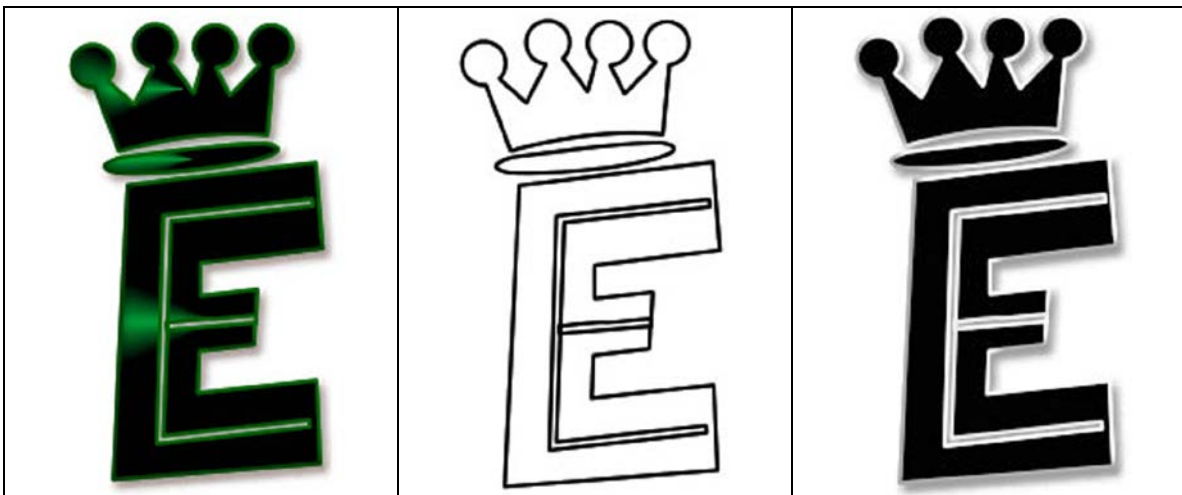


O-059-14

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2647927
BY NATHAN ALEXANDER EZEKIEL SCOTT & MERLYN AUDRIANA SCOTT
TO REGISTER THE FOLLOWING SERIES OF THREE TRADE MARKS
IN CLASSES 9, 14, 16, 18, 25 & 41:**



AND

OPPOSITION THERETO (NO. 400291) BY ETERNA MODE GMBH

The background and the pleadings

1) The trade mark the subject of this dispute was filed jointly by Nathan Alexander Ezekiel Scott & Merlyn Audriana Scott (the “applicants”) on 7 January 2013 and published in the Trade Marks Journal on 22 February 2013. Registration is sought for a wide range of goods and services, but this opposition is directed only at the following:

Class 18: Articles made wholly or principally of leather or of imitation leather; trunks and travelling bags; bags; shoulder bags; toiletry bags; luggage; handbags; key-cases, wallets, purses, briefcases; belts; carriers (luggage) for suits and for dresses; attaché cases; credit-card holders; umbrellas, parasols; holdalls.

Class 25: Clothing, footwear and headgear; jackets, coats, jerseys, jumpers, sweatshirts, sweatpants, sweaters, shirts, T-shirts, trousers, jeans, tracksuits, skirts, dresses, bathrobes, underwear; berets, woollen hats, base ball caps; articles of clothing for sportswear, clothing for sportswear; articles of clothing for swimwear, articles of swimwear.

2) Registration of the mark is opposed by eterna Mode GmbH (the “opponent”) on a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on two trade mark registrations, namely:

i) UK trade mark registration 1489072 which was filed on 28 January 1992 and which completed its registration process on 5 November 1993. The mark and the goods for which it is registered are set out below, together with a disclaimer which has been entered in respect of the registration:



Class 25: Articles of clothing for men and women; all included in Class 25.

Disclaimer: Registration of this mark shall give no right to the exclusive use of the letter "e".

Given its filing date, the mark constitutes an earlier mark as defined by section 6 of the Act. Given the date the registration process was completed, the proof of use provisions set out in section 6A of the Act are applicable because the earlier mark had been registered for five years or more as of the date of publication of the applied for mark. The opponent made a statement of use that the mark has been used in respect of all the

goods relied upon. The relevant period for proof of use is 23 February 2008 to 22 February 2013.

ii) International registration 632883 which designated the EU for protection on 19 December 2011 with protection being conferred on 24 January 2013. The mark and the (relied upon) goods for which it is protected are set out below:



Class 25: Clothing, including boots, shoes and slippers.

Given the date of EU designation, the mark constitutes an earlier mark as defined by section 6 of the Act. Given the date that protection was conferred, the proof of use provisions are not applicable because protection had been conferred only the month before the applicants' mark was published, not the required five years or more. The consequence of this is that this earlier mark may be relied upon in these proceedings for the goods set out above.

3) The basis for the opponent's claim is that:

The mark applied for under application no. 2647927 consists of the letter 'E' with the device of a crown above. The opponent's earlier mark registered under no. 1489072 consists of the letter 'e' with the device of a crown above. The marks are therefore conceptually identical, or at least very similar, and the marks are visually very similar. In addition, both marks would be described by the relevant public when viewing them as 'E and crown', therefore although the marks themselves are not word marks, the description of each must be considered to be aurally identical, or at least very similar.

The goods listed in class 25 of application no. 2647927 must be considered identical and similar to the goods in class 25 of opponent's earlier registration no. 1489072. The goods in class 18 of the application must be considered similar to the goods in class 25 of the opponent's earlier registration, since clothing and accessories such as bags and wallets are often produced by the same entities. They are sold in the same retail channels, and have the same end users. The relevant public is likely to assume association between clothing items and accessory items such as bags and wallets, which are sold under the same or similar marks.

4) The applicants filed a counterstatement denying the claims. It put the opponent to proof of use in relation to the first of the earlier marks listed above. In terms of their defence, I note the following:

- i) The applicants accept that the marks are orally similar but deny conceptual and visual similarity; detailed submissions are made regarding this statement which I will come back to.
- ii) That the goods in Class 18 of the application are not similar to the goods of the earlier mark(s).
- iii) That headgear is not listed in the earlier mark(s).


iv) That the mark was coined by the extrapolation of an element from the applicants existing stylised mark GRIM HEAD (the E of the word HEAD mirroring the applied for mark).

v) That, if necessary, the applicants are content to limit their specification to:

“Clothing - sweaters, T-shirts, jackets, jeans, trousers, tracksuits, sportswear, swimwear, underwear;
Footwear - trainers, plimsolls;
Headgear.”

5) Only the opponent filed evidence. The applicants filed submissions (but not evidence of fact) in response to the opponent’s evidence. Neither side requested a hearing. The opponent filed written submissions in lieu of attending a hearing, the applicants did not. I will, of course, take into account all of the arguments that have been made in the papers before me.

The opponent’s evidence

6) Evidence is given by Mr Henning Gerbaulet, the opponent’s CEO. He “declare[s] that [the opponent] has been selling shirts and blouses under the mark  in the UK since many decades, at least since 1985”.

7) At exhibit A1 he provides a company book which, he states, indicates that “our” trade mark has been on the market since 1963. However, the book is actually referring to the “eterna brand” not the stylised “e” device relied upon and the date is actually 1863 not 1963. There is little in this book giving UK context. Mr Gerbaulet states that the crown logo has been used for many decades.

8) It is stated that the mark is used on shirts and blouses. Various photographs are provided showing the mark on the lapel area or the cuff area of shirts. Provided in Exhibit A7 are advertisements of the eterna product in the UK – they all date from after the relevant period. It is stated that between 2008 and 2012 112,000 shirts were sold (from the context of his evidence, this appears to be a statement in relation to UK sales).

9) Evidence is also given by Ms Jennifer Kathryn Good, a trade mark attorney at Stevens Hewlett & Perkins, the opponent’s representative in this matter. She provides five exhibits to her witness statement as follows:

i) Exhibit JKG1 contain what are described as sample invoices showing UK sales in the last five years. The invoices are issued by the opponent to four different retailers in the UK. They date between 2008 and 2012. The only product identified is shirts. The earlier mark is not depicted on any of the invoices.

- ii) Exhibit JKG2 contains website prints relating to one of the retailers invoiced, namely Slaters Menswear. The evidence demonstrates that the retailer has 23 stores across the UK.
- iii) Exhibit JKG3 contains further prints from the website of Slaters Menswear, showing sales of ETERNA shirts. Close-ups show the earlier mark used on what appears to be the cuffs of the shirts. There is nothing to date the prints from within the relevant period, although, Ms Good notes that two of the product codes match product codes in certain invoices from within the relevant period.
- iv) Exhibit JKG4 is an internet archive print from the website of Slaters Menswear dated 29 November 2010. ETERNA shirts are depicted, but no close-ups are provided so the earlier mark cannot be seen.
- v) Exhibit JKG5 are prints from the website of Brigdens (another of the invoiced retailers) showing ETERNA shirts which it “currently” offers. Ms Good’s evidence was given on 25 September 2013 so “currently” equates to being after the relevant date and proof of use period. Close-ups are provided which show the earlier mark either on the cuff or on the lapel.

The applicants’ submissions on the evidence

10) In relation to Mr Gerbault’s evidence, it is noted by the applicant that the book does not depict the mark relied upon and that the various photographs he has provided do not demonstrate use in the UK, nor when the products were sold. In relation to the advertisements provided, the dates are noted (which I have already said were not within the relevant period) and it is noted that the trade mark relied upon is not depicted.

11) In relation to Ms Good’s evidence, it is stated that based on these, and by cross-referencing product codes, the opponent has sold just 4100 men’s shirts to four different UK retailers. It is noted that this is much less than the figures mentioned by Mr Gerbault. In relation to the web prints, it is stated that only certain codes match codes in the provided invoices and there is nothing to date them. In relation to the archive print, it is noted that the trade mark relied upon is not depicted. In relation to the Brigdens prints, it is noted that only certain product codes match the invoices and that the prints do not show use in the relevant period.

The proof of use provisions

12) Two earlier trade marks are relied upon by the opponent. One is subject to proof of use, the other is not. There is a dispute between the parties as to whether proof of use is established in relation to the earlier mark which is subject

to the requirement to show genuine use. However, I see no merit in making any form of analysis of this. Both earlier marks are for the same trade mark. The mark which is not subject to proof of use has a wider specification than that of the mark that is subject to proof of use. Thus, even if genuine use were established, the other earlier mark would put the opponent in a better position anyway. My decision will, therefore, focus upon earlier mark 632883 (the International registration). I need say no more about the proof of use provisions.

Section 5(2)(b) – the legislation and the leading case-law

13) Section 5(2)(b) of the Act 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.”

14) The CJEU has issued a number of judgmentsⁱ which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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 or 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;

(e) 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;

(f) 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 of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

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

(j) 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;

(k) 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."

The average consumer

15) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer uses when selecting goods and services can vary, depending on what is involved. The conflict involves, in the main, clothing products and goods which can loosely be described as fashion accessories. Such goods are "consumed" by members of the general public. The goods may be tried on (in the case of clothing) and are likely to be inspected for colour, size, style, fitness for purpose etc. All of this increases the potential exposure to the trade mark. That being said, the purchase of the goods in question is unlikely to be a highly considered process as it is purchased relatively frequently and, although cost can vary, it is not, generally speaking, a highly expensive purchase. I consider the purchasing process to be a normal, reasonably considered one, no higher or lower than the norm.

16) In terms of how the goods will be selected, this will normally be via self-selection from a rail or shelf (or the online equivalents) or perhaps chosen from

catalogues/brochures. This suggests a process of visual selection, a view which has been expressed in previous cases¹; although this case was clothing orientated, I see no reason why the principles would not extend to the other goods under consideration here. Despite the importance of the visual aspects of the marks, aural similarity will not, however, be ignored.

Comparison of the goods

17) When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“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.”

18) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services 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 or services 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 or services in the same or different sectors.”

19) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In

¹ See, e.g. *New Look Ltd v OHIM* – Joined cases T-117/03 to T-119/03 and T-171/03 (GC)

Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06 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 *Sergio 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 PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

20) In relation to complementarity, I also bear in mind the recent guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying to rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

21) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”² and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning³.

22) I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of*

² See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

³ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

Patent Attorneys (Trademarks) (IPTRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

23) From their counterstatement, I note that the applicants highlight that the earlier mark does not specifically list headwear and, further, that the goods of the earlier mark are not similar to their class 18 specification; reference is made to the earlier mark not claiming a reputation under section 5(3). I should highlight two points in relation to this. Firstly, if the earlier mark has a broad term which encompasses within its ambit goods which are identical or similar to those applied for, a finding of identity or similarity may still be made. Secondly, it is not a requirement for specific items to be listed in the earlier mark's specification, or, indeed, specific classes. The question is simply whether, after applying the case-law referred to above, the goods are similar.

24) The applicants seek registration in relation to the following goods in class 25:

Clothing, footwear and headgear; jackets, coats, jerseys, jumpers, sweatshirts, sweatpants, sweaters, shirts, T-shirts, trousers, jeans, tracksuits, skirts, dresses, bathrobes, underwear; berets, woollen hats, base ball caps; articles of clothing for sportswear, clothing for sportswear; articles of clothing for swimwear, articles of swimwear.

25) The earlier mark is protected in relation to:

Class 25: Clothing, including boots, shoes and slippers.

26) The fact that the specification of the earlier mark lists specific items which are included within the term "clothing" does not limit the specification to only those items. The use of the word "including" means that the listed items are just examples and are not to be regarded as exhaustive. Consequently, the earlier mark covers all clothing. All of the applicants' terms are clothing products. The fact that they also cover footwear and headgear makes no difference, as they are, in themselves, items of clothing. Even if they were not, they would still be similar to a reasonable degree. **My finding is that all of the applied for goods are identical to goods covered by the earlier mark.** Furthermore, the fall-back specification in the applicants' counterstatement does not assist because the goods would still be identical.

27) The applicants also seek registration in relation to the following goods in class 18:

Class 18: Articles made wholly or principally of leather or of imitation leather; trunks and travelling bags; bags; shoulder bags; toiletry bags; luggage; handbags; key-cases, wallets, purses, briefcases; belts; carriers (luggage) for suits and for dresses; attaché cases; credit-card holders; umbrellas, parasols; holdalls.

28) A complementary relationship can exist between clothing in class 25 (as covered by the earlier mark) and certain goods in class 18. In *El Corte Inglés SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-443/05) the General Court considered the clash between goods in classes 18 and 25, stating:

“42. First, the goods in class 25 and those in class 18 are often made of the same raw material, namely leather or imitation leather. That fact may be taken into account when assessing the similarity between the goods. However, given the wide variety of goods which can be made of leather or imitation leather, that factor alone is not sufficient to establish that the goods are similar (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 55).

43. Second, it is apparent that the distribution channels of some of the goods at issue are identical. However, a distinction must be made according to whether the goods in class 25 are compared to one or other of the groups of goods in class 18 identified by OHIM.

44. On the one hand, as regards the second group of goods in class 18 (leather and imitations of leather, animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery), the Board of Appeal rightly held that the distribution channels were different from those used for the distribution of goods in class 25. The fact that those two categories of goods may be sold in the same commercial establishments, such as department stores or supermarkets, is not particularly significant since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin (see, to that effect, Case T-8/03 El Corte Inglés v OHIM – Pucci (EMILIO PUCCI) [2004] ECR II-4297, paragraph 43).

45. On the other hand, as regards the first group of goods in class 18, namely leather and imitation leather goods not included in other classes such as, for example, handbags, purses or wallets, it should be noted that those goods are often sold with goods in class 25 at points of sale in both major retail establishments and more specialised shops. That is a factor which must be taken into account in assessing the similarity of those goods.

46. It must be recalled that the Court has also confirmed the existence of a slight similarity between 'ladies' bags' and 'ladies' shoes' (SISSI ROSSI, paragraph 42 above, paragraph 68). That finding must be extended to the relationships between all the goods in class 25 designated by the mark applied for and the leather and imitation leather goods not included in other classes, in class 18, designated by the earlier mark.

47. In light of the foregoing, it must be held that there is a slight similarity between the goods in class 25 and the first group of goods in class 18. Consequently, the Board of Appeal could not conclude that there was no likelihood of confusion on the part of the relevant public solely on the basis of a comparison of the goods concerned.

48. As to whether clothing, footwear and headgear in class 25 are complementary to 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18, it must be recalled that, according to the case-law, 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 the production of those goods lies with the same undertaking (SISSI ROSSI, paragraph 42 above, paragraph 60).

49. Goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image ('look') of the consumer concerned.

50. The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in class 25 and the various clothing accessories which complement them such as handbags in class 18. Any such coordination depends on the consumer concerned, the type of activity for which that look is put together (work, sport or leisure in particular), or the marketing strategies of the businesses in the sector. Furthermore, the fact that the goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and strengthen the perception that the same undertaking is responsible for the production of those goods.

51. It is clear that some consumers may perceive a close connection between clothing, footwear and headgear in class 25 and certain 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which are clothing accessories, and that they may therefore be led to believe that the same undertaking is

responsible for the production of those goods. Therefore, the goods designated by the mark applied for in class 25 show a degree of similarity with the clothing accessories included in ‘leather and imitations of leather, and goods made of these materials and not included in other classes’ in class 18 which cannot be classified as slight.”



29) In relation to the clash between class 18 and class 25, the opponent has filed no evidence addressed to this point. Its submissions are somewhat perfunctory. All they submit is that:

cover class 18, the goods listed in the Application in class 18 are clearly similar to goods in class 25, in that they are regularly offered for sale by the same entities, and are a natural extension of the goods covered by the Opponent’s earlier rights.

30) The simple fact that the goods may be offerered by the same entities and that this is a “natural extension” is somewaht superficial. However, bearing in mind what the case-law above says, and bearing in mind what may be the more obvious complementary products, **I conclude that there is a low degree of similairty in respect of purses and wallets, and a moderate degree of similairty in respect of handbags; the latter is more similar (than purses and wallets) as handbags may be designed specifcally to complement the look of certain clothing items. I extend this to “shoulder bags” covered by the applied for goods because they can be, essentially, handbags with shoulder straps.** The same finding will extend to the broad terms of the applied for mark which include such goods. Although, a simple exclusion of purses, wallets, handbags and shoulder bags removes such similairty from the broad terms.

Comparison of the marks

31) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

The applicants’ mark	The opponent’s mark
	

32) Although the applicants have applied for a series of three marks, I think it only necessary to consider one of them – similar findings will extend to the others. Although both marks contain two elements, both elements play important roles within the overall impressions, so neither element strongly dominates the

other. It is, after all, a whole mark comparison. The fact that the applicants' mark is presented in green is no real distinguishing feature, as a notional form of use of the opponent's marks would include use in a similar colour scheme.

33) From a visual perspective, both marks contain a letter E/e with what will be perceived as a crown above it. The applicants made a detailed assessment of the differences between the letters and the crowns in their counterstatement. Although this is borne in mind, there is no getting away from the fact that there is an inherent similarity on a visual level, despite the differences identified. Of course, a small case "e" is not highly similar to an upper case E when one looks simply at its visual impression. There is also the difference in the crowns. However, the way in which the elements combine together in a similar way increases the visual similarity. Overall, I consider there to be a good degree of visual similarity.

34) If articulated both marks will be referred to as "E", or "E with a crown above". The marks are aurally identical. Conceptually, although the marks do not present a fixed definable meaning, they both have the same semantic content of a letter "E" with a crown. This will form part of the way in which the average consumer will recall the marks. The concepts are, thus, highly similar. Overall, I consider the marks to be similar to a reasonably high degree.

Distinctiveness of the earlier mark

35) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). Whilst evidence has been presented of sales in the UK, I do not consider that the distinctiveness of the earlier mark will have been materially enhanced. There are a number of reasons for this. Even setting aside the applicants' criticisms of the evidence, at best the sales do not appear to me to be hugely significant in the context of the large UK market. Furthermore, the mark itself is one used on the lapel or the cuff of shirts. Whilst this can clearly count as trade mark use, the actual use is fairly subtle and secondary to the primary ETERNA mark.

36) In terms of the inherent characteristics of the mark, letters per se are not highly distinctive signs because they often represent something, but, given that what is being represented is not clear (save for footwear, where the letter could represent a width fitting) and given the addition of a crown, I consider the earlier mark to be of at least an average degree of distinctive character.

Likelihood of confusion

37) The factors assessed so far have a degree of interdependency. A global assessment of them must be made when determining whether there exists a

likelihood of confusion. There is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

38) There are two points referred to by the applicants that, as the opponent has submitted, are not pertinent to the issue. Firstly, that the mark forms part of its GRIM HEAD mark is neither here nor there. This does not lessen the likelihood of confusion. In any event, even if this were pertinent, no evidence of its actual use has been presented. Secondly, that a trade mark examiner did not consider the marks to be a problem at search stage does not matter. This does not bind the tribunal and matters must be considered afresh.

39) As the opponent states in its submissions, the average consumer rarely has the opportunity to view marks side by side, and, thus, the concept of imperfect recollection is important. In relation to class 25, the goods are identical and there is a reasonably high level of similarity between the marks. Bearing in mind the concept of imperfect recollection and the nature of the purchasing process, I conclude that there is a likelihood of confusion. Effectively, there is a likelihood, bearing these factors in mind, that one mark may be mistaken for the other. Further, even from the perspective of a highly attentive average consumer, even if the differences (as referred to by the applicant) were noticed, then I still believe that the similarity in the marks and their common make-up will inform such a person that the goods sold come from the same or an economically linked undertaking – the differences being seen as the result, therefore, of a brand variation. **There is a likelihood of confusion in respect of the class 25 goods.**

40) In relation to the class 18 goods I found to be similar, I also consider there to be a likelihood of confusion on a similar basis. Even though the goods are not identical, and, indeed, I found certain of them to be similar to only a low degree, the closeness of the marks makes up for this and I conclude, again, **that there is a likelihood of confusion in relation to the similar goods in class 18.**

Scope of success

41) Only certain goods were opposed. The unopposed goods are not affected by this decision. Furthermore, of the goods opposed, some are not affected because I have not fully found in the opponent's favour. In relation to the wide terms in class 18 which contain within their ambit handbags, shoulder bags, wallets and purses, a simple exclusion will, as already stated, remove similarity. This represents a simple exclusion of actual goods, so I do not consider it necessary to go back to the parties for submissions on a revised specification. In view of all this, the opposition succeeds in relation to:

Class 18: Purses, wallets, shoulder bags and handbags [and wide terms containing such goods]

Class 25: Clothing, footwear and headgear; jackets, coats, jerseys, jumpers, sweatshirts, sweatpants, sweaters, shirts, T-shirts, trousers, jeans, tracksuits, skirts, dresses, bathrobes, underwear; berets, woollen hats, base ball caps; articles of clothing for sportswear, clothing for sportswear; articles of clothing for swimwear, articles of swimwear.

But fails [or was not made against]:

Class 9: Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs, all carrying recorded sound and/or video; compact discs, films, videos and cassettes; all being for use in entertainment; publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites); electronic publications, electronic magazines; multi-media recordings and publications; pre-recorded videos; pre-recorded CDs. Optical goods; spectacles; sunglasses; cases and carrying cases adapted for spectacles and sunglasses; containers for spectacles and sunglasses; chains, cords and straps for spectacles and sunglasses; frames for spectacles and sunglasses; lenses for spectacles and sunglasses; sports goggles; swimming goggles; ear protecting devices; ear plugs for swimmers; ear plugs for divers; headphones; headphones for audio apparatus; mobile phones; mobile phone accessories; mouse mats; parts and fittings for all the aforesaid goods.

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery; costume jewellery and precious jewellery; precious stones; watches, clocks, horological and chronometric instruments, key fobs and key rings, badges, buckles, chains, earrings, pins, parts and fittings for all the aforesaid goods.

Class 16: Printed matter; stationery; calendars, writing instruments, office requisites (other than furniture), postcards, greeting cards, tickets, carrier bags, notebooks, flyers, note cards, books, magazines; printed publications, photographs; stickers, car stickers; posters; advertising and promotional material, billboard advertisements; press advertisements; business stationery; packaging materials; cheque-book holders and passport-holders.

Class 18: Articles made wholly or principally of leather or of imitation leather; trunks and travelling bags; bags; toiletry bags; luggage; key-cases, briefcases; belts; carriers (luggage) for suits and for dresses; attaché cases; credit-card holders; umbrellas, parasols; holdalls; walking sticks; whips, harness and saddler; but none of the aforesaid goods being purses, wallets, shoulder bags or handbags.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; education and instruction relating to radio and television; audio and video recording services; production, presentation and syndication of programmes, sound and video recordings for broadcast by television, cable, satellite, video and video means; exhibition services; production and presentation of shows; organisation of competitions; arranging of musical events; nightclubs, concerts, discotheques, dance clubs, dance venues and dance hall services; music hall services; production of shows, events, displays, and parties; organisation of events for cultural, entertainment and sporting purposes; information relating to education, leisure and entertainment provided on-line from computer databases or the Internet; advisory services relating to all the aforesaid.

Costs

42) The opponent succeeded in class 25. However, it failed for a large bulk of the class 18 goods. In the circumstances, the opponent has won only slightly more than it has lost. Accordingly, I consider that whilst it is entitled to costs in relation to its opposition fee, no other form of costs award should be made. I order Nathan Alexander Ezekiel Scott & Merlyn Audriana Scott (being jointly and severally liable) to pay eterna Mode GmbH the sum of £200. 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 4th day of February 2014

**Oliver Morris
For the Registrar,
The Comptroller-General**

ⁱ The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).