be allowed on the basis of that provision only if it is proven that that trade mark has acquired distinctive character through use throughout the territory of the Member State or, in the case of Benelux, throughout the part of the territory of Benelux in which there exists a ground for refusal.”

The matter was also considered in *The Journal* BL/O/272/08 by Mr Richard Arnold QC, sitting as the appointed person:

“22. Given the applicant’s opposition to a reference, however, I shall give my own answer to the question. In absence of further guidance from the Court of Justice, I consider that it is not possible to overcome an objection under section 3(1)(b), (c) or (d) of the 1994 Act by demonstrating that the mark applied for has acquired a distinctive character within a particular locality or region. The Court of Justice’s first ruling in *EUROPOLIS* appears to be quite unequivocal on this point: “registration of a trade mark can be allowed on the basis of [Article 3(3) of the Directive] only if it is proven that that trade mark has acquired distinctive character through use throughout the part of the territory of the Member State ... where there exists a ground for refusal”. Moreover, its reasoning is that the mark must be free from objection throughout the Member State in question. At least in the case of goods, I do not think that it makes any difference if the market for the goods is confined to a particular locality or region, for the following reasons.”

73) Mr Malynicz considered that the presence of *WARDROBE* in national press articles was of importance. However, most of that presence was as a retailer and style consultant. The public is inundated with a plethora of trade marks for clothing and bags. Appearing in magazines and press articles does not mean that a trade mark will be remembered. There was no impetus to remember the trade mark, where it has been used for goods, as the goods were only available in W1 and were out of the price range of most persons. Mr Malynicz categorised the goods sold by *WARDROBE* as being haute couture, which is a reasonable description. However, they must be judged on the basis of being clothes and bags; there is no clear delineation between haute couture and bas couture. Diffusion ranges cross the divide. H&M advertise in *Vogue* along with Emilio Pucci and Valentino. Vivienne Westwood has produced clothes for Littlewoods. The haute couture aspect of clothing was considered by Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Croom’s Trade Mark Application* [2005] RPC2:

“27 I agree with the Hearing Officer in thinking that the applicant’s specification of goods could not realistically be re-written so as to identify the goods of interest to him in terms that would clearly and completely exclude *haute couture* from the scope of the protection that might be

claimed under ss.5 and 10 of the 1994 Act if the application proceeded to registration.

28 The suggestion that this might be achieved by adding a limitation expressed in negative terms (“ ***none being items of haute couture***” or “ ***not including items of haute couture***”) also appears to be incompatible with the Judgment of the European Court of Justice in Case C-363/99 Koninklijke KPN Nederland NV v Benelux Merkenbureau (POSTKANTOOR) February 12, 2004. The Court ruled on a number of questions, the eighth of which was as follows:

Is it consistent with the scheme of the Directive and the Paris Convention for a sign to be registered for specific goods or services subject to the limitation that the registration applies only to those goods and services in so far as they do not possess a specific quality or specific qualities (for example, registration of the sign POSTKANTOOR for the services of direct-mail campaigns and the issue of postage stamps provided they are not connected with the post office)?

The reply to that question was:

Directive 89/104 prevents a trade mark registration authority from registering a mark for certain goods or services on condition that they do not possess a particular characteristic.

29 Paragraphs [111 to 117] of the judgment confirm that goods and services should not be specified for registration “only in so far as the goods or services concerned do not possess a particular characteristic” ([114]). The mischief countered by the ruling of the Court is identified as “legal uncertainty as to the extent of the protection afforded by the mark” ([115]). These observations appear to me to prevent the applicant from identifying the goods of interest to him negatively, by reference to the absence of attributes such as those (whatever they might truly be) of *haute couture*.

30 That leaves the applicant with a request for registered trade mark protection which is silent as to matters such as the style and quality of the specified goods. This is normal. The goods of interest to an applicant need to be honestly and fairly identified (see ss.32(2)(c) and 32(3) of the Act) with sufficient clarity and precision to enable them to be classified in accordance with the Nice Agreement (see s.34 of the Act and Rules 7 and 8 of the Trade Mark Rules 2000). It is not necessary for the attainment of that objective to refer to characteristics that may be present or absent without changing the nature, function or purpose of the specified goods. However, the distinctiveness (and therefore the registrability) of the relevant trade mark may depend on the presence of one or more such

characteristics. If so, they should be specified. But it is seldom necessary for the wording of the specification to be so closely circumscribed as to define the characteristics of the goods of interest to the applicant exhaustively.

The expert witnesses who give evidence for WBC do not represent the relevant public. Mr Ian Purvis QC, sitting as the appointed person, in *Fresh Direct Holdings Limited's trade mark applications* considered such an issue:

“27. Secondly, even in the narrow field of fruit and vegetables, I do not consider that fame or reputation purely with business customers for those products is sufficient to justify registration of the mark. Acquired distinctiveness, as explained by the ECJ in a different context in Philips v Remington [2003] RPC 2 at paragraph 65 is to be judged by reference to the average consumer. The test given in Case No. C-108/97 (WINDSURFING CHIEMSEE) was whether “*the relevant class of persons, or at least a significant proportion thereof, identify the goods as originating from a particular undertaking because of the trade mark.*” On any view, the vast bulk of customers for fruit and vegetables are members of the general public. I do not consider that acquired distinctiveness in the minds of a small, though economically highly significant, sub-set of those customers is sufficient. Unless and until it is demonstrated by evidence that the mark FRESH DIRECT has established a secondary meaning denoting the applicant's business amongst a significant number of members of the general public, it therefore cannot be said that it has become sufficiently distinctive to justify registration as a trade mark.”

74) The limited number of visitors to the WARDROBE website does not assist WBC as the website was not dealing with goods sold under the trade mark. Expert witnesses commented on the goods of the registration, quoting the specification, but for the most part there has been no use of goods. They seem to have effectively conflated the use as a retailer as the use as a provider of goods.

75) Taking into account the extremely limited use of the trade mark in relation to goods, the absence of use since 1990, the limited availability of the goods when they were available (being only available in W1), the absence of any specific sales figures for goods and the nature of the market; if WBC's trade mark is subject to objection under section 3(1)(b) and/or (c), at neither the date of application for registration nor the date of application for invalidation, would WBC's use establish that the trade mark had become distinctive.

76) In relation to distinctiveness Mr Malynicz submitted that the matter must be considered de novo, not relying upon the views of the examiner and hearing officer at ex parte stage. This must be the correct approach. In this case the

objections seem, anyway, not very well considered. The examiner objected “because the mark consists exclusively of the word WARDROBE, being a sign which may serve to designate the kind of goods (eg. wardrobe trunks and cases in Class 18).” The objection has nothing to do with the class 25 goods. The hearing officer referred to the trade mark being on a par with soap for soap. As Mr Malynicz submitted that cannot be the case; the trade mark is not a description of actual goods in classes 18 and 25.

77) In *Biold AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-37/03 P* the CJEU stated that for a term to be viewed as being descriptive of a characteristic of goods:

“there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see Case T-19/04 *Metso Paper Automation v OHIM(PAPERLAB)* [2005] ECR II-2383, paragraph 25 and the case-law cited).”

In *Score Draw Limited v Alan James Patrick Finch* [2007] EWHC 462 (Ch) Mann J stated:

“39. The words "other characteristics of goods or services" are obviously more general than the more specific words which precede it. They demonstrate that the preceding words are not the only way in which the provisions of the subsection can be fulfilled. It is therefore open to Score Draw to seek to demonstrate that the badge operates so as to be descriptive of some characteristic of goods other than those enumerated in the section. It seeks to do so by saying that the badge identifies the Brazilian football team nature of the goods to which it is applied. Mr Reed found it hard to articulate the precise characteristic involved, but it was of that general nature. By way of a parallel, Mr Reed relied on *Linkin Park LLC's Application, Case O-035-05* [2006] ETMR 74.

There is, therefore, no limitation as to the nature of a characteristic that can give rise to objection.

78) WBC's own witnesses agree that WARDROBE describes an individual's collection of clothes. They have done this in the evidence at ex-parte stage and in the evidence for these proceedings. Ms Faux regularly uses it with this meaning, and to include, inter alia, bags. There is no doubt that it is a term that is used in trade with this meaning. However, the application for invalidation has not been raised on the basis of section 3(1)(d) of the Act.

79) At no time has Meemi clearly stated what characteristic WARDROBE describes. Mr Engelman submitted that WARDROBE describes items of clothing

and bags. He did not elucidate how it describes a characteristic of clothing and bags. That all one's clothes either in their entirety or for a season can form a wardrobe does not describe a characteristic of individual clothes. There is no elucidation how the relevant public would see the word WARDROBE on clothing or bags and without further thought perceive "a description of the goods" or "one of their characteristics".

80) In *Develey Holding GmbH & Co Beteiligungs KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-238/06 P the CJEU stated:

"79. According to consistent case-law, the distinctive character of a trade mark within the meaning of Article 7(1)(b) of Regulation No 40/94 means that the mark in question makes it possible to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* [2004] ECR I-5173, paragraph 32, and Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 42). That distinctive character must be assessed, first, by reference to the products or services in respect of which registration has been applied for and, second, by reference to the perception of the relevant public (*Procter & Gamble v OHIM*, paragraph 33, and Case C-24/05 P *Storck v OHIM* [2006] ECR I-5677, paragraph 23)."

The General Court (GC) in *Rewe Zentral AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-79/00 described the issue in a clear and pragmatic manner:

"26. The signs referred to in Article 7(1)(b) of Regulation No 40/94 are signs which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition."

The trade mark could be used on swing tags, it could be embossed into bags, it could be used in sewn in labels, it could be used on the front of garments, it could be printed into the lining of garments, it could be used on buttons, it could be used on point of sales material, it could be used on racks of clothing. In none of these circumstances is it easy to see how it would **not** identify the goods of one undertaking. Even used in advertising it is difficult to see how it would not identify the goods of the registration as emanating from a particular undertaking.

81) Mr Engelman referred to others using wardrobe in trade marks. The only example prior to the date of the filing of the application for registration is a

reference to Wardrobe of Hampstead, in 1973. This identifies where a particular garment is available and so relates to retail use and not to the goods of the registration. Consequently, there is no evidence of use for the goods of the registration prior to the date of the application for registration. If there were evidence of use by others of WARDROBE for the goods this would not mean that the mark would be devoid of any distinctive character. There is no requirement for a trade mark to be unique to be distinctive; the likes of Anheuser-Busch Inc and Budejovický Budvar, národní Podnik would be somewhat concerned if that were the case. The type of argument that Mr Engelman advanced was rejected by Warren J in *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] RPC 30:

“In my judgement, Mr Foley was entitled to reach the conclusion that Sabatier was a distinctive mark as he did. In particular, it remained distinctive in March 2000. I agree with Mr Vanhegan when he says that a person challenging the distinctiveness of a registered trade mark must show on the evidence more than just some use by one or more others; the challenger must show that the mark has become generic or incapable of distinguishing. HH has failed to do that on the evidence.”

The matter was also considered by Floyd J in *Nude Brands Limited v Stella McCartney Limited and others* [2009] EWHC 2154 (Ch):

“29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) - customary indication in trade. Ground 7(1)(b) is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or quality or other characteristics of the goods, and thus support an attack under 7(1)(c).”

82) The state of the register evidence does not establish use and is not, anyway, directed to the date of application.

83) Meemie has failed to establish that the trade mark of WBC was objectionable under either section 3(1)(b) and/or (c) of the Act at the date of application for registration. The application for invalidation of the trade mark of WBC is dismissed. Consequently, WBC does not need to rely upon the proviso to establish distinctiveness.

Passing-off

84) Save for the pages downloaded from the Internet on 11 August 2011 (exhibit JRO-4), there is no evidence as to use by Meemi of its trade marks. The pages downloaded advise that Meemi has been a Feefo member since 15 March 2009 but this does not give any hint of the nature of use. Consequently, the date of the behaviour the subject of the complaint is the date of the filing of Meemi's applications, 14 January 2010. There has been no pleading of common law acquiescence.

85) At the date of the filing of the applications of Meemi and up to and including the date of the hearing, WBC had a goodwill by reference to the sign WARDROBE. WBC claims that the goodwill relates to clothing, clothing accessories and related fashion items; retail services connected with the sale of clothing, clothing accessories and fashion items; style consultancy services. There is no doubt that the goodwill relates to retail services connected with the sale of clothing, clothing accessories and fashion items; style consultancy services. The last indication of use of WARDROBE for goods is at page 493 of VAF12: "has now launched her own label, Wardrobe Italia". This is from December 1990. There is no evidence for use in relation to goods between January 1991 and January 2010, a period of 19 years. Goodwill does not evaporate following the end of use of a sign in relation to particular goods. In *Ad-Lib Club Limited v Granville* [1971] FSR Pennycuik VC considered the issue of residual goodwill:

"In support of that statement there is cited the case of *Norman Kark Publications Ltd. v. Odhams Press Ltd.*, [1962] 1 All E.R. 636; [1962] R.P.C. 163 in which the first paragraph of the headnote reads:

"In an action to restrain the use of a magazine or newspaper title on the ground of passing off the plaintiff must establish that, at the date of the user by the defendant of which the plaintiff complains, he has a proprietary right in the goodwill of the name, viz., that the name remains distinctive of some product of his, so that the use of the name by the defendant is calculated to deceive; but a mere intention on the part of the plaintiff not to abandon a name is not enough".

Wilberforce, J. went at length into the principles underlying proprietary right in goodwill and annexation of a name to goodwill and the laws of the right to protection of a name and on the facts of that particular case he held that the plaintiff company had lost its right in respect of the name TODAY as part of the title of a magazine.

It seems to me clear on principle and on authority that where a trader ceases to carry on his business he may nonetheless retain for at any rate some period of time the goodwill attached to that business. Indeed it is obvious. He may wish to reopen the business or he may wish to sell it. It further seems to me clear in principle and on authority that so long as he

does retain the goodwill in connection with his business he must also be able to enforce his rights in respect of any name which is attached to that goodwill. It must be a question of fact and degree at what point in time a trader who has either temporarily or permanently closed down his business should be treated as no longer having any goodwill in that business or in any name attached to it which he is entitled to have protected by law.

In the present case, it is quite true that the plaintiff company has no longer carried on the business of a club, so far as I know, for five years. On the other hand, it is said that the plaintiff company on the evidence continues to be regarded as still possessing goodwill to which this name AD-LIB CLUB is attached. It does, indeed, appear firstly that the defendant must have chosen the name AD-LIB CLUB by reason of the reputation which the plaintiff company's AD-LIB acquired. He has not filed any evidence giving any other reason for the selection of that name and the inference is overwhelming that he has only selected that name because it has a reputation. In the second place, it appears from the newspaper cuttings which have been exhibited that members of the public are likely to regard the new club as a continuation of the plaintiff company's club. The two things are linked up. That is no doubt the reason why the defendant has selected this name."

In this case there has been a continuum of the primary business of retail services connected with the sale of clothing, clothing accessories and fashion items and style consultancy services by reference to the sign WARDROBE. A continuum that has been reinforced by the presence at Conduit Street for many years and the presence of Ms Faux as the face of the business. There is a close relationship between clothing, clothing accessories and related fashion items and clothing, clothing accessories and related fashion items. Taking into account these factors, WBC has a residual goodwill in relation to clothing, clothing accessories and related fashion items. If this were not the case, the close relationship between the goods and services means that the position for WBC would hardly be any worse if there were no residual goodwill for the goods.

86) The business began in 1973. The business in relation to which the goodwill relates is at the very expensive end of the market. The business has always been located in W1. There is no evidence as to the catchment area of customers, however, promotion of the business has been in publications that are circulated throughout the United Kingdom.

87) Mr Engelman considered that the use of others of signs contained WARDROBE was significant as he considered that the sign was descriptive. The examples of use by others of signs including WARDROBE exhibited relate to very different businesses to that of WBC. They cannot be considered to overlap. The one example of an overlap is with Wardrobe of Hampstead, where both

Wardrobes are retailing that same garment. However, that relates to a situation in 1973. Moreover, as Laddie J stated in *Associated Newspapers Limited and others v Express Newspapers* [2003] FSR 51:

“As Mr Watson implicitly accepts, there is no requirement in the law of passing off that the claimant's reputation has to be exclusive. There have been a number of cases where a claimant has succeeded even though he was not the only trader with a reputation in the mark.”

The actual business has been limited to one particular area and for the most part one location. In *Chelsea Man Menswear Ltd v Chelsea Girl Ltd* [1987] RPC 189, Slade LJ stated:

“There is, in my judgement, no reason in fact or in law why the court, in considering the proper form of relief, should treat them as having a business of which the boundaries will necessarily be confined to the three proposed restricted areas. Immediately after the passage from the judgement of Jenkins LJ in *Brestian v Try* cited above, he continued (supra at page 170):

‘Moreover, reasonable scope for the expansion of the Plaintiff's business by the opening of new branches should be allowed, and conversely the possibility of expansion by the Defendant should be taken into account.’”

The latter point is key in this case. Meemie has trade mark registrations, which of their nature, encompass the whole of the United Kingdom and so must cover the same area as that of WBC.

88) Lord Simons in *Office Cleaning Services Ltd v Westminster Window & General Cleaners* (1946) 63 RPC 39 at 43:

“It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The Court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

Lord Davey in *The Cellular Clothing Company v Maxton and Murray* (1899) 16 RPC 397 at page 408 stated:

“But, my Lords, there are two observations upon that which must be made. One is that, as has been more than once said, particularly by Lord

Justice *Fry* (then I think a Judge of First Instance) in the case of *Siebert v. Findlater*, a man who takes upon himself to prove that words, which are merely descriptive or expressive of the quality of the goods, have acquired the secondary sense to which I have referred, assumes a much greater burden, and indeed a burden which it is not impossible, but at the same extremely difficult to discharge - a much greater burden than that of a man who undertakes to prove that same thing of a word not significant and descriptive, but what has been compendiously called a fancy word.

Lord Simons refers to a trade name consisting “wholly or in part of words descriptive of the articles to be sold or the services to be rendered”. As has been decided in relation to the grounds of invalidation under section 3(1) it is not considered that the *WARDROBE* is descriptive for the goods. *WARDROBE* is certainly not descriptive of the services for which there is a goodwill. Moreover, over 37 years a part of the public has been educated to identify the services with the undertaking currently owned by WBC. For the customers of WBC and certain, if not all, persons in the fashion industry, *WARDROBE* means the business of WBC. That public will readily distinguish WBC’s business from that of a fancy dress supplier or corporate clothing supplier (some of the examples of use relied upon by Mr Engelman), if it were to come across their use of *WARDROBE*. It is also to be taken into account that WBC has relied upon the sign *WARDROBE* on its own to identify its goods and services.

89) Mr Malynicz submitted that in relation to the law of passing-off there is no need for a common field of activity. In *Harrods v Harrodian School* [1996] RPC 697 Millett LJ 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 he went on to state:

“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.”

And

“The name “Harrods” may be universally recognised, but the business with which it is associated in the minds of the public is not all embracing. To be known to everyone is not to be known for everything.”

(In *Lego Systems A/S v Lego M Lemelstricht Ltd* [1983] FSR 155 there was no common field of activity but the gap was bridged by evidence showing the deception of the public.)

An absence of a common field of activity will militate against misrepresentation. It will also militate again there being damage as per the judgment of Slade LJ in *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501:

“even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.”

90) A common field of activity is not the same as similarity of goods or services. There is, for instance, a long established relationship between clothes, perfumes and bags; these goods have generally not been considered as being similar for the purposes of section 5(2)(b) of the Act but, owing to the practices of the market, they are in a common field. Other than for a brief period the services and goods of WBC have related solely to women. It is common for the type of services and goods to which the goodwill of WNC relates to also to be used in relation to men and children. Consequently, any misrepresentation will extend to both genders and children.

91) The following goods and services of the registrations of Meemi are in a common field of activity with the goods and services for which WBC has goodwill:

soaps; perfumery, essential oils, cosmetics, hair lotions; after-shave lotions; bath salts (not for medical purposes); baths (cosmetic preparations for); cosmetic kits; hair colorants; hair spray; nail care preparations, polish and varnish; make-up; skin care (cosmetic preparations for); toiletries;

goods in precious metals or coated therewith, not included in other classes; jewellery, chronometric instruments; watches; bracelets; brooches; necklaces; cuff links; earrings; rings; tie clips; tie pins; keyrings; belt buckles of precious metals; hat ornaments of precious metal; watch straps; watch bands;

goods made of leather and imitations of leather and not included in other classes; travelling bags; umbrellas, parasols; bags; handbags, beach bags, sports bags, backpacks; briefcases, suitcases, holdalls; purses and wallets; vanity cases (not fitted); luggage; garment bags for travel; shopping bags; shoulder bags; clutches;

clothing, footwear, headgear; shirts; skirts; dresses; blouses; sweatshirts; jackets; hats; caps; t-shirts; rainwear; sportswear; leisurewear; underwear; coats; neckwear; scarves; gloves; belts; boots; shoes; socks; stockings; tights; bras;

garments for women; garments for men; garments for children; neckties; outerclothing; suits; trousers; pants; jeans; corduroy trousers; shorts; boxer shorts; parkas; overcoats; scarves; shawls; ear muffs; pullovers; jumpers; cardigans; knitwear; evening wear; beach clothes; hosiery; pyjamas; bathrobes; dressing gowns; lingerie, bodices, brassieres, camisoles, corsets, slippers; swimwear; sandals; slippers; trainers; sports shoes; parts and fittings for the above mentioned goods;

the bringing together, for the benefit of others of a variety of goods, namely, clothing, footwear, headgear, soaps, perfumery, essential oils, cosmetics, hair lotions, goods in precious metals or coated therewith, jewellery, chronometric instruments, goods made from leather and imitations of leather, travelling bags, umbrellas, parasols, enabling customers to conveniently view and purchase those goods in a retail store; the bringing together, for the benefit of others of a variety of goods, namely, clothing, footwear, headgear, soaps, perfumery, essential oils, cosmetics, hair lotions, goods in precious metals or coated therewith, jewellery, chronometric instruments, goods made of leather and imitations of leather, travelling bags, umbrellas, parasols, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order or by means of telecommunications; the bringing together, for the benefit of others, of a variety of goods, namely, clothing, footwear, headgear, soaps, perfumery, essential oils, cosmetics, hair lotions, goods in precious metals or coated therewith, jewellery, chronometric instruments, goods made of leather and imitations of leather, travelling bags, umbrellas, parasols, enabling customers to conveniently view and purchase those goods from an Internet website or other communications network.

In considering this common field of activity it is taken into account that WBC has been furnishing style consultations, has, inter alia, supplied perfumes (if under the name Sfera) and has had hair dressing facilities in the building it now occupies, which have been identified with it.

92) It is common for undertakings to promote themselves by ascribing ownership of the undertaking to their customers, such as your Asda, my Tesco and mygarmin.com. So it is likely that a person who knows WBC's business will see the presence of my before wardrobe as part of this marketing trend. The .com element of the trade marks will simply advise that the goods or services are available through the Internet. This is also likely to be simply seen as the business making use of the Internet.

93) Mr Malynicz submitted that counter intuitively the trade mark below may be even more liable to give rise to misrepresentation than the other trade mark of Meemi.



The wardrobe.com element is separate. The my element is very large. However, owing to the separation between my and wardrobe.com, the person knowing of WBC's business is likely to simply see this as a web address for WBC's business. Consequently, there will be a misrepresentation. MY-WARDROBE.COM combines wardrobe with the first person personal pronoun and a sign indicating a domain name. The my element will indicate a personalisation of the website for the customer. The person knowing of the business of WBC is likely to see the trade mark as being a web extension of the business of WBC. It has not been possible to purchase from the website of WBC, however, it has an established website, if with limited visitors, and so its existing presence on the Internet makes the misrepresentation all the more likely.

94) Mr Malynicz put no weight upon the instances of confusion referred to by Mr Faux. Owing to the lack of detail in relation to these instances, they have been given no weight in this decision.

95) Damage in passing-off can take a number of formsⁱⁱⁱ. In this case, taking into account the reputation of the earlier sign and the goods and services, damage is likely to occur as possible:

- By the injury which is inherently likely to be suffered by any business when on frequent occasions it is confused by customers or potential customers with a business owned by another proprietor or is wrongly regarded as being connected with that business. WBC's business is highly liable to damage owing to the elite and very up-market nature of its business. The dilution of its image could have serious effects upon its business.
- Erosion of the distinctiveness of WBCs sign.
- By the restriction of the ability to exploit the goodwill.

Mr Engelman regularly returned to the absence of any evidence of successful passing-off actions launched by WBC, despite comments that Mr Faux made about enforcing WBC's rights and his reference to an action that was launched against Brook Taverner. An absence of actions before the court is not pertinent to any of the issues in this case.

96) The registrations of Meemi are to be limited to the following specifications:

bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; dentifrices;

precious metals and their alloys; precious stones; clocks; clock cases; Jewellery cases; watch cases; watch springs; watch cases; parts and fittings for all the aforesaid goods;

leather and imitations of leather, animal skins, hides; trunks; walking sticks; whips, harness and saddlery;

the bringing together, for the benefit of others of a variety of goods, namely, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, dentifrices, precious metals and their alloys, leather and imitations of leather, animal skins, hides, trunks, walking sticks, whips, harness and saddlery, enabling customers to conveniently view and purchase those goods in a retail store; the bringing together, for the benefit of others of a variety of goods, namely, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, dentifrices, precious metals and their alloys, precious stones, leather and imitations of leather, animal skins, hides, trunks, walking sticks, whips, harness and saddlery, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order or by means of telecommunications; the bringing together, for the benefit of others, of a variety of goods, namely, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, dentifrices, precious metals and their alloys, precious stones, leather and imitations of leather, animal skins, hides, trunks, walking sticks, whips, harness and saddlery, enabling customers to conveniently view and purchase those goods from an Internet website or other communications network.

Costs

For the most part WBC has been successful and is entitled to a contribution towards its costs. Mr Engelman wished it to be taken into account that the grounds under section 5(3) of the Act were dropped in the skeleton argument of Mr Malynicz. The evidence of the parties would have been the same, with or without this ground. The logic of Mr Engelman's argument would lead parties to run grounds which have no legs, so increasing costs. The dropping of the grounds under section 5(3) of the Act will have no effect on the costs award.

Costs are awarded upon the following basis:

Application fees for invalidation:	£400
Preparing statements of case and considering the statements of case of Meemi:	£500
Preparing evidence and considering evidence of Meemi:	£2,000
Preparation for and attendance at a hearing:	£1,500
Total:	£4,400

Meemi Ltd is ordered to pay Wardrobe (Beautiful Clothes) Limited the sum of £4,400. 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 14th day of May 2012

**David Landau
For the Registrar
the Comptroller-General**

ⁱ 47. - (1).....

.....(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A)* But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration, (b) the registration procedure for the earlier trade mark was not completed before that date, or (c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration 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) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community. (2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

ⁱⁱ See *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v Camelot Group PLC* [2004] RPC 8 and 9.

ⁱⁱⁱ See *Sir Robert McAlpine Limited v Alfred McAlpine Plc* [2004] EWHC 630 (Ch) Mann J:

“20 When it comes to considering damage, the law is not so naïve as to confine the damage to directly provable losses of sales, or "direct sale for sale substitution". The law recognises that

damage from wrongful association can be wider than that. Thus in *Ewing –v- Buttercup Margarine Limited* (1917) 34 RPC 232 Warrington L.J. said:

"To induce the belief that my business is a branch of another man's business may do that other man damage in all kinds of ways. The quality of the goods I sell; the kind of business I do; the credit or otherwise which I might enjoy. All those things may immensely injure the other man, who is assumed wrongly to be associated with me."

In so saying, he was not limiting the kinds of potential damage to those listed by him. Rather, he was indicating that the subtleties of the effect of passing off extend into effects that are more subtle than merely sales lost to a passing off competitor.

In *Associated Newspapers Limited –v- Express Newspapers* [2003] FSR 909 Page 929. Laddie J cited this passage, referred to other cases and went on to say:

"In all these cases [that is to say, the *Clock Limited* case referred to above and *Harrods –v- Harroldian School* [1996] RPC 679], direct sale for sale substitution is unlikely or impossible. Nevertheless the damage to the Claimant can be substantial and invidious since the Defendant's activities may remove from the Claimant his ability to control and develop as he wishes the reputation in his mark. Thus, for a long time, the common law has protected a trader from the risk of false association as it has against the risk of more conventional goods for goods confusion."

The same Judge expressed himself more picturesquely, but equally helpfully, in *Irvine –v- Talksport Limited* [2002] 1 WLR 2355 at page 2366. Having pointed out the more familiar, and easier, case of a Defendant selling inferior goods in substitution for the Claimant's and the consequential damage, he went on to say:

"But goodwill will be protected even if there is no immediate damage in the above sense. For example, it has long been recognised that a Defendant cannot avoid a finding of passing off by showing that his goods or services are of as good or better quality than the Claimant's. In such a case, although the Defendant may not damage the goodwill as such, what he does is damage the value of the goodwill to the Claimant because, instead of benefiting from exclusive rights to his property, the latter now finds that someone else is squatting on it. It is for the owner of goodwill to maintain, raise or lower the quality of his reputation or decide who, if anyone, can use it alongside him. The ability to do that is compromised if another can use the reputation or goodwill without his permission and as he likes. Thus Fortnum and Mason is no more entitled to use the name FW Woolworth than FW Woolworth is entitled to use the name Fortnum and Mason ...

"The law will vindicate the Claimant's exclusive right to the reputation or goodwill. It will not allow others so to use goodwill as to reduce, blur or diminish its exclusivity." (at p 2368)

In *Taittinger SA –v- Allbev Limited* [1994] 4 All ER 75 Page 88, Peter Gibson L.J. acknowledged that:

"Erosion of the distinctiveness of the name champagne in this country is a form of damage to the goodwill of the business of the champagne houses."

The same view was expressed by Sir Thomas Bingham M.R. at page 93.

21 The damage which results must be as a result of a misrepresentation to a relevant part or section of the public. In the *Jif Lemon* case the relevant people were described as "prospective customers or ultimate consumers of the goods or services in question" by Lord Diplock and as the "purchasing public" by Lord Oliver. Mr Thorley realistically accepted that in this case the relevant public was not confined to people who are at the moment actually customers of Robert and Alfred. In doing so he acknowledged the possibility, which in my view exists in this case, that

the misrepresentation, if any, would or might be received by a wider class than that. However, for Robert to succeed there must be people whose dealings in respect of Robert would somehow be affected by the alleged misrepresentation. Such people must be assumed to be "reasonably well informed and reasonably observant and circumspect". Per Chadwick L.J. in *Bach –v- Bach Flour Remedies Trademarks* [2000] RPC 513 and 534."