

O-251-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION

No. 2355496

BY BBC ICE CREAM LLC

TO REGISTER THE TRADE MARK

ICE CREAM

IN CLASSES 3, 14, 18 & 25

AND

IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO

UNDER Nos. 97797 and 96067 BY

GILMAR S.P.A. AND SEMINVEST INVESTMENTS B.V.

BACKGROUND

1) On 10 February 2004, BBC Ice Cream LLC applied to register the trademark **ICE CREAM** in respect of:

Class 3: Preparations for the care of the hair, scalp, face, skin and body; cosmetics; facial makeup, concealers, blushers, facial powders, foundation makeup, eye makeup, eye pencils, eyebrow pencils, mascara, false eyelashes, cosmetic compacts, cosmetic pencils, lipstick, lip gloss, lip pomades, lip pencils; makeup removers; makeup applicators in the nature of cotton swabs for cosmetic purposes; facial cleansers, toners, facial exfoliants and scrubs, facial creams, facial moisturizers, facial lotions and non-medicated facial treatments, wrinkle removing skin care preparations; anti-aging preparations for use on the skin; nail care preparations, nail polishes, nail polish removers, nail creams, cuticle removing preparations, nail buffing preparations; skin moisturizers and skin moisturizer masks, skin conditioners, hand creams, massage oils, essential oils for personal use; talcum powder, bath beads, bath crystals, bath foam, bath gels, bath oils, bath powders, bath salts; skin cleansers, body scrubs; body fragrances; body and hand lotions, body gels, shower gels, body oils, body powders, body exfoliants, body masks, body mask creams and lotions, body creams; shaving preparations, shaving balm, after-shave preparations; skin abrasive preparations; non-medicated lip care preparations, lip cream; sunscreen preparations, sun-block preparations, sun-tanning preparations and after-sun lotions; self-tanning preparations for use on the body, self tanning milk and cream, accelerated tanning cream, self-tanning lotions, gels and sprays; perfume, cologne, eau de toilette, eau de perfume, eau de cologne and toilette water; toothpaste, teeth whitening preparations, mouthwashes; deodorant and antiperspirant; cosmetic pads, pre-moistened cosmetic wipes, pre-moistened cosmetic tissues and towelettes; cotton sticks for cosmetic purposes, all purpose cotton swabs for personal use and cosmetic purposes; non-medicated topical skin creams, ointments, gels, toners, lotions, sprays and powders; aromatherapy creams, lotions and oils; hair care products, shampoos, conditioners, hair mousse, hair gels, hair frosts, hair creams, hair rinses, hairsprays, hair colour, hair waving lotion, permanent wave preparations, hair lighteners, hair dyes, hair emollients, hair mascara, hair pomades, hair colour removers, hair relaxers, hair relaxing preparations, hair straightening preparations, hair styling preparations; hair removing cream, and hair care preparations; baby wipes; antibacterial pre-moistened cosmetic wipe preparations for use on the skin cosmetics; disposable wipes impregnated with chemicals or compounds for personal hygiene and household use; contact lens cleaning preparations; preparations for cleaning eyeglasses, pre-impregnated cloths for cleaning spectacles; excluding bath bombs.

Class 14: Jewellery and related accessories; items made of precious metal, or coated therewith; pendants; lapel pins; ornamental lapel pins; pins being jewellery; ear clips; tie pins and clips; bolo ties with precious metal tips; cuff-links; badges of precious metal; belt buckles of precious metal; jewellery; costume jewellery; jewellery chains; jewellery pins for use on hats; hat ornaments and pins of precious metal; holiday ornaments of precious metal; jewellery boxes and cases of precious metal; match boxes of precious metal; snuff boxes and serviette rings of precious metal; watches and related accessories; wristwatches; pocket watches; stop watches; watch straps and bands; watch chains and fobs; watch cases;

clocks; alarm clocks; clocks incorporating radios; wall clocks; figurines and sculptures of precious metal; piggy banks made of precious metal; book markers of precious metal; precious metal money clips; ashtrays of precious metal; bottle closures of precious metal; coffee services, tea services and toothpick holders of precious metal; vases of precious metal; cruets of precious metal; cruet stands for oil or vinegar of precious metal; flower bowls of precious metal; busts, figures, figurines, statues, statuettes and stirring rods of precious metal; candlesticks, candle holders, candle rings and candle holders of precious metal; non-electric candelabras made of precious metal; cigarette holders and lighters of precious metal; match boxes and holders of precious metal; letter openers of precious metal.

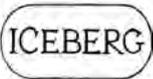
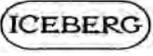
Class 18: Items made of leather or imitation leather; all-purpose sports and athletic bags, fanny packs, backpacks, knapsacks, sports packs, waist packs, gym bags, duffel bags, tote bags, book bags, hand bags, purses, clutch purses, change purses, shoulder bags, carry-on bags, travel bags, garment bags for travel, leather shopping bags, beach bags, satchels, luggage, luggage tags, trunks, suitcases, cosmetic cases sold empty, toiletry cases sold empty, vanity cases sold empty, cosmetic bags sold empty, tool bags sold empty, attache cases, briefcases, briefcase-type portfolios, men's clutches, business cases, business card cases, credit card cases, calling card cases, passport cases, key cases, leather key chains, coin pouches, wallets, billfolds, umbrellas and parasols.

Class 25: Clothing; jackets, coats, parkas, raincoats, blazers, blouses, shirts, T-shirts, skirts, dresses, trousers, jeans, shorts, sweaters, cardigans, scarves and belts; footwear; headwear; jerseys, uniforms, athletic uniforms, pants, cycle pants, slacks, denim jeans, overalls, coveralls, jumpers, jump suits, boxer shorts, under shirts, night shirts, rugby shirts, polo shirts, tops, crop tops, tank tops, halter tops, sweat shirts, sweat shorts, sweat pants, warm-up suits, jogging suits, vests, fleece vests, pullovers, fleece pullovers, snow suits, anoraks, ponchos, dinner jackets, sports jackets, sportswear, golf and ski jackets, reversible jackets, suits, turtlenecks, swimwear, beachwear, caps, berets, hats, headbands, wrist bands, headwear, ear muffs, aprons, scarves, bandanas, belts, braces for trousers, suspenders, neckwear, neckties, ties, bow ties; babies' wear, cloth bibs, cloth diapers, booties; infantwear; underwear, briefs, trunks, bras, sports bras, singlets, socks; loungewear, robes, bathrobes, pajamas, sleepwear, night gowns; lingerie, camisoles, slippers, stockings, body stockings, pantyhose, hosiery, knit hosiery, leg warmers, bodysuits, leggings, tights, leotards, unitards; gloves, mittens; footwear, shoes, sneakers, boots, galoshes, sandals, zori, slippers and rainwear.

2) The application was examined and accepted, and subsequently published for opposition purposes on 2 November 2007 in Trade Marks Journal No.6708. A priority claim of 13 August 2003 was made due to its OHIM registration.

3) Gilmar S.p.A. and Seminvest Investments BV (hereafter the opponents), filed notices of opposition, both dated 24 July 2008, subsequently amended and consolidated. The consolidated grounds of opposition are in summary:

a) The opponents are the proprietors of the following trade marks:

Trade Mark	Number	Application Date and Registration Date	Specification
	1247863	07.08.1985 / 30.04.87	Class 3: Cosmetic articles included in Class 3 for personal use; soaps; perfumes; essential oils; hair lotions.
			Class 18: Articles of luggage, trunks (luggage), travelling bags, purses (not of precious metal or coated therewith); key holders and shoulder belts, all made of leather.
ICEBERG IC priority claim of 15.12.1988 based on Italian registration	1386189	30.05.1989 / 15.02.1991	Class 9: Eye glasses and lenses; spectacles, spectacle glasses and lenses; spectacle frames and parts and fittings therefor; spectacle cases; sunglasses; all included in Class 9.
ICEBERG IC priority claim of 15.12.1988 based on Italian registration	1386190	30.05.1989 / 25.01.1991	Class 14: Timepieces, clocks, watches; jewellery; all included in Class 14.
	1175324	20.05.1982 / 30.05.84	Class 25: Articles of clothing; but not including footwear other than woven or knitted footwear.

b) The opponents state that the mark applied for is similar to the opponent's earlier registrations and that the goods applied for, excluding the Class 3 goods, are similar to the opponent's goods for which its' marks are registered. The opponent states that the application offends against Section 5(2)(b) of the Trade Marks Act 1994.

c) The opponents state that they have goodwill in the mark ICE and in marks containing the mark ICE. They state that they have used this mark in the UK on clothing and fashion accessories, bags and spectacles since 1999. The mark in suit, in relation to the goods sought to be registered in Classes 14, 18 and 25, therefore offends against Section 5(4)(a).

4) On 16 September 2008 the applicant filed a counterstatement which denied the opponents' claims. The applicant puts the opponents to strict proof of use.

5) Both sides filed evidence. The matter came to be heard on 29 June 2010 when the applicant was represented by Mr Acland of Queen's Counsel instructed by Messrs Mischon de Reya and the opponents were represented by Ms Szell of Messrs Venner Shipley LLP.

OPPONENTS' EVIDENCE

6) The opponents filed a witness statement, dated 16 April 2009, by Massimo Marani the Chief Financial Officer of Gilmar S.p.A. He states that Seminest Investments BV is his company's parent company. The marks owned by the parent company are used by Gilmar S.p.A. as a consequence of a licence agreement between the two companies. He states that his company produces and sells clothing and accessories under a range of marks which include the word ICE. These include ICEBERG, ICE JEANS, SPORT ICE, ICE J, ICE ICE ICEBERG and ICE ICEBERG. He states that his company first used the ICEBERG mark in the UK in 1992 in relation to clothing and accessories. He states:

“4.Over 1997 to 1998, my company phased out the SPORT ICE mark, replacing it with ICE JEANS. The ICE JEANS brand effectively replaced the SPORT ICE brand, building on the reputation and goodwill already built up under that brand, particularly the ICE element. By 2004, my company had introduced other ICE marks to the UK including ICE ICE ICEBERG, ICE J and ICE B. In 2007 the ICE ICEBERG line has been launched. In this witness statement I will refer to the marks SPORT ICE, ICE JEANS and other marks containing ICE (excluding however the marks comprising the ICEBERG mark) as “Ice marks”.

5) By “accessories” in the above two paragraphs and elsewhere in this witness statement I mean goods which are frequently sold alongside clothing such as bags, purses, wallets, watches, bracelets and necklaces.”

7) At exhibits MM1 and MM2 he provides turnover and promotion figures for clothing and accessories sold under the mark ICEBERG and ICE marks for the UK. These figures are in Euros. The figures are shown below.

Year & Goods	Iceberg Sales €	Iceberg Advertising €	Ice Lines Sales €	Ice Lines Advertising €
1998 wear	1,114,077	211,990	4,136,625	51,129
1998 accessories	42,635		75,151	
1999 wear	1,552,240	45,448	4,569,360	59,392
1999 accessories	46,051		73,837	
2000 wear	1,626,914	186,469	6,788,277	226,478
2000 accessories	71,647		172,662	
2001 wear	1,285,757	314,714	4,042,370	291,820
2001 accessories	115,604		115,959	
2002 wear	1,661,988	192,700	4,832,165	158,742
2002 accessories	123,881		99,221	
2003 wear	1,509,983	311,376	4,587,572	78,897
2003 accessories	123,657		109,405	
2004 wear	1,421,941	281,161	3,943,095	0
2004 accessories	74,947		78,068	
2005 wear	625,074	246,906	1,440,219	108,500

2005 accessories	15,489		41,053	
2006 wear	267,869	169,602	981,197	0
2006 accessories	25,294		77,923	

8) Mr Marani also provides, at exhibits MM3-MM21 copies of catalogues of his company's goods. These were distributed to UK distributors and others in the UK interested in selling the opponents' goods. He states that the catalogues show how the various marks were used. He contends that the exhibits show that where the marks ICE B or ICE J are used the mark ICEBERG is also present in the catalogue. He claims that the clothing is effectively dual branded and he draws a parallel with POLO and Ralph Lauren. However, in the case of the ICE J products in the Autumn /Winter 2005/2006 collection and the photographs of the ICE B collection it is possible to see the marks ICE B and ICE J alone on the T-shirts, tags, belts and bags. He claims that this gives particular attention to the mark ICE in such lines. All the catalogue exhibits show the mark stated on the cover with outer clothing for men and women shown in the photographs.

- Exhibit MM3: ICEBERG Spring/Summer 2000, also shows use on belts and bags.
- Exhibit MM4: ICE JEANS Autumn/Winter 2000/2001 also shows use on key rings, bags and belts.
- Exhibit MM5: ICE JEANS Spring /Summer 2004 also shows use on belts and photos of the ICE J collection of the same season.
- Exhibit MM6: ICEBERG Autumn/Winter 2003/2004 also shows use on a handbag and belts.
- Exhibit MM7: ICEBERG Spring/Summer 2005.
- Exhibit MM8: ICEBERG Autumn/Winter 2005/2006 also shows use on a shoulder bag and belts.
- Exhibit MM9: ICEBERG Bags Autumn/Winter 2005/06 and Spring/Summer 2006.
- Exhibit MM10: ICE B Autumn/Winter 2005/2006. It is claimed that this exhibit also shows use on bags and belts. Whilst the models are wearing belts and carrying bags, unlike other catalogues these items are not identified by a code with which they could be ordered, nor can any trade mark be seen on the items.
- Exhibit MM11: ICE J Spring/Summer 2006 also shows use on key rings, necklaces, handbags and belts.
- Exhibit MM12: ICE J Autumn/Winter 2005/2006 also shows use on keyrings, handbags and belts.

- Exhibit MM13: ICE B Autumn/Winter 2005/2006 has all of exhibit MM10 and a few more pages from the same catalogue. It also shows use on belts.
- Exhibit MM14: ICE ICE ICEBERG. This is stated to be Spring/Summer 2006 but it carries no actual date other than the internet search date of June 2006.
- Exhibit MM15: ICEBERG Spring/Summer 2006. Also shows use on handbags and belts.
- Exhibit MM16: ICEBERG Autumn/Winter 2006/2007 also shows use on handbags.
- Exhibit MM17: ICE B Autumn/Winter 2006/2007.
- Exhibit MM18: ICEBERG Spring/Summer 2007. It is claimed that this exhibit also shows use on bags and belts. Whilst a bag can be seen with the mark ICEBERG upon it, it does not have an order code. No belts are offered for sale.
- Exhibit MM19: ICE B Spring/Summer 2007 also shows use on belts.
- Exhibit MM20: ICEBERG Autumn/Winter 2007/2008. Use is also claimed on bags, but whilst there are bags in the photographs they are not coded for order nor do they show the mark.
- Exhibit MM21: ICE ICEBERG Autumn/Winter 2007/2008 and Spring/Summer 2008 together with photographs of the Autumn/Winter 2007 collection.
- Exhibit MM22: This consists of copies of invoices for items of clothing such as T-shirts, shirts, sweaters, skirts, dresses and jeans under ICE JEANS in the UK, dated 2002-2003.
- Exhibit MM23: This consists of invoices for sales of ICE J, ICE B and ICEBERG goods for the years 2004-2007. These invoices are said to also cover sales of belts, bags, bracelets, necklaces and key rings. However, only belts and bags are shown under all three marks. Use on necklaces for ICEBERG is shown as is use on key rings and bracelets for ICE B.
- Exhibit MM24: This shows a list of the opponent's distributors and retailers in the UK for the years 2004-2007 inclusive. It is stated that all those on this list would have sold both ICEBERG and ICE branded products. The addresses shown cover the whole of the UK.
- Exhibits MM25-30: This consists of copies of advertisements which appeared in the UK magazines during the years 2002-2007 inclusive. They show use of the ICEBERG, ICE JEANS, ICE ICE ICEBERG, ICE B, marks.
- Exhibit MM31: Copies of invoices for the purchase of advertising in UK magazines.

- Exhibit MM32: Eyewear is claimed to have been sold in the UK since 1992. Sales figures for the years 2002-2007 for eyewear under ICEBERG and ICE are provided. These are in Euros and are said to relate to UK sales although a breakdown for each trade mark is not provided. From 2002-2005 inclusive the average annual sales figure was approximately 18,000 Euros.
- Exhibit MM33: Examples of invoices for eyewear sold in the UK for the period 2001-2007. Very few refer to the mark ICEBERG, there is no reference to any of the opponent's other trade marks.
- Exhibit MM34: Copies of catalogues for eyewear for the period 2002-2006 together with photographs of the products. The only marks shown in this exhibit are ICEBERG and ICE.
- Exhibit MM35: A copy of the opponent's eyewear catalogue for 2006-2007 which is said to show the types of eyewear sold in the UK. The only mark shown in this exhibit is ICEBERG.

9) None of the opponents' evidence shows use of the marks 1247863 or 1175324. Whilst the volume of evidence is impressive, it would appear to have been selected more for its sheer weight rather than its relevance or quality as much of it is repetitive.

APPLICANT'S EVIDENCE

10) The applicant filed a witness statement, dated 2 November 2009, by Loic Villepontoux the brand manager of the applicant company, a position he has held since 2005. He states that the company was the result of the collaboration between musician Pharrell Williams, his manager Robert Walker and the designer Nigo. The purpose was to develop two high end luxury fashion/sportswear lines under the marks BILLIONAIRE BOYS CLUB and ICE CREAM. He questions whether the opponents used the mark "SPORT ICE" after 1998, and whether the marks ICE ICE ICEBERG or ICE B were in use in the UK prior to the start of 2004. He also questions the amount of use of ICE J within the UK. He points out that the opponents never use just the mark ICE. It is always used in combination with other words. He contends that it is common in the fashion industry to have a signature range and then a diffusion range. He explains that the signature range is usually very expensive and exclusive with the diffusion range being more widely available. Mr Villepontoux states that this is the case with Armani/Armani Jeans and Paul Smith/Paul Smith Jeans. In both instances he states that the word "Jeans" is used to mean casual clothing rather than actual denim trousers. He also claims that in other proceedings between the two parties in the USA, a senior officer of the opponents' company accepted that the opponents did the same with their ICEBERG/ICEBERG ICE JEANS range, He contends that the mark ICEBERG is always used with the other marks of the opponents in order to maintain the link to the signature range. However, no evidence was filed to support any of these contentions.

11) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

12) I turn to the first ground of opposition under section 5(2)(b) which reads:

“5.-(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.”

13) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“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.”

14) In these proceedings the opponents are relying upon a number of earlier marks which have registration dates ranging from 30 May 1984 to 15 February 1991. All are clearly earlier marks which are subject to The Trade Marks (Proof of Use, etc) Regulations 2004, paragraph six of which states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) 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.”

15) The publication date of the application was 2 November 2007. Therefore, the relevant period for proof of use is 3 November 2002- 2 November 2007. All of the opponent’s marks were registered prior to 3 November 2002 and require proof of use. I must first consider whether the opponents have fulfilled the requirement to show that genuine use of the marks has been made. The guiding principles to be applied in determining whether there has been genuine use of a mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following main points:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);

- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);

- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);

- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);

- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

16) I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

17) In *Reckitt Benckiser (España), SL v Office for Harmonization in the InternalMarket (Trade Marks and Designs) (OHIM)* Case T-126/03, it was said:

“42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T- 203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45. It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or subcategories.

53 [...] although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

18) The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant.

"20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for

any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

19) I now turn to consider the evidence filed in this case. In the statement of grounds the opponents stated that the mark 1386190 had only been used on "watches, bracelets, necklaces" even though it is registered for "timepieces, clocks watches, jewellery; all included in Class 14". The applicant contends that the opponent can only rely upon the limited specification listed in the statement of grounds, provided it can show use on these items. I agree with this contention.

20) Below is a table showing which exhibits provide evidence of use of which mark between the relevant dates which excludes exhibits MM3 and MM4 from consideration as they pre-date the relevant period. It should be noted that none of the exhibits show use of marks 1247863 or 1175324 in its exact form complete with device element.

	ICEBERG	ICE JEANS	ICE B	ICE J	ICE ICE ICEBERG	ICE ICEBERG	ICE
Clothing	MM 6, 8, 15, 16,18 & 20.	MM5 & 22.	MM10, 17 & 19.	MM11 & 12.	MM14.	MM21.	
Hand Bags	MM6,8,9,15, 16 & 23		MM23	MM11, 12 & 23.			
Belts	MM6, 8, 15 & 23.	MM5	MM13, 19 & 23	MM11, 12 & 23			
Keyrings			MM23.	MM11 & 12.			
Watches							
Necklaces	MM23.			MM11			
Bracelets			MM23.				
Spectacles	MM34 & 35.						MM34

21) The opponent's accept that the evidence provided does not show use of two of their marks as registered (1247863 & 1175324) but they rely upon the provisions of section 6A(4). This allows use of the mark in a form differing in elements which do not alter the distinctive character of the mark as registered. In the *NIRVANA* case (BL O/262/06) Mr Arnold Q.C (as he was) acting as the Appointed Person set out the test as follows:

"33...The first question...is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period..."

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above the second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the

mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the difference at all.”

22) The Appointed Person had regard to a number of authorities. In *Budejovický Budvar Narodní Podnik v Anheuser-Busch Inc* [2003] RPC 25 the Court of Appeal dealt with issues relating to use of a trade mark in a form which does not alter the distinctive character of the mark in the form in which it was registered. In that case Lord Walker stated:

“43 ...The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry: "Bare ruin'd choirs, where late the sweet birds sang" is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of "whose eyes?-- registrar or ordinary consumer?" is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgement, to analyse the "visual, aural and conceptual" qualities of a mark and make a "global appreciation" of its likely impact on the average consumer, who: "normally perceives a mark as a whole and does not proceed to analyse its various details."

23) Also of relevance are the comments, in the same decision, of Sir Martin Nourse, where he stated, at paragraph 12:

“Mr Bloch accepted that, in relation to a particular mark, it is possible, as Mr Salthouse put it, for the words to speak louder than the device. However, he said that it does not necessarily follow that the entire distinctive character of the mark lies in the words alone. That too is correct. But there is yet another possibility. A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or to put it the other way round, the words have dominance which reduces to insignificance the other recognisable elements...”

24) The opponent contends that its marks as registered (No.s 1247863 & 1175324) consist of the word ICEBERG within a lozenge shaped device. They also contend that the lozenge will simply be seen as a label or perimeter fence to the word within it, with the word ICEBERG being the dominant and distinctive element. I do not consider the absence of the lozenge alters the distinctive character of the trade mark. Consequently, the use of the mark as shown in the evidence satisfies the provisions of section 6A(4)(a). This point was accepted by the applicant at

the hearing. The effect of this is that the opponent's four marks will be treated as being identical i.e. consisting of the word "ICEBERG". Any use of this word will constitute use of any of the four marks registered.

25) I now turn to consider the evidence of use with a view to determining on which goods use has been shown. The opponents have filed considerable evidence of the mark ICEBERG used on clothing. The applicant contends that the opponents have only shown use on "articles of clothing for men and women". I accept that no use has been shown on children's clothing. The sales figures provided in the witness statement of Mr Marani show that during the four year period 2003-2006 clothing sales totalled approximately four million euros in the UK. During the same period approximately one million euros was spent on marketing. I note that the marketing relates to all products not just clothing. The sales figures for clothing have been declining and in the context of the UK market for clothing as a whole they whilst they are not significant enough to achieve a reputation sufficient to gain enhanced protection, they are adequate enough to show that there has been genuine use.

26) Moving on to consider the Class 18 specification, there is little use of bags shown in the catalogues. Many of the models shown in the catalogues and advertisements are carrying handbags or shoulder bags/belts, but for the most part no trade mark can be seen on the bag and in the catalogues it is rare that an order number for a bag is provided. Certainly there is no sign of luggage or trunks, merely hand bags or shoulder bags. Similarly there is no use of the mark ICEBERG shown on key rings. At the hearing the applicant accepted that use had been shown upon handbags and shoulder bags/belts

27) With regard to the Class 14 specification the opponents in their statements of grounds sought to rely upon "watches, bracelets and necklaces" only. Whilst the opponents have provided invoices which show one necklace and twelve bracelets being sold in the relevant period it is not clear whether they were sold under the ICEBERG mark or under one of the opponents' other trade marks. The opponents referred to a single advertisement within the relevant period at exhibit MM27 page 829 where the model is wearing a bracelet and the advertisement states, inter alia, "metal jewellery from a selection, all by Iceberg". They also relied upon the witness statement of Mr Marani where he states that bracelets are part of what he refers to as accessories. I accept that there are bracelets shown on some invoices and that these are said to be merely sample invoices. However, it is not clear which trade mark they were sold under. As such I am not inclined to accept that the opponents have shown use of its ICEBERG mark on bracelets. No evidence of any sales of watches or use in catalogues or advertisements was provided.

28) The applicant accepts that the opponents have used its ICEBERG trade mark in relation to the whole of their Class 9 specification.

29) Lastly I turn to the Class 3 specification where no evidence of use has been provided.

30) The consequence of the above means that the specifications of the opponents' trade marks have been significantly reduced. The table below shows the registered specification and that which is left following the proof of use test and which will be used in the comparison test with the specification applied for by the applicant.

Specification as registered	Specification remaining after the proof of use test.
Class 3: Cosmetic articles included in Class 3 for personal use; soaps; perfumes; essential oils; hair lotions.	Nothing.
Class 9: Eye glasses and lenses; spectacles, spectacle glasses and lenses; spectacle frames and parts and fittings therefor; spectacle cases; sunglasses; all included in Class 9.	Class 9: Eye glasses and lenses; spectacles, spectacle glasses and lenses; spectacle frames and parts and fittings therefor; spectacle cases; sunglasses; all included in Class 9.
Class 14: Timepieces, clocks, watches; jewellery; all included in Class 14.	Nothing.
Class 18: Articles of luggage, trunks (luggage), travelling bags, purses (not of precious metal or coated therewith); key holders and shoulder belts, all made of leather.	Handbags and shoulder bags/belts
Class 25: Articles of clothing; but not including footwear other than woven or knitted footwear.	Articles of clothing for men and women.

31) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) 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*

32) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. 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 different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponents on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods in each parties specification.

33) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. (as he was then) 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. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

34) The opponents have provided turnover figures and marketing figures. However, they are not particularly significant given the size of the UK clothing market. The opponents did not provide evidence of market share or any independent trade evidence. The evidence is not sufficient for them to enjoy enhanced protection because of reputation. However, I do accept that the opponents’ marks are inherently highly distinctive for the goods for which they have been used.

35) I must now determine the average consumer for the goods of the parties.

Both parties’ goods in Classes 14, 18 & 25 are everyday consumer goods bought by the general public. They will be purchased in a variety of ways, e.g. in a retail store, online or by mail order. With regard to clothing and handbags considerable care will be taken in the purchase as the average consumer will take into account issues such as size, style, material and cost. I take into account the comments of the General Court in cases such as *Société Provençale d’Achat et de Gestion (SPAG) SA v OHIM* Case T-57/03 and *React Trade Mark* [2000] RPC 285, where guidance is provided that, bearing in mind the manner in which clothing goods will normally be purchased, it is the visual impression of the marks that is the most important. This would normally be from a clothes rail, a catalogue or a website rather than by oral request. Notwithstanding this, aural and conceptual considerations remain important and should not be ignored. Jewellery is usually, in my experience, a very considered purchase, selecting the stones to be used etc. Although I accept that the purchase of cheap costume jewellery will not be

undertaken with the greatest care. Spectacles can be purchased via mail order or the internet in the case of sunglasses or cheap reading glasses. However, to my mind, the majority of spectacles and lenses will be purchased at opticians and considerable care and attention will be paid to such items.

36) I shall now consider the goods of the two parties. The applicant accepted at the hearing that the Class 25 goods were identical and that the following goods in its Class 18 specification “bags or holders for spectacles, contact lenses or sunglasses” are identical to the opponents’ Class 9 goods. For ease of reference, I set out the goods of the applicant and the limited range of goods which the opponents are able to rely upon following the proof of use exercise.

Applicant’s specification	Opponents’ revised specification
<p>Class 14: Jewellery and related accessories; items made of precious metal, or coated therewith; pendants; lapel pins; ornamental lapel pins; pins being jewellery; ear clips; tie pins and clips; bolo ties with precious metal tips; cuff-links; badges of precious metal; belt buckles of precious metal; jewellery; costume jewellery; jewellery chains; jewellery pins for use on hats; hat ornaments and pins of precious metal; holiday ornaments of precious metal; jewellery boxes and cases of precious metal; match boxes of precious metal; snuff boxes and serviette rings of precious metal; watches and related accessories; wristwatches; pocket watches; stop watches; watch straps and bands; watch chains and fobs; watch cases; clocks; alarm clocks; clocks incorporating radios; wall clocks; figurines and sculptures of precious metal; piggy banks made of precious metal; book markers of precious metal; precious metal money clips; ashtrays of precious metal; bottle closures of precious metal; coffee services, tea services and toothpick holders of precious metal; vases of precious metal; cruets of precious metal; cruet stands for oil or vinegar of precious metal; flower bowls of precious metal; busts, figures, figurines, statues, statuettes and stirring rods of precious metal; candlesticks, candle holders, candle rings and candle holders of precious metal; non-electric candelabras made of precious metal; cigarette holders and lighters of precious metal; match boxes and holders of precious metal; letter openers of precious metal.</p>	<p>Class 25: Articles of clothing for men and women.</p>
<p>Class 18: Items made of leather or imitation leather; all-purpose sports and athletic bags, fanny packs, backpacks, knapsacks, sports packs, waist packs, gym bags, duffel bags, tote bags, book bags, hand bags, purses, clutch purses, change purses, shoulder bags, carry-on bags, travel bags, garment bags for travel, leather shopping bags, beach bags, satchels, luggage, luggage tags, trunks, suitcases, cosmetic cases sold empty, toiletry cases sold empty,</p>	<p>Class 18: Handbags and shoulder bags/belts.</p> <p>Class 9: Eye glasses and lenses; spectacles, spectacle glasses and lenses; spectacle frames and parts and fittings</p>

<p>vanity cases sold empty, cosmetic bags sold empty, tool bags sold empty, attache cases, briefcases, briefcase-type portfolios, men's clutches, business cases, business card cases, credit card cases, calling card cases, passport cases, key cases, leather key chains, coin pouches, wallets, billfolds, umbrellas and parasols.</p>	<p>therefor; spectacle cases; sunglasses; all included in Class 9.</p>
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37) In carrying out the comparison I will take into account *British Sugar Plc v James Robertson & Sons Ltd* (TREAT) RPC 281. This identified the following as elements to be considered, uses, users, nature, trade channels, where the items are to be found and whether they are in competition.

38) I also take into account the views of Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

39) The question of complementary goods/services has been considered by the CFI in *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case T- 325/06 the CFI stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685 , paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057 ; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757 , paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000 , paragraph 48).”

40) The opponents contend that the following goods in Class 14 are similar to articles of clothing as they “are sold with clothing and chosen when worn to be complimentary with the same.”

“Jewellery and related accessories; items made of precious metal, or coated therewith; pendants; lapel pins; ornamental lapel pins; pins being jewellery; ear clips; tie pins and clips; bolo ties with precious metal tips; cuff-links; badges of precious metal; belt buckles of precious metal; jewellery; costume jewellery; jewellery chains; jewellery pins for use on hats; hat ornaments and pins of precious metal; holiday ornaments of precious metal.”

41) The opponents were unable to refer to any evidence filed in this case which would support their view that the goods should be regarded as similar using the criteria in paragraph 37 above. However, Ms Szell referred me to the views of the Court of First Instance in *El Cortes Ingles SA v OHIM* (case T-443/05) ETMR 81 at paragraphs 45-51 where they said:

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

46 It must be recalled that the court has also confirmed the existence of a slight similarity between “ladies' bags” and “ladies' shoes” (*SISSI ROSSI* at [68]). That finding must be extended to the relationships between all the goods in Class 25 designated by the mark applied for and the leather and imitation leather goods not included in other classes, in Class 18, designated by the earlier mark.

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

48 As to whether clothing, footwear and headgear in Class 25 are complementary to “leather and imitations of leather, and goods made of these materials and not included in other classes” in Class 18, it must be recalled that, according to the case law, goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods lies with the same undertaking (*SISSI ROSSI* at [60]).

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

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

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

42) Ms Szell drew the analogy between handbags, which are often purchased as part of an outfit as they need to match/contrast with regard to colour and material, and costume jewellery which she said was similarly purchased to be used with a particular outfit. The point was not contested by the applicant and so I, somewhat reluctantly, will agree that for the purposes of this case jewellery will be regarded as complimentary to clothing.

43) The opponents also contend that their goods in Class 25 are similar to the applicant’s goods in Class 18 and referred me again to the case shown at paragraph 41 above. Again the applicant did not resist the argument that handbags are similar to clothing. In the instant case this does not overly matter as the opponents have shown use on handbags and so has a Class 18 registration.

44) My conclusions with regard to the goods of both parties are that the goods of the two parties in Classes 25 and 18 are identical or very similar, whilst the opponents’ goods in Class 25 are similar to the jewellery items in the Class 14 goods of the applicant, but dissimilar to items such vases, coffee services, candle holders, cruets etc.

45) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant’s Trade Marks	Opponents’ Trade Marks
ICE CREAM	ICEBERG

46) The opponents contend that the word “ICE” at the beginning of their mark “has greater distinctiveness in the mark ICEBERG as a result of the use of the marks made by the opponents”. Further, the opponents contend “the factors to be taken into account in deciding likelihood of confusion include the opponent’s reputation in the ICE element of its trade marks. The manner of use of the marks shows that they are used prominently and that the ICE element of the mark is often dominant. This gives rise to a particular reputation based on the ICE element of the marks and means that confusion is more likely”.

47) I note the comments of Professor Annand acting as the Appointed Person in case O/411/01 where she said:

“36) Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by section 6). Thus where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant’s mark must be considered

against each of the opponent's earlier trade marks separately (*ENER-CAP Trade Mark* [1999] RPC 362).

37) In some circumstances, it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a "family of marks" in the proprietorship and use of the opponent (*AMOR*, Decision no 189/1999 of the Opposition Division, OHIM OJ 2/2000, p. 235). However, that has not been shown by the evidence to exist in the present opposition and cannot, as contended by Mr Walters on behalf of the opponent, be presumed from the state of the register in Classes 29 and 31."

48) There is nothing in the evidence which shows that when using its ICEBERG mark the opponents place emphasis on the initial part of the mark. All of the use shown prior to the relevant date for the opposition, 10 February 2004, and the proof of use shows the mark being used in plain capital letters, all in the same font, colour and size. The opponents would appear to be attempting to rely upon use of their other, unregistered, marks to make the case that the public has been educated to view the term ICE as the dominant element in its family of marks. However, the evidence provided does not support this contention as there is very limited use of the term ICE prior to the relevant date and no evidence that the public views the ICE part of the ICEBERG mark as its dominant part. To my mind the word ICEBERG is such a well known term with a clearly defined meaning that the average consumer will view it for what it is; a single word and not artificially seek to dissect it.

49) In *Claude Ruiz-Picasso V OHIM* C361/04 [2006] E.T.M.R. 29 the Court of Justice of the European Communities (First Chamber) held that:

"H6 1. The likelihood of confusion between signs must be appreciated globally, taking into account all factors relevant to the circumstances of the case. That global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks bearing in mind, in particular, their distinctive and dominant components. These principles were not contradicted by the finding of the Court of First Instance that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them.

H7 2. It was only following consideration of various elements enabling it to make an overall assessment of the likelihood of confusion that the Court of First Instance concluded that the degree of similarity between the marks at issue was not sufficiently great for it to be considered that the relevant public might believe that the goods concerned came from the same undertaking or, as the case may be, from economically-linked undertakings, so that there was no likelihood of confusion between those marks."

50) In *Phillips-Van Heusen Corp v OHIM* (Case T-292/01) [2004] E.T.M.R. 60 the Court of First Instance of the European Communities (Second Chamber) held:

“H5 2. The BASS and PASH marks were not similar enough to lead to a likelihood of confusion between the two parties' goods, when considered from the point of view of an average German consumer. Visually the two marks had the same number of letters and same two central letters. The public however would not be more likely to focus on the central letters than any of the other letters and the similarity between the letters B and P was limited. Aurally the letters B and P were pronounced very similarly in some regions of Germany and the only vowel contained in both signs was identical; even though “sh” sound was not used in German, a sufficient part of the German public was sufficiently familiar enough with the pronunciation of English words ending in “sh” that it would not mispronounce PASH as “pass”. Conceptually, BASS called to mind the voice of a singer or musical instrument while PASH was likely to be associated with the German dice game Pasch. This clear difference in meanings counteracted any visual or aural similarity, even though there was connection between those meanings and the goods. Therefore, while the goods of the two parties were either similar or identical, the marks were not similar enough, when viewed on a global appreciation, for there to be a likelihood of confusion leading to the registration of BASS being barred under Art.8(1)(b) of Regulation 40/94.”

51) I accept that when purchasing clothing the visual element is particularly important (*REACT*). Clearly, there are visual and aural similarities. But equally, there are very obvious visual and aural differences. Both marks begin with the letters “ICE” which obviously form a well known word with an equally well known meaning. However, the second half of each mark is significantly different, “BERG” v “CREAM”. In my view the visual and aural differences outweigh the similarities. Conceptually, both marks have a very strong overall meaning which is very well known and are completely different. The applicant’s mark refers to a form of dessert usually made from cream and egg yolks or a milk or custard base which is flavoured. The opponents’ mark refers to a large mass of ice that has broken from a polar glacier and is floating in the sea, often associated in the UK with the sinking of the Titanic. Ms Szell asked me to take judicial notice that ice cream vans frequently have “soft ices” written upon them. The descriptive term “soft” is crucial here as it presents a different conceptual image to the word “ice” which is usually considered to be a hard substance. To my mind the differences far outweigh any similarities.

52) I take all of the above into account when considering the marks globally. To my mind, the differences in the marks are such that even when used on identical goods I believe that there is no likelihood of consumers being confused into believing that those goods provided by the applicant are those of the opponents or provided by some undertaking linked to them (*Raleigh*). The opposition under Section 5(2)(b) therefore fails in relation to all of the goods.

53) I now move onto consider the ground of opposition under Section 5(4)(a) which reads:

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

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

(b)....

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

54) In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

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

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

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

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

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

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

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.’

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

‘To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

55) First I must determine the date at which the opponents claim is to be assessed; this is known as the material date. In this regard, I note the judgment of the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Joined Cases T-114/07 and T-115/07. In that judgment the GC said:

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

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

56) The date of filing of the instant application is, therefore, the material date. However, if the applicant has used its ICE CREAM trade mark prior to this then this use must also be taken into account. It could, for example, establish that the applicant is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed; any of which could mean that the applicant’s use would not be liable to be prevented by the law of passing-off – the comments in *Croom’s Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer.

57) With these considerations in mind I turn to assess the evidence filed on behalf of the parties in the present proceedings as set out earlier in this decision. The applicant accepted that the opponents have shown goodwill in both ICEBERG and ICE JEANS. In both instances the use, prior to the relevant date was not substantial but was adequate to overcome the first hurdle of showing that, at the relevant date it had goodwill. I note that the use shown prior to the relevant date shows both marks being used in plain capital letters with no stylisation which would serve to highlight the ICE part of the mark in particular. I accept that when used on a diffusion range the term “JEANS” is used to mean more than just denim trousers but refers to a range of casual clothing. However, just because this is the way that the term is used in the trade does not mean that the “JEANS” element of the opponent’s ICE JEANS mark should be ignored. It may play a less prominent role but it would still be taken into account by the average consumer.

58) In reaching my decision I take into account the comments of Morritt L J in the Court of Appeal decision in *Neutrogena Corporation and Another. v Golden Limited and Another* [1996] RPC 473, when he said that the correct test on the issue of deception or confusion was whether, on the balance of probabilities, a substantial number of members of the public would be misled into purchasing the applicant’s products in the belief that they were the opponents’. Whilst ICE JEANS may be the diffusion range of ICEBERG I do not believe that the average consumer would see ICE CREAM as a logical extension of the opponents’ brand. The differences between the mark in suit and the opponents’ marks is such that I do not believe that the average consumer would be misled into believing that the applicant’s goods were those of the opponents.

59) The ground of opposition under Section 5(4)(a) therefore fails.

COSTS

60) Both sides agreed that costs should follow the event and be within the Registry’s normal scale. As the applicant has been successful it is entitled to a contribution towards costs. I order the opponents to pay the applicant the sum of £2,300. This sum is calculated as shown below and

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.

Preparing a statement and considering the other side's statement	£300
Preparing evidence and considering and commenting on the other side's evidence	£1000
Prepare for and attending a hearing	£800
Official Fee	£200
TOTAL	£2300

Dated this 20 day of July 2010

**George W Salthouse
For the Registrar,
the Comptroller-General**