

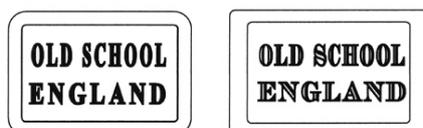
O-415-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No.84352
BY PUNTER OF ENGLAND LIMITED
FOR REVOCATION OF TRADE MARK No. 1505395
STANDING IN THE NAME OF
GLOBAL BRAND GROUP LLC**

AND

**IN THE CONSOLIDATED MATTER OF APPLICATION
No. 2618398
BY PUNTER OF ENGLAND LIMITED
TO REGISTER A SERIES OF TWO TRADE MARKS**



IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 103718 BY
GLOBAL BRAND GROUP LLC**

AND

**IN THE CONSOLIDATED MATTER OF APPLICATION
No. 2632284
BY GLOBAL BRAND GROUP LLC
TO REGISTER THE TRADE MARK
OLD SCHOOL
IN CLASSES 18, 25 AND 35**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 104351 BY
PUNTER OF ENGLAND LIMITED**

AND

**IN THE CONSOLIDATED MATTER OF APPLICATION
No. 2643211
BY PUNTER OF ENGLAND LIMITED
TO REGISTER THE TRADE MARK
OLD SCHOOL
IN CLASSES 18, 25 AND 35**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 400169 BY
GLOBAL BRAND GROUP LLC**

BACKGROUND

1) The following trade mark is registered in the name of Global Brand Group LLC (hereinafter GBG).

Mark	Number	Filing and Registration Date	Class	Specification
OLD SCHOOL	1505395	01 July 1992 15 July 1994	25	Shirts, blouses, trousers, shorts, skirts, jeans, coats, socks, shoes and tee-shirts; all included in Class 25.

2) By an application dated 22 March 2012, subsequently amended, Punter Of England Limited (hereinafter PEL) applied for the revocation of the registration under the provisions of Section 46(1)(b) claiming there has been no use of the trade mark on the goods for which it is registered in the period 21 March 2002 – 20 March 2007 or 20 March 2007 – 19 March 2012. Revocation dates of 21 March 2007 and/or 20 March 2012 were sought.

3) On 14 June 2012 GBG filed a counterstatement denying PEL's claims stating that the marks had been used or that there were proper reasons for non-use.

4) On 20 April 2012 PEL applied to register the series of two trade marks shown on the front page in respect of the following goods in Class 25: Clothing, footwear, headgear.

5) The application was examined and accepted, and subsequently published for opposition purposes on 1 June 2012 in Trade Marks Journal No.6942.

6) On 23 August 2012 GBG filed a notice of opposition. The grounds of opposition are in summary that GBG own the earlier trade mark shown in paragraph 1 above which is similar to the mark applied for and the goods are similar or identical. The mark applied for therefore offends against Section 5(2)(b).

7) On 18 September 2012 PEL filed a counterstatement, which declined to comment on the similarity of the marks or goods but stating that the earlier mark is the subject of a revocation action. PEL also put GBG to strict proof of use.

8) On 17 August 2012 GBG applied to register the trade mark OLD SCHOOL in respect of the following goods and services:

In Class 18: Leather and imitations of leather; trunks and travelling bags; handbags, rucksacks, purses; wallets; card cases; bags; umbrellas, parasols and walking sticks.

Class 25: Clothing; socks; ankle warmers; anoraks; aprons; athletic clothing; vests; clothing for babies, infants and children; pants; undergarments; pyjamas; suits; smocks; robes; gowns; trunks; wraps; belts; shorts; overalls; blazers; jackets; bowties; braces; cagoules; shirts; capes; cardigans; sweaters; scarves; trousers; cloaks; sports clothing; denim clothing; coats; fleeces; jerseys; gloves; pullovers; sweatshirts; jumpers; jogging wear; mackintoshes; polo shirts; T-shirts; raincoats; waterproof and water resistant clothing; windproof clothing; footwear; shoes; boots; slippers; sneakers; trainers; sandals; clogs; sports shoes; flip-flops; moccasins;

wellingtons; waterproof footwear; headgear; ballaclavas; bandanas; caps; hats; beanies; berets; bobble hats; boleros; peak caps; visor caps; fur hats.

Class 35: Retail store and online retail services in connection with the sale of leather and imitations of leather, trunks and travelling bags, bags, card cases, wallets, handbags, rucksacks, purses, umbrellas, parasols and walking sticks, clothing, footwear and headgear; wholesale services in connection with the aforesaid goods; mail-order retail services in connection with the aforesaid goods.

9) The application was examined and accepted, and subsequently published for opposition purposes on 16 November 2012 in Trade Marks Journal No.6966.

10) On 14 January 2013 PEL filed a notice of opposition. The grounds of opposition are in summary:

a) that PEL own the following trade marks:

Mark	Number	Filing and Registration Date	Class	Specification
OLD SCHOOL ENGLAND	CTM 10632768	10 February 2012 28 June 2012	18	Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.
			21	Household or kitchen utensils and containers; combs and sponges; brushes; brush-making materials; articles for cleaning purposes; steel wool; articles made of ceramics, glass, porcelain or earthenware which are not included in other classes; electric and non-electric toothbrushes.
			25	Clothing, footwear, headgear.
	2618398	20 April 2012 pending	25	Clothing, footwear, headgear.

b) That the marks shown above are similar or identical to the mark applied for and the goods are similar or identical. The mark applied for therefore offends against Section 5(2)(b). The form was accompanied by submissions dated 10 January 2013 and a witness statement by Mr Gill the sole director of PEL, dated 8 January 2013. The statement copied in papers from the Registry file relating to PEL's application regarding trade mark 2618398 and a copy of the TM7 from the opposition by GBG to this mark which has been outlined in paragraph 6 above. A request for summary

judgment on the basis of estoppel and abuse of process was filed, despite the fact that at this stage a TM8 had not been filed.

11) On 4 April 2013 GBG filed a counterstatement, which points to slight differences in the marks. They accept that the goods in Classes 18 and 25 were similar but denied there was any similarity between the opponent's goods and the services applied for in Class 35.

12) The cases were consolidated on 15 April 2013 and all the evidence filed in the cases up to this date was accepted into the consolidation.

13) On 23 November 2012 PEL applied to register the trade mark OLD SCHOOL in respect of the following goods and services:

In Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals

In Class 25: Clothing, footwear, headgear

In Class 35: Retail and wholesale and online sales connected with the sale of clothing, footwear, headgear and bags and luggage, trunks and travelling bags, handbags, rucksacks, purses; umbrellas, parasols and chinaware and glassware.

14) The application was examined and accepted, and subsequently published for opposition purposes on 1 March 2013 in Trade Marks Journal No.6981.

15) On 26 April 2013 GBG filed a notice of opposition. The grounds of opposition are in summary that the opponent is the proprietor of trade mark 1505295 detailed in paragraph 1 above and also application 2632284 detailed in paragraph 8 above. The opponent contends that the marks are identical and the goods and services of 1505295, with certain exceptions, are identical or similar. The exceptions referred to are "clothing for animals" in class 18 and "Retail and wholesale and online sales connected with the sale of chinaware and glassware" in class 35, neither of which are opposed. In respect of its opposition under 2632284 there are no exclusions. The opponent contends that the application offends against Section 5(1) and 5(2)(a) of the Act in respect of 1505295 and section 5(1) of the Act in respect of 2632284.

16) On 7 August 2013 PEL filed a counterstatement, which accepted that the marks are identical. This case was also consolidated with the others and all the evidence filed in the cases up to this date was accepted into the consolidation.

17) Both sides filed evidence. The matter came to be heard on 19 September 2013 when GBG was represented by Mr Bryson of Counsel instructed by Messrs J A Kemp; PEL chose not to attend but provided written submissions.

GBG'S EVIDENCE

18) GBG filed two witness statements. The first, dated 17 October 2012 is by Keith Johnston a Member of GBG, a position he has held since January 2009. He states that he has full access to the records of GBG and is authorised to make a statement on its behalf.

He states that the predecessor in title of Old School Clothing to GBG was Harold's Stores Inc. (HS) which manufactured and retailed high-end classic styled ladies and men's apparel. HS operated traditional stores and also sold via catalogues and e-commerce in the USA, Canada and the UK. He states that on 7 November 2008 a voluntary petition of Chapter 7 bankruptcy was granted by the US Court to HS and its affiliates. He states that subsequent to the petition being granted HS began an orderly liquidation under the guidance of its primary creditors, while continuing to trade under the marks HAROLD'S; OLD SCHOOL CLOTHING COMPANY; OLD SCHOOL and OLD SCHOOL CLOTHING COMPANY "OSCC" BESPOKE, via its retail outlets, catalogues and internet. Sales, including in the UK, continued until the first quarter of 2009. He states that HS was quoted on the NASDAQ during 2006-2008 inclusive, and he provides revenue figures for HS. However these figures would cover not only the marks quoted earlier in this paragraph but numerous others assuming that the company purchased in other branded goods to sell in its stores etc. He states that GBG was formed specifically in January 2009 for the purpose of acquiring the intellectual property assets of HS which included the mark in suit. Following a restructure in 2010 the only members of GBG are Mr Johnson and Branded LLC. He also provided the following exhibits:

- KJ1: This consists of marketing materials issued by HS. These show use of the mark OLD SCHOOL CLOTHING COMPANY OSCC. These individual pages which show the clothing are not dated, and it is not clear which pages are part of which catalogue. There are a number of catalogue covers, some dated others not. However, the numbering of the pages is such that it is not possible to be certain where one catalogue starts and another ends. All the prices shown on all the pages are in US\$. However, on the order forms dotted throughout the exhibit it is clear that orders from outside the USA are possible as the costs of such orders, the methods of payment and the identification requirements are clearly set out. The front covers that have dates are as follows:
Page 86: Headed "Harold's" and "Fall and Winter 1995".
Pages 87 and 114: These are identical and are headed "OLD SCHOOL CLOTHING COMPANY" and "Fall and Winter 1995".
Page 138: Headed "Harold's 1996".
Page 142: Headed "Harold's" and "Summer transition 1996".
Page 143: Headed "Old School Clothing Company" and "Summer transition 1996".
Page 156: Headed "Harold's" and "Transition to Fall 1997".
Page 158: Headed "OSCC Old School Clothing Company" and "Transition to Fall 1997".
- KJ2: A copy of the order and shipping details from the catalogues referred to above and already commented upon in exhibit above.
- KJ3: Photocopies of labels used in clothing which show variations on OSCC, Old School Clothing Company, Old School with the words "Oxford Cricket", "Varsity", "POSH", "Brand est.42" and "Blues".
- KJ4: Pictures of clothing with various "Old School" labels sewn on and into them.
- KJ5: A copy of a page from eBay in the UK showing "Old School" brand clothing for sale in UK£ dated 18 August 2012.

19) Mr Johnson also provided evidence relating to the defence of “proper reasons for non-use”. This evidence is the subject of a confidentiality order and so is attached at annex 1 which will not be available to anyone other than the parties and their legal representatives. However, put simply, it shows that GBG have been seeking to reach a licensing agreement for use of the mark in suit in the UK by a third party. The third party is a very large corporation which has agreements in respect of use of other GBG marks in the UK in place. Because of the existing relationship it is hoped that the licensing agreement will be easier to conclude.

20) The second witness statement, dated 17 October 2012, is by Steven Todd Rumsey the Senior Creative Manager at JC Penney, a position he has held since January 2011. He states that during the period January 1997 to November 2008 he was the Director of Marketing for HS. In this capacity he oversaw all marketing and creative functions at HS and reported directly to the CEO. He states that he was responsible “for all company marketing objectives, strategy, brand positioning and creative development”. As part of his role he oversaw the marketing of the OLD SCHOOL brand. He states that he has been asked by GBG to comment on UK sales under the mark OLD SCHOOL up until the demise of HS in 2009 as there was a lack of data available following the acquisition of the mark. He states that he can clearly recollect that the mark OLD SCHOOL was in genuine use in the USA, UK and other countries worldwide until the demise of HS in 2009. He states that the comments made by Mr Johnston in his witness statement are correct.

21) Mr Rumsey states that OLD SCHOOL was a very successful brand for HS and that “sales under the brand occurred at both a personal retail as well as wholesale level in United Kingdom. A significant proportion of sales under the OLD SCHOOL trade mark can be attributed to International sales, which includes the UK.” He states that budgets were not split into individual markets but that a small percentage of the overall budget would have been dedicated to the UK. He states that the order form states that payments had to be in US\$ as HS could not handle other currencies. He points out that the phone number on the sales order is an international toll free number. He states that he attended the annual international apparel tradeshow in Las Vegas known as “Magic”. He states that at this show he meet, solicited and sold to international wholesale buyers including those from the UK.

PEL’S EVIDENCE

22) PEL filed four witness statements, dated 7 November 2012, 20 January 2013, 27 February 2013 and 27 March 2013, by Prabhjit Singh Gill the sole director of PEL. Mr Gill makes much of the fact that Mr Rumsey left HS in November 2008 and yet comments on issues in 2009, and also that Mr Rumsey is not listed as a Director of HS on a Reuters website despite stating that he was the marketing director. Firstly, I accept that comments regarding events after Mr Rumsey left the company are hearsay, but it is perfectly reasonable that he would be aware of such events. As to the list of directors on Reuters; firstly, there is the issue of whether Reuters is the definitive source for such matters, to my mind it is not. It is perfectly normal business practice for an employee to be given a title such as marketing director when they are not an actual director of the company and listed at the equivalent of Companies House. To suggest that these matters undermine Mr Rumsey’s credibility is simply not the case.

23) Next Mr Gill alleges that Mr Johnston is guilty of “a wilfully false statement” when he stated that HS was listed on the NASDAQ in 2008. Mr Gill provides, at exhibit PSG3, a copy of a report from the Houston Chronicle which states that HS is withdrawing from the American Stock Exchange (AMEX). Mr Gill seems to be unaware that AMEX is an America stock exchange and not the only stock exchange in the USA. At exhibit PSG4 he provides a copy of HS’s financial report for the first quarter of 2008 which states that:

“Sales from store locations represented approximately 93% of the Company’s total sales for the thirteen weeks ended May 3, 2008.” And “The Company’s direct catalog [sic] and internet sales represented about 7% of the total sales for the thirteen weeks ended May 3, 2008.”

24) Mr Gill points out that there is no mention of wholesaling. There is no mention of wholesaling in the report and in its overview it is stated: “Harold’s is a multi-channel speciality retailer of ladies’ and men’s apparel, including accessories and footwear. Harold’s markets its merchandise through retail store, catalogs [sic] and its website at www.harolds.com.” Mr Gill states that the opponent, in mentioning wholesaling as part of the activity of HS has “engaged in submitting wilfully false testimony”. Mr Gill provides copies of court documents regarding the bankruptcy of HS which makes it clear that marketing materials, internet archives, catalogue archives and finished goods and samples were all provided to GBG. He states that this is where the opponent obtained the items that it has exhibited regarding use, which is not surprising in the slightest. He also states that as the opponent was liquidating HS it would be aware of the business of HS and that claims that HS was engaged in wholesaling was “all relevant in indicating perjury”.

25) Mr Gill also states:

“14. I am now looking at exhibit PSG 8 which consists of 3 pages printed off from the website of the well-known United States of America Securities and Exchange Commission “SEC” which is a Federal body charged with policing financial markets in that country. Exhibit PSG8 consists of 3 pages; the first two pages list various stock exchanges registered with the SEC, this is relevant to show that the NASDAQ stock exchange which the witness Mr Johnston falsely claims at paragraph 12 of his 17.10.12 statement was the trading portal for shares in Harold’s Stores, Inc, was a different legal entity from the American Stock Exchange from which the company was delisted in mid-2006 as described in the earlier Exhibit PSG3. The final page in this exhibit PSG 8 relates to Over The Counter (OTC) market on which Harold’s Stores LLC was listed from 2006 until its demise as earlier set-out and described in the newspaper report at exhibit PSG3.”

26) This paragraph is very curious. GBG merely stated that HS was listed on the NASDAQ during 2006-2008 inclusive. The earlier press report provided by Mr Gill states that HS voluntarily deregistered from AMEX in June 2006 and that “The Company expects that its shares will be eligible for trading on the Over The Counter Bulletin Board System.” The report also states that the company will continue to file reports as required by the SEC. I fail to comprehend how Mr Gill believes that these exhibits show that GBG is making false claims. Having decided to delist from AMEX there was nothing stopping HS being listed on the NASDAQ in the same financial year. The fact that a newspaper report states that the company expects its shares to be listed on the OTC system does not mean that this actually occurred or that the OTC and the NASDAQ are mutually exclusive. There is simply not enough evidence to reach this type of conclusion.

27) Mr Gill refers to a newspaper article about one of the chairman of HS, court documents and documents from the SEC which state that HS targeted the US market, do not mention anything about wholesaling or selling to the UK and do not show Mr Rumsey as a director. It is unsurprising that HS would primarily target its home market where it owned 42 stores. The fact that these, relatively short, reports concentrate on the main business activities of HS is unsurprising. The fact that sales in the UK and wholesaling are not mentioned does not justify the repeated claims of false evidence being filed by GBG. Mr Gill refers to the requirements to file or report on operating segments. Presumably he does this to establish his claim that HS did not sell via wholesale or in the UK.

28) Mr Gill also accuses me of bias and of providing evidence on behalf of GBG, both charges which I deny emphatically. He states that the Registry held ex-parte talks with GBG and their representatives. This is not how I would characterise a clerk speaking on the telephone to a trade mark agent regarding a query the agent had on IPO procedures. Mr Gill also contends that the Solicitor acting for GBG was also complicit in misleading the Tribunal. This is a serious charge which has, in my opinion, no basis. Mr Gill also refers to part of GBG's evidence where reference is made to three trade marks unrelated to this case, which GBG claim are already licensed for use in the UK to the business partner it is negotiating with regarding the mark in the instant case. Mr Gill appears to be under the illusion that GBG is stating that these marks are preventing the mark in suit being used. I did not take this meaning from the evidence, in fact quite the reverse. I read the evidence as stating that a relationship between GBG and its potential partner for the instant mark already exists in relation to three other trade marks, and that therefore an extension to include a fourth trade mark (OLD SCHOOL) would be quite reasonable.

GBG'S EVIDENCE IN REPLY

29) GBG filed two witness statements. The first, dated 25 May 2013, is by Mr Johnston who has provided evidence already in this case. He utterly refutes the allegations made by PEL and restates that he stands by the evidence of his first statement as it was all true. He also provides evidence which is the subject of a confidentiality order and so will be commented upon in the annex to this decision.

30) The second witness statement, dated 25 May 2013 is by Mr Rumsey who has provided evidence previously in this case. He totally refutes all of the allegations made by PEL and provides at exhibit SJR3 a copy of part of a magazine issued by HS which states that he was indeed Director of Marketing of HS. He states categorically that the evidence he provided in his earlier statement was true.

PEL'S EVIDENCE IN REPLY

31) PEL filed a witness statement, dated 25 May 2013, by Mr Gill who has provided evidence previously in this case. Mr Gill returns to a claim he made earlier in the proceedings of this case when he sought security of costs. At that time he filed a copy of papers which showed that Global Brands Group LLC was voided on the Delaware Registry. However, in their letter of 18 September 2012 GBG's agents (J A Kemp) pointed out:

“The registered proprietor is Global Brand Group LLC and not Global Brands Group LLC. Thus the latest financial information which the Applicant provides to the Registry is wholly erroneous.”

32) Mr Gill states:

“2. I am now looking at Exhibit PSG28 which consists of 5-pages; of a single page print off from the Delaware Division of Corporations website explaining how to obtain public information of a Delaware corporation because J A Kemp in its letter to UKIPO 05.03.2013 misled the Tribunal to believe that the financial information earlier obtained by me on Global Brand Group LLC and Global Brands Group LLC was not from the official company registry source, it claimed the source was a “credit check” this was misleading information from J A Kemp, the Delaware Division of Corporations is a Delaware government body which supplied the latest relevant information on both Global Brand Group LLC and Global Brands Group LLC, the remaining 4 pages in the exhibit PSG28 are a copy of my earlier print-off relating to the similarly named Global Brands Group LLC entity also registered in Delaware, an official snap-shot of that company together with the Delaware company registry’s glossary of terms entitled “Field Definitions”.

33) The exhibit shows that an entity called Global Brands Group LLC was formed on 1 April 2005 and was voided on 6 January 2008. I also note that in their letter dated 5 March 2013 J A Kemp made the following comment:

“The continuing reference to the applicant’s failed request for security in these proceedings is distracting. As we have repeated on numerous occasions, the Applicant has failed to provide any evidence to support the request. Whatever Mr Salthouse may or may not have said during the course of the case management conference which features prominently in Mr Gill’s submissions and witness statement, is irrelevant where there was no legal basis to support the request. The Applicant provided a credit check against an erroneous company. The Applicant maintained their request for security after we pointed out this error.”

34) Not for the first time in this case Mr Gill has reached conclusions simply unsustainable from the evidence actually filed. I note that no evidence regarding the listing for GBG has been provided at any time by Mr Gill. Lastly, Mr Gill makes yet more allegations of impropriety when he states:

“3. I am now looking at exhibit PSG29 which consists of a single page print-off from the well-known Chambers and Partners website relating to the profile of J A Kemp’s Mr Fish which clearly states that Mr Fish is both a solicitor and a barrister but which J A Kemp denied and misled the Tribunal in its letter of 05.03.2013 as being only a trademark attorney in order to render its own criticism of me therefore the fact becomes relevant to the proceedings as a defence to the criticism albeit that the point being raised was the duty of the advocate to the court not the qualification of Mr Fish.”

35) I note that the comments being referred to in the letter from J A Kemp dated 5 March 2013 actually state:

“The registered proprietor continues to incur substantial unnecessary costs in addressing the issues raised by the Applicant and we are no further forward in these proceedings. The allegations now raised against our partner James Fish will result in an additional layer of cost for this firm. For the record, James Fish practices as a

trade mark attorney in these proceedings and is regulated by the IP Regulation Board (IPREG).”

GBG’S FURTHER EVIDENCE

36) GBG filed another witness statement, dated 10 September 2013, by Mr Rumsey. He states that he has been asked to clarify some of his earlier comments regarding sales in the UK. He comments that his former company’s records are not available to him so he “conservatively estimates” that 15% of all international sales could be attributed to sales under OLD SCHOOL, that the UK accounted for around 21-31% of all international sales, of which 20 to 30% would have been under OLD SCHOOL and that certain items such as blouses, skirts, socks and shoes were not sold in the UK. He states that they principally sold shirts, trousers, jeans, T shirts, shorts and coats. GBG also filed a witness statement, dated 18 September 2013 by Mr Johnston who has also provided evidence earlier in this case. He refers to allegations made by Mr Gill and seeks to refute them. However, as the allegations have no basis and have already been dismissed by me earlier in my evidence summary I do not intend to further detail them here.

37) That concludes my review of the evidence. I now turn to the decision.

DECISION

38) Prior to dealing with the actual decision there are a number of preliminary points which require comment. At the earlier Case Management Conference Mr Gill sought an order for security of costs. Tribunal work manual Chapter 7 paragraph 5.7 reads:

“In proceedings before the Tribunal it is usually requested where a party does not carry on business in the United Kingdom or does not appear to have any, or sufficient, assets in the United Kingdom to cover any award of costs made against them, or has not paid previous costs ordered by the Tribunal, OHIM or a Court. Where security is agreed between the parties, appropriate sums of money are deposited or undertakings agreed by third parties such as trade mark agents, solicitors or banks. If there is no agreement that security should be paid, the Tribunal can be asked to intervene and determine the matter.

Requests by UK parties for security for costs from a party which is a national or resident in another member state party to the Brussels or Lugano Conventions may not be granted, unless very cogent evidence of substantial difficulty is provided.⁴⁷

In the case of *Sun Microsystems Inc v Viglen*⁴⁸ the Appointed Person held, following *Nasser v United Bank of Kuwait*,⁴⁹ that security for costs applications needed to be determined on their own merits; simply because a party was resident abroad outside a Brussels or Lugano Convention country would not automatically result in security being ordered. Whether to order security is an act of discretion.

A failure to pay previous costs awards will usually be accepted as good evidence of a difficulty in recovering costs.

⁴⁷ This is because the Civil Jurisdiction and Judgments Act 1982, clarified by a decision in the Court of Appeal (*Fitzgerald v Williams*, The Times, January 3, 1996, C.A.), determines that the Registrar does not have the power to automatically award costs against such a party, as the Conventions introduced

an effective means by which a successful defendant resident in the UK can enforce an order for costs against an unsuccessful plaintiff in another contracting state.

⁴⁸ BL O/585/01

⁴⁹ [2001] EWCA Civ 556”

39) The United States of America is a Brussels Convention member and as GBG is resident in that country security of costs are only required where cogent evidence is provided that GBG is unable to meet any costs awarded against it. In the instant case no such evidence was provided. It was also clear that the company has a licensing agreement regarding three marks not connected to this case with a very large well known high street company. In such circumstances an award of security of costs was not warranted. At the time of the CMC on 19 December 2012 PEL was relying upon a document which related to a different company, and the fact that it was registered in Delaware which was described as the haunt of many illegitimate businesses such as drugs traffickers, embezzlers and money launderers. I was informed that it was very easy to set up a company in Delaware, requiring only about one hour and a few dollars. Given the same situation occurs in many other countries, including the UK, I did not view this last point as particularly valid. No evidence was provided which showed that GBG was anything other than a legitimate business.

40) PEL provided submissions dated 7 November 2012, 23 January 2013, 28 February 2013 and 28 March 2013. Ordinarily I would simply refer to these my decision as and when required. However, some of the submissions are extreme and are not corroborated by the evidence. The unsubstantiated allegations of false statements / perjury are repeated in every set of submissions. Mr Gill seems particularly exercised that Mr Rumsey was not a director of HS, something I have already dealt with earlier in this decision. He also returns to his claim that Mr Rumsey could not comment on the activities of HS after he left. Given that he left in November 2008 and the company went into liquidation in early January 2009 I believe that he was able to reasonably state that the company would continue selling the stock that it had. Mr Rumsey made it very clear in his statement the exact duration of his employment and was not seeking to mislead in any way. For Mr Gill to make the type of allegations he has is intemperat at best. He also comments on the issue of confidentiality, as at the time of writing one of his submissions he had been provided only with a redacted version of Mr Johnston’s witness statement dated 17 October 2012. He refers to “secret trails” and claims it is an abuse of process. Both contentions are clearly ludicrous. He also claims:

“9. Mr Rumsey would not have produced false testimony had Mr Johnston not sought to induce him, Mr Rumsey is the witness sought out and arranged by Mr Johnston with reference to paragraph [3] of Mr Rumsey’s first witness statement.”

And:

“21. A request for costs is made and requested to be off the standard scale because of the opponent proprietor’s conduct in submitting perjured testimony, or at least that no reduction is made in a costs award because this company is a litigant-in-person.”

41) These are very serious allegations which do not appear to be supported by any evidence.

42) On 17 September 2013 Mr Gill provided further submissions. In it he makes the following allegation:

- “1. Paragraph [2] of Mr Keith Johnston’s second witness statement and paragraph [2] of Mr Steven Todd Rumsey’s second witness statement are almost completely identical this is an indicative behaviour that Global Brand Group LLC’s alleged evidence is manufactured and therefore inherently unreliable.

2. Since the witness statements of the above witnesses were drawn up by J A Kemp under the auspices of its Mr Fish this collusion by a “professional” practitioner who is; a solicitor, barrister and trademark attorney, this manufacturing of witness testimony as assisted by its professional representative is contrary to CPR Part 1.1 and CPR Part 1.3 and is wrong and is also wasteful of the Tribunal’s resources.”

43) Given that the paragraphs referred to relate to both men reserving their right to bring libel proceedings against Mr Gill it is hardly surprising that the wording would be identical as I would presume that both men would have sought legal advice on the wording of such a warning from their legal advisor, Mr Fish. This is not the first attack upon the integrity of Mr Fish individually and J A Kemp as a business. The allegations are completely without foundation. Given that the paragraphs referred to relate to both men reserving their right to bring libel proceedings against Mr Gill it is hardly surprising that the wording would be identical as I would presume that both men would have sought legal advice on the wording of such a warning from their legal advisor, Mr Fish. This is not the first attack upon the integrity of Mr Fish individually and J A Kemp as a business. The allegations are completely without foundation. and result either from Mr Gill’s complete lack of understanding of the business world or a wilful misreading of every action taken and word spoken to attempt to twist them to meet some grand conspiracy theory in which everyone, myself and the IPO included, are colluding against him. I am unsure why such a grand alliance would occur or how most of the “players” said to be involved would benefit. Had GBG been manufacturing evidence then they were remarkably inept as they would surely have been capable of ensuring that they had a better paper trail than that filed.

44) Further, given his comments on wasting the Tribunal’s resources it is ironic that his latest submissions cover 35 pages and is merely a detailed rehash of what Mr Gill has said many, many times in his previous witness statements and submissions. I therefore do not intend to say anything further about his submissions as I do not find them useful to my decision.

45) The revocation action is based upon Section 46(1)(a) & (b) of the Trade Marks Act 1994, the relevant parts of which read as follows:

“46.-(1) The registration of a trade mark may be revoked on any of the following grounds -

- (a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;
- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- (c)

(d)

(2) For the purposes of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.”

46) PEL alleges that the mark has not been used in the five years subsequent to its registration or in the five years prior to the date of the application for revocation. The periods in question are, therefore, 21 March 2002 - 20 March 2007 for Section 46(1)(a) and 20 March 2007 - 19 March 2012 for the Section 46(1)(b) ground.

47) Where GBG claims that there has been use of the trade mark, the provisions of Section 100 of the Act make it clear that the onus of showing use rests with it. It reads:

“100. 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.”

48) In *Pan World Brands Ltd v Tripp Ltd* (EXTREME Trade Mark) [2008] RPC 2 Mr Arnold Q.C. (as he was then) acting as the Appointed Person set out the following:

“Standard of proof

29 The standard of proof is the ordinary civil standard of proof upon the balance of probabilities. In *LABORATOIRE DE LA MER Trade Marks* [2002] F.S.R. 51 at [9] Jacob J. said:

“Those concerned with proof of use should read their proposed evidence with a critical eye—to ensure that use is actually proved—and for the goods and services of the mark in question. All the t's should be crossed and all the i's dotted.”

This remains wise advice. Jacob J. did not suggest, however, that the standard of proof was anything other than the normal standard.

30 NODOZ Trade Mark was a decision under section 26(1)(b) of the Trade Marks Act 1938 . In that case the applicant for rectification had adduced positive evidence, which included independent evidence from a prominent representative of the relevant

trade, that the trade mark had not been used by the proprietor. As the passage from the judgment quoted by the hearing officer shows, the proprietor relied upon a single isolated transaction as showing that there had been *bona fide* use of the trade mark during the relevant period. Furthermore, the transaction was alleged to consist of the supply of pharmaceutical tablets to an individual resident in Britain directly by a US supplier, and there was no evidence that the tablets or an accompanying invoice had actually arrived. It was specifically in that context that Wilberforce J. said that “if not conclusive proof, at any rate overwhelmingly convincing proof” was required (a statement which the hearing officer misquoted in his decision). In my judgment this statement is an application of the general principle that, when applying the standard of proof on the balance of probabilities, the less probable the event alleged, the more cogent the evidence must be to demonstrate that it did indeed occur: see *Re H (Minors)* [1996] AC 563 at 586. I consider that the hearing officer was correct to say that this principle is equally applicable under section 46(1) of the 1994 Act. Whether he was correct to regard it as applicable to the present case I shall consider below.

What constitutes evidence of use?

31 Basing himself upon the first three sentences of the passage I have quoted from *MOO JUICE*, counsel for the applicant submitted (1) that a mere assertion of use of a trade mark by a witness did not constitute evidence of use sufficient to defeat an application [for revocation] for non-use, and (2) it followed that mere testimony from a representative of the proprietor was not enough and such testimony had to be supported either by documentary records or corroborated by an external witness. I accept submission (1) but not submission (2). Kitchin J.'s statement that “bare assertion” would not suffice must be read in its context, which was that it had been submitted to him that it was sufficient for the proprietor to give evidence stating “I have made genuine use of the trade mark”. A statement by a witness with knowledge of the facts setting out in narrative form when, where, in what manner and in relation to what goods or services the trade mark has been used would not in my view constitute bare assertion. As counsel for the applicant accepted, it might not be possible for a trade mark proprietor to produce documentary evidence: for example all the records might have been destroyed in a fire. In such circumstances I do not see anything in either, the Directive, the 1994 Act or the 2000 Rules which would require the proprietor to adduce evidence from an external witness (which is not to say that it might not be advisable for the proprietor to do so).

32 In this respect it is important to note that, as counsel for the applicant rightly conceded, the position in OHIM is different. This is because Rule 22(2) and (3) of Commission Regulation 2868/95 of 13 December 1995 implementing the Community Trade Mark Regulation provide:

“(2) The indications and evidence for the furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based, and evidence in support of these indications in accordance with paragraph 3.

(3) The evidence shall, in principle, be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices,

photographs, newspaper advertisements, and statements in writing as referred to in Article 76(1)(f).”

Rule 22(3) makes documentary records the primary form of evidence required for proof of use in OHIM. In these circumstances it is understandable that the jurisprudence of the Court of First Instance and of the Boards of Appeal indicates that witness statements from representatives of the proprietor unsupported by documentary records or external evidence should be given little weight.”

49) When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied namely: the judgments of the Court of Justice of the European Union (“CJEU”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). The position² was helpfully summarized by Ms Anna Carboni, sitting as the Appointed Person, in BL O-371-09 *SANT AMBROEUS*, which included reference to *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28.

“(a) 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].

(b) 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].

(c) 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].

(d) 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].

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

(ii) 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].

(e) 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].

(f) 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].”

50) Whilst GBG have stated that they sold goods in the UK and have contended that their catalogues were sent to the UK they have provided no corroborative documentary evidence. The catalogues provided are all dated 1995-1997 inclusive, which is significantly before the earliest date of this revocation action 21 March 2002. GBG has not provided a list of UK customers who received catalogues or who placed orders. All of the prices are in US\$ and despite claims that the toll free number applies worldwide there is no evidence of any orders being placed or shipped to customers in the UK. At the very least one would have thought that some invoices from the relevant period showing purchases by UK customers would have been available. As part of his evidence Mr Gill provided copies of court documents regarding the bankruptcy of HS which makes it clear that marketing materials, internet archives, catalogue archives and finished goods and samples were all provided to GBG. This statement has not been contested by GBG, and indeed I have assumed that it must be correct or otherwise how would GBG have been able to provide copies of such old catalogues. However, as the bankruptcy took place in 2008 I find it odd that catalogues from 1995 were present and yet no more recent documentation relating to any sales in the UK was present. GBG have provided statements from Mr Johnson who as an officer of GBG can have had no direct experience of the dealings of HS and can only comment on what he has been told and what he can glean from the obviously limited paperwork inherited from HS. The other evidence comes from statements by Mr Rumsey, who served as the Director of Marketing for HS in the period January 1997 – November 2008. I have no reason to doubt his integrity and to my mind he is a credible independent witness as he now holds a senior position in a large corporation in the USA with, as far as I am aware, no links to GBG. He states that during his time with HS he oversaw all marketing and creative functions at HS and was responsible “for all company marketing objectives, strategy, brand positioning and creative development”. He states that as part of his role he oversaw the marketing of the OLD SCHOOL brand. His recollection is that the mark was sold worldwide including the UK. However, he does not comment on what steps HS took to market the brand in the UK, nor does he state how they identified potential clients in the UK who could be sent their catalogue. I would question whether he can accurately comment upon sales figures other than from information he was told by others within the company as he does not refer to any written communications within the company that he read and remembers which stated sales figures for the UK. I also note that HS used a number of marks which included the words OLD SCHOOL and it is not clear which mark/marks Mr Rumsey had in mind when providing his evidence that OLD SCHOOL had been used on goods sold in the UK. I have no doubt that HS would have considered the UK as a potential market given that there are a number of US citizens living in the UK and, broadly, the USA and the UK can be said to speak the same language.

51) I bear in mind that the legal test is whether the evidence shows “exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]”. The question arises however, as to whether they actually

targeted the UK or simply responded to orders which might have been forthcoming from curious UK consumers with American connections. I would have found Mr Rumsey's evidence more compelling had he provided a cohesive narrative on the marketing efforts made by HS to promote its goods under the mark in suit in the UK. Further, the relative precision with which he describes the proportion of international goods sold in the UK under the OLD SCHOOL mark at paragraph 36 above is in contrast to the vague description he provides at paragraph 21 above as to the proportion of HS's goods sold internationally, which he describes only as "a significant proportion". In the absence of such evidence and in the absence of any paper corroboration I am not persuaded that GBG has shown that it made genuine use of its mark in the UK during the periods concerned. GBG have submitted that in negotiating with a potential business partner over use of the mark in suit constitutes genuine use. I accept that GBG has a business relationship with the company concerned, and that the potential partner is a significant company in the UK clothing sector. However, such activity not equate to genuine use. **I therefore find that there has been no genuine use of the trade mark in the UK in the relevant periods.**

52) I now go onto consider whether GBG has shown good reasons for non-use. A useful starting point for this issue is *Kerly's Law of Trade Marks and Trade Names (Fourteenth edition at 10-72 to 10-73)* because it makes reference to Article 19(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994:

"References to "proper" reasons for non-use" need to be interpreted in accordance with Art. 19(1) of TRIPS which uses the expressions "valid reasons based on the existence of obstacles" to the genuine use which is required. "Circumstances arising independently of the will of the owner of the trademark, such as import restrictions on or other governmental requirements for goods and services protected by the trademark, shall be recognized as valid reasons for non-use"

53) Also of note is the judgment of the CJEU in *Haupt v Lidl Stiftung & Co KG* where it was stated:

"It follows that only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as 'proper reasons for non-use' of that mark."

54) In the *INoTheScore* Application (BL O-276-09) Mr Iain Purvis QC, sitting as the Appointed Person, referred to the above case and stated:

"37. In *Armin Haupt* the ECJ established the following test for identifying proper reasons: "...only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as 'proper reasons for non-use' of that mark."

38. The phrase "independently of the will of the proprietor" (which comes from Article 19(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)) is crucial here."

55) The CJEU reaffirmed its position in *Il Ponte Finanziaria SpA v OHIM* Case C-243/06P [2008] ETMR 13 when it stated:

“The concept of “proper reasons”... refers essentially to circumstances unconnected with the proprietor of a trade mark which prevent him from using the mark...”

56) I also note the decision in *Magic Ball* [2000] R.P.C. 439 where Mr Justice Park stated:

“As regards the new Act, there has been no discussion yet in the High Court or above of the words “proper reasons”. There is one earlier decision of a hearing officer in *Invermont Trade Mark* [1997] R.P.C. 125. The officer, in a passage cited and relied on by his colleague who decided the present case, said this:

“... bearing in mind the need to judge these things in a business sense, and also bearing in mind the emphasis which is, and has always been placed on the requirement to use a trade mark or lose it, I think the word proper, in the context of section 46 means: apt, acceptable, reasonable, justifiable in all the circumstances. I do not think that the term “proper” was intended to cover normal situations or routine difficulties. I think it much more likely that it is intended to cover abnormal situations in the industry or the market, or even perhaps some temporary but serious disruption affecting the registered proprietor’s business. Normal delays occasioned by some unavoidable regulatory requirement, such as the approval of a medicine, might be acceptable but not, I think, the normal delays found in the marketing function. These are matters within the businessman’s own control and I think he should plan accordingly.”

On the facts of the INVERMONT case the decision was that the reasons for non-use were not “proper”. However, the facts were too different from the present case for the particular decision to afford any guidance. I have no disagreement with anything which the hearing officer said in the INVERMONT case. I would only add the comment that, while the adjectives which he puts forward--“apt, acceptable, reasonable, justifiable in all the circumstances”--seem to me to be well chosen, it must not be forgotten that the statutory word which falls to be applied is “proper”, not any of the near-synonyms which the hearing officer suggested.”

57) In terms of proper reasons for non-use, and taking the authorities in the round, it seems to me that proper reasons for non-use are not something to be accepted lightly. Having a reason for non-use, from the proprietor’s subjective point of view, is not the same as having “proper” reasons which calls for, in my view, an objective test. The test for “proper” reasons relates to obstacles or impediments or other events causing serious disruption. I also note that the authorities differentiate between events that are independent of the will of the proprietor and events that are within its control.

58) GBG’s contention is that if I were to find that what it had done was not genuine use then the negotiating of an in-principle licensing agreement during difficult trading conditions constitutes a proper reason for non-use. It was contended that the problems experienced by the retail sector had the effect of making it very difficult to conclude a licensing agreement. I fully accept that the retail sector, and indeed the whole of the UK economy has been through a torrid few years. The fact that GBG had difficulty in reaching

a license agreement because of market conditions does not constitute a proper reason for non-use, as judged against the authorities set out above. Whilst it is clear that GBG has negotiated with one company it has not provided any evidence that it considered casting the net wider. It is simply untenable that no new business ventures have been launched in recent years because of the state of the economy. It was GBG's decision to restrict itself to one potential partner and therefore it is not immunized from the requirement to genuinely use its trade mark. **The claim to there being proper reasons for non-use is dismissed.**

59) The application for revocation is successful. The mark is revoked with effect from 21 March 2007.

60) I now turn to consider the opposition to the application filed by PEL on 20 April 2012. This was opposed by GBG under Section 5(2)(b) on the basis that it owned an earlier trade mark 1505395 which in paragraph 51 I have revoked with effect from 21 March 2007. **Therefore, at the date of the application GBG did not have an earlier right and so the opposition must fail. Application 2618398 will therefore be registered.**

61) I now turn to consider GBG's application 2632284 and the opposition under section 5(2)(b) which reads:

"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,

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

62) An "earlier trade mark" is defined in section 6, the relevant part of which states:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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."

63) PEL is relying upon its two trade marks listed in paragraph 10 above, both of which are clearly earlier trade marks. Given the interplay between the date on which the application was published and the date on which the opponent's registrations completed their registration procedures, the earlier trade marks are not subject to proof of use, as per section 6A of the Act. It is clear that PEL's strongest case lies in its CTM mark and so I shall simply deal with this mark in the opposition. This is in spite of the fact that GBG have made a last minute application for invalidity (filed 16 September 2013) in respect of PEL's CTM mark. The invalidity is based upon GBG's UK mark 1505395 which I revoked earlier in this decision and which consequently was not valid at the date that PEL filed its CTM application (10 February 2012).

64) When considering the issues under Section 5(2) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice to the European Union (CJEU) 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] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 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)*. In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below, by reference to the CJEU cases, which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(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/ 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; 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;

(e) 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 in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

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

(i) 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;

(j) 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 process

65) I must now determine the average consumer for the goods and services of the parties. Clearly, both are concerned with, broadly speaking, clothing, footwear, headgear, bags and trunks, leather goods and the retailing of the aforesaid goods. Both parties' specifications would be aimed at the general public wishing to purchase clothing, footwear, headgear, leather items or bags etc. These products will vary in cost as will the level of attention paid. A pair of socks will not command as much attention as a tailor made suit, but at the very least the consumer will be considering if the item will fit, what material it is made of and whether it will meet their needs. I therefore consider that the average consumer for such products will take considerable care in their purchase. For the most part the goods covered in the specifications will be displayed in shops, online or in catalogues and the shopper will self select although they could also be purchased in a specialist outlet. Whilst aural considerations must not be overlooked it is the visual aspect of the competing trade marks that will dominate the selection process.

Comparison of goods

66) For ease of reference I reproduce the specifications of both parties:

Applicant's specification	Opponent's specification
<p>In Class 18: Leather and imitations of leather; trunks and travelling bags; handbags, rucksacks, purses; wallets; card cases; bags; umbrellas, parasols and walking sticks.</p> <p>Class 25: Clothing; socks; ankle warmers; anoraks; aprons; athletic clothing; vests; clothing for babies, infants and children; pants; undergarments; pyjamas; suits; smocks; robes; gowns; trunks; wraps; belts; shorts; overalls; blazers; jackets; bowties; braces; cagoules; shirts; capes; cardigans; sweaters; scarves; trousers; cloaks; sports clothing; denim clothing; coats; fleeces; jerseys; gloves; pullovers; sweatshirts; jumpers; jogging wear; mackintoshes; polo shirts; T-shirts; raincoats; waterproof and water resistant clothing; windproof clothing; footwear; shoes; boots; slippers; sneakers; trainers; sandals; clogs; sports shoes; flip-flops; moccasins; wellingtons; waterproof footwear; headgear; ballaclavas; bandanas; caps; hats; beanies; berets; bobble hats; boleros; peak caps; visor caps; fur hats.</p> <p>Class 35: Retail store and online retail services in connection with the sale of leather and imitations of leather, trunks and travelling bags, bags, card cases, wallets,</p>	<p>In Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.</p> <p>In Class 25: Clothing, footwear, headgear.</p> <p>.</p>

handbags, rucksacks, purses, umbrellas, parasols and walking sticks, clothing, footwear and headgear; wholesale services in connection with the aforesaid goods; mail-order retail services in connection with the aforesaid goods.	
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67) The accepted test for comparing goods is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed by the Advocate General in *Canon*; ETMR 1. The factors to be taken into account are:

- a) The respective uses of the respective goods;
- b) The respective users of the respective goods;
- c) The physical nature of the goods;
- d) The respective trade channels through which the goods reach the market;
- e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be found on the same or different shelves;
- f) The extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods in the same or different sectors.

68) I also take into account the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) case T-133/05 i.e.

“29 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).”

69) The question of complementary goods/services has been considered by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case T- 325/06. The GC stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685 , paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057 ; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757 , paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000 , paragraph 48).”

70) In relation to the class 18 goods the words “Leather and imitations of leather; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks” appear in both parties specifications. They are therefore identical. The application also has the term “bags” which must be regarded as very similar to “travelling bags and handbags”. Equally the term “wallets” in the application must be very similar to the term “purses”. Lastly “card cases appears in the application and these are similar to “purses”.

71) Turning to the class 25 goods PEL has the terms “Clothing, footwear, headgear” registered. These terms encompass the whole of GBG’s specification and as such they must be regarded as identical.

72) Lastly, considering the retail services, in *Oakley, Inc v OHIM* - T-116/06 (GC) it was held that retail services for goods X may be complementary and therefore similar to goods X, where goods X are identical. In the instant case the opponent’s goods have exactly the same items as the retail services applied for by the applicant with the exception of “bags, card cases and wallets”. As indicated in paragraph 62 above these are either very similar or similar.

Comparison of trade marks

73) The trade marks to be compared are as follows:

Applicant’s mark	Opponent’s mark
OLD SCHOOL	OLD SCHOOL ENGLAND

74) It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

75) To my mind the words “OLD SCHOOL” are the dominant and distinctive elements of both marks. I believe that the term “ENGLAND” in the opponent’s mark will be seen as simply a geographical reference to here the products originate from.

Distinctive character of the opponent’s earlier trade marks

76) The opponent has not provided any evidence of use of its mark and so cannot benefit from an enhanced reputation. However, to my mind the PEL’S mark, and in particular the OLD SCHOOL element of it, is inherently quite distinctive for the goods for which it is registered. It could be said to allude to school type clothing but it has no obvious meaning when used on, broadly speaking, clothing, footwear, headgear or bags.

Visual / Aural and Conceptual similarity

77) Clearly both marks contain the words OLD SCHOOL. The only difference being that in the opponent's mark the word "ENGLAND" appears as the last word. Clearly, there is a significant visual, aural and conceptual similarity between the marks albeit there are minor differences. Overall, the respective marks share a high level of similarity.

Likelihood of confusion

78) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and services and vice versa. The lack of evidence does not allow me to find that PEL'S mark had a reputation for any goods for which it is registered, however the goods in question are either identical or highly similar and the marks are also highly similar such that, allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the goods provided by GBG are those of PEL or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore succeeds in total.**

79) I now turn to consider the opposition to the application filed by PEL on 23 November 2012. This was opposed by GBG under Section 5(1) and 5(2)(a) on the basis that it owned an earlier trade mark 1505395 which in paragraph 59 have revoked with effect from 21 March 2007. It was also opposed in respect of application 2632284 which I have determined cannot be registered in paragraph 78 above. **Therefore, at the date of the application GBG did not have an earlier right and so the opposition must fail. Application 2618398 will therefore be registered.**

CONCLUSION

80) The revocation action in respect of trade mark 1505395 succeeds. Opposition number 103718 fails. Opposition number 104351 is successful. Opposition number 400169 fails.

COSTS

81) PEL has been successful in all four actions and is entitled to a contribution towards its costs. However, in TPN 4/2007 unreasonable behaviour is cited as a reason to increase or withhold costs. In paragraphs 38 – 44 I have dealt with the serious and unfounded allegations made by Mr Gill against GBG's witnesses and legal representatives. Given the behaviour of Mr Gill in this case I decline to make any award of costs.

Dated this 18th day of October 2013

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