

O-156-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3081738
BY BRECREST FASHION LIMITED**

TO REGISTER THE TRADE MARK

PETIT CADEAU

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 403836**

BY PETIT BATEAU (SOCIÉTÉ PAR ACTIONS SIMPLIFIÉE)

BACKGROUND

1. On 14 November 2014, Brecrest Fashion Limited (“the applicant”) applied to register the mark shown on the cover page of this decision for the following goods:

Class 25

Clothing; articles of clothing included in Class 25 for babies and children; footwear; headgear; casualwear; articles of sports clothing.

2. The application was accepted and published for opposition purposes on 28 November 2014.

3. PETIT BATEAU (société par actions simplifiée) (“the opponent”) opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in the application. The opponent relies upon its earlier Community Trade Mark (“CTM”)¹ no. 1923820 ‘PETIT BATEAU’, which has a filing date of 27 October 2000, claims a seniority date of 25 August 1972 and which was entered into the register on 18 January 2002. The opponent relies on the CTM insofar as it is registered for the following goods:

Class 25

Clothing; shoes and footwear; headgear.

4. The applicant filed a counterstatement in which it denies the opponent’s claim and puts it to proof of use.

5. Only the opponent filed evidence; it also filed written submissions. Although, in its counterstatement, the applicant stated that it was its intention to file evidence of co-existence of the marks, no such evidence was submitted. Neither party wished to be heard nor did they file written submissions in lieu.

DECISION

6. The opposition is based upon Section 5(2)(b) of the Act which reads:

“5(2) A trade mark shall not be registered if because –

(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.”

7. An earlier trade mark is defined in Section 6(1) of the Act, which states:

¹ As of 23 March 2016 known as European Union trade mark (EUTM)

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

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

[....]”

8. As can be seen from the details given above, the mark relied upon by the opponent is an earlier mark within the meaning of the Act. It can also be seen that the opponent’s mark had been registered for more than five years at the time the application was published and as such, is subject to proof of use. The relevant period for the opponent to prove use of its mark is the five-year period ending with the date of the publication of the applied for mark, i.e. 29 November 2009 to 28 November 2014.

9. The relevant sections of the Act read as follows:

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

6A. - (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, 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 or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

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

10. Section 100 of the Act is also relevant and reads:

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

11. With the above in mind, I go on to consider the evidence filed.

The opponent's evidence

12. This takes the form of a witness statement from Céline Berniot, the opponent's Director of Legal Affairs accompanied by five exhibits (Annexes 1-5). Ms Berniot states that the opponent's mark was first used in the UK in 1980 and that goods sold under the mark are “clothing for men, women, children and babies, plus toys”. She provides sales figures for ‘PETIT BATEAU UK’ relating to the period 2012-2014 showing annual sales averaging £ 8 million. UK promotional expenditures are given for 2014 alone² and amount to approximately £ 62,000. Neither the turnover nor the promotional figures are broken down in any way. Ms Berniot also states that the opponent has had a UK subsidiary since 1996, owns 14 shops in the UK and has a commercial website for the UK ‘www.petit-bateau.co.uk’.

13. Exhibit Annex 1 consists of photocopies of extracts from a range of UK fashion and lifestyle magazines, pregnancy, babies’ and toddlers’ magazines, regional and national newspapers and websites, showing pictures of clothes identified as ‘PETIT BATEAU/Petit Bateau’. These are dated between 30 January 2014 and 12 December 2014 and are mostly within the relevant period. Examples include ‘*Elle*’, ‘*Marie Claire*’, ‘*Glamour*’, ‘*Cosmopolitan*’, ‘*Metro*’, ‘*The Times*’, ‘*Mother & Baby*’. Ms Berniot states that this evidence shows “indicative use of the mark in relation to [the] goods”. Most of the pictures are presented within fashion trends sections, i.e. what-

² Ms Berniot refers to “advertisement budget to 2014” which could be read as “up to 2014”. However, she equally refers to the annual turnover figures as “to 2012”, “to 2013”, “to 2014”, which, it appears, is intended to mean “turnover of PETIT BATEAU UK in 2012/2013/2014”. I, therefore, understand the meaning of the preposition “to”, in the context of these figures, as being “for/in”.

to-wear guides. The goods are women's clothes, babies' and children's clothes. Given the quality of the copies, it is impossible to discern any labels, but 'PETIT BATEAU/Petit Bateau/petit-bateau' appear in the description of the goods/style and/or on the website ('petit-bateau.com' and 'petit-bateau.co.uk') below or next to each image, together with the price (in pounds). Two items feature 'petit bateau/Petit Bateau' on the actual goods; one of them³ shows the phrase 'petit bateau' in a handwritten script embroidered on the left breast of a long sleeved top but is dated 12 December 2014 and it is, therefore, after the relevant date. The one within the relevant period is exhibited at page 40⁴ and shows 'Petit Bateau' in a decorative manner on the front of a t-shirt in a large handwritten script above the word 'Paris' (in the same font). Page 17 consists of an extract from '*littlelondonmagazine.co.uk*' which features a special promotion for children's clothes offering a 20% discount in "Petit Bateau UK stores and online with free delivery". This shows the opponent's mark used in conjunction with a boat device (I will say more about this below) but it is dated April/May 2015⁵ and is, again, after the relevant date. Finally, the exhibit includes a number of printouts from the websites '*ELLEUK.COM*' and '*Redonline.co.uk*'. These show women's clothes identified as 'Petit Bateau' and are within the relevant period.

14. Exhibit Annex 2 consists of samples of six invoices, dated between 24 January 2014 and 13 July 2015, two of which are after the relevant date. All the invoices are issued by 'PETIT BATEAU UK Ltd' to UK addresses, one of which appears to be a retail business, i.e. Foundation Retail Cheltenham Ltd. The invoices are for items of clothing and headgear for babies aged 0-2 and for children aged 2-10, and for items of adult clothing listed as cardigans, vests, tee shirts, chemise tops, long sleeves, t-shirts and strappy dresses. Two invoices, dated within the relevant period, are made out to businesses, i.e. 'Gemini' and 'Alex and Alexa', which are referred to as the opponent's "distributors [...] in the UK" (exhibit Annex 4); it is my understanding that those businesses are essentially UK retailers for the opponent's goods. The mark does not feature on the invoices but 'petit bateau/PETIT BATEAU' is shown on the website address 'www.petit-bateau.com' and in the company name 'PETIT BATEAU UK Ltd'. This, I note, is different from the opponent, but it seems reasonable to infer that it is the opponent's UK subsidiary, to which Ms Berniot refers in her statement.

15. Exhibit Annex 3 consists of copies of press articles and promotional material from various sources, including well-known UK magazines and national newspapers. All but one are within the relevant period. Examples include '*Time Out London*', '*Grazia (daily.co.uk)*', '*The Telegraph*', '*The Times Life*', '*The Independent*'. A number of press articles refer to 'Petit Bateau' collaborating with French and Belgium designers⁶ and opening a 'pop up shop' in London for a month between February and March 2014 to exhibit its spring collection for men and women. An article from '*All In London*' dated 13 February 2014 states the following: "Since opening its first shop in London in 2001, French favourite Petit Bateau now has nine shops in the UK, but tomorrow will open its first adult Pop-Up Shop in Shoreditch". An article from '*The Telegraph*' dated 4 February 2014 about 'Petit Bateau' shows items of men's clothing described as "the debut collection from Notch London". An article from '*The*

³ Page 47

⁴ Dated September 2014

⁵ The opponent says it is dated April 2014 but the copy shows the date as 2015.

⁶ Christian Lacroix, Maison Kitsune, Cedric Charlier

Times Life of 17 June 2014 shows a picture of the Duchess of Cambridge and Prince George who, it is said, is wearing 'Petit Bateau' branded clothes. No mark is visible on the actual goods. The only item which shows use of 'petit bateau' on goods is, at page 4, the picture of a striped top with 'petit bateau' embroidered on the left breast in a handwritten script. This is dated February 2014, so it is within the relevant period. Further, page 17, shows an advertisement for 'PETIT BATEAU', (see Annex A) which, it is said, was published in the magazine *'PORTER'*. Although the front cover of the magazine and the page showing the advertisement are photocopied and presented separately, the opponent states that the advertisement was published in the July 2014 edition, which tallies with the date shown on the copy of the front cover (summer 2014). The advertisement is for women and children's clothes and shows the opponent's mark 'PETIT BATEAU' accompanied by a '®' sign, indicating trade mark usage, in conjunction with a circular boat device and the text 'CLOTHES FOR 0 TO 1000 MONTHS' as below:



16. Exhibit Annex 4 is a list of businesses which are said to be the opponent's UK 'distributors' and, as I have explained above, are essentially retailers selling the opponent's goods in the UK. The list, which includes just under 50 names and website addresses, indicates whether the retailers are 'Pure Player' or 'Brick&Mortar' (although it is not stated what Pure Player means, it seems likely that it refers to retailers who have an online presence). Examples include 'Harrods', 'Liberty', 'Harvey Nicholls', 'Amazon UK', 'Next'. There is nothing to confirm that these businesses were UK retailers for the opponent's goods at the relevant dates. Further, there is no information on the level of sales achieved by the individual retailers during the relevant dates.

17. Exhibit 5 consists of copies of photographs of the opponent's stand at a commercial exhibition for children's wear which, it is said, was held at the Bubble kids fair Spring Summer 2012 in Islington. The first page is a photograph of a promotional poster fitted to the side of a display cabinet featuring the mark both as registered and in conjunction with the boat device (as shown above). The second page is a photograph of babies' and children's clothes hanging on a wall-mounted rail above which there is a promotional poster. Again, this shows the mark in conjunction with the boat device although, given the quality of the picture, the phrase 'PETIT BATEAU' is only barely legible. The same picture also shows the presence of promotional gift bags featuring the boat device placed on the floor below the clothes, although, the quality of the image is poor and it is not possible to make the mark out clearly. The third page is a photograph showing a similar setting but the goods are women's clothes; the mark, in conjunction with the boat device, features on a wall.

Again, whilst it is also possible to discern the boat device on posters and gift bags, owing to the poor quality of the photographs, any text is illegible. The fourth page incorporates the setting displayed in the second and third pages and also shows the opponent's exhibition stand identified as '356 Petit Bateau CLASSIC KIDS'. None of these copy photographs are dated.

18. That concludes my summary of the evidence filed to the extent I consider it necessary. I now turn to the decision.

Proof of use

19. In considering whether genuine use of the opponent's mark has been made during the relevant period in respect of the goods it seeks to rely on, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use. What constitutes genuine use of a mark has been subject to a number of judgments. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He stated:

"I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance

with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

20. In *Laboratoire De La Mer Trade Mark* [2002] FSR 51 Jacob J stated:

“9. In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye – to ensure that use is actually proved - and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted.”

21. In considering the opponent's evidence, it is a matter of viewing the picture as a whole, including whether individual exhibits corroborate each other. In Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, in relation to the need to get a sense from the overall picture of the evidence, notwithstanding that individual pieces may not, of themselves, be compelling, the General Court (GC) stated:

“53. In order to examine whether use of an earlier mark is genuine, an overall assessment must be carried out which takes account of all the relevant factors in the particular case. Genuine use of a trade mark, it is true, cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (COLORIS, paragraph 24). However, it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of

evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (see, to that effect, judgment of the Court of Justice of 17 April 2008 in Case C-108/07 P Ferrero Deutschland v OHIM, not published in the ECR, paragraph 36).”

22. Whilst the opponent’s evidence is unchallenged, this does not mean that I can, or that I should, accept that it is sufficient to establish genuine use. By virtue of section 100 of the Act the evidential burden of showing what use has been made of its mark lies with the opponent and the question for me remains as to whether the opponent has discharged that burden.

23. Most of the evidence consists of press articles and references to the opponent’s mark in fashion sections of magazines where ‘Petit Bateau/PETIT BATEAU’ is mentioned. However, this evidence does not show how the mark is used by the opponent and it cannot be relied on as such. There is no evidence of how the mark is used on the actual goods and the opponent has not supplied a single example showing a swing tag or of a garment with a ‘PETIT BATEAU’ label on it, although there is some limited evidence which shows the phrase ‘petit bateau/Petit Bateau’ embroidered or printed on items of clothing. I bear in mind that when looking at all the evidence submitted, I must not simply consider each item of evidence individually but step back and consider the evidence as a whole to see what it establishes. In my view, while the above evidence, together with the invoices, corroborates Ms Berniot’s account that the opponent has used the mark in the UK, the opponent’s best evidence which shows use of the mark by the opponent in relation to the goods is:

- i) the advertisement for women’s, babies and children’s clothes which features the mark in conjunction with the boat device (Annex 1) and
- ii) the photographs taken at the commercial exhibition where the mark (either in plain words or in conjunction with the boat device) is shown on promotional material, again, in relation to women’s, babies and children’s clothes.

24. The mark appears in most of the above material in a perfectly straightforward (i.e. non stylised) script positioned in a roughly semi-circular pattern below a circular shaped device of a boat and on one occasion above the device of a boat there appears the words ‘CLOTHES FOR 0 TO 1000 MONTHS’. The registered mark itself is unaltered and its positioning around a semi-circular pattern is within the bounds acceptable by the registration of a mark in block capitals. It is true that the mark appears with other matter, i.e. the boat device and the words ‘CLOTHES FOR 0 TO 1000 MONTHS’, that being the case, I need to decide whether such use constitutes use of ‘PETIT BATEAU’ in plain script (as registered). In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (CJEU) found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of

registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

25. Applying the above case-law to the present case, I find that use of the mark 'PETIT BATEAU' jointly with the boat device and, where relevant, the words 'CLOTHES FOR 0 TO 1000 MONTHS' falls into the category of acceptable use as set out in *Colloseum*.

26. I therefore consider that the evidence is sufficient to enable me to conclude that there was use of the registered mark 'PETIT BATEAU' in the UK during the relevant period by the opponent as an indication of origin in connection with goods covered by the registered specification (I will say more about the goods below).

27. The next step is to assess whether the use made amounts to genuine use i.e. real commercial exploitation of the mark, on the market for the relevant goods. In considering the issue of genuine use in relation to CTMs the CJEU in *Leno Marken BV v Hagelkruis Beheer BV*, Case C-149/11, stated that:

"36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase 'in the

Community' is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use."

And

"50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as 'genuine use', it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark."

And

"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)."

28. The Court held that:

"Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."

29. In *The London Taxi Corporation Limited* (supra), Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

30. The GC restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of a Community trade mark. Consequently, trade mark opposition and cancellation proceedings continue to entertain the possibility

that use of a CTM in an area of the EU corresponding to the territory of one Member State may be sufficient to constitute genuine use of a CTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the EU.

31. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the CTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the EU during the relevant 5 year period. In making the assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- v) The geographical extent of the use shown

32. Ms Berniot has given unchallenged evidence that in the three year period prior to the filing of the contested application, the opponent achieved annual turnover in the UK in excess of £8m. Although the figures are not broken down in any way, the evidence is that the turnover was generated by the sale of goods relied upon in these proceedings (with the exception of toys) and in relation to which, as I will explain below, the opponent has shown use of the mark. On this point, whilst Ms Berniot refers to the sale of “clothes for men, women, children and babies and toys”, the invoices (and the evidence) suggest that most of the sales (and the promotional activity) were in relation to babies’, children’s and women’s clothes (and babies’ and children’s headgear) only. These are goods for which (see below) use of the mark has been shown. I am therefore satisfied that the turnover figures relate to the sales of goods relied upon by the opponent and in relation to which the opponent has demonstrated use of the mark. As to whether this amounts to genuine use of the opponent’s CTM, taking into account the above factors, I find that:

- The goods are, broadly speaking, items of clothing and headgear. No evidence is given which shows the size of the Community market for these goods. On any reasonable view, however, the market must be significant. However, even in the absence of comparable figures, an annual turnover in excess of £8 million amounting to in excess of £24 m over a period of three consecutive years is sufficient, in my view, to demonstrate a sufficient scale and frequency of use. Whilst I note that sales figures are only quantified from 2012 and there is no indication of the volume of commercial activity for the early years of the proof of use period, this does not fatally undermine the opponent’s evidence as what I need to consider is the total amount of transactions over the relevant period.
- The evidence shows use of the mark in the UK only. Notwithstanding the opponent’s claim that “the ‘PETIT BATEAU’ clothing brand has been created in 1983 in France” and that “since this date, the brand has acquired a large reputation through intensive use in the clothing field and more specifically clothing for babies and children worldwide”, no evidence has been provided of use of the mark outside the UK.

33. The opponent's evidence could certainly have been better focused. That said, the evidence shows use of the mark in the UK on promotional materials distributed on a national level. Further, taking into account the average cost of the relevant goods, the figures provided demonstrate that a significant number of items have been sold in the UK under the opponent's mark during the relevant period. In my view, the evidence is sufficient to demonstrate that there has been real commercial exploitation of the registered mark in the course of trade, sufficient to create or maintain a market for goods in the EU.

Goods which can be relied upon and fair specification

34. Although I have partially done it in the preceding paragraphs, I must now determine the goods on which use has been shown. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

35. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He stated

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark

or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered."

36. The opponent's use of the mark as shown has been almost exclusively in relation to babies' and children's wear/headgear and women's wear. Whilst there is some evidence that demonstrates that items of men's clothing from a 'Petit Bateau' collection have been made available in the UK during the relevant period, there is no evidence to show the manner in which the mark 'PETIT BATEAU' has been used either upon or in relation to them. Whereas it is possible that the mark was used on these items in the same manner as shown in relation to other goods, in the absence of solid and objective evidence, I am unable to find that the mark was used in the registered form on men's clothes. Likewise, I find that the evidence is not sufficient to

demonstrate use in relation to the other goods, i.e. shoes and footwear. In my view, genuine use of the mark has been shown on *articles of clothing and headgear for babies and children, articles of clothing for women* which is a fair specification for the use shown.

Section 5(2)(b) - case-law

37. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (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 be dominated by one or more of its components;
- (f) however, it is also 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 greater 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

38. In comparing the respective specifications, all the relevant factors should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the Court 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”.

39. The criteria identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] RPC 281 for assessing similarity between goods and services is as follows

- (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.”

40. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...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”.

41. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T- 133/05 the GC stated:

“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 trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

42. The parties’ goods are:

Opponent’s goods (following the proof of use assessment)	Applicant’s goods
<p>Class 25</p> <p><i>Articles of clothing and headgear for babies and children, articles of clothing for women.</i></p>	<p>Class 25</p> <p><i>Clothing; articles of clothing included in Class 25 for babies and children; footwear; headgear; casualwear; articles of sports clothing</i></p>

43. The applicant’s *articles of clothing included in Class 25 for babies and children* are self-evidently identical to the opponent’s *articles of clothing for babies and children*.

44. The opponent’s *articles of clothing for babies and children* and *articles of clothing for women* are encompassed by the broader term *clothing* in the applicant’s specification and can, therefore, be considered identical on the *Merici* principle. Likewise, the applicant’s *casualwear and articles of sport clothing* encompass the opponent’s *articles of clothing for children and articles of clothing for women*, as casualwear and sport clothing can be designed for women and children, thus, these goods are also identical.

45. This leaves the applicant’s *footwear and headgear*. The opponent’s *headgear for babies and children* are encompassed by the broader tem *headgear* in the applicant’s specification, thus, these goods are identical on the *Merici* principle. The applicant’s *footwear* could include items such as socks and tights which are a form of clothing and, as such, would be identical to *articles of clothing for babies and children and articles of clothing for women*, as well as shoes and slippers which would be similar. This is because the nature and purpose are the same (they are all aimed to cover parts of the human body), they are targeted at the same end consumers, manufactured by the same companies and distributed through the same channels. In my view, they are highly similar. I am reinforced in this view by the comments of the GC in *Giordano Enterprises Ltd v Office for OHIM* at paragraph 20:

“As the Court has held in previous cases, in view of the sufficiently close links between the respective purposes of ‘clothing’ and ‘footwear’, which are identifiable in particular by the fact that they belong to the same class, and the specific possibility that they can be produced by the same operators or sold together, it may be concluded that those goods may be linked in the mind of the relevant public.”

46. The Court concluded in the same paragraph of its judgment that: “... ‘clothing’ and ‘footwear’ must therefore be regarded as similar within the meaning of Article 8(1)(b) Regulation No. 40/94”.

The average consumer and the nature of the purchasing act

47. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods will be selected in the course of trade.

48. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

49. In the present case, the goods at issue are, broadly speaking, articles of *clothing, headgear and footwear* in class 25.

50. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC considered the level of attention paid when and the manner in which clothing is selected. It stated:

“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 that 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.

“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.”

51. The relevant public is composed of the general public at large who will pay at least an average level of attention when selecting the goods. The purchase is likely to be primarily visual as it is likely to be made from a physical store on the high street, a catalogue or from a website. That said, as the selection of the goods may, on occasion, involve the intervention of a sales assistant, aural consideration cannot be ignored.

Comparison of marks

52. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

53. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features, which are not negligible and therefore contribute to the overall impressions created by them.

54. The respective marks are shown below:

Opponent's mark	Applicant's mark
PETIT BATEAU	PETIT CADEAU

Overall impression

55. The opponent's mark consists of the French phrase 'PETIT BATEAU' presented in upper case with no additional stylisation. As to the applicant's mark, it consists of the French phrase 'PETIT CADEAU' in upper case; no part is highlighted or emphasised in any way. The overall impression both marks create is of foreign

(French) words and the distinctiveness of the marks lie in the combination of the words themselves.

Visual similarity

56. The opponent draws my attention to a number of OHIM⁷ decisions, suggesting that they show the proper approach to the assessment of the visual, aural and conceptual similarities between marks. On this point, it is a well-established rule that opposition decisions of OHIM or of other national registries are not binding upon the UK Registry (and vice versa) and, furthermore, I am required to make a decision on the basis of the facts before me from the average UK consumer's point of view.

57. Considered from a visual perspective, the competing marks are of equal length, both consisting of the word 'PETIT' followed by the six letter words 'BATEAU' and 'CADEAU' respectively. The second words in each mark are visually similar to the extent that they both contain a letter 'A' in the second letter position and coincide in the sequence 'EAU' at the end but differ to the extent that in the opponent's mark it begins with the letter 'B' and contains a letter 'T' as the third letter while in the applicant's mark it begins with the letter 'C' and contains a letter 'D' as the third letter. I also bear in mind that, as pointed out by the opponent, there is a general rule, clear from decisions such as joined cases T-183/02 and T-184/027⁸, that the first parts of words (and consequently, first words of marks) catch the attention of consumers although, it is also clear that each case must be decided on its merits considering the marks as wholes. Weighing the similarities and differences, in particular the fact that the marks share the same structure, that the first element is identical and that the construction of the second element is similar, I consider there to be a medium to high degree of visual similarity.

Aural similarity

58. The opponent submits that the marks are similar because the syllabic structure is the same. The aural assessment must be from the standpoint of the average consumer in the UK. The combination of the vowels 'EAU' is unusual in English and it is likely to be pronounced as O, so the marks will be pronounced as PE-TI BA-TO and PE-TI CA-DO. Both marks start with the same five letter word and although the remaining part of the marks are different, the rhythmic pattern and common vowel sounds of the syllables in the second element of each mark is highly similar. Overall I find that there is a medium to high degree of aural similarity.

Conceptual similarity

59. Conceptually, the applicant submits that "the marks have distinct meanings which would not be confused by the average consumer in the UK" (but it does not say what it considers these distinct conceptual meanings to be). The opponent, on the other hand, contends that although the average consumer is unlikely to understand the meaning of the marks, there is conceptual similarity to the extent that both signs will be perceived as of French origin. I believe there is some strength in

⁷ As of 23 March 2016 known as European Union Intellectual Property Office (EUIPO)

⁸ *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II – 965, paragraph 81

the opponent's submission. In my view, it is likely that a significant number of the UK population will be familiar with the common French word 'PETIT', meaning small as it resembles the English word petite (which is the French feminine form of petit) meaning "(of a woman) small, delicate, and dainty"⁹, and a word which also, in my experience, designates a UK standard clothing size designed to fit women of shorter height. As to the perception of the words 'BATEAU' and 'CADEAU', I bear in mind the comments of Ms Amanda Michael, sitting as the Appointed Person in O/92/11 when she stated:

27. [...]. In BL O/25/05, *Acqua di Gio*, Mr Geoffrey Hobbs QC sitting as the Appointed Person said at paragraph 29 "the impact of a word mark on speakers of English should be used to determine whether it is acceptable for registration in the United Kingdom on absolute and relative grounds" and at paragraph 41 he said "it is impermissible for the English equivalents of foreign words to be used for the purpose of testing issues relating to the distinctiveness, descriptiveness or deceptiveness of such words in the United Kingdom in the absence of good reason for thinking that a significant proportion of the predominantly anglophone public in the United Kingdom would understand the meaning of the word(s) in question." In my judgment, the position is that even though many people live in the UK whose native tongue is not English that does not mean that such individuals are to be treated as the relevant "average" consumers for the purpose of deciding what a word means, or how a word would be pronounced, in the United Kingdom. In the absence of special circumstances, the average public is the "predominantly anglophone public."

60. In my view, the majority of UK consumers cannot be assumed to be familiar with the French language. The words 'BATEAU' and 'CADEAU' are not, in my view, common French words which have entered into the English language and while it is not inconceivable that some consumers may understand their meaning, such individuals cannot be treated as the relevant average UK consumer for the purposes of deciding how these words will be perceived. In my view, it is unlikely that the average 'anglophone' consumer in the UK will understand the meaning of these words. What, I believe, the same average 'anglophone' UK consumer will recognise, instead, is (together with the use of the of the French word 'PETIT') the ending of the words, i.e. 'EAU', as a construction of French origin which he is accustomed to seeing on packaging of, for example, eau de toilette and eau de cologne. In my view, the average UK consumer will understand the competing marks as being of French origin and will perceive the word 'PETIT' as referring to something small, but the combination of words will make little sense without further explanation. To this extent, I find that the conceptual similarity between the marks is medium. For those not familiar with the meaning of any of the words within the marks, the position is one of conceptual neutrality.

Distinctive character of earlier mark

61. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*²⁶, the CJEU stated that:

⁹ Collins English Dictionary

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

62. Insofar as the inherent distinctive character of the mark is concerned, whilst the word ‘PETIT’ is likely to be seen as referring to something small, it will not be perceived on its own but as part of the whole mark ‘PETIT BATEAU’ whose meaning will be unclear. In my view, given that the earlier mark is neither descriptive of nor non-distinctive for the goods at issue and consists of what will be perceived as a phrase of French origin with no clear meaning, it is endowed of a high distinctive character per se.

63. The opponent claims that the distinctiveness of the ‘PETIT BATEAU’ mark has been increased through its extensive use. The mark ‘PETIT BATEAU’ is said to have been first used in the UK in 1980. Turnover figures are given for the three year period 2012-2014 but, as I noted earlier in this decision, nothing has been provided which allows me to determine the size of the relevant market as a whole. Again, even in the absence of figures, the UK clothing sector, even in relation to the subcategories in which the opponent operates, i.e. women’s, babies’ and children’s clothes and babies’ and children’s headgear, must be significant. In my view, whilst the annual turnover figures of around £8m indicate a successful business, in relation to the overall size of the market, I do not consider this is sufficient to have enhanced the distinctive character to any material extent.

Likelihood of confusion

64. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct

comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

65. By way of summary, earlier in this decision I found that the competing goods are identical or highly similar. I also found that the competing marks share a medium to high degree of visual and aural similarity and a medium degree of conceptual similarity or alternatively, that the conceptual position is neutral. Further, the earlier mark is endowed with a high degree of inherent distinctive character which has not been shown to have been enhanced to any material extent through use. I also found that the average consumer is a member of the general public who will pay an average degree of care and attention when selecting the goods and their purchase is primarily a visual one.

66. Weighing up the various factors and taking into account imperfect recollection, I come to the conclusion that there is likelihood of direct confusion, which means that one mark will be mistaken for the other. The marks coincide in the word 'PETIT' which is the first element of each mark and whose meaning will be understood by the UK average consumer. Whilst there is a difference between 'BATEAU' and 'CADEAU' to the extent that the first and the third letters are different, the rhythm, length and construction of these words is the same and they coincide in the ending 'EAU'. Further, as I have already said, the meaning of 'BATEAU' and 'CADEAU' will not be understood by the average consumer. In my view, what will be remembered is the impression of a two-words as being a mark of French origin, meaning something small. This combined with the identical rhythm of the marks and the absence of any perceived conceptual difference, is likely to lead to the differentiating elements being misremembered/misrecalled as one another.

Conclusion

67. The opposition has succeeded.

Costs

68. The opposition has been successful and the opponent is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide and taking account of the fact that the opponent filed evidence, but that this was on the light side, I award costs to the opponent on the following basis:

Official fee: £100

Preparing a statement and considering other side's statement: £200

Preparing evidence: £500

Written submissions: £200

Total: £1,000

69. I order Brecrest Fashion Limited to pay to PETIT BATEAU (société par actions simplifiée) the sum of £1,000 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 24th day of March 2016

**Teresa Perks
For the Registrar
The Comptroller - General**

ANNEX A

