

O-358-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2462925
BY MR DAVID HALEWOOD AND MRS ANNE-LYDIA HALEWOOD TO
REGISTER THE TRADE MARK**

ICE SCREAM

IN CLASS 25

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 96289
BY GILMAR S.P.A.**

TRADE MARKS ACT 1994

**IN THE MATTER OF application no 2462925
by Mr David Halewood and Mrs Anne-Lydia Halewood to register the trade
mark:**

ICE SCREAM

and

**IN THE MATTER OF opposition thereto under no 96289
by Gilmar S.p.A.**

BACKGROUND

1) On 1st August 2007, Mr David Halewood and Mrs Anne-Lydia Halewood (“the Halewoods”), c/o Lewis Silkin LLP, 5 Chancery Lane, Clifford’s Inn, London EC4A 1BL applied under the Trade Marks Act 1994 (“the Act”) for registration of the trade mark “ICE SCREAM” in respect of the following goods and services:

Class 25: Clothing, footwear, headgear.

2) On 15th February 2008, Gilmar S.p.A. (“Gilmar”) of Via Malpasso 723/725, 47048, Italy filed notice of opposition to the application. The grounds of opposition are summarised as follows, namely:

- a) registration of the application would offend under Section 5(2) (b) of the Act. Gilmar claims that the Halewood’s trade mark is similar to its earlier mark and is for identical or similar goods. Gilmar relies upon the following earlier mark:

Mark and filing date	Goods and services covered (or goods and services relied upon if narrower)	Goods and services being opposed
1175324 20 May 1982 	<i>Class 25: Articles of clothing; but not including footwear other than woven or knitted footwear.</i>	All of the Class 25 goods.

- b) Gilmar also claims that it has used the mark “ICE” alone and other marks starting with the word “ICE” in the UK in relation to a wide range of clothing and fashion accessories since 2000. On the basis of this use,

Gilmar claims that registration of the Halewood's mark would be contrary to Section 5(4) (a) in respect of all of the goods in class 25.

3) The Halewood's subsequently filed a counterstatement on 21st May 2008, denying Gilmar's claims and requesting Gilmar to provide proof of use in respect of all goods and services for which the earlier mark was registered.

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Gilmar provided written submissions; neither party requested to be heard, and after careful consideration of the papers I give the following decision.

Opponent's Evidence

5) Gilmar's evidence is in the form of two witness statements. These are by Sarah Kate Széll, a partner with Venner Shipley LLP, representatives of Gilmar. Prior to this, she was a partner with Lloyd Wise who represented Gilmar in earlier opposition no. 93015 against application 2358107 PINK ICE ("the PINK ICE opposition").

6) At Exhibit SKS1, Ms Széll provides a witness statement and accompanying exhibits by Silvano Gerani, President of Gilmar. Mr Gerani's statement dated 5th September 2005 was prepared and filed in respect of the earlier PINK ICE opposition and details the use made of ICEBERG and other ICE marks at that time. This was summarised by the hearing officer at that time. That summary is provided as an annex to this decision and I adopt it insofar as it is relevant to the current proceedings. It is worth mentioning that this evidence has been recycled in several cases and criticised for its poor quality, lack of clarity and pagination, see eg before the Appointed Person in an opposition against Gilmar's own mark, ICE B, Case BL O-284-09 (para 7).

7) The second witness statement is also by Ms Széll, to which she exhibits at SKS2 a copy of a witness statement dated 5th November 2008 by Massimo Marani, the Chief Financial Officer of Gilmar since 1994. The witness statement dated 5th November 2008 by Mr Marani had been filed in oppositions 96661, 96673 and 96920. He states that since Mr Gerani made his statement in September 2005, Gilmar's range of marks containing the word ICE has expanded to include, not only ICEBERG and ICE JEANS, but other ICE marks such as ICE ICE ICEBERG, ICE J and ICE B. The annual turnover (in Euros) for the years 2006 and 2007 in the UK for goods sold under the various ICE marks is provided as follows:

Lines	2006 (Euros)	2007 (Euros)
Iceberg		
Wear	267, 869.00	185, 514.00
Accessories	25, 294.00	19, 354.00
Total	293, 163.00	204, 868.00
ICE Lines		
Wear	981, 197.00	473, 688.00
Accessories	77, 923.00	40, 213.00
Total	1,059,120.00	513, 901.00

8) Beyond these figures however, Mr Marani provides no further, corroborative examples of actual use during 2006-2007 of either the ICEBERG brand or any of the 'ICE' brands which are conflated in the table above under the designation 'ICE Lines'.

Applicant's Evidence

9) This takes the form of a witness statement dated 23rd March 2009 by Dominic Farnsworth who is a partner of Lewis Silkin LLP, attorneys acting for the Halewoods. He provides Exhibits DF1 and DF2 which are, respectively, a screenprint and the results of a search on the SAEGIS™ database of "ICE" marks in class 25 of the UK, Community and International databases. The total comes to 75 and these are all listed in DF2. The remainder of his evidence constitutes critique of Gilmar's evidence and I shall deal with this in due course.

Opponent's Evidence in reply

10) This takes the form of a witness statement dated 18th June 2009 by Massimo Marani. He says that his company vigorously defends its trade marks and has taken action against a large number of the marks revealed in Mr Farnsworth's search. A summary of that action is provided.

DECISION

Proof of use

11) The Trade Marks (Proof of Use, etc) Regulations 2004 apply in respect to the Section 5(2) (b) grounds of this case. The provision reads as follows:

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

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) 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, ...

...

(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...”

12) The requirements for “genuine use” have been set out by the European Court of Justice (“ECJ”) in its judgment in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 (“*Ansul*”) and in its reasoned Order in Case C-259/02, *La Mer Technology Inc. v Laboratoires Goemar S.A.* [2005] ETMR 114 (“*La Mer*”).

13) In *Ansul*, the ECJ held as follows:

“35. ... ‘Genuine use’ therefore means actual use of the mark....

36. ‘Genuine use’ must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user...

37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of its enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns...

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

14) In *La Mer* the ECJ also held:

21. ... it is clear from paragraph [39] of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case by case assessment which it is for the national court to carry out....

...

25. In those circumstances it is not possible to determine *a priori*, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down.

15) Gilmar relies on just one earlier registered right which plainly qualifies as an earlier mark as defined by Section 6 of the Act. This mark was registered on 22nd February 1984, which predates by more than five years the publication of the Halewood's mark, namely 16th November 2007, and as such the proof of use provision applies.

16) The evidence by Mr Gerani (as filed in the PINK ICE opposition case and summarised in the annex to this decision) provides instances of ICEBERG being used in normal and stylised script. There is no use shown in the form as registered in 1175324. In this registration the word ICEBERG appears inside a simple line drawing of a "lozenge shape". It is established case law that to qualify as genuine, use of a mark must be in the form registered or in a form which does not alter the distinctive character of the mark in the form in which it is registered. The leading English authority on the issue is the Court of Appeal decision in *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25. This dealt with genuine use within the context of interpreting Section 46(2) of the Act, but is equally applicable here. More recently, the same issue has been considered by both the Court of First Instance ("CFI") and the ECJ. These cases have been reviewed by Richard Arnold QC, sitting as Appointed Person, in *NIRVANA Trade Mark* (BL O/262/06) and *REMUS Trade Mark* (BL O/061/08). He summarised his review in *NIRVANA* (and reiterated it in *REMUS*) in the following way:

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

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

second question does not depend upon the average consumer not registering the differences at all...”

17) The distinctive character of the registered mark is, overwhelmingly, the word ICEBERG and the difference between this registered mark and the form used is the absence of the lozenge shaped line border and absence of the minimal stylisation of the letters. Applying the guidance of the Courts, it is my view that these differences will not alter the distinctive character of the registered marks. The use therefore satisfies the requirements set out in Section 6A(4)(a) of the Act.

18) Next, I must consider the scope of goods that genuine use has been shown within the relevant date, that is, use as between the dates 16th November 2002 and 16th November 2007. There are exhibits from Mr Gerani’s witness statement of September 2005, filed in the PINK ICE opposition, eg:

- Exhibit 1 in relation to invoices to retailers from 2003 which use the designations:- HISTORY ICEBERG UOMO (invoice of 20th February 2003 to LINEA OF HAMPSTEAD in respect of sweaters, invoice of 25th July 2003 to REPORT CLOTHING of London in respect of sweaters, sweat shirts, t-shirts, jeans and knitted caps and invoice of 19th November 2003 to PROHIBITION UK LTD of London in respect of sweaters, gilets and sports jackets); HISTORY ICEBERG DONNA (invoice of 19th November 2003 to PROHIBITION UK LTD of London in respect of sweaters) and ICEBERG UOMO (invoice of 20th February 2003 to LINEA OF HAMPSTEAD in respect of sweaters, t-shirts and shirts);

- Exhibit 3 which (although undated) shows use of ICEBERG displayed prominently on womens’ anoraks and both mens’ and womens’ t-shirts;

- Exhibit 10 in relation to catalogues for Autumn/Winter 2002/2003 and Spring/Summer 2003. The mark ICEBERG is sometimes used alongside ICE JEANS but as an independent element in these catalogues. There is also use alone, as in “ICEBERG: The Movie” and “ICEBERG THE TOUR”;

- Exhibit 12 in relation to advertising in FASHION and ESQUIRE magazines, both published in late 2002 which shows use of the mark ICEBERG;

- Exhibit 13 which is an assortment of editorial advertising appearing in, eg DAZED AND CONFUSED, ELLE , THE FACE, MAXIM, ARENA HOMME, I-D, MARIE CLAIRE, VOGUE, GQ, LOADED, HARPERS AND QUEEN, all taken from the period 1st February 2003 – 1st October 2004;

which all show, during the relevant period, genuine use of the mark ICEBERG, either alone, or (independently) with other designations (mostly ICE JEANS). As

far as the marks: HISTORY ICEBERG UOMO, HISTORY ICEBERG DONNA, and ICEBERG UOMO on the invoices are concerned, I am prepared to conclude that either goods were either sold under the ICEBERG name, or that alternatively, if sold under the name on the invoice, that ICEBERG nonetheless constitutes a separate and independently distinctive element within the totalities. Such a conclusion is based both on the fact that a predominantly English-speaking consumer will be unable to make sense of the longer phrases and therefore separate the words. Moreover in any event, the use of such terms on invoices does not mean that the goods are sold to the end consumer under the same designations. When the evidence of the invoices is seen in the context of the other evidence of genuine use from Mr Gerani, I think it more than likely that only the mark ICEBERG would have appeared on the goods. I may just add that if I am found to be wrong on this point, there is the other use of the word ICEBERG to which I have drawn attention, and such a finding does not materially affect my overall conclusion in respect of genuine use.

19) The years 2006-2007 are covered by Mr Marani's later witness statement, but only in broad terms relating to UK sales of ICEBERG and "ICE" products. As I have said in para 8 above, Mr Marani has not supplemented or corroborated these sales figures with actual exhibits of the mark ICEBERG in use, and as such adds little to the evidence of Mr Gerani in the context of deciding for what exactly genuine use has been shown.

20) I have not found genuine use on "*woven or knitted footwear*", claimed in the specification of the earlier mark. I am assuming that the description used is another way of saying 'socks' or 'soft- slipper' style footwear. I have not found any use on such items. I have not found any use on *headgear* at large, but there are invoices to a company called REPORT CLOTHING of London dated 20th February 2003 and 25th July 2003, which refers to 'caps' and 'knitted caps', listed under the name HISTORY ICEBERG UOMO.

21) I must now consider what would be a 'fair specification', reflecting the goods in respect of which genuine use has been shown. The starting point for a fair specification must be Gilmar's original specification which I cannot expand in any way. In this regard, even though I have found use of ICEBERG on, eg footwear, and accessories like belts or bags, it is not open to me to include such items within the scope of a fair specification. This is because footwear is expressly excluded (except for woven or knitted footwear) by Gilmar, and accessories are not included in the original specification.

22) Taking account of the case law provided by *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03* and *Animal Trade Mark* [2004] FSR 19, clothing is readily and often sub-divided between outer clothing and under clothing. These two terms represent clearly definable sections of the trade and the goods.

Consequently, an appropriate specification for the goods of registration no 1175324, which includes also other specific items for which I have found use in the evidence, is:

articles of outer clothing; womens' swimwear; caps; jeans, t-shirts and shirts, vests, pullovers, jumpers, outer-coats.

Section 5(2) (b)

23) Section 5(2) (b) reads:

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

(a) ...

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

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

24) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

Comparison of goods

25) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23:

‘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.’

26) Other factors may also be taken into account such as, for example, the trade channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281)

27) Taking account of my finding in respect of genuine use, the goods to be compared are listed below:

Gilmar’s relevant goods	The Halewood’s goods
<i>articles of outer clothing; womens’ swimwear; caps; jeans, t-shirts and shirts, vests, pullovers, jumpers, outer-coats.</i>	<i>Clothing, footwear and headgear</i>

28) In the case of *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 133/05 (“Meric”)* it is said at para 29 that:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

29) Applying this guidance in respect to this case, I find that the terms “clothing” and “headgear” in the Halewood’s application are identical to Gilmar’s “articles of outer-clothing ” and “caps”. “Footwear” in the Halewood’s application is highly similar to “articles of outer-clothing” in Gilmar’s relevant goods. That is to say that the nature and intended purpose of these respective items is the same, namely to be worn and to functionally protect the body from the elements and/or to be worn as fashion items. As such the users also are the same. Footwear may (but admittedly not necessarily) also contribute to an ‘overall look’ and as such, aesthetically complement other items of clothing. Reference is made in this regard to the discussion in, eg CFI cases of *SERGIO ROSSI (Case T-169/03) [2005] ECR II 685*, and *EL CORTE INGLES SA (Case T-443/05)* which, whilst not concerning footwear as such, nonetheless discuss how clothing and accessories can contribute to an overall look. Moreover, in terms of channels of trade, in many retail outlets (admittedly, only one of the channels of trade) footwear is sold alongside clothing.

The average consumer

30) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, para 23) it is important that I assess who the average consumer is for the goods and services at issue. In respect to “clothing” and “headgear”, I found identity, and it follows that the consumers of both parties’ goods are identical in respect of these goods.

31) These goods are ordinary consumer items and it follows that the respective consumers are the general public. The purchasing act will involve a reasonable degree of care and attention, but not the highest degree of attention that is associated with more specialised goods.

32) In relation to footwear, I have found this to be highly similar to articles of outer- clothing. The same finding in respect to the average consumer will be true; the respective consumers will be drawn from the same pool as clothing at large, namely the general public. Likewise the purchasing act will require a reasonable degree of care, but not the highest degree of attention.

33) I am also mindful of the comments of the CFI in cases such as *Société provençale d’achat and de gestion (SPAG) SA v OHIM Case T-57/03* and *React Trade Mark [2000] RPC 285*, as regards the nature of the purchasing act, to the effect that bearing in mind the manner in which clothing goods will normally be purchased, it is the visual impression of the marks that can be the most important. This would normally be from a clothes rail, a catalogue or a web-site, rather than by oral request. These cases do not however provide any authority for ignoring the role that aural considerations may play in the purchasing act.

Comparison of marks

34) The respective marks are:

Opponent's trade mark	Applicant's trade mark
	ICE SCREAM

35) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). Beginning with the visual comparison, the respective marks begin with the syllable/word ICE. This is the extent of the visual similarity as all other components of all the respective marks are different. Gilmar's marks have the second, conjoined element BERG and the overall impression is that of a single word. The Halewood's mark has a second word SCREAM, plainly conveying the visual impression of two separate words. Gilmar's stylised mark also includes a line border in a lozenge shape which is absent in the Halewood's mark. Noting the similarity and the differences between the marks, I find that only a low level of visual similarity exists between the respective marks.

36) From an aural perspective, the respective marks share the same letters ICE (pronounced as AYE-SS), but differ in that the second syllable in Gilmar's mark is BERG whereas the second word in the Halewood's mark is SCREAM. The Halewood's mark will be pronounced in virtually the same way as ICE CREAM. That is to say that in normal speech the two expressions will be virtually indistinguishable; only if the speaker opts to emphasise the letter 'S' at the beginning of the second word to make it clear that it is not CREAM, will a difference be evident. Whether or not the listener picks up the difference, it is manifestly a markedly different pronunciation than ICEBERG. Taking these similarities and differences into account, I find the respective marks share only a low level of aural similarity.

37) In respect of the conceptual comparison, ICEBERG has an ordinary meaning in the minds of the consumer, namely "a large mass of ice floating in the sea"¹. If the consumer identifies that the Halewood's mark is not, in fact, ICE CREAM, then the conceptual identity behind the Halewood's mark will present itself as a combination of two completely unrelated words, ICE and SCREAM. These words together have no obvious conceptual meaning; there is simply no such thing as an "ice scream". However, I consider it highly probable that the combination will be seen by the average consumer to be derived from, be a play on, or in some other way related to ICE CREAM – being a "semi-soft frozen

¹ The Concise Oxford English Dictionary, www.oxfordreference.com

dessert made from sweetened and flavoured milk fat”². Whether or not the consumer makes such a linkage to ICE CREAM (which is not necessarily inevitable), the only finding possible in this case is that there is no conceptual similarity as between the Halewood’s mark and Gilmar’s.

38) Taking the visual, aural and conceptual elements overall, I conclude that the respective marks share only a very low level of similarity.

Distinctive character of the earlier trade mark

39) I have to consider whether Gilmar’s mark has a particularly distinctive character, either arising from its inherent characteristics or because of the use made of it. It consists of, or essentially of, the word ICEBERG. This has a clear meaning in English, as already identified above, but in respect of the relevant goods the word has no connection. As such, the mark enjoys a high degree of inherent distinctive character.

40) I must also consider the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act. This was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at para 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be

² The Concise Oxford English Dictionary, www.oxfordreference.com

alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

41) Here I must assess the impact of use upon the earlier mark, as registered. The evidence illustrates that ICEBERG has been used in respect of those items of clothing I have already listed. The scale of this use is small when considered in the context of these clothing markets as a whole. Whilst no evidence is provided regarding the size of this market or Gilmar’s market share, I believe my conclusion is well founded in light of the visibly huge scale of the industry in the UK.

42) In conclusion, I find that the already high degree of inherent distinctive character is not enhanced to any significant extent as a result of any use of the marks.

State of the register evidence

43) Mr Farnsworth identifies a number of other Community and International trade mark applications/registrations in support of his argument that there are a number of other ICE marks, in the names of third parties, on the trade mark register. In response, Mr Marani submitted counter-arguments. I do not intend to address these further here, other than to refer to the CFI case T-135/04, *GfK AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*:

“68 ..., the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. ...”

44) Similarly, in the current proceedings, proof of the mere existence of other earlier marks containing the word ICE does not progress the Halewood’s case.

Likelihood of confusion

45) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly, with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

46) My assessment is based upon notional and fair use of the respective marks and in respect of the relevant goods.

47) In this assessment, I found that the earlier mark has a high level of inherent distinctive character and that this distinctive character is not enhanced further through use; that there is identity in respect of all clothing and headgear, and high similarity with footwear. I also acknowledged that the average consumer is the same for many of these goods. In respect of the marks themselves, I found that they share a low level of visual similarity, a low level of aural similarity and no conceptual similarity. Overall I found only a very low level of similarity as between the marks themselves. In considering these findings and their collective impact upon the likelihood of confusion, I am mindful of the comments of the ECJ, regarding the weight to be given to conceptual differences, in *Claude ruiz-Picasso et al v OHIM (PICASSO) C-361/04 P*, it commented:

“20. ...where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them...

21. ...such a finding is, in this case, entirely part of the process designed to ascertain the overall impression given by those signs and to make a global assessment of the likelihood of confusion between them”

48) I am also mindful of, and have already mentioned, the comments of the CFI in cases such as *Société provençale d'achat and de gestion (SPAG) SA v OHIM Case T-57/03* and *React Trade Mark [2000] RPC 285*, where guidance is provided that, bearing in mind the manner in which clothing goods will normally be purchased, it is the visual impression of the marks that can be the most important. This would normally be from a clothes rail, a catalogue or a web-site, rather than by oral request.

49) Notwithstanding this, it is important to bear in mind that neither the *PICASSO* case, nor the other cases to which I have referred above in para 48 provides authority for *either* the proposition that conceptual differences are determinative, *or* that in the case of clothing, visual selection and comparison dominates over aural and conceptual comparisons (see eg, para 21 and following of the opposition in respect of the mark *TECHNICALS* in *BL O-131-09* before the Appointed Person). Rather, all these cases reflect, in each of their individual circumstances, what factors may have, in the minds of the respective decision makers, particular importance *in the overall assessment of likelihood of confusion*.

50) Taking *all* factors into account and giving due notice to the fact that the purchasing act for the relevant goods may involve a reasonable degree of care and attention, I nevertheless believe the total absence of conceptual similarity is sufficient *in the particular circumstances of this case* to counteract the low level of visual or aural similarity arising from the presence of the shared syllable or

word ICE. Therefore, having consideration for *all* the relevant factors, I conclude that there is no likelihood of confusion in respect of any of the relevant goods. Such similarities as there are would not lead the relevant public into believing that the respective goods originate from the same or economically linked undertaking and, as such, there is no direct or indirect confusion.

51) In conclusion, Gilmar's opposition based upon its Section 5(2) (b) grounds fails in its entirety.

Section 5(4)(a)

52) I will go on to consider the grounds under Section 5(4) (a). That section reads as follows:

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

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

(b)

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

53) The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

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

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

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

54) To the above, I add the comments of Pumfrey J (as he then was) in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case [2002] RPC 19, in which he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

55) The relevant date for determining the opponent’s claim will be the filing date of the application in suit, that is to say 1st August 2007 (see, CFI case *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (*OHIM*), Joined Cases T-114/07 and T-115/07). The earlier right must have been acquired prior to that date (Article 4.4(b) of First Council Directive 89/104, on which the UK Act is based).

56) I must first assess if the opponent has acquired any protectable goodwill in relation to business conducted using its sign(s) prior to the relevant date. Whilst I am mindful of the criticisms made by Mr Farnsworth in his evidence of the lack of specificity in relation to what signs exactly may have goodwill attached, nevertheless, taking the evidence as a whole, I conclude that Gilmar at the material date had a protectable goodwill in the UK through its use of ICEBERG in respect of outer-clothing. I do not think it possible to say from the evidence exactly when that goodwill commenced; much of the evidence from Mr Gerani is undated or unclear. Plainly the Hearing Officer in the opposition in relation to Gilmar’s own mark ICE B (BL O-008-09, which was appealed as BL O-284-09, see para 8 in particular) had the same difficulty. In the light of my overall conclusions below it is not, in any event, a material point whether that date is 1982, when use is first claimed by Mr Gerani; 1998, when the earliest turnover figures are available, or some other date prior to the relevant date.

57) As regards a protectable goodwill in *other* ICE signs, the evidence is especially hard to assess, as Mr Farnsworth notes in his evidence. Only a conflated figure for “wear” for all “ICE” signs is given for the years 2006 and 2007 of , 1, 059, 120.00 and 513, 901.00 euros respectively. This is of no assistance in reaching any conclusion on each of the ICE signs separately. In the PINK ICE opposition, the Hearing Officer found that a protectable goodwill existed in relation to the sign ICE JEANS. I am prepared to make the same finding based upon the same evidence. This may be seen as a generous finding in the light of the Appointed Person’s observations in the ICE B Case, BL O-284-09 (see para 9), notably in respect of the difficulty of attributing a date of commencement to any goodwill in the sign ICE JEANS, based upon the same poor quality evidence put forward in this case. Nonetheless, the evidence plainly shows use of ICE JEANS prior to the material date on, eg the invoices comprising Exhibit 1 to Mr Gerani’s witness statement in respect of various items of outer-clothing and Exhibit 13 of the same witness statement showing advertising in various UK magazines such as DAZED AND CONFUSED, ELLE, THE FACE, ARENA HOMME, again all prior to the material date. As far as any other variant or derivative signs are concerned, namely ICE ICE ICEBERG (with ICEBERG forming a separate element in presentation), ICE J and ICE B, I do not find the evidence conclusive and am not therefore prepared to find that a separate and independently (that is to say, as distinct from ICEBERG and ICE JEANS) protectable goodwill existed at the material date in respect of these signs. Gilmar are hindered in this regard by not producing separate sales figures for each mark, as well as the absence of dates and clarity attached to much of their material.

58) In summary, I find that Gilmar enjoys a goodwill in ICEBERG and ICE JEANS, and in respect of those goods for which I have already determined genuine use to be applicable, namely:

articles of outer clothing; womens’ swimwear; caps; jeans, t-shirts and shirts, vests, pullovers, jumpers, outer-coats.

To which I would add, *footwear and accessories such as bags and belts.*

59) Moving on to the issue of misrepresentation, the claim, made in submissions by Gilmar’s representatives, and quoting from an OHIM Decision 2106/2005 dated 12th June 2005, is that:

“It is common, in the clothing sector, for the same mark to be configured in various different ways, according to the type of product it designates. It is also common for the same clothing manufacturer to use sub brands, that is to say signs that derive from a principal mark and which share with it a common dominant element, in order to distinguish his various lines from one another (women’s, men’s use). In such circumstances, it is conceivable that the targeted public may regard the clothing designated by

the conflicting marks as belonging, admittedly, to two distinct ranges of products, but as coming, nonetheless from the same manufacturer.”

On that basis, OHIM concluded that the marks ICE and ICEBERG were successful against the mark ICE AGE.

60) Following the rationale in the OHIM case, Gilmar contends that consumers will conclude that the words ICE SCREAM would be seen as a sub-brand of, firstly the ICEBERG brand, or alternatively any or all of the other variant or derivative ICE signs belonging to Gilmar. For the reasons I have given in relation to my analysis under section 5(2), in relation to the similarity of the sign ICE SCREAM to the sign ICEBERG, I do not believe the average consumer would believe that use of the sign ICE SCREAM amounts to any misrepresentation as far as the sign ICEBERG is concerned. There is no conceptual similarity and only a low level of aural and visual similarity. Gilmar’s case under section 5(4)(a), in respect of the sign ICEBERG, is therefore no stronger than it was under section 5(2)(b) and is accordingly dismissed.

61) That leaves me to consider the case in relation to the protectable goodwill I have found to exist in business conducted under the sign ICE JEANS. Based upon the ‘sub-brand’ argument particular to clothing, I can envisage that use by a third party of the sign ICE, plus some entirely descriptive matter, may result in misrepresentation. As I see it, this approach was taken by the Hearing Officer in the PINK ICE opposition, but he was at pains to stress in para 38 of his decision that the colour PINK could well signify a sub-brand only because it could indicate a descriptive characteristic of a product bearing the ICE brand. But where the term ICE SCREAM differs so much from ICE JEANS, the sub-brand argument cannot be persuasive. The identity behind ICE SCREAM is created by the two words *combined together*, without either one acting as a distinctive, dominant element. Instead, the two words combine to create a conceptually- devoid whole (although one which is apt to be seen to be derived from, or be a play on, ICE CREAM), but not one which is predisposed to misleading the consumer to the effect that the goods on sale under the sign are a sub-brand of ICE JEANS. I should add that I have considered whether the word SCREAM may be interpreted as the descriptive colour CREAM, in which case the sub-brand argument may have more force, but in the event I think it more probable (but not necessarily inevitable) that the words together would be taken, as I have already concluded under section 5(2)(b), to be derived from, be a play on or be otherwise related to the well-known frozen dessert.

62) For the avoidance of any doubt, I would have rejected the sub-brand argument for the reasons I have given above in respect of *any* of the variants Gilmar may have used (either separately *or* in combination to create a protectable goodwill in the single word ICE), but in respect of which I have found the evidence of protectable goodwill to be inconclusive, namely: ICE ICE ICEBERG, ICE B and ICE J. It is worthwhile observing in this respect that, whilst

I have not found it possible to conclude that any protectable goodwill exists in the UK in respect of these variant signs separately, there are grounds for concluding that Gilmar's core sign was, and remains, ICEBERG. This core sign has morphed (but not displaced ICEBERG) at some point into ICE JEANS, and these two signs have then provided a 'thematic link' behind Gilmar's branding development subsequently. ICE B and ICE J can both be seen in use to be derived from ICEBERG and ICE JEANS respectively. Such goodwill as Gilmar may, theoretically, have cultivated in their signs as a whole may thus be seen in the light of having been derived from, and inextricably linked, to those original and core brand(s), ICEBERG and ICE JEANS. This would represent another reason (not that one is needed) for an absence of misrepresentation in this case.

63) In conclusion, I find there is no misrepresentation leading to damage of Gilmar's goodwill. Use of ICE SCREAM by the Halewoods will not result in trade being diverted from Gilmar to itself, in damage to its reputation in the case of any failings in the Halewood's goods, or in it being wrongly regarded by the relevant consumer that the two companies are connected.

64) Therefore, the grounds for opposition based upon Section 5(4) (a) of the Act fail in their entirety.

COSTS

65) The opposition having failed, the Halewoods are entitled to a contribution towards their costs. I award costs on the following basis:

Considering Notice of Opposition and statement and Preparing statement of case in reply	£400
Preparing, considering and filing evidence	£700
TOTAL	£1100

66) I order Gilmar S.P.A. to pay Mr David Halewood and Mrs Anne-Lydia Halewood the sum of £1100. 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 16th day of November 2009

**Edward Smith
For the Registrar,
the Comptroller-General**

ANNEX – Extract from Decision BL O/257/06

EVIDENCE OF GILMAR

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

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

Marketing expenditure for the years 1998 to 2004 was €105,000, €412,000, €607,000, €352,000, €390,000 and €328,000 respectively. Mr Gerani states that Gilmar has used the trade marks ICE JEANS and ICE ICE ICEBERG. He states that the annual turnover in the United Kingdom in relation to goods bearing the trade mark ICE JEANS is as follows:

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

Marketing expenditure for the years 1998 to 2003 was €51,000, €60,000, €226,000, €292,000, €159,000 and €79,000 respectively. At exhibit 1 are various invoices; nine of these emanate from prior to 26 September 2003 and are for the United Kingdom (another invoice relates to Jersey). There are twelve United Kingdom invoices in all. The trade marks referred to upon the invoices are: Ice Jeans, Iceberg Uomo, History Iceberg Donna and History Iceberg Donna. The majority of the goods on the invoices are described as Ice Jeans; the goods so described are: jeans, t-shirts, shirts, sweaters, belts, knitted vests, sports jackets, skirts, sweatshirts, dresses, leather jackets, scarves, leather blousons, coats and pants.

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

9) Mr Gerani describes exhibit 4 as showing copies of photographs of examples of products sold under the trade mark ICEBERG combined with other ICE trade marks. The photographs

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

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

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

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

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

Exhibit 6 shows pictures of tags showing ICE ICE and ICE ICE ICEBERG. There is no indication as to from when the tags emanate. Exhibit 7 has several pictures showing use of ICE ICE ICEBERG and one showing use of ICE; again there is no indication of their provenance. Exhibit 8 shows a photograph of the ICE ICE ICEBERG stand at Pitti in Florence. Mr Gerani omits to state when the picture was taken. Exhibit 9 shows pictures of footwear and tops bearing ICE ICE ICEBERG, again there is no indication of provenance. (I note that one top bears the Castellano wording "su nombre aqui" (sic) (your/his/her name here). Mr Gerani states that exhibit 10 consists of sample catalogues to promote ICEBERG goods which are sold under the ICE trade marks in the United Kingdom. The quality of the copy is poor, making it difficult to make out details. The first catalogue bears the words "ice jeans" and at the bottom appear to be the words "look back" or "look book". Various items of clothing for men and women appear; ICEJ and ICEJEANS can be seen upon some of the items. There is no indication as to when the catalogue was produced. The end of the catalogue shows the name and address of Gilmar in Italy. A catalogue for Ice Jeans bears the wording "autunno inverno 03/04", various items of clothing are shown. At the end of the catalogue there is a list of show rooms, including one in London. A catalogue for ICE JEANS ICEBERG for spring/summer 2003 is included; a range of clothing is shown, some of it bearing ICE JEANS. There are pages from 'ICEBERG THE MOVIE' which features the spring summer collection for 2003, this includes one page bearing the name ice jeans. A copy of a catalogue entitled 'ICEBERG THE TOUR' has what appears to be a photocopied Post-it® upon it bearing the writing "CATALOGUE WINTER 2003". There is a reference to ICE

JEANS. At the end of the exhibit is a page which is headed Autumn Winter 2003 – 2004, this includes a list of boutiques and showrooms across the world; one is in the United Kingdom.

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

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

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

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