

O-377-12

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS 2577744A AND 2578079A
BY
ASHLEIGH & BURWOOD LTD
TO REGISTER THE TRADE MARKS

Tales of London by Ashleigh & Burwood

AND



TALES
of
LONDON

IN CLASS 3

AND

THE CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS 102225 AND 102288
BY
TAYLOR OF LONDON LIMITED

**Trade Marks Act 1994
In the matter of application nos 2577744A and 2578079A
by Ashleigh & Burwood Ltd
to register the trade marks:**

**Tales of London by Ashleigh & Burwood
and**



**in class 3
and the oppositions thereto
under nos. 102225 and 102288
by Taylor of London Limited**

BACKGROUND

1. Application Nos 2577744A and 2578079A are the result of a request to divide the original applications and have a filing date of 8 April 2011. They stand in the name of Ashleigh & Burwood Ltd (the applicant) and seek registration of the following goods in Class 3:

Class 03:

Cosmetics; fragrances; Potpourris [fragrances]; room fragrances; essential oils; Scented oils; cosmetic oils; massage oils; soaps; Skin creams; non-medicated lotions; aftershave lotions; perfumes; perfumed paper; lotions for cosmetic purposes; lotions for face and body care.

2. Following publication of the applications on 29 April and 20 May 2011 respectively, Taylor of London Limited (the opponent) filed notices of opposition against the applications.

3. The grounds of opposition were brought under section 5(2)(b) and 5(3) of the Trade Marks Act 1994 (the Act).

4. The opponent relies on the following earlier marks in respect of the objections brought under sections 5(2)(b) and 5(3):

MARK DETAILS AND RELEVANT DATES	GOODS
<p>CTM: 2796050</p> <p>MARK: TAYLOR OF LONDON</p> <p>Filing date: 29 July 2002 Registered: 30 October 2003</p>	<p>Class 03: Non-medicated toilet preparations; perfumes; perfume sachets; perfumed paper; potpourri; pomanders containing perfumed preparations and mixtures; essential oils; eau de cologne; toilet water; soaps; talcum powder; preparations for the care and conditioning of the body, skin and scalp; bubble bath, bath gel and shower gel; shampoos; hair preparations; hair conditioners; shaving preparations and aftershave; all included in class 3</p>
<p>TM: 1583045</p> <p>MARK: TAYLOR OF LONDON</p> <p>Filing date: 26 August 1994 Registered: 10 October 1995</p> <p>Disclaimer: Registration of this mark shall give no right to the exclusive use of the word "London".</p> <p>Special circumstances: Advertised before acceptance.</p> <p>Honest concurrent use: Honest concurrent use from 1963 with Registration Nos 1248883, 1371440 and 1371442.</p>	<p>Class 03: Non-medicated toilet preparations; perfumes; perfume sachets; perfumed paper; potpourri; pomanders containing perfumed preparations and mixtures; essential oils; eau de cologne; toilet water; soaps; talcum powder; preparations for the care and conditioning of the body, skin and scalp; bubble bath, bath gel and shower gel; all included in Class 5; but not including shaving preparations.</p>
<p>TM: 1044143</p> <p>MARK:</p> <div style="text-align: center;">  <p>TAYLOR OF LONDON</p> </div> <p>Filing date: 26 March 1975 Registered: 8 November 1976</p> <p>Disclaimer: Registration of this mark shall give no right to the exclusive use of the words "Taylor of London" and a letter "T".</p>	<p>Class 03: Non-medicated toilet preparations; perfumes; perfumed sachets; pot-pourri, pomanders containing perfumed preparations and mixtures; essential oils for use in the manufacture of such goods.</p>

5. The opponent claims use on all of the goods for which the marks are registered. In its statement of grounds it states, inter alia:

“4. The predominant part of the Applicant’s mark is the words TALES of LONDON which is very similar to the Opponent’s mark both visually and phonetically.

5. The goods of the respective marks are identical in class 3.”

6. Under s. 5(3) of the Act the opponent states that it has a reputation in relation to all of the goods for which its marks are registered and confirms that the marks completed their registration procedure 5 years or more before the opposed mark was published. This is the full extent to which the 5(3) grounds are particularised. The remainder of the opposition form (TM7) is blank and though the opponent has stated ‘see attached statement of grounds’ in the section for providing further information, the statement of grounds is silent on the issue of opposition under section 5(3) of the Act. No further explanation has been provided either in evidence, or in submissions.

7. On 29 September 2011, the applicant filed a counter statement in which it denies the grounds of opposition and puts the opponent to proof of use of its marks. The applicant states in relation to the opposition to its word and device mark:

“5. The word element of the Application Mark is different and readily distinguishable from the word elements of the Opposition Marks, visually, conceptually, phonetically and semantically, such that there is no prospect of there being resulting confusion or association...”

6. The Applicant submits that the respective class 3 goods for comparison are similar but are not identical and rejects the Opponent’s claims to the contrary.”

8. In respect of its word only mark it states:

“4. The Applicant submits that the Application Mark makes it very clear that the Applicant (Ashleigh & Burwood) is the producer of the relevant goods, such that the dominant component of the Application Mark is the component “Ashleigh & Burwood”...The Applicant denies the Opponent’s suggestions to the contrary.”

9. Both parties filed evidence. While neither party asked to be heard, both filed written submissions in lieu of attendance at a hearing; I will refer to these submissions as necessary below.

EVIDENCE

The Opponent’s evidence in chief

10. The opponent’s evidence consists of a witness statement from Peter Jackson, dated 7 December 2011, accompanied by 4 exhibits. Mr Jackson is the Chairman of Jackson Trading Company Plc., which owns Taylor of London Limited (of which he is a Director). The main facts emerging from Mr Jackson’s statement are, in my view, as follows:

- CTM2796050 was filed in the name of Fine Fragrances & Cosmetics Limited (FF&C) on 29 July 2002.

- TM1583045 was filed in the name of FF&C on 26 August 1994
- TM1044143 was filed in the name Taylor of London on 26 March 1975 (A company no longer in existence and not the same entity as the opponent company Taylor of London Limited) and was assigned to FF&C in 1992.
- All three marks were assigned with goodwill to Vivalis Limited by Deed of Assignment dated 1 April 2008.
- All three marks were assigned with goodwill from Vivalis Limited to Taylor of London Limited [the opponent company] by Deed of Assignment dated 31 March 2010

11. In respect of the period of use and turnover figures, Mr Jackson states:

“3. I have been involved with the perfume and cosmetics business for 40 years and have been well aware of Taylor of London products for all of that time. I believe that Taylor of London brands have been owned by a succession of companies over many years and for the last 20 years by FF&C, who were acquired by Vivalis around 12 years ago. JTC/Taylor of London acquired these products from Vivalis in March 2010.

4. I have made enquiries of FF&C and Vivalis and I believe that the annual turnover of products under the trade Mark TAYLOR OF LONDON for the years preceding [the dates of the applications for registration] is as follows:

Period	Turnover (£millions)
2004-5	1.05
2005-6	1162
2006-7	1224
2007-8	1884
2008-9	680
2009-10	737

12. Mr Jackson also states:

“6. I am informed by FF&C and Vivalis that the following sums have been spent on trade press advertising, design, photography, Christmas guides and other promotional support.

Period	Spend (£)
2009	33,668
2010	35,432

13. Exhibit PJ1 consists of two export order forms, printed from a computer, which have not been completed. They have file headings dated 2004 and 2008. The company name 'Fine Fragrances & Cosmetics' can be seen at the top of the page with the company address. The words TAYLOR OF LONDON can be seen half way down the document and may refer to a company name or a brand. Under this heading is a list of products including, inter alia, Luxury Perfumed Soap, EDT Spray and Bath Cubes. It is not clear how these listed products were branded. The first exhibit is dated before the material date, so is of no assistance to the opponent, the second is within the period (the material dates are calculated at paragraph 42, below).

14. Exhibit PJ2 consists of "a selection of promotional and advertising material covering years prior to the dates of the applications".

15. Page 10 is taken from www.thebrilliantgiftshop.co.uk and shows three gift sets of Taylor of London products: two priced at £12 and one at £20. The page is not dated.

16. Pages 11 and 12 are headed Bath, Body and Home Collection and have the words Taylor of London in the top left hand corner. The pages show a range of products in four fragrances. The second page states: "Sold throughout the world, including the UK, Australia and the USA." The pages appear to be in the style of a presentation printed from a computer and are not dated. It is not clear where and to whom this information was made available, but from its content it appears to be directed at the trade. The pages are not dated.

17. Pages 13-20 are the Vivalis Christmas Gift Catalogue for 2008. The pages show gift sets of toiletries branded Tweed, White Satin, Chique, Lace, Panache and Taylor of London gift sets at pages 16 and 17. Page 19 is an order form on which orders could be placed for Taylor of London gift sets. All of these brands were owned by Vivalis and have subsequently been assigned to the company Taylor of London. The prices of goods range from £4.95 to £12.95.

18. Page 21 shows a range of Taylor of London Lavender toiletries. The words Taylor of London can be seen at the top of the page. Supporting text indicates the range is available in four fragrances. The bottom left hand corner contains the words 'At selected Sainsbury's stores'. The page is undated. It is not clear where and to whom this information was made available.

19. Pages 22-25 refer to the Taylor of London range of products and provide contact details for stockist information. The last page states 'Taylor of London is available from selected independent chemists and gift outlets'. The first page is dated June 2007 and the trade mark Taylor of London is presented at the top of the first page. It is not clear where and to whom this information was made available.

20. Pages 26-28 refer to Room Fragrance Beads, Candles and Bath Petals. Each page states that the product is new and that it will be 'on counter' from 1 October 2006. The address at the bottom of each page is that of Fine Fragrances and Cosmetics Ltd.

21. Pages 29-32 appear to be in-house packaging designs for four fragrances of talcum powder. They clearly show the Taylor of London mark and are dated 6 January 2005, which is before the material date.

22. Pages 33-39 make up a catalogue of Taylor of London products, featuring the packaging designs from the previous pages. The catalogue is dated 2005, once again, before the material date.
23. Page 40 consists of an advertisement for Taylor of London 'bath and body' gift sets for Christmas 2004. Four products are shown, the mark being clearly visible on the front of each. Once again, this page is dated before the material date.
24. Page 41 is an advertisement for 'Taylor of London Elegant Rose fragrance'; it refers to the product being available from April 2004 (before the material date). The Taylor of London mark is shown at the top of the page and contact details are provided for www.finefragrancesandcosmetics.com.
25. Pages 42-45 consist of packaging designs for four fragrances of body spray. The mark can be clearly seen on the front of each design. The pages are dated 28 April 2008.
26. Exhibit PJ3 is described by Mr Jackson in his witness statement as, '*samples of material confirming the reputation of the Trade Mark TAYLOR OF LONDON.*'
27. Page 47 consists of cuttings from several documents which have been overlaid onto a floral background. The page is headed 'TAYLOR OF LONDON, LATEST & GREATEST PR ACTIVITY & ADVERTISING MAY-NOVEMBER 2003'. This is before the material date. The cutting on the page shows two gift sets of toiletries, both of which show the mark and both of which are described as part of the Christmas gift collection for 2003.
28. Page 48 shows a similar cutting from the same 2003 collection and a crossword from *My Weekly* magazine which lists 'Winners of Taylors of London Prize in Crossword No. 2156.' This is not dated.
29. Page 49 consists of in-house copy of an advertisement for Taylor of London products headed 'Taylor made'. The page is dated 8 June 2005 (before the material date) and shows the lines around the outside where the advert will be cut.
30. Pages 50-51 are headed Taylor of London, LATEST PRESS NEWS. A magazine page is shown with text added which describes it as PRIMA DECEMBER 2006. Under the title, 'Five of the best gift packs', the first 'gift' is a Taylor of London gift set of shower gel and EDT spray. The mark cannot be seen clearly but the packaging is obviously the same as that shown in earlier examples in exhibit PJ2. The second page has text added which reads 'Bella Magazine' 13 February 2007. Under 'top romantic products' the fifth item is 'Taylor of London Rose Fragranced Bath Petals'. The petals are shown but the packaging and mark are not.
31. Page 52 is from 'Best' magazine, but is undated. The page is headed 'best beauty'. At the top of the page is an oval in which there is a picture of a rose and the title 'Treat of the week...' which highlights Taylor of London Fragranced Bath Petals.
32. Exhibit PJ4 is a page printed from the applicant's website on 7 December 2011. The words Ashleigh & Burwood in script can be seen at the top of the page with the word London in block capitals underneath. A range of fragranced products are shown including drawer liners and a premium fragrance lamp.

Applicant's evidence

33. The applicant's evidence consists of a witness statement from John Christopher Nettleton, dated 9 February 2012, accompanied by 7 exhibits. Mr Nettleton is the Managing Director of Ashleigh & Burwood (the applicant). The exhibits JN1 - JN6 attached to the witness statement consist of, inter alia, dictionary definitions and prints from the UK register showing marks which contain the words 'TAYLOR' and 'LONDON'. It is clear from a number of cases decided by the courts of the UK and the Community, that state of the register evidence of this sort does not assist the applicant.¹ I will not detail the remaining submissions here but will refer to them when necessary below.

34. Exhibit JN7 consists of prints from Ashleigh & Burwood's website which Mr Nettleton states "*show the types of product we sell and also give an indication of the price ranges*". The pages were printed on 13 February 2012, after the material date.

35. In his witness statement Mr Nettleton states:

"28. I am quite taken aback by the poverty of the evidence submitted by the Opponent. In relation to the key question of reputation, the evidence is effectively useless. Mr Jackson has provided nothing which evidences the sales or marketing spend which might relate to Taylor of London products. Once [sic] would normally look for audited accounts or verified details of marketing spend, including a breakdown of how that spend had been made, for example by print, online advertising, and so on. Instead, Mr Jackson states (my underlining) that he "has made enquiries of FF&C and Vivalis" and that he "believes" the turnover figures and marketing spend are as he set out in paragraphs 4 and 5 respectively. With due respect, this is nowhere near good enough. I really have little idea what he is saying or what this really means? Did he write to those companies, did he call them? If so, who did he speak to? What did they tell him? On what basis does he therefore believe?

...

30. I submit that if Mr Jackson had such documentary proof, he should have submitted it. He has failed to do so and negative inferences should be drawn from his failure. The information he has submitted in relation to sales and marketing spend is not supported by any documentary proof at all and is without credibility. This point is well illustrated by paragraph 4 of his statement, in which he shows the sales of Taylor of London as having risen from £1.05 Million in 2004/5 to £1,162 Million in 2005/6. In doing so, he is alleging that sales of Taylor of London products went from just over £1 Million to almost £1.2 Billion in the space of a single year! I would venture that that is simply not true. Were it true, it would be stratospheric growth to outstrip even the most successful brands on the planet. All of this on the basis of 'enquiries' Mr Jackson has made and what he therefore 'believes'.

31. Based on Mr Jackson's paragraph 4, it looks like the sales continued apace, with sales nearing £2 Billion in 2007/8, only to suddenly drop to £680 Million in 2008/9. All of this on the basis of a low-end and outmoded series of products.

32. I don't really know how Mr Jackson has arrived at these figures and the 'evidence' he has submitted does not allow me even to hazard a guess. I suspect

¹ See, in particular, British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281 and GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-135/04 the General Court (GC)

he has somehow fastened onto information he has been provided by some third party and I also suspect that the figures may relate to the turnover of those companies and have no relevance to Taylor of London. Be that as it may, I submit that these figures have no credibility at all, are entirely unsupported and go nowhere near the standards one could reasonably be expected to reach in demonstrating reputation. In my view, they should not have been included in a sworn witness statement.”

Opponent’s Evidence in reply

36. The opponent’s evidence in reply consists of a second witness statement from Peter Jackson, dated 10 April 2012. At paragraph 10 he states:

“In paragraph 28 of his statement, Mr Nettleton refers to the ‘poverty of evidence submitted by the opponent. Figures of sales and promotional expenditure have been filed and backed up by appropriate evidence. It is true that because of the recent acquisition of the TAYLOR OF LONDON brand it has not been possible to file full and further evidence of use of the Trade Mark TAYLOR OF LONDON from 19th century to date but I stand by the comments I made in my previous statement.”

DECISION

37. I will start by assessing the case under section 5(2)(b) of the Act which reads as follows:

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

38. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

39. In these proceedings the opponent is relying upon the trade marks shown in paragraph 4 each of which constitute an earlier trade mark under the above provisions. The applications were published on 29 April and 20 May 2011. The opponent's earlier marks completed their registration procedure on 30 October 2003, 10 October 1995 and 8

November 1976. Consequently, the opponent's registrations are subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004, and, as I mentioned above, the applicant has asked the opponent to provide proof of use in relation to all of its goods in class 3. The relevant sections of the Proof of Use Regulations read 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 in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or
- (b) the making of an application for a declaration of invalidity under section 47(2)(application on relative grounds where no consent to registration).”

40. The relevant period is the five year period ending on the date of publication of the application, namely 30 April 2006 to 29 April 2011, in respect of 2577744A and 21 May 2006 to 20 May 2011, in respect of 2578079A. The onus is on the opponent, under section 100 of the Act², to show genuine use of its marks during these periods on those goods

² “ If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put it is for the proprietor to show what use has been made of it.”

relied on or, alternatively, to show that there are proper reasons for non-use of the mark during these periods. The two periods entirely overlap with the exception of less than one month.

Proof of use

41. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use.

42. The requirements for “genuine use” have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Ms Anna Carboni, sitting as the Appointed Person in O-371-09 *SANT AMBROEUS*:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle* where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The 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 by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark

or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

43. In addition, I will keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29. I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30. Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31. Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

44. The comments of Mr Justice Jacob in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

“20. The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

45. The comments of the Court of First Instance (now the General Court) in *Reckitt Benckiser (Espana), SL v OHIM*, Case T- 126/03 are also relevant where it held that:

“45. It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub- divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46. Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

46. During the periods in which proof of use of the earlier rights must be shown the 'Taylor of London' marks have been owned by three different proprietors., Evidence provided by Mr Jackson includes information he has obtained from these three companies. The evidence, in its totality, shows no indication that the mark 'TAYLOR OF LONDON' below a stylized letter 'T' has been used at all. That being the case, the opponent has failed to show genuine use of this mark. Neither has it filed anything to suggest it has proper reasons for non-use. Consequently, the opposition based on this earlier mark fails on all grounds and I will make no further reference to it in this decision.

47. Earlier mark nos 2796050 and 1583045, are presented in plain block capitals. Examples of the marks provided by Mr Jackson show the words Taylor of London in plain block capitals, in title case and in some cases, with the word 'Taylor' above the words 'of London'.

48. In the European Court of Justice ("ECJ" now CJEU) Case C-291/00 (*LJT Diffusion SA v Sadas Vertbaudet SA*) ("*Sadas*"), the Court made the following statement in relation to when marks can be considered identical:

"Article 5(1)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

49. In my view, the differences between the earlier mark as registered and the examples provided by Mr Jackson of the mark in title case simply come down to whether individual letters are presented in lower or upper case and would go unnoticed by the average consumer.

50. Mr Jackson's evidence, within the material dates, shows products branded 'Taylor of London' in a Christmas catalogue from Vivalis in 2008. The products cannot be seen clearly, however, the accompanying order form lists soap, cologne, talcum powder, moisturizing lotion, room fragrance, drawer liners, bath soak, shower gel, drawer liners and hand and nail cream under the heading Taylor of London. A document that looks as though it has been printed from a computer is dated June 2007 and shows the 'lily of the valley collection' on its front page. The rest of the document lists the other fragrances available and the products in the range (which are those listed earlier in this paragraph). Also in evidence are three A4 sheets which show Taylor of London fragrance beads, candles and bath petals as being 'in store' from 1 October 2006. Mr Jackson's evidence also includes packaging designs for body sprays dated 28 April 2008.

51. In his witness statement Mr Nettleton has questioned the turnover figures provided by Mr Jackson in respect of products bearing the TAYLOR OF LONDON mark. It is true to say that his questions reflect my own concerns.

52. Mr Jackson describes the figures he provides as relating to annual turnover under the TAYLOR OF LONDON trade marks. Page 12 of exhibit PJ2 states "Sold throughout the world, including UK, Australia and the USA." Mr Jackson has not provided any breakdown of these figures nor has he confirmed which countries these figures refer to. Consequently, I am unable to conclude what the relevant turnover figure may be in the EU or the UK in relation to the relevant goods.

53. Mr Jackson also provides a catalogue from Vivalis as part of exhibit PJ2. As Mr Jackson has made clear, Vivalis is a company that previously owned all of the marks now owned by Taylor of London. The Trade Mark Register shows that these marks include not just TAYLOR OF LONDON but also inter alia Panache, Tweed, White Satin. Again it is not clear from Mr Jackson's evidence which marks the turnover figures refer to. I note that all of the brands in the Vivalis catalogue are now owned by the Taylor of London company.

54. Mr Nettleton raised his concerns in respect of this evidence in his witness statement dated 9 February 2012. In accordance with Tribunal Practice Notice 5/2007³, Mr Jackson had the opportunity to address these concerns in his evidence in reply. In that evidence he stated that he stands by the comments made in his previous statement. A further opportunity to clarify the position was available in the period allowed for both parties to file written submissions in lieu of a hearing.

55. On both occasions Mr Jackson has failed to explain the sharp increase in figures between 2004/5 and 2005/6 or provide a clear breakdown explaining which marks and what countries these figures refer to. Mr Jackson has had to approach several previous owners of the marks in order to collate these figures. No doubt each of these companies keeps records according to its own criteria but no such documentation has been filed and the source of the figures has not been identified. As a result, I do not consider that the turnover figures supplied provide an accurate or reliable picture on which it can rely.

56. Three out of the four of Mr Jackson's exhibits, within the material dated, are made up of in house documents which have not been given any additional explanation. It is not clear where these products were made available or to whom. The fourth exhibit within the relevant dates is the Vivalis Christmas Catalogue for 2008. Again I have no indication of where this catalogue was made available. As I have already outlined, I cannot be sure in which countries goods have been made available under the 'Taylor of London' mark, nor can I be sure what percentage of sales refer to these goods in the relevant jurisdiction. Consequently, I cannot conclude to what extent, if any, the mark 'Taylor of London' has been used in respect of the opponent's goods in class 3 and so the opposition fails as the proof of use requirement is not satisfied.

57. Whilst I have found that no genuine use has been made of the earlier mark Taylor of London, if, in the event of any appeal I should be found to be wrong in this regard, I will now go on to consider the position under section 5(2)(b) on the basis that proof of use had been established in respect of all of the goods for which the marks are registered.

The opponent's best case

58. Trade mark 1583045 is set out above. It contains an error in its specification in that it refers to class 5, when the registration is recorded, properly, in class 3. The registration is also subject to a disclaimer. Consequently, trade mark 2796050 for the plain words 'TAYLOR OF LONDON' represents the opponent's best case and it is on this mark that I shall base the comparison.

Section 5(2)(b) case law

59. In his decision in *La Chemise Lacoste SA v Baker Street clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR

³ Procedure for parties to challenge evidence filed in inter partes trade mark disputes

11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

60. *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] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing act

61. In accordance with the above cited case law, I must determine who the average consumer is and consider the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant, but with a level of attention likely to vary according to the category of goods at issue. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

62. The average consumer for the respective goods is a member of the general public. At paragraph 6.c. of its written submissions, filed in lieu of attendance at a hearing, the applicant states:

“In respect of goods such as cosmetics and candles, consumers will tend to buy on sight, so the visual basis of comparison will predominate.”

63. I agree, the purchasing act is likely to be primarily a visual one as the goods will be selected from a website, catalogue or directly from a shelf. However, I do not ignore aural considerations as it is not unusual to find more expensive cosmetic products kept in cases or behind counters in, for example, salons and department stores. In my view, the average consumer is likely to consider, inter alia, intended skin type, particular ingredients, aroma etc. However, as a general rule these are relatively low value, fairly frequent purchases and are unlikely to demand anything more than a moderate degree of attention to be paid to their selection.

Comparison of goods

64. The goods to be compared are as follows:

The opponent’s goods	The applicant’s goods
<p>Class 03: Non-medicated toilet preparations; perfumes; perfume sachets; perfumed paper; potpourri; pomanders containing perfumed preparations and mixtures; essential oils; eau de cologne; toilet water; soaps; talcum powder; preparations for the care and conditioning of the body, skin and scalp; bubble bath, bath gel and shower gel; shampoos; hair preparations; hair conditioners; shaving preparations and aftershave; all included in class 3.</p>	<p>Class 03: Cosmetics; fragrances; Potpourris [fragrances]; room fragrances; essential oils; Scented oils; cosmetic oils; massage oils; soaps; Skin creams; non-medicated lotions; aftershave lotions; perfumes; perfumed paper; lotions for cosmetic purposes; lotions for face and body care.</p>

65. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in Gérard Meric v OHIM, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

66. In its evidence the opponent states:

“9. ...I submit that many of the goods in the applications are identical to those in the Opponent’s marks and, in addition, would in any case be included under the general expression ‘non-medicated toilet preparations’. The respective class 3 goods are, to all intents and purposes, identical.”

67. In his witness statement, at paragraph 23, Mr Nettleton states:

“I therefore ask that the s5(2)(b) grounds of opposition are rejected in their entirety in respect [of] both the Crown Mark and the A&B Mark. I say this in acceptance of there being a good degree of similarity between the class 3 goods applied for and those in the Opponent’s cited marks. There is overlap and similarity but there are also material differences in the specifications. However, the fundamental differences in the respective marks, as discussed above, means that even if the goods were identical, there would still be no risk of association or confusion.”

68. Perfumes, aftershaves, potpourri, soaps and perfumed paper are included in the applications and the opponent’s earlier mark. These are self evidently identical. The applications also include essential oils; scented oils; cosmetic oils and massage oils. The opponent’s specification includes essential oils. Essential oils normally contain a scent derived from plants and may include the types of oils listed in the applications. In addition, the types of oils included in the applications can include essential oils within their broader categories. Fragrances and room fragrances fall within the broader term perfumes. The term ‘cosmetics’ contained in the applications is a broad one. Cosmetics along with the remaining terms in the applications, encompasses goods for cleaning and preparation of the body. Such goods can fall within the wider categories ‘non-medicated toilet preparations’ and ‘preparations for the care and conditioning of the body, skin and scalp’ in the opponent’s earlier registration and those goods can also fall within the term cosmetics. Thus, each of the respective goods are identical.

Comparison of marks

69. The marks to be compared are:

Opponent's mark	Applicant's marks
TAYLOR OF LONDON	Tales of London by Ashleigh & Burwood
	

70. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components⁴, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

Dominant and distinctive components

71. The opponent's mark consists of three words 'TAYLOR OF LONDON', presented in plain block capitals. It is not possessed of any stylisation or any additional matter. The first of the applicant's two marks consists of the words 'Tales of London by Ashleigh & Burwood'. It is presented in title case with no additional stylisation. The second of the applicant's marks consists of a large stylised crown which makes up the top half of the mark. The words 'TALES of LONDON' are presented one word above the other on three lines and below the crown device and are presented in an unremarkable type face with the word 'of' being in a much smaller font size.

72. In its written submissions the opponent states:

“(C)(a)...whilst both applications contain additional wording or a device, the dominant part is the words ‘Tales of London’ and ‘TALES of LONDON’ both of which are very similar to the Opponent’s mark TAYLOR OF LONDON.”

73. In its written submissions the applicant makes the following comments in respect of the distinctive and dominant elements of its marks:

“6.a. The crown device is the dominant and most distinctive element of the crown mark.”

⁴ Sabel v Puma AG, para.23

“7.e. The ‘Ashleigh and Burwood’ component will be seen as the dominant element of the mark, as it indicates the trade origin of the goods concerned, in just the same way as marks such as ‘Polo by Ralph Lauren’ or ‘CKone by Calvin Kline’.

74. The opponent’s mark consists of the word ‘TAYLOR’ followed by the words ‘OF LONDON’. The words ‘OF LONDON’ simply denote geographic origin and are not a distinctive element of the mark. TAYLOR is the only part of the mark that possesses a degree of distinctiveness and consequently, it is this word that is the dominant and distinctive element.

75. I will deal with the applicant’s marks in turn. The ‘crown’ mark consists of a large device in the form of a stylised crown at the top of the mark. It takes up 50% of the mark and will not be overlooked. The words ‘TALES of LONDON’ underneath this distinctive device makes up the other half of the mark and are, in my view, equally dominant within the mark. As discussed above at paragraph 74, the words ‘of London’ simply denote geographic origin and are not distinctive within the mark. The ‘Ashleigh and Burwood’ mark also consists of two elements. ‘Tales of London’ (the same applies as already discussed regarding ‘of London’) and ‘by Ashleigh & Burwood’. Both are equally dominant within the mark but the elements ‘Tales’ and ‘Ashleigh & Burwood’ are the distinctive elements.

Visual and aural similarities

76. In relation to visual and aural similarities the opponent is of the view that TALES OF LONDON and TAYLOR OF LONDON are the dominant parts of the marks and on that basis, reaches the conclusion that the marks are visually and aurally similar.

77. In respect of visual comparison the applicant submits in its evidence:

“9. My experience...is that, in relation to products such as cosmetics and toiletries, consumers tend to buy ‘on sight’, so that visually dominant components, such as the crown device, will carry more weight than any other basis of comparison.”

78. Also in its evidence, the applicant submits the following in respect of aural similarities between the marks:

“13. Phonetically and orally, the marks are also quite different. Taylor comprises a word of two syllables and 6 letters, whereas ‘Tales’ comprises only one syllable and 5 letters.”

79. Visually, the obvious similarity between the applicant’s two marks and the opponent’s mark rest in the words ‘OF LONDON’, which are identical. The first word of each of the parties’ marks is different; the applicant’s being the word ‘TALES’ and the opponent’s being the word ‘TAYLOR’, though both begin with the letters ‘TA’.

80. In addition, one of the applicant’s marks contains a large, stylised crown, and the other, the additional words ‘By Ashleigh & Burwood’ follow the words ‘Tales of London’. Both of these elements make up at least 50% of the respective marks and consequently, neither can be considered de minimis.

81. Throughout its evidence the opponent makes clear that in its view the applicant’s marks will both be referred to as ‘Tales of London’. I agree that the average consumer will

pronounce one of the applicant's marks as 'TALES OF LONDON' as the device of a crown is unlikely to be articulated. The mark 'Tales of London by Ashleigh & Burwood' may be articulated in full, however, given the length of the mark, it is highly likely that the average consumer will shorten the mark and this is most likely to be achieved by not articulating 'by Ashleigh & Burwood' and referring to the mark simply as 'Tales of London'. The opponent's mark will be pronounced 'TAY-LOR OF LONDON'.

82. Taking all of these factors into account I find there to be a moderate degree of visual similarity between each of the applicant's two marks and the opponent's earlier right and a high degree of aural similarity between the opponent's mark and those of the applicant.

Conceptual similarities

83. In its evidence the applicant submits:

"10. Turning to the conceptual basis of comparison, the Merriam-Webster online dictionary defines 'Tale' as follows:-

1. *obsolete: DISCOURSE, TALK*
2. *a: a series of events or facts told or presented: ACCOUNT
b(1): a report of a private or confidential matter 'dead men tell no tales' (2) a libelous report or piece of gossip*
3. *a: a unusually imaginative narrative of an event: STORY
b: an intentionally untrue report: FALSEHOOD 'always preferred the tale to the truth - Sir Winston Churchill'*
4. *a: COUNT, TALLY
b: TOTAL*

Examples of TALE

The movie is a stirring tale of courage.

We listened to his familiar tale of woe as he talked again about the failure of his marriage.

He told us thrilling tales about his adventures as a pilot in the war.

Are you telling tales again? Or is that the truth?

11. The same online dictionary defines 'Taylor' merely as a biographical name.

12. Therefore on the one hand we have 'Tale' which relates to stories and accounts, carrying with it associations of history. On the other, we have 'Taylor' which is simply a surname and therefore conceptually void. The conceptual comparison could hardly be more stark. One mark is rich with history and meaning. The other is empty. In my view, this clear conceptual difference strongly mitigates against any likelihood of confusion or association."

84. With regard to the conceptual similarities between the marks the opponent submits in its second witness statement dated 10 April 2012:

"4. It is irrelevant that Taylor is a surname or the word 'Tales' has a meaning, the two Trade Marks TAYLOR OF LONDON and TALES OF LONDON are virtually identical and confusion will occur in the market place."

85. For a conceptual meaning to be relevant it must be capable of being immediately grasped by the average consumer.⁵ I must consider the conceptual message which each mark, in its totality, would convey to the average consumer.

86. I agree with the applicant to the extent that, in my view, the average consumer will immediately comprehend a different conceptual message from the respective parties' marks. The applications 'TALES OF LONDON' send the average consumer the conceptual message of stories either emanating from or about the city of London. The addition of the words 'by Ashleigh & Burwood' conveys an impression of two people with the surnames Ashleigh and Burwood, in some way providing the 'Tales of London'. I disagree with the conclusion that the opponent's mark has no conceptual message. It indicates, for example, a person with the surname 'TAYLOR' either conducting business or hailing from London.

87. In my view, the meanings that will immediately occur to the average consumer of the goods at issue will be those mentioned above, and as such, not only is there no conceptual similarity, the competing marks are, in my view, conceptually dissonant.

Distinctive character of the earlier mark

88. I must now assess the distinctive character of the opponent's earlier trade mark. The distinctive character of the opponent's earlier trade mark must be appraised first, by reference to the goods upon which I have found it has been used and, secondly by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

89. The opponent's earlier mark consists of the words 'TAYLOR OF LONDON'. As I have concluded above, this gives the relevant public the impression of a person from London, or an undertaking of that name based in London. As the name Taylor is a fairly common one and London is a large geographical location, I find the mark to have a low level of inherent distinctive character when considered as a totality.

90. In making the comparison between the marks I am proceeding only in the event that my primary finding that no genuine use has been made of the mark is found to be wrong. With that in mind, I proceed on the basis that there has been genuine use of the mark in relation to all of the goods for which it is registered. As a result the mark would be enhanced to some degree through the use made of it, but to what extent I cannot be sure. However, given my approach to this decision, I will proceed on the basis that the distinctive character of the earlier mark has been enhanced through the use made of it.

Likelihood of confusion

91. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the

⁵ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

consumer relying instead on the imperfect picture of them he has kept in his mind.⁶ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and must have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

92. In its evidence the applicant points out that there are other 'Taylor' marks on the register in class 3 and other marks which contain the words 'of London' also in class 3. That is not disputed.

93. I have found that the applicant's marks share a moderate degree of visual similarity with the opponent's earlier right. Aurally the marks share a high degree of similarity. I have identified a low level of inherent distinctive character in the opponent's earlier mark, which (for the purposes of this comparison) has been enhanced by the use made of it, though I cannot conclude to what extent. I have found the parties' goods to be identical I have identified the average consumer, namely a member of the general public. I have concluded that the purchase will be primarily visual, though I do not discount aural or conceptual considerations. The purchasing process will involve a reasonable degree of care and attention.

94. Having found that this opposition failed due to insufficient evidence to support use of the opponent's earlier right, I have, in the event of my being found to be wrong in that conclusion, continued to make an assessment on the merits of the opposition under 5(2). In doing so I have assumed use in respect of all the goods in the specification. Taking all the above factors into account, considering the marks as a whole, and the nature of the purchasing process, I conclude that the differences between the marks outweigh the similarities. In my view the parties' marks both have clear and specific meanings which differ from each other and which the average consumer would immediately grasp. In reaching such a decision I am guided by the comments of the CJEU in Case C-361/04 *The Picasso Estate v OHIM* in which they said:

"56. Such conceptual differences can in certain circumstances counteract the visual and phonetic similarities between the signs concerned. For there to be such a counteraction, at least one of the signs at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately [Case T-292/01 *Phillips-Van Heusen v OHIM — Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 54]."

95. In my view the average consumer will not (either directly or indirectly) confuse the competing marks and as a consequence there will be no likelihood of confusion.

96. In the course of these proceedings both parties have referred me to opposition B1828204, a decision of the (OHIM) Opposition Division. The decision concerns the same parties and similar marks, though not any of the marks at issue in these proceedings. It is clear from decisions such as O/201/04, *Zurich Private Banking*, that decisions of other jurisdictions are not determinative or binding on the decision before me and consequently, I need give it no further consideration not least because I am considering a different average consumer (i.e. one in the UK).

⁶ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27

The case based on 5(3)

97. In light of my findings above I dismiss the opponent's case based on s. 5(3) of the Act due to lack of relevant evidence and the fact that the opponent has not particularised its claim. However, even if I am wrong in my evaluation of the evidence and a reputation had been established, the differences between the marks are such that no link would be established. Without a link being established there can be no successful opposition under section 5(3).

CONCLUSION

98. The opposition fails.

Costs

99. The opposition having failed, the applicant is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place and the applicant filed evidence as well as written submissions in lieu of a hearing. I make the award on the following basis.

Preparing a statement and considering the other side's statement:	£ 300
Preparing evidence and considering the other side's evidence:	£ 500
Written submissions:	£ 300
Total:	£ 1100

100. I order Taylor of London Limited to pay Ashleigh & Burwood Ltd. 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 3rd day of October 2012

**Ms Al Skilton
For the Registrar,
The Comptroller-General**