

O-556-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 3025547  
BY PAPER LONDON LIMITED  
TO REGISTER THE TRADE MARK  
PAPER LONDON  
IN CLASS 25  
AND**

**IN THE MATTER OF OPPOSITION  
THERE TO UNDER No. 401654 BY  
PAPER DENIM and CLOTH LLC**

## BACKGROUND

1) On 9 October 2013, Paper London Ltd (hereinafter the applicant) applied to register the trade mark PAPER LONDON in respect of the following goods in Class 25: Clothing, footwear and headgear; hosiery; socks; underwear; nightwear; swimwear.

2) The application was examined and accepted, and subsequently published for opposition purposes on 1 November 2013 in Trade Marks Journal No.2013/044.

3) On 31 January 2014 Paper Denim and Cloth LLC (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

Mark	Number	Date of application / registration	Class	Specification
PAPER DENIM & CLOTH	CTM 2237626	30.05.01 20.06.02	25	Jeans, sweaters, jackets, coats, shirts, t-shirts, skirts, vests and tank tops.

b) The opponent contends that the prefix "PAPER" in both marks would be seen as the distinctive and dominant element and that the other words used in the marks would be disregarded by the public as they are not distinctive. The opponent contends that the mark in suit is confusingly similar to its registered trade mark. It states that the goods applied for in the mark in suit are similar or identical to those for which its mark is registered. As such there will be confusion in the marketplace if the mark in suit, is allowed to become registered and used. The mark in suit therefore offends against Section 5(2)(b) of the Act.

4) On 1 May 2014, the applicant filed a counterstatement denying all the grounds. The applicant put the opponent to proof of use of its mark.

5) Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard although the opponent did provide written submissions in lieu of a hearing.

## OPPONENT'S EVIDENCE

6) The opponent filed two witness statements. The first, dated 30 July 2014, is by James Saunders the opponent's Trade Mark Attorney. He provides a copy of a page from the applicant's website at exhibit 1. Under the title "About PAPER LONDON" this states, *inert alia*, "Taking pride in the manufacturing excellence of its British roots, each garment is produced in London".

7) The opponent's second witness statement, dated 17 July 2014, is by Richard Gilbert the President of the opponent, a position he has held since 1999. He states that his company has been trading under its mark since 1999 and refreshed and re-launched it in 2012. The mark has been used on clothing which he describes as "fashion-forward, and high quality designer clothing in the mid to high end price point". He states that his company sells items online through its website which was launched on 1 October 2012. He states that the website provides details of stockists of the opponent's goods in the UK and Sweden and that the website has European and UK sizes. He states that since its re-launch his company has sold US\$3,648 worth of goods to Sweden and US\$5,656 worth of goods to Italy. These were shipped in February and March 2013 respectively. He states that his company sends out a regular newsletter to customers, but does not state if any are in the UK or the EU. He states that the company advertises in the trade and International press. Mr Gilbert provides details of WeAr and Flaunt magazines. He states that WeAr is a global magazine printed each quarter and with between 15,000 and 21,000 copies issued on each printing. It is available in eight languages and is distributed at fashion shows, at leading global department stores and other retail establishments, as well as online and in concept stores such as Selfridges in London, Merci in Paris, Quartier 206 in Berlin and Gerard Loft in Florence. He states that Flaunt magazine is published ten times per annum and is distributed in 32 countries, he does not provide details of which countries.

8) Mr Gilbert states that his company obtains significant media coverage as its clothes are regularly worn by celebrities which also garner attention from the media. The company was mentioned in Vogue's "Definitive Guide to Denim" in January 2013 published on its website, and also featured in an article in Vogue magazine in 2012. He states that Vogue's "international monthly users are around 31.1 million". These include users in many EU countries. He states that his company's goods are offered for sale on other websites. He states that the re-launch of the brand in 2012 was covered by the media including a number of publications which he states are read in the UK. He also states that the opponent uses social media to promote its brand. He provides the following exhibits:

- 1: Photocopies of two labels used in clothing. Both seem to use the mark in the following manner "**paperdenim&cloth**".
- 2: Copies of two invoices for goods sold into Sweden and Italy. These show 48 pairs (US\$3,648) of jeans provided to Sweden in 2013, and 73 pairs (US\$5,656) of jeans supplied to Italy also in 2013.
- 3: Pages from the opponent's website which do not show prices or descriptions of items merely images of items of clothing. It would appear that in printing the pages from the Internet certain details have been missed.
- 4: This consists of pages from the opponent's website. It shows a list of countries in which it claims to have stockists, including the UK. However, no details of any

stockists in the UK are provided. There is also a page which shows size comparisons for US, UK, Euro, France and Japan.

- 5&6: These are said to be copies of advertisements from Flaunt and WeAr Global magazine. These are said to be dated September 2013 and January 2013. However, they are photocopies which simply show photographs of two men and a woman wearing various items of clothing. It does not show what the advertisement looked like or what other details were provided.
- 7: A list of agents for WeAr magazine. It includes a number of EU countries.
- 10: A photocopy of a page from the website of Vogue, dated January 2013. This shows an entry for the opponent in the “Definitive Guide to Denim”.
- 11: Photocopies of an article from Vogue magazine in 2012 which mentions the opponent.
- 12: A photocopy of a page from the UK website of Glamour magazine showing a picture of a woman attending an event run by the opponent, location unknown, in June 2013.
- 13: Photocopies of various women, who are said by the opponent to “celebrities” wearing the opponent’s clothing from US websites.
- 14: Copies of pages from websites [www.shopstyle.co.uk](http://www.shopstyle.co.uk); [www.farfetch.com](http://www.farfetch.com); and [www.revolveclothing.com](http://www.revolveclothing.com). These are dated January 2014. Only the first site appears to be in the UK the other two appear to be based in the USA.
- 15: photocopies of articles from a variety of websites which mention the opponent. Most are dated July – August 2012. These all appear to be based in the USA.
- 16: A copy of an article from a UK digital news and media brand, The Drum. This is dated 16 October 2012 and details the website of the opponent.
- 17: Copies of interviews with officers of the opponent company at the re-launch of the brand. These are with two websites which appear to be based in the USA.
- 18: Various pages from social media sites which mention the opponent’s goods.

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

## **DECISION**

10) There is only one ground of opposition which is based on section 5(2)(b) which reads:

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

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

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

11) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

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

12) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. The applicant requested that the opponent provide proof of use. Given the interplay between the dates that the opponent’s mark was registered and the date that the applicant’s mark was published, it is entitled to request such proof in respect of mark 2237626 as per Section 6A of the Act which states:

“Raising of relative grounds in opposition proceedings in case of non-use

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

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if -

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

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

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

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

13) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its mark has been made. In the instant case the publication date of the application was 1 November 2013, therefore the relevant period for the proof of use is 2 November 2008 – 1 November 2013. I take into account the comments of Arnold J. in *Stichting BDO v BDO Unibank, Inc.*, [2013] F.S.R. 35 (HC), where he stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

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

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

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

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

14) As the opponent’s mark is a CTM I also take into account the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, where the Court of Justice of the European Union noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

15) The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market

concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

16) I also take note of the comments of Mr Daniel Alexander Q.C sitting as the Appointed Person in *Awareness Limited v Plymouth City Council*, Case BL O/230/13 where he commented:

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

and further at paragraph 28:

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

17) Whilst in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

“[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.”

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

18) Lastly I note that in *Reber Holding GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-355/09, the General Court found that the sale of 40-60Kg per annum of specialist chocolate under a mark was insufficient to constitute genuine use of the national trade mark, which was registered in Germany. On further appeal in Case C-141/13 P, the CJEU stated, at paragraph 32 of its judgment, that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The CJEU found that “*the General Court conducted an overall assessment of that trade mark, taking into account the volume of sales of the goods protected by the trade mark, the nature and characteristics of those goods, the geographical coverage of the use of the trade mark, the advertising on the website of Paul Reber GmbH & Co. KG and the continuity of the trade mark’s use. It thus established a certain degree of interdependence between the factors capable of proving genuine use. The General Court therefore correctly applied the concept of ‘genuine use’ and did not err in law in its assessment of that use*” (paragraphs 33 and 34 of the judgment of the CJEU).

19) Thus, proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the [European Union] market for the goods or services protected by the mark” is therefore not genuine use.

20) In the instant case the opponent has offered scant evidence of use. The opponent asserts to have stockists throughout Europe yet it fails to even provide a list of these

stockists, let alone any evidence of sales to them at any time. The only evidence of sales in Europe relates to the sale of a total of 121 pairs of jeans totalling US\$9,304 to Italy and Sweden in spring 2013. Whilst the opponent's website may provide a list of size comparisons around the world there is no evidence that it offers shipping outside the USA. None of the pages provided showed prices or even details. The exhibit which is said to show advertisements is nothing of the sort. It is merely photographs of models wearing, presumably, the opponent's clothing. It is not a copy of the actual advertisement that would have appeared in the magazine. The opponent contends that it has been mentioned in Vogue. It is not clear whether this is the USA or UK version of the magazine. The only evidence of the opponent's clothing being offered for sale in the UK is from the shopstyle website and is after the relevant date of 9 October 2013 and so cannot be taken into account. The opponent seems to rely mainly upon social media and so-called celebrities being photographed wearing their products. However, even here they have failed to show that these have made their way from the USA into Europe or the UK.

21) In my opinion the use shown by the opponent cannot be regarded as "real commercial exploitation of the mark on the market for the relevant goods" it certainly has not created or maintained an outlet for its goods or a share in that market. The sales seem to be isolated incidents which have occurred as an overlap from the USA. **As the opponent has not met the requirements under section 6A of the Act the opposition under section 5(2)(b) must fail.**

## **CONCLUSION**

22) **The applicant has been successful in defending its mark against the opposition under Section 5(2)(b),**

## **COSTS**

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

Preparing a statement and considering the other side's statement	£200
Considering the evidence of the other side	£200
<b>TOTAL</b>	<b>£400</b>

24) I order Paper Denim and Cloth LLC to pay Paper London Ltd the sum of £400. This sum 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 19th day of December 2014**

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