

O-326-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2360413
BY ASCOT (S & F) INTERNATIONAL LIMITED
TO REGISTER THE TRADE MARK:**



IN CLASS 25

AND

**THE OPPOSITION THERETO
UNDER NO 92734
BY HUMMEL A/S**

Trade Marks Act 1994

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to register the trade mark:**



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INTRODUCTION

1) On 7 April 2004 Ascot (S & F) International Limited, which I will refer to as Ascot, applied to register the above trade mark. The application was published for opposition purposes in the *Trade Marks Journal* on 21 May 2004 with the following specification:

clothing; footwear; headgear.

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 20 August 2004 Hummel A/S, which I will refer to as Hummel, filed a notice of opposition to the application. In its grounds of opposition Hummel relied upon five earlier trade mark registrations. The grounds based upon two of the earlier registrations were struck out owing to a failure to substantiate use of them in the five year period ending with the date of the publication of the application¹. The details of the remaining three registrations are as follows:

- Community trade mark registration no 1203983 of the trade mark:



The application for registration was made on 12 June 1999 and the trade mark was registered on 21 October 2003 for, inter alia, *sports and leisure clothing, including shoes and headgear*.

- Community trade mark registration no 2406999 of the trade mark:



The application for registration was made on 10 October 2001 and the trade mark was registered on 31 March 2003 for, inter alia, *clothing, footwear, headgear*.

- Community trade mark registration no 3015377 of the trade mark:



The application for registration was made on 20 January 2003 and the trade mark was registered on 17 March 2004 for, inter alia, *clothing, footwear, headgear, all the aforesaid goods also for use in sports (not included in other classes)*.

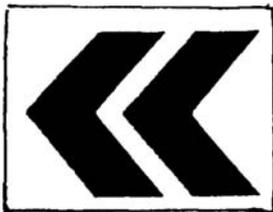
All the above goods are in class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3) Hummel claims that trade marks the subject of registration nos 3015377 and 1203983 are identical to Ascot's trade mark and that the respective goods are identical or similar. In the alternative it claims that the respective trade marks are similar and the respective goods are identical or similar. Consequently, registration of Ascot's trade mark would be contrary to sections 5(1), 5(2)(a) or 5(2)(b) of the Trade Marks Act 1994 (the Act).

Hummel claims that the trade mark the subject of registration no 2406999 is similar to Ascot's trade mark and that the respective goods are either identical or similar. Consequently, registration of Ascot's trade mark would be contrary to section 5(2)(b) of the Act.

4) Hummel claims that the trade marks the subjects of registration nos 3015377, 1203983 and 2406999 have a reputation in respect of all of the goods encompassed by the registrations. It claims that it has a substantial reputation in the United Kingdom due to its presence in the United Kingdom market since 1996. It claims that if it is found that the respective goods are neither identical nor similar that, in view of the close proximity of the respective markets, use of the trade mark of Ascot would take unfair advantage of or be detrimental to the distinctive character and repute of its trade marks. Consequently, registration of the trade mark of Ascot would be contrary to section 5(3) of the Act.

5) Hummel claims that it has used the trade marks the subjects of registration nos 3015377 and 1203983 and the trade mark:



in the United Kingdom since 1996 in relation to a wide variety of leisure and sports clothing including, but not limited to, outerclothing, shorts, t-shirts, sweatshirts, training suits, soccer boots, handball shoes, leisure shoes and socks. It states that the trade marks have also been used on bags and accessories, team bags, leisure bags, bag packs, sweatbands and caps. Consequently, registration of the trade mark of Ascot would be contrary to section 5(4)(a) of the Act.

6) Ascot filed a counterstatement in which it denied that the respective trade marks were identical or similar. It denies all of the grounds of opposition.

7) Both sides filed evidence.

8) The sides were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing; both sides filed written submissions.

EVIDENCE

Main evidence of Hummel

9) This consists of a declaration made by Mr Søren Schriver. Mr Schriver is chief executive officer of Hummel International A/S, which I will refer to as International. International is a subsidiary company of Hummel and the authorised user of the latter's trade marks.

10) Mr Schriver states that the trade marks the subject of registration nos 3015377 and 1203983 and the trade mark shown in paragraph 5 (the trade marks) were first used in the United Kingdom in relation to sports clothing and footwear in 1982 by Hummel or with its consent by subsidiary companies. He states that since 1982 the trade marks have been continuously used by Hummel, by subsidiary companies of Hummel or by authorised licensees. Mr Schriver states that the range of goods marketed and sold in the United Kingdom under the trade marks has extended to cover bags, leisure clothing, leisure footwear and balls. Mr Schriver states that the trade marks were used in the United Kingdom from 1982 to 1995 by a subsidiary company of Hummel, Hummel Sport & Leisure (UK) Limited. Exhibited at SS2 is a copy of a letter from Hummel Sport & Leisure (UK) Limited to Hummel Sport Danmark A/S dated 6 July 1992. At the right hand side of the page the following device can be seen:



Above it there are 2 chevrons pointing downwards and below it there are 36 chevrons pointing downwards; the design runs the length of the page. The letter relates to a t-shirt and a sweat top. Included in the exhibit is a copy of a leaflet from spring 1992. This shows use of the device shown above, the word HUMMEL and two chevrons pointing downwards. The device shown above and the word HUMMEL are the prominent elements of the leaflet. The above device and the word HUMMEL appear on some pictures of clothing in the leaflet.

11) Mr Schriver states that from 1995 – 2000 a licensee of Hummel located in the Netherlands was responsible for the marketing and sale in the United Kingdom of products bearing the trade marks. Mr Schriver states that the trade marks continued to be used in the United Kingdom in respect of sports clothing and footwear.

12) Mr Schriver states that for the period 2001 – 2004 Hummel appointed a United Kingdom licensee, Gilbert and Pollards Sports Limited. He states that during this period the trade marks were continually used in the United Kingdom in respect of sports clothing and footwear. Exhibited at SS3 is a copy of an invoice dated 15 June 2001 to Gilbert and Pollards Sports Limited from International; it relates to a royalty payment.

The letter paper does not bear any devices or designs. Mr Schriver states that from June 2004 onwards Hummel has licensed a subsidiary, Hummel UK, to use the trade marks in the United Kingdom in relation to the goods referred to in paragraph 10. Mr Schriver states that goods bearing the trade marks have been sold in a large number of towns in the United Kingdom.

Evidence of Ascot

13) This consists of a witness statement by Guru Dev Seth. Mr Seth is the managing director of Ascot. The majority of Mr Seth's statement deals with the history of Ascot's business in the United Kingdom and does not relate to the trade mark the subject of this opposition. Consequently, it does not have a bearing upon my decision.

14) Mr Seth states that the principal brand of Ascot is ASCOT. However, Ascot has adopted several secondary brand names and logos or devices. He states that one such brand is ATOM. Exhibited at GDS 2 are copies of sales brochures for 2004/2005 and 2006. These show use of ATOM and the trade mark the subject of the application. The trade mark the subject of the application appears on sports shoes on its own in various positions eg the tongue and the sides. The shoes are identified by various sub-brand names eg EDISON and TECHNIQUE. Also included in the exhibit is tissue paper bearing the word ATOM and the trade mark the subject of the application. A shoe box is also exhibited, this shows use of the word ATOM and the trade mark the subject of the application.

15) Mr Seth states that he is not aware of any instances of confusion.

Evidence in reply of Hummel

16) This consists of a witness statement by Stephen Gilbert Knott, who is a trade mark attorney. This witness statement contains no evidence of fact but a list of submissions. I bear in mind the submissions in reaching my decision but will say no more about them here.

DECISION

Findings of fact

17) For the grounds of opposition to be considered under section 5(3) of the Act Hummel must establish that at the date of the filing of Ascot's application that the trade marks upon which it relies under this section of the Act were known by "a significant part of the public concerned by the products or services covered"ⁱⁱⁱ. As all three trade marks are Community trade marks it must establish a reputation in the European Union, a reputation in one member state is not enoughⁱⁱⁱ. The evidence goes nowhere near establishing the appropriate reputation in the United Kingdom, yet alone in the European Union. **The grounds of opposition under section 5(3) must, therefore, be dismissed.**

18) In its submissions Hummel identifies the basis for its claim under section 5(4)(a) to be the law of passing-off. In order to succeed under this head Hummel must establish that it has a goodwill in a business situated in the United Kingdom and that this goodwill is related to the signs upon which it relies. It relies upon three signs. There is no evidence showing use of two of the signs. The use of the other sign, two chevrons pointing downwards, is limited to a leaflet from 1992. This sign could be seen as being simply decoration; there is nothing to indicate that it has any other significance. In addition to this problem, there is an enormous gap between the use and the material date. It is well established that the material date in relation to passing-off is the date of the behaviour complained of; in relation to section 5(4)(a) this date cannot be later than the date of application for registration^{iv}. Ascot appears to have used its trade mark, however, there is nothing to indicate that it was used prior to the date of application, 7 April 2004. Consequently, the behaviour complained of is the act of making the application and the material date is the same date. The evidence does not support a goodwill related to any of the signs upon which Hummel relies at the material date. **Consequently, the grounds of opposition under section 5(4)(a) of the Act must be dismissed.**

19) On the basis of the evidence before me Hummel cannot claim any enhanced protection for the trade marks upon which it relies upon the basis of use.

Sections 5(1), 5(2)(a) and 5(2)(b) of the Act

20) The relevant sections of the Act read as follows:

“5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

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

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

The trade marks the subject of registration nos 3015377, 1203983 and 2406999 are earlier trade marks as per section 6(1)(a) of the Act^v.

Average consumer and purchasing process

21) The goods in question are clothing, footwear and headgear, goods that are bought by the public at large. These are goods that can be both expensive and cheap. In my experience there is a good deal of brand awareness in relation to these goods so that even for cheap goods there will be a reasonably careful purchasing decision. However, the purchasing decision will be a long way from the type of careful and educated decision that will be involved in purchasing such things as white goods and computers. The nature of the goods and the purchasing process is not such that small differences in the trade marks will mitigate against confusion or make the consumer less subject of the effects of imperfect recollection. It is, of course necessary to take into account that the average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant^{vi}”. The case law holds that in relation to clothing it is the visual impression of the trade mark that is important^{vii}.

Sections 5(1) and 5(2)(a) of the Act

22) Sections 5(1) and 5(2)(a) of the Act require that trade marks are identical. “A sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer^{viii}.” Ascot’s trade mark consists of a large chevron going from right to left and two smaller chevrons of the same size going from left to right. The trade mark the subject of 1203983 consists of two chevrons of the same size going downwards, these chevrons are thicker than the chevron’s of Ascot’s trade mark. I consider that the difference in the direction of the chevrons and the absence of a larger chevron means that the differences between that trade mark and Ascot’s trade mark are such that they will not go unnoticed by the average consumer. The two chevrons the subject of registration no 3015377 are thicker than the chevrons of Ascot’s trade mark; of much greater importance, is the absence of a large chevron going in the opposite direction. I consider that the differences between that trade mark the subject of registration no 3015377 and Ascot’s trade mark are such that they will not go unnoticed by the average consumer. Hummel seems to be effectively relying upon the French concept of partial reproduction for the basis of its claim under section 5(1) and 5(2)(a) of the Act, a concept that did not find favour with the European Court of Justice (ECJ) in *LTJ Diffusion SA v Sadas Vertbaudet SA*. **I do not consider that either of the trade marks upon which Hummel relies in relation to sections 5(1) and 5(2)(a) are identical and the grounds of opposition under this head must be dismissed.**

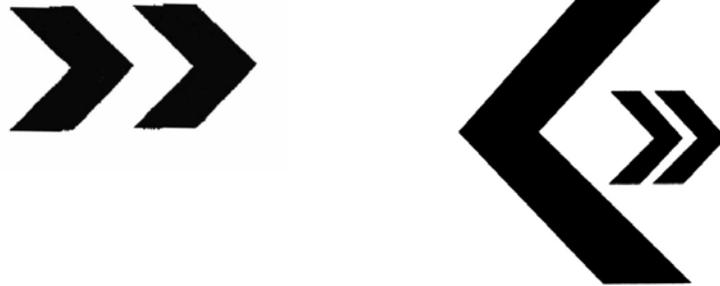
Section 5(2)(b) of the Act

23) The trade mark the subject of registration no 3015377 is the closest in appearance to that of the application. The respective goods are identical. If Hummel cannot succeed in relation to this trade mark I cannot see that it can succeed in relation to its other trade marks.

24) The trade marks to be compared are:

Hummel's trade mark:

Ascot's trade mark:



25) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^{ix}. The visual and any 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^x. Consequently, I must not indulge in an artificial dissection of the trade marks, although I need to take 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/she has kept in his mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{xi}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{xii}.

26) I cannot see that the trade mark of Hummel lends itself to a division into distinctive and dominant components. Hummel's trade mark consists of two chevrons going from left to right. Ascot's trade mark includes two chevrons going from left to right, they are slightly closer together and thinner but the differences are negligible. I consider that there is a clear similarity between the dual chevron elements of the respective trade marks. The difference resulting from the large chevron is not such as to mean that the trade marks are not visually similar. I consider that the trade marks are visually similar. My view of this is reinforced by the nature the use shown by Ascot. I consider that the actual use shown by Ascot can be considered to be normal and fair use of its trade mark and as such paradigm use^{xiii}. In this use the large chevron sometimes appears more as part of the design of the shoe or the shoe box rather than as part of the trade mark, consequently, the two chevrons in paradigm use become the distinctive and dominant element of Ascot's trade mark. (There is use where this does not occur but this does not gainsay part of the paradigm use shown).

27) I do not consider that the average consumer will imbue the respective trade marks with any conceptual associations.

28) I find that the respective trade marks are similar.

Conclusion

29) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{xiv}. In this case the goods are identical and the trade marks are, in my view, similar to a relatively high degree.

30) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion^{xv}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xvi}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings^{xvii}. I am aware that flashes are used by a number of companies in relation to clothing and footwear, however, a simple geometrical pattern of two chevrons is at the low end of inherent distinctiveness^{xviii}; of its nature it lies on the hinterland between trade mark use and use as decoration. It is necessary to bear in mind that I have to assume notional and fair trade mark use of the earlier trade mark, not use as decoration, and there is a presumption of validity of the earlier trade mark^{xix}.

31) In considering the likelihood of confusion I have to bear in mind the nature of the goods and the nature of the purchasing decision, which I have discussed above. In making this consideration I take into account the paradigm use of Ascot's trade mark that has been shown and the effects of imperfect recollection.

32) Ascot argues that there have been no incidents of confusion in the market place. However, there is no evidence to show concurrent use in the market place of the respective trade marks. The use by Ascot is also with other identifying matter and appears to be restricted to footwear. Consequently, the absence of evidence of confusion tells me nothing^{xx}.

33) Ascot submits that it is “unreasonable for any one proprietor to claim that they have a monopoly in the use of V-shaped stripes of all sizes, numbers and arrangements on goods in class 25”. This might or might not be the case but it is not the issue before me; it is not an argument that has been put by Hummel, the matter is completely the construction of Ascot. Even if this were an issue, I cannot see that this is a matter upon which the likelihood of confusion can hinge^{xxi}. The issue before me is whether there is a likelihood of confusion in respect of two particular trade marks.

34) Taking all factors into account I consider that there is a likelihood of confusion and that the registration should be refused in its entirety.

COSTS

35) At an early stage Hummel was advised that it was considered that the claims under section 5(1) and 5(2)(a) were unsustainable. Hummel insisted upon maintaining these grounds. On the basis of the evidence the claim under section 5(3) of the Act was hopeless and that under section 5(4)(a) of the Act not much better. Hummel continued to press these grounds. This case boiled down to a comparison of one trade mark to one trade mark, the goods being identical, under one section of the Act. Hummel clouded and complicated the matter needlessly. Consequently, I consider that the costs compensation should be adjusted accordingly. I can see no justification for compensation for the evidence filed by Hummel, or, taking into account the nature of the grounds upon which it was successful, compensation for the written submissions. I also consider that the compensation for the notice of opposition should be limited and that there should be no compensation for considering the counterstatement. Consequent upon this I award costs on the following basis

Opposition fee	£200
Notice of opposition	£100

TOTAL	£300
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I order Ascot (S & F) International Limited to pay Hummel A/S the sum of £300. 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 2nd day of November 2007

David Landau
For the Registrar
the Comptroller-General

ⁱ Section 6A of the Trade Marks Act 1994 requires an opponent to prove use of an earlier trade mark in opposition proceedings if an earlier trade mark had been registered for five years at the date of the publication of the opposed application and the applicant requests such proof. 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).”

ⁱⁱ *General Motors Corporation v Yplon SA* Case C-375/97 [2000] RPC 572.

ⁱⁱⁱ See the decision of Richard Arnold QC, sitting as the appointed person, in *Mobis Trade Mark* BL O/020/07:

“30. The opponent contends that, where an opponent relies upon a Community trade mark, it is sufficient for the purposes of section 5(3) to show that it has a reputation in the United Kingdom and that the hearing officer was wrong in law to hold that it was required to show a reputation in the Community.

31. I am unable to accept this argument. Section 5(3) on its face expressly distinguishes between what is required in the case of an earlier national mark, namely “a reputation in the United Kingdom”, and what is required in the case of an earlier Community trade mark, namely “a reputation ... in the European Community”. This distinction reflects the difference between Article 4(4)(a) of the Directive, which requires that “the earlier [national] trade mark has a reputation in the Member State concerned”, and Article 4(3), which requires that “the earlier Community trade mark has a reputation in the Community”. The same distinction is also to be found in Article 5(5) of Council Regulation 30/94 of 20 December 1993 on the Community trade mark. I cannot see any basis on which the Act, the Directive and the Regulation can be interpreted as merely requiring that the Community trade mark relied upon should have a reputation in the Member State in question. Nor did the opponent’s attorney cite any authority or commentary to support such an interpretation. Furthermore, as the applicant’s attorney pointed out, the judgment of the ECJ in Case C-375/97 *General Motors Corp v Yplon SA* [1999] ECR I-5421 at [25]-[29], while not directly on point, tends to support the opposite interpretation.

32. It follows that the hearing officer did not make the error of law alleged.”

^{iv} 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”.

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

“a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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”.

^{vi} *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77.

^{vii} See *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 and *React Trade Mark* [2000] RPC 285.

^{viii} *LTJ Diffusion SA v Sadas Vertbaudet SA* (Case C-291/00) [2003] ETMR 83.

^{ix} *Sabel BV v Puma AG* [1998] RPC 199.

^x *Sabel BV v Puma AG* [1998] RPC 199.

^{xi} *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

^{xii} *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{xiii} Neuberger J in *Premier Brands v Typhoon* [2000] FSR 767 commented upon paradigm use:

“On behalf of TEL, Mr Bloch argued that it follows from this observation that Premier could not rely upon the way in which it actually uses the TY.PHOO mark, and that, therefore, Premier could not claim a reputation in so far as it is based on its colour scheme (and in particular on the fact that the mark TY.PHOO was frequently used written white on red): Premier's trade mark registration is not limited to that, or any other particular colour scheme. I do not accept that submission. Premier's registrations are for the word

mark TY.PHOO and, as Jacob J. said, the allegedly infringing sign has to be compared with that mark "used in a normal and fair manner in relation to goods for which it is registered". In my judgment, in the absence of argument or evidence to the contrary, the way in which the proprietor actually uses the mark can be said, at the very least *prima facie*, to be the paradigm case of its use in a normal and fair manner. It seems to me that Mr Arnold was also correct in submitting that this conclusion was consistent with the proposition, established in the three decisions of ECJ to which I have referred, that acquired reputation can broaden the protection afforded to a mark, even one which was initially wholly undistinguished. In the present case, Premier's most frequent depicted use of the TY.PHOO mark (white capitals on a red background with the T in somewhat larger format than the rest) appears to me to be a normal and fair manner of the use of the mark."

^{xiv} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

^{xv} *Sabel BV v Puma AG* [1998] RPC 1999.

^{xvi} *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

^{xvii} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

^{xviii} See by analogy the judgment of the Court of First Instance in *Cain Cellars, Inc c Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI)* Case T-304/05 in relation to simple geometrical shapes:

"22 Il importe de relever à cet égard qu'un signe d'une simplicité excessive et constitué d'une figure géométrique de base, telle qu'un cercle, une ligne, un rectangle, ou un pentagone conventionnel, n'est pas susceptible, en tant que tel, de transmettre un message dont les consommateurs peuvent se souvenir, de sorte que ces derniers ne le considéreront pas comme une marque, à moins qu'il ait acquis un caractère distinctif par l'usage, ainsi qu'il est relevé à juste titre dans la décision attaquée (points 11 et 12) (voir, en ce sens, l'arrêt BioID/OHMI, précité, points 72 et 74)."

^{xix} Article 95 of Council Regulation 40/94 of December 20, 1993.

^{xx} Mr Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18 gave weight to an absence of confusion in the market place. However, he was not referred to the existing case law in regard to this matter: the Court of Appeal in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at p 291, Laddie J in *Compass Publishing BV v. Compass Logistics Ltd* [2004] RPC 41 at p 809 and the Court of Appeal in *Phones 4U Ltd v. Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45.) The matter was succinctly summed up by Millet LJ in the first case:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

In *Fiorelli* there was also evidence of concurrent use.

^{xxi} In *Koipe Corporación SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-363/04 the CFI held:

"83 However, OHIM submits that a single competitor cannot exclusively appropriate to itself the representation of a woman. The question whether the elements which make up a trade mark may be freely used by other competitors does not form part of the examination of the distinctive character of the figurative elements of a trade mark (see, by way of analogy, Case C-329/02 P *SAT.1 v OHIM* [2004] ECR I-8317, paragraph 36). The only relevant issue in that examination is whether the sign examined is

distinctive or not, a question which, as regards the seated woman, OHIM has already answered affirmatively.”

In *L'Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-235/05 P the ECJ stated:

“45 The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”