

**O-335-15**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION No. 3051897**

**BY TAUSIF AHMED**

**TO REGISTER THE TRADE MARK TRILLIONAIRE**

**IN CLASSES 9, 14, 18 & 25**

**AND**

**OPPOSITION No. 402704**

**BY BILLIONAIRE TRADEMARKS B.V.**

## Background and pleadings

1. This is an opposition by Billionaire Trademarks B.V. to an application made on 17<sup>th</sup> April 2014 by Mr Tausif Ahmed to register the trade mark **TRILLIONAIRE** for a range of spectacles, telephones, jewellery, watches/clocks, leather goods and bags, clothing, footwear and headgear<sup>1</sup>.

2. The grounds of opposition are based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act.

3. In summary, the grounds are that:

- i) The opponent is the owner of earlier UK trade mark 3040166 and earlier international trade mark (EU) 908720A ("IT EU"), both of which consist of the word BILLIONAIRE. The earlier marks are registered or protected for goods/services in classes 9, 14, 18, 25 & 35 which are the same or similar to the goods covered by the application.
- ii) The opponent claims that the earlier marks are similar to the applicant's mark and there exists a likelihood of confusion on the part of the public.
- iii) The opponent further claims that the earlier marks have a reputation in the UK (or in the case of the IR EU, in the Community) for clothing, footwear, bags and jewellery.
- iv) Use of the applicant's mark would, without due cause, take unfair advantage of the earlier marks' reputation because the public will see the applicant's mark as a natural extension of the earlier marks and will therefore assume that the users of the marks are economically connected.
- v) The opponent further claims that it has established goodwill under the mark BILLIONAIRE as a result of the use of that mark throughout the UK since 2007 in relation to clothing, footwear, bags and jewellery. Use of the applicant's mark would constitute a misrepresentation to the public that the applicant is connected with the opponent, which will damage the opponent's goodwill. Such use is therefore liable to be restrained under the law of passing off.

4. UK trade mark 3040166 had not been registered for five years at the date of publication of the opposed mark<sup>2</sup>. Consequently, the opponent was not required to

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<sup>1</sup> The full list is shown at paragraph 26 below.

<sup>2</sup> The mark was published for opposition on 16<sup>th</sup> May 2014

make a statement of use in relation to its UK mark<sup>3</sup>. IR EU 908720A was protected on 15 November 2010, also less than five years before the date of publication of the opposed mark. Consequently, the opponent was not required to make a statement of use of that mark in relation to the goods in classes 9, 14, 18 & 25 relied upon for the purposes of this opposition. However, the opponent in fact made such a statement.

5. The applicant filed a counterstatement denying the grounds of opposition. In essence the applicant contended that:

- i) There is a big difference between BILLIONAIRE and TRILLIONAIRE.
- ii) There are other similar marks which are registered and co-exist without confusion, including BILLIONAIRE'S BOYS CLUB.
- iii) There is no likelihood of any confusion or deception of the public.

6. In answer to the question on Form TM8 which asked the applicant if he wanted the opponent to provide proof of use of the earlier IR EU, the applicant stated 'no'.

7. Both sides seek an award of costs.

### **The evidence**

8. The opponent filed three witness statements. Two of these are from Peter Cornford, who is the opponent's Trade Mark Attorney. As one would expect, most of his statements are composed of legal arguments. I will come to these later. The opponent's third statement is from Maureen Van Der Blij, who is the Managing Director of Trust International Management (T.I.M.) B.V., which has been appointed to manage the opponent's business affairs. Ms Blij says that she is fully acquainted with the opponent's business and has access to its records.

9. According to Ms Blij, the opponent's business began in Italy in 2005. In 2007 it opened its "*flagship*" store in the UK in London's fashionable Sloane Street. She says that the opponent's earlier marks have been in use in the UK in relation to goods since 2009 (not, I note, 2007). The core goods are clothing, footwear, headgear, jewellery, bags, belts and accessories for these goods. Ms Blij states that the mark has also been used in relation to items which she says are "*related*" to the core range, such as blankets, ashtrays, boxes, coin trays, footballs and "*leather accessories*". Ms Blij exhibits pages from the opponent's website<sup>4</sup> which she says show the mark in use on the goods in question and on the packaging. In fact, although the word BILLIONAIRE (with a stylised letter B) appears on the shoes on one page and on a scarf on another page, it does not appear on most of the goods shown and I cannot see any packaging. The mark (with a stylised letter B) does

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<sup>3</sup> In accordance with s.6A of the Act

<sup>4</sup> See exhibit 3 to Ms Blij's statement.

appear on each of the web pages<sup>5</sup>. I note that the website is named billionairecouture.com. This is reflected in some of the opponent's branding. For example, the buckles on some of the belts shown on the website have logos consisting of a stylised version of the letters 'BC'.

10. The opponent's goods are aimed at the top end of the market. For example, the shirts sold under the mark cost between £365 and £775. Jackets cost between £1635 and £2330. Jeans cost between £495 and £1750. Even a belt costs between £515 and £1855. In 2009, the opponent sold over £2.5m worth of goods in the UK. By 2013, this had risen to over £4.5m worth.

11. The goods are sold via the opponent's shop in Sloane Street and also at Harrods.

12. Between 2010 and 2012 the opponent spent almost £100k promoting the goods via fashion magazines, such as Esquire, and British Airways High Life magazine. Examples of the mark in use in various articles, extracts from magazines and other printed materials are in evidence<sup>6</sup>. I note that one of the magazines (Golf Vacations) is the Singapore Edition, another has goods priced in Euros, and a third postdates the application. However, most of the articles and advertisements are from the period 2010 to 2013 and are in UK publications. The goods promoted appear to be mainly clothing and footwear, although I note that wallets are also featured. The quality of the exhibit is so poor that I could not read some of the exhibits, so it is possible that other goods also featured. I note that the brand is often referred to as Billionaire Italian Couture or Billionaire Couture, but there is also some evidence of use of Billionaire alone (usually with a stylised letter B).

13. The applicant's evidence takes the form of a witness statement by Tausif Ahmed. Mr Ahmed's evidence includes dictionary entries for the words BILLIONAIRE and TRILLIONAIRE and exhibits showing that a number of existing marks consisting of, or including, the words MILLIONAIRE, BILLIONAIRE and TRILLIONAIRE are registered for the goods covered by the application<sup>7</sup>. In addition, Mr Ahmed says that BILLIONAIRE BOYS CLUB is "*a global luxury brand with a significant presence in the UK*".

14. Mr Ahmed's own mark is not yet present on the UK market, although he has invested £10k in the purchase of the domain name TRILLIONAIRE.xyz.

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<sup>5</sup> Although the pages post date the application, Ms Blij says that they reflect the goods available since 2007.

<sup>6</sup> See exhibit 8 to Ms Blij's statement. The publications include GQ, Ritz Magazine, Esquire, Hello Magazine and Mayfair Magazine.

<sup>7</sup> See exhibits 4-9 and 11 and 12 to Mr Ahmed's statement.

15. Mr Ahmed points out that the opponent's official website, and its Facebook and Instagram pages<sup>8</sup>, refer to the opponent as Billionaire Italian Couture (not just BILLIONAIRE). This is true, although I note that the BILLIONAIRE trade mark (each time with a stylised letter B) also appears on each of these pages.

## **Representation**

16. The opponent is represented by Stevens, Hewlett & Perkins, Trade Mark Attorneys. The applicant is not legally represented. A hearing was held on 30 June 2015 at which the applicant appeared in person. The opponent was not represented.

## **The correct approach**

17. The applicant relies on a number of factors which he says will avoid any likelihood of confusion or connection being made between the marks. These are that:

- i) The opponent trades as BILLIONAIRE ITALIAN COUTURE, not as BILLIONAIRE alone as per the earlier marks.
- ii) The opponent is trading at exclusive locations at the high end of the market, whereas he intends to trade in a different segment of the market and in different geographical locations.
- iii) There are other similar marks registered which co-exist with the opponent's earlier marks.

18. These are familiar arguments in trade mark oppositions. They are often made by those, such as Mr Ahmed, who are new to these matters and have no legal representation. Less understandably, these are points sometimes taken by legal representatives practising before the IPO, despite a mountain of case law to the contrary. Therefore before going any further into the merits of this opposition it is necessary to explain again why, as a matter of law, these points will have no bearing on the outcome of this opposition.

19. A trade mark registration is essentially a claim to a piece of legal property, i.e. the trade mark. The goods and services for which the mark is registered set some limits to the claim, although since marks can be protected against the use of the same or similar marks in relation to goods or services which are only similar to those for which the earlier mark is registered<sup>9</sup>, the limits of the claim are not precise. Every registered mark is therefore entitled to legal protection against the use or registration

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<sup>8</sup> See exhibits 13-15 to Mr Ahmed's statement.

<sup>9</sup> And where the earlier mark has a reputation, potentially even dissimilar goods/services

of the same or similar trade marks for the same or similar goods/services, if there is a likelihood of confusion.

20. Until a trade mark has been registered for five years, it is entitled to protection in relation to all the goods/services for which it is registered or (in the case of the IR EU) protected. Consequently, the opponent's earlier UK mark must be protected for the goods and services for which it is registered in classes 18, 25 and 35 without the opponent needing to prove any use of the BILLIONAIRE mark in relation to those goods/services. The opponent's earlier IR EU covers goods in classes 9, 14, 16 and 25. This mark had not been protected in the EU for five years at the date of publication of the applicant's mark. Consequently, and despite the opponent making a statement of use of this mark, it was not subject to proof of use<sup>10</sup>. The opponent's earlier marks are therefore entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of the earlier marks for the goods/services on which the opponent relies for the purposes of this opposition. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd*<sup>11</sup> like this:

"22. ....It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

21. This approach has recently been endorsed by the Court of Appeal in *Roger Maier v ASOS*<sup>12</sup>. Therefore although the mark(s) that the opponent has actually used may be relevant when it comes to assessing its claim for additional legal protection based on the claimed reputation of the earlier marks, the actual mark(s) that the opponent has used is irrelevant when it comes to assessing the likelihood of confusion based on just the registration of the earlier marks. Consequently, the extent to which the opponent has used the registered marks BILLIONAIRE (as opposed to the use of the composite marks BILLIONAIRE ITALIAN COUTURE/BILLIONAIRE COUTURE) is only of any relevance to the opponent's

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<sup>10</sup> In any event, as I noted above, when completing his counterstatement the applicant opted not to ask the opponent to prove use of the IR EU.

<sup>11</sup> [2004] RPC 41

<sup>12</sup> [2015] EWCA Civ 220 at paragraphs 78 and 84

claim for additional legal protection of the BILLIONAIRE marks based on the claimed reputation and enhanced distinctiveness of the marks, which is said to result from the extensive use of the BILLIONAIRE marks in the UK.

22. The opponent appears to be trading at the top end of the fashion market whereas the applicant does not yet appear to be trading under the opposed mark. If and when such trade commences, Mr Ahmed says it will be in a different market segment and through different physical locations. I have already explained why the particular segment of the market in which the opponent has so far chosen to trade does not deprive the opponent's marks of the normal level of protection afforded to every registered trade mark, and why this means that I must consider notional and fair use of the opponent's marks across all segments of the markets for the goods/services for which they are registered. So far as the applicant's proposed use of his mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*<sup>13</sup>, the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Consequently, I must include consideration of the likelihood of confusion if both parties (and their successors in title to the marks) decide to target the same segment of the market. Therefore the fact that the parties are currently, or currently intend to, target different market segments is irrelevant<sup>14</sup> where the goods/services at issue are fundamentally the same or similar.

23. The proprietor also seeks to rely on the existence of other similar marks on the UK and Community trade mark registers in order to show that such marks can co-exist without a likelihood of confusion. However, in the absence of evidence that such marks are in use this sort of evidence has always been given short shrift. This is because without evidence that the marks are in use on a scale that might have led to confusion, it cannot be shown that the public have got used to distinguishing between them without confusion. There is ample authority to this effect<sup>15</sup>. It is therefore well established that the mere existence of similar marks on trade mark registers neither increases nor decreases the likelihood of confusion between one such mark and another trade mark in a different ownership. The 'state of the register' evidence is therefore of no weight.

24. It might seem odd to some that the opponent's earlier marks would be entitled to protection even if they had not been used at all, but the existence of other registered marks in the names of third parties, without evidence of the use of those marks, is irrelevant to the scope of protection of the opponent's marks. However, as I

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<sup>13</sup> Case C-533/06

<sup>14</sup> See the judgment of the CJEU in *Devinlec Développement Innovation Leclerc SA v OHIM, Case C- C-171/06P* at paragraph 59

<sup>15</sup> See, for example, TREAT [1996] RPC 281

explained above, the answer to this apparent anomaly is that the registration of a trade mark provides its owner with an exclusive right to use that mark. The law protects the exclusive right provided by registration against any unjustified invasion by third parties. The level of protection provided is normally based on a notional assessment of the likelihood of confusion between the registered (or protected) trade mark and any later mark. This will only change when it is shown that more or less protection than normal is justified because of exceptional and firmly established factual circumstances in the market place. None of the three points set out in paragraph 17 above qualify as such.

## DECISION

### Section 5(2)(b)

25. Sections 5(2)(b) of the Act is as follows:

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

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

### Comparison of goods and services

26. The respective goods and services are set out in the following table.

Applicant's goods	UK 3040166	IR EU 908720A
<p>Class 9 Optical, Spectacles, Glasses, Sunglasses, Spectacle Frames, Spectacle Glasses, Contact lenses, Spectacle cases or cases for contact lenses. Accessories and Covers, namely; Telephones, Mobile Telephones, Smart Phones, Cameras, Tablets, PDAs and MP3 players. Covers, Shells, Fronts, Chargers, Lanyards or Chokers, Earphones, Bags and cases for Mobile Telephones and Telephone equipment.</p> <p>Class 14 Jewellery articles made of gold, sterling silver and other precious metals, with or without precious and semi-precious stones, namely; belt buckles, necklaces, chains, rings,</p>		<p>Class 9 Spectacle cases, cases for contact lenses; optical lenses, frames (mountings) for spectacles, spectacles, sunglasses, sports eyewear.</p> <p>Class 14 Items of jewellery including, rings, bracelets, chains, charms, necklaces, tie pins, cuff links, earrings, fancy key rings, ornamental pins; clocks, watch</p>

<p>earrings, pins, brooches and pendants, bracelets, cufflinks, tie bars, tie clips, tie pins and tie studs, collar and shirt studs, cuff links, medals, medallions, charms and boxes of precious metal. Horological and Chronometric instruments, watches and structural parts therefor, chronographs (watches), stopwatches, wristwatches, clocks, pendulums (clock and watch making), small clocks, straps for wristwatches, clasps for watches, dials for watches, watch cases, watch chains, movements for clocks and watches, cases for clock and watch making, jewellery cases, cases for watches, cases for cufflinks, novelty key rings, parts and fittings for all the aforesaid goods.</p> <p>Class 18 Animal skin, leather and imitation of animal skin and leather goods, namely; men's and women's handbags, trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddlery, luggage, bags and cases, travel bags, shooting sticks, briefcases, attache cases, document holders and cases, holdalls, pochettes, suit-carriers, credit card cases and holders, key cases, wallets, coin purses, passport holders, cheque book holders, travel organisers, satchels, holders, cuff link holders; leather key fobs; toiletry bags, rucksacks, sling bags; beach bags, shopping bags, shoulder bags, carrier bags, belt bags, pouches, suitcases, briefcases, school bags, purses, clutch and shoulder bags, sunshades, parts and fittings for all the aforesaid goods.</p> <p>Class 25 Clothing, footwear, headgear; boots; shoes; loafers; slippers; sandals; trainers; socks and hosiery; hats; caps; berets; scarves; gloves; mittens; belts</p>	<p>Class 18 Purses and handbags; credit card holders (leather and imitation of leather); wallets; key cases; vanity cases (sold empty); school bags; straps of leather; umbrellas; wallets; briefcases; beach bags, travelling bags, suitcases, attaché cases, rucksacks.</p> <p>Class 25 Clothing; leather and imitation leather clothing; coats; bathrobes; shoes, boots and slippers; short-sleeved shirts,</p>	<p>bands.</p> <p>Class 18 Purses and handbags; traveling sets (leather goods); key cases (leather goods); college satchels; straps of leather; umbrellas; wallets; attaché cases; beach bags, traveling bags, suitcases, business cases, rucksacks.</p> <p>Class 25 Clothing for gymnastics; leather and imitation leather clothing; coats; bath robes; footwear; short-sleeved shirts, shirts;</p>
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<p>(being articles of clothing); shirts; T-shirts; sports shirts; trousers; jeans; shorts; sports shorts; swimwear; underwear; lingerie; tracksuits; articles of outerwear; coats; jackets; ski jackets; waterproof and weatherproof clothing; ski wear; suits; jumpers; cardigans; knitwear; leggings; neckties; pyjamas; waistcoats; headbands and wristbands; leather and imitation of leather clothing; animal skin and imitation of animal skin clothing; menswear; womenswear; childrenswear; underclothing; clothing for men, women and children; slacks; skirts; wraps; jerseys; blouses; dresses; sleepwear; robes; sweatshirts; bibs; stockings; earmuffs; ties; tuxedos; vests; kilts; shawls; blazers; overalls.</p>	<p>shirts; headgear; overcoats; bathing suits; neckties, gloves (clothing), scarves; jackets; skirts; waterproof clothing; ready-made clothing; knitwear (clothing); underwear; hosiery; sweaters, trousers, pullovers; dresses; belts (clothing).</p> <p>Class 35 Retail services connected with the sale of cosmetics, cosmetic creams, essential oils, nail varnish, lotions for cosmetic purposes, beauty masks, cosmetic preparations for baths, sun-tanning preparations, make-up preparations, perfumery, lipsticks, cakes of soap, soaps, shampoos, room fragrancing products, deodorants for personal use, spectacle cases, containers for contact lenses, optical lenses, spectacle mountings (frames), spectacles, sunglasses, sports eyewear, helmets, electronic products namely telephones, mobiles, MP3 readers, MP4 readers, USB keys, CD readers, DVD readers, CD and DVD cases, computer and tablet cases, organizers, calculators, frames for digital photos, jewellery and costume jewellery, including rings, bracelets, chains, charms, necklaces, tie pins, cuff links, earrings, fancy key rings, ornamental pins, precious stones, clocks, watches, chronometric instruments, watch cases, watch bands, watch straps, purses and handbags, passport holders</p>	<p>headgear; overcoats; bathing suits; ties, scarves; jackets; skirts; raincoats; ready-made clothing; knitwear (clothing); hosiery; jerseys, trousers, pullovers; sandals, gym shoes, beach shoes; outerwear, dresses; clogs (footwear).</p>
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	(leather and imitation of leather), credit card holders (leather and imitation of leather), wallets, key cases, vanity cases (sold empty), school bags, straps of leather, umbrellas, briefcases, beach bags, travelling bags, suitcases, attaché cases, rucksacks, furniture, mirrors, picture frames, household or kitchen utensils and containers (not of precious metal or coated therewith), combs and sponges, brushes (except paint brushes), glassware, porcelain and earthenware, textiles and textile goods, curtains, household, table and bed linen, bath linen, clothing, leather and imitation leather clothing, coats, bathrobes, shoes, boots and slippers, short-sleeved shirts, shirts, headgear, overcoats, bathing suits, neckties, gloves (clothing), scarves, jackets, skirts, waterproof clothing, ready-made clothing, knitwear (clothing), underwear, hosiery, sweaters, trousers, pullovers, dresses, belts (clothing), carpets, rugs, mats and matting, linoleum and other materials for covering existing floors, wall hangings (non-textile).	
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27. It can be seen that the optical apparatus in class 9 in the application is effectively covered by the goods in class 9 in the opponent's IR EU 908720A. However, neither of the opponent's earlier marks covers the remaining class 9 goods of the application, namely:

'Telephones, Mobile Telephones, Smart Phones, Cameras, Tablets, PDAs and MP3 players. Covers, Shells, Fronts, Chargers, Lanyards or Chokers, Earphones, Bags and cases for Mobile Telephones and Telephone equipment.'

28. Although they are sometimes expressed in different terms, I find that the goods in class 14 in the application are covered by those listed in class 14 of the opponent's earlier IR EU, except for:

'Watches, stopwatches, wristwatches, pendulums (clock and watch making), clasps for watches, dials for watches, watch cases, movements for clocks and watches, cases for clock and watch making.'

29. Although they are sometimes expressed in different terms, I find that the goods in class 18 in the application are covered by those listed in class 18 of the earlier marks, except for:

‘Walking sticks, whips, harness and saddlery, shooting sticks, passport holders, cheque book holders, travel organisers, cuff link holders; leather key fobs; toiletry bags; sling bags; shopping bags, shoulder bags, carrier bags, belt bags, pouches; clutch and shoulder bags, sunshades, parasols.’

30. The applicant’s goods in class 25 are clothing, footwear and headgear and specific examples of such goods. The same general terms appear in the list of goods covered by the earlier marks. It follows that the goods in class 25 in the application are the same as the goods in class 25 in the earlier marks.

31. In its judgment in *Canon*<sup>16</sup>, the CJEU stated that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

32. The goods in class 9 covered by the application (broadly, electric communications devices) which are not identical to the goods in class 9 covered by the opponent’s IR EU (broadly, optical apparatus, particularly spectacles), do not appear to me to be similar goods. This is because:

- The respective goods are used for different purposes;
- They are different in nature;
- The methods of use are different;
- The goods are not in competition and they are not obviously complementary goods.

33. However, I note that the opponent’s earlier UK registration also covers:

‘Retail services connected with the sale of.....electronic products namely telephones, mobiles, MP3 readers, MP4 readers, USB keys, CD readers, DVD readers, CD and DVD cases, computer and tablet cases.’

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<sup>16</sup> Case C-39/97 at paragraph 23 of the judgment.

34. In *Oakley, Inc v OHIM*<sup>17</sup> the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and are therefore similar to a degree.

35. In *Tony Van Gulck v Wasabi Frog Ltd*<sup>18</sup> Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning the similarity of retail services and related goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

36. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*<sup>19</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>20</sup>, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*<sup>21</sup>, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;
- iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;

<sup>17</sup> Case T-116/06, at paragraphs 46-57

<sup>18</sup> Case BL O/391/14

<sup>19</sup> Case C-411/13P

<sup>20</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>21</sup> Case C-398/07P

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

37. It appears to me that the public would normally expect the goods listed at paragraph 27 above to be marketed by a retailer providing the services listed at paragraph 31 above. I therefore find that there is complementary relationship between these goods and services. On this basis I find that there is a low level of similarity between the goods and services in question, despite them being different in purpose, nature and method of use, and despite the fact that these goods and services are not in competition with one another.

38. As regards the non-identical goods in class 14 listed at paragraph 28 above, I find that 'watches, stopwatches, wristwatches, pendulums (clock and watch making)' are highly similar to 'clocks' and 'watch bands' covered by class 14 of the opponent's earlier IR EU. I find that 'clasps for watches, dials for watches, watch cases, movements for clocks and watches, cases for clock and watch making, cases for watches' are similar to a medium degree to 'clocks' and 'watch bands' covered by class 14 of the opponent's earlier IR EU. For the reasons given in paragraph 37 above, I find that all the aforementioned goods in the application are also similar to a low degree to 'retail services connected with the sale of.... clocks, watches, chronometric instruments, watch cases, watch bands, watch straps' in class 35 of the opponent's earlier UK mark. I find that 'jewellery cases' and 'cases for cufflinks' in class 14 of the application is highly similar to 'items of jewellery' and 'cuff links' covered by class 14 of the opponent's earlier IR EU.

39. I find that 'walking sticks, whips, harness and saddlery, shooting sticks,' in class 18 of the application are not similar to any of the goods or services covered by the earlier marks because they are different in purpose, nature (except at a relatively high level of generality as leather goods), method of use, and they are not in competition or complementary to any of the goods/services covered by the opponent's earlier marks.

40. I find that 'sunshades, parasols' in class 18 of the application are similar to a low degree to 'umbrellas' in class 18 in the opponent's earlier marks. This is because the respective goods are similar in nature and method of use, but different in purpose and not in competition with one another or complementary goods.

41. I find that 'passport holders, cheque book holders, travel organisers, cuff link holders; leather key fobs' in class 18 of the application are highly similar to 'credit card holders (leather and imitation of leather); wallets; key cases' and 'traveling sets (leather goods)' in class 18 covered by the opponent's earlier marks. This is because

they are all small leather goods for use in travel. Similarly, I find that ‘toiletory bags; sling bags; shopping bags, shoulder bags, carrier bags, belt bags, pouches; clutch and shoulder bags’ in class 18 of the application are highly similar to ‘hand bags, vanity cases (sold empty); school bags; briefcases; beach bags, travelling bags, business cases, rucksacks’ in class 18 of the opponent’s earlier marks. This is because they are all bags which may be made of similar materials and sold in the same places to the same type of customers. Indeed, some of them could be alternative descriptions of the same product, e.g. shopping bags/hand bags, toiletory bags/travelling bags. Others are obviously complementary and could be members of the same product range, e.g. hand bags/shoulder bags.

### **Comparison of marks**

42. The visual and aural similarities and differences between the marks BILLIONAIRE and TRILLIONAIRE are obvious. Generally, similarities or differences at the beginnings of marks are given particular importance when it comes to assessing how similar they are<sup>22</sup>. However, this is no more than a rule of thumb<sup>23</sup>. The visual and aural impacts of the difference between the first two letters of these marks are partly offset by the identity of the last nine letters and the quite long length of the words. In my view, there is a medium degree of visual and aural similarity between the marks.

43. The degree to which the marks are conceptually similar is a point of disagreement between the parties. The opponent submits that the words in question both describe a person of extreme wealth and that they are therefore highly similar from a conceptual perspective. The applicant puts more emphasis on the difference in scale between a billionaire and trillionaire and therefore argues that there is only a low degree of conceptual similarity between the marks. The degree of conceptual similarity between two words is a relative matter. If one considers the meaning of these words against just the words that could be used to describe a person of extreme wealth, then the difference between the meanings of billionaire and trillionaire seems quite significant. But if one is considering the relative degree of conceptual similarity between these words compared to the meanings of every word in the English language (which are, in principle, all available for use as trade marks), the degree of conceptual similarity between billionaire and trillionaire appears high. Much more so than (say) between the well known trade marks Blackberry and Apple, which might also be said to share some conceptual similarity because they describe types of fruit. I therefore accept that the difference between a billion and a trillion is very significant when those words are used as a monetary description. However, in the context of their use as trade marks, the specific monetary meaning of BILLIONAIRE and TRILLIONAIRE creates less of a conceptual difference than the

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<sup>22</sup> See, for example, *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, General Court of the EU

<sup>23</sup> *CureVac GmbH v OHIM*, Case T-80/08, General Court of the EU

strong conceptual similarity created by the use of two words that both describe a person of extreme wealth. I therefore find that there is a high degree of conceptual similarity between the marks.

44. Overall I find that there is a medium to high level of similarity between the marks.

#### **Average consumer and the purchasing act**

45. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question<sup>24</sup>.

46. Mr Ahmed submitted that the high price of the opponent's goods means that the relevant public would pay a high degree of attention when purchasing their goods/services and this eliminates any likelihood of confusion with the goods proposed to be sold under the opposed mark. However, as I have explained above, the opponent's marks are entitled to protection across all market segments for the goods/services for which they are registered and protected. Similarly, I must consider all notional and fair uses of the applicant's mark. The targeting of different segments of the market for the same or similar goods is therefore irrelevant as a matter of law<sup>25</sup>.

47. I find that the relevant public is composed of the general public who will pay an average level of attention when selecting the types of goods covered by the application.

#### **Distinctive character of earlier mark**

48. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>26</sup>, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services 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 (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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<sup>24</sup> *Lloyd Schuhfabrik Meyer, CJEU, Case C-342/97*

<sup>25</sup> See also *Bang & Olufsen A/S v OHIM*, Case T-460/05, where the General Court of the EU held that the different price points of the goods at issue is irrelevant for the purposes of opposition proceedings because it depends only on the (current) will of the parties.

<sup>26</sup> Case C-342/97

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

49. The earlier marks are not descriptive of the goods or services for which they are registered/protected. On the other hand they are ordinary dictionary words (as opposed to made up words such as KODAK which are inherently highly distinctive). I therefore find that the opponent’s marks have a normal degree of inherent distinctiveness.

50. The opponent claims that the distinctiveness of the BILLIONAIRE marks has been increased further through the extensive use of the marks. I do not accept this because:

- i) The opponent’s use of the mark in the UK is relatively short in length, only starting in 2009;
- ii) Although the monetary value of the opponent’s sales seem quite high, it is likely to represent only a small share of the relevant markets;
- iii) The high cost of the opponent’s goods means that the number of items actually sold is likely to be relatively modest;
- iv) The opponent’s goods appear to be sold through only two UK outlets, both of which are located in London;
- v) Although it is possible for the reputation and distinctiveness of a trade mark for high end goods to be much greater than would appear from just looking at the volume of sales, e.g. ROLEX, this generally requires a very high level of promotional activity over a long period of time. The opponent’s promotion of BILLIONAIRE is over a relatively short period and the amount spent promoting the brand in the UK appears relatively modest.
- vi) The opponent’s marks are often used as part of the composite marks BILLIONAIRE ITALIAN COUTURE and BILLIONAIRE COUTURE. Although ‘Italian’ and ‘Couture’ are descriptive of the goods/services covered by the earlier marks (to various degrees in the case of Couture), it is not clear from

the evidence the extent to which the word BILLIONAIRE alone has become more distinctive of the opponent.

### **Likelihood of confusion**

51. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

52. Some similarity of goods/services is necessary in order to sustain an opposition under s.5(2)(b)<sup>27</sup>. Consequently, as I have found that none of the goods/services covered by the opponent's marks are similar to 'walking sticks, whips, harness and saddlery, shooting sticks', it follows that the opposition under s.5(2)(b) fails for these goods.

53. Where the goods/services are identical, highly similar or similar to a medium degree, I find that the medium to high level of similarity between the marks, combined with the normal degree of distinctiveness of the earlier mark, is sufficient to create a likelihood of confusion amongst average consumers paying a normal level of attention when selecting the applicant's goods.

54. In particular, allowance must be made for the fact that such consumers will not necessarily be comparing the marks side by side. In my view, it is likely that average consumers will imperfectly recollect BILLIONAIRE and thereby confuse it with TRILLIONAIRE (or vice versa). Further, even if there is no such direct confusion between the marks, there is likelihood that the public will regard the TRILLIONAIRE mark as a variant on, or updated version of, the earlier marks and mistakenly believe that the marks are used by the same undertaking, or by economically related undertakings.

55. I have considered Mr Ahmed's arguments as to why neither is likely. Most of the arguments are based on factors I have found to be irrelevant. The only relevant additional factor identified by Mr Ahmed is the presence on the UK market of the trade mark BILLIONAIRE'S BOYS CLUB, which is said to already co-exist with the opponent's marks. However, the applicant has filed no evidence to show such co-

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<sup>27</sup> *Waterford Wedgwood plc v OHIM, Case C-398/07P, CJEU*

existence (or the scale of the use of BILLIONAIRE BOYS CLUB in the UK, or to what extent the goods/services sold under the marks overlap). In the absence of any concrete evidence to support the assertion of such co-existence, I am unable to attach any weight to Mr Ahmed's claim that this means that there is also room on the register for his TRILLIONAIRE mark, without a risk of causing confusion. For the avoidance of doubt, this should not be understood as meaning that the opposition would necessarily have failed if such evidence had been filed.

56. Where the similarity between the goods in the application and the goods and services covered by the opponent's marks is low, as is the case with:

'Telephones, Mobile Telephones, Smart Phones, Cameras, Tablets, PDAs and MP3 players. Covers, Shells, Fronts, Chargers, Lanyards or Chokers, Earphones, Bags and cases for Mobile Telephones and Telephone equipment' in class 9

And:

'Sunshades, parasols' in class 18

I find that there is no likelihood of confusion.

57. The likelihood of confusion through imperfect recollection of the earlier marks, or indirect confusion through association, is less when one is considering goods on the one hand, and retail services on the other. In this case I find that the differences between BILLIONAIRE and TRILLIONAIRE are likely to be sufficient to avoid a likelihood of confusion. Similarly I find that, even allowing for imperfect recollection, it is unlikely that an average consumer paying a normal degree of attention is likely to confuse a TRILLIONAIRE parasol or sunshade with a BILLIONAIRE umbrella, or that such a consumer may believe that the users of such marks for such goods may be economically connected.

58. The opposition under s.5(2)(b) therefore succeeds, except in relation to:

Class 9

Telephones, Mobile Telephones, Smart Phones, Cameras, Tablets, PDAs and MP3 players. Covers, Shells, Fronts, Chargers, Lanyards or Chokers, Earphones, Bags and cases for Mobile Telephones and Telephone equipment.

Class 18

Walking sticks, whips, harness and saddlery, shooting sticks; sunshades, parasols.

## The s.5(3) ground of opposition

59. Section 5(3) is as follows:

(3) A trade mark which-  
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

60. As the opposition under s.5(2)(b) has succeeded against most of the goods covered by the application, I will only consider this ground of opposition in relation to the goods shown at paragraph 58 above.

61. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

62. The opponent's BILLIONAIRE marks have been used, but for the reasons given at paragraph 50 above it is not clear to me whether the opponent's mark was known to "a significant part of the relevant public" in the UK or, in the case of the IR EU, to a significant part of the relevant public in the EU. As the onus is on the opponent to show that its marks have a qualifying reputation, I find that the opposition under s.5(3) falls at the first hurdle because the opponent has not established that the earlier marks have the necessary reputation.

62. I acknowledge that there is room for argument about whether that finding is correct, particularly with regard to the reputation of BILLIONAIRE for clothing. I will therefore also consider whether the public will make the necessary link between the marks for the purposes of the s.5(3) ground, assuming that the BILLIONAIRE marks have the claimed reputation for clothing, footwear, bags and jewellery. My

assessment must take account of all relevant factors. The factors identified in *Intel* are:

**The degree of similarity between the conflicting marks**

The degree of similarity between the marks is medium to high for the reasons explained above.

**The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public**

The goods for which the opponent's marks are claimed to have a reputation are for wear on the person or (in the case of bags in class 18) goods with aesthetic and functional purposes. The goods of the application under consideration here are electronic communications apparatus, walking sticks, horse riding apparatus and sunshades/parasols. Even taking into account that mobile phones may be considered by some to be fashion accessories, I find that there is little or no similarity between the respective goods. All of the goods at issue are aimed at the general public. Therefore there is bound to be an overlap between the relevant public for the parties' goods.

**The strength of the earlier mark's reputation**

At most, the opponent's mark has a modest reputation in the UK and EU for clothing and maybe a small reputation for jewellery and bags.

**The degree of the earlier mark's distinctive character, whether inherent or acquired through use**

The earlier mark is inherently distinctive to a normal degree. For the reasons given at paragraph 50 above, it is not possible to say that the opponent's BILLIONAIRE marks have become more highly distinctive through use in the UK (or the EU).

**The existence of the likelihood of confusion on the part of the public**

I have found that there is no likelihood of confusion on the part of the public if the parties' marks are used in relation to the goods under consideration for the purposes of this ground of opposition.

63. Taking all relevant factors into account, I find that the public will not make the necessary mental link between the marks at issue. I have carefully considered whether that is correct in relation to mobile phones and similar goods in class 9 in the application, which like the goods for which the opponent claims that its marks

have a reputation, may fall into the same broad general category of ‘fashion goods’, but even here I find that the difference between the nature and purpose of the respective goods is such that the public will not be caused to make any link between the marks BILLIONAIRE for clothing, footwear, bags and jewellery and TRILLIONAIRE for mobile phones etc.

64. In the absence of such a link it follows that there will be no detriment to the earlier mark or unfair advantage to the applicant’s mark as a result of the use of the latter in relation to the goods listed at paragraph 58 above.

65. The s.5(3) ground therefore adds nothing to the ground of opposition under s.5(2)(b).

### **The s.5(4)(a) ground of opposition**

66. It is well established that passing off is dependent on the existence of goodwill, deception and damage. I am prepared to accept that the opponent had established goodwill in the UK under the mark BILLIONAIRE at the relevant date of 17<sup>th</sup> April October 2014 as a result of a trade in clothing, footwear, bags and jewellery.

67. Again there is no need to consider the consequences of this, except in relation to the goods listed at paragraph 58 above which have survived the s.5(2)(b) ground of opposition.

68. The test for misrepresentation was stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.*<sup>28</sup>. Adapted to the matter in hand, the question is:

“is it, on a balance of probabilities, likely that, [use of the applicant’s mark will mean that] a substantial number of members of the public will be misled into purchasing the [applicant’s goods] in the belief that [they are the opponent’s goods]”.

68. For essentially the same reasons given in relation to the s.5(3) ground of opposition, I find that it is unlikely that a substantial number of members of the public will be misled by the applicant’s use of TRILLIONAIRE in relation to the goods listed at paragraph 58 above<sup>29</sup>. Consequently, the passing off right ground adds nothing to the ground of opposition under s.5(2)(b).

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<sup>28</sup> [1990] R.P.C. 341 at page 407

<sup>29</sup> Cogent evidence of misrepresentation and damage is required when the parties are assessed to be in different fields of commercial activity: *Stringfellow and Anr. v McCain Foods (G.B.) Limited and Another* [1984] RPC 501

## Post hearing amendment of the application

69. After the hearing the applicant made an application to amend his list of goods in classes 14, 18 and 25. The proposed new list of goods in these classes is as follows:

Gold, silver, platinum, precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious or semi-precious stones, diamonds, pearls, rings, earrings, medals, belt buckles, cuff links, timepiece products; watches, wrist watches, horological and chronometric instruments in class 14.

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; toiletry bags, shoulder bags, backpacks, messenger bags, tote bags, handbags, shopping bags, clutch and shoulder bags, attache-cases, briefcases, document holders and cases, pouches, wallets, purses, travel organisers, card holders and cases, sunshades, umbrellas, parasoles and walking sticks; whips, harness and saddler.

Clothing, Footwear, Headgear.

70. The relevant part of s.39 of the Act states:

“39. - (1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.  
If the application has been published, the withdrawal or restriction shall also be published.

(2) –

and then only where the correction does not.....extend the goods or services covered by the application.”

71. The proposed new list of goods in classes 14 and 18 appear to extend the goods covered by the application. This is because the general wording at the beginning of the present list of goods in those classes is qualified by the following word “*namely,...*”. The effect of this is that the current application only covers the list of goods that follow that word. By contrast, the general descriptions of goods at the beginning of the amended list in classes 14 and 18 are not so limited. Therefore the amendment in classes 14 and 18 appears to be contrary to s.39.

72. The proposed amendment in class 25 appears to be a reduction in the list of goods. It certainly reduces the length of the list. However, as the three general descriptions left cover all the specific goods that follow those same descriptions in the current list, the amendment has no substantive effect on the list of goods covered by class 25 of the application.

73. I conclude that the proposed amendment has no bearing on the outcome of the opposition

## **Outcome**

74. The opposition succeeds except in relation to the goods listed at paragraph 58 above.

## **Costs**

75. The opponent has been mostly successful and is entitled to a contribution towards its costs. In the circumstances I order Mr Tausif Ahmed to pay Billionaire Trademarks B.V. the sum of £1200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Filing the notice of opposition and considering the counterstatement - £500

Filing evidence and considering the applicant's evidence - £700

76. The above sum should be paid within 14 days of the expiry of the appeal period or (if an appeal is filed, but does not result in this decision being varied or set aside) within 14 days of this decision becoming final.

**Dated this 22<sup>nd</sup> day of July 2015**

**Allan James  
For the Registrar**