

O-319-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2297070  
BY TIMOTHY ROY BARRETT-SMITH TO REGISTER A  
TRADE MARK IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION No. 90954  
BY GLENBEIGH LIMITED (PREVIOUSLY JOBOK LIMITED  
T/A DV8 SHOES)**

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**BACKGROUND**

1. On 4 April 2002 Timothy Roy Barrett-Smith applied to register the following mark:



for a specification of goods which reads “Sunglasses; sunglass cases” (Class 9). The application is numbered 2297070.

2. On 14 August 2002 Jobok Limited t/a DV8 Shoes filed notice of opposition to this application. Glenbeigh Limited has since been substituted as opponent and, following assignments, is the proprietor of the following registrations:

NO	MARK	CLASS	SPECIFICATION
2042760 (UK)		25	Articles of clothing, footwear.
2346534 (CTM)	DV8	16,18,25 and 35	<p>Paper, cardboard and goods made from these materials, printed matter; magazines, catalogues; boxes of cardboard or paper.</p> <p>Leather and imitations of leather and goods made of these materials; trunks and travelling bags; bags; leather shoulder belts; handbags; linings of leather for boots and shoes; pocket wallets and purses; leather laces.</p> <p>Clothing, footwear, headgear; belts.</p> <p>Retail services; mail order services; mail order catalogue services; Internet and online shopping services; advertising services; promotional services; publicity services.</p>

3. The opponent says that the mark applied for is identical or at least similar to its Community Trade Mark and identical to the word element of its UK registration. In particular it is said that DV8 is a prominent, distinctive and major element of the applicant's mark. The opponent also asserts that the applicant's goods are similar to the Class 25 goods of its UK registration and to the goods and services in Classes 18, 25 and 35 of its Community Trade Mark registration. Accordingly, the opponent claims that there is a likelihood of confusion and that the application should be refused under Section 5(2)(a) and 5(2)(b) of the Act.

4. Additionally, the opponent says it has made use of the Community Trade Mark, DV8 in relation to retail services, footwear, headgear, bags and other associated goods since at least May 1995 and has made use of the UK Trade Mark DV8 (logo) since at least 2001 in relation to retail services, footwear and clothing. In doing so, the opponent's trade marks have acquired greater distinctiveness and commensurate goodwill and reputation. It says the risk of confusion in the marketplace is heightened by such use. The opponent, therefore, asserts that use of the trade mark the subject of the application, in the United Kingdom, would, in addition, amount to passing-off of the opponent's goods and business and that the registration would be contrary to Section 5(4)(a) of the Act.

5. The applicant filed a counterstatement denying the above claims. I note, in particular, the following points:

- it is denied that the marks are identical;
- it is admitted that there is a degree of similarity;
- it is denied that the applicant's goods are similar to the Class 25 goods of the opponent's UK registration;
- it is denied that the applicant's goods are similar to the Class 18 and 25 goods of the opponent's Community Trade Mark registration (I observe, parenthetically, that the opponent makes no claim in relation to its Class 16 goods);
- no admission is made as to similarity between the applicant's goods and the opponent's Class 35 services.

6. The applicant's research suggests that the opponent is a footwear retailer with just six outlets in Northern Ireland and that it operates an online shop branded voodoooshoes.com and not DV8. The opponent is put to proof of its claim in relation to Section 5(4)(a).

7. Both sides ask for an award of costs in their favour. Only the opponent filed evidence.

8. As is apparent from the details of the opponent's CTM registration set out above the specification includes retail services. It does so, moreover, without any restriction as to the nature of the goods which are the subject of that trade. That state of affairs suggested that it might be necessary for me to consider the scope of protection to be afforded to the term retail services and how one should approach issues of similarity between retail services and goods. At the point in time that the case papers came to me for a decision the ECJ's judgment was awaited in relation to a reference by Germany's Bundespatentgericht in case C-418/02 (*Praktiker Bau*). With the agreement of the parties this case was stayed pending the judgment in that case which was given on 7 July 2005. Prior to that neither side had either requested a hearing or furnished written submissions in response to the usual invitation from the Registry to indicate their wishes. In the light of the ECJ's judgment it seemed appropriate to give the parties a further opportunity to either request a hearing or provide written submissions. This I did by letter dated 28 July 2005. In the event neither side has asked to be heard. Written submissions have been supplied on behalf of the applicant. I take these into account in so far as they address the relevance of the ECJ's judgment and issues arising therefrom. Neither side has suggested that a reference to the ECJ is called for in relation to how any potential conflicts between retail services specifications and goods should be resolved.

### **Opponent's evidence**

9. The opponent filed a statutory declaration by James Berkeley, its Managing Director, a position he has held since the formation of DV8 Shoes in May 1995. Mr Berkeley describes the background to the opponent's businesses as follows:

- “3. “Since 1995 the opponent have been selling a range of items under the Trade Mark DV8. The primary area of sales activity is in relation to men's and ladies footwear and a range of accessories are also sold such as handbags, record bags, sunglasses and watches. A range of these goods are own branded DV8 goods. The opponent bought UK Trade Mark Registration No 2042760, from Maraday Hill who had been using the mark in the United Kingdom since

in or around 1988. The business of Maraday Hill was in retail, wholesale and branded manufacturing. On May 11, 1995 Maraday Hill licensed the opponents to use UK Registration No. 2042760 and word mark DV8 in Northern Ireland. Maraday Hill continued to use the Trade Mark DV8 in the rest of the UK. UK Registration No. 2042760, together with all the goodwill in DV8 in the UK, was then assigned to the opponent on May 15, 2001 for £30,000. The assignment and licence can be produced if required”.

10. He exhibits (JB1) examples of use of the DV8 mark since 1995 including photographs of men’s and ladies’ shoes, packaging for watches and shoes, labels, stickers and swing tags. He adds that use of the DV8 foot logo (the UK mark) has been relatively small compared to use of DV8 itself and the retail premises have never used the DV8 foot logo.

11. Approximate annual sales turnover for the DV8 retail stores and the on-line voodoo.shoes business (it is later said that this is within a DV8 shoes site) is given as follows:

<b>YEAR</b>	<b>DV8 £</b>	<b>voodoo.shoes £</b>
1996	457,028	-
1997	929,083	-
1998	1,208,366	-
1999	1,449,949	-
2000	2,197,096	7,900
2001	2,717,293	112,137
2002	3,173,257	387,863

12. Sales of goods branded DV8 or with the DV8 logo are given as follows (the latter being a subset of the DV8 figures):

<b>YEAR</b>	<b>DV8 £</b>	<b>DV8 logo £</b>
1996/97	5,000	2,500
1997/98	15,000	12,500
1998/99	28,000	14,000
1999/00	44,000	8,000
2000/01	80,000	6,500
2001/02	105,000	6,500

13. Currently the opponent owns seven stores within the United Kingdom, all of which are located in Northern Ireland. The stores are situated in Londonderry, Ballymena, Belfast (2), Enniskillen, Lisburn and Newry. Each of these stores is located in the central areas in each of these cities or regional towns in Northern Ireland. They are said to attract a wide variety of consumers, from school children, to students and employed/professional people. The opponent company currently employs 60 people.

14. Advertising expenditure is given as follows:

<b>YEAR</b>	<b>£</b>
1997	7,000
1998	6,000
1999	6,800
2000	12,000
2001	28,000
2002	25,000

15. Approximately £3000 per annum of the above represents spending in relation to the foot logo. In substantiation of these claims Mr Berkeley exhibits:

- JB2 - examples of advertisements in the Northern Irish press and magazines;
- JB3 - the tape of a radio advertisement on Cool FM thought to be from 1997/8;
- JB4 - tapes of two television commercials, only one of which appears to have been before the material date in these proceedings;
- JB5 - documentation relating to the costs of one of the above advertisements;
- JB6 - examples of publicity achieved for the stores and goods;
- JB7 - a photograph of a bag bearing the mark DV8 in support of the claim that the opponent sells fashion items and other accessories in addition to footwear. Bags are said to have been sold since 1998 in the opponent's stores;
- JB8 - photocopied examples of the 2002 range of sunglasses together with the artwork involved and a photograph of a display of sunglasses under the DV8 brand;
- JB9 - a sample pair of sunglasses, I note the goods are branded DV8 eyewear (though the DV8 is presented in slightly stylised form).
- JB10 - documentation relating to the purchase of sunglasses in June 2002 (this is after the material date);

16. The remaining exhibits (JB11 to 13) go into further detail about the trade in sunglasses and the internet shopping site but do not do so in a way that readily yields information that is relevant to the period up to 4 April 2002. In fact, if I have interpreted Mr Berkeley's evidence correctly the opponent did not commence selling sunglasses until spring/summer 2002. Earlier in his declaration he says that the company's year runs from April to March so it must be doubtful whether any material level of sales of sunglasses was achieved by 4 April 2002.

17. Mr Berkeley goes on to offer a number of submissions in relation to the trade in shoes, accessories, sunglasses etc and the complementary nature of such items. I do not propose to

record these submissions but bear them in mind in reaching my decision and will refer to them as necessary below. That completes my review of the evidence.

## **DECISION**

18. Section 5(2) reads as follows:

- “(2) A trade mark shall not be registered if because -
- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
  - (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.”

19. Both the opponent’s marks are registered with filing dates that are earlier than that of the mark applied for. They are, therefore, earlier trade marks within the meaning of Section 6(1)(a) of the Act.

### **Section 5(2)(a)**

20. The opponent’s statement of grounds indicates that it considers the applied for mark to be identical to its Community Trade Mark No 2346534. The subsequent wording of the statement of grounds makes the rather more limited claim that the word element of the respective marks is the same. To the extent that the more sweeping of these claims is still relied on it is relevant to turn to the guidance from the European Court of Justice (ECJ) on the question of what constitutes identity. In *LTJ Diffusion SA and Sadas Vertboudet SA* [2003] FSR 34 the ECJ said:

- “50. The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition of identity implies that the two elements compared should be the same in all respects. Indeed, the absolute protection in the case of a sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered, which is guaranteed by Art. 5(1)(a) of the Directive, cannot be extended beyond the situations for which it was envisaged, in particular, to those situations which are more specifically protected by Art. 5(1)(b) of the Directive.
51. There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the element constituting the latter.
52. However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign

produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question (see, to that effect, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] E.C.R. 1-3819, para.[26]).

53. Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.”

21. Any claim that the applied for mark is identical to the opponent’s Community Trade Mark registration appears to me to be untenable in the light of the *LTJ Diffusion v Sadas* guidance. The applied for mark contains a prominent device element. Even accepting that the letters and numeral DV8 is the more obvious focal point for consumer attention and the element by which the mark is likely to be known, the device makes an unmistakable contribution to the overall character of the mark. It can scarcely be said to constitute an “insignificant difference” which may go unnoticed by the average consumer. I, therefore, dismiss the objection based on Section 5(2)(a) in so far as the opponent’s Community Trade Mark registration is concerned. It follows, also, that the opponent is even less well placed in relation to this head of objection based on UK registration No 2042760 which contains a device in addition to the element DV8 (with the letters in lower case).

#### **Section 5(2)(b)**

22. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

23. An objection under this head is said to raise a single composite question : are there similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the “earlier trade mark” and the sign subsequently presented for registration were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered (*Raleigh International Trade Mark* [2001] RPC 202)? The matter must be considered from the standpoint of the average consumer who is deemed to possess the qualities set out in the *Lloyd Schuhfabrik* case. In this case I take the average consumer to be members of the public at large.

#### **Comparison of Marks**

24. I propose to take as my starting point the opponent’s Community Trade Mark Registration No 2346534. That registration has both a broader specification of goods and services and is for the mark DV8 solus.

25. The applicant in his counterstatement has taken the view that the marks “differ in their material particulars, so cannot be considered identical. With regard to the claim to similarity of the respective marks, to the extent that the marks share the common element DV8, it is admitted that there is a degree of similarity” (applicant’s emphasis).



26. The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel v Puma*, paragraph 23). The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel v Puma*, paragraph 23).

27. The applicant's acknowledgement of a degree of similarity is, in my view, a necessary concession. But it does not follow that, because one mark features as an element in the other, the respective marks are distinctively similar (to adopt Mr Hobbs' expression from *TORREMAR Trade Mark* [2003] RPC 4). In *10 ROYAL BERKSHIRE POLO CLUB Trade Mark* [2001] RPC 32, for instance, the Appointed Person found that use of the word POLO in the applicant's mark did not capture the distinctiveness of the opponent's earlier trade mark. However, equally, this is not a case where the presence of an additional word or feature serves to differentiate the marks (cf *Cardinal Place Trade Mark* O/339/04).

28. In the applicant's favour in this case is the fact that the device element of the mark is a reasonably strong one and provides an important visual backdrop to the element DV8. However, even if it is said that DV8 is not the visually dominant element in the mark, it is, in my view, the element that is likely to fix itself in the observer's perception and recollection of the mark. It is, by any test, a distinctive, significant and memorable element and one, moreover, that will also be the key reference point in oral mention of the mark. Conceptually, I assume that DV8 is a play on the word 'deviate'. Though I doubt that it matters greatly whether that reference is picked up. Whatever conceptual significance is conveyed or perceived (whether a play on words or simply a combination of letters and a numeral) will be identical in so far as the key element DV8 is concerned.

29. It follows that the applicant's mark captures the distinctive character of the opponent's Community Trade Mark registration. The respective marks are similar to a high degree. That view is based on the inherent characteristics of the opponent's mark. On the evidence before me the opponent's reputation would appear to be restricted largely, if not exclusively, to Northern Ireland at the material date and to be mainly based on a trade in footwear. Although sales appear to have been running at material levels I doubt that it can be said the use is such as to further improve the distinctive character of the mark.

### **Comparison of goods and services**

30. Guidance on the approach to be adopted in comparing goods and services can be found in two main authorities. The first is *British Sugar Plc v James Robertson & Sons Ltd (TREAT)* [1996] RPC 281 at page 296. Adapted to the current case the test proposed by Mr Justice Jacob (as he then was) involved consideration of the following:

- (a) the uses of the respective goods or services;
- (b) the users of the respective goods or services;
- (c) the physical nature of the goods or services;
- (d) the trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, whether in practice they are respectively found or likely to be found on the same or different shelves; and
- (f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods or services,

for instance market research companies, put the goods or services in the same or different sectors.

31. These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgment, the ECJ stated at paragraph 23:

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

32. Mr Berkeley has made a number of submissions in his evidence bearing on what he considers to be the complementary nature of the trade in footwear, accessories and sunglasses. Thus:

“17 .... it is my opinion that retail services, of the type the opponent is engaged, and sunglasses, are considered closely related goods and services by persons dealing in this area of trade such as retailers and wholesalers. This is also obvious in popular, “trendy” high street stores such as Top Shop as the consumers often visit these outlets as a one stop for accessories and shoes. The DV8 store is in a similar position to these types of stores as it is targeting many of the same consumers, and has built a reputation for fashionable footwear and accessories. Consumers are therefore likely to find the use of DV8 on shoes, accessories and sunglasses as an indication of common origin of these goods.”

and

“19 In trading in accessories, including sunglasses, the opponent is not unusual in my experience of the market. I have attached hereto and marked “JB13” at the time of swearing hereof further examples from internet traders such as shoesurf.com, jungleshop.com and deeshoes.com who deal in shoes as their primary market, but who offer additional accessories such as sunglasses. It is therefore my belief that sunglasses are a complementary product to the goods covered by the opponent’s registration. Accessories such as sunglasses are commonly found in stores such as that operated by the opponent, both on the High Street and on the internet. They are therefore integral products to this type of retailing.”

33. I will deal firstly with the goods of the opponent’s registration. Its Community Trade Mark No 2346534 covers a range of leather goods, bags, purses etc in Class 18 and clothing, footwear, headgear and belts in Class 25. To the extent that the above recorded submissions are intended to support the proposition that the applicant’s sunglasses and sunglass cases are closely related to the opponent’s goods in Classes 18 and 25, then I consider that they overstate the position. The users of the respective sets of goods may be the same at a high level of generality (but most consumer goods share that point of commonality). But the intended purpose and physical nature of the goods are quite different. There may be some overlap in trade channels but Exhibit JB13 supplied in support of such a claim is of limited assistance to the opponent. Whilst I acknowledge that the e-tailers concerned are shown to

offer both shoes and sunglasses the evidence is after the material date (and I note that generally speaking the goods are not sold under the same brand as the e-tailing service).

34. There may be some force to the complementarity argument and it is a factor that must be considered in accordance with the *CANON/TREAT* tests. I have little doubt that there are fashion goods companies whose activities extend to a wide range of consumer fashion items such as clothing, perfumery, jewellery, leather goods etc and might also include sunglasses. But care must be taken before extrapolating from the practices of certain of the larger fashion houses to the behaviour of the large number of traders whose business is in one or other of the above goods areas only. It is, it seems to me, primarily a matter to be decided on evidence. Even in relation to a Section 5(4)(a) passing off claim the matter needs to be approached with caution as the following passage from the Appointed Person's decision in *WANNABEE Trade Mark*, BL O/471/00, illustrates:

“35 The question that falls to be decided is whether or not a notional and fair use by the Applicant of the mark Wannabee on perfume would be likely to lead to relevant confusion between that perfume and the opponent's shoes. There is no evidence that shoe manufacturers as a class have habitually extended their business into that of perfumery. The evidence, such as it is, seeks to draw a comparison between the reputation in Wannabee shoes with that of an established fashion house such as Chanel or Calvin Klein. I do not believe that this is justified in the case of this opponent on the evidence before me.”

35. Taking the *CANON/TREAT* criteria in the round I am of the view that sunglasses and sunglass cases have only a low level of similarity to the opponent's goods. I have, however, hesitated over the point because I am aware that *SAVILE ROW Trade Mark*, [1998] RPC 155, might be thought to point to a different outcome. It was held in that case that sunglasses were used extensively in the fashion industry as accessories to clothing. The Hearing Officer indicated that:

“It is not disputed that Savile Row has a high reputation for articles of tailored clothing so I must consider whether this reputation is likely to “spill over” into accessories such as sunglasses. It can reasonably be accepted, and indeed it is claimed in the opponents' evidence, that this is indeed the case particularly in relation to the names of fashion houses who make and or sell a wide range of fashion goods. The same practice also applies in respect of the names of fashion designers where such names are often used in relation to a whole range of goods closely with the clothing industry. In this case sunglasses could almost be classified as an item of apparel and there is no doubt they are used extensively within the fashion industry in relation to items of clothing. That being the case I am quite prepared to believe that the general public on encountering the mark SAVILE ROW used in relation to designer or fashion sunglasses would assume that such goods emanated from Savile Row or were associated with it in some way. This view is buttressed by the way in which the applicants use the mark such as “The Savile Row Collection, the original classics” and “The Savile Row Gallery Collection”, London, England. Such use strongly associates the mark with fashion goods and even indicates to some extent a business in Savile Row when in fact this is not the case.”

36. Whilst I note the outcome of that case I consider that I should exercise some care in seeking to apply it to the circumstances here. Firstly it was, of course, a case under the old

law; secondly the issue under consideration was Section 11 of the preceding law (rather than Section 12) and hence the Hearing Officer was not required to reach a view on whether goods of the same description were involved; and thirdly Savile Row enjoys a particular reputation in relation to clothing and, indeed, the evidence showed the presence of fashion houses in Savile Row.

37. Taking into account the net effect of the similarities and differences between goods and marks in the case before me I have come to the view that the opponent does not succeed in so far as its case is based on the goods of its registration.

38. That brings me to the opponent's services in Class 35 of their CTM registration.

39. In *Praktiker Bau - und Heimwerkermärkte AG*, Case-418/02, the ECJ was asked to consider the following questions:

- “1. Does retail trade in goods constitute a service within the meaning of Article 2 of the directive? If the answer to this question is in the affirmative:
2. To what extent must the content of such services provided by a retailer be specified in order to guarantee the certainty of the subject-matter of trade-mark protection that is required in order to:
  - (a) fulfil the function of the trade mark, as defined in Article 2 of the directive, namely, to distinguish the goods or services of one undertaking from those of other undertakings, and
  - (b) define the scope of protection of such a trade mark in the event of a conflict?
3. To what extent is it necessary to define the scope of similarity (Article 4(1)(b) and Article 5(1)(b) of the directive) between such services provided by a retailer and
  - (a) other services provided in connection with the distribution of goods, or
  - (b) the goods sold by that retailer?”

40. In answer to the first two questions the Court indicated that:

- “49. .... for the purposes of registration of a trade mark covering services provided in connection with retail trade, it is not necessary to specify in detail the service(s) for which that registration is sought. To identify those services, it is sufficient to use general wording such as ‘bringing together of a variety of goods, enabling customers to conveniently view and purchase those goods’.
50. However, the applicant must be required to specify the goods or types of goods to which those services relate by means, for example, of particulars such as those contained in the application for registration filed in the main proceedings (see paragraph 11 of this judgment).

51. Such details will make it easier to apply Articles 4(1) and 5(1) of the directive without appreciably limiting the protection afforded to the trade mark. They will also make it easier to apply Article 12(1) of the directive, which states that '[a] trade mark shall be liable to revocation if, within a continuous period of five years, it has not been put to genuine use in the Member State in connection with the ... services in respect of which it is registered, and there are no proper reasons for non-use'.
52. The answer to the first two questions referred for a preliminary ruling must therefore be that the concept of 'services' referred to by the directive, in particular in Article 2, covers services provided in connection with retail trade in goods.

For the purposes of registration of a trade mark for such services, it is not necessary to specify the actual service(s) in question. However, details must be provided with regard to the goods or types of goods to which those services relate."

41. In relation to the third question, the Court took the view that the referring court had not shown it was necessary to rule on the concept of similarity between retail services and goods and that it had no jurisdiction to rule on hypothetical problems. Accordingly, the third question was declared to be inadmissible.

42. The opponent's CTM registration containing, inter alia, an unrestricted retail services specification was obtained prior to the ECJ's judgment in *Praktiker Bau*. An issue arises as to how such a specification is to be interpreted.

43. I note that the applicant's written submissions claim that (following *Praktiker Bau*):

"5.3.2 The earlier CTM is invalidly registered in that it simply lists retail and mail order services; the latter being simply an alternative form of retailing. The evidence filed clearly points to the Opponent being a footwear retailer. The offering of sunglasses is merely an incidental product to the main activity of the Opponent. At best, an assumption must be made as to retailing footwear. Accordingly, the retail services should be construed as those relating to footwear. In any event, the Opponent failed to adduce evidence to establish that there is a similarity between sunglasses and retail services."

44. The approach thus advocated appears to be based on the principle that the notional scope of the specification should be presumed to be co-extensive with the actual use shown. That seems to me to be inconsistent with the normal principle that one should give full effect to the wording used in a specification consistent with the natural meaning of those words (see *Beautimatic International v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267). I can see no basis, therefore, for artificially restricting the scope of the term 'retail services' though that is not of course to say that what is shown by a party's own use is irrelevant.

45. In Communication No. 3/01 the President set out the Community Trade Mark Office's position in relation to retail services (this, of course pre-dates the *Praktiker Bau* judgment). At that time it was indicated that that Office did not accept the view expressed in the

*Giacomelli* case that a reference to the field of activity is a legal necessity though it was suggested that such a limitation to the field of activity or nature of the retail service is desirable. The position adopted with respect to conflicts was said to be:

“The limitation of applications and registrations for such services by indicating the field of activity of retail or other selling services will reduce the likelihood of conflicts because the risk of confusion between, for example, retail sales of meat on the one hand and of electrical goods on the other is non-existent.

As regards conflicts between services and goods, the Office takes the view that, while a "similarity" between goods sold at retail and retail services cannot be denied in the abstract, the risk of confusion is unlikely between retail services on the one hand and particular goods on the other except in very particular circumstances, such as when the respective trade marks are identical or almost so and well-established in the market. Each case that arises will of course be dealt with on its own merits.

Given that situation those requesting registration of marks for retail (or similar) services should not expect that they thereby obtain protection against the use or registration of marks for goods. If such protection is required as well, it is clear that registration for goods must be requested as well.”

46. The Community Office’s position in relation to conflicts between retail services and goods was broadly endorsed in paragraph 99 of the Advocate General’s Opinion in *Praktiker Bau* (unfortunately that Opinion is not available in English on the curia website) but as noted above the issue was not dealt with by the ECJ itself.

47. Against this background a number of possible approaches to the interpretation of a retail services specification appear to present themselves. One view of the matter is that, if the term is unrestricted (e.g. by type of goods or type of retail outlet) then it must be taken to embrace the retail sale of all or any goods. On that basis, and assuming identical or closely similar marks, goods of any kind might be thought to conflict with the term retail services.

48. An alternative view of the matter is that, if the proprietor of a retail services specification has not indicated any particular area of trade then the presumption must be that his trade is of a broad and certainly non-specialist nature (in other words he would simply be considered to be a general trader). In those circumstances it might be argued that there is no compelling reason to suppose that consumers would make an association between that service and products branded with an identical or closely similar mark. Or if they did make an association they would either regard it as coincidental or, at least, not indicative of a common trade source, save perhaps where highly distinctive marks were involved.

49. Applying those tests would be likely to produce quite different outcomes in any particular case. It remains to be seen what view the ECJ will take of the matter. In any event the circumstances of individual cases are likely to have to be taken into account.

50. Accepting for present purposes that the unrestricted term retail services lends itself to a broad interpretation, and if a polarised view of the matter is not considered appropriate, the degree of similarity between such services and any particular goods item or categories of goods is likely to turn on a number of considerations. It seems to me that these would include:

- how specialised the goods are. The more narrowly focussed and specialised they are the less likely it is that consumers would expect to see the same or closely similar sign also in use as a retail service mark. Thus it is not uncommon in the clothing trade for retailers to offer own brand clothing. On the other hand, whilst retailers will sell, for instance, rubber bands, there is no specialist trade in such goods nor to the best of my knowledge is there a widespread practice of offering such goods under the same brand name as the retail source;
- whether it is common practice to have retail outlets dedicated to the goods in question;
- whether consumers would expect to encounter the same mark in use both in relation to the retail service and in relation to the goods (that is own brand goods) or whether traders in that particular goods area normally only sell third party brands;
- whether the retail trade is one where the goods themselves may not normally carry a mark (meat in a butcher's shop for instance) and therefore, the customer may make a particular association between the retail service and the goods as distinct from retail services where the goods themselves are prominently branded.

An opponent's own trading activities and, in particular, any existing reputation it possesses can also be expected to inform and guide the debate.

51. Without the benefit of guidance from the ECJ or a request for a reference, I propose to consider the matter from the point of view of the particular circumstances of this case.

52. The applicant in this case has applied for a narrow and well-defined set of goods, namely sunglasses and sunglass cases. The opponent has sought to show, inter alia, that it is not unusual for retailers to trade in fashion goods and accessories and cites Top Shop as an example of such a practice. I have also been referred at Exhibit JB13 to material from three websites showing that retailers offer both sunglasses and other fashion items such as shoes and bags. I do not doubt that such goods may be available from the same trade source but that does not establish how widespread the practice is. Furthermore, the evidence does not establish that the same branding is used in relation to the retailing service and the goods. The three sites referred to are [www.jungleshop.com](http://www.jungleshop.com), [www.deeshoes.com](http://www.deeshoes.com) and [www.shoesurf.com](http://www.shoesurf.com) but it would appear that the goods offered for sale are under third party brands.

53. Nevertheless, consumers are not wholly unaccustomed to specialist retailers in the fashion and fashion accessories field. The activities of companies such as Tie Rack and Sock Shop is evidence that hitherto unexplored opportunities for specialist retail trading now exist. I am aware from my own knowledge that there is at least one such niche retailer operating in this goods' area, namely Sunglass Hut. In addition, I think that I can take judicial notice of the fact that various high street retailers of clothing and footwear such as Next and Marks & Spencer offer sunglasses under their own brand though I accept that comparisons with these large and well known high-street retailers must be used with caution.

54. The opponent's evidence as to its own trade in sunglasses is summarised above. It confirms that it sells these goods from its own DV8 shops and does so under the DV8 brand. The trade appears to have got underway at or about the period spanning the material date in these proceedings and most of the supporting documentation is strictly after that date. Whilst it was within the opponent's immediate commercial field of vision it could not claim a reputation in relation to a retail and/or goods trade in sunglasses at that time. Nevertheless, it would have formed an area of trade which the opponent would reasonably have wished to defend if challenged. For instance, had the guidance from *Praktiker Bau* been available at the time the opponent's CTM application was examined it could reasonably have specified sunglasses amongst the goods to be traded under the retail service.

55. Making the best I can of it, I find that the competing goods and services are similar to a material extent. I have reached that view on the basis of the particular facts and circumstances of this case and without having to reach a concluded view on the full extent of the opponent's retail services specification. I have also found that DV8 is a strong mark/element and that the respective marks are distinctively similar.

56. Bearing in mind the interdependency principle and the need to consider the net effect of the similarities between marks and goods/services I have, with some hesitation (because this case raises as yet untested issues), come to the conclusion that there is a likelihood of confusion if the applicant's mark was to be put into use in relation to the goods applied for. The opposition succeeds under Section 5(2)(b).

57. There is a further ground of opposition under Section 5(4)(a). In the light of my above finding I need only deal with it briefly. The elements of the action for passing off can be summarised as being:

- (1) that the opponent's goods and services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods offered by the applicant are goods of the opponent; and
- (3) that the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

58. The opponent's earlier right must have been acquired prior to the date of application for registration (Article 4.4(b) of Directive 89/104/EEC). In this case I consider that there is insufficient evidence to say that the opponent's goodwill extended beyond that of a retailer of footwear (including the supply of the goods themselves) under the mark DV8 at the material date. Whilst I accept that the law of passing off is not constrained by the concept of similarity of goods, the degree of similarity between the applicant's goods and the opponent's goods and services is not irrelevant either. For reasons akin to those given above (see in particular the passage from *WANNABEE Trade Mark*) I do not think use of the applied for mark in relation to sunglasses and sunglass cases would lead to relevant confusion with the services and goods which were the subject of the opponent's goodwill at 4 April 2002. The opposition fails on this ground.



## **COSTS**

59. The opposition has succeeded under Section 5(2)(b). The opponent is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £1200. 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 7<sup>th</sup> day of December 2005**

**M REYNOLDS  
For the Registrar  
the Comptroller-General**