

O-293-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3269456
BY LAURICE EL BADRY RAHME LIMITED
TO REGISTER THE TRADE MARK
BROOKLYN
IN CLASS 3
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 411953 BY
GALLIVANT PERFUMES LIMITED**

BACKGROUND

1) On 9 November 2017, Laurice El Badry Rahme Ltd (hereinafter the applicant) applied to register the trade mark BROOKLYN in respect of the following goods and services:

Class 3: Fragrances for personal use namely, perfumes in class 3.

2) The application was examined and accepted, and subsequently published for opposition purposes on 15 December 2017 in Trade Marks Journal No.2017/050.

3) On 15 March 2018 Gallivant Perfumes Limited (hereinafter the opponent) filed a notice of opposition, subsequently amended. The grounds of opposition are, in summary:

- a) The opponent contends that it has used the sign “BROOKLYN BY GALLIVANT” throughout the UK on perfume since 8 March 2017. It contends that it had sold its perfume under its sign for six months and attracted a significant amount of press coverage in the UK. As such it contends that the application offends against Section 5(4)(a) of the Trade Marks Act 1994.
- b) The opponent contends that there are numerous companies that use BROOKLYN in relation to perfumes and it is therefore dilute and incapable of distinguishing goods or services of one undertaking from those of another undertaking. It therefore offends against section 3(1)(a) of the Trade Marks Act 1994.
- c) The opponent contends that BROOKLYN is a geographic term which is known internationally and which is associated with a city that leads the world in terms of fashion, design and luxury goods. In addition, there are numerous perfume stores in Brooklyn. The mark in suit therefore offends against section 3(1)(b) & (c) of the Trade Marks Act 1994.
- d) The opponent also contends it has since 26 April 2017 been seeking to assert its rights in Brooklyn against the applicant and has pointed out to the applicant that many other companies have been using the mark for many years, that it is descriptive and also that the opponent’s use of the mark BROOKLYN pre-dates that of the applicant in the UK. It also points out that two other companies have EU registrations for the marks EAU DE BROOKLYN (EU 4916334 registered in 2006) and BROOKLYN SOAP COMPANY (EU 13209473 registered in 2014). The mark in suit therefore offends against section 3(6) of the Trade Marks Act 1994.

4) On 17 May 2018 the applicant filed a counterstatement, subsequently amended, which basically denied all the grounds pleaded, and claims to be the senior user.

5) Both parties seek an award of costs in their favour. Both parties filed evidence. The matter came to be heard on 16 May 2018 when Mr Day of Messrs Carpmaels & Ransford LLP represented the opponent; the applicant was represented by Ms Blyth of Counsel instructed by Messrs HGF Limited.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement dated 31 August 2018 by Nick Steward the founder, in September 2015, of the opponent company which was incorporated in April 2016. He provides some details as the setting up and launch of his company. He states that Brooklyn is the most highly populated borough of New York and claims that New York leads the world in terms of luxury brands and goods. He contends that there are 180 perfume stores in Brooklyn who incorporate the Brooklyn name such as the Brooklyn Perfume Company, Euphorium Brooklyn and Eau de Brooklyn. He also contends that there are a number of fashion designers in the borough. He also claims that there are a number of marks which include the term BROOKLYN on the EU and UK registers, but without evidence of use this is merely "State of the Register" evidence. He also claims that Brooklyn Beckham has an association with the perfume and fashion industry. He speculates as to why no other US companies have sought to register the mark "BROOKLYN" solus. This is of no worth to me in reaching my decision. He provides the following invoices for between 24 May 2017 and 6 November 2017 (all to either Roullier-White or Pulse of Perfumery). The invoices have all figures redacted so it is no clear if the testers and/or samples were charged for or provided free. It is therefore impossible to provide any actual sales values:

Description	Number
30ml Brooklyn perfume	30
30ml Brooklyn tester	5
2ml Brooklyn sample	50
Discovery set: 2ml vials of 4 perfumes including Brooklyn	20

7) He also provides the following exhibits:

- NS3: An article from Forbes magazine, dated 31 March 2017, which states that the opponent company has launched four fragrances (London, Tel Aviv, Istanbul and Brooklyn) in 30ml bottles. It was only sold in the UK via the company website, whilst being sold via retail outlets in the USA. He states that he chose Brooklyn instead of New York City because “of its lower, slower feeling, and a feeling of home away from home. It’s where my friends are. It was my first landing point in New York. Felt only right.”
- NS4: An article on the BBC news website, dated 4 October 2017, it mentions the fact that it sells in smaller than industry standard bottles and that it is a niche player.
- NS5: An order for the launch production, dated December 2016. The initial order was for 756 30ml bottles of Brooklyn EdP as well as similar numbers of the other three perfumes in the series. These were delivered on 22 February 2017.
- NS6: Copies from websites in USA showing bottles of Brooklyn perfume for sale at \$95 a bottle. Two are clearly from 2018, the other two are of indeterminate date.
- NS7: Copies of five articles from the internet which mention the opponent company and its BROOKLYN product. Four are clearly for the American market. Nor is it clear how many people actually read the articles.
- NS8: A photo of a book called “Perfumes: The guide 2018” which mentions the opponent’s fragrances. This is clearly after the relevant date, and it is not clear where this was sold or how many copies were sold or to whom.
- NS9: It includes stories from UK publications Vogue (Page 4: September 2017), Grazia (page 9: June 2017), Wylde (page 18 June 2017), Cent (Page 20: June 2017), Byrdie (page 24: June 2017): as well as blogs, The Perfume Society (page 27: Summer 2017), Greek Goddess London (Page 30: May 2017) and A Bottled Rose (Page 32: May 2017). All the above show a photograph of BROOKLYN perfume. Others have a photograph of another of the perfumes but mention BROOKLYN in the text: Metro (Page 12: May 2017), The City Magazine (page 12: May 2017), Phoenix magazine (page 17: June 2017), Twenty magazine (page 23: June 2017) and blogger I scent you a day (page 31: May 2107). Other pages are from the UK media but simply discuss the launch of Gallivant and/or mention another of the perfumes but NOT

Brooklyn. (pages 2, 3, 5, 7, 8, 10, 11,13, 15, 16, 19, 21, 22, 25, 26, 28, 29, 33, 34 & 35). Others are not from the UK (pages 36, 37, 38 & 39). No details are provided regarding the publication numbers for any of the media outlets, or reader numbers. \Nor is any mention made as to the availability of the articles in the UK.

- NS10: An article from Wallpaper magazine dated 30 May 2017 which mentions the opponent's launch and the Brooklyn fragrance. No detail is provided regarding readership or publication numbers or general availability.
- NS11: A letter from the applicant's lawyers in USA to the opponent informing the opponent of the rights that the applicant has in its US registered mark BOND NO.9 BROOKLYN. There are also copies of numerous letters which I believe should have been refused in as evidence as they would appear to be "without prejudice" correspondence between the parties.
- NS13: Copies of pages from the websites of Brooklyn Perfume Company, Euphorium Brooklyn and Eau de Brooklyn. None of the pages are dated and do not give any details of whether the companies are trading etc.
- NS14: A list of perfume stores in Brooklyn. Only ten are shown although the search result claims to have 180 on the list. Without the full print-out it is not possible to state if there is any duplication, although presumably it will have chemist stores and supermarkets on the list.
- NS 15: An article in the Telegraph dated 17 May 2018 which gives a list of places to go in New York, amongst which is a clothes shop in Brooklyn and the flea market in the same borough also gets a mention.
- NS 16 -21: These are undated pages from websites which appear to show fragrances which have the word BROOKLYN as part of the name. With the exception of one (DKNY BE DELICIOUS BRROKLYN GIRL) there is no evidence of them being offered for sale in the UK.
- NS 23: A copy of an undated page from the website of Roullier-White, offering the opponent's BROOKLYN perfume at a cost of £65 per 30ml bottle.

- NS24 & 26: Copies of invoices to Roullier-White and Pulse of Perfumery, based in London and Manchester respectively. All figures redacted.
- NS25: Pages from the website of Pulse of Perfumery dated 26 November 2017 announcing they were starting to sell the opponent's range of perfume, including Brooklyn.
- NS27: An undated page from the website of Trouva offering the opponent's Brooklyn perfume for sale. Mr Steward claims this company has been selling his product since May 2017 but provides no corroborating evidence for this claim such as invoices.

APPLICANT'S EVIDENCE

8) The applicant filed a witness statement, dated 8 January 2019, by Laurice Rahme the Chief Executive Officer of the applicant company. She states that the applicant has a history of naming perfumes after areas of New York city, and launched its "Bond No.9 Brooklyn" perfume in 2009. It has been sold in the UK since 2010, initially upon Amazon and subsequently in Harrods and Selfridges. It is also available on line in the UK via two other UK websites. She provides the following sales figures for the product in the UK which typically sells for between £150-£180 per bottle.

Year	£
2010	12,867
2011	5,515
2012	7,353
2013	2,757
2014	11,948
2015	4,595
2016	5,515
2017	919

9) The bottle the perfume is sold in is shown below:



10) She provides the following exhibits:

- LR2: page 9: (undated and unattributed); LR9 page 92 (dated 14 January 2009 on the website ODD NEWS) and LR10 page 100 (dated 22 December 2008 Cosmetic World magazine). All feature stories regarding the launch of the applicant's perfume where the perfume is referred to as BROOKLYN and the company as Bond No.9"
- LR4: An advertisement, dated July 2018, on an American website for the applicant's perfume showing the picture above. Underneath it states "Brooklyn: New York's legendary city within a city, home to a century or more of strivers, dreamers, and Nobel Laureates, its reinventing itself, neighbourhood by neighbourhood, as an edgy metropolis. A long lasting woody, spicy, male-but-loved-by-females kind of scent, as edgy as the borough its named for."
- LR7: An article from an American magazine BEAUTY FASHION, dated March 2009, which has a small article about the launch of the applicant's perfume under the heading Brooklyn in Bloom. It states:

"Bond No.9 celebrates the borough of Brooklyn with its newest fragrance. Brooklyn eau de Parfum captures the vibe of edgy new Brooklyn, which is home to artists, bloggers and creative types."
- LR12: A print out from the applicant's website, dated June 2017, showing its Brooklyn perfume for sale in Harrods, London.
- LR13: A undated print out from Harrods website showing the applicant's product on sale, but prices in US\$.

- LR14: A print out from the Amazon website showing the applicant's Brooklyn perfume on sale in the UK from 24 July 2010. It refers to the product as "brooklyn".
- LR15: Print outs, dated July 2018, from websites, www.notino.co.uk and www.perfume-click.co.uk showing the applicant's perfume on sale in the UK.
- LR16: Invoices from the applicant to Harrods and Selfridges showing sales of US\$7,439 worth of the applicant's Brooklyn perfume between 2011 and 2017.

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

DECISION

12) The first ground of opposition is under sections 3(1)(a) & (b) which read:

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

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d)

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

13) I shall firstly consider the issue under section 3(1)(a). The opponent contends that there are numerous companies that use BROOKLYN in relation to perfumes and it is therefore dilute and incapable of distinguishing goods or services of one undertaking from those of another undertaking. It therefore offends against section 3(1)(a) of the Trade Marks Act 1994. In its submissions it stated:

“He [Mr Steward] goes on to show that BROOKLYN is a place of significant size and international repute and one that could be and is associated with many commercial activities including in relation to luxury brands and goods. Finally, his Statement shows that many others use BROOKLYN in relation to perfumes such that it is dilute.”

14) When considering whether a sign is capable of distinguishing the goods and services of one party from those of other undertaking I look to the case of *Koninklijke Philips Electronics NV and Remington Consumer Products Ltd*, Case C-299/99, where the Court of Justice of the European Union stated that:

“30. Moreover, according to the case-law of the Court, the essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin, and for the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality (see, in particular, Case C-349/95 *Loendersloot* [1997] ECR I-6227, paragraphs 22 and 24, and Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28).”

AND:

“47. First, it is clear from Article 2 of the Directive that a trade mark has distinctive character if it serves to distinguish, according to their origin, the goods or services in respect of which registration has been applied for. It is sufficient, as is clear from paragraph 30 of this judgment, for the trade mark to enable the public concerned to distinguish the product or service from others which have another commercial origin, and to conclude that all the goods or services bearing it have originated under the control of the proprietor of the trade mark to whom responsibility for their quality can be attributed.”

15) The opponent has not provided any evidence of use of the mark BROOKLYN on perfumes by others in the UK. There may be a number of marks incorporating the word “Brooklyn” upon the IPO and EU registers, but absent evidence of use this does not provide a reason why the goods of the applicant cannot be distinguished from the goods of other undertakings. I do not believe that the average consumer will view the term as indicating geographical origin as there is no evidence that

Brooklyn has a reputation for perfume amongst the general public in the UK. **The opposition under section 3(1)(a) fails.**

16) I now turn to section 3(1)(b) which is slightly different. The general principles under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as *OHIM* points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of

certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37).”

17) The opponent contends that BROOKLYN is a geographic term which is known internationally and which is associated with a city that leads the world in terms of fashion, design and luxury goods. In addition, there are numerous perfume stores in Brooklyn. The same submission as made for 3(1)(a) was made against this ground. For ease of reference the submission was:

“He [Mr Steward] goes on to show that BROOKLYN is a place of significant size and international repute and one that could be and is associated with many commercial activities including in relation to luxury brands and goods. Finally, his Statement shows that many others use BROOKLYN in relation to perfumes such that it is dilute.”

18) I take into account the case of *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2013] F.S.R. 29, where Arnold J. held that a descriptive word with a minor figurative embellishment was, as a whole, devoid of any distinctive character. He found that:

“116. Taking all of the evidence into account, I conclude that the CTM is precluded from registration by art.7(1)(c) in relation to the services in issue because NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the service. The figurative elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word NOW, I consider that the CTM is devoid of distinctive character and thus unregistrable by virtue of art.7(1)(b) .

117. I would comment that it appears to me that PCCW only succeeded in obtaining registration of the CTM because it included figurative elements. Yet PCCW is seeking to enforce the CTM against signs which do not include the figurative elements or anything like them. That was an entirely foreseeable consequence of permitting registration of the CTM. Trade mark registries should be astute to this consequence of registering descriptive marks under the cover of a figurative figleaf of distinctiveness, and refuse registration of such marks in the first place.”

19) A similar point arose in *Thomas Pink Ltd v Victoria's Secret UK Ltd*, [2014] EWHC 2631 (Ch), when Birss J. found that the registration of the descriptive word PINK (for clothing) with the letters in the colour pink, and in a unique form of script, and within a rectangular box, did not prevent the mark being *prima facie* unregistrable under s.3(1)(c). In the alternative, the mark was excluded by s.3(1)(b).

20) In *Canary Wharf Group plc v The Comptroller General of Patents, Designs and Trade Marks* [2015] EWHC 1588 (Ch), Mr Iain Purvis QC sitting as a Deputy Judge of the High Court set out the correct approach to assessing whether a trade mark is descriptive of the subject matter of the goods/services. He stated that:

“39. The general approach to be taken by a tribunal dealing with a ‘subject matter’ or ‘theme’ objection under s3(1)(c) or s3(1)(b) was recently considered by Geoffrey Hobbs QC sitting as the Appointed Person in *NMSI Trading Ltd's Trade Mark Application (Flying Scotsman)* [2012] RPC 7 by reference to a number of authorities including the General Court in *Danjaq v OHIM* (Dr No) [2009] ECR II-2097 , Mr Richard Arnold QC (as he then was) sitting as the Appointed Person in *Linkin Park* [2006] ETMR 74 , the First Board of Appeal of OHIM in *Ferrero OHG v FIFA* [2008] ETMR 76 and Mr Allan James in *Diana Princess of Wales Trade Mark* [2001] ETMR 25 .

40 Following, in general terms, the approach of Mr Hobbs as set out in particular in paragraph 18 of *Flying Scotsman*, I believe that at least three matters need to be considered where a ‘subject matter’ or ‘theme’ objection arises under s 3(1)(c) or (b) :

- (a) The nature of the goods or services for which the application is made. Are they in principle apt to provide or convey information about (or imagery relating to) the subject matter of the sign?
- (b) The nature of the sign. Is it something which it is reasonable to believe would be recognised by the relevant class of persons (that is to say average consumers of the goods or services in question) as indicating a particular subject matter or theme?
- (c) Is the subject matter or theme of a kind which (in the context of the goods or services in question) the average consumer would consider was controlled by a single economic undertaking, as opposed to something which was free to be used and exploited by anyone.

See for example *Psytech International v OHIM* [2011] ETMR 46 at [34]-[43] and the concept of ‘official merchandise’ recognised in *Arsenal Football Club v Reed* [2003] RPC 9 (CJEU) and [2003] RPC 39 at [50]-[69] (Court of Appeal).”

21) Whilst in *Bundesverband Souvenir – Gesschenke – Ehrenpreise eV v EUIPO*, Case C-488/16P, the CJEU upheld a judgment of the General Court to reject an application to invalidate the name of a famous German castle – NEUSCHWANSTEIN – on the grounds, inter alia, that the name was descriptive and non-distinctive for souvenirs. The court stated that:

“40. In the present case, the General Court held, in essence, in paragraph 27 of the judgment under appeal, that Neuschwanstein Castle is first and foremost a museum location, the primary function of which is not the manufacture or marketing of souvenir products or the provision of services, but heritage conservation, and that that castle is not famous for the souvenir items it sells or the services it offers. The General Court inferred from this that, as that castle is not, as such, a place where goods are produced or services are rendered, the contested trade mark may not be indicative of the geographical origin of the goods and services it covers. Accordingly, it is for the Court to verify whether, as the appellant claims, that assessment stems from a failure to have regard to the public interest underlying Article 7(1)(c) of Regulation No 207/2009.

41. In the first place, it is necessary to examine the appellant’s argument that the name ‘Neuschwanstein’ is descriptive for the purposes of Article 7(1)(c) of Regulation No 207/2009, in so far as the memory to which that name relates is an indication of a quality or an essential characteristic of the goods and services covered by the contested trade mark enabling the relevant public to establish a connection between those goods and services and Neuschwanstein Castle.

42. In that regard, it should be emphasised, as the Advocate General observed in point 39 of his Opinion, that none of the classes of the Nice Agreement concerns ‘souvenir items’. Consequently, the General Court was fully entitled to consider, as is apparent from paragraphs 22 and 27 of the judgment under appeal, that the goods covered by the contested trade mark are everyday consumer goods and that the services concerned are everyday services facilitating the management and operation of the castle.

43. In addition, it is not apparent from the case file that those goods and services for everyday use have particular characteristics or specific qualities for which Neuschwanstein Castle would be traditionally known and in respect of which the relevant public would be likely to believe that they originate there or that they are manufactured or provided there.

44. In particular, regarding the goods covered by the contested trade mark, it should be emphasised that the fact that those goods are sold as souvenir items is irrelevant for the purpose of assessing the descriptive character of the name 'Neuschwanstein'. The souvenir function ascribed to a product is not an objective characteristic inherent to the nature of that product, since that function is determined by the free will of the buyer and is focused solely on that buyer's intentions.

45. In so far as the name 'Neuschwanstein' designates the castle which bears that name, it must be considered that merely affixing that name on, inter alia, the goods concerned enables the relevant public to regard those everyday consumer goods also as souvenir items. The fact that they constitute souvenirs through the mere affixing of that name is not, in itself, an essential descriptive characteristic of those goods.

46. Accordingly, it is not reasonable to conclude that, in the mind of the relevant public, the memory to which the name 'Neuschwanstein' relates is an indication of a quality or an essential characteristic of the goods and services covered by the contested trade mark.

47. In the second place, it is necessary to examine the appellant's argument that the name 'Neuschwanstein' is descriptive of the geographical origin of the goods and services covered by the contested trade mark in so far as the place where those goods and services are marketed should be regarded as a tie connecting those goods and services with Neuschwanstein Castle.

48. In that regard, it should be borne in mind that, in its judgment of 4 May 1999, *Windsurfing Chiemsee* (C-108/97 and C-109/97, EU:C:1999:230, paragraph 36), the Court held that, whilst an indication of the geographical origin of a product usually indicates the place where that product was or could be manufactured, the connection between a product and a geographical location might depend on other ties, such as the fact that that product was conceived and designed in that geographical location.

49. Accordingly, the Court did not confine such ties to the place of manufacture of the goods concerned. However, as the Advocate General indicated in point 41 of his Opinion, that does not necessarily imply that the place of marketing may serve as a tie connecting the goods and services covered by the contested trade mark with the place concerned, even in the case of items sold as souvenirs.

50. The mere fact that those goods and services are offered in a particular place cannot constitute a descriptive indication of the geographical origin of those goods and services, in so far as the place where those goods and services are sold is not capable, as such, of designating characteristics, qualities or distinctive features connected with the geographical origin of those goods and services, such as a craft, a tradition or a climate which is a characteristic of a particular place, as the Advocate General notes, in essence, in point 42 of his Opinion.

51. In the present case, as the General Court considered in paragraphs 27 and 29 of the judgment under appeal, Neuschwanstein Castle is famous not for the souvenir items it sells or the services it offers, but for its unusual architecture. Furthermore, it is not apparent from the case file that the contested trade mark is used to market specific souvenir products and to offer particular services for which it would be traditionally known.

52. Moreover, as is apparent from paragraph 41 of the judgment under appeal, none of the services covered by the contested trade mark is directly offered onsite at Neuschwanstein Castle. Regarding the goods concerned, as the appellant itself acknowledges in its appeal, it cannot be excluded that they may be sold beyond that castle's surroundings.

53. In those circumstances, it is not reasonable to conclude that, in the mind of the relevant public, the place of marketing to which the name 'Neuschwanstein' relates is, as such, a description of a quality or an essential characteristic of the goods and services covered by the contested trade mark.

54. Therefore, the General Court did not err in law in finding, in paragraph 27 of the judgment under appeal, that, as Neuschwanstein Castle is not, as such, a place where goods are produced or services are rendered, the contested trade mark could not be indicative of the geographical origin of the goods and services it covers."

22) The key points in this judgment are:

- (i) Neuschwanstein Castle is first and foremost a museum location and that castle is not famous for the souvenir items it sells or the services it offers;
- (ii) The goods covered by the contested trade mark are everyday consumer goods and services and cannot be classified as 'souvenirs' solely on the basis of the buyer's intentions;

- (iii) Merely affixing the name of the castle on the goods concerned enables the relevant public to regard those everyday consumer goods also as souvenir items;
- (iv) However, the fact that they constitute souvenirs through the mere affixing of that name is not, in itself, an essential descriptive characteristic of those goods.
- (v) The mere fact that those goods and services are offered in a particular place cannot constitute a descriptive indication of the geographical origin of those goods and services;
- (vi) However, it is not necessary for the goods to be made in the place concerned and the name would designate geographical origin if it designated characteristics or features connected with the geographical origin of those goods and services, such as a craft, a tradition or a climate;
- (vii) Neuschwanstein Castle is famous for its unusual architecture and there was no evidence that the corresponding trade mark was used to market specific souvenir products or to offer particular services for which it would be traditionally known;
- (viii) As a consequence of the above, 'Neuschwanstein' is not a description of a quality or an essential characteristic of the goods and services covered by the contested trade mark.

23) The court went on find that the General Court did not err in law in finding that the name of the castle is a fanciful name, which has no descriptive relationship with the goods and services marketed or offered. There was no error of law or distortion of the facts in its finding that the mere affixing of the contested trade mark on the items sold and the services offered enables those goods and services to be distinguished from other everyday consumer goods and services sold or provided in other commercial or tourist areas. And that was sufficient reasoning to justify the General Court's finding that the mark was not devoid of any distinctive character.

24) To my mind, the instant case is not on all fours with any of the authorities set out above. All the opponent has alleged is that there are a number of perfumes which have the word "Brooklyn" within the mark used but has failed to provide any evidence of use. It is claimed that Brooklyn is a known centre for perfume production, but the only evidence is that there are three companies who produce scented products in the Brooklyn area, and that there are a number of stores within Brooklyn that sell perfume. There is no evidence that the public in the UK views Brooklyn as a perfume making centre, and I would imagine that any decent size borough in London could boast similarly large numbers of

outlets selling perfume. Mr Day submitted at the hearing that the borough of Brooklyn is “an enormous cultural, commercial and residential hub” the area was bound be either have or will achieve in the future a reputation for perfumes. He contended that any such conurbation was likely to either have or develop such a reputation for perfume and presumably a range of other goods and services. I do not accept that every such area has a reputation for a huge range of goods and services, or that they will inevitably develop the same. Again, the opponent has singularly failed to make a credible case as to why the mark in suit is devoid of distinctive character. **The ground of opposition under section 3(1)(b) fails.**

25) Turning to the ground under section 3(1)(c) the opponent again claims that “BROOKLYN is a geographic term which is known internationally and which is associated with a city that leads the world in terms of fashion, design and luxury goods. In addition, there are numerous perfume stores in Brooklyn. The mark in suit therefore offends against section 3(1)(b) & (c) of the Trade Marks Act 1994.”

26) Whilst Brooklyn as a large borough of the City of New York, the opponent has not shown that the average consumer of perfume in the UK believes the borough to be well known for anything. I also take into account the comments in *Nude Brands Ltd v Stella McCartney Ltd*, [2009] EWHC 2154 Ch, Floyd J. stated that:

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

27) I note that the above comments cover both sections 3(1)(b) and (c). The opponent has not shown that the instant mark consists “exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of

production of goods or of rendering of services, or other characteristics of goods or services”. **The opposition under section 3(1)(c) fails.**

28) I next turn to the ground of opposition under section 3(6) which reads:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

29) The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch), as follows:

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, “Bad faith in European trade mark law” [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C- 529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November

2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plastics Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

30) The opponent contends it has been seeking to assert its rights in Brooklyn against the opponent and has pointed out to the applicant that many other companies have been using the mark for many years, that it is descriptive and also that the opponent's use of the mark BROOKLYN pre-dates that of the applicant in the UK. It also points out that two other companies have EU registrations for the marks EAU DE BROOKLYN (EU 4916334 registered in 2006) and BROOKLYN SOAP COMPANY (EU 13209473 registered in 2014). In its submissions for the hearing it put its case in a simpler way:

“Section 3(6)-the Applicant has never used BROOKLYN simpliciter and filed the Application in full knowledge of (i) the various other trade mark registrations that are owned and used by third parties and (ii) the Opponent's use of the mark.”

31) In considering this issue I look to the case of *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others [2009] RPC 9 (approved by the COA in [2010] RPC 16), Arnold J. stated that:

“189. In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the bases discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Article 107 can hardly be said to be abusing the Community trade mark system.”

32) The applicant failed to show that any of the other marks that it found on the IPO or EU registers had been actually used in the UK. In the instant case the applicant contends that it is the senior user having been using its mark in the UK for a considerable time prior to the entry into the market of the opponent. To my mind, this case is on all fours with the authority quoted in paragraph 31 above. **The ground of opposition under section 3(6) fails.**

33) Lastly, I turn to consider the ground of opposition under section 5(4) 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.”

34) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

35) Whilst Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 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) It is clear that the opponent launched its perfume “Brooklyn by Gallivant” in March 2017. I note that the opponent has contended that no-one can claim rights in the mark “Brooklyn” *simpliciter* in the UK as it claims the word is not distinctive. However, under this ground of opposition it decides that it has an earlier right in the word Brooklyn. Whilst the opponent’s launch date is clear, and I accept there was a small degree of publicity surrounding the event and the company has managed to get its press releases reported subsequently. However, the picture when it comes to sales is far from clear. The opponent has provided a few invoices but the values of the products are completely redacted so that it is not possible to confirm that samples were actually charged for. Despite this it is possible to state that the opponent has put out into the market prior to the relevant date of 9 November 2017 (when the application was filed) 35 x 30ml bottles, and 70 x 2ml vials of its perfume. As stated earlier these figures include those items marked as samples and so is the absolute maximum in terms of sales that can be claimed by the opponent. It would appear that the opponent’s perfume sells for £65 per 30ml according to the exhibits filed. On this basis its sales can be roughly monetised as being $35 \times £65 = £2275$; $70 \times 2\text{ml} = 140 \div 30\text{ml} = 4.6 \times £65 = £303$; total value of sales £2578. When put in the

context of the perfume market in the UK this is quite low, although on a par with the sales of the applicant in per annum terms. However, I accept this provides the opponent with goodwill and so it gets over the first hurdle. It follows, inevitably, given that the marks are identical as are the goods that misrepresentation would occur, and damage would naturally follow. The ground of opposition under section 5(4)(a) succeeds.

37) However, in its defence the opponent has claimed that it has sold its perfume in the UK since 2010. It has provided sales figures which show sales per annum averaging at £6,400. These sales have been made under the mark shown on the bottle pictured below:



38) I must therefore decide whether this mark can be considered to be use of the mark in suit in a different form, or as part of or with another mark. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1). (emphasis added)

39) Whilst in *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

"33. The first question [in a case of this kind] 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, this 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 differences at all."

40) Although this cases was decided before the judgment of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

41) Although the word appears in colour and a "graffiti" style, the word BROOKLYN appears extensively, at least five times, upon the bottle. The print for the word BROOKLYN is larger than that used for the "Bond No.9" part of the mark and BROOKLYN appears three times above the "Bond No.9". I accept there would also appear to be a printed label stuck on the bottle on the lower left side with the name of the company (Bond No.9) with a large centre piece with the letters NYC clearly referencing New York City. To my mind, the public would when viewing the bottle take the clear message that the perfume is called BROOKLY and that the manufacturer is the Bond No.9 company based in New York City. I therefore regard the sales of the perfume referred to in the applicant's evidence as use of the mark in plain capital letters BROOKLYN. **As such the applicant is the senior user and the ground of opposition under section 5(4)(a) must fail.**

CONCLUSION

42) The opposition under Sections 3(1)(a),(b) and (c), 3(6) and 5(4)(a) have all failed.

COSTS

43) As the applicant has succeeded in it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Preparing evidence	£600
Considering the other sides evidence	£800

Attendance at the hearing	£1200
TOTAL	£2,900

50) I order Gallivant Perfumes Ltd to pay Laurice El Badry Rahme Ltd the sum of £2,900. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of June 2019

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