

O-231-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 652590
BY MAGLIFICIO BARBARA SRL
TO REGISTER A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 71021
BY CREACIONES MIRTO S.A.**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 652590
by Maglificio Barbara Srl to register a Trade Mark in Class 25**

and

**IN THE MATTER OF Opposition thereto under No. 71021
by Creaciones Mirto S.A**

Background

1. On 7 November 2002 Maglificio Barbara Srl applied to protect the trade mark MIRTILLO in the UK on the basis of registration in Italy. Protection was sought in relation to the following Class 25 goods:

“Clothing, including boots, shoes and slippers”.

2. The application was subsequently published in the Trade Marks Journal and on 20 June 2003 Creaciones Mirto S.A. filed a Notice of Opposition on the following grounds:

(i) under Section 5(2)(b) of the Act because the mark applied for is similar to the following earlier trade mark owned by the opponent which covers identical and similar goods and there exists a likelihood of confusion on the part of the public –

UK Trade Mark Registration No.	Mark	Date Registration Effective	Specification of Goods
1207484	MIRTO	18 November 1983	Class 25: Articles of outerclothing and T-shirts.

(ii) under Section 5(3) of the Act as the mark applied for is similar to the opponent’s earlier trade mark (see above) which has a reputation in the United Kingdom and use of mark in suit without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark;

(iii) under Section 5(4)(a) of the Act by virtue of the law of passing off.

3. The applicant filed a Counterstatement denying each of the grounds of opposition. In particular the applicant denies the marks are similar and denies that the goods covered by the earlier registration are similar to the applicant’s boots, shoes, and slippers.

4. The opponent filed evidence and both parties have asked for an award of costs in their favour.

5. At the hearing, which took place on 3 August 2005, the opponent was represented by Ms Hutchinson of GSCP. The applicant chose not to attend.

Opponent's Evidence

6. The opponent's evidence consists of a witness statement by Ricardo Fraguas Alvaro, the President of Creaciones Mirto S.A. (the opponent company). It is dated 27 April 2004.

7. Mr Alvaro states that the opponent has used the MIRTO trade mark in the UK continuously since 1974 and that it has built up a substantial reputation and goodwill under the mark over the last twenty years.

8. Mr Alvaro explains that his company's goods are sold to customers throughout the UK through independent retail stores. He refers to Exhibit RFA1 to his statement, confirming copies of invoices dating from 1995 to October 2003 to demonstrate sales throughout the UK including, he states, the following counties and cities:

Lancashire	West Yorkshire	Warwickshire
Staffordshire	West Midlands	Buckinghamshire
South Yorkshire	Cheshire	Worcestershire
Middlesex	Cambridge	Aberystwyth
Nottingham	Norfolk	Cardiff
West Sussex	Leicester	London
Northamptonshire	Suffolk	Lincolnshire
Hertfordshire	Birmingham	Essex

9. Mr Alvaro states that the mark MIRTO appears on permanent fabric labels, on paper cards attached to the goods as well as on the boxes in which the goods are provided to the consumer. Examples of these labels, paper cards and boxes are attached as Exhibit RFA2 to his statement. Mr Alvaro adds that the mark is also used in his company's catalogues and two examples of such catalogues are attached at Exhibit RFA3 to his statement. He states that approximately 2,000 of these catalogues have been distributed each year throughout the United Kingdom since 2000. The mark also appears on point of sale materials in the retail outlets through which his goods are provided, and examples of these materials are exhibited at RFA4, to Mr Alvaro's statement.

10. Mr Alvaro goes on to list the following details of his company's sales under MIRTO between the years 1989 and October 2003.

Year	Gross Sales Value (€)
1989	14,853
1990	51,665
1991	34,723
1992	57,800
1993	73,806
1994	63,344
1995	47,889
1996	43,564
1997	68,995
1998	90,617
1999	75,207
2000	68,788

2001	102,275
2002	126,351
2003	113,744

11. Mr Alvaro submits that the figures above show considerable growth over an extended period of time and that one of the reasons for this growth is the promotion of his company's products on the United Kingdom market in a variety of ways.

12. Mr Alvaro explains that the opponent's products are sold to trade outlets via marketing activities of his company's sales representatives who arrange sales to independent retail outlets across the United Kingdom. Attached at Exhibit RFA5 to his statement are examples of the colour card samples and swatches used by sales representatives in order to assist with the promotion of the goods.

13. Mr Alvaro states that his company has also promoted the MIRTO brand by investing in advertising and he lists below details of his company's advertising expenditure in the United Kingdom for the years 1997 to 2003:

Year	Advertising Expenditure (€)
1997	4,657
1998	9,185
1999	9,849
2000	9,987
2001	5,568
2002	15,879
2003	5,093

14. Mr Alvaro states that his company's goods are advertised in MWB Menswear Buyer magazine which is published ten times a year in the United Kingdom and aimed at the United Kingdom menswear retail industry. He adds that this magazine has a circulation figure of approximately 5000 according to the company's website. Furthermore, Mr Alvaro says that the goods are also advertised in L'Uomo Vogue which is the Italian edition of Vogue but which is available in the United Kingdom, the JC Decaux News Magazine and also in the in-flight magazine of Iberia airlines which operates flights from airports throughout the United Kingdom in Aberdeen, Birmingham, Edinburgh, Glasgow, London, Manchester and Newcastle to Spain and The Canary Islands. Examples of advertisements in these magazines between the years 1997 and 2003 are exhibited at RFA6 to Mr Alvaro's statement.

15. Mr Alvaro submits that his company is well known internationally and has recently been admitted as a member of The Forum for Spain's Top Brands ("The Forum") which is an institution made up of The Association of Spain's Top Brands, the Spanish Ministry of Science and Technology, and the Spanish Institute of Foreign Commerce. The Forum comprises 60 companies who own top Spanish brands, who are leaders in their respective sectors, and who have broad and lasting international presence. He adds that the trade marks of the members of the Forum are considered by The Forum to be internationally renowned and to meet the basic requirements of the World Intellectual Property Organisation concerning top brands. Exhibited at RFA6(a) is a copy of The Forum's letter to the opponent company notifying it of admission to The Forum with an English translation attached.

16. Mr Alvaro states that the opponent company has developed familiarity with the United Kingdom retail industry over the last 20 years in the clothing trade and he is not aware of any other clothing brands on the United Kingdom market which incorporate the prefix MIRT-. In preparation for this opposition the opponent's trade mark attorneys conducted a search of the United Kingdom trade mark register to determine the number of trade marks registered for clothing which comprise the prefix MIRT-. He says that the results have been provided to him and indicate that his company's mark MIRTO is the only such mark registered. He adds that the opponent's mark is very distinctive both because it is meaningless and unusual in relation to the goods and because of extensive use.

17. Mr Alvaro contends that the languages French, German, Spanish and Italian are well known European languages which are likely to be understood by a reasonable and increasing number of United Kingdom residents, and although neither MIRTO nor MIRTILLO have a meaning in English, these words have very similar meanings in Spanish and Italian and are therefore likely to be understood by a reasonable number of United Kingdom residents. Mr Alvaro explains that in Spanish "mirto" means "myrtle" which is a shrub with blue-black berries, whilst "mirtilo" means "bilberry" or "whortleberry" which is also a shrub with blue or black berries. These meanings are mirrored in Italian; "mirto" meaning "myrtle" and "mirtillo" meaning "whortleberry" or "bilberry". Attached at Exhibit RFA7 to Mr Alvaro's statement are extracts from the Collins Spanish-English Dictionary and the Sansoni English-Italian Dictionary evidencing these meanings. Mr Alvaro adds that as Myrtle or whortleberry shrubs have no relevance to the relevant goods and as the meaning of these marks is likely to be understood by a reasonable number of consumers in the United Kingdom there is a likelihood that consumers will believe that the goods provided under both of the marks come from the same company.

18. Mr Alvaro goes on to submit that for those United Kingdom consumers who do not understand Spanish or Italian there is also a likelihood of confusion between the marks MIRTO and MIRTILLO due to the likelihood that the marks will be imperfectly recalled. He adds that from his company's experience marketing products in the United Kingdom, he knows that consumers generally pay more attention to the first part of a brand name as it has more of an impact and is more likely to be recalled than the rest of the name. He contends that the prefix MIRT- of his company's mark is therefore likely to be confused on sight of the mark MIRTILLO.

19. Mr Alvaro states that from his understanding of English he believes the prefixes of MIRTO and MIRTILLO will be pronounced in the same way. He adds that it is well known that suffixes such as -ILLO, -INI and -INO are used in Italian, Spanish and sometimes in English to identify a diminutive form of something. Examples of these uses include cigarillo, crostini, and cappuccino. In Mr Alvaro's view, consumers will believe that products provided under the mark MIRTILLO are his company's range of clothing for children and an extension to the range of his company's clothing. The identical final letter of each mark will increase the likelihood of confusion between the marks.

20. Next, Mr Alvaro states that his company has already opposed a number of applications made by the applicant to register MIRTILLO in territories outside the United Kingdom based on his company's earlier rights in MIRTO and he attaches at Exhibit RFA8, translations of the decisions issued by the authorities in Spain, Hong Kong and at the Office for Harmonisation in the Internal Market ("OHIM"), all of which, he states, endorse his views on the likelihood of confusion between the marks. He adds that the Head of the Appeals Unit at

the Spanish Patent and Trade Marks Office considered that there was an obvious conceptual similarity between the marks and so there was a risk that the public would associate MIRTILLO with MIRTO; the Second Board of Appeal at OHIM considered that the marks MIRTO and MIRTILLO were phonetically similar in view of their identical prefixes, that the second syllable of the marks commenced with the consonant T, and the fact that the marks ended with the letter O, with the Board highlighting the fact that the beginning of marks retain the public's attention and so the points of similarities between MIRTO and MIRTILLO outweighed the differences; and that the Registrar of Trade Marks in Hong Kong decided that MIRTILLO is likely to be seen as the diminutive form of MIRTO and there was a likely chance of imperfect recollection and confusion since the marks had no meaning to purchasers in Hong Kong where English is an official language.

21. Mr Alvaro points out that the applicant in this matter has opposed his company's application to register MIRTO in the United States. Exhibited at RFA9 to his statement is a copy of the Notice of Opposition filed by the applicant in which he submits that purchasers and persons in the trade will be confused as to the source or origin of the goods provided under the respective marks and that purchasers and persons in trade will assume that the goods provided under MIRTO are associated with or endorsed by the applicant.

22. Mr Alvaro concludes by submitting that his company's use of MIRTO for 20 years in the United Kingdom has resulted in his company building a sound reputation and goodwill under the mark and as MIRTO has a highly distinctive character in respect of clothing, consumers in the United Kingdom who do not understand the similar meanings of the marks may confuse them given the identity and distinctiveness of their prefixes and their overall similarity. He adds that those consumers in the United Kingdom who understand the conceptual similarities of the mark are even more likely to believe that goods provided under MIRTILLO come from his company and there is therefore a likelihood of confusion between the marks.

DECISION

23. Firstly, I go to the Section 5(2)(b) ground.

Section 5(2) of the Act reads as follows:

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

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

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

24. An earlier right is defined in Section 6, the relevant parts state:

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

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

25. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

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*, paragraph 23, 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 & C. 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) account should be taken on the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it was registered; *Lloyd*;
- (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*;

- (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.*

26. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection for such a mark. The opponent has filed evidence relating to the reputation of its MIRTO trade mark in the UK. While the evidence confirms use of the mark and provides information on the turnover of goods sold under the mark, it provides no evidence of its market share or evidence going to the extent of its reputation. Given the very large market for the goods – clothing – it seems to me that the turnover details provided do not indicate a particularly high market share and they do not enable me to readily infer that the opponent has a great reputation under the mark in the UK amongst the relevant customers for the goods, who are the public at large. Furthermore, the extent of marketing and promotion of the mark is relatively light. I would add that no supporting evidence from third parties or the trade has been filed.

27. On the evidence filed, I have no doubt that the opponent possesses goodwill in relation to its earlier mark. However, it is a good way from demonstrating that it is a famous or household name amongst the relevant public.

28. The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was recently considered by David Kitchin QC sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion.”

29. The opponent’s mark comprises an Italian/Spanish word which has no reference to the goods at issue. It seems to me that, irrespective of its reputation, the mark MIRTO is inherently fully distinctive and deserving of a wide penumbra of protection. I will take this into account for the purposes of this decision.

30. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, in addition to making comparisons which

take into account the actual use of the respective marks, I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods within the respective specifications.

31. The opponent has drawn my attention to decisions issued in Spain, Hong Kong and at OHIM – paragraph 20 of this decision refers. These decisions are, of course, not binding upon me and I note that the decisions reached in Spain and at OHIM are based on the perceptions of Spanish speaking and not English speaking consumers. Furthermore, the opponent has drawn my attention to the state of the UK register (not supported by evidence) regarding marks incorporating the prefix MIRT – paragraph 16 of this decision refers. However, my decision involves a comparison of the respective marks at issue and must be made on its own merits bearing in mind the guidance I have set out above.

32. I turn to a consideration of the goods covered by the application in suit and the opponent's earlier registration.

33. The application is in respect of "Clothing, including boots, shoes and slippers". While the earlier mark covers "Articles of outerclothing and T-shirts. As the goods of the earlier mark are encompassed by the general term "clothing" within the specification of the mark applied for, there is identity of goods.

34. In its Counterstatement the applicant submits that "boots, shoes and slippers" are not similar to the opponent's goods. At the hearing, Ms Hutchinson on behalf of the opponent pointed out that in the applicant's specification, "boots, shoes and slippers" were expressed as a sub-group of the general description "clothing" by virtue of the word "including".

35. Collins English Dictionary (2000 Edition) defines: "clothing" (inter alia) as something that covers or clothes; "clothes" as articles of dress; and shoes, boots and slippers as coverings shaped to fit the foot. Given the broad scope of these definitions it follows that the term "articles of outerclothing" incorporates "boots, shoes and slippers" as these are all outerwear (as opposed to underwear) which cover (part of) the body. Accordingly, identical goods are involved. Even if I am wrong on this point in that I have been too liberal with the dictionary definitions, it seems to me that the respective goods must be closely similar. My own knowledge and experience tells me that clothing and shoes are often sold through the same specialist outlets, possess the same general function or purpose ie. to cover the body and protect from the elements, and are often complementary fashion items.

36. Now, a comparison of the respective marks. The mark applied for consists of the word MIRTO and the opponent's earlier mark is the word MIRTILLO.

37. The guiding authorities make it clear that I must compare the marks as a whole and by reference to overall impression. I must be careful not to over analyse the marks and thus shift away from the real test which is how the marks would be perceived by customers in the normal course and circumstance of trade.

38. There is no evidence before me as to how the respective marks would be perceived by the relevant customer for the goods ie. the public at large in the UK. The opponent points out that the respective marks consist of Spanish/Italian words with a botanical meaning. MIRTO means "myrtle" and MIRTILLO "whortleberry or bilberry", in the English language. However, I doubt this would be apparent to the relevant customer in the UK. Spanish or

Italian may be relatively well known foreign languages but I doubt that even UK customers with knowledge of those languages would readily identify the words at issue given the relative obscurity of the words.

39. It seems to me that the average customer encountering the relevant marks would not perceive them as having any particular meaning but could well think they were words of Southern European origin, or possibly invented words with a Southern European nuance.

40. I go to a visual comparison of the respective marks. The applicant's mark consists of the eight letter word MIRTILLO, which shares the first four letters and final letter of the opponent's earlier mark the five letter word MIRTO. Accordingly, the respective marks share the same commencement and ending. While the mark applied for contains the additional letters "ill", these are found towards the middle or middle to end part, where the visual impact is less striking. Bearing in mind the possibility of imperfect recollection, it is my view that the respective marks in totality possess obvious visual similarity.

41. In relation to the aural comparison of trade marks used in respect of articles of clothing, I agree with the view expressed by the Registrar's Hearing Officer in the matter of Opposition thereto by Update Clothing Limited under No. 45787 (BL O/258/98) when he said:

"There is no evidence to support Ms Clarke's submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely *primarily* on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon".

42. This view was supported on appeal to the Appointed Person (*REACT Trade Mark* [2000] 8 RPC 285 lines 22 to 26).

43. The marks share the same first syllable and both terminate with an "O" sound. It was accepted under the Trade Marks Act 1938 that in aural use, the beginning of marks is more important than their endings – *'London Lubricants Limited' Application* (TRIPCASTROID) 42 [1925] RPC 264 at page 279. I see no reason why this should not apply under the Trade Marks Act 1994. I note that the respective marks share the first four letters, MIRT. However, while aural similarities exist in relation to the commencement and termination, I take the view that the opponent's case is less strong here than in relation to visual similarity.

44. Next, I turn to a conceptual comparison of the marks. The opponent submits that the word MIRTILLO will be taken to be a "petite version of MIRTO products or a range of MIRTO clothing for children" as ILLO is used in Spanish, Italian to distinguish something small and that there are also numerous instances of such use in the English language e.g. cigarillo, peccadillo. I am far from convinced by this submission as I believe such an interpretation would be far from obvious to the average consumer coming across the marks in ordinary and normal trading conditions. It seems to me that both marks are likely to be perceived by the average consumer as unknown or invented words with a Southern European origin or nuance (paragraphs 38 and 39 of his decision refer). Given the common

commencement and termination of the respective words (paragraphs 40 and 43 of this decision refer) and as words of this nature are far less readily distinguishable than known words with similar appearances but different meanings, I am of the view that there will be conceptual similarity to the average customer, especially as given the nature of the marks. Imperfect recollection of the marks may well be a factor.

45. Finally, the customer for the goods and the nature of the goods. As mentioned earlier in the decision, the relevant customer is the UK public at large. The relevant goods are often necessities as well as being fashion items and are sold through a wide variety of outlets at a wide range of prices. They are usually purchased with a reasonable degree of care after a visual reference, although purchases may be on a relatively occasional basis.

CONCLUSION

46. On a global appreciation, taking into account all the relevant factors, I have come to the following conclusions:

- (i) the respective goods are identical or, if I am wrong on this point, closely similar;
- (ii) the respective marks are visually, aurally and conceptually similar;
- (iii) the customer for the goods is the public at large, who normally purchase the goods on a visual basis, but with a reasonable degree of care.

47. Considering the position in its totality I believe that there is a likelihood of confusion on the part of the public. In reaching this conclusion I have borne in mind that the average customer rarely has the chance to make direct comparisons between marks but must instead rely upon the imperfect picture of them he/she has kept in his/her mind.

48. The opposition under Section 5(2)(b) is successful.

49. As the opposition has been successful under Section 5(2)(b) I have no need to go on to consider the other grounds raised. I would only add that I do not believe them to be any stronger than Section 5(2)(b).

COSTS

50. The opponent has been successful and is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £1,300 which takes into account that the applicant filed no evidence in this case. 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 17 day of August 2005

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General