

O-008-09

TRADE MARKS ACT 1994

IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. 832107
BY GILMAR S.P.A.

AND

IN THE MATTER OF OPPOSITION NO 71407 THERETO
BY ICE CLOTHING CO LTD.

Background

1. On 27 May 2004 Gilmar S.P. A. (“the applicant”), on the basis of an Italian registration with a priority date of 5 May 2004, requested protection in the UK under the terms of the Madrid Protocol for the mark ICE B.

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

Class 18

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25

Clothing, footwear, headgear.

3. Following publication of the international registration in the *Trade Marks Journal*, Notice of Opposition was filed by Ice Clothing Co Ltd (“the opponent”). The opposition is directed to the request for protection of goods in class 25 only and is based on section 5(4)(a) of the Act. In support of this ground of opposition, the opponent claims rights in two earlier marks:

- ICE
The opponent claims to have used the mark since 1996 in relation to women’s clothing including trousers, shirts, dresses, tops and blouses.
- ICE BABES
The opponent claims to have used the mark since the year 2000 also in relation to women’s clothing including trousers, shirts, dresses, tops and blouses.

4. The applicant filed a counter-statement which simply puts the opponent to proof of use of its claimed earlier rights. I will return to this later in this decision.

5. Both sides filed evidence. Neither party requested to be heard but both filed written submissions in lieu of a hearing. After a careful consideration of all the material before me, I give this decision.

Opponent’s evidence

6. This takes the form of a witness statement dated 28 February 2008 of Surinder Channa. Mr Channa is the sole director of the opponent company which was incorporated on 7 August 1996.

7. The opponent’s business is the manufacture and sale of ladies’ clothing and, between the date of its first sale on 16 November 1996 until 2002, all sales are said to have been made under the mark ICE. At SC 1, Mr Channa exhibits photographs of various garments showing sewn-in labels and swing tags which date from between October 1999 and 2002. Mr Channa states that the garment labels and swing tags have been re-designed periodically. The earliest, said to have been used

between October 1999 and December 2000 shows a blouse/top with the sewn in label showing the word ICE. One said to be from 2001 shows ICE ICE ICE. One dating from 2002 shows the word ICE in cursive script with a red heart replacing the dot above the letter i. Two of the photographs show the mark ICE in conjunction with the word BABES and are said to date from 2003 and 2005.

8. Mr Channa provides the following details of the opponent's total turnover:

Period/Year ending	Turnover (£)	Garments sold (est)
30/09/1997	133,717	23,880
30/09/1998	624,539 (<i>See below</i>)	111,525
30/09/1999	1,149,258	205,225
30/09/2000	1,378,422	245,150
30/09/2001	1,308,436	233,650
30/09/2002	1,952,257	===
30/09/2003	2,192,999	===
30/09/2004	1,792,800	===

9. Mr Channa states that in 2002 the opponent began to manufacture "some other brands". In particular, it made a number of garments into which JAPAN labels were sewn for one of its existing customers. Mr Channa states that he was not interested in expanding this aspect of the business as "my priority has always been the sale of our own ICE and (later) ICE BABES branded clothing." I take it from this that the JAPAN clothing was made for a third party. Mr Channa states that the opponent had no commercial reason to keep separate records of sales made under the mark ICE and other marks. He estimates, however, that for each of the years ending 30/09/2002 and 30/09/2003, a maximum of £300,000 of the above turnover figures would have been attributable to non ICE branded clothing with a figure of £200,000 relating to the period from October 2003 to the end of May 2004.

10. At SC2 Mr Channa exhibits copies of the opponent company's profit and loss accounts for the above years from which the above figures have been extracted. I note in passing that there is one discrepancy in the above turnover figures in that the figure given for year ending 30/09/1998 appears in the profit and loss figures as 624,536. Nothing turns on this (very slight) discrepancy.

11. Having analysed a small number of invoices for sales made over less than two weeks in October 1999, Mr Channa estimates that the average price of an ICE branded garment was approximately £5.60 and this provides the basis for his estimate of the number of garments sold under the mark.

12. Mr Channa states that garments have been sold to customers throughout the UK with most of these sales being made direct to independent clothes shops and cash and carry outlets with a few being made to wholesalers. The opponent also operates a showroom in London. Since 1998 the opponent has exported some clothing mainly to Southern Ireland and, to a much lesser extent, Iceland. Mr Channa estimates these sales to amount to £100,000 for the years 1998-2000, £200,000 in 2002 and £220,000 for the years 2003 and 2004.

13. Mr Channa provides information about a number of orders he placed for labels and swing tags each year between 1996 and May 2004. These orders range from some 18,000 garment labels in 1996 to 256,550 in 2003 with a high of 417,690 in 2002. Swing tags ordered for these same years are given as 20,000, 215,900 and 349,250 respectively. At SC3 Mr Channa exhibits copies of the relevant invoices and indicates that he cannot be certain that these are all the orders he made for labels, particularly in the period 1996 to 1999. At SC4 he exhibits copies of the artwork for the labels and swing tags as supplied to him. These are dated from May 1999 to December 2003 and bear the mark ICE either on its own, duplicated or in triplicate or with the word CLOTHING. One label is dated 2004 but because of the state of the photocopy I am unable to see anything on the label shown.

14. Whilst the opponent manufactures a large proportion of the clothing it sells, Mr Channa confirms that it also outsources some manufacturing to other companies. At SC5 he exhibits copies of instructions given to those other companies and dating between 1997 and 2004 and comments that they all indicate that ICE labels and swing tags are to be attached to the garments.

15. At SC6, Mr Channa exhibits sample invoices showing sales of ICE clothing in the UK since 1996. Those dating from 1996 and 1997 show them to be "from" Ice Clothing or Ice Clothing Co Ltd. The remainder, dating from 1998 onwards, are on headed paper where the heading is shown as Ice Clothing or Ice Ice Ice. All show the sale of garments from the opponent company and in relation to a wide range of clothing.

16. Finally, at SC7, Mr Channa exhibits a number of invoices said to relate to the first orders he made for the purchase of labels and swing tickets carrying the mark ICE BABES. The earliest is dated October 2002 with a further order being made on 30 March 2005 following the first sales under the mark ICE BABES which are said to have taken place in September 2003.

Applicant's evidence

17. This takes the form of a witness statement dated 26 May 2008 by Massimo Marani who is the Chief Financial Officer of the applicant company, a position he has held since 1994.

18. Mr Marani confirms that Italian is his mother language but that he has a good understanding of the English language. He confirms that the information he gives comes from his own personal knowledge or the records of his company and that he is authorised by his company to make the statement on its behalf.

19. Mr Marani states that the applicant produces and sells clothing and accessories under a range of marks. It first started using the mark ICEBERG in relation to these goods in the UK in 1982. At least as early as 1992 it started using the mark SPORT ICE and, in 1998, it started to use the mark ICE JEANS. He explains that the mark ICE JEANS replaced the use of the mark SPORT ICE though for an (unspecified) period the use of these two marks overlapped. Whilst he gives no specific indication of when use of the mark SPORT ICE ceased, the latest dated material I have been able to identify of use of the mark SPORT ICE is at exhibit MM2 (invoice dated

17.3.97). Mr Marani also provides details of turnover in relation to use of the mark SPORT ICE. He states that total turnover in the UK between 1992 and 1997 amounted to some 4million Lira and that this equates to some €206500 approximately. Sales in the three month period July to September 1992 are said to amount to £40,823 in relation to the SPORT ICE men's collection, which I note would have equated to approximately a quarter of the total turnover for the period 1992 to 1997.

20. Mr Marani states that the applicant "subsequently expanded its use of marks containing the word ICE". As examples, he refers to ICE ICE ICEBERG, ICE J and ICE B. He gives no further details of any use of these later marks.

21. Attached to Mr Marani's witness statement are a number of exhibits:

- MM1: Copy of a witness statement of Mr Silvano Gerani & exhibits
- MM2: Copies of sample invoices for sales of SPORT ICE goods to retailers in the UK with dates ranging from July 1992 to March 1997
- MM3: Extracts of agreements (in Italian with informal translations into English) appointing agents within the UK in relation to sales under the mark SPORT ICE
- MM4: Faxed exchanges between the applicant company and its agent
- MM5: Copies of photographs and drawings of goods sold in the UK under the mark SPORT ICE
- MM6: Copies of photographs of SPORT ICE labels and swing tags
- MM7: Copies of invitations sent to UK customers advising them of the Pitti fashion shows taking place in Florence in 1994, 1995 and 1996
- MM8: Name and address details of UK recipients of the invitation to the 1993 Pitti show
- MM9: Copies of photographs from a Pitti fashion show.

22. As I indicated above, exhibit MM1 to Mr Marani's witness statement consists of a copy of a witness statement of Mr Silvano Gerani. It is dated 5 September 2005. Mr Marani explains that the original of this material was filed by Mr Gerani in relation to other opposition proceedings involving his company (Opposition 93015 by Gilmar SpA to application No. 2358107 for the mark PINK ICE in the name of Lacharité Apparels (1989) Inc.). Mr Marani states that he confirms the statements of Mr Gerani.

23. Mr Gerani is the president of the applicant company, a position he has held since 1980. He states that the applicant first started using the mark ICEBERG in relation to clothing within the UK in 1982 and that the mark is "currently" used in relation to a range of clothing and accessories. Mr Gerani states the applicant has also used the marks ICE JEANS and ICE ICE ICEBERG

24. Mr Gerani gives the following details of combined turnover and advertising spend for goods sold in the UK under the marks ICEBERG and ICE ICE ICEBERG.

ICEBERG and ICE ICE ICEBERG	1998 € (000)	1999 € (000)	2000 € (000)	2001 € (000)	2002 € (000)	2003 € (000)	2004 € (000)
Wear	1,114	1,552	1,626	1,286	1,662	1,586	1,647
Accessories	43	46	72	116	124	124	75
Total	1,157	1,598	1,698	1,402	1,786	1,710	1,722
Marketing	263	105	412	607	352	390	328

25. Figures are also given for 2005, however as these relate to a period after the relevant date I have not included them here. No indication is given as to what proportion of the figures for 2004 relate to a period before the relevant date. In relation to use of the mark ICE JEANS details of turnover and marketing in the UK are given as follows:

ICE JEANS	1998 € (000)	1999 € (000)	2000 € (000)	2001 € (000)	2002 € (000)	2003 € (000)	2004 € (000)
Wear	4137	4569	6788	4042	4382	4588	3943
Accessories	75	74	173	116	99	109	78
Total	4212	4643	6961	4158	4481	4697	4021
Marketing	51	60	226	292	159	79	=

26. My comments at paragraph 25 above apply equally to these figures.

27. Mr Gerani's copy witness statement is accompanied by a substantial number of individual, unpaginated, photocopied pages. As filed, these pages, rather unhelpfully, were not collated in any way but appear to me to make up some fourteen exhibits. It also appears to me that these pages are the result of having been photocopied from previously poorly photocopied pages such that in many instances I am unable to discern what they might have been intended to show.

28. At Exhibit 1 are a total of thirteen invoices, eleven for addresses within England, one for an address in Scotland and one for an address in Jersey. All date from 2003. The trade marks referred to on the invoices are: History Iceberg Uomo, Ice Jeans, Iceberg Uomo and History Iceberg Donna with the majority being referred to as Ice Jeans. The goods supplied under this mark are stated to be jeans, t-shirts, shirts, sweaters, belts, vests, tops, sports jackets, gilets, skirts, sweatshirts, dresses, leather jackets, scarves, leather blousons, coats, shorts, bathing costumes, shoes and pants.

29. Mr Gerani states that ICEBERG, ICE JEANS and ICE ICE ICEBERG goods are distributed throughout the UK. At exhibit 2 is a list of what he describes as distributors but which appear to me to be retailers. These include e.g. Harvey Nichols, Harrods and Selfridges as well as other, what I take to be independent clothes retailers. Exhibit 3 is said to be copies of photographs of examples of products sold under the mark ICEBERG. Most of this material is very poor quality and none of it is dated.

30. At Exhibit 4 are copies of photographs described as showing examples of products sold under the mark ICEBERG combined with other ICE marks. Only one of

the numerous pages making up this exhibit gives any indication of its source and/or date: a copy of a page from FHM magazine dated July 2001 (notated with a date of August 2001). This shows various sandals including a sandal by ICEBERG however, due to the angle from which the original photograph was taken, I am unable to see what is written on the sandal. Again it is impossible to make out much of the detail on many of the pages but others show garments which have the words ICE J, ICE JEANS, ICE JEANS ICEBERG, ICEBERG and ICEBERG ICE on them.

31. Exhibit 5 is said to consist of copies of advertisements for goods sold under the mark ICE ICE ICEBERG. The majority of these are extracts from Vogue magazine from July 2004, after the relevant date in these proceedings. There are copies of pages taken from Junior magazine however I am unable to make out the date of the publication other than it shows a date of "July 20..." The final page making up this exhibit dates from the 25 January 2003 edition of Drapers Record. This refers to the "Pitti Bimbo kidswear exhibition" which took place "last weekend" in Florence. It states that 379 brands were shown at the exhibition and that "debutants included Ice Ice Baby by Iceberg". It also includes a reference that "Gerry Myers, UK agent for the new Ice Ice Baby collection said...."

32. Mr Gerani says that Exhibit 6 shows pictures of tags for ICE ICE ICEBERG but there is no indication as to if or when these tags were used. Exhibit 7 are three pages showing use of ICE ICE ICEBERG and one showing use of ICE but no indication is given of the source or date of this material. At Exhibit 8 are copies of two photographs said by Mr Gerani to be of the "ICE ICE ICEBERG stand taken during the International fashion fair (PITTI) in Florence in [date]." but he has not included the date details. Exhibit 9 shows pictures of boots, sandals and t-shirts bearing the mark ICE ICE ICEBERG but again there is no indication of the source and date of this material.

33. Mr Gerani states that Exhibit 10 consists of copies of sample catalogues used to promote "ICEBERG goods and goods sold under other ICE marks" within the UK. The quality of the copy is extremely poor. There is what I take to be a front cover from an ICE JEANS catalogue though not the date of that catalogue and I note the address on what I take to be the back cover is one in Italy. There are also what I take to be front pages from the ICEBERG catalogue Autumn/Winter 2002, Icejeans Autunno/inverno 03/04, ICE JEANS ICEBERG Spring/Summer 2003, ICEBERG...(indecipherable)...in town stereo!" marked as A/Winter 2000 and ICEBERG The Tour, The Official Tour Programme, marked as A/Winter 2003. The Spring/Summer 2003 ICE JEANS ICEBERG catalogue shows a range of clothing. The final page of the exhibit is the back page of the Autumn/Winter catalogue 2003/2004 and shows a list of boutiques and showrooms across the world, one of which is in London.

34. Exhibit 11 is said to be "examples of billboard advertisements displayed in London together with an example list of locations of those billboards." Again the standard of the copy is so poor that for the most part I am unable to see what they are intended to show. On three of the pictures I can just make out the word ICEBERG, in one case along with other wording that I am unable to make out. Mr Gerani does not explain which billboard advertising was shown at any particular site at any given date.

35. Exhibit 12 consists of copies of advertisements. The majority are for ICEBERG goods and some of the material does not identify its source nor bear a date. There are, however, a number of advertisements from a range of magazines dating from before the relevant date including Vogue, Loaded, i-D, marie-claire and Maxim Fashion and which bear the mark ICE JEANS ICEBERG (where ICEBERG appears in smaller type below the words ICE JEANS).

36. Exhibit 13 consists of more copies of advertisements said to be from a number of magazines including Dazed & Confused, The Face UK, Elle UK, GQ UK, Arena UK and Harpers & Queen UK. Almost half of them date from after the relevant date in these proceedings. Where the magazines are dated before the relevant date, some, curiously, indicate the circulation of the relevant magazines as being nil. No explanation is given to explain this apparent oddity. The vast majority of the remainder of the advertisements show use of the mark ICEBERG though there is a small number of references to Ice Jeans Iceberg, Ice Jeans and Iceberg History on a range of clothing.

37. Lastly, Exhibit 14 is said to be copies of editorial advertising dating from between 2000 and 2003 though the latest date I have identified is in 2002. Yet again, the quality of some parts of this material is very poor and made worse, in some instances, by the fact that where the relevant part has been highlighted previously, the further photocopying has made those parts impossible to see. The vast majority of this material relates to ICEBERG or ICEBERG JEANS though there are isolated references to ICEBERG UOMO, ICE JEANS and ICEBERG HISTORY.

38. Mr Gerani concludes his evidence by stating that the applicant has acquired a strong reputation and goodwill in the marks ICEBERG, ICE JEANS and ICE ICE ICEBERG in the UK and that because of the way the marks are presented, the ICE element of the marks is particularly associated with its goods.

39. No further evidence was filed by either party.

Preliminary Issue

40. Before I go on to consider the substantive issue in these proceedings, there is a preliminary issue relating to the basis of the applicant's defence which I should address. In its Form TM8 and counter-statement the applicant stated:

"The opposition is based on the claim that the opponent has the right to prevent use of the mark applied for on the basis of unregistered trade marks or other signs ICE BABES and ICE. The opponent is put to proof regarding its claims to have used the marks ICE BABES or ICE within the United Kingdom and also in relation to its claim to have the right as a result of use of the mark ICE BABES or ICE, or otherwise, to prevent the applicant's use of its mark in relation to the goods objected to."

41. In his witness statement, Mr Marani gives his evidence then states:

“The above, together with the exhibits to my statement all show that my Company had used ICE Marks in the UK since a date prior to the Opponent and had continued to do so up to the time at which this International registration was applied for”.

42. For his part, Mr Gerani, in his witness statement, states:

“As can be seen from the above, my company has acquired a strong reputation and goodwill in the marks ICEBERG, ICE JEANS and ICE ICE ICEBERG in the U.K. Because of the way the marks are presented, the ICE element of the marks is particularly associated with my Company’s goods”.

43. In its written submissions the opponent notes that the evidence filed by the applicant suggests that, despite the limited wording of the Form TM8 and counter-statement, the applicant has an intention to assert it owns rights in the mark ICE through its use of various other marks. The opponent indicates that the applicant should not be allowed to rely on these assertions as this did not form part of its pleaded case.

44. The Form TM8 filed by the applicant cannot in any way be said to be a detailed statement of defence and neither did it contain any admissions. It may be that the applicant could and should have been more detailed and specific in pleading its case and certainly evidence is not the proper vehicle for setting out one’s claims. That said, the opponent made no objections to the claims made in the evidence either when it was filed or prior to the filing of its own written submissions. The opponent has not sought a hearing and the written submissions it has filed deal with the claims made by the applicant. Whilst it is a fundamental principle that the basis of any claims should be clearly set out in the pleadings as the purpose of the pleadings is to allow a party to know the case against them, in all the circumstances, and given the content of the opponent’s written submissions, it does not seem to me that allowing the applicant to rely on its claim as raised in its evidence would lead to the opponent suffering any real prejudice in this case that could not be compensated for by an award of costs, if necessary. I proceed on that basis.

Decision

45. The opposition is based on a single ground founded on Section 5(4)(a) of the Act. This reads:

“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 the Act as the proprietor of an “earlier right” in relation to the trade mark.”

46. The requirements for a passing off action have been restated many times and can be found in the decision of Geoffrey Hobbs QC sitting as the Appointed Person in *Wild Child Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponent's goods 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.

47. Clearly there is an evidential burden on an opponent who relies on a passing off claim. The opponent also has to establish the claim at the relevant date. The Act does not set out the relevant date at which the matter must be judged. Article 4.4(b) of First Council Directive 89/104, however, makes the position clear:

(b) rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent mark;"

48. In the event that an applicant is not shown to have used his mark in advance of the filing date of his trade mark application, the relevant date will be the filing date. As I indicated in paragraph 1 of this decision, the application was filed on 27 May 2004 and is based on an Italian registration with a priority date of 5 May 2004. Section 35 of the Act states:

“35.-(1) A person who has duly filed an application for protection of a trade mark in a Convention country (a “Convention application”), or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the first such application.

(2) If the application for registration under this Act is made within that six month period-

- (a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application, and
- (b) the registrability of the trade mark shall not be affected by any use of the mark in the United Kingdom in the period between that date and the date of the application under this Act.

(3) Any filing which in a Convention country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.”

49. I therefore take the filing date of the application to be the priority date afforded by the Italian registration i.e. 5 May 2004.

50. Despite Mr Marani’s claim in his witness statement that the mark in suit has been used, (paragraph 4), he has provided no details of any such use and I have been unable to locate any such use within the evidence filed. On the basis of the evidence before me I am unable to find there has been any evidence of any use of the mark applied for, ICE B. That being the case I take the relevant date in these proceedings to be the priority date of the Italian registration on which the application is based i.e. 5 May 2004.

Applicant’s evidence of use

51. The applicant claims to have used “a range of marks which include the word ICE”. Mr Marani refers to the use of ICEBERG, ICE JEANS, SPORT ICE, ICE ICE ICEBERG, ICE J and ICE B though he states his evidence “concentrates” on ICE JEANS and SPORT ICE. For his part, Mr Gerani states his company uses a range of marks which contain “the word ICE, in conjunction with the word ICEBERG.”

52. As I indicated above, the quality of much of the evidence exhibited by the applicant is poor. Where I am able to make out what the material shows, the vast majority of it is either undated or does not give any indication of its source. I can only work with what is before me and, making the best I can of it, the following facts emerge.

53. I have already found that the evidence does not establish any use of the mark applied for, ICE B. Whilst amongst the invoices which have been filed there are isolated references to other marks such as HISTORY ICEBERG UOMO and HISTORY ICEBERG DONNA and amongst the advertising material there are, again isolated, generally undated references to ICE J, ICE ICE BABY BY ICEBERG and ICEBERG HISTORY, no other information is provided to establish the duration and extent of use of these marks. The evidence does not therefore show there was any protectable goodwill by reference to any of these marks at the relevant date.

54. The mark ICEBERG is said to have been used for the first time in 1982. Advertising material shows use of the mark ICEBERG though most of it is undated. The earliest dated evidence of use of the mark ICEBERG which I have been able to identify is the Autumn/Winter 2000 catalogue (exhibit 10). I have no evidence of any distribution of this catalogue. There is also evidence of use of the mark ICE ICE ICEBERG though there is no evidence is given of when use of this mark began. The earliest dated evidence of use I have been able to identify is an advertisement in Vogue UK from July 2004 (Exhibit 5), i.e. after the relevant date in these proceedings. Composite turnover for the two marks from 1998 onwards have been given. This ranges from €1.1m to €1.6m with advertising costs ranging from €105,000 to €607,000. This suggests that both ICEBERG and ICE ICE ICEBERG were in use in 1998. My strong impression is that ICEBERG has functioned as the

core brand and provides a thematic link for the applicant's branding as a whole. Given that the turnover figures referred to above represent aggregated figures for ICEBERG and ICE ICE ICEBERG, it is not possible to say what levels of consumer awareness exist in relation to the individual brands. In light of the fact that the evidence shows ICEBERG to be an almost constant feature of the applicant's branding, it is, I think, reasonable to suppose that an independent goodwill exists in this sign, reinforced by whatever use has been made of ICE ICE ICEBERG.

55. Use of the mark SPORT ICE is said to have begun in 1992 but ceased sometime later. Total turnover under the mark is said to have been equivalent to approximately €206,500 with around a quarter of this figure being in relation to goods sold between July and September 1992. Given the size of the clothing market this does not appear to be a significant sum and, as far as I am able to ascertain from the evidence, use of this mark appears to have ceased in 1997. There is no evidence of any residual goodwill in the mark.

56. Whilst there is no evidence of when the use of the mark ICE JEANS commenced, its use is said to have replaced, and overlapped with, use of the mark SPORT ICE. The advertising material exhibited (the earliest dateable material I have found is from 2003) shows some use of the mark ICE JEANS but there is a greater number of references to ICE JEANS ICEBERG, ICE JEANS by ICEBERG or ICEBERG ICE JEANS. This is consistent with Mr Gerani's statement that his company uses a range of marks which "contain the word ICE, in conjunction with the word ICEBERG".

57. What is not clear from the information in the form in which it is presented is whether the turnover figures Mr Gerani provides (see paragraph 25 above) represents use of ICE JEANS solus or that sign in association with the ICEBERG housemark. His introductory remarks suggest the latter. The supporting exhibits, however, indicate that there has been some independent use of the sign. Exhibit 4, for example, shows use of both but the sources and dates of the photographs are not given and I note that there is a document with Italian text towards the end of the exhibit.

58. The applicant has shown it presents its brands in a variety of ways. Although much of the use is of ICE JEANS in association with the housemark, the nature of that use, taken together with some independent use of ICE JEANS is likely to mean that there is some recognition of that sign independently of the housemark.

59. The evidence shows that the sign has not been restricted to use in relation to "jeans" but has been used in relation to a range of clothing. Exhibit 1, for example, shows it to be used in relation to, *inter alia*, shirts, t-shirts, sweaters, jackets, dresses and jeans.

Opponent's evidence of use

60. The opponent bases its opposition on the two marks ICE and ICE BABES.

61. The first sales under the mark ICE are said to have taken place on 16 November 1996. Sample invoices show sales of a wide range of clothing under the mark. Sales

are said to have been made either direct to customers throughout the UK, mostly to independent clothes shops but also to wholesalers or through the opponent's showroom in London.

62. In its written submissions the applicant comments that as the earlier invoices refer to ICE CLOTHING this cannot be taken to be use at that time of ICE alone. The goods to which the invoices relate are articles of clothing. It seems to me therefore that the reference to clothing on these invoices is "wholly and specifically descriptive" (c.f. Jacob LJ's example "If the added words had been wholly and specifically descriptive—really adding nothing at all (e.g. "Palmolive Soap" compared with "Palmolive") the position might have been different. But "Business Information" is not so descriptive—it is too general for that." *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40).

63. Photographs of garments bearing the mark ICE on sewn-in labels and swing tags have been submitted. Turnover under the mark ranges from some £134,000 in its first (part) year of sale to some £1.3 million in the years ending September 2000 and 2001. Sales under the mark ICE continued and figures for later years are provided though only as a composite with sales of clothing under other marks. I am satisfied that the opponent has shown itself to have had goodwill at the relevant date under the mark ICE in relation to outerclothing.

64. The first sales of clothing under the mark ICE BABES are said to have taken place in September 2003. There are photographs of clothing bearing swing tags and labels with the words ICE BABES on them. Whilst evidence is provided of invoices relating to the purchase of labels bearing this mark, the composite turnover figures provided do not enable me to establish the volume of any sales made under the mark. On the basis of the evidence filed, I am unable to be satisfied the opponent had goodwill under the mark ICE BABES at the relevant date.

"Clean hands" argument

65. At this point, there is a further issue I should address. The applicant argues that the opposition should be rejected as the opponent has not come to this passing off action with "clean hands". It says this because it claims, essentially, that at the date the opponent began to use its marks, the applicant had already accrued rights in the mark ICE because of the commonality of that word within its own marks which would have prevented the opponents from using the word as a mark itself.

66. As the applicant has not shown it has used the mark applied for prior to the filing date, this claim must be taken to be based on the marks ICEBERG and SPORT ICE, these being the only marks which it had used at the time the opponent commenced use of ICE. The issue as to whether the applicant would have been entitled to restrain the opponent's use at that time based on the applicant's rights in the business conducted under these signs, is a matter that is beyond the scope of this action. In any case, a person who had the right to object at the date of commencement may have lost that right because concurrent use has resulted in the other party establishing its own independent right. In *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42, Mr Justice Pumfrey quoted Oliver L J in *Budweiser* [1984] FSR 413 where he said:

“I should just add that there must come a time after which the court would not interfere with a continued course of trading which might have involved passing off at its inception but no longer did so: logically, this point would come six years after it could safely be said that there was no deception and independent goodwill had been established in the market by the protagonists. There must also be doubt as to the availability of injunctive relief if there is no passing-off at the date the action is commenced.”

67. I therefore reject the applicant’s argument that the opposition should be dismissed on the basis the opponent does not have “clean hands”.

The rival claims

68. The position is, therefore, that by the relevant date the opponent had established goodwill in a business conducted under the sign ICE. I note also that the opponent sometimes uses its mark in repeated form (see e.g. use of ICE ICE ICE in exhibit SC1 and ICE ICE in exhibit SC4). The applicant, for its part, had longstanding use of ICEBERG, use of that mark with other elements to form ICE ICE ICEBERG and ICE JEANS ICEBERG/ICEBERG ICE JEANS and some standalone use of ICE JEANS.

69. Given this state of affairs, it is perhaps somewhat surprising that conflict between the parties has not surfaced earlier. That may be due to the large size and fragmented nature of the clothing market, the relatively modest size of the parties within that market and the particular retail niches they occupy. The application to register ICE B is, of course, without restriction as to geographical coverage and is not constrained to the applicant’s past trading patterns and sales outlets. It represents, therefore, an extension of the applicant’s business into the “unclaimed middle ground”.

70. In relation to clothing, ICE is a very strong mark with no direct or allusive meaning in relation to the goods in issue. If the matter rested simply on a comparison of ICE and ICE B, I would have little hesitation in concluding that the latter would be regarded as a subbrand or development of the basic ICE mark. On that basis, a misrepresentation leading to damage would have been made out. The issue that I need to address here is whether a different conclusion should be reached in the circumstances of this case where the applicant can point to use of other “ICE” marks

71. One of the most recent cases dealing with a proposed extension of trade in circumstances where both sides already had an established presence in the relevant mark (under signs that incorporated a common element) is *Sir Robert McAlpine Ltd v Alfred McAlpine PLC*, [2004] RPC 36. The two parties had common origins and an overlapping trade in the construction and civil engineering field. The name McAlpine was valuable to both parties, with their businesses having been differentiated by the use of the respective forenames. The passing off action was triggered by the defendant’s wish to re-brand itself by dropping, or significantly reducing the impact of, the name Alfred. In finding passing off to be made out, Mr Justice Mann held that:

“36. Accordingly there is, and will be, a situation in which “McAlpine” features almost exclusively in the trading persona of Alfred. Does this amount to a misrepresentation for the purposes of the law of passing off? In relation to relevant activities, it seems to me that it does. I have already found that the word is capable of referring to Robert, so using the word will inevitably amount to a misrepresentation because the business being referred to is not, in fact, that of Robert. I accept Mr Wyand’s submission that the use of the word, in a market which understands the word to refer to Robert even if it is capable of referring to Alfred, is a statement that the user is the entity known as Mc Alpine, and as such is a misrepresentation. Since the use of that word lies at the heart of the present corporate presentation and image, the misrepresentation is made out. This is supported by the evidence from the witnesses as to what McAlpine would be taken to mean, and the two companies themselves recognised the dangers of this in the correspondence in the mid-1980s that I have referred to above.”

72. This was a case involving what amounted to shared goodwill in the name McAlpine in circumstances where both parties would have had a cause of action against third parties based on use of the name. But it was held that the defendant was not entitled to trade under that name without the addition of some other distinguishing feature. I acknowledge that the facts of the case before me are somewhat different but the principle remains the same. In my view, if the applicant is allowed to register ICE B it will have encroached into the middle ground and misrepresented itself as being associated with the opponent.

73. The high point of the applicant’s case against this view of the matter is the fact that it has already traded under the sign ICE JEANS. Although the word JEANS has descriptive connotations, the picture that emerges from the evidence is that it is used on a variety of goods (see paragraph 59 above) and that even when used on trousers, the word is not always used in a more literal sense to indicate a product made from denim. In other words, JEANS is an integral part of the branding (again, see Jacob LJ’s observations in *Reed supra*) even though it lacks the distinctiveness of the word ICE. In the circumstances, I do not regard use of this mark as providing a basis for finding that the applicant is entitled to register ICE B. They are different marks.

74. I conclude that it is likely that confusion or deception would arise from the use by the applicant of the mark ICE B, as the consumer would be likely to believe that ICE B was a sub-brand of ICE. The confusion would divert trade from the opponent, potentially injure the opponent’s reputation if there were any failings in the goods of the applicant and would cause the injury which is likely inherently to be suffered by any business when, on frequent occasions, it is confused by customers, or potential customers, with a business owned by another proprietor or is wrongly regarded as being connected with that business (*See Habib Bank Limited v Habib Bank Zurich* [1982] RPC 1).

75. The opposition based on section 5(4)(a) therefore succeeds and the application is to be refused in relation to the goods on which the opposition has been brought. The application therefore stands refused in respect of the specification of goods in

class 25 but may proceed in respect of the goods for which protection is sought in class 18.

Costs

76. The opponent, having been successful, is entitled to a contribution towards its costs. I order Gilmar SpA to pay Ice Clothing Co Ltd the sum of £2000. This figure includes an additional sum for the preparation of written submissions to reflect the additional work that would have needed to be done in relation to the lack of particularisation of the applicant's true basis of its claim as filed in its counter-statement. 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 12 day of January 2009

**Ann Corbett
For the Registrar
The Comptroller-General**