

O/448/11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2556777  
BY XU CAIJUN TO REGISTER THE TRADE MARK**

**ÇARSYDA**  
珈仕达

**IN CLASSES 3, 14, 18 & 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 101301  
BY KUVERA S.P.A.**

## BACKGROUND

1. On 24 August 2010, Xu Caijun ("XC") applied to register

CARSYDA  
珈仕达

as a trade mark for the following goods:

**Class 3:** Hair lotions; non-medicated bath lotions; washing preparations; cleaning preparations; floor wax; perfumes; dentifrices; cosmetics; potpourris (fragrances); essential oils.

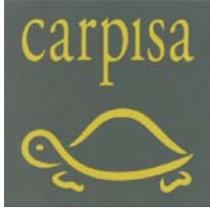
**Class 14:** Trinkets (jewellery); paste jewellery; jewellery; tie clips; cuff links; clocks; wrist watches; cases for watches (presentation); electronic clocks; watch cases.

**Class 18:** Handbags; pocket wallets; valises; furniture coverings of leather; articles made from leather; leather straps; umbrellas; canes; shopping bags; clothing for pets.

**Class 25:** Clothing; leather belts (clothing); swimsuits; waterproof clothing; football shoes; footwear; headgear for wear; hosiery; gloves (clothing); neckties.

Following examination, the application was accepted and published for opposition purposes on 17 September 2010.

2. On 16 December 2010, Kuvera S.P.A. ("Kuvera") filed a notice of opposition which, following amendment, now consists of grounds based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Kuvera's opposition, which is directed against all of the goods in XC's application is, under sections 5(2)(b) and 5(3) of the Act, based upon the following trade mark:

Trade Mark	No.	Designation Date	Registration Date	Goods
 <p>The applicant claims the colours green and gray as an element of the mark.</p>	M821045	<p><b>In relation to classes 18 and 25:</b></p> <p>18.06.2003 IC claimed from 07.02.2003 (Italy)</p> <p><b>In relation to class 14:</b></p> <p>21.06.2005</p>	<p><b>In relation to classes 18 and 25:</b></p> <p>21.08.2004</p> <p><b>In relation to class 14:</b></p> <p>25.05.2006</p>	<p><b>18</b> –Leather and imitation leather and goods made of these materials namely bags, handbags, briefcases, suitcases, wallets, document cases, key holders, purses, trunks and travelling bags, animal skins and hides, umbrellas, parasols and walking sticks.</p> <p><b>25</b> - Clothing namely jackets, hats, caps, shirts, ties, trousers, coats, sweaters, skirts, pullovers, t-shirts, socks, stockings, tights, gloves, scarves, jeans, underwear, nightwear, tracksuits, swimsuits, footwear.</p> <p><b>14</b> - Clocks, watches and chronometers; jewelry namely bracelets, rings, necklaces, earrings, ankle chains, pendants, pins, cufflinks.</p>

3. In relation to its objection based upon section 5(2)(b) of the Act, Kuvera said:

“3. [XC’s] mark is visually and aurally similar to [Kuvera’s] trade mark. Both marks have the same initial three letters, “CAR” and end in the letter A, and both marks consist of seven letters which makes them visually similar. The three letters that differ in the marks are in the middle of the marks and therefore the differences are less noticeable when considering the marks visually. The differences in the marks also consist of a consonant followed by a vowel followed by a consonant. In both marks the vowel can either be pronounced as, “Eye” or “Ee” and therefore the marks are aurally very similar when taking into account the identical start and endings. Although both marks contain device elements, the word elements are more prominent and more weight will be given to the word elements (confusion is likely to occur due to the similarities of the words).

4. The goods in the application are considered to be identical and similar to those in the international registration...”

In relation to its objection based upon section 5(3) of the Act it says:

“6. [Kuvera’s] trade mark has been used on the goods in the international registration in the UK since at least 2007. In this time [Kuvera] has established a reputation for the trade mark in relation to those goods as a “Luxury brand.” The use of [XC’s] trade mark for the goods in the application by [XC] without due cause would take unfair advantage as the confusion in the market place would allow [XC] to capitalise on [Kuvera’s] investment and work in building the reputation of its [trade mark]. It will also be detrimental to [Kuvera’s] trade mark as any goods sold by [XC] of a lesser quality or through a less exclusive sales environment may be attributed to [Kuvera] and its “Luxury brand” reputation may be damaged.

7. There is also a likelihood that the strength of [Kuvera’s] trade mark would be diluted through the use and registration of confusingly similar marks lessening the exclusive nature of the brand as perceived by [Kuvera’s] customers.”

And finally, in relation to its objection based upon section 5(4)(a) of the Act it says:

“8. The unregistered trade mark CARPISA has been used in the UK from as early as 9 August 2007 in relation to jewellery, leather and imitation leather goods, bags, luggage, clothing, footwear and headgear. The trade mark has acquired common law rights in these goods through establishing a reputation and goodwill within the UK. The use of [XC’s] trade mark will give rise to confusion in the market place and cause damage to [Kuvera’s] business and/or reputation.”

4. On 15 March 2011, XC filed a counterstatement. In his counterstatement XC explains the derivation of his trade mark, draws the tribunal’s attention to the state of the registers in respect of other trade marks which he considers to be on a par with the instant proceedings and provides arguments as to why, in his view, the competing trade marks are distinguishable; I will refer to the comments in XC’s counterstatement as necessary below.

5. Only Kuvera filed evidence. Neither party asked to be heard; Kuvera filed written submissions in lieu of attendance at a hearing. As with the comments in XC’s counterstatement, I will refer to these written submissions as necessary below.

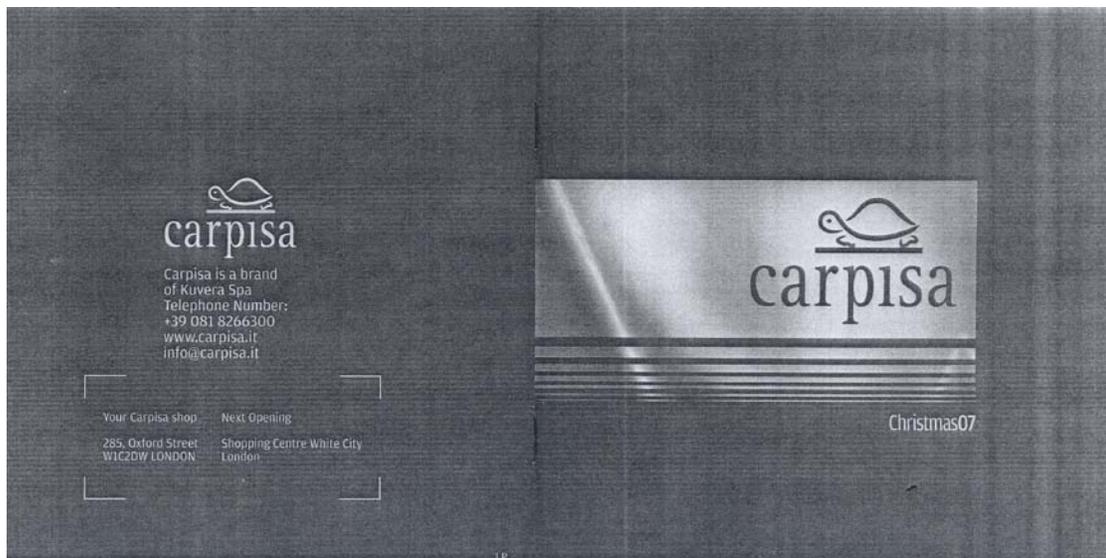
## **EVIDENCE**

6. Kuvera’s evidence consists of a witness statement, dated 13 May 2011, from Maurizio Carlino, Kuvera’s Managing Director. Mr Carlino describes exhibit MC3 to his statement in the following terms:

“4....is a commercial agreement between my company and Jamino Ltd. This agreement provides Jamino Ltd with an exclusive licence to use the CARPISA trade mark in relation to marketing and retailing Kuvera’s S.p.A’s products within the UK.

5. My company has established CARPISA as a luxury brand through the quality of the products sold under the mark, the way the products are marketed, the look of the CARPISA retail outlets, their locations and the sales and management techniques used in retailing the goods...”

7. Mr Carlino goes on to say that the CARPISA trade mark was first used in the United Kingdom in August 2007. Exhibit MC4 consists of a copy of a catalogue from Christmas 2007. The front page of the catalogue looks like this:



8. Mr Carlino says:

“6. The catalogue shows the mark in use with the device element and also as a word only mark. The catalogue shows the marks in use on bags, purses, belts, wallets, braces, caps, make-up kits and accessories, grooming kits, key-rings, watches, hats, scarves, gloves, jewellery boxes, personal organisers, umbrellas and other similar items and accessories.”

9. I note that while the catalogue provided does contain items priced in £, the manner in which they are expressed is somewhat unusual. For example, on page 174 of the exhibit a bag is shown as costing “£23,9”, on page 175 a baseball cap is shown as costing “£9,9”, on page 178 a wallet is shown as costing “£16,9”, on page 180 a watch is shown as costing “£22,9” and on page 186 a suitcase is shown as costing “£83,9”. In the absence of any information to the contrary, I have assumed that the comma is

intended to represent a full stop and so, for example, the cost of the watch on page 180 is in fact £22.90.

10. Exhibit MC5 consists of five catalogues two of which (pages 302-307 and 308-310 appear to be undated). The others date from Spring 2008 (pages 272-301), Winter 2008/2009 (pages 240-271) and Summer 2009 (pages 189-230). All of the catalogues show prices in £ (although the Spring 2008 catalogue and the undated catalogue at pages 302-307 show the prices in the same rather unconventional manner mentioned above). All of the brochures refer to a shop in Oxford Street London, with the Winter 2008/2009, Summer 2009 (and the undated brochure at pages 308-310) referring to additional shops at the Bluewater and Westfield Shopping Centres in Kent and London respectively. The introductions to the Spring 2008 and Summer 2009 catalogues contain the following text respectively:

“This time the style, details and colours, the shapes and materials of the new lines of bags and accessories...”

And:

“...The feast of colours and shapes that you experience during the journey is a perfect match for Carpisa handbags and suitcases...”

11. In relation to the positioning of the Carpisa shops Mr Carlino says, inter alia:

“8. The positioning of these stores is also paramount in retaining CARPISA as a luxury brand. The locations have been chosen to establish CARPISA in the UK’s premier shopping street in London and also the UK’s premier shopping centres....”

12. Exhibit MC6 consists of what Mr Carlino describes as pages taken from the Bluewater and Westfield shopping centres leasing brochures, which indicate that the annual footfall at the shopping centres mentioned was 26 million and 23 million respectively. Also included in this exhibit is an extract obtained on 9 May 2011 from the on-line encyclopedia Wikipedia for the words “Oxford Street”. Mr Carlino notes that the extract explains that Oxford Street London is: “Europe’s busiest shopping street” and that it is home to: “major department stores and numerous brands’ flagship stores”. I also note that the entry explains that: “It is the major shopping street in central London, although not the most expensive or fashionable...”

13. Mr Carlino explains that the CARPISA trade mark has featured in advertising in the national press in the United Kingdom and on the London Underground. Exhibit MC7 consists of a half page advertisement which appeared in *The Sunday Times* on 7 February 2010. The advertisement shows Kuvera’s word and device trade mark together with the following text:

“The Italian bestseller handbag.”

14. Exhibit MC7 also contains a number of (what appear to be) undated photographs taken on the London Underground which (where the station can be identified) were taken at Shepherd's Bush underground station. The billboards shown are of a significant size and frequency and all show, inter alia, Kuvera's device trade mark together with the word CARPISA presented in upper case. With the exception of the word and device appearing on a range of turnstiles, all of the billboards appear to bear the wording mentioned in paragraph 13.

15. Exhibit MC8 consists of invoices (in Italian) which Mr Carlino explains relate to the promotion of Kuvera's brand on 125 London buses (between 28 January 2008 and 10 February 2008) and on 200 London buses (between 22 November 2010 and 5 December 2010, the latter of which is after the material date in these proceedings). A photograph of a London bus bearing the advertisement to which Mr Carlino refers is also provided which, I note, contains, inter alia, the word carpisa alone, the word and device and the words "The bestseller Italian handbag." Also included in this exhibit is a sales order dated 3 October 2008 for the Bluewater magazine together with a copy of the advertisement which appeared in the magazine and a proforma invoice and photographs relating to what Mr Carlino refers to as a "launch event for CARPISA" which appears to have taken place at "Sketch" in Conduit Street, London on 7 November 2007. The word and device trade mark can be seen in the first of the two photographs provided.

16. Exhibit MC10 consists of what Mr Carlino describes as "excerpts from my company's company profile". He goes on to say that the advertising spend for CARPISA worldwide has been over €10m in each year since 2008. He points out that Kuvera sponsor a range of high profile sports teams, sporting stars and music events. I note that the exhibit refers to: FIN team, Offshore Carpisa/Yamamay team, Carpisa Neapolis Festival, Napoli Soccer team (women), Busto Arsizio Volley Team and Carpisa CISS Basket Naples (all of which appear to be Italian in origin) as is the swimmer Federica Pellegrini. Mr Carlino states that there are over 500 CARPISA stores either owned by Kuvera or for which franchises have been granted in 14 different countries.

17. Turnover (which has not been split by class) for goods sold under the CARPISA trade mark in the United Kingdom has been as follows:

<b>Year</b>	<b>Turnover – (£)</b>
2007	470,658
2008	1,740,856
2009	2,072,445
2010	2,044,934

18. Exhibit MC11 consists of a range of invoices dated 19 July 2007, 31 July 2008, 31 October 2008, 29 May 2009, 31 May 2010, 30 July 2010 and 30 November 2010 sent by Kuvera to Jamino Ltd all of which bear Kuvera's word and device trade mark. While I think it is fair to say that the majority of the entries relate to bags of one type of another

e.g. handbags, fabric bags, synthetic bags, leather bags, straw bags, travel bags, beach bags, trolleys/luggage etc. there are also entries for a wide range of other goods such as briefcases, jewellery cases, wallets, document holders, credit card holders, coin holders, leather pouches, leather key holders, diary holders, luggage covers, umbrellas, playing card holders, beauty cases, watch holders, travel kits, mobile phone holders, purses, money belts, cases for glasses, lipstick cases, make-up kits, organisers, PC cases, metal pillboxes, metal mirrors, metal cigarette cases, metal bookmarks, metal key holders, mirrors, gloves, hats, leather belts, scarves, mobile phone pendants and watches.

19. That concludes my summary of the evidence filed to the extent that I consider it necessary.

## **DECISION**

20. The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act. I will deal first with the objection based upon section 5(2)(b) which reads as follows:

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

(a)....

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

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

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

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

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

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

22. In these proceedings Kuvera is relying upon the trade mark shown in paragraph 2 above, which bearing in mind both designations' dates, constitutes an earlier trade mark under the above provisions. I note that in his counterstatement XC did not ask Kuvera to provide proof of use of its trade mark (as per The Trade Marks (Proof of Use, etc) regulations 2004) for that part of its International Registration which was, in principle, susceptible to such a request.

### **Section 5(2)(b) – case law**

23. The leading authorities which guide me are from the CJEU (Court of Justice of the European Union): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

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

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

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

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

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

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

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

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

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

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

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

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

### **The average consumer and the nature of the purchasing process**

24. 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 its submissions Kuvera said:

“7. The specifications in the application and [the registration] cover a broad range of goods which are everyday purchases and, as they are not restricted in any way, should be considered to span the whole spectrum of type, value and quality. The average consumer that should be taken into account when comparing the marks is the general public. The goods are likely to be the subject of self selection within retail establishments or through catalogues or websites and therefore the average consumer is likely to pay an average level of attention to their selection of the goods.”

25. As all of the goods at issue in these proceedings are everyday consumer items, I agree with Kuvera that the average consumer will be a member of the general public. I also agree that the goods are, for the most part, likely to be the subject of self selection from retail outlets, catalogues and websites. However, as Kuvera point out, the cost of some of the goods at issue can vary considerably. Keeping that in mind, it is, in my

experience, not unusual for some retail premises to keep some of the goods (jewellery, watches and perfumes for example) housed in locked glass cabinets; however, even in those circumstances, the average consumer is likely to have inspected the goods visually before approaching a sales assistant. Considered overall, I think the selection of all of the goods will be predominantly a visual one; while aural considerations may play their part, in my view, it will be to a lesser extent. In its submissions Kuvera says the average consumer will pay an average level of attention when selecting the goods at issue. As many of the goods at issue are for use on, to be worn by or for the average consumer's personal adornment, I think that the average consumer will pay at least an average level of attention to the selection of the majority of the goods, a level of attention which is likely, in my view, to increase as the cost and importance of the goods increases i.e. the average consumer is likely to pay far more attention when selecting, for example, a watch than they would when selecting, for example, a non-medicated bath lotion.

### Comparison of goods

26. For the sake of convenience the goods to be compared are as follows:

<b>Kuvera's goods</b>	<b>XC's goods</b>
<p><b>14</b> - Clocks, watches and chronometers; jewelry namely bracelets, rings, necklaces, earrings, ankle chains, pendants, pins, cufflinks.</p> <p><b>18</b> –Leather and imitation leather and goods made of these materials namely bags, handbags, briefcases, suitcases, wallets, document cases, key holders, purses, trunks and travelling bags, animal skins and hides, umbrellas, parasols and walking sticks.</p> <p><b>25</b> - Clothing namely jackets, hats, caps, shirts, ties, trousers, coats, sweaters, skirts, pullovers, t-shirts, socks, stockings, tights, gloves, scarves, jeans, underwear, nightwear, tracksuits, swimsuits, footwear.</p>	<p><b>Class 3:</b> Hair lotions; non-medicated bath lotions; washing preparations; cleaning preparations; floor wax; perfumes; dentifrices; cosmetics; potpourris (fragrances); essential oils.</p> <p><b>Class 14:</b> Trinkets (jewellery); paste jewellery; jewellery; tie clips; cuff links; clocks; wrist watches; cases for watches (presentation); electronic clocks; watch cases.</p> <p><b>Class 18:</b> Handbags; pocket wallets; valises; furniture coverings of leather; articles made from leather; leather straps; umbrellas; canes; shopping bags; clothing for pets.</p> <p><b>Class 25:</b> Clothing; leather belts (clothing); swimsuits; waterproof clothing; football shoes; footwear; headgear for wear; hosiery; gloves (clothing); neckties.</p>

27. In its submissions Kuvera said:

“8...The goods in classes 14, 18 and 25 of the application are identical and/or similar to those in the respective classes [in its registration].”

28. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 the GC said:

“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).”

29. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services 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 or services 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 or services in the same or different sectors.

30. Insofar as complementary goods and services are concerned, the comments of the Court of First Instance (now the General Court) in *Boston Scientific Ltd v OHIM* case T-325/06 are relevant i.e.

“82 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).”

31. I should begin by saying that when construing the goods for which Kuvera’s trade mark is protected, the presence of the word “namely” in each class operates to limit the goods to only those goods which follow the word “namely”.

#### **Class 14**

32. Given the wording used in both parties’ specifications and having applied the guidance in *Gérard Meric*, it is clear that the “trinkets (jewellery)”, “paste jewellery”, “jewellery”, “cuff links”, “clocks”, “wrist watches” and “electronic clocks” in XC’s application in this class must be considered identical to the goods in Kuvera’s registration in class 14. That leaves “tie-clips”, “cases for watches (presentation)” and “watch cases”. In my experience jewellery for use with ties may be called either a “tie-clip” or a “tie-pin”; as Kuvera have the word “pins” at large in its specification in class 14, it must, in my view, include tie pins which would in turn be identical to the tie clips in XC’s application. As for presentation cases for watches and watch cases, as, in my experience, such cases are often specifically designed to carry a particular watch, they are, given their intended purposes and trade channels, complementary to watches and, in my view, similar to a high degree.

#### **Class 18**

33. Applying the same approach mentioned above, the “handbags”, “pocket wallets”, “valises”, “furniture coverings of leather”, “articles made from leather”, “umbrellas”, “canes” and “shopping bags” in XC’s application in this class must, in my view, be considered identical to the goods in Kuvera’s registration in class 18. That leaves “leather straps” and “clothing for pets”. As the “leather straps” in XC’s application could, for example, be leather straps for use with bags, they are, given their nature, intended purpose and channels of trade, similar to bags to a high degree. While the physical nature of clothing for pets may be the same as the materials from which Kuvera’s goods are made, their respective methods of use and intended purposes are different and they are not, as far as I am aware, in competition with or (in any meaningful way)

complementary to Kuvera's goods. If there is any similarity between clothing for pets and Kuvera's goods, it must only be a low level of similarity.

### **Class 25**

34. On the principles outlined in *Gérard Meric*, the competing goods must be considered identical.

### **Class 3**

35. Having listed the goods in Class 3 of XC's application Kuvera go on to say:

"9. As the relevant consumers for [XC's] products are the general public the users of the above products will be the same as those for [Kuvera's] products. The goods are complimentary to those of [Kuvera] as consumers are accustomed to fashion labels diversifying their brands to encompass class 3 goods such as lotions, cosmetics, perfumes etc. The goods in class 3 in the application are therefore similar to the goods [in Kuvera's registration]."

36. Although Kuvera are opposing all of the goods in class 3 of XC's application, in its submissions it argues that goods such as "lotions", "cosmetics", "perfumes" etc. would be considered "complimentary" to its own goods in classes 14, 18 and 25 as the average consumer is accustomed to fashion labels diversifying their brands. A similar argument has already been considered by the GC in *Mühlens GmbH & Co KG v OHIM* Case T-150/04, where the comparison was between class 3 goods (perfumery and toiletries) and goods in classes 18 and 25 (bags and clothing). The GC stated:

"34 In this regard, it is clear from Article 8(1)(b) of Regulation No 40/94 that a likelihood of confusion between two identical or similar marks can exist only within the limits of the principle of speciality, that is to say, where, as has been pointed out at paragraph 27, regardless of the distinctive character which the earlier mark enjoys as a result of the awareness which the relevant public may have of it, the goods or services at issue are identical or similar in the eyes of that relevant public.

35 Nevertheless, it cannot be ruled out, particularly in the fashion and body and facial care sectors, that goods whose nature, purpose and method of use are different, quite apart from being functionally complementary, may be aesthetically complementary in the eyes of the relevant public.

36 In order to give rise to a degree of similarity for the purposes of Article 8(1)(b) of Regulation No 40/94, this aesthetically complementary nature must involve a genuine aesthetic necessity, in that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use these products together (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685,

paragraphs 60 and 62).

37 However, the existence of an aesthetically complementary nature between the goods at issue, such as that referred to in the previous paragraph, is not enough to establish similarity between those goods. For that, the consumers must consider it normal that the goods are marketed under the same trade mark, which normally implies that a large number of producers or distributors of these products are the same (*SISSI ROSSI*, paragraph 63).

38 In the current proceedings, the applicant claims only that the public is accustomed to fashion industry products being marketed under perfume trade marks owing to the practice of granting licences. Yet, if proved, that point alone would not be sufficient to compensate for the absence of similarity between the goods at issue. Such a point does not, in particular, establish the existence of an aesthetically complementary connection between perfumery goods on the one hand and the leather goods and clothing, referred to at paragraph 3 above, on the other hand, so as to mean that one is indispensable or important for the use of the other and that consumers consider it ordinary and natural to use those goods together.

39 The applicant nevertheless claims that the goods at issue have in common their importance for a person's image and appear together in fashion magazines. In this respect, it should be pointed out that, apart from the fact that this argument, which was not pleaded in the hearings before OHIM, has been submitted out of time, the point does not suffice, in any event, to establish the existence of an aesthetically complementary nature, such as that referred to above in paragraph 36."

37. As Kuvera identified in its submissions, its strongest case is (probably) in relation to the complementary nature of some of the competing goods. However, as the GC points out complementary means that one product is indispensable or important for the use of the other and that consumers consider it ordinary and natural to use those products together. Whilst I accept that the users of the competing goods may be the same, in reality that tells one little. The nature of the goods are different as are their intended purposes and methods of use, they are neither in competition with one another nor are they complementary in the sense described by the GC. In short, XC's goods in class 3 are not similar to Kuvera's goods in classes 18 and 25. Insofar as the clash between classes 3 and class 14 are concerned, this was considered by the Hearing Officer in (BL-O-280/09); I agree with and gratefully adopt her reasoning when she said:

"23. Jewellery is unnecessary for the use of cleaning preparations, toiletries and perfumery and vice versa. Are the goods of an 'aesthetically complementary nature'? It seems to me that if perfumery and clothing are not considered by the CFI to be complementary and therefore not similar, then any link between perfumery and jewellery is even more tenuous. The argument may be stronger where clothing and jewellery is concerned, although not as strong as in *El Corte*

*Inglés* (for shoes and bags). In *Oakley*, the CFI considered how far one can take an argument about aesthetically complementary goods, in particular, with regard to jewellery/watches and clothing:

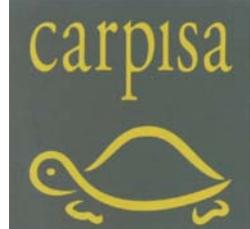
“85 Notwithstanding the fact that, as held in paragraphs 63 to 70 above, the signs are very similar, there is no similarity whatsoever between, in particular, retail services concerning eyewear, on the one hand, and items of clothing and leather goods, on the other hand. The earlier trade mark does not cover, directly or indirectly, goods similar to ‘eyewear, sunglasses, optical goods and accessories, watches, timepieces, jewellery, decals, and posters’.

86 The intervener’s argument that eyewear, jewellery and watches could be similar or complementary to items of clothing cannot succeed, since, as correctly pointed out by OHIM, the relationship between those goods is too indirect to be regarded as conclusive. It must be borne in mind that the search for a certain aesthetic harmony in clothing is a common feature in the entire fashion and clothing sector and is too general a factor to justify, by itself, a finding that all the goods concerned are complementary and, thus, similar (*SISS/ ROSSI*, paragraph 49 above, paragraph 62).”

38. In summary, I have found that: (i) there is no clash between XC’s goods in class 3 and any of the goods in Kuvera’s registration, (ii) that XC’s goods in class 14 are identical or highly similar to Kuvera’s goods in class 14, (iii) with the exception of clothing for pets (which I found to be at best similar to only a low degree), XC’s goods in class 18 are identical or highly similar to Kuvera’s goods in class 18, and (iv) XC’s goods in class 25 are identical to Kuvera’s goods in class 25.

**Comparison of trade marks**

39. The trade marks to be compared are:

Kuvera’s trade mark	XC’s trade mark
	

40. 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 components of the respective trade marks and, with that

conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

### **Distinctive and dominant components**

41. Kuvera describes its own trade mark in the following terms:

“The trademark consists of the outline of a walking turtle viewed in profile, obtained by using a schematized arrangement of stylized lemon green lines, above which is the word "CARPISA" in fancy Roman small type, also in lemon green, the whole of which is placed against a background in gray.”

42. In my view, Kuvera’s trade mark consists of three elements i.e. the word carpisa, a stylised device of what both parties agree is a turtle and the colours claimed. As far as I am aware, neither the word carpisa nor the stylised device of a turtle either describe or are non-distinctive for any of the goods for which Kuvera’s trade mark stands registered; as such, they are both distinctive elements. In terms of their relative sizes, both elements are, in my view, equally dominant. However, appearing as it does as the first element in Kuvera’s trade mark and the element by which the average consumer is most likely to refer to the trade mark, the word carpisa is, in my view, the more dominant element. Finally, I note that Kuvera have claimed the colours green and gray as an element of its trade mark; I will return to the issue of colour below.

43. XC’s trade mark consists of the word CARSYDA (in which the letter C is shown in the format above) accompanied by three Chinese characters. Once again, as far as I am aware neither the word CARSYDA (as shown above) nor the Chinese characters either describe or are non-distinctive for any of the goods for which XC seeks registration. However, while they are both distinctive elements the size of the CARSYDA element compared to the Chinese characters, means that it is the CARSYDA element which dominates XC’s trade mark. While I accept that the initial letter of XC’s trade mark has an element which projects downwards from the base of the letter C, I think that this is likely to go largely unnoticed by the average consumer.

I will approach the visual, aural and conceptual comparison with these conclusions in mind.

### **Visual similarity**

44. In *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2011] FSR 1 Mann J said:

“119. It is not clear to me that this is a debate which advances the case very much, but the position seems to me to be as follows. As a matter of principle the exercise involves comparing the offending sign with the registered mark and assessing the likelihood of confusion or association. The two things have to be compared. Since we live in a visual world, and signs are visual, some form of

appearance has to be considered. If the registered mark is limited to a colour, then the mark that is used has to be compared, as used, to the mark that is registered, as registered (and therefore in colour). If the registered mark is unlimited as to colour then it is registered for all colours. This means that the colour of the offending sign becomes irrelevant. It will not be possible to say that its colour prevents there being an infringement. At this point one can take one of two courses, each of which ought to have the same result. The first is to imagine the registered mark in the same colour as the offending sign. The second is to drain the colour from the offending sign. Either way one then has the material for comparison. One could even imagine them both in a third colour. It does not matter. So in a sense, both Mr Purvis and Mr Bloch are right. As a matter of visual convenience it seems to me to be easier to imagine the registered mark in a colour than to imagine the offending sign drained of colour, and I propose to adopt that course.”

45. In its submissions Kuvera said:

“12. The marks have a visual similarity as they both include as a prominent and distinctive element a seven letter word beginning in the word, “CAR” and ending with the letter, “A”. This is unusual within the English language creating a visual aspect within the marks that is likely to be confused when considering the marks through imperfect recollection. The Chinese characters and the accent on the letter “C” are effectively de minimis with the mark and therefore do not contribute to reducing the likelihood of confusion between the two marks.”

46. In his counterstatement XC said:

“2.3 [XC] refutes that [his trade mark] is visually similar to [Kuvera’s] registration. In its statement of grounds [Kuvera] submitted that the differences between the words in [the two trade marks] by their letters in the middle are less noticeable. However, the differences are in fact not “in the middle of the marks” but near the end of the marks. The mere letter “a” in common at the end of both marks should not be strong enough to cause negligence of other letters on the left of the letter “a” in both marks, especially when the letters in difference, namely “PIS” and “SYD” are obviously in different graphical representations and does not bear any visual resemblance. Therefore, the difference between “PIS” and “SYD” should be obvious to the general consumers....

2.4. Besides, the initial three letters in [the competing trade marks] are arguably different since the word in [XC’s trade mark] actually begins with [the C as shown] but not “C”. General consumers should be able to notice that [XC’s trade mark] begins with [the C as shown] because the first letter is generally rendered more important and would be given more attention. Also, the element that distinguishes “C” from [the C as shown] is visually noticeable because it clearly projects out of [the word] which is arranged regularly in a rectangular shape. In the circumstances, the word CARSYDA [as shown] is different from the word

CARPISA by the first, the fourth, the fifth and the sixth letters and such visual differences should be sufficient to [distinguish the competing trade marks].”

47. The word elements of both trade marks consist of seven letters. The first three and seventh letters would, in my view, be viewed by the average consumer as the same i.e. C A R and A. However, while both parties’ trade marks share the letter S in the string of letters between letters four to six, the S is in a different position and the other two letters are completely different. Insofar as the colours claimed by Kuvera are concerned, it is clear from the comments in *Specsavers* that when making the comparison the correct approach is for me to imagine XC’s trade mark presented in the same colours as Kuvera’s trade mark; that is what I have done. Having done so, and whilst keeping in mind the distinctive and relatively prominent device element appearing in Kuvera’s trade mark and the distinctive but much less dominant device element in XC’s trade mark, it results, in my view, in the competing trade marks sharing a relatively low degree of visual similarity overall.

### **Aural similarity**

48. In its submissions Kuvera said:

“13. When assessing the similarity of the marks aurally the device elements of both marks will not be considered and the comparison should therefore be on the word elements alone. The marks begin with the word “CAR” and end with the letter “A”, both of which have hard pronunciation within the English language. Whilst the letter “C” has an accent in [XC’s] mark the English speaking public will not recognise this and pronounce the letter as a “K”. The middle syllable of both marks (i.e. letters four to six) consist of three letters with the dominant part being a strongly pronounced “l” creating an aural similarity within this element. Both marks consist of three syllables and will therefore be considered to have an identical cadence due to how the hard and softly pronounced aural elements of the mark are arranged. The marks are aurally highly similar and even more so when considered with imperfect recollection.”

49. In his counterstatement XC said:

“2.5 [XC] refutes that [his trade mark] is aurally similar to [Kuvera’s] trade mark. The consonants in the word CARPISA are “C” (pronounced as “K”), “P” and “S” from the left to the right and therefore the word CARPISA is pronounced as “Kar-pee/pie-sa”. By contrast, the consonants in the word CARSYDA [as shown] are “C” (pronounced as “K”), “S” and “D” from the left to the right and therefore the word CARSYDA [as shown] is pronounced as “Kar-see/side-da”. Although the words CARSYDA [as shown] and CARPISA both start with the pronunciation “Kar”, “Kar-pee/pie-sa” and “Kar-see/side-da” when taken in their entirety are obviously not the same in pronunciation. Furthermore, if C [as shown] is taken as a French letter, it should even be pronounced as “S” such that CARSYDA [as

shown] is pronounced as “Sar-see/side-da”, which is further distinguishable from “Kar-pee/pie-sa.”

2.6 Moreover, as mentioned before, the device element of [XC’s] trade mark is in fact three Chinese characters which are pronounced as “JIA; SHI; DA”. By contrast, the element of [Kuvera’s] trade mark is a turtle and the turtle is not visually similar to the Chinese characters in [XC’s] trade mark and could not be pronounced either. Therefore, not only does the word CARSYDA [as shown] differ from the word CARPISA, the device elements [are also different].”

50. As words “speak louder” in trade marks than devices, I see no reason why the average consumer would attempt to refer to the competing trade marks by the device elements present in each. Insofar as the word elements are concerned, I agree that each trade mark is most likely to consist of three syllables with the first syllable of each trade mark i.e. CAR being the same; in addition, both trade marks end with an A sound. In my view, Kuvera’s trade mark is most likely to be pronounced as either CAR-PEE-SA or CAR-PIE-SA. While it appears to me that XC’s trade mark is open to more potential variations than Kuvera’s trade mark, CAR-SID-A, CAR-SEE-DA or CAR-SIDE-DA are, in my view, the most likely variations. As each trade mark is likely to consist of three syllables, have the first syllable in common and end with an A sound, there is undoubtedly a degree of aural similarity between them. However, when considered overall, the difference between the sound produced by the letter P in Kuvera’s trade mark as opposed to the sound produced by the letter S in XC’s trade mark, results, in my view, in a reasonable (and not, as Kuvera argue, a high) degree of aural similarity between the competing trade marks.

### **Conceptual similarity**

51. In its submissions Kuvera said, inter alia:

“14. Neither of the marks have a clear definable meaning within the English language and therefore the average consumer will not be given any assistance conceptually in distinguishing between them...”

52. With the exception of the devices of a turtle and characters which the average consumer is likely to recognise as oriental characters but to which they would accord no meaning, I agree with Kuvera that the word elements of the competing trade marks are unlikely to create any conceptual imagery in the mind of the average consumer.

### **Distinctive character of Kuvera’s earlier trade mark**

53. I must now assess the distinctive character of Kuvera’s earlier trade mark. The distinctive character of a trade mark must be appraised first, by reference to the goods in respect of which it has been registered, and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing

whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As I have already concluded that neither the word nor device elements present in Kuvera's trade mark are descriptive/non-distinctive for the goods for which the trade mark stands registered, it follows that as a totality and absent use, Kuvera's trade mark is possessed of a fairly high degree of inherent distinctive character.

54. Kuvera began using its trade mark in the United Kingdom in August 2007. By the date of XC's application for registration, Kuvera had been using its trade mark in the United Kingdom for approximately three years. If one assumes that the evidence which cannot be dated refers to a period before the material date in these proceedings, it indicates that by winter 2008 Kuvera had three stores (in Oxford Street and the Westfield shopping centre in London and in the Bluewater shopping centre in Kent ) and that its trade mark had been promoted by means of a launch event in 2007, in its own stores/catalogues etc. on London buses between January and February 2008, in the *Bluewater Magazine* at Christmas 2008, in an advertisement in *The Sunday Times* in February 2010 and on the London Underground. While these efforts will have built upon the inherent distinctiveness Kuvera's trade mark already possessed, Kuvera's turnover of approximately £6.3m achieved between 2007 and 2010 (which has not been split by class) must, given the obvious size of the markets in the United Kingdom for goods in classes 14, 18 and 25, be considered modest at best. In short, I do not consider that given the size of the markets in which Kuvera operates, that the use it had made of its trade mark by the material date in these proceedings will have built upon its inherent credentials to any appreciable extent.

### **Likelihood of confusion**

55. In determining whether there is a likelihood of confusion, I need to bear a number of factors 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. It is also necessary for me to keep in mind the distinctive character of Kuvera's earlier trade mark (as the more distinctive this trade mark is, the greater the likelihood of confusion), 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.

56. Earlier in this decision I concluded that the average consumer was the public at large who would select the goods at issue by primarily visual means and who would pay at least an average level of attention when doing so. I also concluded that XC's goods in classes 14, 18 and 25 were (with the exception of clothing for pets which I felt were at best only similar to a low degree) either identical or highly similar to Kuvera's goods but

I concluded that there was no similarity between XC's goods in class 3 and any of the goods in Kuvera's registration. Having then assessed the distinctive and dominant elements of the competing trade marks, I concluded that there was a relatively low degree of visual similarity and a reasonable degree of aural similarity and that while the device elements present in the competing trade marks differed, neither word element was likely to create any conceptual picture in the average consumer's mind. Finally, having assessed the inherent characteristics of Kuvera's trade mark as fairly high, I concluded that the use Kuvera had made of its trade mark was unlikely to have improved its position to any material extent.

57. In order to engage the test for likelihood of confusion there must be at least some similarity in both the trade marks and the goods. As I have found no similarity between Kuvera's goods and XC's goods in class 3, this part of Kuvera's opposition falls at the first hurdle. Insofar as the other goods which I have found to be predominately identical or highly similar are concerned, bearing in mind that the selection of the goods is primarily a visual one and that given the nature of the goods at issue the average consumer will pay at least a reasonable degree of attention when making his selection, I have no hesitation in concluding that the superficial similarities between the competing trade marks are more than offset by the differences, such that there is no likelihood of either direct confusion (where one trade mark is mistaken for the other) or indirect confusion (where the average consumer assumes the goods of XC come from an undertaking economically linked to Kuvera). Kuvera's opposition based upon section 5(2)(b) of the Act is dismissed.

### **The objection based upon section 5(3) of the Act**

58. Section 5(3) of the Act reads as follows:

"5(3) A trade mark which -

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

59. The current state of the-law in relation to section 5(3) was summarised by the Hearing Officer (Mr Allan James) in (BL-O-179-11). Mr James said:

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

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which

the mark is registered; General Motors, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; General Motors, paragraph 26; but the reputation of the earlier mark may extend beyond the consumers for the goods and services for which it is registered; Intel, paragraph 51.

(c) It is necessary, but not sufficient, for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; Adidas Saloman, paragraph 29 and Intel, paragraph 63.

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

(e) Although it is not a necessary factor, a link between the trade marks is necessarily established where the similarity between the marks causes the relevant public to believe that the goods/services marketed under the later mark come from the owner of the earlier mark, or from an economically connected undertaking; Intel, paragraph 57.

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

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

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

(i) Detriment to the repute of the earlier mark is caused when the goods or services for which the later mark is used by the third party may be perceived by the public in such a way that the earlier trade mark's power of attraction is reduced; L'Oreal, paragraph 40.

(j) Unfair advantage covers, in particular, cases where a third party seeks to ride on the coat-tails of the senior mark in order to benefit from a transfer of the image of the earlier mark, or of the characteristics it projects to the goods/services identified by the later mark; L'Oreal, paragraph 41.

60. In order to get its objection based upon section 5(3) of the Act off the ground, Kuvera must establish that, at the material date, its trade mark was known by a significant part of the relevant public which, given the nature of the goods for which Kuvera stands registered, is the public at large. While I am aware that Kuvera began using its trade mark in the United Kingdom in August 2007 and that it has promoted it in the national press, on London buses and on the London Underground and that it has shops in Oxford Street and in the Westfield and Bluewater shopping centres, insofar as the latter is concerned so do a vast array of other traders, traders who compete in all market segments. When considered as a totality, the modest length and intensity of use made by Kuvera of its trade mark falls, in my view, a long way short of establishing that by the material date in these proceedings its trade mark would be known by a significant part of the public at large. Without the requisite reputation, Kuvera's opposition based upon section 5(3) cannot succeed and is dismissed.

61. However, even if it could be argued that I have taken too critical a view of Kuvera's evidence and that by the material date in these proceedings it had established the requisite level of reputation, its objection must still fail. This is because, as I mentioned above, the superficial similarities between the competing trade marks would, in my view, and notwithstanding the identity/similarity in some of the competing goods, be insufficient for the average consumer to call Kuvera's trade mark to mind and in so doing to create the link necessary to engage this section of the Act.

#### **The objection based upon section 5(4)(a) of the Act**

62. In its pleadings, Kuvera relies upon the use of the word CARPISA alone. In reaching a conclusion, I note the comments of the Appointed Person, Mr Geoffrey Hobbs QC, in *Wild Child Trade Mark* [1998] RPC 455. In that decision Mr Hobbs said, inter alia:

"The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords

in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

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

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

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

### **The material date**

63. First, I must determine the date at which Kuvera’s claim is to be assessed; this is known as the material date. In this regard, I note the judgment of the General Court in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07. In that judgment the GC said:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

64. The date of filing of XC’s application is, therefore, the material date. However, if XC had used his trade mark prior to this, then this use must also be taken into account. It could, for example, establish that he is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed; any of which could mean that XC’s use would not be liable to be prevented by the law of passing-off – the comments in *Croom’s Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42 refer. As no evidence has been filed by XC in these proceedings, any potential defences he may have had to Kuvera’s claim to passing off do not come into play.

65. Kuvera's evidence demonstrates that whilst the vast majority of its use of the word carpisa has been in lower case (and often accompanied by its turtle device) its evidence also contains examples of the word CARPISA presented alone and in upper case. As the difference between words presented in upper or lower case is likely to go largely unnoticed by the average consumer, I am prepared to accept that, at the material date, Kuvera had, since 2007, used the word CARPISA in relation to a range of goods (mainly bags of one sort or another) but also in relation to a number of other goods of the type I have identified in paragraph 18 above. Whilst earlier in this decision, I found that Kuvera had not established the necessary reputation under section 5(3) of the Act, I am satisfied that the use it has made of the word CARPISA is sufficient for me to conclude that by the material date it had a protectable goodwill in a business operated under, inter alia, the word CARPISA presented in upper case.

66. As there is no requirement in passing off for a common field of activity – see *Lego System Aktieselskab and Another v Lego M. Lemelstrich Ltd* [1983] FSR 155, and as the comparison to be made under section 5(4)(a) of the Act is between XC's trade mark and the word CARPISA alone, Kuvera are clearly in a better position here than it was under section 5(2)(b) of the Act. However, once again the differences between the word CARPISA alone and the trade mark of XC more than offset the similarities and are, in my view, sufficient to avoid misrepresentation. Without misrepresentation there can be no damage and Kuvera's opposition based upon section 5(4)(a) of the Act fails accordingly.

### **Costs**

67. XC has been successful and is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide, I award costs to XC on the following basis:

Preparing a statement and considering Kuvera's statement:	£300
Considering Kuvera's evidence:	£500
<b>Total</b>	<b>£800</b>

68. I order Kuvera S.P.A. to pay to Xu Caijun the sum of **£800**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 13<sup>th</sup> day of December 2011**

**C J BOWEN**  
**For the Registrar**  
**The Comptroller-General**