

O-289-08

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION No. 879337  
BY BRANTANO N.V.

AND

IN THE MATTER OF OPPOSITION NO. 71377 THERETO  
BY ANTONIO RIERA FARRE

## Background

1. On 12 January 2006 Brantano N.V. ("Brantano"), on the basis of a Benelux registration with a priority date of 8 July 2005, requested protection in the UK under the terms of the Madrid Protocol for the following mark.



2. The request was made in relation to the following goods:

Class 14  
*Fashion jewelry (jewelry)*

Class 18  
*Bags, handbags, belts; trunks and suitcases, garment covers, all made of leather or imitation leather*

Class 25  
*Clothing, footwear, headgear*

3. The registration claims the colours light blue, white and black.

4. Following publication of the international registration in the *Trade Marks Journal*, Notice of opposition was filed by Antonio Riera Farre ("ARF"). The opposition is in relation to the request for protection of goods in class 25 only and is based on section 5(2)(b) of the Act. In support of this ground of opposition, it relies on a single Community trade mark registration as follows:

No: 1144252

Mark:



# **ELEMENTS**

Goods

*Sportswear; football boots, studs for football boots; footwear for sports; shirts, jumpers, blouses, windcheaters, parkas, jackets, trousers, gloves, socks, stockings, underwear, pyjamas, night-dresses, waistcoats, cloaks, shawls, coats, scarves,*

*jerseys, skirts, suits, neckties, belts, suspenders, swimsuits; caps (headwear), waterproof clothing, anoraks, gymnastics and sports clothing included in this class; dressing gowns; stoles, headscarves; suits; overalls; footwear and headgear; knitwear.*

5. The registration relied on has a registration date of 23 June 2000.

6. Brantano filed a counterstatement in which it accepted that there is a direct overlap between the goods covered by the earlier mark and its own goods in class 25 but otherwise denied the grounds of opposition. It also put ARF to proof of use of its earlier mark.

7. Neither party requested to be heard. Brantano filed written submissions. After a careful consideration of the papers, I give this decision.

## **Evidence**

### ARF's evidence

8. Caitriona Mary Desmond, a Trade Mark Attorney Assistant with Murgitroyd & Company, ARF's professional representatives, has filed a witness statement dated 27 July 2007 with 4 exhibits. Ms Desmond confirms she is authorised to make the statement by and on behalf of ARF and does so from matters within her own knowledge.

9. Ms Desmond states ARF has used its earlier mark in Spain continuously since at least 1995 in respect of "clothing". She provides details of the total sales figures for the period 2003 to 2005 as follows:

Year	Total sales (in euros)
2003	3,892,320
2004	4,067,561
2005	4,111,600

I shall comment further on the figure given for 2005 below.

10. Attached to Ms Desmond's witness statement are the following exhibits:

- CMD 01 said to be examples of the earlier mark as used. This exhibit appears to consist of pages taken from (a) catalogue(s) and show the earlier mark on various articles of sports clothing.
- CMD 02 said to be confirmation of sales figures along with extracts from numerous sporting magazines dated between 2001 and 2006. The first page of this exhibit refers to two identified trade marks. These two trade marks do not form part of the matter before me and no explanation is given as to the relevance of this information to these proceedings. The second (Spanish) and third (English "translation") pages provide details of sales figures. The figures are said to have been taken from the "Registro Mercantil" /"Commercial Registry" but no indication is given of who collated this information nor who

provided the “translation”. In any event, the figures do not fully accord with that given above in that the figure given for 2005 is stated in this exhibit to be 3,111,600 euros not 4,111,600 euros. The rest of this exhibit are extracts from magazines and newspaper articles along with “translations”(see below).

- CMD 03 said to be numerous statements from third parties involved in the sporting equipment field and intended to show the reputation of the earlier mark since 2001. The exhibit consists of unaddressed statements, some on headed paper, along with “translations” (see below). None of these documents are in the form of witness statements nor headed for these proceedings. Indeed where dated, they indicate they were written in either 2001 or 2002 and so could not have been prepared for these proceedings. I cannot be certain to which trade marks they relate. Certainly none of these pages show the earlier mark relied on in these proceedings.
- CMD 04 said to be printouts from ARF’s website dating from 2002 to 2006. The exhibit also includes pages said to show the number of viewers to ARF’s website and the result of a Google search (in fact it is a single page rather than a complete result). These latter pages are presented in Spanish and are not accompanied by any translation or explanation as to their relevance.

11. Before I proceed, there is a matter I should raise in relation to the “translations” accompanying exhibits CMD 02 and CMD 03. None of these “translations” are in the form of a statutory declaration or affidavit etc. They fail to identify who “translated” the material from the original Spanish and they provide no indication of the “translator’s” competence or qualifications. In relation to the magazine articles exhibited at CMD 02, the “translations” are extremely brief in comparison to the length of the articles such that it is clear that only a very small part of each of the articles has been “translated”. It is well established that to be relied upon, exhibited material in a foreign language should be supported by a certified translation in the form of statutory declaration or affidavit prepared by a competent translator (see *Pollini* BL O-146-02). No such certified translations have been filed and I am unable to give this material any weight.

#### Brantano’s evidence

12. This is a witness statement, dated 7 March 2008, of Theodorus L. Strybos, Director of the Brantano group of companies. Mr Strybos confirms he is authorised to make the statement on behalf of Brantano and that the facts within it come from his personal knowledge and from the books and records of his company to which he has full and free access.

13. Much of Mr Strybos’ witness statement is given to commentary on the evidence of Ms Desmond. I do not intend to summarise those comments but do take them into account and will refer to them as necessary later in this decision.

14. Mr Strybos states that Brantano has sold goods under the mark in the United Kingdom since at least 2005. Mr Strybos’ exhibits are somewhat unusually identified as KM1 to KM6, though nothing rests on this. At KM1, he exhibits details of these sales as follows:

Brand ID	Net Sales Qty	Net Sales Revenue	Year (week)
ELEMENT Z	25,504	173,062.66	2005
ELEMENT Z	78,004	363,113.52	2006
ELEMENT Z	378,933	2,313,440.87	2007
ELEMENT Z	46,790	267,808.26	2008 to date

15. At KM2 he exhibits a list of some 148 stores throughout the United Kingdom at which such goods were and are sold. At KM5 are examples of how the mark is used in these stores and at KM6 are details of the various goods bearing the mark which I note are handbags and cases. Mr Strybos states that he is not aware of any instances of confusion between the respective trade marks.

16. Mr Strybos explains that his company is the owner of various domain names incorporating elementzat@ brantano and elementzatbrantano, registered since February 2005. Details of the registrations are exhibited at KM3 and KM4.

17. That concludes my summary of the evidence.

## Decision

18. There is a single ground of opposition founded on section 5 (2)(b) of the Act. This reads:

“(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.”

An earlier trade mark is defined in Section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK), 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.”

19. Also of relevance are the provisions of Section 6A of the Act. Section 6A sets out the circumstances in which the provisions apply in relation to opposition proceedings, the relevant parts of which state:

“6 A(1) .....

(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 or 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.

(7)...

### **Proof of use**

20. ARF relies on Community trade mark No. 1144252. This has a registration date of 23 June 2000. It is an earlier trade mark as defined in Section 6(1) of the Act. The mark applied for was published for opposition purposes on 30 June 2006, more than five years after the earlier mark was registered. The mark relied on by ARF is subject, therefore, to the proof of use requirements set out above. In its counterstatement Brantano puts ARF to proof of use of its mark.

21. Section 100 of the Act provides that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

22. The requirements for “genuine use” have been set out by the European Court of Justice in its judgment in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and in its reasoned Order in Case C-259/02, *La Mer Technology Inc. v Laboratoires Goemar S.A.* [2005] ETMR 114. From these cases I derive the following principles:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark; i.e. to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must not be just internal to the undertaking concerned but must be “on the market” (*Ansul* paragraph 37);
- the use must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37)
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting the goods on the market (*Laboratoire de la Mer*, paragraph 25, referring to the earlier reasoned decision of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraphs 34);

- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

23. The earlier mark relied on by ARF under Section 5(2)(a) is registered in respect of: *Sportswear; football boots, studs for football boots; footwear for sports; shirts, jumpers, blouses, windcheaters, parkas, jackets, trousers, gloves, socks, stockings, underwear, pyjamas, night-dresses, waistcoats, cloaks, shawls, coats, scarves, jerseys, skirts, suits, neckties, belts, suspenders, swimsuits; caps (headwear), waterproof clothing, anoraks, gymnastics and sports clothing included in this class; dressing gowns; stoles, headscarves; suits; overalls; footwear and headgear; knitwear.*

24. In her witness statement Ms Desmond states that the earlier mark has been used in respect of *clothing*, with annual sales under the mark amounting to some 3 to 4 million euros. Whilst evidence of specific sales is absent, there is no reason to doubt the sales made are genuine commercial transactions. Exhibit CMD 01 shows use of the mark on catalogues dated 2000/2001 and sales figures are given for the years 2003-2005. In his evidence, Mr Strybos does not dispute these sales figures nor does he dispute the content or generality of ARF's evidence of use. That said, he points to the fact that the use made of the earlier mark was made in Spain and not the United Kingdom. He does not explain his point further. For its part, ARF do not claim to have made any use in the United Kingdom of its earlier mark.

25. The earlier mark is, as I indicated above, a Community trade mark. Section 6A(3) above, sets out the requirements that must be satisfied in order for the proof of use conditions to be met. Section 6A(3) has to be read in conjunction with section 6A(5). The combined effect of these provisions is, in my view, that genuine use of the earlier Community trade mark in Spain, in relation to the goods or services for which the mark is registered would satisfy the proof of use requirements. Whilst recognising that it is not directly on point in that it deals with the issue of reputation of a Community trade mark in relation to a claim under section 5(3), I am supported in my view by the comments of Mr Geoffrey Hobbs Q.C. sitting as a Deputy Judge of the High Court in *Whirlpool Corporation (a company existing under the laws of Delaware, United States of America) Whirlpool Properties Inc (a company existing under the laws of Michigan, United States of America), Kitchenaid Europa Inc. (a company existing under the laws of Delaware, United States of America) v Kenwood Ltd* [2004] EWHC 1930 (Ch). Mr Hobbs stated:

“76. Article 9(1)(c) provides protection for Community trade marks which have a reputation *in the Community*. Kenwood suggested that this means a reputation across the Community as a whole or at least a large area of it. I do not agree. In the case of a trade mark registered at the national level, protection of the kind provided by Article 9(1)(c) can be claimed for trade marks which have a reputation in the sense that they are known by a significant part of the public concerned by the products or services covered by that trade mark in territory of registration. Since the territory of registration is part of the Community, the trade mark has a reputation in the Community. The trade mark does not cease to have a reputation in the Community if the national registration is either subsumed within a Community trade mark

registration under Article 34(2) CTMR on the basis of a valid claim to seniority or duplicated by a Community trade mark registration. In principle, a Community trade mark should not receive less protection than a national trade mark with a reputation in the same territory. I think that the aim should generally be to prevent conflict occurring in any substantial part of the Community and that the United Kingdom can for that purpose be regarded as a substantial part of the Community, with or without the addition of France and Germany. It thus appears to me that Whirlpool's Community trade mark has a reputation in the Community."

26. I therefore go on to consider whether the evidence of use provided by ARF shows genuine use in relation to the goods for which its earlier mark is registered.

27. Though the specification of goods of the earlier mark covers a wide range of articles of clothing, the term *clothing* per se does not appear in the specification. The material exhibited to Ms Desmond's witness statement includes pages taken from catalogues and ARF's website over a period of years. These show the earlier mark used on and in relation to a range of clothing for sports use including shirts, socks, shorts, jerseys and dresses for football, basketball or hockey use and swimwear, tracksuits, sports jackets and sports anoraks. From the evidence before me, I am unable to say that ARF has shown any use in relation to football boots, studs for football boots, blouses, gloves, stockings, underwear, pyjamas, night-dresses, waistcoats, cloaks, shawls, scarves, skirts, neckties, belts, suspenders, caps (headwear) waterproof clothing, gymnastics clothing, dressing gowns, stoles, headscarves, overalls, footwear and headgear or knitwear.

28. The question of how tightly a specification needs to be drawn in the light of the use shown to have been made is a matter to be determined on a case by case basis having regard to the principles set out in *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] RPC 32 and *Reckitt Benckiser (España) SL v OHIM (Aladin)* Case T-126/03. Applying that guidance, I find that ARF has shown genuine use of its earlier mark and that a fair specification which reflects that use and is consistent with the manner in which the average consumer would describe those goods is *articles of sports clothing*.

29. In reaching my decision under section 5(2)(b) I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77 and *Marca Mode CV v Adidas AG and Adidas Benelux B.V.* [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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has

kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B.V.* paragraph 27;

- (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*, paragraph 23;
- (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*, paragraph 23;
- (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 v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (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*, paragraph 24;
- (g) 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 + Adidas Benelux BV*, paragraph 26;
- (h) 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*, paragraph 41;
- (i) 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*, paragraph 29.

30. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed.

### **Comparison of goods**

31. Taking into account my findings as to ARF's use of the mark and the extent of the opposition, the respective goods are as follows:

ARF	Brantano
Articles of sports clothing	Clothing, footwear, headgear

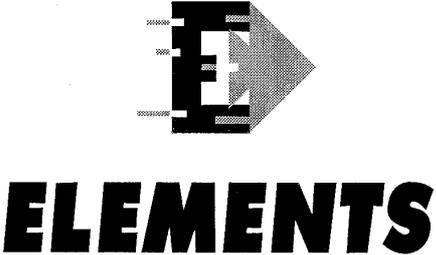
32. Brantano accepts in its counterstatement that there is a direct overlap between the goods though it does not specify the extent of that overlap. Clearly, the general term *clothing* included in Brantano’s application would include articles of sports clothing. It is well established that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category with the later mark (see e.g. *Gérard Meric*, Case T-133/05 paragraph 29). Based on the notional scope of the application, identical and/or closely similar goods are involved.

**The relevant consumer and the nature of the purchasing process**

33. The relevant consumer is deemed to be reasonably well informed, reasonably circumspect and observant and will range from the general public to the wholesaler. Purchases are likely to be made with a degree of care with consideration being given, variously, to issues such as price, style, colour, size and suitability for purpose etc. That said, it is likely that the degree of care may vary depending on the article being considered i.e. with more consideration being given to a suit than to a pair of socks. I take into account the varying levels of consideration likely to be given.

**Comparison of marks**

34. The marks to be compared are:

ARF’s earlier mark	Brantano’s mark
	

35. Both trade marks are composite ones which contain both words and devices. ARF’s mark consists of a device which appears to me to be a stylised upper case letter E “gripping” a right-pointing arrow, the whole appearing centrally above the word ELEMENTS also written in upper case. Brantano’s mark consists of the word ELEMENTZ written in lower case and appearing above the proportionately much smaller symbol and word @BRANTANO with the word ELEMENTZ appearing in white and @Brantano in black against a light blue background.

**Distinctive and dominant components of the respective marks**

36. ARF do not comment on this issue however, in its written submissions, Brantano state “...the distinctive and dominant elements of the earlier trade marks (sic) are highly stylised “E” device and the Opponent’s trade mark and the “Z” and “@BRANTANO” elements of the Applicant’s trade mark”. I cannot be entirely sure what it means by this statement.

37. In *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* ECR I-8551 it was stated:

“The global appreciation of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, in particular, *SABEL*, paragraph 23, *Lloyd Schuhfabrik Meyer*, paragraph 25 and *Matratzen Concord*, paragraph 29).”

38. Thus, all of the component parts of a mark must be taken into account unless they are merely negligible (*Case C-334/05 P OHIM v Shaker di L.Laudato & C Sas*).

39. An element of a mark which may not be dominant may still have an independent distinctive role. Again in *Medion (supra)*, it was stated:

“However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.”

40. The highly stylised E and arrow device appearing in ARF’s earlier mark is such that it must be considered to be a distinctive part of the mark. The word ELEMENTS is an ordinary dictionary word in common usage to denote a component part or parts that make a composite whole. In relation to goods such as e.g. suits, the word could, perhaps, be regarded as alluding to the individual pieces making up a complete outfit though it is even less clear that the same position holds true in relation to articles of sports clothing. It may also be taken to allude, again somewhat obliquely, to clothing intended to protect one “from the elements”, e.g. the wind and rain.

41. Brantano submits that the word ELEMENTS is a common term for clothing and refers to eight marks on the UK register which each contain the word ELEMENTS. Brantano indicate that because of these other registrations, the respective marks can be distinguished. These submissions relate to the “state of the register”. I have no evidence as to whether any of these marks are in use nor, if they are, do I know the nature of any such usage. Neither is it clear whether any of the marks, if used, use the word in any descriptive manner.

42. Notwithstanding my comments above, I do not consider the word ELEMENTS is directly descriptive in relation to the relevant goods. I find that the word has an independent distinctive character within the totality of the earlier mark and that it is at least of equal dominance within the mark as the E device component.

43. The word ELEMENTZ appearing in Brantano’s mark would be seen as a complete word and as a clear misspelling of, and accorded the same meaning as, the word ELEMENTS. I consider the “@” symbol is commonly understood to mean

“at”. The word BRANTANO does not, as far as I am aware, have any meaning in English and is to be considered an invented word. As such, the symbol and word @BRANTANO is distinctive however, given its relative size I consider it to be subordinate to the visually dominant word ELEMENTZ and may well be overlooked by some.

### **Other factors**

44. In the *React* case, [2000] RPC 285, Mr Simon Thorley, sitting as the Appointed Person, said:

“There is no evidence to support Ms Clark’s submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent orders usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely primarily on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.”

45. The decisions in *Claudia Oberhauser v OHIM (Fifties)* [2003] ETMR 58 and *Criminal Clothing Ltd v Aytan’s Manufacturing (UK) Ltd* [2005] EWHC 1303, also indicate that the circumstances in which the relevant goods and trade marks are encountered by the consumer, particularly at the point at which the purchase is made, is an important consideration, but the matter must be assessed by applying an assessment of all relevant factors. Although the selection of clothes is a visual act which places the importance on the appearance of marks, this does not negate the need to take into account and balance the aural and conceptual considerations. This I go on to do below.

### **Visual, oral/aural and conceptual considerations**

46. Clearly there are visual differences in the respective marks in relation to the E device within the earlier mark and the @Brantano words of the application. There are, however, clear visual similarities between them in respect of the commonality of the first seven letters of the words ELEMENTS and ELEMENTZ. The words differ only in respect of their final letters, a difference which is likely to be overlooked given the increasing practice of misspelling endemic in today’s marketing environment. Similarly, the fact that one appears in upper case and the other in lower case, even if noticed, is unlikely to be a material factor from the consumer’s perspective. When compared as wholes, there is a fair degree of visual similarity.

47. Whilst ARF’s earlier mark contains a device, this is unlikely to be articulated: the inclusion of a word within the mark means that it is the word which is likely to be referred to orally. The word ELEMENTS is indistinguishable in oral/aural use from the word ELEMENTZ appearing as the first and dominant word in Brantano’s mark. There is a high degree of oral/aural similarity.

48. For some consumers the words ELEMENTS/ELEMENTZ may be conceptually identical in bringing to mind items of clothing which, together, make up one's wardrobe but even if this is the case it is not clear that this is true in respect of all items of clothing. The conceptual identity is somewhat diluted by the fact that the remaining parts of the respective mark have no conceptual similarity. Taking the respective marks in their entirety, there is a fair degree of conceptual similarity.

### **Likelihood of confusion**

49. ARF has filed evidence of use of its mark, some of it specifically intended to show its reputation (CDM03). As I indicated above, much of this exhibit is in Spanish and is not accompanied by a certified translation, cannot be said definitively to relate to the earlier mark relied on in these proceedings and appears to date from a period long before these proceedings began. ARF's remaining (unchallenged) evidence show annual sales on articles of sports clothing under the mark amounting to between 3 and 4 million euros, however whilst this figure is not, of itself, insignificant, I have no evidence which puts those sales into context in respect of the relevant market, which I expect to be extremely large. Based on the evidence before me, I am unable to say that ARF's earlier mark has accrued any significantly enhanced distinctive character through use. The mark is, however, inherently distinctive.

50. Brantano have also provided some evidence of the use of its mark and submit that there have been no instances of confusion. Given that ARF's use, in Spain, has been made in relation to articles of sports clothing and Brantano's, in the UK, appears to have been in relation to handbags and articles of luggage, this is not, perhaps surprising. In any event I have to consider matters on the basis of the specification of goods for which it has applied.

51. I have found the goods to be identical and the marks to be similar to at least a fair degree. Taking all factors into account and allowing for imperfect recollection, I consider there is a likelihood of confusion and the ground of opposition based on section 5(2)(b) succeeds. The application for protection in the UK is refused in respect of the goods for which protection is sought in class 25.

### **Costs**

52. ARF has been successful and is entitled to a contribution towards its costs. I award costs on the following basis taking into account the criticisms I make above in relation to parts of the evidence which it filed:

Filing Notice of Opposition	£200 plus £300 (fee)
Considering the counterstatement	£300
Filing evidence	£200
Considering Brantano's evidence	£200
Total:	£1200

53. I order Brantano N.V. to pay Antonio Riera Farre 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 22<sup>nd</sup> day of October 2008

Ann Corbett  
For the Registrar  
The Comptroller-General