

O-334-07

TRADE MARKS ACT 1994
TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996
IN THE MATTER OF INTERNATIONAL TRADE MARK REGISTRATION
NO. 800822 IN THE NAME OF BRACCIALINI S.R.L
FOR THE TRADE MARK TUA IN CLASS 18

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 71203 IN THE NAME OF TULA BAGS LTD

Trade Marks Act 1994
Trade Marks (International Registration Order) 1996

IN THE MATTER OF International Trade Mark Registration No. 800822
in the name of Braccialini S.r.l for the trade mark TUA in Class 18

And

IN THE MATTER OF opposition thereto
under No. 71203 in the name of Tula Bags Ltd

BACKGROUND

1. On 5 November 2004, Braccialini S.r.l made a request for protection of a trade mark in Class 18 in relation to the following specifications of goods:

Leatherware articles, bags and suitcases

2. The base International registration has a registration date of 12 March 2003. The mark for which protection is sought looks as follows:



3. On 11 May 2005, Tula Bags Ltd filed notice of opposition to the designation, the grounds of opposition being in summary:

Under Section 5(2)(b) because the mark applied for is similar to the opponents' earlier marks, and is sought to be registered in respect of goods that are identical or similar to those for which this earlier marks are registered, such that there exists a likelihood of confusion.

Under Section 5(4)(a) by virtue of the law of passing off.

4. In relation to the ground under Section 5(2)(b) the opponents rely on one earlier mark, for the word TULA that was registered on 2 February 1996 in respect of the following goods in Class 18:

Handbags, satchels, sacks, bags, purses, luggage, wallets, belts, straps, pouches, vanity sets, cases, boxes, and other goods made of leather, imitation leather, and fabric.

5. The applicants filed counterstatements in which they deny the grounds on which the opposition is based, and put the opponents to proof in respect of the use they have made.

6. Both sides ask that an award of costs be made in their favour.

7. Only the opponents filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. Neither side took up the offer of an oral hearing, the opponents instead electing to file written submissions in lieu of a hearing. After a careful study of the evidence and submissions, I now go on to give my decision.

Opponents' evidence

8. This consists of a Witness Statement dated 5 October 2006, from Justin Robert Anthony Murphy, a Director of Tula Bags Ltd, a position he has held since August 2000.

9. Mr Murphy says that his company was incorporated in 1977 and has used the TULA trade mark continuously since that date. Mr Murphy says that prior to this the trade mark was used by a predecessor in title trading under the name Tula Imports Ltd. Mr Murphy says that that company started using the mark in the 1970s although he does not know the precise date.

10. Mr Murphy says that the mark has been used on a wide variety of bags such as handbags, satchels, shoulder bags, briefcases, body bags and waist bags, as well as luggage such as wheelie bags, backpacks, vanity cases, holdalls, garment bags and wash bags, and also in relation to a range of small leather goods such as wallets, purses, passport holders, key rings and mobile phone holders. He says that these goods were primarily made from leather, with some being made of fabric or textiles. Mr Murphy continues saying that his company sells its products through department stores such as John Lewis, House of Fraser and Debenhams, as well as quality leather goods shops, approximately 1500 in all located throughout the UK and Eire. He says that his company also sells via mail order and sources such as Good Housekeeping magazine.

11. Mr Murphy goes on to say that in the last nine financial years his company has achieved an annual turnover in the region of £8,000,000 to £12,000,000, and in the same period has spent "roughly £175,000 to £260,000 annually on advertising or otherwise promoting the mark TULA." He goes on to refer to Exhibit JRAM1, which consists of catalogues produced by the opponents in the years 1991, 1992 and 1999 to 2004. The catalogues have the word TULA in a stylised script on the cover, and also on various pages inside, both as a badge on the goods and as an unconnected name. The stylisation of TULA remains reasonably constant, and whilst not a usual typeface is nonetheless quite clearly the word. It is often (but not always) placed inside a rounded triangle but to my mind that serves no more than as a background and is use of the mark as represented in the registrations relied upon. In some places the products appear under headings such as Navigator, Impression and Regatta, and where there appears to be no mention of TULA, at least none that I can see. This may be because the picture quality is poor; I do not know. These are clearly not product

descriptions, and leave open the question of whether they are sub-brands of TULA or a distinct brand.

12. In most cases the covers of these catalogues list the goods as being “handbags, wallets and purses” although on inspection this description does not actually encompass the full range of goods that they list. Other catalogues list a “business and travel collection” encompassing goods such as document and conference folders, key wallets, wash bags, attaché cases and wheeled suitcases. On my examination I consider the evidence to show use on the range of bags, wallets, luggage and small leather goods of the like kind as stated by Mr Murphy.

13. Mr Murphy goes on to refer to Exhibit JRAM2, which consists of pages from various publications. The first comes from Good Housekeeping By Post, which refers to “Great savings on top quality leather bags from Tula”. However, the article dates from October 2005, well after the relevant date. The second and third pages consists of an article from Good Housekeeping called “4 minute guide to what’s new” dated May 2001, and a page from the February 2001 edition of Sunday Express, which refer to a Tula bag and a Tula purse, respectively. The only other mention of Tula that can be dated is found in an article from the June 2001 edition of LE magazine which refers to the “renowned Tula brand accessories” having launched a range of “distinctive, quality handbags for Spring/Summer 2001.” Mr Murphy says that his company’s goods are targeted at the mid price, high volume sector of the market, and as such do not attract the same level of press coverage as products directed to the high price, low volume sector. Even so, Mr Murphy says that his company’s products have been in the top three best selling leather handbag brands in the UK for the last two decades, for most of which they have been the best selling brand.

14. Mr Murphy goes on to refer to Exhibit JRAM3, which consists of press cuttings from 2000 and 2002. The first press release is dated 30 October 2000 and announces a range of purses and wallets. The next is dated 2 January 2001 and relates to a new range of shoulder bags, with the next two dating from 8 December 2000 giving details of a new range of handbags called softbags, and a handbag for brides called a rose-bag. The remaining press release dates from 25 September 2000 and refers to a range of luggage and business cases. It mentions the incorporation of Tula Group Plc as a vehicle to for Tula Bags Ltd to expand its activities. Mr Murphy says that these press releases were circulated by his company’s PR agency to trade press, fashion newspapers and magazines. Mr Murphy concludes his Statement by referring to Exhibit JRAM4, which consist of a page announcing the Spring/Summer range of handbags and small leather goods. The second page lists a range of show dates in January 2004, and depicts a handbag with the TULA name above.

15. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

DECISION

16. The opposition is founded on Section 5(2)(b). That section reads as follows:

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

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

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

17. An earlier trade mark is defined in Section 6 of the Act as follows:

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

- (a) a registered trade mark, international trade mark (UK), 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,

- (b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK),

- (ba) a registered trade mark or international trade mark (UK) which-

- (i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

- (ii) accordingly has the same claim to seniority, or

- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.”

18. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the

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

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*,
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

19. The opponents rely on one earlier trade mark. This achieved registration on 2 February 1996, more than five years prior to the date on which the application in suit was published so the provisions of Section 47(2)(A) introduced under The Trade Marks (Proof of Use, etc.) Regulations 2004 apply.

20. The Proof of Use Regulations place an onus upon the opponents to show that there has been genuine use of their earlier mark, in the UK, within the five years ending with the date on which the application was published. The use can either be by the opponents, or by another party with their consent. If the proprietors have not used the mark, they may nonetheless satisfy the requirement by showing that there are proper reasons for this. The

provisions of sub-section (2)(C) allow for use of a trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.

21. The Act refers to “genuine use” having been made of the trade mark but does not set out what constitutes use that is genuine. The European Court of Justice (ECJ) in Case C-40/01, *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 page 725 paragraph 36, answered the question of what “genuine use” means in the following terms:

“Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such 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 product or service from others that have another origin.”

22. So according to *Ansul*, genuine use entails use of the mark in the market place for the goods or services protected by that mark and not just internal use by the undertaking concerned. Such use must be in relation to goods or services that are already on the market, or about to be marketed and for which preparations are underway to secure customers, for example, by means of advertising. The *Bud* Trade Mark case [2002] RPC 38 at paragraphs 41 and 42 gives some limited guidance on advertising.

23. The assessment of whether there has been genuine use must take into account all of the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, and may include giving consideration, *inter alia*, to the nature of the goods or services at issue, the characteristics of the market concerned, and the scale and frequency of use; the use need not always be “quantitatively significant” for it to be deemed genuine.

24. In the *Police* case [2004] RPC 35, the Appointed Person took the view that the *Ansul* decision did not limit the factors to be taken into account in establishing whether use was genuine only to the three areas specifically mentioned. It had stated that all facts and circumstances relevant to establishing whether there had been real commercial exploitation should be included, and that the size of a proprietor’s undertaking may be relevant.

25. Further guidance on the scale and frequency of use can be found in the *La Mer Technology Inc* case [2005] F.S.R. 29. This is the decision of a resumed appeal hearing following a reference to the ECJ on various questions relating to the meaning of “genuine use”. In his decision Blackburne J stated:

“**31.** Whether in any given case the proven use amounts to genuine use (“whether the commercial exploitation of the mark is real” as paragraph 38 of *Ansul* puts it) will depend on all of the facts and circumstances relevant to establishing such a state of affairs, including the characteristics of the market concerned and of the products or services in question, and the frequency or regularity of use of the mark.

Even minimal use will be sufficient if, in the market concerned, the proven use is considered sufficient to preserve or create a market share for the goods or services protected by it.

Thus, the sale or offering for sale (in, say, a trade magazine) of a single exceedingly costly and highly unusual item carrying the mark in a specialised market, for example a very large and complex piece of earth-moving equipment, may very well be considered by itself to be sufficient in the market for such equipment to preserve or create a market share for items of that kind which carry the mark whereas the sale of a low priced everyday product in a widespread market, for example a single jar of face cream bearing the mark or the exposure for sale of, say, half a dozen such jars for sale on a shop shelf, would almost certainly not be. It would be irrelevant to this conclusion that, in the latter example, the purpose of the proprietor of the mark (or of some third-party acting with the proprietor's consent) when offering the jar of cream for sale was to create a share in the market for face cream sold in jars bearing the mark.”

26. Mr Justice Blackburne referred back to the decision of Jacob J in the earlier part of the appeal:

“15. Jacob J himself ventured an answer to those questions. At paragraph 29 of his judgment [2002] F.S.R 51 at 29 he said this:

"I take the view that provided there is nothing artificial about a transaction under a mark, then it will amount to ‘genuine’ use. There is no lower limit of ‘negligible’. However, the smaller the amount of use, the more carefully must it be proved, and the more important will it be for the trade mark owner to demonstrate that the use was not merely ‘colourable’ or ‘token’, that is to say done with the ulterior motive of validating the registration. Where the use is not actually on the goods or the packaging (for instance it is in advertisement) then one must further enquire whether that advertisement was really directed at customers here. ...

Nor do I think that the absence of a *de minimis* rule significantly affects the policy behind the legislation. Yes, marks must be used within the relevant period, but there seems no reason to make a trader who has actually made some small, but proper, use of his mark, lose it. Only if his use is in essence a pretence at trade should he do so. And of course, if he has only made limited use of his mark it is likely that the use will be only for a limited part of his specification of services. If he has a wider specification, that can and should be cut back to just those goods for which he has made use ..."

27. Mr Murphy says that the mark has been used on a wide variety of bags such as handbags, satchels, shoulder bags, briefcases, body bags and waist bags, as well as luggage such as wheelie bags, backpacks, vanity cases, holdalls, garment bags and wash bags, and a range of small leather goods such as wallets, purses, passport holders, key rings and mobile phone holders. These goods are primarily made from leather although some are made of fabric or textiles. The company sells its products through department stores and leather goods shops, approximately 1500 in total located throughout the UK and Eire, and through mail order sources such as Good Housekeeping magazine. In each of the last nine financial years, they state that they have achieved an annual turnover in the region of £8,000,000 to £12,000,000, and spent “roughly £175,000 to £260,000 annually on advertising or otherwise promoting the

mark TULA.”

28. Evidence in support of these claims can be found in Exhibit JRAM1, which consists of copies of the opponents’ catalogues for the years 1991, 1992 and 1999 to 2004. The catalogues show the word TULA in a stylised script on the cover that I would say is similar in style to that used for the applicants’ mark. The stylisation of TULA remains reasonably constant throughout, often being placed inside a rounded triangle. To my mind the triangle adds to the visual impression but in reality will be regarded by the consumer as serving no more than as a background, a defining area for the word. Some products appear under headings such as Navigator, Impression and Regatta where there is no apparent mention of TULA. These are clearly not product descriptions, and leave open the question of whether they are sub-brands of TULA or distinct brands.

29. The covers of these catalogues list the goods as being “handbags, wallets and purses” although on inspection this does not accurately list the full range of goods contained within. A couple of catalogues refer to a “business and travel collection” containing goods such as document and conference folders, key wallets, wash bags, attaché cases and wheeled suitcases. On my examination of these catalogues I consider the evidence to show use on the range of bags, wallets, luggage, and small leather goods of the like kind, as stated by Mr Murphy.

30. Exhibit JRAM2 consists of an article from Good Housekeeping called “4 minute guide to what’s new” dated May 2001, a page from the February 2001 edition of Sunday Express, which refers to a Tula bag and a Tula purse, respectively and an article from the June 2001 edition of LE magazine that mentions the renowned Tula brand accessories as having launched a range of “distinctive quality handbags for Spring/Summer 2001.” Mr Murphy says that his company’s products have been in the top three best selling leather handbag brands in the UK for the last two decades, for most of which they have been the best selling brand. Press cuttings contained within Exhibit JRAM3 date from 2000 and 2002 and announces a range of purses, wallets, shoulder bags, handbags, luggage and business cases. The press releases mention the incorporation of Tula Group Plc as a vehicle to for Tula Bags Ltd to expand its activities. Mr Murphy says that these press releases were circulated by his company’s PR agency to trade press, fashion newspapers and magazines. Exhibit JRAM4 announces the Spring/Summer range of handbags and small leather goods, and lists a range of show dates in January 2004.

31. On the basis of the evidence provided I am satisfied that at the relevant date the opponents had used the name TULA in relation to bags such as handbags, satchels, shoulder bags, briefcases, body bags and waist bags, luggage backpacks, holdalls, garment bags and wash bags. There is also evidence that they have done so in respect of a range of small leather goods such as wallets, purses, passport holders, key rings and mobile phone holders. Being terms that describe specific items, I do need to consider whether they reflect how the relevant consumer would perceive or describe them; there should be no difference. The description “other goods made of leather” is broad enough to encompass items such as saddlery and is clearly not an accurate description of the goods for which the mark has been used. Whilst these goods have primarily been made of leather, there is evidence of some having been made of fabric. There can be no argument that the opponents have used the TULA in respect of these goods in a genuine commercial endeavour.

32. Having assessed the use, I am also in the position to say that at the relevant date, the opponents are most likely to have established a strong reputation in the name TULA in relation to their bags, luggage and the small items of leatherware that I have mentioned. Given the consistent way in which the opponents have used the TULA name it is quite possible that the stylisation may also have come to be part of the public perception. It is difficult to be certain without specific evidence and I therefore place no weight on this.

33. In any analysis it is inevitable that reference will be made to the elements of a mark, and particularly so where these are separated or made distinct in some way. However, it must be remembered that the consumer does not embark on a forensic analysis of trade marks and it is the marks as a whole that must be compared.

34. The opponents' earlier mark consists of the word TULA in plain block letters. The mark applied for consists of the word TUA. Self evidently, both marks begin with the letters TU and terminate with the letter A. That the similarities are at the beginning and end of the words with only one letter difference in the body of the word would ordinarily mean that there is a strong degree of visual similarity, but these are very short words where even minor changes have a disproportionate significance and impact. To my mind, when represented in plain block letters, the occurrence (or absence) of the letter "L" is clear to the eye, but the applicants mark is represented in a stylized script where the letters are not as clear. If I were to factor in the actual use as shown in the opponents' evidence there is a marked similarity in the style of the opponents' use (which is a reasonable indication of what would be normal and fair use) and that in which the applicants' mark is shown. In this scenario the differences in the words are less plain to see.

35. When considered from the point of view of their aural similarity, it is clear to me that these are words that are likely to sound similar when spoken or heard. In long words it is usual for emphasis to be placed on every consonant, vowel or syllable, but in short marks such as these that will be the case. In my view, when these marks are used in speech they will have two distinct sounds. The applicants' mark will be enunciated as "Too-Lah", the L being lost in the body and almost inaudible. The applicants' mark is more rounded, being likely to be pronounced as TOO -AH. They may not be identical, but in my view they are aurally similar.

36. . TULA is not, as far as I am aware, a word that appears in the English language, at least there is no evidence that it is, or that it has any relevance for the goods for which it is registered. As far as I am aware it is an invented word. The same appears to be the case in respect of the applicants' mark TUA.

37. I have already stated that the consumer does not look at a word and break it up into pieces. However, when considering the question of similarity from a legal standpoint it is necessary and correct to consider the significance of the individual elements provided it is the marks as a whole on which the assessment is based. Taking all of these factors together I come to the view that the respective marks should be considered to be similar.

38. Being an invented word, TULA must be considered to possess a strong distinctive character. The question is whether the use that the opponents have made had accrued any

reputation and added to the distinctiveness. The opponents say that they have used the TULA trade mark continuously since 1977, and that prior to this it was used by a predecessor in title trading under the name Tula Imports Ltd from the 1970s.

39. Turning to the respective goods. The application covers “leatherware articles” and “bags and suitcases”. The opponents’ earlier mark specifically mentions “bags”, and “luggage” which would encompass suitcases. Self evidently identical goods are involved. The remaining item in the applicants’ specification is a general term “leatherware”, or in other words, “ware”, including bags, suitcases, purses, wallets made of leather. To my mind there can be no doubt that the term encompasses goods of the kind covered by the opponents’ earlier mark. Accordingly, the clash of goods covers the entirety of the applicants’ specification.

40. There is no limitation or restriction to either of the respective specifications that would serve to distinguish the users or market, so having found that identical goods are involved I can see no reason why the channels of trade should not also be identical. The opponents are not a mass-market high street brand but that is not reflected in their specification of goods which notionally encompasses all markets for the goods in question. Likewise, the applicants’ specification is notionally capable of covering goods from the cheap and cheerful to the exclusive designer.

41. Taking all of the above into account and adopting the global approach advocated by the case law, I come to the view that if the applicants were to use their mark in respect of the goods for which they seek registration, this would lead the consumer into believing that the goods are those of the opponents or some connected enterprise. The opposition under Section 5(2)(b) succeeds.

42. Whilst my decision under Section 5(2)(b) effectively decides the matter, for completeness I will go on to consider the ground under Section 5(4)(a). That section reads as follows:

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

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

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark”.

43. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

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

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

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation."

44. To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case [2002] RPC 19, in which he said:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472).

Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur."

45. The first question is whether the opponents have any goodwill in TULA. I my assessment of the evidence in respect of the ground under Section 5(2)(b) I came to the view that the opponents are likely to have established a strong reputation in TULA in respect of their bags, wallets, purses, luggage and the like. I see no reason why the position should be any different in respect of goodwill. I also found the respective marks to be similar. Thus, I believe it follows that having found the applicants and the opponents to be trading in identical goods, that use of the mark applied for, by the applicants, in respect of the goods covered by the application would amount to a misrepresentation that will lead to damage. The ground under Section 5(4)(a) succeeds.

46. The opposition having been successful, albeit in part, the opponents are entitled to a contribution towards their costs. I therefore order that the applicants pay the opponents the sum of £1,250 towards their costs. 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 12th day of November 2007

**Mike Foley
for the Registrar
the Comptroller-General**