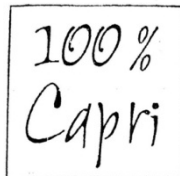


O-501-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2614064
BY ANTONINO AIELLO
TO REGISTER THE TRADE MARK**



**IN CLASSES 3, 9, 18 & 25
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 104035 BY
IN.PRO.DI -INGHIRAMI PRODUZIONE DISTRIBUZIONE S.P.A.**

BACKGROUND

1) On 15 March 2012, Antonino Aiello (hereinafter the applicant) applied to register the trade mark shown above in respect of the following goods:

In Class 3: Washing preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices.

In Class 9: Glasses, eyeglasses, sunglasses.


In Class 18: Leather and imitation of leather, and goods made of these materials and not included in other classes, animal skins; trunks and valises, umbrellas, parasols, walking sticks.

In Class 25: Blouses, shirts, polo shirts, jackets, sweaters, tops, coats, scarves, belts, knit shirts, ties, pashminas, suits, skirts, dresses, chinos, all being made of linen; panama hats.

2) The application was examined and accepted, and subsequently published for opposition purposes on 3 August 2012 in Trade Marks Journal No.6951.

3) On 1 November 2012 IN.PRO.DI- Inghirami Produzione Distribuzione S.p.A. (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

Mark	Number	Date of application / registration	Class	Specification
 The word "CAPRI" in fancy lettering.	CTM 2689891	06.05.2002 10.02.2004	25	Outer clothing.

b) The opponent contends that the mark in suit is confusingly similar to its registered trade mark. It states that the goods applied for in the mark in suit are similar or identical to those for which its mark is registered. The mark in suit therefore offends against Section 5(2)(b) of the Act.

4) On 15 January 2013, the applicant filed a counterstatement denying the ground. They put the opponent to strict proof of use of its mark.

5) Both sides filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard. Both sides filed written submissions which I shall refer to as and when relevant in my decision.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 20 March 2013, by Giovanni Inghirami the Chairman of the opponent company. He states that his company first used its CAPRI mark in the 1950s. He provides a number of exhibits which consist of sample invoices which he states illustrate the use to which the mark has been put. As the invoices use Italian terms for the articles he also provides a list of Italian terms and the English translation. He states that the mark has been used on clothing to a significant scale in the EU in the five years preceding the date of publication, 3 August 2012. The exhibits are as follows:

- GI.1: Consists of six invoices, dated between 7 February 2009 and 30 April 2010, all addressed to a company in Spain. All have the opponent's mark at the top of the invoice (albeit in black lettering on a white background rather than white lettering on a black background as registered) and total €54,977. All relate to use on shirts.
- GI.2: Consists of seven invoices, dated between 16 March 2007 and 12 March 2010. However, I have ignored the first invoice as it is outside the proof of use period and have instead used the six invoices covering the period 31 December 2007 to 12 March 2010. All are addressed to the same company in Italy. All have the opponent's mark at the top of the invoice (albeit in black lettering on a white background rather than white lettering on a black background as registered) and total €17,302. The invoices relate to suits, shirts, pullovers, belts, trousers and jackets.
- GI.3: Consists of four invoices, dated between 28 February 2007 and 13 March 2009, all addressed to a company in Italy (different from the company in GI.2). I have ignored the first invoice as it is outside the proof of use period and have instead used the three invoices covering the period 30 September 2008 to 13 March 2009. All have the opponent's mark at the top of the invoice (albeit in black lettering on a white background rather than white lettering on a black background as registered) and total €24,421. The invoices relate to T-shirts, shirts, trousers jackets, undershirts, blouses, skirts and polo shirts.
- GI.4: Consists of three invoices, dated between 30 April 2010 and 31 August 2010, all addressed to a company in Italy (different from the companies in GI.2 & 3). All have the opponent's mark at the top of the invoice (albeit in black lettering on a white background rather than white lettering on a black background as registered) and total €3,046. All relate to use on shirts.

- Gl.5: Consists of one invoice, dated 29 October 2010, addressed to a company in Italy (different from the companies in Gl.2, 3 & 4). It has the opponent's mark at the top of the invoice (albeit in black lettering on a white background rather than white lettering on a black background as registered) and is for €1,259. The invoices relate to suits, trousers and jackets.
- Gl.6: Consists of one invoice, dated 18 April 2008, addressed to a company in Hungary. It has the opponent's mark at the top of the invoice (albeit in black lettering on a white background rather than white lettering on a black background as registered) and is for €3,765. The invoice relates to shirts.
- Gl.7: Consists of two invoices, dated 19 March 2013, addressed to two companies in the UK. They have the opponent's mark at the top of the invoice (albeit in black lettering on a white background rather than white lettering on a black background as registered) and are for €381. However, these are outside the relevant period.
- Gl.8: Consists of copies of correspondence between the opponent and Studiozeta (an Italian company) regarding the opponent supplying clothing articles bearing the "Capri" trade mark for sale in Italy and worldwide. The letters are dated 4 and 11 July 2011.
- Gl.9: Consists of a copy of a webpage of Studiozeta. It shows a shirt with a "capri" mark although the font is completely different from that registered. The wording is in English. However, the page is undated.
- Gl.10: consists of a copy of a page from the opponent's website. It shows the mark in suit being used on a shelf in a shop to promote shirts as part of its 2010 range. It is not clear where the shop is or when exactly the photograph was taken although as it is labelled as the 2010 collection it probably dates from that year.

APPLICANT'S EVIDENCE

7) The applicant filed a witness statement, dated 17 June 2013, by Ryan Edward Pixton their Trade Mark Attorney. He provides a copy of a revocation action against the opponent's mark which resulted in its specification being reduced to "outer clothing" as shown at paragraph 3 above. He also provides a copy of a decision of the General Court (Case T-415/09) which he states he will rely upon in submissions. Lastly he provides a copy of a page from Collins English Dictionary (the version is not provided) which shows the following definition:

"Outer garments: the garments that are worn over a person's other clothes."

8) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

9) The sole ground of opposition is based on section 5(2)(b) which reads:

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

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

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

10) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

11) The opponent is relying upon its mark listed in paragraph 3 above which is clearly an earlier trade mark. Given the interplay between the date the opponent’s mark was registered and the publication date of the mark in suit, the proof of use provisions are in play and the applicant has put the opponent to proof of use. Section six of the Act states:

“6A Raising of relative grounds in opposition proceedings in cases 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 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, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

12) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the mark has been made. In the instant case the publication date of the application was 3 August 2012, therefore the relevant period for the proof of use is 4 August 2007 – 3 August 2012. When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied, namely: the judgments of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case-law of the CJEU in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

"(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector

concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

13) The earlier mark is a CTM which means that genuine use must be in the EC. In its judgment in *Leno Merken BV v Hagelkruis Beheer BV* C-49/11 (“*ONEL*”) the CJEU said:

“28 The Court has already - in the judgments in *Ansul* and *Sunrider v OHIM* and the order in *La Mer Technology* - interpreted the concept of 'genuine use' in the context of the assessment of whether national trade marks had been put to genuine use, considering it to be an autonomous concept of European Union law which must be given a uniform interpretation.

29 It follows from that line of authority that there is 'genuine use' of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether there is real commercial exploitation of the mark in the course of trade, particularly the usages regarded as warranted in the economic sector concerned as a means of maintaining or creating market share for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (see *Ansul*, paragraph 43, *Sunrider v OHIM*, paragraph 70, and the order in *La Mer Technology*, paragraph 27).

30 The Court has also stated that the territorial scope of the use is only one of several factors to be taken into account in the determination of whether that use is genuine or not (see *Sunrider v OHIM*, paragraph 76).

31 That interpretation may be applied by analogy to Community trade marks since, in requiring that the trade mark be put to genuine use, Directive 2008/95 and Regulation No 207/2009 pursue the same objective.”

14) Regarding the territorial scope of the use, the CJEU went on to say:

“52 Some of the interested persons to have submitted observations to the Court also maintain that, even if the borders of the Member States within the internal market are disregarded, the condition of genuine use of a Community trade mark requires that the trade mark should be used in a substantial part of the Community, which may correspond to the territory of a Member State. They argue that such a condition follows, by analogy, from Case C-375/97 *General Motors*

[1999] ECR I-5421, paragraph 28, Case C-328/06 *Nieto Nuño* [2007] ECR I-10093, paragraph 17, and Case C-301/07 *PAGO International* [2009] ECR I-9429, paragraph 27).

53 That argument cannot be accepted. First, the cases in question concern the interpretation of provisions relating to the extended protection conferred on trade marks that have a reputation or are well known in the Community or in the Member State in which they have been registered. However, the requirement for genuine use, which could result in an opposition being rejected or even in the trade mark being revoked, as provided for in particular in Article 51 of Regulation No 207/2009, pursues a different objective from those provisions.

54 Second, whilst it is reasonable to expect that a Community trade mark should be used in a larger area than a national mark, it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the product or service concerned on the corresponding market (see, by analogy, with regard to the scale of the use, *Ansul*, paragraph 39).

55 Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark 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 (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)."

15) The applicant refers me to the case of *New Yorker SHK Jeans GmbH & Co KG v OHIM* Case T-415/09 where it states:

"66. With regard, next, to the invoices relating to the relevant period, the applicant submits that a number of these, which it identifies expressly in its application, could not be used to show genuine use of the earlier mark as they do not refer either directly or indirectly to that mark. In question here are 11 invoices from 2002, 10 invoices from 2003 and 10 invoices from 2004. It is true, on reading those invoices, that none of them mentions goods under the FISHBONE mark, such that, even though the earlier mark appears at the head of those invoices, they are, of themselves, incapable of proving that the intervener actually sold t-shirts or beach clothing under that mark, and are therefore incapable of showing genuine use of that mark (see, to that effect, judgment of 11 January 2011 in Case T-382/08 *Advance Magazine Publishers v OHIM – Capela & Irmãos (VOGUE)*, not published in the ECR, paragraph 48). Nevertheless, although those invoices do not mention goods under the FISHBONE mark, they can, to a certain extent, be

taken into account for the purpose of assessing the genuine nature of the use of the earlier mark, since they are additional elements which corroborate the other evidence in the file, examined below.”

16) However, the applicant overlooked the earlier comments in this judgment when the Court stated:

“58. In the present case, it must be noted that no information has been provided as to the person who made the affidavit, other than the fact that she has worked in the garment industry since 1995. Furthermore, in that document, it is stated, *inter alia*, that items of clothing showing the mark FISHBONE have regularly been marketed throughout Greece since 1994, including in the major Greek cities. The declarant adds that the earlier mark was used and shown in various sponsorship programmes or trade fairs between 1999 and 2004. In the absence of more precise information concerning the declarant herself, and in the absence of fuller explanations in that affidavit enabling the content and veracity of the information to be confirmed, the view must be taken that that affidavit cannot, of itself, be regarded as evidence of genuine use. Nevertheless, it must be held that it has a certain probative value and constitutes an element which must be taken into account and which corroborates the other elements in the file. It is common ground that the document written in Greek annexed to that affidavit, to which the Board of Appeal does not even refer in the contested decision, could not be taken into consideration as it had not been translated into the language of the case.”

17) In the instant case the evidence has a cogent narrative from an officer of the company who clearly is in a position to provide such evidence and can comment upon the activities of the opponent during the relevant period. I also note that the evidence of the opponent was not challenged by way of a request for cross examination. The applicant also sought to persuade me that the term “outer garments” could not encompass shirts. They claimed that the term “outer garments” would be understood to mean coats, anoraks, scarves etc. I do not accept this contention. Shirts are often worn in public without anything over the top of them, although the wearer may have a vest or T-shirt underneath the shirt. Thus the shirt is an outer garment. To my mind, most consumers would view an outer garment as anything which is not an under garment or underwear.

18) The applicant also contended that the mark used upon the invoices was different from that registered. In determining this issue I take into account the comments of Ms Carboni acting as the Appointed Person in *Orient Express* (BL O/299/08) where she said:

“66. It is unnecessary for me to give any further details here of the various underlying decisions. Their full case references are set out in *NIRVANA* [BL O/262/06] and *REMUS* [BL O/061/08]. But I do set out below the guidance that Richard Arnold QC derived from his review, which he set out in *NIRVANA* and reiterated in *REMUS*, as follows:

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....

67. There have been no decisions in the ECJ or CFI since *REMUS* that would give any reason to change this guidance. It seems to me that it is fully consistent with the approach laid down in *BUD*, effectively being a step-by-step version of the process that Lord Walker described in the extract that I have set out at paragraph 19 above. I would not expect a different result to come out of a comparison between a logo and a word mark depending on which guidance was being followed."

19) The mark used is simply a negative image of the mark registered and as such, to my mind, it does not alter the distinctive character of the mark. To my mind the evidence of the opponent as a whole has to be considered. Whilst I accept that it is not without fault and that in an ideal world additional information would have been filed, I am willing to accept that on the basis of the witness statement and the corroborative exhibits that the opponent has used its mark upon "shirts, T shirts, polo shirts, undershirts, blouses, pullovers, jackets, trousers, skirts, belts and suits".

20) I must now consider the evidence filed and determine a fair specification for use in the comparison test. In determining a fair specification I take into account the approach set out by Mr Richard Arnold QC (as he was then) acting as the Appointed Person in O/262/06 (*NIRVANA*) where he said:

"58. I derive the following propositions from the case law reviewed above:

(1) The tribunal's first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at[30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not

constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

(8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].”

21) The opponent’s mark is registered for “Outer clothing” and it has shown use on “shirts, T shirts, polo shirts, undershirts, blouses, pullovers, jackets, trousers, skirts, belts and suits”. Of these items undershirts and belts could not be considered to be outer clothing in class 25. The term “jackets” could refer to a suit jacket or a short coat. To my mind the use shown is more than adequate to maintain its full specification as registered.

22) When considering the issues under Section 5(2) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the CJEU 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] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 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)*. In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Distinctive character of the opponent's earlier trade marks

23) The opponent has provided evidence of use of its mark in a number of areas within the EU in respect of outer garments but none within the UK. The opponent has failed to provide total sales figures or even comment upon market share. Nor has it provided any

independent evidence to support any such claim. Even if the use had been within the UK it is not sufficient for the opponent to benefit from an enhanced reputation. I believe that the opponent's mark is inherently distinctive for the goods for which it is registered.

The average consumer and the nature of the purchasing process

24) I must now determine the average consumer for the goods of the parties. The products of both parties are such that they would be aimed at both the general public and also at businesses retailing the products. Both parties' specifications include clothing. Such goods will be sold in, inter alia, traditional retail outlets on the high street, through catalogues and on the Internet. The average consumer of the goods at issue is a member of the general public who is likely, in my opinion, to select the goods mainly by visual means. I accept that more expensive items may be researched or discussed with a member of staff. In this respect I note that in *New Look Ltd v OHIM Cases- T-117/03 to T-119/03 and T-171/03*, the General Court (GC) said this about the selection of clothing:

“50. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

25) In the same case the Court also commented upon the degree of care the average consumer will take when selecting clothing. It said:

“43. It should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, Case C 342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

26) Clearly, the average consumer's level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of clothing such as socks, the average consumer will pay attention to considerations such as size, colour, fabric and cost. Overall the average consumer is likely to pay a reasonable degree of attention to the selection of items of clothing or headgear.

27) Similar views hold true for the goods in Classes 3, 9 and 18, although each has their own issues. For instance class 3 goods will involve considerations around skin sensitivity, colouring, hair and skin type (dry, normal, greasy) etc. Class 9 goods will often involve discussions with a professional optician. Whereas certain class 18 goods such as furs are sold by highly specialised outlets. To my mind, none of the goods involved in this case are likely to be purchased by an individual or retailer without some consideration.

Comparison of goods

28) For ease of reference I reproduce the specifications of both parties:

Applicant's specification	Opponent's specification
In Class 3: Washing preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices.	Outer clothing
In Class 9: Glasses, eyeglasses, sunglasses.	
In Class 18: Leather and imitation of leather, and goods made of these materials and not included in other classes, animal skins; trunks and valises, umbrellas, parasols, walking sticks.	
In Class 25: Blouses, shirts, polo shirts, jackets, sweaters, tops, coats, scarves, belts, knit shirts, ties, pashminas, suits, skirts, dresses, chinos, all being made of linen; panama hats.	

29) 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 and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU 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.’

30) The accepted test for comparing goods is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed in *Canon*. In that case the factors to be taken into account were:

- a) The respective uses of the respective goods;
- b) The respective users of the respective goods;
- c) The physical nature of the goods;
- d) The respective trade channels through which the goods reach the market;

- e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be found on the same or different shelves;
- f) The extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods in the same or different sectors.

31) I also bear in mind the following guidance of the GC in *Gérard Meric v OHIM*, T-133/05:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

32) Finally, in terms of understanding what a "complementary" relationship consists of, I note the judgment of the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 where it was stated:

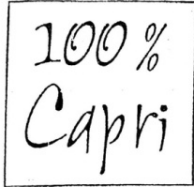

"It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Segio Rossi v OHIM - Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM - Propamsa (PAM PUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Ingles v OHIM - Bolanos Sabri (PiraNAN diseño original Juan Bolanos)* [2007] ECR I-0000, paragraph 48)."

33) Clearly all of the items listed in the applicant's class 25 specification, with the exception of panama hats, must be encompassed by the definition of "outer garments". To my mind, panama hats are similar to outer garments. I am willing to accept that Glasses, eyeglasses and sunglasses in Class 9 have a degree of similarity / complementarity with clothing in that they are also worn and are often used as part of an outfit or overall look. The public have also been educated into accepting that clothing manufacturers often also produce glasses and they are often found in the same parts of retail outlets. A similar argument can be made for bags in class 18 which again form part of a coordinated look. However, the other items in Class 18 "Leather and imitation of leather, and goods made of these materials and not included in other classes; animal

skins; trunks and valises, umbrellas, parasols, walking sticks” are, to my mind, neither similar or complementary to outer garments and I note that the opponent has not mentioned these items in its submissions other than to state they are similar without providing as reasons for this contention. A similar situation exists in the opponent’s submissions with regard to the applicant’s class 3 goods which are clearly very different to the class 25 goods of the opponent and cannot be regarded as complementary.

Comparison of trade marks

34) The trade marks to be compared are as follows:

Applicant’s mark	Opponent’s mark
	

35) It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

36) Other than being a type of trouser which finishes half way up one’s calf, the word “Capri” does not appear to have any meaning for any of the goods of either party and so must be regarded as distinctive, other than when used upon trousers. To my mind, the initial part of the applicant’s mark “100%” would be seen as reflecting the purity of the “Capri” element, as such the dominant element in the applicant’s mark is the “Capri” element. It does not “hang together” as a phrase or create an alternate meaning, as was the case in *Cardinal v Cardinal Place*. I will approach the comparison of the trade marks with these conclusions in mind.

Visual / Aural and Conceptual similarity

37) Clearly both marks contain the term CAPRI. They differ in that the applicant’s mark also has the term “100%” as its first element. The fonts also differ but neither font is particularly outlandish or memorable and in both cases the words are clearly visible and easy to read. Clearly, there is a significant visual, aural and conceptual similarity

between the marks albeit there are differences. Overall, the respective marks share a high level of similarity.

Likelihood of confusion

38) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and vice versa. The evidence does not allow me to find the opponent to have a reputation in class 25 goods, however given the similarity of the marks, where the goods are identical or similar as set out in paragraph 24 above, even allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore succeeds in relation to the following:**

- In Class 9: Glasses, eyeglasses, sunglasses.
- In Class 18: Leather and imitation of leather bags.
- In Class 25: Blouses, shirts, polo shirts, jackets, sweaters, tops, coats, scarves, belts, knit shirts, ties, pashminas, suits, skirts, dresses, chinos, all being made of linen; panama hats.

39) However, despite the similarity of the marks where the goods are not similar there is no likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them.

The opposition under Section 5(2) (b) therefore fails in relation to the following:

- In Class 3: Washing preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices.
- In Class 18: Leather and imitation of leather, and goods made of these materials and not included in other classes excluding bags; animal skins; trunks and valises, umbrellas, parasols, walking sticks.

COSTS

40) As the opponent has enjoyed a measure of success it is entitled to a contribution towards its costs. I have reflected the fact that the opponent was only slightly more successful than the applicant.

Expenses	£200
Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering the evidence of the other side	£200

TOTAL	£600
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41) I order Antonino Aiello to pay In.Pro.Di-Inghirami Produzione Distribuzione S.P.A. the sum of £600. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of December 2013

**George W Salthouse
For the Registrar,
the Comptroller-General**