

O-541-15

TRADE MARKS ACT 1994

IN THE MATTER OF

INTERNATIONAL REGISTRATION NO. 700394

IN THE NAME OF

SOCIÉTÉ ANONYME MONÉGASQUE MC COMPANY

TO REGISTER:

LIVIA

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 401778 BY LIVIA CORSETTI FASHION S.J. W.L. ZENTALA**

BACKGROUND

1. On 24 June 2013, société anonyme monégasque MC COMPANY (“the applicant”) requested protection in the United Kingdom of the International Registration (“IR”) of the trade mark shown on the cover page of this decision. The United Kingdom Trade Marks Registry (“TMR”) considered the request satisfied the requirements for protection and particulars of the IR were published on 29 November 2013 for the following goods in class 25:

Clothing for men, women, children, ready-to-wear clothing, ready-made clothing, footwear, bathing suits.

2. The designation of the IR is opposed by Livia Corsetti Fashions S.J. W.L. Zentala (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition, which is directed against all of the goods in the IR, is based upon the goods (shown below) in the following IR designating the United Kingdom:

IR no. 1008558 for the trade mark:



“Mark Description

The trademark is "LIVIA FASHION CORSETTI" in its particular graphical form; the "LIVIA FASHION CORSETTI" inscription is represented by stylized lettering, slightly slanted to the right side; the first letter of word "LIVIA", and the letters of words "FASHION CORSETTI" are in upper case whereas the remaining letters are in lower case; the "LIVIA CORSETTI" words are shaded giving the impression of three-dimensionality; the "LIVIA FASHION CORSETTI" inscription is arranged in two rows so that "CORSETTI" is located beneath words "LIVIA" and "FASHION"; the letters in word "FASHION" are smaller than the letters of words "LIVIA" and "CORSETTI"; there is a graphical symbol on the left side of "LIVIA FASHION CORSETTI" formed by the second degree curves; the trademark is black and white”,

which designated the United Kingdom on 13 February 2009 and for which the date of protection in the United Kingdom is 5 February 2010:

Class 25 - Underwear, hosiery, corsetry products.

3. The applicant filed a counterstatement (subsequently amended) in which it stated:

“As part of the opposition based on the ground of Section 5(2) (b) of the Trade Marks Act 1994, the Defendant will only argue that the two respective marks “LIVIA CORSETTI FASHION” (figurative) and “LIVIA” (word) are based on the first identical word “LIVIA”.

The International Trade Mark registration No 1008558 “LIVIA CORSETTI FASHION” is registered in UK since 5 february 2010 in class 25 for “Underwear, hosiery, corsetry products”. The International Trade Mark registration No 700394 “LIVIA” is registered since 9 October 1998 for “clothing for men, women, kids, ready to wear, shoes, swimwear’ in Germany, Austria, Benelux, Spain, Italy, Portugal, Switzerland. Protection in the United Kingdom (based on the international Trade Mark) has been designated for LIVIA in 2013 for products mentioned above.

Consequently, regarding Section 5(2) (b) of the Trade Marks Act 1994 the two trade marks opposed can be considered similar.”

4. Only the applicant filed evidence. Neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing.

The applicant’s evidence

5. For reasons to which I will return below, it is not strictly necessary for me to summarise the applicant’s evidence here. However, to do justice to the applicant’s position and as the evidence provided is not extensive, a brief summary appears below. It consists of a witness statement from Daniel Flachaire, the applicant’s President, a position he has held since 1996. The following facts emerge from Mr Flachaire’s statement:

- the trade mark LIVIA was first used in the United Kingdom in 1982 by Livia Company (a French company) who were the owners of two United Kingdom trade mark registrations in class 25 which were filed in 1982 (no. 1177362) and 1985 (no. 1244308) respectively.

Although no details of these trade marks have been provided, the registrar is entitled to inspect his own register. Having done so, I note that both trade marks are shown as being owned by Livia (France) and both were registered in respect of goods in class 25; both trade marks are now shown as status “Dead”. The trade marks look like this:

No. 1177362



No. 1244308



- the French company, Livia S.A., became bankrupt in 1996 and the business, goodwill and trade marks were bought by the applicant;
- trade mark registration no. 1177362 was renewed until 24 June 2013;
- the transfer of the above trade marks to the applicant was never recorded;
- the LIVIA trade mark has been used upon bathing suits;
- exhibit 1 consists of the front pages of brochures from 1997, 2000, 2001 and 2007 (all of which bear images of bathing suits for women). Various trade marks appear on these pages, but none are in the same format as either of what were the United Kingdom registrations;
- exhibit 2 consists of two pages from the applicant's website downloaded on 19 March 2015 relating to the history of the Livia swimsuit brand, its philosophy and designer, Karine Boyer. Both bear images of bathing suits for women;
- exhibit 3 consists of an attestation dated 23 February 2015 (in French accompanied by an English translation) from Jean-Paul Samba. Mr Samba explains that he is an accountant acting as an auditor for the applicant. He certifies that between 1 October 1995 and 30 September 1996, the applicant made sales in the United Kingdom under the trade mark LIVIA which amounted to £24,239.52;
- exhibit 4 is a further attestation from Mr Samba accompanied by six invoices dated between December 1995 and April 2010 to five business based in the United Kingdom for goods amounting to £10,952.45. Once again a trade mark

appears on these invoices which is not in the same format as either of what were the United Kingdom registrations;

- exhibit 5 consists of a Purchase Agreement (in French accompanied by an English translation) dated 1996 between the Official Receiver, LIVIA SA and the applicant in which, inter alia, United Kingdom trade mark no. 1244308 is specifically listed as is the phrase “This list is not exhaustive”;
- since 1996 the average annual amount spent on promoting the goods was £5000;
- the trade mark has been used upon goods sold to businesses based in Devon, Cheshire, Middlesex, Dorset and South Buckinghamshire i.e. locations corresponding to the invoices provided as exhibit 4.

DECISION

6. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

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

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

7. 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.”

8. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before

the publication date of the IR in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods it has identified.

Section 5(2)(b) – case law

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

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

10. The competing goods are as follows:

| Opponent's goods | Applicant's goods |
|--|--|
| Underwear, hosiery, corsetry products. | Clothing for men, women, children, ready-to-wear clothing, ready-made clothing, footwear, bathing suits. |

11. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court ("GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

12. As all of the opponent's goods are, in my view, encompassed by, inter alia, the phrases "Clothing for men, women, children" and "footwear" appearing in the applicant's specification, the competing goods are identical on the principle outlined in *Merica*. However, as the opponent's specification is very specific, it is possible that within the general phrases included in the applicant's specification there may be goods which share no similarity with those of the opponent. That said, if one compares, in particular, the "underwear" and "corsetry products" in the opponent's specification with the goods which, on the basis of the applicant's evidence, appears to be of interest to it i.e. bathing suits for women, the coincidence in the nature, users, to some extent intended purpose and trade channels through which the competing goods pass, I am lead to conclude that such goods are similar to the opponent's named goods to at least a low degree. I will return to this point when I consider the likelihood of confusion.

The average consumer and the nature of the purchasing act

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

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

14. The average consumer for the goods at issue is a member of the general public. As to the manner in which such an average consumer will select these goods, in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, the GC considered the level of attention paid to and the manner in which clothing is selected. It stated:

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

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

15. As all of the goods at issue are, most likely to be the subject of self selection from traditional retail outlets on the high street, catalogues and websites, visual



considerations are likely to dominate the selection process, though not to the extent that aural considerations can be ignored. The cost of the goods at issue can vary considerably. Nevertheless, as factors such as material, size, colour, cost and compatibility with other items may all come into play, the average consumer will, in my experience, pay an average degree of attention when making their selection. This level of attention is also, in my experience, likely to increase as the cost and importance of the item increases.

Comparison of trade marks

16. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

| Opponent’s trade mark | Applicant’s trade mark |
|---|--|
|  |  |

18. As the applicant’s trade mark consists of a single word presented in upper case, this is the overall impression it will convey and where its distinctiveness lies.

19. The opponent’s trade mark consists of a number of elements. When considered in relation to the goods at issue, the word FASHION has no distinctive character and will have little or no weight in the overall impression the trade mark conveys. The device element which appears at the top left of the trade mark is distinctive and, given its size

and positioning, will contribute to the trade mark's overall impression. The word Livia is presented in title case in a slightly stylised typeface. Given its central positioning and size, it is, in my view, a dominant element and will make a significant contribution to the overall impression the trade mark conveys. As to the distinctiveness of this element, I think it is likely that it will be construed by the average consumer as either an invented word or as a female forename (either in its own right or as a shortening of Olivia). However, even if it is construed as a female forename of some sort, it is, in my view, unusual, and would, as a consequence, be distinctive in its own right. Finally, as to the word CORSETTI, this is presented in the same stylised typeface as the word Livia which appears above it. Although the word CORSETTI is larger than, inter alia, the word Livia, when considered in the context of goods in class 25, I think the average consumer will, given its visual and aural similarity to the English language words CORSET or CORSETRY, interpret it as being a foreign language word (most likely Italian) equivalent to those words. As such, it will, despite its size and central positioning, play a much lesser role in the trade mark's overall impression. Whilst the device element will contribute to the overall impression the opponent's trade mark conveys, it will make a less significant contribution than the word Livia, which, for the reasons indicated above, will, in my view, dominate the overall impression the opponent's trade mark conveys.

20. I now turn to the visual, aural and conceptual comparison. Having concluded that the opponent's trade mark will be dominated by the word Livia, and as the applicant's trade mark consists exclusively of this word albeit presented in upper case, there is, in my view, at least an average degree of visual similarity between the competing trade marks.

21. As to the degree of aural similarity, as the applicant's trade mark consists of only one element this is how it will be referred to i.e. as a three syllable word. Insofar as the opponent's trade mark is concerned, it is well established that when a trade mark consists of a combination of words and figurative element it is by the word elements that the trade mark is most likely to be referred. In view of my conclusions above, I have no doubt that when the opponent's trade mark is referred to, the word FASHION will not be articulated. If I am correct, it is also doubtful if the word CORSETTI would be articulated. If it is not articulated, as the word Livia in the opponent's trade mark will be pronounced in an identical fashion to the identical word of which the applicant's trade mark consists, the competing trade marks would be aurally identical. However, even if I am wrong on my primary conclusion and the average consumer does articulate the word CORESTTI, as the word LIVIA/Livia would be the first word articulated, there remains, in my view, a fairly high degree of aural similarity between the competing trade marks.

22. I have already concluded that the word FASHION will, and the word CORSETTI is likely to, send descriptive messages. If the word LIVIA/Livia is considered to be invented, the conceptual position in relation to this element would be neutral. If, however, the word LIVIA/Livia is understood as a female forename (on either of the bases I have described), the competing trade marks would, to that extent, be conceptually identical.

Distinctive character of the earlier trade mark

23. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought 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 the opponent has not filed any evidence of the use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. The opponent's trade mark consists of a combination of descriptive and distinctive elements. However, when considered as a totality, the size and positioning of the distinctive device and word Livia results, in my view, in a trade mark possessed of at least an average degree of inherent distinctive character.

Likelihood of confusion

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

- the average consumer is a member of the general public who will select the goods by predominantly visual means and who will pay an average degree of attention when doing so;
- whilst all of the opponent's goods are encompassed by the applicant's goods, the applicant's specification could include goods which are not similar to the opponent's goods (see below);
- the distinctiveness of the applicant's trade mark and the overall impression it conveys results from the single word of which it consists;
- the overall impression of the opponent's trade mark will be dominated by the distinctive word Livia which appears within it;

- the competing trade marks are visually similar to at least an average degree and if not aurally identical, aurally similar to a fairly high degree;
- insofar as their distinctive word elements are concerned, the competing trade marks are either conceptually neutral or conceptually identical;
- the opponent's earlier trade mark is possessed of at least an average degree of inherent distinctive character.

25. In reaching a conclusion, I bear in mind that the applicant has filed evidence showing the history of its business (including two United Kingdom trade mark registrations it acquired as a result of a Business Purchase Agreement in 1996). It has also provided evidence of the use it states it has made of its LIVIA trade mark since 1996. As I mentioned above, the two United Kingdom trade mark registrations are now dead, however, even if they were still extant, they would not assist the applicant for the reasons outlined in Tribunal Practice Notice ("TPN") 4 of 2009, the relevant part of which reads as follows:

"Trade mark opposition and invalidation proceedings - defences

Defences including a claim that the applicant for registration/registered proprietor has a registered trade mark that predates the trade mark upon which the attacker relies for grounds under sections 5(1) and 5(2) of the Act.

1. A number of counterstatements in opposition and invalidation actions have sought to introduce as a defence that the applicant for registration/registered proprietor has a registered trade mark (or trade mark application) for the same or a highly similar trade mark to that which is the subject of the proceedings that predates the earlier mark upon which the attacker relies.

2. Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds.

3. The position was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) T-269/02*:

"24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (Case T 6/01 Matratzen Concord v OHIM - Hukla Germany (MATRATZEN) [2002] ECR II 4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities."

26. Similarly, any use the applicant has made of its LIVIA trade mark does not assist it for the reasons mentioned below (which also appears in TPN 4 of 2009):

"The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

27. As far as I am aware, no action has been taken against the earlier trade upon which the opponent relies.

28. Returning to the likelihood of confusion, in their counterstatement, the applicant accepts that the competing trade marks are "similar"; I agree. Although this admission was made on the basis that the applicant enjoyed an earlier right of some sort (which I

have dismissed), it does nothing to vitiate the correctness of the admission. In relation to either the identical goods at issue, or what appears to be the goods of interest to the applicant. i.e. bathing suits for women (which I have concluded are similar to the opponent's "underwear" and "corsetry products" to at least a low degree), the fact that the word Livia dominates the overall impression the opponent's trade mark conveys will inevitably cause a likelihood of confusion with the applicant's trade mark which consists exclusively of this word. Given the various differences between the competing trade marks, this likelihood of confusion is more likely to be indirect i.e. when the average consumer assumes that the goods at issue come from undertakings which are economically linked rather than direct confusion i.e. where one trade mark is mistaken for the other.

Primary conclusion

29. As matters stand, the opposition succeeds in full.

Restriction to the specification of the application

30. Notwithstanding my primary conclusion, earlier in this decision (paragraph 12), I concluded that there may be goods within the scope of the applicant's specification which are not similar to the opponent's goods. Given the nature of the applicant's evidence which indicates that it conducts a business in relation to bathing suits for women, I have paused, given the likely similarity between these goods and those goods in the opponent's specification I have identified, before offering the applicant an opportunity to provide a restriction to its specification which may avoid the clash with the opponent's goods. However, as its application has been made in relation to:

Clothing for men, women, children, ready-to-wear clothing, ready-made clothing, footwear, bathing suits,

it is, in my view, appropriate to allow the applicant an opportunity to consider the position. In those circumstances, in accordance with TPN 1/2012, paragraph 3.2.2, I invite the applicant to file submissions in which it should identify any goods it wishes to register that fall within the above descriptions and explain why it considers such goods not to be similar to those relied upon by the opponent. A period of 14 days from the date of this decision is allowed for such action. Upon receipt of the above, the opponent is allowed a period of 14 days to comment upon any revised list of goods the applicant suggests. I will then consider the position and issue a supplementary decision in which I will decide whether any of the goods in the revised list of goods provided is free from objection. If the applicant does not respond to this invitation, I will issue a supplementary decision confirming my primary conclusion and the application will, subject to any successful appeal, be refused in full.

31. The appeal period for the substantive and supplementary decisions will run from the date of the supplementary decision which will also include a decision on costs.

Dated this 19th day of November 2015

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