

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2235681C
BY COWLEY DESIGNS LIMITED
TO REGISTER THE TRADE MARK:**



IN CLASSES 14, 18 AND 28

AND

**THE OPPOSITION THERETO
UNDER No. 51995C
BY GB INTERNATIONAL SPA
BASED UPON THE EARLIER TRADE MARK:**



**Trade Marks Act 1994
in the matter of Application No. 2235681C
by Cowley Designs Limited
to register the trade mark:**



**in classes 14, 18 and 28
and the opposition thereto under No. 51995C
by GB International SpA**

Background

1) On 10 June 2000 Cowley Designs Limited (Cowley) applied to register the above trade mark. The application was published on 11 October 2000. Since publication the application has been divided. This opposition concerns the division which has given rise to application No. 2235681C, which is for the following goods:

watches, clocks, alarm clocks, timepieces; key rings [trinkets or fobs]; jewellery; hair ornaments of precious metal; tiaras;

bags and purses; umbrellas and parasols;

games and playthings; costumes being children's playthings; dressing up clothes; fancy dress outfits being children's playthings.

The above goods are in classes 14, 18 and 28 respectively of the International Classification of Goods and Services.

The application was published with the following clause:

“The Applicant claims the colours light pink, dark pink, black and red as an element of the mark.”

2) On 11 January 2001 GB International SpA (GB) of Italy filed a notice of opposition to this application.

3) GB is the owner of United Kingdom trade mark registration nos 1169309 and 1169310 for the trade mark:



The registrations are, respectively for the following goods:

trousers, jackets, jerseys, pullovers, overalls; boots foulards and socks, all being articles of clothing; all for use in rock and/or mountain climbing;

sporting articles (other than clothing) adapted for use in rock and/or mountain climbing.

The above goods are in classes 25 and 28 respectively of the International Classification of Goods and Services.

The registrations include the following published limitations:

“Registration of this Trade Mark shall give no right to the exclusive use of the word "Pink".”

“The device of a spot appearing in the Trade Mark is limited to the colour pink.”

4) GB states that because of the association between clothing and goods in class 14, the use of goods (such as bags) in class 18 in relation to outdoor activities such as rock climbing and mountain climbing and the association of goods in class 28 (such as costumes, dressing up clothes and fancy dress outfits) with clothing in general, including clothing and footwear used in rock climbing and mountain climbing, it fears that there would be confusion between the source of its products and those of Cowley.

5) GB states that its trade mark and that of Cowley are dominated by the words THINK PINK and the goods are likely to be asked for using this name. GB states that the respective trade marks are similar. Consequently, GB considers that there is a likelihood of confusion and so registration of Cowley’s trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

6) GB claims that it has goodwill for trade marks including the words THINK PINK for goods included in classes 25 and 28. GB states that it has been using THINK PINK for such goods since 1986. It states that, consequently, use of Cowley’s trade mark is liable to be prevented by the law of passing-off and so its registration would be contrary to section 5(4)(a) of the Act.

7) GB seeks the refusal of the application and an award of costs.

8) Cowley filed a counterstatement. Cowley states that none of the goods encompassed by the respective trade marks are similar. It states that the visual differences between the two trade marks is such that they are not similar. Cowley states that there is not a likelihood of confusion. Cowley also denies that registration of its trade mark would be contrary to section 5(4)(a) of the Act.

9) Cowley states that the opposition should be dismissed and seeks an award of costs. It states that it was not contacted by GB prior to the filing of the opposition and, therefore, not given the opportunity to reach an amicable settlement which might have avoided these proceedings taking place. Cowley states that GB were unprepared to enter into settlement negotiations; Cowley requests that this be taken into account when deciding upon the award of costs.

10) After the completion of the evidence rounds I advised the parties that I believed a decision

could be made without a hearing. However, the parties were advised that they retained their right to a hearing. Neither party requested a hearing so I will make a decision after a careful study of the papers. Cowley filed written submissions in relation to the case and I take these into account in reaching my decision.

Evidence of GB International SpA

Statutory declarations of Alastair John Rawlence

11) Mr Rawlence is a trade mark attorney.

12) Mr Rawlence states that GB has made use of its trade mark since 1986. He states that from 1994 until winter 2000 the exclusive distribution of goods bearing GB's trade mark was handled by Blue Ridge of Perivale, Middlesex. He states that goods bearing GB's trade mark were distributed throughout the whole of the United Kingdom. However, Mr Rawlence does not give any specific details as to where the goods were sent. Mr Rawlence exhibits seven sales invoices from GB to Blue Ridge. The invoices cover the period from 14 January 1994 to 26 January 2000. The goods on the invoices are t shirts, t shirts for men, pants for men, climber bags, sports wallets, men's sweaters, men's jackets, men's cotton fleeces, women's fleeces and men's underwear.

13) Mr Rawlence gives the following turnover figures:

Financial Year	Turnover £
1998	108, 508
1999	139,236
1/1/2000 – 25/5/2000	23, 702

14) Mr Rawlence states that in his experience well known brands and trade marks in the United Kingdom such as Karrimor, Timberland and Rockport, which were traditionally associated almost exclusively with sporting items of clothing, are now frequently marketed as casual fashion in the High Street. Mr Rawlence does not supply any exhibits to support his assertion. He states that clothing items for use in rock and/or mountain climbing are now bought as casual wear by adults and children. Again he does not support this assertion with evidence.

15) Mr Rawlence goes on to make submissions as to the similarity of the respective trade marks.

16) Mr Rawlence states that class 14 goods are often sold under the same trade mark as clothing and in the same retail outlets. In support of this position he exhibits copies of pages from the Next Directory for Autumn/Winter 2000. He states that it shows that the NEXT trade mark is used in respect of both clothing and a wide range of non-clothing items such as those covered by the class 14 specification of Cowley's application.

17) Mr Rawlence states that the July 1999 edition of the Trade Marks Registry's Guide to Cross Searching of Trade Marks highlights goods such as purses and handbags for women and girls as being similar to clothing, footwear and headgear. He again refers to the extract from

the Next Directory to show use of the same trade mark for clothing and non-clothing fashion items such as those covered by class 18 of Cowley's application. Mr Rawlence states that bags are similar to sporting articles as the latter definition covers rucksacks and holdalls for both sporting and casual uses. He states that such goods are sold from the same outlets and to the same customer base.

18) Mr Rawlence continues by making various submissions as to the similarity of the class 28 goods of Cowley's application with the goods in classes 25 and 28 of GB's registrations.

19) Little of Mr Rawlence's evidence is evidence of fact. The majority is assertion and submission, and for the most part unsupported by substantiating documentation.

20) Mr Rawlence submitted a short second declaration which brought into the proceedings copies of two brochures of GB. The brochures show young people, of both sexes, in a variety of poses, wearing presumably THINK PINK clothing; some of the clothing can be seen bearing the words THINK PINK. The brochures are somewhat obtuse, it is not immediately obvious what goods are being promoted. The brochure seems to be more of a promotion for the brand than for specific goods. Mr Rawlence states that the brochures correspond to brochures circulated in the United Kingdom by GB prior to the filing of Cowley's application. This would appear to be a roundabout way of Mr Rawlence stating that the particular brochures emanate from after the date of filing. As Mr Rawlence is not an employee of GB it is difficult to state on what basis he can make this statement, other than hearsay. If he had earlier brochures he could compare with those exhibited, he would, no doubt, have exhibited them.

Declarations/witness statements of Michael Jardine, Creswick Roger John Southcott and Mitch Terlekvj, dated 4 February 2002, 29 January 2002 and 5 February 2002 respectively.

21) Mr Jardine is an employee of Snowsport Industries of Great Britain. He states that this is an association of snowsport retailers, manufacturers and suppliers. Mr Southcott is a director of the Outdoor Industries Association. He states that this is a trade body for manufacturers and retailers of clothing, equipment and services for outdoor leisure pursuits in Britain and Ireland. Mr Terlekvj is the general manager of Blue Ridge.

22) Mr Jardine states that he first became aware of the trade mark of GB in 1983. He states that THINK PINK is used in respect of clothing for climbing and outdoor use, with increasing use of the trade mark in respect of general leisure clothing. He states that in his opinion THINK PINK is a well known brand in the United Kingdom for leisure and outdoor clothing. He states that if he saw or heard of a mark THINK PINK being used in respect of items of jewellery, bags, children's clothing, watches and clocks he would think that it was being used in respect of goods of GB or with its permission.

23) Mr Southcott states that he became aware of the trade mark THINK PINK in 1992. He states that it is used in respect of outdoor clothing, although the trade mark has increasingly been used in respect of other forms of clothing such as ski clothing and general leisurewear.

24) Mr Southcott states that THINK PINK is a well known brand in the United Kingdom for outdoor clothing. He states that if he saw or heard of a mark THINK PINK being used in respect of items of jewellery, bags, children's clothing, watches and clocks he would think

that it was being used in respect of goods of GB or with its permission. Mr Southcott uses virtually identical wording as Mr Southcott in respect of this matter.

25) Mr Terlekvj states Blue Ridge distributed the following THINK PINK goods in the United Kingdom: outdoor clothing for adults and children, outdoor footwear for adults and children, outdoor headgear for adults and children, clothing for adults and children (eg leisurewear), footwear for adults and children and headgear for adults and children.

26) He states that Blue Ridge also distributed key rings, bags, purses and umbrellas bearing the trade mark THINK PINK. Mr Terlekvj states that the approximate ages of the customers for the goods were from 0-12 years of age and over twenty five years of age.

27) He states that THINK PINK is a well known mark in the United Kingdom in respect of outdoor and general items of clothing, footwear and headgear for adults and children. He states that THINK PINK is a well known brand in the United Kingdom for children's clothing.

Evidence of Cowley Designs Limited

Declaration of Timothy Guy Hislop

28) Mr Hislop is the managing director of Cowley.

29) Mr Hislop states that the first use of Cowley's trade mark, the subject of this opposition, was in September 2000. This is after the date of the filing of the application and so after the relevant date. Mr Hislop refers to the nature of the goods which Cowley sell under the trade mark and the target consumers, girls. I have to consider the specifications of the application, which are not limited in this way. The presence of the trade mark on the market place also tells me little as there is nothing to indicate that it has shared the same part of the market place as the THINK PINK trade mark of GB. Mr Hislop's declaration also contains much submission rather than evidence of fact. I do not consider what he tells me in his declaration assists me in coming to a decision in this case.

Declaration of Carin Elizabeth Burchell

30) Ms Burchell is a trade mark attorney.

31) Ms Burchell's declaration represents submissions rather than evidence of fact. She also relies on state of the register evidence. I take on board her submissions but do not consider it necessary to say any more about them here.

Declaration of Gareth Ian Price

32) Mr Price is a trainee trade mark attorney. His declaration is dated 13 May 2002.

33) Mr Price states that he visited GB's website at www.thinkpink.it. He exhibits a page from the website downloaded on 13 May 2002. This shows GB's distributor in the United Kingdom as being Blue Ridge. Mr Price also exhibits a page from Blue Ridge's website which shows them as distributors of various products but not the THINK PINK products of GB. Mr Price states that he followed a link from Blue Ridge's website to the website of the

Ski Division of Blue Ridge. He exhibits a page from this website. He states that the web site lists various products but no THINK PINK ones. Mr Price states that as Blue Ridge are listed as GB's United Kingdom distributor still it would seem that GB's THINK PINK products are not currently distributed in the United Kingdom.

Evidence of GB International SpA in reply

34) This consists of a further declaration by Mr Rawlence. Most of the declaration represents submissions rather than evidence of fact and so I will say no more about these submissions, although I bear them in mind in reaching my decision. In response to Mr Price's comments about the distribution of GB's products in the United Kingdom Mr Rawlence exhibits invoices from GB to its new distributor, Alcatraz, which is based in Pwllheli. Mr Rawlence then returns to discussion of the activities of Next.

Decision

The evidence of GB – what does it prove?

35) The evidence of GB is rather short on facts, rather long on submissions, assertions and claims. It gives turnover figures but no clear indication as to what specific goods the figures relate. All I see is the occasional snapshot glimpse of the goods from the invoices exhibited with the first declaration of Mr Rawlence. A wide range of goods are covered by their specifications. A turnover of £108,508 and £139,236 in the years 1998 and 1999, in terms of the clothing industry in the United Kingdom, seems very small, it would hardly make a ripple in the trade. This is especially the case as GB makes claims to have moved away from specialist mountain and rock climbing goods. I have no idea of knowing how much of the expenditure relates to mountain and rock climbing articles and how much to clothing. GB gives no figures for advertisement or promotion. GB exhibits two brochures. There is no certainty of when they were issued. There is no information as to the extent of their circulation in the United Kingdom. GB makes claims to distribute its wares throughout the United Kingdom. However, it does not specify where in the United Kingdom the retailers are based. There is also no indication of the nature of the retailers; whether they are general clothing shops or specialist climbing shops for instance.

36) I view the evidence of Mr Terlekvj with some circumspection. He gives a strangely precise age profile of the customers. They begin as babes in arms and continue until they are twelve, then there is a hiatus until they reach twenty five when they again purchase the goods. None of the other material suggests that baby and toddler clothes have been supplied under the trade mark. None of the invoices suggests that clothing other than for adults has been supplied. The brochures supplied by Mr Rawlence, which would seem to emanate from after the relevant date, give no hint of goods aimed at anyone other than adults.

37) The evidence of Messrs Jardine and Southcott indicates that the trade mark of GB has been used on clothing for climbing and outdoor use. Their evidence emanates from some eighteen months after the relevant date so it is difficult to ascertain what their perception of the trade mark would have been at the relevant date. Their view as to confusion does not greatly influence me. Firstly, this is a question for me, not them, they are experts in the market, not in the issue of likelihood of confusion. Millett LJ held in *The European Limited v*

The Economist Newspaper Ltd [1998] FSR 283 that expert witnesses “are experts in the market, not on confusing similarity”. He also stated: “In the end the question of confusing similarity was one for the judge. He was bound to make up his own mind and not leave the decision to the opinion of the witnesses”. Secondly they have used a virtual identical form of wording. So it would seem likely that the form of wording was suggested to them rather than decided independently by them.

38) The best that could be said of the evidence is that it shows some use of the trade mark of GB. However, it lacks precision as to the nature of such use. Both Messrs Jardine and Southcott identify the trade mark with outdoor clothing, both of them speak as experts of outdoor leisure activities. As independent witnesses weight must be given to their evidence. However, there is a lack of surrounding detail. The evidence indicates that GB enjoy a limited goodwill in the business associated with THINK PINK. However, the absence of detail and clarity in the evidence does not allow me to gain a clear view as to what that business exactly is. It could relate to clothing for young people at large, it could relate to clothing for mountain activities. I simply do not know. I need to know what is the attractive force – the goodwill (see Lord Macnaghten *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217, 223 (HL)). The evidence is, I believe, the sort of evidence that Pumfrey J found fault with in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 when he stated:

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

39) I do not consider that the evidence of GB has established a goodwill that can be used in relation to the law of passing-off.

Likelihood of confusion – section 5(2)(b)

40) According to section 5(2)(b) of the Act a trade mark shall not be registered if because -

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

41) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 723.

Comparison of trade marks

Earlier registrations:



Application:



42) Cowley have argued that because of the difference in stylisation of the trade marks that they are not similar.

43) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG* page 224). 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* page 224). I take into account the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel BV v Puma AG* page 224) 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 BV* page 84, paragraph 27).

44) I consider that the distinctive and dominant element of the respective trade marks is the words THINK PINK. These words, in combination, are unusual and not allusive to the goods. They are very distinctive. I believe that what the consumer will remember about both marks is the words THINK PINK. I consider that the different stylisations of the trade marks is peripheral to the overall effect of the words. In my view the trade marks are not only similar but similar to a high degree.

Comparison of goods

45) In its submissions Cowley referred to the test formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 282 in relation to the comparison of goods and services:

- (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.

46) Since that decision the European Court of Justice has ruled on this issue in *Canon*; where it held that in relation to the assessment of the similarity of goods and/or services, that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary. There is no great discrepancy between the two sets of tests, however, the United Kingdom judgment does not cover the issue of goods and/or services being complementary.

47) The goods to be considered are:

Earlier registrations

Trousers, jackets, jerseys, pullovers, overalls; boots foulards and socks, all being articles of clothing; all for use in rock and/or mountain climbing.

Sporting articles (other than clothing) adapted for use in rock and/or mountain climbing.

Application

Watches, clocks, alarm clocks, timepieces; key rings [trinkets or fobs]; jewellery; hair ornaments of precious metal; tiaras – class 14

Bags and purses; umbrellas and parasols – class 18

Games and playthings; costumes being children's playthings; dressing up clothes; fancy dress outfits being children's playthings – class 28

48) The first thing I note is that all the goods of the earlier registration are for use in rock and/or mountain climbing, They, therefore, have a very specialist purpose and a specialist market.

49) I cannot see how the class 14 goods of the application intersect with any of the goods of the earlier registration. They do not have the same use. In terms of similarity of goods use defines the user and so I do not consider that they have the same user. You would not substitute any of the class 14 goods for those of the earlier registrations, they are, therefore, not in competition. Neither is there a symbiotic or mutually dependant relationship between the class 14 goods of the application and the goods of the earlier registration. The goods are,

in my view, clearly not similar.

50) The same can be said for purses, umbrellas and parasols. GB have referred to the cross search list of the Registry for support for their case. This list was not comparing these goods with specialist mountain and rock climbing clothing.

51) Games and playthings have a different purpose to sporting articles for mountain and rock climbing. GB have made various assertions about a similarity but they have not shown any actual link in the market place. It is difficult to even think of a theoretical link. There is no intersection of games and playthings with the goods of GB.

52) I turn now to *costumes being children's playthings; dressing up clothes; fancy dress outfits being children's playthings* of the application. The primary role of these goods is play, not for clothing the body, that is why they are in class 28 and not class 25. I find it difficult to see the intersection between clothing for mountain and rock climbing and fancy dress clothing which is in the nature of being playthings. It is necessary to also bear in mind that fancy dress clothing at large is in class 25. Class 28 only includes fancy dress clothing in the nature of playthings (see *Reliance Water Controls Ltd v Altecnic Ltd* [2002] RPC 34). I cannot see how the two sets of goods would fit within the parameters set out in *Canon* and do not consider that there is any similarity.

53) This leaves me with *bags* to consider. All of the other goods I consider not to be similar. The class 28 goods of GB are *sporting articles adapted for use in rock and/or mountain climbing*. The term *sporting articles* is a general term and in the context of the specification is limited only by its purpose – rock and/or mountain climbing. Consequently, the term includes bags which are specially adapted to carry sporting articles; the bags themselves falling into the category of being sporting articles owing to their special adaptation. In practical terms this could include such items as rucksacks specially adapted to carry mountain and rock climbing articles. The specification of Cowley includes bags at large. So, for the purposes of this example, it also includes rucksacks. To follow this example and apply the *Canon* criteria the bags have the same purpose – to carry items on the back, they could readily have the same customer – someone who wishes to go hiking or climb for instance, they are likely to be of the same material, the specially adapted bags and the unadapted bags could be substituted for one another, they are, therefore in competition, both types of bag could be for sale in the same specialist shops or in the same areas of non-specialist shops. The long and short of it is that *bags* of the Cowley specification are similar, and potentially highly similar, to the goods encompassed by the class 28 specification of GB. From the evidence of Cowley, the actual goods upon which they currently use their trade mark would be most unlikely to clash with those for which GB has protection in class 28. However, I have to consider notional and fair use in relation to the specification of Cowley as a whole. Even if it had been limited an avoidance of a clash would be very problematic; the dividing line between bags in the two classes can be very narrow eg specially adapted holdalls and ordinary holdalls.

54) Mr Rawlence has spent much time in his evidence on the trading patterns of Next. GB is not Next. There is also the premise in Mr Rawlence's comments that because one enterprise uses a trade mark across a range of goods the goods must be similar. If this was the case the whole basis of similarity of goods would be thrown out of the window. The use of a brand across a swathe of goods does not indicate similarity. Mr Rawlence thinks that in theory that the class 14 goods of the application and the goods of the GB might seem not to be similar. I think that this is more than a matter of theory. I find it rather difficult to find the link between

mountain and rock climbing articles and clothing and tiaras. I doubt that even Next supply crampons and tiaras.

55) Consequent upon the above I find that the only goods of the application which are similar to the goods of the registrations of GB are bags.

Conclusion

56) In my view both parties have taken what have been virtually untenable positions. Cowley that the trade marks are not similar, GB that patently dissimilar goods are similar.

57) Cowley sought to support their case with state of the register evidence. State of the register evidence does not say anything about what is happening in the market . I refer to the comments of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281:

AIn particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.@

Following Jacob J I too disregard the state of the register evidence.

58) For there to be a likelihood of confusion the respective goods have to be similar or identical. This is what the Act says, this is what the European Court of Justice said in *Sabel*:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

There are no identical goods. The only similar goods are *bags*. In considering the likelihood of confusion I need to bear in mind the degree of closeness of the trade marks, the degree of closeness of the goods and the distinctiveness of the earlier trade mark. I am of the view that the earlier trade mark of GB enjoys a high degree of distinctiveness and that the respective trade marks are very similar. I also consider that *bags* are highly similar to the goods of GB in class 28. **Consequently, I have no hesitation in finding that there is a likelihood of confusion in relation to *bags* in the specification of the application. In relation to the other goods, as they are not similar goods, there is no likelihood of confusion.**

Passing-off – section 5(4)(a)

59) Section 5(4)(a) of the Act states:

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

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

60) For a claim to passing-off to succeed the plaintiff needs to satisfy the classic trinity of requirements:

- that he has goodwill in his trade mark
- that there is a misrepresentation by the defendant (whether intentional or not)
- that he has been damaged or is likely to be damaged by the misrepresentation

61) As I have stated earlier in this decision I do not consider that GB has established a goodwill for the purposes of passing-off. The grounds of objection under section 5(4)(a) is, therefore, dismissed.

Outcome

62) GB has only been successful in its opposition in respect of bags. The opposition fails in respect of all other goods. Consequently, Cowley should file, within one month of the expiry of the appeal period from the decision, a form TM21 to remove bags from the class 18 specification of the application. If no form TM21 is filed within the period set the application will be refused in its entirety.

63) For the most part Cowley has been successful in these proceedings. It is entitled to a contribution towards its costs. Cowley has requested that I should take into account that GB did not give notice of its intention to oppose nor to seek to make a settlement. There is a strict and non-extendable time limit for the filing of an opposition, three months. I do not, therefore, see that it is beholden upon an opponent to give notice of an intention to oppose; he simply might not have the time. I do not see why GB should be penalised for not wishing to negotiate a settlement. That is a decision it has to make on the basis of both legal and commercial considerations. To penalise them for not seeking to negotiate would be tantamount to encouraging pointless negotiations. Nothing that Cowley has advanced suggests to me that I should move away from the normal scale of costs. I, therefore, order GB International SpA to pay Cowley Designs Limited the sum of £1,000. 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 26th day of November 2002

**D.W. Landau
For the Registrar
the Comptroller-General**