

O-292-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS 2447390 AND 2447943
BY ICE ROCKS LTD TO REGISTER THE TRADE MARKS**

“ICErocks”

IN CLASSES 9, 14, 18, 25 AND 43

AND



IN CLASSES 3, 9, 14, 16, 18, 25 AND 35

**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER NOS 95373 AND 95438
BY GILMAR S.P.A.**

TRADE MARKS ACT 1994

IN THE MATTER OF application nos. 2447390 and 2447943

by Ice Rocks Ltd to register the trade marks:

“ICErocks” in classes 9, 14, 18, 25 and 43

and



in classes 3, 9, 14, 16, 18, 25 and 35

and

IN THE MATTER OF consolidated oppositions thereto under nos. 95373 and 95438

by Gilmar S.p.A.

BACKGROUND

1) On 21 February 2007, Ice Rocks Ltd (“IRL”), of 290a Green Lane, London, N13 5TW applied under the Trade Marks Act 1994 (“the Act”) for registration of the trade mark “ICErocks” (Application no. 2447390) in respect of the following goods and services:

Class 09: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, data processing equipment and computers; fire-extinguishing apparatus; computer hardware and firmware; computer software (including software downloadable from the internet); compact discs; digital music (downloadable from the Internet); telecommunications apparatus; computer games equipment adapted for use with TV receivers; mouse mats; mobile phone accessories; contact lenses, spectacles and sunglasses; clothing for protection against accident, irradiation or fire.

Class 14: Precious metals and their alloys; jewellery, precious stones; horological and chronometric instruments; clocks and watches; costume jewellery.

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; handbags, rucksacks, purses; clothing for animals.

Class 25: *Clothing, footwear, headgear.*

Class 43: *Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking/reservation services for restaurants and holiday accommodation.*

2) On 28 February 2007, IRL also applied for registration of the following trade mark (Application no. 2447943):



3) This application was in respect of the following goods and services:

Class 03: *Perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants.*

Class 09: *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, data processing equipment and computers; fire-extinguishing apparatus; computer hardware and firmware; computer software (including software downloadable from the Internet); compact discs; digital music (downloadable from the Internet); telecommunications apparatus; computer games equipment adapted for use with TV receivers; mouse mats; mobile phone accessories; contact lenses, spectacles and sunglasses; clothing for protection against accident, irradiation or fire.*

Class 14: *Jewellery, precious stones; horological and chronometric instruments; clocks and watches; costume jewellery.*

Class 16: *Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type;*

printing blocks; disposable nappies of paper for babies; printed publications.

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; handbags, rucksacks, purses; clothing for animals.

Class 25: Clothing, footwear, headgear.



Class 35: Advertising; business management; business administration; office functions. Also in this class are the organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information; retail services connected with jewellery, precious stones, horological and chronometric instruments, clocks and watches, costume jewellery.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; compilation, creation and maintenance of a register of domain names.

Class 43: Catering services for providing food and drink; restaurant services, café services, hotel services; temporary accommodation.

4) On 20 July 2007 and 20 August 2007 respectively, Gilmar S.p.A. ("Gilmar") of Via Malpasso 723/725, 47048, Italy filed notice of opposition to both the applications. The grounds of opposition in both cases are summarised as follows, namely:

- a) registration of either of the applications would offend under Section 5(2)(b) of the Act. Gilmar claims that IRL's trade marks are similar to its earlier marks and is for identical or similar goods. Gilmar relies upon the following four earlier marks:

Mark, filing date	Goods and services covered (or goods and services relied upon if narrower)	Goods and services being opposed
1247863 7 August 1985 	Class 18: <i>Articles of luggage, trunks (luggage), travelling bags, purses (not of precious metal or coated therewith); key holders and shoulder belts, all made of leather.</i>	All of the Class 18 and 25 goods
1175324 20 May 1982 	Class 25: <i>Articles of clothing; but not including footwear other than woven or knitted footwear.</i>	All of the Class 18 and 25 goods; all of the Class 14 goods except clocks, horological and chronometric instruments (except watches and other devices designed to be worn); clothing for the protection against accident, irradiation or fire, in Class 9
1386189 30 May 1989 ICEBERG	Class 09: <i>Eye glasses and lenses; spectacles, spectacle glasses and lenses; spectacle frames and parts and fittings therefor; spectacle cases; sunglasses; all included in Class 9.</i>	Contact lenses, spectacles and sunglasses; optical apparatus and instruments; class 18 goods to the extent they are bags or holders for spectacles, contact lenses, sunglasses
CTM4432092 11 May 2005 Pending ICEBERG	Class 35: <i>Advertising; business management; business administration; office functions; organisation of exhibitions for commercial purposes; management of sales outlets; franchising; retailing of cosmetics, perfumery, spectacles, watches, jewellery, furnishing accessories, leatherware, clothing, footwear and headgear</i>	Contact lenses, spectacles and sunglasses; optical apparatus and instruments; all of the goods in classes 14, 18 and 25; clothing for protection against accident, irradiation or fire.

b) Gilmar also claims that it has used the mark “ICE” and other marks containing the word “ICE” in the UK in relation to clothing and fashion accessories, bags and spectacles since 1999. On the basis of this use, Gilmar claims that registration of IRL’s marks would be contrary to Section 5(4) (a) in respect of all of the goods in classes 14, 18 and 25 and in respect of contact lenses, spectacles; optical apparatus and instruments; clothing for protection against accident, irradiation or fire in Class 9.

5) The applicant subsequently filed counterstatements in both sets of proceedings denying the opponent’s claims and requesting that Gilmar provide proof of use in respect of all goods and services it relies upon except jeans, t-shirts and shirts, vests, pullovers, jumpers, outer-coats. The two sets of proceedings were subsequently consolidated.

6) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 2 June 2009 when IRL was represented by Mr Jonathan Hill of Counsel, instructed by DL Legal LLP and Gilmar was represented by Ms Kate Szell of Venner Shipley LLP.

Opponent’s Evidence

7) Gilmar’s evidence is in the form of two witness statements. The first of these is by Sarah Kate Szell, a partner with Venner Shipley LLP, representatives for Gilmar. Prior to this, she was a partner with Lloyd Wise who represented Gilmar in earlier opposition no. 93015 against application 2358107 PINK ICE.

8) At Exhibit SKS1, Ms Szell provides a witness statement and accompanying exhibits by Silvano Gerani, President of Gilmar. Mr Gerani’s statement was prepared and filed in respect of the earlier PINK ICE opposition and detailed the use made of ICEBERG and other ICE marks at that time. This was summarised by the hearing officer at that time. That summary is provided as an annex to this decision and I adopt it insofar as it is relevant to the current proceedings.

9) The second witness statement is by Massimo Marani, Chief Financial Officer of Gilmar since 1994. He states that since Mr Gerani made his statement in September 2005, Gilmar’s range of marks containing the word ICE has expanded to include, not only ICE JEANS and ICE ICE ICEBERG but also ICE ICEBERG, ICE J and ICE B. He states that these marks are sometimes used in combination with the mark ICEBERG and sometimes not. The annual turnover (in Euros) in the UK for goods sold under the various ICE marks is provided at Exhibit SG1 as follows (I have rounded these to the nearest hundred thousand Euros):

	1998	1999	2000	2001	2002	2003	2004	2005	2006	2007
	€000									
ICEBERG										
Wear	1,114	1,552	1,626	1,286	1,662	1,510	1,422	625	268	186
Accessories	43	46	72	116	124	124	75	15	25	19
TOTAL	1,157	1,598	1,698	1,401	1,786	1,634	1,497	641	293	205
ICE Lines										
Wear	4,137	4,569	6,788	4,042	4,832	4,588	3,943	1,440	981	474
Accessories	75	74	173	116	99	109	78	41	78	40
TOTAL	4,212	4,643	6,961	4,158	4,931	4,697	4,021	1,481	1,059	514

10) At Exhibit SG2 , Mr Marani provides copies of sample invoices for sales of ICE J, ICE B and ICE ICEBERG goods to UK based parties. Seventy five of these relate to a period of time before the publication dates (“the relevant dates”) of the two applications and give details of sale of various types of clothing, belts, hats and bags as well as less frequent occurrences of bathing costumes in respect of both the ICE B and ICE J marks. Additionally, these invoices record sales of key rings, bracelets, footwear, wallet and bags both in respect of the ICE B mark only. Two of these invoices, dated 17 February and 23 February 2005 relate to women’s ICEBERG clothing such as vests, skirts, T-shirts, dresses, tops, jackets and jeans.

11) Mr Marani provides a list of UK “distributors and retailers” relating to the period 2004 to 2007. These include such well known retailers as Harrods, Selfridges and Harvey Nichols and the list appears to include traders spread across a wide geographical spread in the UK and Northern Ireland.

12) Mr Marani explains that Exhibits SG4 to SG8 are all photographs illustrating clothing that is representative of the clothing sold throughout the UK. He explains that these photographs relate to items of clothing that belonged to various seasonal collections between 2004 and 2007, however the provenance of these photographs is not obvious. He states that there is a high degree of visibility of the marks on the clothes themselves and that, although not visible, the labels within the clothing all show the relevant marks, for example, ICE J, ICE B, ICE B ICEBERG.

13) At Exhibit SG9, Mr Marani presents examples of articles published in the UK in 2004 in relation to goods sold under the ICE marks and articles published in 2006 in relation to goods sold under the ICE B mark. These are summarised in the table below:

Date	Publication	Goods shown
1 February 2004	Maxim	"ICE JEANS" boots
1 May 2004	Dazed & Confused	Denim jeans by "ICE JEANS BY ICEBERG"
1 May 2004	GQ	Jeans by "ICE JEANS"
1 May 2004	Maxim	Claimed gilet by "ICE JEANS" but mark not visible in reproduction
1 July 2004	Vogue	"ICE ICE ICEBERG" in relation to children's cloths.
1 July 2006	Issue One	Women's cloths, but the mark is not visible
1 November 2006	In Style	Denim jeans by "ICE B ICEBERG"

14) The magazines listed in the above table have average readerships in the range 120,200 to 220,084 according to Mr Marani.

15) At Exhibit SG10, Mr Marani provides examples of advertisements for goods sold under the mark ICEBERG which were published in the "first half of 2007". These are advertisements for women's and men's clothes, however, it is not altogether clear from the exhibits which advert is from which publication. The publications are:

- "Spring/Summer" edition of magazines such as ANOTHER MAGAZINE, ANOTHER MAN and POP
- "Spring" edition of "10" magazine
- Summer/Autumn edition of HOMME magazine
- undated publication named CRASH that has contents listed on its front cover that includes "Collections 2007"
- March and April editions of DAZED & CONFUSED
- "Feb/Mar 07" edition of WONDERLAND
- "Spring/Summer February 2007" edition of POP magazine

16) At Exhibit SG11, similar adverts to those listed above are provided but in this case, relate to the year 2006. The publication DAZED & CONFUSED features again and, additionally, the publications AVANTGARDE (a Dutch edition), ELLE, and INSTYLE are also present.

17) There are also various photographs that illustrate the mark ICEBERG appearing upon, or in the promotion of belts and shoes, but many of these are of unknown provenance. A copy of the ICE B ICEBERG catalogue for the Fall/Winter 2006/07 carries photographs of men's and women's outer clothing. Here ICEBERG appears underneath ICE B in a secondary or subservient way and in a smaller script. Similar catalogues for ICE J ICEBERG dated Spring/Summer 2006 and ICE B ICEBERG are also provided with the former also including photographs of belts, shoes and a baseball hat, however these do not appear to actually carry the mark ICEBERG.

18) Photographs at SG1, Exhibit 4 show items of luggage, but these are undated and no mark is visible. At Exhibit SG5 a photograph of unknown provenance, showing a handbag bearing the mark ICE B appears on a page where the web address "www.iceberg.com" appears in small text at the bottom of the page. A number of photographs, again of unknown provenance, are provided at Exhibit SG4 and SG7. These show handbags featuring the ICE J mark.

19) A number of photographs illustrate belts, such as at Exhibit SG6, where photographs show leather belts with the marks ICE B and ICEBERG appearing on the buckles. All these photographs are without provenance. Various sneaker style shoes bearing the mark ICEBERG are shown in photographs at Exhibit SG8. Once again, these photographs are of unknown provenance. An advertorial featuring a pair of ICEBERG sandals, shown in Exhibit SG1, pre-dates the relevant periods applicable in these current proceedings.

19) In Exhibit 13 of Exhibit SG1, there are a number of magazine advertisements or advertorials featuring ICEBERG sunglasses. By way of illustration, one is a copy of a page from GQ magazine, dated June 2004, featuring fifteen different pairs of sunglasses. One of these is identified as an ICEBERG pair costing £169. Copies of two identical advertisements featuring sunglasses and the mark ICEBERG are also provided at Exhibit SG10. These appeared in magazine publications, but from the order of papers filed it is not clear which publication the first of these appeared in. It is either AnOtherMan or Another Magazine, both dated Spring/Summer 2007. The second advert appeared in Homme magazine, also dated Spring/Summer 2007.

20) Exhibit SG2 also includes an invoice dated 23 February 2005, and lists four bathing costumes. Exhibit SG1, Exhibit 14 also provides a copy of an advertorial featured in Cosmopolitan magazine (July 2002) showing fifteen swimsuits, one of which is identified as being by ICEBERG.

21) At Exhibit SG1, are photographs from a fashion show in Florence featuring a range of children's wear under the mark ICE ICE ICEBERG. These photographs are undated.

Applicant's Evidence

22) This takes the form of a witness statement dated 1 August 2008, by Ismayil (Smile) Mehmet, Director of Ice Rocks Limited. He provides Exhibits IM1/1, IM1/2 and IM1/3 illustrating the mark in use to show that the mark is distinctly different from that of Gilmar. All these exhibits show the stylised form of the mark, the subject of application 2447943, being used in respect of jewellery. The final exhibit is a representation of the same mark and a handwritten note stating "as used on clothing & Class 18-25 items".

23) Exhibit IM1/4 is a copy of a web page from "Thesaurus.com" illustrating that "ice" is a synonym for "gem", "jewel", "jewelry" (sic) and "trinket" and that there were no synonyms for the term "ice rock". Exhibits are also provided to support the contention that, conceptually, ICE ROCK is closer to the trade marks "Snow + Rock" and "Rock + Ice". These exhibits show use of these third party marks.

24) Exhibit IM1/6 is an extract from Dictionary.com showing the entry on that website for the term "iceberg" meaning "a large floating mass of ice" and other similar definitions. Mr Mehmet states that this exhibit illustrates that ICE ROCKS is not a synonym for "iceberg". He also provides evidence of a number of other marks used in respect of clothing. These are in the form of Internet extracts illustrating marks appearing on or to promote various clothing items and include "Rocks of Ice" (Exhibit IM1/10), "Fire and Ice Clothing" (Exhibit IM1/11), "Rock + Ice Clothing" (Exhibit IM1/12), Ice Casual fashions (Exhibit IM 1/13) and "IceHouse 55 Clothing" (Exhibit IM1/14).

25) Mr Mehmet also identifies a number of jewellers using "ice" in their marks, and provides Internet extracts illustrating this. These marks are "White Ice" (Exhibit IM 1/15) and "Fire and Ice Gold Jewellery" (Exhibit IM 1/16). He also identifies six other trade mark applications/registrations in Classes 18 and 25 that feature the word "ice" as part of the mark, namely "Ice Cream", "Ice Cube", Ice Fashions", "Ice Legend", Ice-L" and "Ice-Mountain" and device.

26) Mr Mehmet also includes a number of submissions that I will not comment on here but will refer to, as required, later in the decision.

Opponent's Evidence in reply

27) This takes the form of a further witness statement from Ms Szell, dated 23 January 2009. Ms Szell contends that Mr Mehmet is mistaken in claiming that the various third party marks referred to in his witness statement are "clothing brands". To support this, she provides a number of exhibits. I will not itemise these as they are of limited assistance to me in considering the issues in these proceedings.

28) In response to Mr Mehmet's identification of other trade mark applications/registrations, Ms Szell states that Gilmar has opposed a number of these, or has filed an invalidation action. In respect of the Community trade mark (CTM) application to register ICE CUBE, Ms Szell states that Gilmar was largely successful in its action and a copy of the decision of the OHIM is provided at Exhibit SKS9. Others are International registrations that Ms Szell states (and provides supporting documents) that their base applications have been, at least in part, refused but that WIPO's database has not yet been updated to reflect this.

DECISION

Proof of use

29) The Trade Marks (Proof of Use, etc) Regulations 2004 apply in respect to the Section 5(2) (b) grounds of this case. The provision reads as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

...

(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...”

30) The requirements for “genuine use” have been set out by the European Court of Justice (ECJ) 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.

31) In *Ansul*, the ECJ held as follows:

“35. ... ‘Genuine use’ therefore means actual use of the mark....

36. ‘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...

37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of its enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns...

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant

to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

32) In *La Mer* the ECJ also held:

21. ... it is clear from paragraph [39] of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case by case assessment which it is for the national court to carry out....

...

25. In those circumstances it is not possible to determine *a priori*, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down.

33) Gilmar relies upon four earlier rights, three of which are registered and therefore qualify as earlier marks as defined by Section 6 of the Act. All three have completed registration procedures that predate, by more than five years, the publication of IRL's marks, namely 20 April and 18 May 2007 respectively (the relevant dates) and as such, the proof of use provisions applies to all three marks.

34) The evidence provides numerous instances of ICEBERG being used in normal script, both alone and with other marks such as ICE B and ICE J. There is no use shown in the form as registered in 1247863 and 1175324. In these registrations the word ICEBERG appears inside a simple line drawing of a

“lozenge shape”. It is established case law that to qualify as genuine, use of a mark must be in the form registered or in a form which does not alter the distinctive character of the mark in the form in which it is registered. The leading English authority on the issue is the Court of Appeal decision in *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25. This dealt with genuine use within the context of interpreting Section 46(2) of the Act, but is equally applicable here. More recently, the same issue has been considered by both the Court of First Instance (CFI) and the ECJ. These cases have been reviewed by Richard Arnold QC, sitting as Appointed Person, in *NIRVANA Trade Mark* (BL O/262/06) and *REMUS Trade Mark* (BL O/061/08). He summarised his review in *NIRVANA* (and reiterated it in *REMUS*) in the following way:

“33. The first question is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period....

34. The second question is whether the sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all...”

35) Applying this guidance to the current proceedings, the distinctive character of the registered marks are, overwhelmingly, the word ICEBERG and the difference between these registered marks and the form used is the absence of the lozenge shaped line border and absence of the minimal stylisation of the letters. It is my view that these differences will not alter the distinctive character of the registered marks. The use therefore satisfies the requirements set out in Section 6A(4)(a) of the Act.

36) Next, I must consider the scope of goods that genuine use has been shown. Examples of use in respect of various items of outer-clothing are seen in a variety of magazine adverts, some dated within the relevant five year period, such as the advert that appeared in “Dazed & Confused” magazine of 1 May 2004. Many of these magazine adverts are dated “Spring 2007”. The relevant dates of 20 April and 18 May 2002 clearly fall at least a month after the commencement of “Spring” and as such, I accept that such publications were published before the relevant dates.

37) There are various photographs that illustrate the mark ICEBERG appearing upon or in the promotion of various items of outer clothing for men and women as well as belts and shoes, but as many of these are of unknown provenance they do not support a claim of genuine use in the UK. However, there is a copy of the

ICE B ICEBERG catalogue for the Fall/Winter 2006/07 that carries photographs of men's and women's outer clothing. Here ICEBERG appears underneath ICE B in a secondary or subservient way and in a smaller script. Similar catalogues for ICE J ICEBERG and ICE B ICEBERG dated Spring/Summer 2006 are also provided with the former also including photographs of belts, shoes and a baseball hat. It is not clear from the exhibits if these catalogues are intended to promote the goods on the UK. There is some collaborative evidence in the form of a small number of invoices relating the sale of ICEBERG goods such as vests, skirts, T-shirts, dresses, tops, jackets and jeans. However, the invoices relating to ICE B and ICE J goods make no reference to ICEBERG being used at all, let alone in the subservient way mentioned above. As such, I am unable to conclude that genuine use has been made of ICEBERG in respect of wider goods, namely belts and shoes.

38) The evidence of genuine use in respect of bags is also inconclusive. There is a photograph, of unknown provenance, of a handbag bearing the mark ICE B and the web address "www.iceberg.com" appears in small text at the bottom of the page. Further, there are a number of photographs, again of unknown provenance, of handbags bearing the ICE J mark, but with no reference to ICEBERG. Invoices listing bags are only in respect to the opponent's ICE B mark. There is therefore no clear evidence of ICEBERG being used in the UK in respect of bags. At the hearing, Ms Szell suggested that I should accept that references to "accessories" should be accepted as evidence of use in respect of bags and purses. I am not persuaded by this argument as the term "accessories" is too imprecise and I do not know what proportion, if any, of the use in respect of "accessories" relates to bags and purses, or for that matter any other relevant goods.

39) The evidence contains a number of photograph showing leather belts with the marks ICE B and ICEBERG appearing on the buckles, but as these are of unknown provenance, they do not illustrate use in the UK. Similarly, various sneaker-style shoes bearing mark ICEBERG are shown in photographs, but once again, these are of unknown provenance. An advertorial featuring sandals is provided, but this relates to a time that pre-dates the relevant periods in these proceedings and as such, fails to support a claim of genuine use.

40) The evidence features a number of copies of magazine adverts featuring ICEBERG sunglasses. These relate to UK published magazines and relate to various dates that fall within the relevant periods. There are no collaborative invoices, but as Ms Szell pointed out at the hearing, advertising the products for sale in the UK is use of the mark in such a way as to create a market.

41) At least one invoice within the relevant date range includes a record of the sale of swimsuits. The numbers are very small (four) but in conjunction with advertorial featured in Cosmopolitan magazine in July 2002, I am prepared to accept that there has been some genuine use in respect of these goods.

42) There is some evidence of use of the mark ICE ICE ICEBERG in respect of children's wear. Even if I were to accept that use of ICE ICE ICEBERG was sufficient to support a claim to genuine use of the mark ICEBERG, the evidence does not show use in the UK. The evidence consists of photographs from a fashion show in Florence, but is undated. As such no genuine use has been shown in respect of children's clothing.

43) Taking all of this together, I am satisfied that the use shown has been for a broad spectrum of outer clothing for men and women and also headgear, women's swimwear and sunglasses. Taking account of the case law provided by *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03* and *Animal Trade Mark* [2004] FSR 19, I consider the appropriate specifications for the goods of registrations 1386189, 1247863 and 1175324 respectively, are:

Class 9

Sunglasses

Class 25

Articles of outer clothing; headgear; women's swimwear; jeans, t-shirts and shirts, vests, pullovers, jumpers, outer-coats.

The specific items "jeans, t-shirts and shirts, vests, pullovers, jumpers, outer-coats" listed in the Class 25 specification are those goods where IRL specifically did not request that Gilmar provide proof of use.

44) Of course, Gilmar also relies, in its grounds of opposition, upon its pending CTM no. 4432092 for ICEBERG in respect of "retailing of cosmetics, perfumery, spectacles, watches, jewellery, furnishing accessories, leatherware, clothing, footwear and headgear" in its attack on all of IRL's Class 14, 18 and 25 goods and its "contact lenses, spectacles and sunglasses; optical apparatus and instruments; clothing for protection against accident, irradiation" in Class 9. I bear this in mind, and I will comment upon the significance of this later in the decision but at this stage I will proceed by considering Gilmar's case in respect of the list of goods where it has demonstrated genuine use.

Section 5(2) (b)

45) Section 5(2) (b) 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.”

46) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the 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] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). 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 and Adidas Benelux BV*,

(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*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

Comparison of goods

47) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23:

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

48) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281)

49) Taking account of my finding in respect of genuine use, the goods to be compared are listed below:

	IRL's goods under attack	Gilmar's relevant goods
Class 9	Optical apparatus and instruments; contact lenses, spectacles and sunglasses; clothing for protection against accident, irradiation or fire <i>(both applications)</i>	Sunglasses Articles of outer clothing
Class 14	Precious metals and their alloys; jewellery, precious stones; horological and chronometric instruments (designed to be worn); watches; costume jewellery. <i>(Application 2447390)</i> Jewellery, precious stones; horological and chronometric instruments; clocks and watches; costume jewellery. <i>(Application 2447943)</i>	Articles of outer clothing
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; handbags, rucksacks, purses; clothing for animals. <i>(Both applications)</i>	Articles of outer clothing, headgear; women's swimwear; jeans, t-shirts and shirts, vests, pullovers, jumpers, outer-coats.
Class 25	Clothing, footwear, headgear. <i>(Both applications)</i>	Articles of outer clothing, headgear; women's swimwear; jeans, t-shirts and shirts, vests, pullovers, jumpers, outer-coats.

50) Firstly, I turn to the respective goods in Class 9. Gilmar's "sunglasses" are obviously identical to the "sunglasses" listed in IRL's specification. Sunglasses have the purpose of optically reducing the light reaching the eyes and as such,

like other similar goods such as spectacles and contact lenses, can be rightly described as “optical instruments” or “optical apparatus”. It is well established that goods can be considered identical when those covered by an earlier mark are included in a wider term of a later mark (and vice versa); see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 133/05*. It follows that “optical apparatus and instruments” are also identical to “sunglasses”.

51) In respect of the comparison between “spectacles” and “sunglasses”, both are very similar in nature and method of use. Their intended purpose may not correspond identically, but there can be a clear overlap as spectacles often control the amount of light reaching the eye as well as correcting the focus of the eye. Therefore, whilst not being identical, they are very similar. “Contact lenses” on the other hand, whilst having the same intended purpose as spectacles (and therefore overlap to the same extent with “sunglasses”) are different in nature and method of use. Nevertheless, the trade channels of both “contact lenses” and “sunglasses” can overlap and as such I find that there is a moderately high level of similarity between these goods.

52) When comparing “clothing for protection against accident, irradiation or fire” in Class 9 with “outer clothing” at large in Class 25, it is clear that the respective goods share the same method of use. However, their nature and purpose are different. The latter are used to cover various parts of the human body but the former are used to protect against accident, irradiation or fire and to do so, will be made from specialist protective materials. The manufacturers of these goods are likely to be different because of the specialised nature of the former goods. The relevant public for the respective goods is also different. The same applies for the trade channels where the respective goods can be found. As such, I find that there is only a low degree of similarity between these goods.

53) In respect to Class 14, in light of my finding regarding genuine use, Gilmar must rely upon its claim that similarity exists between its Class 25 goods and “precious metals and their alloys; jewellery, precious stones; horological and chronometric instruments (designed to be worn); watches; costume jewellery”. The high point of this claim (not actually made by Gilmar) would be that such goods would be seen as accessories to outer clothing. I shall restrict my analysis to considering this “high point”.

54) There is no evidence that jewellery, even costume jewellery, watches or any other Class 14 goods are sold in the same establishments as outer-clothing (although I do not rule out the possibility). The purpose of costume jewellery, for example, is similar to outer-clothing insofar that both are worn by or adorn the wearer. But a similarity of purpose at such a general level is insufficient for me to conclude that there is any similarity between these goods. In *Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)*, at paragraph 44, the CFI said that the fact that goods may be sold in the same

commercial establishments (such as department stores and supermarkets) was not particularly significant as a wide variety of different types of goods can be found in such shops, without customers automatically believing they have the same origin. It is also possible that costume jewellery may, on occasion, be chosen by an individual to wear with a specific outfit, this does not mean that these goods will be seen to be so closely connected that they would be seen as indispensable or important for the use of clothing as settled case law suggests: *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06. They would not lead to a consumer automatically believing that the goods had the same origin. Taking all these factors into account, I find that the respective goods are not similar. As I have considered the high point of Gilmar's case in respect to similarity with Class 14 goods and found no similarity with outer clothing, it follows that, in respect to the remaining Class 14 goods, there exists no similarity when compared to Gilmar's Class 25 goods.

55) In respect of the comparison between Gilmar's goods and IRL's Class 18 goods, the only goods relied upon by Gilmar that have survived my analysis of genuine use are "articles of outer clothing, headgear; women's swimwear; jeans, t-shirts and shirts, vests, pullovers, jumpers, outer-coats".

56) In *El Corte Inglés*, the CFI acknowledged that in making a comparison between Class 25 and Class 18 goods, a distinction must be drawn between different types of Class 18 goods. In respect of "leather and imitations of leather, animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery", it found that the distribution channels were different from those used for the distribution of goods in Class 25. In respect of "goods made of leather and imitation leather", which can include the specifically listed terms "handbags" and "purses", it noted that these goods are often sold with goods in Class 25 and found a "slight similarity" between these goods. Further, it recognised that some consumers may perceive a close connection between clothing and certain "leather and imitations of leather goods made of these materials" where such goods are clothing accessories. It concluded that clothing and footwear share a degree of similarity, that is not slight, with the clothing accessories included in "goods made of leather and imitations of leather", "handbags" and "purses". I see no reason to diverge from such an opinion in the current proceedings. I am, therefore, of the view that there is a moderate degree of similarity between these latter Class 18 goods and clothing and footwear in Class 25. In respect of "leather and imitations of leather, animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery", I find there is no similarity with clothing.

57) *El Corte Inglés* did not specifically comment on the similarity between "rucksacks" and "clothing for animals" with Class 25 goods but applying the principles of this judgment, it seems to me that "rucksacks" are not similar to clothing and footwear as they are different in nature, purpose and method of use.

They are also not in competition and there is no evidence of a complementary relationship in the manner described in *Boston Scientific*. The position is slightly different in respect to “clothing for animals” where the nature and purpose and method of use of the respective goods have some similarity, in that they all cover the wearer. However, the trade channels are likely to be different and they are certainly not in competition or complementary to each other. No evidence or submissions have been put forward to the effect that clothing manufacturers commonly produce clothing for animals and as such, I find that if there is any similarity between these goods, then this is on the low side.

58) In respect to Class 25, there is identity between the respective term “headgear”. In respect to “clothing”, I find that the term “clothing” in both of IGL’s applications is identical to Gilmar’s “articles of outer-clothing” as well as its “jeans, t-shirts and shirts, vests, pullovers, jumpers, outer-coats” in line with the guidance provided in *Meric*. Finally, “footwear” listed in IRL’s specification shares a high level of similarity with outer-clothing by virtue of sharing the same intended purpose and method of use, namely wearing the goods to cover a part of the body and protect from the elements.

The average consumer

59) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods and services at issue. In respect to “sunglasses” and “clothing” in Class 25, I found identity and it follows that the consumers of both parties’ goods are identical in respect of these goods. I also believe the average consumer will also be the same in respect of the Class 18 goods that could be described as “clothing accessories” and in respect of “footwear”. I will now go on to consider who these consumers are and what is the nature of the purchasing act involved in accessing the respective goods.



60) Firstly, considering the average consumer of “sunglasses”, these will be that segment of the general public who wish to wear sunglasses for fashion and/or practical reasons, namely to protect eyes from bright sunlight. The purchasing act will to a large extent be driven by style and will involve a reasonable degree of care and attention. In respect to items of clothing as well as those Class 18 goods that could be described as “clothing accessories”, the average consumer is the general public and, as these are consumer items, I would normally expect the average consumer to display a reasonable degree of care and attention during the purchasing process, but not the highest degree of attention.

61) Finally, in respect of those Class 18 goods not considered to be “clothing accessories”, namely “leather and imitations of leather, animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery”, the relevant consumer will, once again, be the general public. In addition, however, “leather and imitations of leather, animal skins,

hides” may also be raw materials for use in manufacture and as such will also have a trade outlet where, by definition, the purchasing act will be more considered. Where the average consumer for these goods is the general public there will be a reliance upon a visual impressions as the goods may often be bought for the purposes of fashion or decoration.

Comparison of marks

62) For ease of reference, the respective marks are:

Opponent’s trade marks	Applicant’s trade marks
<p style="text-align: center;">ICEBERG</p> 	<p style="text-align: center;">ICERocks</p> 

63) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). Beginning with the visual comparison, all the respective marks begin with the word ICE. This is the limit of the similarity as all other components of all the respective marks are different. Gilmar’s marks have the second, conjoined element BERG and the overall impression is that of a single word. IRL’s two marks have a second, conjoined element ROCKS and both give the overall impression of two separate words. Gilmar’s stylised mark also includes a line border in a lozenge shape absent in IRL’s marks. In both of IRL’s marks, there is a contrast between the two words ICE and ROCKS, in the normal typeface version this is achieved by the word ICE being in capitals and the word ROCKS being in lower case. In the stylised form, the two words are different in both shade and typeface with the word ICE being formed by a series of dots. Noting the similarity and the numerous differences, I conclude that the level of visual similarity ranges from moderate (in respect of the normal typeface versions of the respective marks) to only a low level of similarity when comparing the respective stylised marks.

64) From an aural perspective, all the respective marks share the same syllable ICE but differ in that the second syllable is BERG in Gilmar’s marks but ROCKS in IRL’s marks. Taking these similarities and differences into account, I find the respective marks share a low level of aural similarity.

65) In respect of the conceptual comparison, ICEBERG has an ordinary meaning in the minds of the consumer, namely “a large mass of ice floating in the sea”¹. At the hearing, Ms Szell submitted that ICEROCKS has a similar conceptual meaning because it will be understood as meaning a rock of ice, that is, an

¹ The Concise Oxford English Dictionary, www.oxfordreference.com

iceberg. However, no evidence was put forward to support this view. Ms Szell went on to contend that an iceberg is an “ice rock”. My view is that this is not the case. A rock is not made of ice but rather a “hard mineral material of the earth's crust”². As such, there is not an obvious conceptual similarity. Rather, the two words ICE and ROCKS, present in IRL’s marks retain their own meaning and do not naturally combine to give the marks, as a whole, a conceptual meaning. However, as the first word ICE does have some conceptual similarity with ICEBERG, I find that there is some conceptual similarity when viewing the marks as a whole, but that this is very low.

Distinctive character of the earlier trade mark

66) I have to consider whether Gilmar’s marks have a particularly distinctive character either arising from the inherent characteristics of the marks or because of the use made of them. They all consist of, or essentially of, the word ICEBERG. This has a clear meaning in English, as already identified above, but in respect of the relevant goods the word has no connection. As such, the marks enjoy a reasonably high degree of inherent distinctive character.

67) I must also consider the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act. This was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such

² ditto

an important consideration. But all must depend upon the circumstances of each individual case.”

68) Here I must assess the impact of use upon the earlier marks, as registered. The evidence illustrates that ICEBERG has been used in respect of clothing in the main and to a lesser degree on hats. There is also some evidence of use in respect of sunglasses. The scale of this use, in respect of clothing, is declared as being in the region of €1 million to €1.7 million, dropping to €625,000 and €268,000 in the last two relevant years. The turnover in respect to “accessories” is much smaller, being no more than €125,000 and as low as €25,000 in the last relevant year. The scale of use suggested by this level of turnover is small when considered in the context of the clothing and accessories market as a whole. Whilst no evidence is provided regarding the size of this market or Gilmar’s market share, I believe my conclusion is well founded in light of the visibly huge scale of the industry in the UK.

69) In conclusion, I find that the already high level of distinctive character is not enhanced to any significant extent as a result of any use of the marks.

State of the register evidence

70) Mr Mehmet identifies a number of other Community and International trade mark applications/registrations in support of his argument that there are a number of other ICE marks, in the names of third parties, on the trade mark register. In response, Ms Szell submitted counter-arguments. I do not intend to address these further here, other than to refer to the CFI case T-135/04, *GfK AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*:

“68 ..., the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. ...”

71) Similarly, in the current proceedings, proof of the mere existence of other earlier marks containing the word ICE does not progress IRL’s case.

Likelihood of confusion

72) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

73) At the hearing, Ms Szell contended that I should take account of ICEBERG used in conjunction with other ICE marks as part of the global appreciation. Such an approach would appear to take me beyond the mark to mark comparison that Section 5(2) (b) requires. My assessment is based upon notional and fair use of the respective marks and in respect of the relevant goods and not on use of the earlier marks in a form significantly different to that registered or in a form that includes additional marks.

74) In this assessment, I found that the earlier marks have a reasonably high level of inherent distinctive character and that this distinctive character is not enhanced further through use, that there is identity in respect of all outer-clothing and headgear in Class 25 and spectacles in Class 9. Further, there is varying levels of similarity between a number of other goods such as contact lenses and clothing for protection against accident, irradiation or fire and Gilmar's sunglasses and outer-clothing. I also acknowledged that the average consumer is the same for many of these goods. In respect of the marks themselves, I found that they share a moderate to low level of visual similarity, a low level of aural similarity and a very low level of conceptual similarity. In considering these findings and their collective impact upon the likelihood of confusion, I am mindful of the comments of the ECJ, regarding the weight to be given to conceptual differences, in *Claude Ruiz-Picasso et al v OHIM (PICASSO)* C-361/04 P, it commented:

“20. ...where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them...

21. ...such a finding is, in this case, entirely part of the process designed to ascertain the overall impression given by those signs and to make a global assessment of the likelihood of confusion between them”

75) I am also mindful of the comments of the CFI in cases such as *Société provençale d'achat and de gestion (SPAG) SA v OHIM* Case T-57/03 and *React Trade Mark* [2000] RPC 285, where it provides the guidance that, bearing in mind the manner in which clothing goods will normally be purchased, it is the visual impression of the marks that is the most important. This would normally be from a clothes rail, a catalogue or a web-site rather than by oral request. Notwithstanding this, aural and conceptual considerations remain important and should not be ignored completely.

76) Giving due notice to the fact that the purchasing act for the relevant goods may involve a reasonable degree of care and attention, I nevertheless believe the very low level of conceptual similarity is sufficient to overcome any visual or aural similarity arising from the presence of the shared word ICE. Therefore, having consideration for all the relevant factors, I conclude that there is no

likelihood of confusion in respect of any of the relevant goods. The similarities identified would not lead the relevant public into believing that the respective goods originate from the same or economically linked undertaking and, as such, there is no direct or indirect confusion.

77) I have a few additional comments. Firstly, even if Gilmar had demonstrated genuine use for the full range of goods claimed, it would not have had an impact upon my findings regarding likelihood of confusion. Secondly, whilst I accept that reliance upon its pending CTM would provide Gilmar with a case for finding similarity with a wider range of IRL's goods, such a finding would also not have had an impact on my findings on likelihood of confusion. For this reason, I have not considered the case based upon the pending CTM in more detail.

78) In conclusion, both of Gilmar's oppositions based upon its Section 5(2) (b) grounds are unsuccessful in their entirety.

Section 5(4)(a)

79) I will go on to consider the grounds under Section 5(4) (a) first. 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”.

80) 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.

81) To the above I add the comments of Pumfrey J (as he then was) 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."

82) The relevant date for determining the opponent's claim will be the filing date of the applications in suit, that is to say 21 February and 28 February 2007, respectively. The earlier right must have been acquired prior to that date (Article 4.4(b) of First Council Directive 89/104 on which the UK Act is based).

83) I must first assess if the opponent has acquired any goodwill and if so, what is the extent of this goodwill at the relevant date. Taking the evidence as a whole, it is not difficult for me to conclude that Gilmar has acquired goodwill in the UK through its use of ICEBERG in respect outer-clothing. The evidence does not illustrate that this goodwill has extended to other goods. Earlier, I found that there was genuine use in respect of sunglasses, but the evidence does not provide any indication of the scale of use and as such, I am unable to conclude that there has been sufficient use to establish goodwill and a reputation. I also reach the same conclusion in respect of swimwear. In summary, I find that Gilmar enjoys goodwill through its use of ICEBERG, but only in respect of outer-clothing.

84) The evidence also illustrates use in respect of ICE B with relevant invoices and catalogues showing various items of outer-clothing, belts, bathing costumes, key rings, bracelets, footwear, hats, scarves, wallet and bags. The same batch of invoices also illustrate use of ICE J in respect of outer-clothing, belts, bathing costumes, hats, scarves. The evidence is presented in such a way that it is not possible to identify turnover in respect of these separate marks, but a combined figure for “wear” for all “ICE” marks is given, ranging between €4.9 million and €0.9 million a year. It is therefore possible that all, or a very significant proportion of this turnover relates to only one of these “ICE” marks. It is claimed by Mr Marani that many of the collaborative photographs provided in the evidence are from a number of catalogues of seasonal collections, but this is not clear from the photographs themselves. However, when taken in the context of the sales illustrated by the many invoices and the list of UK retailers, I conclude that Gilmar also enjoys goodwill in the UK, through use of ICE B and ICE J in respect of outer clothing and hats.

85) There are two magazine advertorials illustrating use of ICE JEANS in respect of a pair of boots and a pair of jeans. This compliments the evidence provided in respect of the PINK ICE proceedings and which has been adopted into these proceedings. I am content that these exhibits demonstrate goodwill through use of ICE JEANS in respect of clothing and footwear.

86) Finally, the evidence, in the form of photographs and text that appeared in Vogue magazine in 2004, regarding children’s outer-clothing in respect of the mark ICE ICE ICEBERG is insufficient to demonstrate that any goodwill has been developed in respect of such goods. Taken in conjunction with the earlier “PINK ICE evidence”, I accept that Gilmar enjoys goodwill through use of this mark also, in respect of children’s outer clothing.

87) Whilst stopping short of claiming that Gilmar have a family of ICE marks, at the hearing Ms Szell contended that as Gilmar has goodwill in a range of ICE marks and that another ICE mark such as ICE ROCKS coming onto the market is very likely to cause confusion. I am unconvinced by this argument. All of Gilmar’s marks have been born out of use of its earlier marks ICEBERG and ICE JEANS, so that ICE B may be seen as a reference to ICEBERG and ICE J may be seen as a reference to ICE JEANS. The link with ICEBERG is highlighted in much of the evidence with the mark often appearing in smaller script beneath the marks ICE J and ICE B. As such, I do not believe that a pattern of use has been demonstrated that would lead the consumer to think that Gilmar was responsible for the goods of IRL. As such, the issue reduces to merely a mark to mark comparison. The position in respect to ICEBERG is no different to that in respect to Section 5(2) (b) of the Act. As such, I find there is no confusion or deception in respect of these marks.

88) I must also consider if there is any confusion or deception in respect to Gilmar’s ICE J, ICE B and ICE JEANS marks. Firstly, considering the marks ICE

J and ICE B, they both consist of the word ICE and a single letter. Both are visually distinct of IRL's ICE ROCKS marks. ICE J and ICE B consist of four letters whereas IRL's mark consists of eight letters. Aurally, the difference in the second element in the respective marks results in a significant aural difference. Finally, conceptually there is only a slight similarity resulting from the shared word ICE, but in the case of ICE B and ICE J the letters B and J respectively have no conceptual identity. This results in the marks as a whole not having any conceptual identity. ICE ROCKS on the other hand, consists of two words both with clear conceptual meanings and whilst there is no clear relationship between these two concepts, it does have an allusive quality that is not shared by the earlier marks. Taking all these points together, I conclude that there is no confusion or deception in respect of these marks.

89) Finally, I will consider the existence of confusion or deception in respect of ICE JEANS and ICE ROCKS. Again, they both share the first word ICE giving a degree of visual and aural similarity, but this is the extent of similarity as the second element in both marks are different creating significant aural and visual differences. From a conceptual perspective, in Gilmar's mark, the word ICE qualifies the word JEANS whereas in IRL's mark the word ICE qualifies the word ROCKS. In both cases, there are abstract or allusive meanings that are totally unrelated to each other. Considering all these points, I find that there is no confusion or deception in respect of these marks.

90) Of course, one of IRL's marks is in a stylised form which puts further distance between it and Gilmar's marks.

91) In conclusion, I find that there is no material misrepresentation leading to damage of Gilmar's goodwill. Use of ICE ROCKS by IRL will not result in trade being diverted from Gilamar to itself, in damage to its reputation in the case of any failings in IRL's goods, or in it being wrongly regarded by the relevant consumer that the two companies are connected.

92) Therefore, the grounds for opposition based upon Section 5(4) (a) of the Act fail in their entirety.

COSTS

93) The opposition having failed, IRL is entitled to a contribution towards its costs. I award costs on the following basis:

Considering Notice of Opposition and statement	£200
Statement of case in reply	£300
Preparing and filing evidence	£600
Considering evidence	£300
Preparation for, and attendance at hearing	£750

TOTAL

£2150

94) I order Gilmar S.P.A. to pay Ice Rocks Ltd the sum of £2150. 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 23rd day of September 2009

**Mark Bryant
For the Registrar,
the Comptroller-General**

EVIDENCE OF GILMAR

7) This consists of a witness statement by Silvano Gerani. Mr Gerani is the president of Gilmar, a position that he has held since 1980. The majority of the exhibited evidence shows use of the trade mark ICEBERG. There does not seem to have been use in the lozenge form of the trade mark registration. However, there has been considerable use of ICEBERG in standard font. The exhibits show use of ICEBERG in relation to outer clothing for men and women as well as for headgear and footwear. There is much use shown of ICEBERG in various magazines. Mr Gerani gives the following turnover figures for goods sold under the ICEBERG trade mark in the United Kingdom:

	1998	1999	2000	2001	2002	2003	2004
	€000	€000	€000	€000	€000	€000	€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 expenditure for the years 1998 to 2004 was €105,000, €112,000, €107,000, €52,000, €90,000 and €28,000 respectively. Mr Gerani states that Gilmar has used the trade marks ICE JEANS and ICE ICE ICEBERG. He states that the annual turnover in the United Kingdom in relation to goods bearing the trade mark ICE JEANS is as follows:

	1998	1999	2000	2001	2002	2003	2004
	€000	€000	€000	€000	€000	€000	€000
Wear	4,137	4,569	6,788	4,042	4,382	4,588	3,943
Accessories	75	74	173	116	99	109	78
Total	4,212	4,643	6,961	4,158	4,481	4,697	4,021

Marketing expenditure for the years 1998 to 2003 was €1,000, €60,000, €26,000, €92,000, €159,000 and €79,000 respectively. At exhibit 1 are various invoices; nine of these emanate from prior to 26 September 2003 and are for the United Kingdom (another invoice relates to Jersey). There are twelve United Kingdom invoices in all. The trade marks referred to upon the invoices are: Ice Jeans, Iceberg Uomo, History Iceberg Donna and History Iceberg Donna. The majority of the goods on the invoices are described as Ice Jeans; the goods so described are: jeans, t-shirts, shirts, sweaters, belts, knitted vests, sports jackets, skirts, sweatshirts, dresses, leather jackets, scarves, leather blousons, coats and pants.

8) Mr Gerani states that ICEBERG, ICE JEANS and ICE ICE ICEBERG goods are distributed throughout the United Kingdom. At exhibit 2 is a list of what Mr Gerani describes as distributors. The names would appear to indicate that the undertakings are retailers rather than distributors in the sense of wholesalers/importers eg Harvey Nichols, Moss Bros, Harrods and Selfridges.

9) Mr Gerani describes exhibit 4 as showing copies of photographs of examples of products sold under the trade mark ICEBERG combined with other ICE trade marks. The photographs

show use of Ice J, ICE JEANS, ICEJ, ICE jeans, Ice Jeans, ice j, icejeans. The majority of the use of these signs is for tops or various kinds, although there is also use for jeans, a purse, belts, a scarf and a key fob. Items of luggage are also, shown but the quality of the copy does not allow for identification of the trade mark. There is no provenance, with one exception, for the photographs. The writing opposite one picture of luggage is in Italian. The exception is a copy of a page from "FHM" for August 2001; it shows various sandals, including sandals by ICEBERG. From the angle of the picture it is not possible to see what is actually written upon the sandal. Mr Gerani states that exhibit 5 shows advertisements for goods sold under the trade mark ICE ICE ICEBERG. There are seven clippings from 'Vogue' from 1 July 2004. As these emanate from after the international priority date they are not pertinent to the use of Ice Ice Iceberg in relation to this case. There are copies of pages from 'Junior' magazine. However, from the quality of the copy it is only possible to read that it emanates from July 20--. The only material clearly emanating from prior to the international priority date is a copy of an article from 'Drapers Record' of 25 January 2003 about the Pitti Bimbo kidswear exhibition in Florence. It states that 379 brands were shown at the exhibition. The article includes the following:

"Debutants included Ice Ice Baby by Iceberg and the new Joop collection.

Gerry Myers, UK agent for the new Ice Ice Baby collection, said:.....

A further article from what might be the same edition of 'Drapers Record', comments on key trends at Kids' Fashion, Brussels and Pitti Bimbo, Florence. The following appears in the article:

"**Iceberg's** new **Ice Ice Baby** kids' range included padded ski outfits, *faux* shearlings and parkas."

Exhibit 6 shows pictures of tags showing ICE ICE and ICE ICE ICEBERG. There is no indication as to from when the tags emanate. Exhibit 7 has several pictures showing use of ICE ICE ICEBERG and one showing use of ICE; again there is no indication of their provenance. Exhibit 8 shows a photograph of the ICE ICE ICEBERG stand at Pitti in Florence. Mr Gerani omits to state when the picture was taken. Exhibit 9 shows pictures of footwear and tops bearing ICE ICE ICEBERG, again there is no indication of provenance. (I note that one top bears the Castellano wording "su nombre aqui" (sic) (your/his/her name here). Mr Gerani states that exhibit 10 consists of sample catalogues to promote ICEBERG goods which are sold under the ICE trade marks in the United Kingdom. The quality of the copy is poor, making it difficult to make out details. The first catalogue bears the words "ice jeans" and at the bottom appear to be the words "look back" or "look book". Various items of clothing for men and women appear; ICEJ and ICEJEANS can be seen upon some of the items. There is no indication as to when the catalogue was produced. The end of the catalogue shows the name and address of Gilmar in Italy. A catalogue for Ice Jeans bears the wording "autunno inverno 03/04", various items of clothing are shown. At the end of the catalogue there is a list of show rooms, including one in London. A catalogue for ICE JEANS ICEBERG for spring/summer 2003 is included; a range of clothing is shown, some of it bearing ICE JEANS. There are pages from 'ICEBERG THE MOVIE' which features the spring summer collection for 2003, this includes one page bearing the name ice jeans. A copy of a catalogue entitled 'ICEBERG THE TOUR' has what appears to be a photocopied Post-it® upon it bearing the writing "CATALOGUE WINTER 2003". There is a reference to ICE

JEANS. At the end of the exhibit is a page which is headed Autumn Winter 2003 – 2004, this includes a list of boutiques and showrooms across the world; one is in the United Kingdom.

10) Exhibit 12 consists of copies of advertisements; the majority are for ICEBERG products. However, there are advertisements from ‘Vogue’, ‘Loaded’ ‘i-D’ magazine, ‘marie-claire’, ‘Elle’, ‘Dazed’ ‘FHM’, ‘Esquire’, ‘Nova’, ‘The Face’, ‘Red’ ‘Arena+’ and ‘Maxim Fashion’ all bearing the name ice jeans ICEBERG; the ice jeans is the dominant element of the trade mark that is shown (ICEBERG appearing below in much smaller type). Exhibit 13 contains more copies of advertisements. Virtually all of the emanate from after the international priority date. The exceptions are two advertisements from ‘Dazed & Confused’ of 1 September 2003 and one from ‘Dazed & Confused’ of 1 February 2003. They are for ice jeans ICEBERG. Exhibit 14 consists of examples of editorial advertising; again the quality of the copying makes it difficult to see details in parts of the material; to make matters worse, where the relevant part of a page had been highlighted, the copying of the highlighting has blotted out the pertinent part. There is a large amount of material relating to ICEBERG. The only matter relating to Ice Jeans is as follows:

‘In Style’ June 2002 - strapless dress by IceJeans by Iceberg;
‘Glamour’ July 2002 - sleeveless shirt – Ice Jeans by Iceberg;
‘In Style’ December 2002 “cream and chocolate edged wool scarf, £85, by Ice Jeans”.

There are also three advertisements from ‘Daze & Confused’ of November 2002 which go under the title of “Ice Ice Baby”, these are advertising Iceberg products also. All of the material in exhibit 14 emanates from prior to the international priority date.

11) Mr Gerani states that Gilmar has acquired a strong reputation and goodwill in the trade marks ICEBERG, ICE JEANS and ICE ICE ICEBERG in the United Kingdom; because of the way that the trade marks are presented, the ice element of the trade marks is particularly associated with Gilmar’s goods.