

O-257-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2358107
BY LACHARITÉ APPARELS (1989) INC
TO REGISTER THE TRADE MARK:**

PINK ICE

IN CLASS 25

AND

**THE OPPOSITION THERETO
UNDER NO 93015
BY
GILMAR SPA**

Trade Marks Act 1994

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by Lacharité Apparels (1989) Inc
to register the trade mark:
PINK ICE
in class 25
and the opposition thereto
under no 93015
by Gilmar SpA**

BACKGROUND

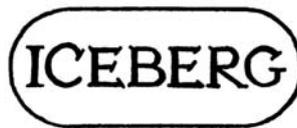
1) On 11 March 2004 Lacharité Apparels (1989) Inc, which I will refer to as Lacharité, applied to register the trade mark PINK ICE (the trade mark). The trade mark has an international priority date (from Canada) of 26 September 2003. The application was published for opposition purposes in the “Trade Marks Journal” on 10 September 2004. Following amendment after publication, the specification reads as follows:

clothing excluding jeans

The above goods are in class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 6 December 2004 Gilmar SpA, which I will refer to as Gilmar, filed a notice of opposition to the application. Gilmar is the owner of the following trade mark registrations:

- United Kingdom registration no 1175324 of the trade mark:



It was filed on 20 May 1982 and registered on 30 May 1984. It is registered for the following goods:

articles of clothing; but not including footwear other than woven or knitted footwear.

The above goods are in class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

Gilmar claims that it has used the trade mark in respect of a wide range of goods included in the specification.

- International registration no 797538 of the trade mark ICE ICE ICEBERG. The date of designation in the United Kingdom is 14 January 2003 with an international priority date (from Italy) of 22 November 2002. It is protected in the United Kingdom. It is registered for the following goods:

leather and imitation leather, goods made thereof not included in other classes; animal skins and hides; trunks and suitcases; umbrellas, parasols for men, women and children;

clothing, footwear, headgear, for men, women and children.

The above goods are in classes 18 and 25 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

Gilmar claims that the respective trade marks are similar and that they encompass identical or similar goods. Consequently, there is a likelihood of confusion and registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

3) Gilmar claims that it has used the sign ICEBERG in the United Kingdom in relation to clothing articles, footwear, necklaces, bracelets, bags, handbags, wallets, key rings and umbrellas since 1979. It claims that it has used the sign ICE ICE ICEBERG in the United Kingdom in relation to clothing and clothing for babies since 2003. It also claims that it has used the sign ICE JEANS in the United Kingdom since 2000 in relation to a wide range of clothing. On the basis of each usage Gilmar claims that registration of the trade mark would be contrary to section 5(4)(a) of the Act, which protects unregistered trade marks and other signs used in the course of trade.

4) Lacharité filed a counterstatement. It requires Gilmar to prove use of its United Kingdom trade mark registration in the five year period prior to the date of publication. Lacharité denies that the respective trade marks are similar. It accepts that the respective goods in class 25 are identical or similar. Lacharité does not admit that that registration of the trade mark would be contrary to section 5(4)(a) of the Act. It seeks the rejection of the opposition.

5) Only Gilmar filed evidence.

6) A hearing was held on 15 August 2006. Lacharité was not represented and did not furnish any written submissions. Gilmar was represented by Ms Szell of Lloyd Wise.

EVIDENCE OF GILMAR

7) This consists of a witness statement by Silvano Gerani. Mr Gerani is the president of Gilmar, a position that he has held since 1980. The majority of the exhibited evidence shows use of the trade mark ICEBERG. There does not seem to have been use in the lozenge form of the trade mark registration. However, there has been considerable use of ICEBERG in standard font. The exhibits show use of ICEBERG in relation to outer clothing for men and women as well as for headgear and footwear. There is much use shown of ICEBERG in various magazines. Mr Gerani gives the following turnover figures for goods sold under the ICEBERG trade mark in the United Kingdom:

	1998	1999	2000	2001	2002	2003	2004
	€000	€000	€000	€000	€000	€000	€000
Wear	1,114	1,552	1,626	1,286	1,662	1,586	1,647
Accessories	43	46	72	116	124	124	75
Total	1,157	1,598	1,698	1,402	1,786	1,710	1,722

Marketing expenditure for the years 1998 to 2004 was €105,000, €112,000, €607,000, €352,000, €390,000 and €328,000 respectively. Mr Gerani states that Gilmar has used the trade marks ICE JEANS and ICE ICE ICEBERG. He states that the annual turnover in the United Kingdom in relation to goods bearing the trade mark ICE JEANS is as follows:

	1998	1999	2000	2001	2002	2003	2004
	€000	€000	€000	€000	€000	€000	€000
Wear	4,137	4,569	6,788	4,042	4,382	4,588	3,943
Accessories	75	74	173	116	99	109	78
Total	4,212	4,643	6,961	4,158	4,481	4,697	4,021

Marketing expenditure for the years 1998 to 2003 was €1,000, €0,000, €226,000, €92,000, €159,000 and €79,000 respectively. At exhibit 1 are various invoices; nine of these emanate from prior to 26 September 2003 and are for the United Kingdom (another invoice relates to Jersey). There are twelve United Kingdom invoices in all. The trade marks referred to upon the invoices are: Ice Jeans, Iceberg Uomo, History Iceberg Donna and History Iceberg Donna. The majority of the goods on the invoices are described as Ice Jeans; the goods so described are: jeans, t-shirts, shirts, sweaters, belts, knitted vests, sports jackets, skirts, sweatshirts, dresses, leather jackets, scarves, leather blousons, coats and pants.

8) Mr Gerani states that ICEBERG, ICE JEANS and ICE ICE ICEBERG goods are distributed throughout the United Kingdom. At exhibit 2 is a list of what Mr Gerani describes as distributors. The names would appear to indicate that the undertakings are retailers rather than distributors in the sense of wholesalers/importers eg Harvey Nichols, Moss Bros, Harrods and Selfridges.

9) Mr Gerani describes exhibit 4 as showing copies of photographs of examples of products sold under the trade mark ICEBERG combined with other ICE trade marks. The photographs show use of Ice J, ICE JEANS, ICEJ, ICE jeans, Ice Jeans, ice j, icejeans. The majority of the use of these signs is for tops or various kinds, although there is also use for jeans, a purse, belts, a scarf and a key fob. Items of luggage are also, shown but the quality of the copy does not allow for identification of the trade mark. There is no provenance, with one exception, for the photographs. The writing opposite one picture of luggage is in Italian. The exception is a copy of a page from "FHM" for August 2001; it shows various sandals, including sandals by ICEBERG. From the angle of the picture it is not possible to see what is actually written upon the sandal. Mr Gerani states that exhibit 5 shows advertisements for goods sold under the trade mark ICE ICE ICEBERG. There are seven clippings from 'Vogue' from 1 July 2004. As these emanate from after the international priority date they are not pertinent to the use of Ice Ice Iceberg in relation to this case. There are copies of pages from 'Junior' magazine. However, from the quality of the copy it is only possible to read that it emanates from July 20--. The only material clearly emanating from prior to the international priority date is a copy of an article from 'Drapers Record' of 25 January 2003 about the Pitti Bimbo kidswear exhibition in Florence. It states that 379 brands were shown at the exhibition. The article includes the following:

"Debutants included Ice Ice Baby by Iceberg and the new Joop collection.

Gerry Myers, UK agent for the new Ice Ice Baby collection, said:.....

A further article from what might be the same edition of 'Drapers Record', comments on key trends at Kids' Fashion, Brussels and Pitti Bimbo, Florence. The following appears in the article:

"**Iceberg's** new **Ice Ice Baby** kids' range included padded ski outfits, *faux* shearlings and parkas."

Exhibit 6 shows pictures of tags showing ICE ICE and ICE ICE ICEBERG. There is no indication as to from when the tags emanate. Exhibit 7 has several pictures showing use of ICE ICE ICEBERG and one showing use of ICE; again there is no indication of their provenance. Exhibit 8 shows a photograph of the ICE ICE ICEBERG stand at Pitti in Florence. Mr Gerani omits to state when the picture was taken. Exhibit 9 shows pictures of footwear and tops bearing ICE ICE ICEBERG, again there is no indication of provenance. (I note that one top bears the Castellano wording "su nombre aqui" (sic) (your/his/her name here). Mr Gerani states that exhibit 10 consists of sample catalogues to promote ICEBERG goods which are sold under the ICE trade marks in the United Kingdom. The quality of the copy is poor, making it difficult to make out details. The first catalogue bears the words "ice jeans" and at the bottom appear to be the words "look back" or "look book". Various items of clothing for men and women appear; ICEJ and ICEJEANS can be seen upon some of the items. There is no indication as to when the catalogue was produced. The end of the catalogue shows the name and address of Gilmar in Italy. A catalogue for Ice Jeans bears the wording "autunno inverno 03/04", various

items of clothing are shown. At the end of the catalogue there is a list of show rooms, including one in London. A catalogue for ICE JEANS ICEBERG for spring/summer 2003 is included; a range of clothing is shown, some of it bearing ICE JEANS. There are pages from 'ICEBERG THE MOVIE' which features the spring summer collection for 2003, this includes one page bearing the name ice jeans. A copy of a catalogue entitled 'ICEBERG THE TOUR' has what appears to be a photocopied Post-it® upon it bearing the writing "CATALOGUE WINTER 2003". There is a reference to ICE JEANS. At the end of the exhibit is a page which is headed Autumn Winter 2003 – 2004, this includes a list of boutiques and showrooms across the world; one is in the United Kingdom.

10) Exhibit 12 consists of copies of advertisements; the majority are for ICEBERG products. However, there are advertisements from 'Vogue', 'Loaded' 'i-D' magazine, 'marie-claire', 'Elle', 'Dazed' 'FHM', 'Esquire', 'Nova', 'The Face', 'Red' 'Arena+' and 'Maxim Fashion' all bearing the name ice jeans ICEBERG; the ice jeans is the dominant element of the trade mark that is shown (ICEBERG appearing below in much smaller type). Exhibit 13 contains more copies of advertisements. Virtually all of the emanate from after the international priority date. The exceptions are two advertisements from 'Dazed & Confused' of 1 September 2003 and one from 'Dazed & Confused' of 1 February 2003. They are for ice jeans ICEBERG. Exhibit 14 consists of examples of editorial advertising; again the quality of the copying makes it difficult to see details in parts of the material; to make matters worse, where the relevant part of a page had been highlighted, the copying of the highlighting has blotted out the pertinent part. There is a large amount of material relating to ICEBERG. The only matter relating to Ice Jeans is as follows:

'In Style' June 2002 - strapless dress by IceJeans by Iceberg;
'Glamour' July 2002 - sleeveless shirt – Ice Jeans by Iceberg;
'In Style' December 2002 "cream and chocolate edged wool scarf, £85, by Ice Jeans".

There are also three advertisements from 'Daze & Confused' of November 2002 which go under the title of "Ice Ice Baby", these are advertising Iceberg products also. All of the material in exhibit 14 emanates from prior to the international priority date.

11) Mr Gerani states that Gilmar has acquired a strong reputation and goodwill in the trade marks ICEBERG, ICE JEANS and ICE ICE ICEBERG in the United Kingdom; because of the way that the trade marks are presented, the ice element of the trade marks is particularly associated with Gilmar's goods.

DECISION

Preliminary matter

12) Part of Gilmar's case was based upon the claim that the Ice element of its trade marks was particularly associated with it. This was not identified in the grounds of opposition. Gilmar used form TM7 and did not furnish any further elucidation of the basis of its grounds. If an opponent is going to rely, to whatever extent, on something more than is

indicated on the form of opposition, this should be clearly identified in the grounds. The first time that this element of the grounds of opposition was intimated was in the final paragraph of Mr Gerani's witness statement. It was not clear as to the exact nature of this reliance. I assumed, owing to the reference to the three trade marks, that Gilmar was relying upon a family of marks. At the hearing Ms Szell stated that this was not the case but that Gilmar was relying upon the general use of ICE in relation to its products. The bases for an opposition should be up-front and clear; it is not acceptable that they are only fully come to light at the hearing. There is a mixed practice in relation to statements of grounds. Some practitioners will file a form TM7 with no further explanation of the grounds. Others will file a form TM7 and attach an explanation of the grounds. If an opponent is relying upon than more than just a mark to mark comparison or sign to mark comparison, it should explain this, so that an applicant is aware of the full nature of the opposition. There could be obvious consequences if it does not; a hearing might have to be vacated, additional evidence may need to be filed. In making these comments, I am not criticising Gilmar's representatives; they have completed the form as requested and required by the Trade Marks Registry; neither the form nor the notes for completion indicate that further explanation of grounds is necessary. Unfortunately, the form and notes will tend to give rise to a failure of particularisation. I will deal with the case on the basis of the grounds as clarified at the hearing as I do not see that any prejudice to Lacharité arises.

Evidence of use

13) To consider the grounds of opposition under both sections 5(2)(b) and 5(4)(a) of the Act, it is necessary to decide what the use shown by Gilmar establishes. Section 6A of the Act reads:

“(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.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration)."

14) Use of ICEBERG in normal script, as well as in other scripts, has been shown in the five year period prior to the date of publication of the trade mark. There is no use shown in the exact form of trade mark registration, ie the word inside the lozenge. In *Budejovicky Budvar Narodni 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:

"40 These points are uncontroversial, not to say pedestrian, but they do to my mind help to show what is the right approach to the language of s.46(2) of the Act, which is at the heart of the first appeal: "... 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."(This language is word for word the same as the English language version of Art.10.2(a) of the Directive.)

41 The word "elements" can be used, and often is used, to refer to the basics or essentials of a matter. However it can hardly have that meaning in s.46(2), since a basic or essential difference in the form in which a trade mark is used would be very likely to alter its distinctive character. In s.46(2) "elements" must have a weaker sense (of "features" or even, as Mr Bloch came close to submitting, "details").

42 The deputy judge touched on this and some related points in paras [18-22] of his judgment. He stated that the elements of a mark must be assessed separately. He also stated (or at least implied) that only some of the elements might contribute to the distinctive character of the mark. He pointed out that the inquiry was as to whether the mark's distinctive character was altered (not substantially altered).

43 I have no wish to be overcritical of the way in which the deputy judge expressed himself, especially since I think he was a little overcritical of the way in which the hearing officer had expressed himself. But I am inclined to think that the deputy judge made the issue rather more complicated than it is. 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 judgment, 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."

The quotations are from para.[26] of the judgment of the Court of Justice in Case C-342/97 Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV [1999] E.C.R. I-3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance."

The difference in use is the absence of the lozenge. Does this alter this distinctive character of the trade mark as registered? I am of the view that the lozenge will simply be seen as the form of a label or a perimeter fence for the word. I cannot imagine that in the eyes of the average consumer that the absence of the lozenge will alter the distinctive character of the trade mark. Consequently, the use shown satisfies section 6A(4)(a). The use shown has been for a spectrum of outer clothing for men and women, as well as some headgear and footwear. There is now a body of case law as to how to arrive at a fair specification of goods in non-use cases:

Thomson Holidays Ltd v Norwegian Cruise Lines Ltd [2003] RPC 32:

"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.”

Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03

“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 sub-categories.

53 First, 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."

Animal Trade Mark [2004] FSR 19:

"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 pernicky 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."

15) Clothing is readily and often sub-divided between outer clothing and under clothing. These two terms represent clearly definable sections of the trade and the goods. Consequently, an appropriate specification for the goods of registration no 1175324 is:

articles of outer clothing; but not including footwear other than woven or knitted footwear.

In this case nothing will turn upon this limitation of the specification.

16) The issues in this case centre on the international priority date, 26 September 2003. A lot of the evidence of Gilmar emanates from after the material date or is without clear provenance. Ms Szell argued that owing to the nature of general use of the trade mark on clothing and in advertising/advertorials ICE was identified with Gilmar. Her strongest evidence for this lays with various pictures without provenance of goods at exhibit 4 and the catalogue 'Look book' or 'Look back' which is part of exhibit 10, this catalogue is without provenance. Included in this exhibit are two Ice Jeans catalogues with provenance; for autumn/winter 2003/2004 and spring/summer 2003. In those catalogues the sole use of ICE without JEANS is a belt buckle with ICEJ inside it in the 2003/2004 catalogue; as the catalogue is for autumn/winter it could emanate from after the international priority date. Exhibit 13 shows a greater variation in the use of ICE, however, all such use emanates from after 1 April 2004. The high point of the evidence to support the argument of Ms Szell occurs in three items in exhibit 14. An article from 'Harpers & Queen' refers to the inspiration of the new Iceberg collection as being Jackie Onassis; it is headed "Ice Queen". A small article from 'Vogue' is headed "Tip of the Iceberg". A couple of journalistic puns do not amount to an indication of public perception. Included in exhibit 14 is material from 'Dazed & Confused' of 1 November 2002 where one advertisement has "Ice Ice Baby" written upon it. It may be that the inadequacies of the photocopying process has done a disservice to some of the evidence of Gilmar. I can only work with what it before me; Gilmar supplied the copies. There is an indication from the material emanating from after April 2004 that there was a diversification in the way that Gilmar used its trade marks. Certainly there is a good deal of difference between certain of the evidence which can be identified as emanating from prior to the international priority date and evidence which is after it or is without provenance.

17) Gilmar claims use of three trade marks. The evidence of use shows that Gilmar had, at the international priority date, a protectable goodwill, for outer clothing, headgear and footwear for men and women by reference to the sign ICEBERG. ICE JEANS is often used with ICEBERG, the latter in a subservient position. However, the invoices refer to Ice Jeans and various of the garments bear ICE JEANS upon them. Nowadays trade marks are emblazoned upon clothing as well as being found upon swing tags and labels. The public has been educated into seeing signs upon garments as being trade marks. Many of the public seem to desire such trade mark use, as they crave some form of vicarious kudos from purchasing the goods of a particular trader. The evidence supports a protectable good will, at the international priority date, for outer clothing, headgear and footwear for men and women by reference to the sign ICE JEANS. In relation to the claimed use relating to ICE ICE ICEBERG, Mr Gerani gives no turnover figures or advertising figures. There is no evidence of use prior to the international priority date. The evidence, emanating from after the material date, indicates that this brand is primarily a brand for children. 'Drapers Record' of 25 January 2003 refers to the Ice Ice Baby brand of Iceberg at trade shows in Brussels and Florence but not to ICE ICE ICEBERG. Gilmar appears to have been using the trade shows as a show case for its new brand. There is no evidence of any penetration into the United Kingdom market of the Ice Ice Baby brand. There is a photograph of an ICE ICE ICEBERG stand at the Florence show but no date is given for the show; which appears to be an annual event. The evidence does not support use in the United Kingdom of ICE ICE ICEBERG at the international priority date, and it does not support the claim that there was a protectable goodwill by reference to this sign at this date.

18) So the evidence supports use of ICEBERG and ICE JEANS, usually in conjunction with ICEBERG, for items of outer clothing, footwear and headgear. The actual turnover and promotional budget are in relation to the industry very small. Part of the publicity appear is in the form of advertorials, where there is often a multiplicity of brands. Gilmar's clothing appears to operate in a niche market. The evidence does not suggest that either ICEBERG or ICE JEANS will be known to a significant part of the public.

Open Country

19) Ms Szell saw *Open Country* [2000] RPC 477 as supporting the position that she was arguing. This was a case dealing with section 11 of the 1938 Act. In that case Aldous LJ states at page 480:

“Before us Mr Birss drew attention to the passage in the speech of Lord Upjohn in the *Bali* case which was referred to by the hearing officer. He submitted that the hearing officer had failed to read in that speech where Lord Upjohn had explained the standard of proof required. Lower down on page 496 Lord Upjohn said:

"It is not necessary in order to find that a mark offends against section 11 to prove that there is an actual probability of deception leading to a passing off or (I add) an infringement action. It is sufficient if the result of the registration of the mark will be that a number of persons will be caused

to wonder whether it might not be the case that the two products come from the same source. It is enough if the ordinary person entertains a reasonable doubt, but the court has to be satisfied not merely that there is a possibility of confusion; it must be satisfied that there is a real tangible danger of confusion if the mark which it is sought to register is put on the register.””

He went on to say at page 482:

“The test laid down in *Smith Hayden*, adapted in accordance with the speech of Lord Upjohn in *Bali*, is the test applicable whether the applicant has or has not used his trade mark. However, no court would be astute to believe that the way that an applicant has used his trade mark was not a normal and fair way to use it, unless the applicant submitted that it was not. It does not follow that the way that the applicant has used his trade mark is the only normal and fair manner. However in many cases actual use by an applicant can be used to make the comparison. I believe that this is such a case.”

and on the same page:

“In my view the two trade marks are not confusingly similar when compared side by side. The difficulty arises when sequential comparison is carried out. Would members of the public who saw waxed cotton jackets bearing the opponent's label on one day, or were recommended to buy an *OPENAIR* jacket, be caused to wonder, when visiting a shop a day or two later, whether the same sort of jacket but bearing the mark *OPEN COUNTRY* in a rectangular label, came from the same source as the jackets they had previously seen or heard about? In my view they would. The similarity of the first two syllables and idea between the two are sufficient to cause those, with normal imperfect recollection, to be confused. I therefore conclude that the applicants did not discharge the onus upon them. I would therefore allow the appeal and refuse registration.”

It can be seen from the above that the hurdle for success under section 11 of the 1938 Act is lower than that to succeed under the law of passing-off. Also, under section 11, a mere wondering could be enough to succeed, a lesser test than a likelihood of confusion. Under the old law the onus was the opposite to that under the current law; where it is for the opponent to prove its case. Aldous LJ in the judgment states that the comparison is not to be based upon on the trade marks being looked at side by side; the concept of imperfect recollection which exists under the current case law. He also holds that actual use may represent normal and fair use.

Average consumer and the purchasing process

20) The goods under consideration are all goods that will be bought by everyone. The average consumer is the public at large. In my experience customers for clothing are very label conscious. I consider that the purchasing of the goods of the application will be the result of reasonably careful consideration. As Ms Szell emphasised at the hearing, the consideration of the trade mark will be primarily by the eye; it is the visual impact that will be key. I am in complete concurrence with her on this. She referred to *React trade mark* [2000] RPC 285 in support of this position. This is a position which finds authority in the judgment of the Court of First Instance in *Société provençale d'achat and de gestion (SPAG) SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-57/03:

“The Board of Appeal was thus right in finding that, generally, the purchase of an item of clothing involves a visual examination of the marks (paragraph 23 of the contested decision).”

Likelihood of confusion – section 5(2)(b) of the Act

21) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

22) Section 35 of the Act states:

“35. - (1) A person who has duly filed an application for protection of a trade mark in a Convention country (a “Convention application”), or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the first such application.

(2) If the application for registration under this Act is made within that six-month period-

(a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application, and

(b) the registrability of the trade mark shall not be affected by any use of the mark in the United Kingdom in the period between that date and the date of the application under this Act.

(3) Any filing which in a Convention country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

A “regular national filing” means a filing which is adequate to establish the date on which the application was filed in that country, whatever may be the subsequent fate of the application.

(4) A subsequent application concerning the same subject as the first Convention application, filed in the same Convention country, shall be considered the first Convention application (of which the filing date is the starting date of the period of priority), if at the time of the subsequent application-

(a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding, and

(b) it has not yet served as a basis for claiming a right of priority.

The previous application may not thereafter serve as a basis for claiming a right of priority.

(5) Provision may be made by rules as to the manner of claiming a right to priority on the basis of a Convention application.

(6) A right to priority arising as a result of a Convention application may be assigned or otherwise transmitted, either with the application or independently.

The reference in subsection (1) to the applicant’s “successor in title” shall be construed accordingly.”

Lacharité has claimed a priority date of 26 September 2003 based upon Canadian application no 1190570. Canada is a convention country, Lacharité filed a certified copy of its Canadian application to substantiate its claim. Consequently, Lacharité benefits from its international priority claim and the material date for these proceedings is 26 September 2003.

23) Gilmar’s two registered trade marks are earlier trade marks within the meaning of the Act.

24) In determining the question under section 5(2)(b), I take into account the guidance 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 BV* [2000] FSR 77, *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723 and *Vedial SA v Office for the Harmonization of the Internal Market (trade marks, designs and models) (OHIM) C-106/03 P*.

Comparison of goods

25) The respective class 25 goods are clearly identical. (In the case of registration no 1175324 and the effect of overlap giving rising to identical goods see the decision of Professor Annand, sitting as the appointed person, in *Galileo International Technology LLC v Galileo Brand Architecture Limited* BL 0/269/04.)

Comparison of trade marks

26) The trade marks to be compared are:

Gilmar's trade marks:



ICE ICE ICEBERG

Lacharité's trade mark:

PINK ICE

27) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). 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*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 and he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). "The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public" (*Succession Picasso v OHIM - DaimlerChrysler (PICARO) Case T-185/02*).

28) I will first consider Lacharité's trade mark and then consider and compare the two trade marks of Gilmar in turn. Ms Szell emphasised what she considered the non-distinctiveness of the PINK element of the trade mark. Clothing has to be in some colour

and so it could be pink. However, in use for non-pink clothing I cannot see that the word “pink” is non-distinctive; it might even be argued that on a label, even on pink clothing, it would have trade mark significance; in my experience it is not common to identify the colour of a garment on the garment, this being self-evident (although it might be helpful to the colour blind). Setting that matter to one side, the premise in this case rests upon not considering the trade mark as a whole. Pink in relation to ice describes the colour of the ice, it presents a concept and there is a consequent conceptual association which can act as a hook for the memory. It conjures up a clear and unusual idea. I do not think it is helpful to try and separate the two elements of the trade mark; they work as one.

29) Iceberg is a common word, known to all and associated, inter alia, with the sinking of the Titanic. The conceptual association is one of a large mass of ice floating in the seas. The word stands and falls as a whole; one is no more likely to identify the ice element of iceberg than one is the cat element of catastrophe. Both trade marks include the letters ice; one as a word and the other as part of a well known word. Visually and phonetically there are great differences between Gilmar’s trade mark and that of Lacharité. The trade marks are not just not conceptually similar, they are conceptually dissonant; each has its own meaning. The CFI in *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH* Case T-292/01 [2004] ETMR 60 held:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

In *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-135/04 the CFI held that the conceptual meaning must be clear:

“the fact remains that that meaning must be clear, so that the relevant public are capable of grasping it immediately (see, to that effect, Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel*(BASS) [2003] ECR II-4335, paragraph 54).”

In this case the conceptual meanings of both trade marks are clear and very different. This is a case where the differences far outweigh the similarities. **I am of the view that it is not just that the trade marks are not similar but that they are dissimilar.**

30) ICE ICE ICEBERG has, obviously, the iceberg element again and the repetition of the word ice. The trade marks coincide in the presence of ice. The meaningless of ICE ICE ICEBERG as a whole lessens any conceptual associations. The repetition of the word ICE is unusual and striking. Although the use of ICE ICE ICEBERG is not shown before the material date, the use shown might be accepted as being normal and fair use of the trade mark as per *Open Country*. At exhibit 6 one can see labels where first ICE is above the second and ICEBERG is below this in smaller type; similar use also appears in exhibit 7. I am of the view that this form is probably, just about, within the parameters of normal and fair use. As has been accepted, it is the visual impact that is most important. The use shown does not lessen the impact of the repetition of ICE. The respective trade marks are clearly visually and phonetically different. PINK ICE has a clear conceptual association that is alien to ICE ICE ICEBERG. **I do not consider the respective trade marks similar.**

Conclusion in relation to likelihood of confusion

31) To succeed under section 5(2)(b) of the Act the goods have to be similar; that is what the Directive states, it is what the Act states. It is what is pointed out in *Sabel BV v Puma AG*:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public.”

The ECJ in *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM)* stated:

“51 For the purposes of applying Article 8 (1)(b) of Regulation No 40/94, the likelihood of confusion presupposes both that the mark applied for and the earlier mark are identical or similar, and that the goods or services covered in the application for registration are identical or similar to those in respect of which the earlier mark is registered. Those conditions are cumulative (see to that effect, on the identical provisions of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 22).

52 Contrary to Vedial’s claim, the Court of First Instance did not rely on the visual, aural and conceptual differences between the earlier mark and the mark applied for in deciding that there was no likelihood of confusion.

53 After making a comparative study, at paragraphs 48 to 59 of the judgment under appeal, of the two marks in the visual, aural and conceptual senses, the Court of First Instance concluded, as stated at paragraph 65 of the judgment, that the marks could in no way be regarded as identical or similar for the purposes of Article 8(1)(b) of Regulation No 40/94.

54 Having found that there was no similarity between the earlier mark and the mark applied for, the Court of First Instance correctly concluded that there was no likelihood of confusion, whatever the reputation of the earlier mark and regardless of the degree of identity or similarity of the goods or services concerned.”

32) Ms Szell submitted that, although not relying upon a family of trade marks, the general use by Gilmar of the word ice should be part of the global appreciation. I find this argument difficult to square with the job that I have to undertake under section 5(2)(b) of the Act, which is a mark to mark comparison as per *Ener-Cap Trade Mark* [1999] RPC 362. I could take into account reputation for a particular trade mark, if there was a distance between similar goods (as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*), which there is not. Reputation for a particular trade mark could add to its distinctiveness (as per *Sabel BV v Puma AG*) if it is not a particularly distinctive trade mark. As I have noted already, I do not consider that ICEBERG has a particular reputation; however, it is a distinctive trade mark for clothing. So even if it had a reputation Gilmar could not be assisted. Section 5(2)(b) is about earlier registered trade marks and applications; it deals with them, not with an ambience possibly arising from their use. Ms Szell would not have been able to rely on a family of trade marks, even if she had wanted, as the evidence shows, at the material date, only use of the ICEBERG trade mark.

33) The absence of similarity between the respective trade marks means that the grounds of opposition under section 5(2)(b) must fail. If I took an a posteriori view taking into account the identity of the goods, the high degree of distinctiveness of both of the earlier trade marks, the differences between the respective trade marks, the nature of use of the trade marks, the average and the nature of the purchasing process; I could not envisage the average consumer considering the goods sold under the respective trade marks came from the same or economically linked undertaking.

34) The grounds of opposition under section 5(2)(b) of the Act are dismissed.

Passing-off – section 5(4)(a) of the Act

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

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

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

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:

"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] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 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 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."

.....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.””

36) The first matter that I have to decide is the material date. It is well established that the material date for passing-off is the date of the behaviour complained of (see *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v Camelot Group PLC* [2004] RPC 8 and 9). Section 5(4)(a) is derived from article 4(4)(b) of First Council Directive 89/104 of December 21, 1998 which states:

“rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark...”

So the date of passing-off cannot be after the international priority date. There is no evidence of use of the trade mark in the United Kingdom, so the material date is the international priority date, 26 September 2003.

37) The evidence shows that at the material date Gilmar had a protectable goodwill in relation to articles of outer clothing, headgear and footwear by reference to the signs ICEBERG and ICE JEANS. Ms Szell's claim in relation to the way that Gilmar has used the word ice, one might say her claim that that use is part of the ambience of the brand, could have a basis in relation to passing-off; which is not necessarily about a simple sign to sign comparison. The use could infuse the public perception, could permeate the signs

that are used by Gilmar. (Ms Szell did not rely upon a family of trade marks in relation to passing-off either.) If the pattern of use in promotion and/or on the garments could lead to confusion with the trade mark, lead the consumer concerned to think that Gilmar was responsible for the goods of Lacharité, then that is confusion/deception for the purposes of passing-off. That is the theoretical possibility. The reality is, as I have stated above, that Gilmar has not established any such use at the material date. So the matter reduces to a mark to mark comparison. The position in relation to ICEBERG is no different than it is under section 5(2)(b) of the Act. The respective trade marks are not just not similar, they are dissimilar; the dissimilarity means that there will not be confusion or deception.

38) ICE JEANS consists of the distinctive word ICE and the descriptive word JEANS; as such this sign must represent the strongest case that Gilmar has under either ground of opposition. In relation to garments that are not jeans the strong descriptive nature of the word JEANS is unlikely to dissipate. ICE overwhelms and dominates JEANS. PINK ICE “hangs together” owing to its meaning. However, it can still easily be postulated that those knowing of ICE JEANS will consider that PINK ICE is a sub or variant brand of it. The colour identifying a sub-brand of ICE JEANS as well as identifying a particular colour of ice. Lacharité has excluded jeans from the specification so the customer will not be confronted with PINK ICE jeans; he or she will potentially be confronted with PINK ICE on every other form of clothing. It is possible that someone could refer to or ask for an ICE JEANS garment coloured pink eg a pink ICE JEANS t-shirt. So there might be a strong possibility of oral confusion. Ms Szell submitted, and I concur, that the key issue in relation to clothing relates to visual impression. If there were any aural confusion of the kind postulated above it would be unlikely to survive the purchasing process when the customer was confronted with the garment and its label(s). Consequently, there would be little likelihood of damage to the goodwill of Gilmar. So the matter turns again on viewing PINK ICE as a sub-brand of ICE JEANS. In relation to clothing “ice” has no meaning, either directly or allusively, and is a very strong sign; that strength is not dissipated by use in conjunction with “jeans”. Taking into account the strength of the sign ICE JEANS and the nature of the trade mark PINK ICE and the identity of the goods, I have come to the conclusion that it is likely that confusion or deception would arise from the use of the trade mark as the consumer concerned could readily believe that PINK ICE clothing was a sub-brand of ICE JEANS. The confusion that would arise in relation to identical goods would give rise to all three of the classic causes of damage:

- Diverting trade from Gilmar to Lacharité.
- Potentially injuring the trade reputation of Gilmar if there were any failings in the goods of Lacharité
- By the injury which is inherently likely to be suffered by any business when on frequent occasions it is confused by customers or potential customers with a business owned by another proprietor or is wrongly regarded as being connected with that business.

(See *Habib Bank Limited v Habib Bank AG Zurich* [1982] RPC 1)

39) Under section 5(4)(a) of the Act the trade mark is to be refused in its entirety.

COSTS

40) Gilmar SpA having been successful is entitled to a contribution towards its costs. I order Lacharité Apparels (1989) Inc to pay Gilmar SpA the sum of £1450. 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 13th day of September 2006

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