

O-422-17

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3164942
BY CKL HOLDINGS N.V.
TO REGISTER THE TRADE MARK
SANDRA
IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 407677 BY
SANDRO ANDY**

BACKGROUND

1) On 17 May 2016, CKL Holdings N.V (hereinafter the applicant) applied to register the trade mark “SANDRA” in respect of the following goods in Class 25: “Clothing; shoes; headgear; shirts; leather clothing; belts (clothing); furs (clothing); gloves (clothing); scarves; ties; hosiery; socks; slippers; beach shoes; ski boots; sport shoes; underwear.”

2) The application was examined and accepted, and subsequently published for opposition purposes on 5 August 2016 in Trade Marks Journal No.2016/032. The applicant claimed a priority date of 1 March 2016 based upon trade mark 4253091 registered in France.

3) On 14 August 2016 Sandro Andy (hereinafter the opponent) filed a notice of opposition, subsequently amended. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
SANDRO	EU 8772568	21.12.09 27.07.10	25	Outer clothing and underwear for men, women and children; clothing of leather and of imitation leather; fur clothing; sportswear (other than for diving); blousons; gabardines (clothing); raincoats; coats; mantillas; mittens; overcoats; trench coats; parkas; wraps; fur coats; stuff jackets (clothing); suits; masquerade costumes; jackets; smocks; aprons (clothing); jumpsuits (clothing and underwear); crop tops; cardigans; pullovers; sweatshirts; sweaters; knitted goods (clothing); tank tops; waistcoats; skirts; petticoats; trousers; three-quarter length trousers; jeans; gaiters; dungarees; dresses; shirts; undershirts; henleys; shorts; Bermuda shorts; overcoats; ready-made clothing; paper clothing; muffs; pyjamas; dressing gowns; peignoirs; pants, including bathing trunks; swimwear and beachwear; jerseys, including swimsuits; slips; bodies (teddies); bustiers; knickers; briefs; brassieres; corsets; stocking suspenders; socks; stockings, hosiery; bandannas (neckerchiefs); scarves; shawls; neckerchieves; mufflers; fur stoles; gloves (clothing); belts (clothing); braces; ties; bow ties; pocket handkerchiefs (clothing); collar protectors; footed pyjamas; Brassiere; layettes; saris; shoes; footwear, including beach footwear; sports shoes; boots; ankle boots; wooden shoes; esparto shoes or sandals; sandals; slippers; slippers; headwear; hats; veiling (clothing); caps; visors (hatmaking); berets; caps, including swimming caps; head bands; turbans.
SANDRO	M827287	International Registration	25	Outerwear and underwear for men, women and children; leather and imitation leather clothing; fur clothing; sportswear (other than for diving); blousons; gabardines; waterproof clothing; coats;

		(designating the UK) 04.03.04 Date of protection in UK 22.10.09	mantillas; mittens; overcoats; trench coats; parkas; pelerines; pelisses; stuff jackets; suits; masquerade costumes; jackets; blouses; aprons (clothing); coveralls (clothing) and slippers (underwear); cross-over tops; cardigans; pullovers; sweatshirts; sweaters; knitwear (clothing); tank tops; waistcoats; skirts; petticoats; trousers; gaucho trousers; jeans; ski trousers; dungarees; dresses; shirts; chemisettes; T-shirts; shorts; Bermuda shorts; topcoats; ready-made clothing; paper clothes; sleeves; pyjamas; dressing gowns; house coats; undershorts, including swimming trunks; beach and swimwear; singlets, including swimming suits; underwear; leotards (bodies); bustiers; knickers; briefs and pants; bras; corsets; suspenders; socks; stockings, tights; bandannas; foulards; shawls; neckerchiefs; scarves; stoles (furs); gloves; belts (clothing); braces; ties; bowties; pockets (clothing); neck scarves; baby sleepsuits; bras; layettes; saris; shoes; footwear, including beach footwear; sports footwear; boots; ankle boots; clogs (footwear); espadrilles; sandals; slippers; boot socks; headgear; hats; veils; caps; visors; berets; bonnets, including bathing caps; headbands; turbans.
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a) The opponent contends that its marks and the mark applied for are very similar and that the goods applied for are identical and/or similar to the goods for which the earlier marks are registered. As such the mark in suit offends against Section 5(2)(b) of the Act.

4) On 13 April 2016 the applicant filed a counterstatement basically denying that the marks are similar and stating that the two parties are not identical or similar. I will deal with the applicant's claims regarding the goods and marks later in my decision. The applicant put the opponent to strict proof of use of its goods in class 25.

5) Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard. Only the opponent provided written submissions which I shall refer to as and when necessary in my decision.

OPPONENT'S EVIDENCE

6) The opponent filed two witness statements. The first, dated 21 April 2017, is by Annie Virieux-Aboulker the opponent's French trade mark attorney. She states that the information comes from her own knowledge, the opponent's records and the internet. She provides the witness statement to satisfy the request for proof of use. She provides a number of exhibits which she states shows use of

the opponent's marks on the clothing for which they are registered and also shows details of the opponent's 27 stores in the UK. Further the exhibits have, she contends, extracts from UK fashion magazines, pictures of the opponent's stores, and internet records. She states that these all show use of the mark in the UK. She also states that in 2011 the opponent sold goods in the UK to the value of £4.1 million, forming a significant proportion of overall EU sales of £10.5 million. The exhibits provided are as follows:

- AV1: Articles from *Drapers* (a fashion industry magazine) dated July 2012 referring to the opening of a shop in London selling "Sandro Homme" Menswear which its states is just along the street from the brands Womenswear flagship. Other internet articles such as "justopenedlondon" state that a Sandro clothes store opened at Canary Wharf on 31 March 2014. Another article from *Drapers* which provides some history to the use of the mark in the UK. This states that the first sales of clothes were from a concession in Selfridges in 2008, with the first stand-alone store opening in 2009. The article states that in 2011 the UK turnover was £4.1 million from five concession stores and six stores owned by the opponent. The exhibit includes other articles which are either not dated or so poorly photocopied that the details cannot be made out to any degree of certainty.
- AV2: This consists of pages from the "waybackmachine" website dated May 4 & 5 2012, 23 December 2013, 28 November 2014, 21 December 2014, 5 & 10 September 2015, 27 November 2015, 19 February 2016, March 2016, 24 April 2016. These are very poorly photocopied but appear to show items of clothing for sale. However, the website is www.sandro-paris and virtually all of the descriptions are in French (e.g. "veste", "Chapeau" and "ceinture") and the pricing is in Euros. I accept that there are English words, but these appear to be use of universal descriptors such as T-shirts, jeans, cardigans, polos and sweats, rather than aimed specifically at the UK market as the majority of descriptive words are in French and the shops listed are all in France. However, this exhibit, whilst not showing use in the UK, does show use of the mark in France in respect of Women's jackets, hats, trousers, tops, waistcoats, cardigans, robes, shorts, T-shirts, blouses, dresses, coats, shoes and boots, gloves, belts, handbags, scarves and skirts; and Men's blazers, jackets, waistcoats, coats, shirts, shoes and boots.
- AV3: This consists of press articles. The first is from *Vogue UK* (dated 16 February 2017), which refers to the floating of the company on the stock market. The second, dated 20

February 2016, is about French fashion and includes an interview with the creative designer from the opponent company. It includes examples of clothing from the opponent such as tops, dresses, shirts, jackets, coats and shoes and shows the cost of each item in UK£. Other articles are also included but many are in languages other than English (with no translation provided) or do not add to the information already gathered. Again this exhibit is poorly photocopied. Indeed page 8 contains wording which has presumably been highlighted and then photocopied which has the effect of redacting the evidence so it cannot be read.

- AV4: This would appear to be a press release regarding the floatation of the opponent company. I note that it states that the company owns three, what it describes as, “French brands” (Sandro, Maje and Claudie Pierlot). It states that in 2015 sales were 675 million Euros worldwide.
- AV5: This consists of two pages of an internet search, which is undated and shows men’s hats and shoes under the Sandro label for sale in UK£.
- AV6: Extremely poor photocopies of what appear to be labels with the word SANDRO written upon them. Other than a carrier bag the items to which they are attached cannot be made out and none are dated.

7) The second witness statement, dated 24 April 2017, is by Annie Blake the British Trade Mark Attorney for the opponent. She states that her evidence is derived from internet searches. She provides the following exhibits:

- AB1: An undated screen print of the opponent’s website which shows a list of countries worldwide where the opponent sells its SANDRO branded products. This list includes 14 EU countries.
- AB2: More undated screen prints from the opponent’s website showing the number of stores in various EU countries and photographs of shop fronts. It would appear that the number of stores in each country are as follows: Germany 16; France 218; Italy 13; Spain 22; and the UK 22. It is possible to make out a date on certain of the pictures. Two of the German stores are dated September 2015 and February 2016. None of the other stores have visible dates.

- AB3: Press articles regarding the floatation of the company and which also mention the value of the company and sales figures. However, as the figures and value relate to the company as a whole and the articles also make it clear that the company owns a number of brands this does not assist me in my decision.
- AB4: Pages 1-6 appear to be from the same website, Models.com. They appear to show photographs of front covers of catalogues dated between Spring/Summer 2015 and Summer 2017. I note that Ms Blake does not comment on these pages in her statement. Page 7 comes from Pinterest and states that the images shown are from advertising campaigns for Sandro in 2014. The photos show women wearing various items of clothing, four of which are linked to Sandro and are dated between 2013 and 2015. Pages 8 & 9 show a female with the words Spring/Summer 15 collection alongside, and a male with the same wording alongside him. No details of where the campaigns ran, if these are catalogues or brochures where or to whom they were distributed, or if they are related to advertising campaigns where the advertisements appeared. Page 10 shows a shop window with the photograph of the male in it, but no details as to where or when this was other than Ms Blake's claim that it was in London. Page 11 shows a billboard with a female and the word SANDRO, but no details are provided as to where or when this photograph was taken, other than Ms Blake claiming it was in Paris.
- AB5: Two screen prints from the opponent's twitter account which shows pictures of a dress and two pairs of training shoes. The label with Sandro can be seen clearly in the dress and the wording is in English referring to it as a daisy dress. The wording for the shoes is very difficult to read and appears to be in French. No dates are visible or prices for either item. Ms Blake states that the company has sent 1,685 tweets which show the latest products and events that the company attend. She states that the opponent has had a twitter account since November 2014 and has attracted 13,800 followers.
- AB6: Consists of pages from the internet website "waybackmachine". Pages 1-5 are from the opponent's French website dated between 21 December 2013 and 13 July 2015. They show pictures of various items of clothing for women and men, but only shows prices on a page from the last date for a dress, two women's tops and a ladies shoe. Pages 6-9 are said to be from the opponent's Spanish website, dated 6 May 2016 to 6 June 2016. There are no pictures of products, no prices and they are written in Spanish with no translation.

8) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

9) The only ground of opposition is 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.”

10) 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.”

11) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. The applicant requested that the opponent provide proof of use and, given the interplay between the date that the opponent’s marks were registered / given protection in the UK (27 July 2010 and 22 October 2009) and the date that the applicant’s mark was published (5 August 2016), the proof of use requirement bites. Section 6A of the Act states:

“6A. - (1) This section applies where -

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

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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 European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

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

12) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its mark has been made. In the instant case the publication date of the application was 5 August 2016, therefore the relevant period for the proof of use is 6 August 2011 – 5 August 2016. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at

[20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

13) Also in *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law in respect of use of EU trade Marks since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

14) The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark).

Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

15) Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown

16) I also look to *Awareness Limited v Plymouth City Council*, Case BL O/230/13, where Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the

proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

17) I also take into account the following cases which, although they refer to use on a shop are, I believe, relevant to the instant case. In *Aegon UK Property Fund Limited v The Light Aparthotel LLP*, BL O/472/11), Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“17. unless is it obvious, the proprietor must prove that the use was in relation to the particular goods or services for which the registration is sought to be maintained.

18) In its evidence the opponent filed a number of documents in languages other than English. In *Le Mans* (BL O/012/05) Mr Arnold, as he was, acting as the Appointed Person commented upon the admissibility of foreign language documents as follows:

“29. Secondly, the opponent submitted that some limited assistance could be gained from the untranslated documents in a foreign language, for example where the subject-matter was obvious even without knowledge of the language in question. This question I have found more difficult because the documents in question are in French, and I have some knowledge of French. This means that I have been tempted to read the documents relying upon my own knowledge of French. I consider, however, that this temptation must be resisted. The question cannot sensibly depend upon the language skills of the tribunal. If the documents were in (say) Mandarin, I would be wholly unable to read them. Even though they are in French, if I were to rely upon my own knowledge of that language, there would be an obvious risk that I would

mistranslate them. Furthermore, the parties would have no opportunity of scrutinising the accuracy of my translations and correcting them where wrong.

30. Rule 72 of the Trade Marks 2000 provides:

(1) Where any document or part thereof which is in a language other than English is filed or sent to the registrar in pursuance of the Act or these Rules, the registrar may require that there be furnished a translation into English of the document or that part, verified to the satisfaction of the registrar as corresponding to the original text.

(2) The registrar may refuse to accept any translation which is in her opinion inaccurate and thereupon another translation of the document in question verified as aforesaid shall be furnished.

In the present case the Registrar did not exercise the power conferred by rule 72(1) to require translations of the documents in question to be filed. In my judgment, however, that does not excuse the opponent's failure to supply translations or affect the admissibility of the untranslated documents.

19) In the instant case the opponent's trade mark agents did not offer an explanation of what the documents show, instead providing more sweeping statements to the effect that the documents prove use. It may be that they were looking at the original documents upon which the details and pictures very visible, but I have to consider what has been filed which is unsatisfactory as I have set out earlier. Although some of the exhibits being promotional/ marketing were obvious from the photographs.

20) I take into account the comments of Mr Arnold Q.C (as he was) when acting as the Appointed Person in *Extreme* BL/161/07 where he commented on the issue of unchallenged evidence and cross examination:

"Unchallenged evidence

33. *Phipson on Evidence* (16th ed) states at paragraph 12-12:

In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be

accepted on that point. The rule applies in civil cases as it does in criminal. In general the CPR does not alter that position.

This rule [sic] serves the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a particular important point, he will be in difficulty in submitting that the evidence should be rejected.

However the rule is not an inflexible one...

34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the Court of Appeal in *Markem Corp v Zipher Ltd* [2005] EWCA Civ 267, [2005] RPC 31 at [59]-[60].

35. In my judgment the learned editors of *Phipson* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *BRUTT Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness's evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1 WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.

37. Despite this, it is not an uncommon experience to find parties in registry hearings making submissions about such unchallenged evidence which amount to cross-examination of the witness in his absence and an invitation to the hearing officer to disbelieve or discount his

evidence. There have been a number of cases in which appeals have been allowed against the decisions of hearing officers who have accepted such submissions. Two recent examples where this appears to have happened which were cited by counsel for the proprietor are *Score Draw Ltd v Finch* [2007] EWHC 462 (Ch), [2007] *BusLR* 864 and *EINSTEIN Trade Mark* (O/068/07). Another recent example is *Scholl Ltd's Application* (O/199/06). I consider that hearing officers should guard themselves against being beguiled by such submissions (which is not, of course, to say that they should assess evidence uncritically).”

21) I am willing to accept that the opponent has a successful clothing business operating throughout Europe, which has a turnover measurable in £millions. The articles in newspapers and magazines, whilst no doubt reliant upon the opponent's press release for many of the details, would have been substantially authenticated by the publications. The statements regarding turnover under the mark SANDRO in the UK and the EU have not been challenged and fit in with the overall narrative. Whilst the evidence regarding precisely what the business actually sells is somewhat sketchy it is clear that they have offered a variety of items of men's and women's clothing, hats and shoes for sale in at least the UK and France during the relevant period. Each of the opponent's specifications includes the following “Outerwear and underwear for men, women and children; footwear; headwear /headgear”. To my mind the terms “Outerwear and underwear for men, women and children;” are the equivalent of “clothing”. For the purposes of the comparison test I shall use the following specification for each of the opponent's marks “Clothing; footwear; headgear”.

22) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably

circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public will 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 decision

23) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

24) Both parties' specifications have individual items of clothing, footwear and headgear named but also contain, the three words “clothing, footwear and headgear” or words which are their equivalent. Such goods will be sold in, inter alia, traditional retail outlets on the high street, through catalogues and on the Internet. The specifications of both parties are unlimited, and so I must keep all of these trade channels in mind. The average consumer of the goods at issue is a member of the general public (including businesses) who is likely, in my opinion, to select the goods mainly by visual means. I accept that more expensive items may be researched or discussed with a member of staff. In this respect I note that in *New Look Ltd v OHIM Cases- T-117/03 to T-119/03 and T-171/03*, the General Court (GC) said this about the selection of clothing:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the

conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“50..... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

25) In the same case the Court also commented upon the degree of care the average consumer will take when selecting clothing. It said:

“43. It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C 342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

26) Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of clothing such as socks, a woollen hat or a pair of slippers; the average consumer will pay attention to considerations such as size, colour, fabric and cost. **Overall the average consumer is likely to pay a medium degree of attention to the selection of items of clothing, footwear and headgear.**

Comparison of goods

27) In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

28) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“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 trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

29) The goods to be compared are as follows (only one specification is shown for the opponent as both mark shave, after the proof of use test, identical specifications):

Applicant's goods	Opponent's goods
Clothing; shoes; headgear; shirts; leather clothing; belts (clothing); furs (clothing); gloves (clothing); scarves; ties; hosiery; socks; slippers; beach shoes; ski boots; sport shoes; underwear.	clothing; footwear; headgear

30) In its counterstatement the applicant stated:

“The applicant accepts that there are some similarities between the respective classifications. However, it is important to note that the mere fact that a particular good is part of another does not suffice in itself to prove that the goods provided to the public are similar. In particular, their

nature, intended purpose and the consumers, may be completely different (reference is made to the Judgment of the ECJ of 27 October 2005, case no: T-336/03 –Mobilix v Obelix). Simply because a mark is seeking protection for an extremely broad specification of goods available, i.e. “clothing”, cannot imply per se that any other trademark protected for a narrower specification should be able to deny its registration. This would result in a clear trespassing of the UK legislator’s intent and go beyond the scope of the Act.

The additional goods of the subject mark, such as “belts” clearly differentiate the subject mark. As a result, it appears that the nature and purpose of the goods of the opponent’s mark are different from the goods of the subject mark, besides importantly differing further with regard to their intended use.

Further, the aforementioned additional goods specified under class 25 of the respective marks would almost certainly be offered for sale in different outlets. These goods would likely be sold in general clothing stores. Even in larger stores the goods would be sold in separate, distinct areas.”

31) To my mind, the case relied upon by the applicant is not on all fours with the instant case as there the earlier mark had a much narrower specification than the mark applied for. In the instant case this is reversed, which makes the position totally different. Clearly the terms “clothing” and “headgear” which are found in both specification are identical. To my mind, the term “clothing” in the opponent’s specification encompasses the following terms in the applicant’s specification “shirts; leather clothing; belts (clothing); furs (clothing); gloves (clothing); scarves; ties; hosiery; socks; underwear” and so these must be regarded as identical. Similarly, the term “footwear” in the opponent’s specification encompasses the following terms in the applicant’s specification “shoes; slippers; beach shoes; ski boots; sport shoes;” and so these must be regarded as identical. **Overall, the specifications of the two parties are identical.**

Comparison of trade marks

32) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant

components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, Bimbo SA v OHIM, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

33) It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
SANDRO	SANDRA

34) The opponent correctly points out that the only difference between the two marks is to be found in the last letter with the first five letters, “SANDR”, being identical. It states that the letters “a” and “o” are very similar in being rounded and that in some writing the difference between the letters may not be distinguishable. It points out that the marks are 83% identical, that this identity is at the start of the mark, the most important element, and the only difference is at the end which can be slurred. It further states that even if pronounced properly the marks sound similar, and that as are both names there is a conceptual similarity. It further contends that whilst SANDRA is a female name it is unclear to the opponent and native English speakers whether SANDRO is male or female.

35) I accept and indeed agree with the majority of the points that the opponent makes. The marks are clearly visually and aurally similar, given that they are identical for the first five letters it is hard to see how they could not be thus considered. However, when it comes to the conceptual similarity I find myself at odds with the views of the opponent. To my mind, the gender of the name would not be the crucial aspect for the average UK citizen. Clearly the applicant's mark, SANDRA, is a well-known, indeed common, English first name for a female. The opponent's mark would be viewed as a foreign word, and the opponent contends, a name of indeterminate gender. The general public is well used to distinguishing between different names, particularly a common British name and a foreign sounding

name. **To my mind, the conceptual differences far outweigh any visual or aural similarities. Overall the marks are not similar.**

Distinctive character of the earlier trade mark

36) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

37) The opponent contends that its mark would be seen by the average UK consumer as a name, which I am happy to accept. The mark has no meaning in respect of the goods for which it is registered. The opponent’s mark is **inherently distinctive to a medium degree. The opponent has, just about, shown use of its mark but given the specification for which it is registered, the absence of information regarding market share and the enormity of the market in the UK for clothing, footwear and headgear, the level of sales shown is not sufficient to warrant enhanced distinctiveness.**

Likelihood of confusion

38) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is 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. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods is a member of the general public including businesses who will select the goods by predominantly visual means, although I do not discount aural considerations and that they are likely to pay a medium degree of attention to the selection of clothing, footwear and headgear.
- the marks of the two parties are not similar.
- The opponent's mark has a medium level of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- the specifications of the two parties are identical.

39) In view of all of the above, and allowing for the concept of imperfect recollection there is no likelihood of consumers being confused into believing that the goods applied for under the mark in suit and provided by the applicant are those of the opponent or provided by an undertaking linked to it.

The opposition under Section 5(2) (b) therefore fails.

CONCLUSION

40) The opposition in relation to all the goods applied for has failed.

COSTS

41) As the applicant has been successful it is entitled to a contribution towards its costs.

Preparing a counterstatement and considering the other side's statement	£300
Consideration of opponent's evidence & submissions	100
TOTAL	£400

42) I order Sandro Andy to pay CKL Holdings N.V. the sum of £400. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of September 2017

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