

O-219-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2482912A  
BY ELLE MACPHERSON TO REGISTER THE TRADE MARK**

**MISS MAC  
miss mac  
MissMac  
Miss Mac**

**AS A SERIES OF 4, IN CLASSES 25, 35 AND 41**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 98735  
BY MAC MODE GmbH & CO KGaA**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2482912A  
By Elle MacPherson to register the trade mark**

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**IN THE MATTER OF Opposition thereto under No. 98735  
by MAC Mode GmbH & Co KGaA**

## **BACKGROUND AND PLEADINGS**

1. On 19<sup>th</sup> March 2008, Ms Elle MacPherson, c/o Speechly Bircham, 6 St Andrew Street, London EC4A 3LX applied to register six variants of the words 'Miss' and 'Mac'. Following an objection based on the fact the marks were not a series, she divided the application and this application is based around the four variants as above. The goods and services against which the opposition is filed are as follows:

### **Class 25**

Underwear, lingerie, socks; sleepwear including pyjamas, nightgowns, negligees and nightshirts; dressing gowns, bath robes, beachwear, swimwear, lounging pants and tops; slippers.

### **Class 35:**

Advertising and business services; advertising and promotional services; the promotion of products and services for others; the bringing together, for the benefit of others, of underwear, lingerie, socks, sleepwear including pyjamas nightgowns, negligees and nightshirts, dressing gowns, bath robes, beachwear, swimwear, lounging pants and tops and slippers, enabling customers to conveniently view and purchase those goods from fashion retail stores and houseware retail stores.

2. The application was published on 12<sup>th</sup> December 2008, and on 11<sup>th</sup> February 2009 MAC Mode GmbH & Co KGaA of Industriestr.2, Wald/Rosbach 93192 Germany (hereafter "Mode") lodged an opposition against the goods and services specified above. The sole basis of the opposition is section 5(2)(b).

3. Mode rely on two earlier Community marks, the details of which are as follows:

Mark. Filing and registration dates	Goods and services relied upon under section 5(2)(b)
<p>CTM 1022565 ('565)</p> <p>MAC JEANS</p> <p>26<sup>th</sup> January 1999 20<sup>th</sup> December 2001</p>	<p><b>Class 25:</b></p> <p>Sportswear and leisurewear; jeans and denim trousers; shirts, namely men's shirts, sports shirts; leisure shirts, polo shirts, dress shirts, string vests, dinner shirts, shirts for wear with tails; sweat shirts, over shirts, jacket shirts, T-shirts, women's shirts, polo shirts; blouses, pullovers, slipovers, suits, jackets, reversible jackets, shirt jackets, women's shirts, duffel coats, anoraks, waistcoats, over-waistcoats, coats, dresses, skirts, headscarves, scarves, shawls; trousers, thermal trousers, shorts, sports trousers; jeans, denim trousers, denim overalls, denim skirts, denim dresses, denim shirts, denim blouses, denim jackets; denim jackets; scarves, dress handkerchiefs, underclothing, sports underwear, nightclothes, dressing gowns, socks, stockings, neckties, gloves; headgear; sports trousers, sports jerseys; gymnastic suits, training suits, training jackets, training trousers; jogging suits, jogging trousers, jogging jackets, jogging pullovers, jogging tops; bikinis, swimming shorts, beach shorts, Bermuda shorts, bath robes, beachwear and beach coats; clothing for surfing, waterskiing and sailing; knitwear, namely pullovers, slipovers, jackets, leisure jackets, shirt jackets, waistcoats, over-waistcoats, sweaters, coats, dresses, skirts, trousers, shirts, blouses,</p>
<p>CTM 5188891 ('891)</p> <p>mac:M</p> <p>23<sup>rd</sup> June 2006 29<sup>th</sup> May 2007</p>	<p><b>Class 25</b></p> <p>Clothing, in particular trousers; headgear; footwear.</p>

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4. In its statement, Mode say the distinctive and dominant element of the application is the word 'MAC'. The word 'MISS' which precedes it would clearly be seen as an indication the products are intended for the female market. 'MISS' is not particularly distinctive and is more of a descriptor. The MISS MAC range of products would be seen as merely an 'extension' of the opponent's products. The word 'MAC' is common to both marks and, say Mode, in its own '565 mark, the word 'jeans' is merely descriptive. As far as the other matter in their '891 mark is concerned, ':M' is not dominant. Given the identity of the goods in Class 25, and similarity of services in Class 35, there is, on a global assessment, a likelihood of confusion in respect of both their marks.
5. Ms Macpherson filed a counterstatement, admitting her Class 25 specification would constitute 'clothing', but denying the retail services in Class 35 would be similar to the goods themselves. She says the 'MAC' element in her mark does not have an independent role which, according to case law, needs to be considered as a whole. She also says the word 'jeans' is not necessarily descriptive given that the mark would be used on goods other than jeans or trousers, and in any event cannot be excluded from any comparison as it is part of Mode's '565 mark. As far as the '891 mark is concerned, by virtue of the unusual position of the colon, the "":M" must also be considered as a distinctive feature of the mark. Consequently, the dominant element is not necessarily just the 'MAC' element. All factors considered, there is no likelihood of confusion as between any of the respective marks. She also puts Mode to proof of use of its '565 mark.
6. Evidence has been filed by Mode only which, insofar as it is factually relevant, I shall summarise below. Both parties have filed submissions which I will take into account. Neither party has requested a hearing and instead, both parties are content for a decision to be issued based on the papers. Both parties request costs.

### **Opponent's evidence**

7. This takes the form of an affidavit dated 30<sup>th</sup> June 2010 by Eveline Schönleber, who is a managing partner of Mode and has been associated with the company since 1994, and with the trades carried on by the company since 1995. The facts contained in her affidavit are from her company's books and records, or from her personal knowledge.
8. She appreciates that the relevant period for which she is required to prove use of the '565 mark is 13<sup>th</sup> December 2003 – 12<sup>th</sup> December 2008. She says that the '565 mark is currently in use in 24 countries across Europe, including

the UK. It was first used in Germany in 1973 and has been used continuously since then. It has also been used in the same way since use commenced.

9. The following is a table of incoming orders (numbers of items) from 2003 to 2009 in relation to goods bearing the MAC trade mark:

Country	2003	2004	2005	2006	2007	2008	2009	Total
Austria	234,010	254,440	272,453	250,513	278,239	269,302	230,171	1,789,088
GB	19,493	22,087	18,261	15,843	14,157	11,287	11,036	112,164

10. The following is a table regarding incoming orders (value in EURO) from 2003 to 2009 in relation to goods bearing the MAC trade mark:

Country	2003	2004	2005	2006	2007	2008	2009	Total
Austria	6,946,325	7,359,452	7,359,452	8,211,505	7,619,283	8,100,766	6,644,089	52,624,453
GB	620,987	763,068	639,423	567,893	483,921	334,629	323,765	3,733,765

11. She says that, although the figures above relate to goods bearing the MAC trade mark, it can be inferred from Exhibit ES3 that all trousers bear the MAC JEANS trade mark.

12. Exhibit ES3 comprises copies of samples of leather patches, a swing tag, a button, an embroidered strip and labels bearing the MAC JEANS trade mark, as well as a photograph of a pair of jeans bearing a leather patch with the MAC JEANS mark on. I have reproduced that photograph below:



13. She says, “ These samples are typical of leather patches, swing tags, buttons, embroidered strips and labels affixed to the following goods during the relevant period: jeans and denim trousers, trousers, shorts and Bermuda shorts”.
14. Exhibit ES1 comprises copies from an Austrian magazine called Österreichische Textilzeitung, issues 1/2010 and 2/2010, showing use of the Trade Mark MAC. The text from the magazines is in untranslated German, but it is clear from that text that the mark being used is MAC, rather than the fuller version MAC JEANS.
15. Exhibit ES2 comprises copies from an English magazine called Menswear Buyer, issue August 2009 and Womenswear Buyer, issue July 2008. These exhibits comprise photographs of models identified by the brands of clothing being worn. Again the word MAC (not the fuller version, MAC JEANS) is used in connection with jeans and trousers.
16. Exhibit ES3 is as I have described above. The stylisation and lettering of the mark MAC JEANS varies, sometimes italicised and sometimes not. Sometimes with the word ‘MAC’ above the word ‘JEANS’ and sometimes in linear configuration.
17. Exhibit ES4 comprises extracts taken from Mode’s Autumn/Winter 2007 range of trousers for both men and women. The catalogue has the word ‘MAC’ on the front. This catalogue contains no text at all, apart from the covers which have the word ‘MAC’ and Autumn Winter O7 on the front cover; a website address and Mode’s full address is shown on the back.
18. Exhibit ES5 comprises advertisements placed in 2005 – 2008, showing use, again, of the word ‘MAC. Ms Schönleber says the usage is in relation to a “variety of clothing”. As the accompanying text is in German it is not possible to verify this; by “variety” Ms Schönleber may mean a variety of trouserwear, rather than clothing at large
19. Ms Schönleber says her company places advertisements for MAC JEANS in every country in which products bearing the MAC JEANS trade mark are sold by a commercial agent. These countries are: Austria, Belgium, Bosnia, Germany, Denmark, Finland, Ireland, Italy, Netherlands, Poland, Portugal, Sweden, Spain and the UK. Exhibit ES6 comprises copies of press and magazine clippings showing the MAC trade mark for the period August to October 2009. It is confirmed that the clippings are, “typical of those published in the period December 2003 to December 2008”. These magazines are predominantly in German, and include titles such as: “Textil-Revue”, ‘Cosmopolitan’, ‘Joy’, ‘Bild der Frau’, ‘Freundin’ and ‘PLUS Magazin’. It is unclear where exactly and in what countries they are published but they consistently refer to the clothing by the name ‘MAC’ or, alternatively ‘MAC2B’.

## **DECISION**

### ***Proof of use***

20. The Trade Marks (Proof of Use, etc) Regulations 2004 apply in respect to the Section 5(2) (b) grounds of this case. The provision reads as follows:

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

- (1) This section applies where –
  - (a) an application for registration of a trade mark has been published,
  - (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and
  - (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if –
  - (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
  - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes –
  - (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...
- (5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United

Kingdom shall be construed as a reference to the European Community.

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

21. With a filing date of 26<sup>th</sup> January 1999 and registration date of 20<sup>th</sup> December 2001, it is clear that under Section 6(1) of the Act, Mode’s ‘565 mark is an earlier trade mark. Further, as it completed its registration procedure more than five years before the publication of the contested mark (being 12<sup>th</sup> December 2008), it is subject to the proof of use requirements set out in section 6A of the Act. The relevant 5 year period ends on 12<sup>th</sup> December 2008 and starts on 13<sup>th</sup> December 2003. As far as Mode’s ‘891 mark is concerned, this too is an earlier trade mark under the Act, having a filing date of 23<sup>rd</sup> June 2006, but in this case it is not subject to proof of use requirements as its date of registration is within five years of the date of publication of the application in suit.

22. As regards Mode’s ‘565 mark, and concerning proof of use, consideration has to be taken, also, of section 100 of the Act which states:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Consequent upon section 100, the onus is upon the registered proprietor to prove that it has made use of the trade mark in suit, or that there are proper reasons for non-use.

23. The leading cases on use are well known: *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] ETMR 85 (“*Ansul*”), *La Mer Technology Inc v Laboratoires Goemar SA* [2004] FSR 38 and [2005] ETMR 114 (“*La Mer*”), *The Sunrider Corp v OHIM*, Case C-416/04P (“*Sunrider*”). A helpful synthesis of the ‘legal learning’ from these cases and several more recent ones has been provided in *Sant Ambroeus* (BL O-371-09), in which Ms Anna Carboni, sitting as The Appointed Person, stated as follows:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C-495/07, [2009] ETMR 28 (*Silberquelle*) where relevant:

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector

concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

*The mark as used; Mode’s use and what the evidence shows*

24. It is submitted on behalf of Ms Macpherson that:

- none of the exhibits, with the exception of ES3, show use of the registered mark, MAC JEANS; the mark being used is MAC *solus*;
- specifically, exhibit ES1 comprises magazines dated outside the relevant period and does not show a clear nexus between use of MAC or MAC2B in relation to the illustrated clothing;
- exhibit ES2 also comprises material outside the relevant period; it only shows use of the mark, MAC, and even then it is barely legible, and nor is it clear as to what goods the use relates to or the territory in which they are advertised;
- exhibit ES3 is, in parts, illegible; such use of the mark MAC JEANS as there is appear to relate to, at most, two articles: the ‘Boyfriend Pant’ or ‘Leon Jeans’. None of the examples are dated or clearly show what goods the labels are applied to, the location where they may have been sold or in what quantities. Of the examples of the labelling which are legible (one of which I have reproduced above), the marks are represented in a number of different forms, including manuscript, stitching style, stencil, upper and lower case. The absence of consistent style calls into question which, if any, of the versions has been put to genuine use and indeed, if any have, they may well possess distinctive features not evident in, or which alter, the distinctive character of the registered mark;
- exhibit ES4 shows no use of MAC JEANS, and again suffers from being unable to show any link between the MAC mark and the goods. There is no evidence of geographical extent or locations to which the catalogue was sent or otherwise available;
- exhibit ES5 has no reference to the MAC JEANS mark. It is expressly accepted however, that use of the MAC mark is shown in various countries such as Germany, Denmark, Sweden and Norway;

- exhibit ES6 is outside the relevant period and Ms Schönleber's statement that such articles are 'typical' or articles published during the relevant period cannot be accepted as *proof* of genuine use.
25. It is further submitted on Ms Macpherson behalf that exhibits ES1, ES5 and ES6 cannot in any event be admitted as they are in a foreign language.
26. As far as the tables of sales figures are concerned, it is submitted that these are unsubstantiated by copies of sales invoices to retailers or distributors. It is noted that Ms Schönleber refers to the mark MAC rather than MAC JEANS in referring to the tables, and further observed that Ms Schönleber uses the tentative word "*inferred*", as in, "it can be inferred that all trousers bear the MAC JEANS trade mark", and then asserts positively that it has been used on a list of trouser type products. It is submitted that this uncertainty cannot be taken as a basis for *proving* genuine use.
27. Further, there are no examples of advertising, despite it being said that advertisements are placed in every country in which products bearing the mark MAC JEANS are sold by a commercial agent.
28. In summary, it is said on behalf of Ms Macpherson that there is no evidence of use, let alone genuine use, of the mark MAC JEANS by Mode. At best, the evidence may be taken to demonstrate genuine use of the mark MAC. The mark as registered is MAC JEANS; jeans are defined as a specific form of trouser. The Concise Oxford Dictionary (11<sup>th</sup> Ed) defines 'jeans' as follows:
- "jeans** *pl.n.* hard-wearing trousers made of denim or other cotton fabric."
29. It is finally submitted on behalf of Ms Macpherson that as the specification of the earlier mark '565 comprises more than the specific trousers known as 'jeans', the word 'jeans' assumes more than purely a descriptive meaning for those goods other than jeans.
30. Mode responded to these criticisms, both in general and specific terms. On a general level, they say that although genuine use must be proven by reference to a particular period, this does not render inadmissible, or even necessarily inherently weak or compromised, evidence which may be outside that period. Such evidence is capable of casting light upon, or forming a basis of reasonable inference as to the position during that relevant period. This is supported by, eg Case *C-192/03P Alcon v OHIM [2004] ECR-I-8993* para 41, and many others.
31. They also note the qualifications and knowledge of the person giving the evidence, Ms Schönleber. Evidently, she speaks from an experienced and responsible position within the company which must accordingly be given due weight. On a specific level, Mode say that exhibit ES3 plainly shows use of

the mark MAC JEANS in the context of labelling on the clothes garments themselves. The fact that the stylisation of the lettering and configuration of the words may vary is only relevant insofar as those variant uses may affect distinctive character and the overall identity of the mark. The fact that a mark may not have been used consistently or uniformly over a relevant period is something the legislature expressly allows for, given the very good reason that some 'variant' use is likely as peoples' tastes or perceived tastes change over time.

32. I do not see obvious contradictions in Ms Schönleber's evidence and nor do I see that evidence called into question by other conflicting factual evidence. Furthermore, Ms Macpherson has not asked for her cross examination. In these circumstances, I must accept Ms Schönleber's evidence as it stands, both the words used and the exhibits produced, giving it appropriate weight.
33. Without expressing any 'golden rule', common and entirely legible variants in font (such as ones which would be found and commonly used in a word processing package for example) and configuration (meaning the way words are aligned), would normally constitute, "use in a form differing in elements which do not alter the distinctive character of the mark in the form it was registered". I note the '565 mark is registered in plain script. On that basis, I find that the different 'variants' used in exhibit ES3 constitute, in accordance with the section 6A(4) of the Act, use of, MAC JEANS, as registered. Nor do I draw any adverse inference to the effect that use of such 'variants' in any way undermines the overall case being put by Mode that it has used the mark during the relevant period.
34. I also accept, as Ms Schönleber has said, the type of usage on the actual trousers themselves shown in exhibit ES3 is of a kind which the average consumer has been exposed to during the relevant period. As I have already said, cross examination on this matter has not been requested and Ms Schönleber's claim is consistent with the other documentary evidence that she provides.
35. However, as the evidence also shows, whilst MAC JEANS may be in use on the trousers themselves, the company also uses the shorter versions, MAC or MAC2B, in their own promotional literature.. Whilst I have found then that MAC JEANS has actually been used during the relevant period, I need also to consider, as a contingency, whether, in any event, MAC *solus* would be, "use in a form differing in elements which do not alter the distinctive character of the mark in the form it was registered", i.e MAC JEANS.
36. In relation to the goods of Mode's specification, and for which use is shown (see para 43 below), the separate word 'jeans' would undoubtedly carry only a descriptive message to the average consumer even for those goods which are not, strictly speaking, 'jeans'. Use of MAC is thus not even *variant* use of

MAC JEANS; it is use of MAC JEANS. It is worthwhile noting in this regard, this finding would be consistent with the Guidance followed by OHIM in regard to the Community Regulation (see to that effect Part 6 of the OHIM Opposition Guidelines, para 6.2.1.4, quoted, apparently with approval, at para 19 of BL O/262/06, *Nirvana*, a decision of the Appointed Person). I find then, that use of MAC is use of the mark MAC JEANS as registered. Further, even if I am wrong about this for clothing other than jeans, then I find that the word 'jeans' remains non-distinctive for other forms of clothing contained in Mode's specification and that the omission of the word 'jeans' from the mark MAC JEANS does not alter the distinctive character of the mark in the form in which it is registered.

37. At this point, I need also to consider the tables of figures produced by Ms SchönleberIt is submitted on behalf of Ms Macpherson that, because the data in the tables is unaccompanied by other corroborative evidence such as, eg, sales invoices and/or advertising figures, proof of use is not shown.
38. There can be no prescriptive rules as to what *must* be filed to prove genuine use. Mode draws my attention, for example, to the case of R 1153/2009-1, being an OHIM Board of Appeal decision (*Rössle & Wanner GmbH v Invista Technologies S.a.r.l.*). As regards this case, one must always be alert to the fact that the Board of Appeal may be operating under different procedural rules, but having said that, it is clear from this case that the mere fact that a declaration was not accompanied by bills or invoices did not thereby render it inadmissible or even undermine its probative worth. According to the Board, provided the tables and figures were subject to inclusion within a properly sworn affidavit they constitute evidence as required and must be assessed accordingly. I take the same approach here. I may add at this point that, although the Board of Appeal may operate under different procedural rules, the approach taken by, eg Richard Arnold QC, sitting as the Appointed Person, in BL O-161-07 ("*Extreme*"), (see para 31 especially) is essentially the same, in that a witnesses testimony does not necessarily have to be supported either by documentary records or corroborated by external witnesses in order to have some evidential value. The absence of sales invoices or advertising figures does not undermine the probative worth of the evidence as it stands and as such I accept the tables of figures as positively contributing to the evidence of use.
39. Whilst those figures show that, as compared with the UK, Austria provides Mode with most of its business under the mark, nonetheless 112,164 items were sold between 2003 – 2009, having a total value of 3,733,765 Euros. The business is not thereby vast, but, and I do not understand Ms Macpherson to be taking any point on this; the use is not 'token' or 'sham' or otherwise de minimis. It is therefore 'genuine' use in the Community.

40. Bringing my findings together, even if I discount exhibits ES1, ES5 and ES6 on the basis they are in German which has not been translated, I would still have found that genuine use within the relevant period had been made, and specifically:

- use has been made of the MAC JEANS mark based upon the affidavit and Exhibit ES3 and that such use has occurred within the relevant period;
- the variants used in Exhibit ES3 all fall within the relevant provisions of the Act;
- in any event, use of MAC is use of MAC JEANS or use in a form which does not affect the distinctive character of the mark as registered;
- In the absence of any conflicting evidence or challenge as to its truthfulness, Ms Schönleber's written evidence must be taken to be the truthful evidence of an informed person.

*Fair specification*

41. I need now to consider what a 'fair specification' would be, having regard to that use.

42. Mode has relied upon *specific* items of clothing in its '565 specification in Class 25, as can be seen from the specification at para 3 above. It has not expressly relied upon broader terms such as, eg 'clothing' at large. Ms Schönleber has said in her written testimony that actual use has been made on "jeans and denim trousers, shorts, jeans, denim trousers, Bermuda shorts." I intend to accept this evidence at face value. All of these terms appear in the Class 25 specification relied upon by Mode. There are no difficult sub-categories of products to deal with in this case. The only point I would note is that 'jeans' and 'denim trousers' are mentioned twice, unnecessarily, and I have taken that into account below.

43. Accordingly, I find that a fair specification for the '565 mark, in this case reflecting *actual* use, is:

"jeans, denim trousers, shorts, Bermuda shorts."

**Section 5(2)(b)**

44. The opposition is founded upon Section 5(2) (b) of the Act. This reads:

"(2) A trade mark shall not be registered if because –

(a).....

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

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

45. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

### ***The average consumer and nature of the purchase***

46. The average end consumer for both parties' products, in a notional sense, will be the clothes buying general public. Ms Macpherson's Class 25 goods, with the exception of lingerie, nightgowns and negligees, are not gender specific, notionally speaking. Neither are Mode's '565 Class 25 specification gender specific. Even if the goods themselves were gender specific this would not of course necessarily mean that the average consumers were *exclusively* from that sex. As far as their '891 mark is concerned, the average consumer will also be the clothes buying general public. As far as Ms Macpherson's Class

35 specification is concerned, the average consumer will be a mix of both business consumer and the general public.

47. As the consumer for both parties' goods will be drawn from the same 'pool', I must assume there is identity and commonality as far as the question as to who the respective average consumers are, is concerned.

48. As far as the purchasing process is concerned, both parties' products are, if not everyday purchases, then purchased on a regular basis. They are also personal products selected, in the main, by visual and self selection (but not ignoring the possibility of, e.g. oral selection), either in traditional high street retailers or via the web for example. Consumers in the field will be nothing other than reasonably circumspect and observant in their selection and I will factor these observations into my overall assessment of likelihood of confusion.

***Comparison of marks***

49. The case law makes it clear that I must undertake a full comparison of marks in their totalities, taking account of all differences and similarities. The comparison needs to focus on the visual, aural and conceptual identities of all marks. In this case, Mode relies on two distinct marks and it will be necessary therefore to consider both separately. The respective marks to be compared are as follows:

Ms Macpherson's mark	Mode's marks
<p><b>MISS MAC</b>  <b>miss mac</b>  <b>MissMac</b>  <b>Miss Mac</b></p>	<p>(1) MAC JEANS ('565 mark)  (2) mac:M ('891 mark)</p>

*'565 mark*

50. Visually, Mode's mark presents as two separate words, 'MAC' and 'JEANS', in plain script. Ms Macpherson's marks present also as two words; in the version where they are conjoined, two words would nonetheless be seen, given the use of capital letters. The words are in plain script. The word 'MAC' is common to both parties' marks; in Mode's it precedes the word 'jeans' and in Ms Macpherson's it follows the word 'Miss'. Taking the similarities and dissimilarities of the respective marks into account, overall, I consider the marks to be visually similar to a moderately high degree.

51. Phonetically, Mode's mark will be pronounced as 'MACK JEENS'. There is unlikely to be any variation in that, unless the consumer sees the 'MAC' word as an acronym or abbreviation, 'M-A-C'. On balance however, I think this less likely than pronouncing 'MAC' as 'MACK'. Ms Macpherson's mark will be pronounced 'MISS MACK'. Taking the similarities and dissimilarities into account, overall I consider the marks to be phonetically similar to a moderately high degree.
52. When the authorities talk of conceptual similarity, it is meant semantic conceptual similarity. I must also remember that we are viewing matters from the perspective of the average consumer. The concept invoked by Ms Macpherson's mark, in relation to the goods of her specification, is likely to be that of a female person by the name of 'MAC', ie 'MISS MAC'. It is unlikely that 'MAC' will be seen as a shortened version of MACKINTOSH (as in the rain proof garment), although the average consumer may well consider that 'MAC' is a shortened version or nickname for a longer name. The average consumer will be aware, for example, that many Scottish and Irish names commence with the letters 'Mac' or 'Mc', meaning 'son of', and some may also be aware that 'MAC' or 'Mc' can be used to shorten the name, as in, eg 'SUPERMAC', a nickname used to refer to Harold Macmillan (Former British Prime Minister), or Malcolm Macdonald (ex Newcastle United footballer).
53. The same female name concept will not necessarily be evoked by Mode's 'MAC JEANS' mark. Some consumers may see the MAC word as a wholly invented term but most will see it as being someone's name or having been derived from that.
54. Given that both marks present, to a greater or lesser extent, as personal names, it cannot be said the respective marks are conceptually dissonant. However, given that one is plainly a female name and the other is just a name, I find that the respective marks share only a moderate level of conceptual similarity.

*Overall similarity of the marks.*

55. I need now to consider the overall similarity of the marks having regard to their distinctive, dominant characteristics. It is fair to say that, in both marks, the element which presents as having most distinctive capacity is the 'MAC' element. The word 'MISS' in Ms Macpherson's mark is apt simply to confer common 'title', as in the name of an unmarried woman or girl; the full name being 'MISS MAC'.
56. On that basis and taking into account my individual and separate findings in relation to visual, aural and conceptual similarity, I find that, overall, the respective marks share a moderate degree of similarity.

*'891 mark*

57. Visually, Mode's '891 mark comprises the letters 'mac' in lower case, followed by a semi colon and then a large 'M'. There is no separation as between the letters and the punctuation. Ms Mac Pherson's mark is as previously described. Taking the similarities (notably the common element 'MAC') and dissimilarities into account I find that visually the marks are visually similar to a moderately high degree.
58. Phonetically, it is likely that Mode's mark will be pronounced 'MAC EM' ; the semi colon punctuation mark will not be enunciated. Ms MacPherson's mark will be pronounced as above. Taking the similarities (again, notably the common element 'MAC') and dissimilarities into account I find that, phonetically, the respective marks share a moderate level of similarity.
59. At a conceptual level, it is unlikely Mode's mark will convey any concept at all. Grammatically it is odd, with the semi colon introducing something of an unusual juxtaposition. Without it, the mark may again have been seen as a shortened name, 'macM', but the semi colon is likely to be perplexing as far as the average UK consumer is concerned. It could be said, as with the '565 mark , that given the respective marks share the 'MAC' element then there must be some degree of conceptual similarity. The difficulty with this argument is that in the '891 mark, it is questionable that the 'MAC' element will present itself as an independent and separate element, at least to the extent that it plainly does in the '565 mark. In other words, the '891 mark is more of a 'whole', without separation of elements; the semi-colon has that effect. On that basis, I find that conceptually the marks only share a minimal degree of similarity.

*Overall similarity of the marks.*

60. Bringing my findings together, and noting in particular that the '891 mark has a 'unity' of whole not found in the '565 mark, I find that the respective marks share a low degree of similarity.

***Comparison of the goods***

61. In assessing the similarity of the goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the Judgment:

'In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors

include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.’

62. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.

63. It is important to recognise that even though the factual evidence on similarity is non-existent, I nevertheless have the statements of case, submissions and am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC sitting as the appointed person said in *Raleigh International trade mark* [2001] R.P.C. 11, at para 20, that such evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary. He also stated that the tribunal may, in an appropriate case, consider the question of similarity from the viewpoint of the notional member of the relevant purchasing public.

64. I should also mention a further case in terms of the application of legal principle, and that is the European Court of First Instance (“CFI”) in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (“Meric”)* Case T-133/05, where, at para 29, it is stated:

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

65. The respective goods to be compared are as follows:

‘565 mark

Ms Macpherson’s mark	Mode’s goods for which use is shown
<b>Class 25</b> Underwear, lingerie, socks;	<b>Class 25</b> Jeans, denim trousers, shorts,

<p>sleepwear including pyjamas, nightgowns, negligees and nightshirts; dressing gowns, bath robes, beachwear, swimwear, lounging pants and tops; slippers.</p> <p><b>Class 35:</b></p> <p>Advertising and business services; advertising and promotional services; the promotion of products and services for others; the bringing together, for the benefit of others, of underwear, lingerie, socks, sleepwear including pyjamas nightgowns, negligees and nightshirts, dressing gowns, bath robes, beachwear, swimwear, lounging pants and tops and slippers, enabling customers to conveniently view and purchase those goods from fashion retail stores and houseware retail stores.</p>	<p>Bermuda shorts.</p>
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*Class 25*

66. Ms Macpherson does not accept that: 'lingerie', 'slippers', 'socks' or any of the items of 'sleepwear' are similar to any of Mode's goods. In particular she says that her goods would be considered 'luxury' wear . For its part, Mode says its specification is not limited to 'luxury' wear and the relevant comparison must then include all types of, eg nightwear and lingerie and all types of jeans, denim trousers and shorts. Furthermore, it says that the particular *uses* to which the goods may be put is irrelevant in opposition proceedings which applies a notional test based on the goods and services as specified. I agree with Mode; neither respective specifications contain the words 'luxury wear', either standing alone or qualifying any of the other categories of clothing, and in any event any such term would be inherently legally uncertain.
67. Both parties' Class 25 goods are clothes items, but specific types of clothing, rather than clothing at large. Of course, in general terms it could be said that

both parties' goods are worn, but plainly this is at too high a level of generality.

68. To take the high point of Mode's case, it has 'shorts' and 'Bermuda shorts'. These are not gender specific items. Shorts, such as, eg boxer shorts, can be worn as underwear and are also the kind of clothing which would be worn outside on the beach for example. It is furthermore possible that certain types of swimwear may 'double up' as 'shorts'. Likewise, jeans and shorts may well also be worn inside the house as 'relaxing' clothing, for use in an informal and casual setting. I should say I am not familiar with the term 'lounging pants and tops', but for my purposes, have taken the term to mean informal clothing intended primarily for indoor use, similar to track suits. In terms of their respective channels of trade one would expect, in larger clothes shops such as, eg M&S, such clothing as shorts, beachwear, swimwear, lounging pants and tops to be sold in close proximity, for example in a seasonal promotion in both mens' and womens' collections. Even in much smaller shops, such as those, for example found near beaches, these clothes are likely to be found together. Taking all factors into account, Ms Macpherson's: 'underwear', 'beachwear', 'swimwear' and 'lounging pants and tops' are all identical or highly similar to 'shorts', 'jeans' and 'Bermuda shorts' in Mode's specification.
69. That leaves: 'lingerie', 'socks', 'sleepwear including pyjamas', 'nightgowns', 'negligees and nightshirts' 'dressing gowns' 'bath robes' and 'slippers'. 'Lingerie' and 'negligees' are all gender specific in nature, being for females of course. 'Sleepwear including 'pyjamas', 'nightgowns', 'nightshirts' and 'dressing gowns' and, though not admittedly exclusively, 'slippers' are all related to sleep or the night, but are not gender specific. 'Bath robes' also have a specific purpose. Socks, are a form of underwear worn on the feet. . Thus, the purposes of all these goods contrasts with 'jeans, denim trousers and shorts'. Further, the goods are not in competition. 'In terms of their respective channels of trade, Ms Macpherson's goods would tend to be grouped on different shelves to those of Mode in large retail outlets such as M&S. Smaller outlets would tend to do the same or specialise in one or other group of clothing. For example, lingerie especially can be sold in specialist retail outlets such as, eg ANN SUMMERS or on the web via specialist sites. Jeans and denim trousers may also be sold through their own specialist outlets which would not, for example stock nightwear or bathwear. In larger outlets, including supermarkets, slippers and socks tend to be stocked together as accessories, or along with nightwear. Taking all relevant factors into account, I find that 'lingerie', 'socks', 'sleepwear including pyjamas', 'nightgowns', 'negligees and nightshirts' 'dressing gowns' 'bath robes' and 'slippers' share only a low level of similarity with "jeans, denim trousers, shorts, Bermuda shorts."

70. My findings in Class 25 are thus, as follows:

<b>Ms Macpherson's specification</b>	<b>Mode's specification</b>
'underwear', 'beachwear', 'swimwear' and 'lounging pants and tops'	<b>Identical or highly similar to:</b> shorts, Bermuda shorts."
'lingerie', 'socks', 'sleepwear including pyjamas', 'nightgowns', 'negligees and nightshirts' 'dressing gowns', 'bath robes', 'slippers'.	<b>Low level of similarity to:</b> jeans, denim trousers, shorts, Bermuda shorts."

### Class 35

71. Dealing firstly with the retail services of Ms MacPherson's specification, being the part commencing, "the bringing together.....", she says these are dissimilar to the actual clothing products themselves contained in Mode's specification.
72. On the question of the similarity between goods and retail services of those goods, the General Court (GC) has issued an important decision in Case T-116/06 *Oakley Inc v OHIM* ("*Oakley*"). In this case the Court held that the respective goods and services do not have the same nature, purpose and method of use, for example, because goods are fungible when services are not (see para 47). Despite this, the Court found that the Board of Appeal was correct to find that there were similarities, given the complementary nature of the goods and the respective retail services. That is to say that the goods are indispensable to, or at the very least important for the provision of the retail services, which are specifically provided when the goods are sold (paras 54 and 55). This must be true, regardless of how those services are provided, whether by means of a catalogue or traditional brick and mortar environment . As a consequence, the Court found that retail services are not merely auxiliary or ancillary to the goods in question (para 56). The one rider I should note to this is that the finding of overall similarity is only endorsed by the GC in respect of retail services which are in respect of *identical, or closely connected* to the goods of the earlier mark (para 56). I have already said that the goods of the respective specifications are highly similar.
73. I appreciate there is always a danger in regarding cases like *Oakley* as being authority for broad and inflexible legal propositions, eg to the effect that in all cases retail services for the sale of goods identical to or closely connected to those specified in an opponent's specification *must, a priori*, be regarded as similar to the goods themselves. This is far too rule-based and prescriptive an approach; it potentially obviates the need for any evidence on the point and absolves the decision maker from any responsibility for weighing such evidence, even in technical cases which involve specialist goods and retailing. In the *particular* circumstances of the *Oakley* case, it was accepted,

eg by the GC (para 50) that, “the manufacturers of the goods in question (clothing) often have their own sales outlets for their goods or resort to distribution agreements which authorise the provider of the retail services to use the same mark as that affixed to the goods sold”. I accept that to be the case here, noting that both *Oakley* and this case involve clothing, and I have no evidence or even submissions to the contrary.

74. On that basis, and only to the extent that, Ms Macpherson’s retail services in Class 35 cover goods which I have said are identical to or highly similar to Mode’s goods, I find the following in Ms Macpherson’s specification to be similar:

“the bringing together, for the benefit of others, of underwear, beachwear, swimwear, lounging pants and tops, enabling customers to conveniently view and purchase those goods from fashion retail stores and houseware retail stores.”

75. I find the remainder of Ms Macpherson’s retail services, namely:

“the bringing together, for the benefit of others, of lingerie, socks, sleepwear including pyjamas, nightgowns, negligees and nightshirts, dressing gowns, bath robes and slippers enabling customers to conveniently view and purchase those goods from fashion retail stores and houseware retail stores.”

are not similar to Mode’s goods in Class 25.

76. I need also to consider what I shall term the ‘remaining services’ listed in Ms Macpherson’s Class 35 specification:

“Advertising and business services; advertising and promotional services; the promotion of products and services for others”.

77. According to the Explanatory Note published by WIPO for Class 35 of the Nice Agreement, the classification of Class 35 is explained as follows<sup>1</sup>:

“Class 35 includes mainly services rendered by persons or organizations principally with the object of:

1. help in the working or management of a commercial undertaking, or
2. help in the management of the business affairs or commercial functions of an industrial or commercial enterprise,

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<sup>1</sup> Available at <http://www.wipo.int/classifications/nivilo/nice/index.htm?lang=EN#> .

as well as services rendered by advertising establishments primarily undertaking communications to the public, declarations or announcements by all means of diffusion and concerning all kinds of goods or services.

This Class includes, in particular:

- the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods; such services may be provided by retail stores, wholesale outlets, through mail order catalogues or by means of electronic media, for example, through web sites or television shopping programmes;

.....”

78. Whilst it may be unlikely that Ms Macpherson offers *to other businesses*: “advertising and business services; advertising and promotional services; the promotion of products and services for others.”, I must assume, on a notional basis, these services are used in a manner consistent with the essential function of a trade mark which is to guarantee to the average consumer the origin of particular goods or services. I cannot make any assumption about Ms MacPherson’s actual use or lump the services together with the main retail services as purely ancillary or internal. I am left therefore to consider these services on a normal and notional basis.

79. Accordingly, these services are not similar to Mode’s goods as they are not, firstly by their nature, similar. Jeans and trousers are a tangible, physical object to be worn whilst advertising; business and promotional services are not physically tangible, but instead all these services are geared to *help* (see WIPO Classification notes above) in the everyday working of a commercial undertaking or, in the case of advertising, *communicating* the benefits of the products or services of that commercial undertaking. The respective goods and services are not offered through the same trade channels. It follows also that their respective customers will not be the same as these services are offered on a business to business basis. Moreover, there is no complementary relationship (in the sense that one is dependent upon the other) between the respective goods and services.

'891 mark

Ms Macpherson's mark	Mode's mark
<p><b>Class 25</b> Underwear, lingerie, socks; sleepwear including pyjamas, nightgowns, negligees and nightshirts; dressing gowns, bath robes, beachwear, swimwear, lounging pants and tops; slippers.</p> <p><b>Class 35:</b> Advertising and business services; advertising and promotional services; the promotion of products and services for others; the bringing together, for the benefit of others, of underwear, lingerie, socks, sleepwear including pyjamas nightgowns, negligees and nightshirts, dressing gowns, bath robes, beachwear, swimwear, lounging pants and tops and slippers, enabling customers to conveniently view and purchase those goods from fashion retail stores and houseware retail stores.</p>	<p><b>Class 25</b> Clothing, in particular trousers; headgear; footwear.</p>

*Class 25*

80. Applying the *Meric* case, it is inevitable that Ms Macpherson's Class 25 specification is identical to that of Mode. All Ms MacPherson's goods are clothing, including swimwear. The fact that Mode chooses to specify certain items as being "in particular", does not deprive the specification of its encompassing breadth.

### *Class 35*

81. For the reasons set out in paras 71-74 I find that the retail services of Ms Macpherson's specification are similar to Mode's goods in Class 25.
82. For the reasons set out on paras 76-79 I find that the 'remaining services' are not similar to Mode's goods in Class 25.

### **Likelihood of confusion**

#### **'565 mark**

83. Before proceeding to bring all my findings together in an overall global assessment I need to make an assessment of the distinctive character of the earlier marks. An invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness. In terms of its inherent distinctiveness, I regard Mode's '565 mark to be of at least a average degree of inherent distinctiveness. Although the word 'jeans' is descriptive, the word 'MAC' bears no obvious descriptive connection with, or relationship to, trouserwear.
84. I need to consider also whether this level of inherent distinctiveness can be said to be enhanced through use in the UK market. Plainly, use has been shown but it is hard from the evidence to assess what relative exposure to the UK market the mark has had. In other words, it is not clear what market share has been achieved, relative to other like products and exactly where it is sold. As I have said there are no promotional or advertising figures. The predominant market for Mode's products still appears to be Austria and moreover, it has not relied upon possession of a 'reputation' in the UK. On that basis, I do not find that the degree of inherent distinctiveness I have found is enhanced through use.
85. I have found above that the respective marks share a moderate degree of similarity, that the goods and services vary between being identical, highly similar, similar, through to not similar. I have also found the earlier mark to be at least of average distinctiveness and the identity of the respective average consumers to be the same. I must also bear in mind I need to consider marks as a whole of course, and factor in the notion of 'imperfect recollection'. That is to say, consumers may rarely see marks in use side by side but, in real life, retain an imperfect picture of them.
86. In this case, Mode expressly rely on a 'brand extension' argument, whereby although the consumer may not directly confuse one mark for the another, they may assume the later mark is simply an 'extension' of the earlier mark.

This is sometimes called 'indirect confusion', and is argued on the basis that the 'MISS' word, present in Ms Macpherson's mark would, in the clothing sector, indicate that the goods are aimed at young(er) females. I think this is true, so for example, if the consumer were to see a title such as, 'Mr', 'Miss' or 'Mrs', followed by the name of a clothing brand such as, eg M&S, PEACOCKS, MONSOON , the message conveyed will be that of 'extension' or to indicate a specific range aimed at a particular group.

87. Also, it is important to acknowledge this type of confusion is expressly recognised in case law, see, eg paras 16-17 of *LA Sugar*, a decision of the Appointed Person (BL O-375-10). However, I must also bear in mind that the examples I have given earlier are all of highly distinctive marks with reputations, whereas I have found that Mac Jeans has only an average level of distinctiveness. Further, because Mac is a name, the addition of 'Miss' is more natural than if were added to a word which is not a name, such as Monsoon. The addition of 'Miss' does not therefore point as strongly towards the resultant mark as being a brand extension as might be the case in other circumstances. Nevertheless, if seen in the context of identical, or highly similar goods or directly related retail services, the 'brand extension' message is likely to be taken. Taking all factors into account, the likelihood of indirect confusion is made out in respect of the goods and services which I consider to be identical, highly similar or directly related retail services .

**88. As far as the '565 mark is concerned, then, the opposition therefore succeeds in relation to the following goods and services:**

**Class 25**

Underwear, beachwear, swimwear, lounging pants and tops.

**Class 35**

The bringing together, for the benefit of others, of underwear, beachwear, swimwear, lounging pants and tops enabling customers to conveniently view and purchase those goods from fashion retail stores and houseware retail stores."

89. That leaves the goods and services which I regard to share only a low level of similarity or not to be similar at all. Taking all factors into account I find, as regards those goods and services, the opposition is unsuccessful. **As far as the '565 mark is concerned, the opposition is unsuccessful in relation to the following goods and services:**

## **Class 25**

Lingerie, socks, sleepwear including pyjamas, nightgowns, negligees and nightshirts, dressing gowns, bath robes and slippers.

## **Class 35**

Advertising and business services; advertising and promotional services; the promotion of products and services for others; the bringing together, for the benefit of others, of lingerie, socks, sleepwear including pyjamas, nightgowns, negligees and nightshirts, dressing gowns, bath robes and slippers, enabling customers to conveniently view and purchase those goods from fashion retail stores and houseware retail stores.”

## **‘891 mark**

90. In terms of assessing the distinctive character of this mark; it is an inherently distinctive mark to a high degree. The unusual juxtaposition of the semi colon and verbal elements renders an inventive whole which is more distinctive than the ‘565 mark. This high inherent distinctiveness is not however enhanced through use in the UK.

91. I have found that ‘891 is inherently distinctive to a high degree. I have also found that the respective marks share a low degree of similarity; that the goods vary between being identical, highly similar through to not similar. I have found the identity of the respective average consumers to be the same. I must also bear in mind I need to consider marks as a whole of course, and factor in the notion of ‘imperfect recollection’. That is to say, consumers may rarely see marks in use side by side but, in real life, retain an imperfect picture of them.

92. Unlike the ‘565 mark, I can find no basis to apply any ‘brand extension’ argument and, given especially, the ‘unity of whole’ I have spoken of in relation to the ‘891 mark, I do not find likelihood of confusion and the opposition as regards this mark fails in its entirety.

## **COSTS**

93. Neither side can claim outright, or even significant victory in this case; the honours are effectively shared . Whilst the opponent can claim victory in

respect of certain goods, its victory was not complete and other goods and services survived. In addition, it was entirely unsuccessful as far as its '891 mark was concerned. In the circumstances I make no award of costs.

**Dated this 22 day of June 2011**

**Edward Smith  
For the Registrar,  
the Comptroller-General**