

O-261-17

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3159877
AND THE REQUEST BY NAIYER IQBAL
TO REGISTER THE TRADE MARK**



FOR GOODS IN CLASS 18

AND

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 406973
BY EUROGAL TEXTIL, S.L.**

BACKGROUND AND PLEADINGS

1. On 16 April 2016, Naiyer Iqbal (“the Applicant”) applied to register as a trade mark the figurative mark shown on the front page of this decision, in class 18 for “*Leather bags, hand bags, wallets, purses, rucksack, holdalls, hide, business bags and folios, and leather belts.*”
2. The application was published for opposition purposes in the Trade Marks Journal on 13 May 2016. It is opposed by Eurogal Textil S.L. (“the Opponent”) who owns the following European Union Trade Mark registrations (formerly known as Community trade marks), which in this decision I refer to as Mark A and Mark B:

Mark A:

FLORENTINO

Word mark

Registration No. 3296324

Filed on 31 July 2003

Entered on the register on 2 November 2009

Goods and services in classes 3, 25 and 35

Mark B:



Figurative mark

Registration No. 11695798

Filed on 27 March 2013

Entered on the register on 29 August 2013

Goods and services in classes 3, 14, 18, 25 and 35

3. Full details of the goods and services included in the Opponent’s registration are set out at Annex 1 to this decision and I refer to the most relevant goods and services elsewhere in this decision, notably where I compare the parties’ respective specifications.

4. Section 6(1)(a) of the Trade Marks Act 1994 (“the Act”) defines an “earlier trade mark” as including “a *Community trade mark which has a date of application for registration earlier than that of the trade mark in question ...*” Mark A was filed in 2003 and Mark B in 2013, so both are earlier trade marks under the Act.
5. The Opponent relies in this opposition on all goods and services covered by its earlier trade marks. Since Mark B was not registered for five years or more when the Applicant’s mark was published for opposition, that earlier mark is not subject to the proof of use provisions under section 6A of the Act. Consequently, the Opponent is able to rely on all the goods and services protected by Mark B without having to prove use of that mark.
6. Since Mark A was registered in 2009, that mark is subject to the proof of use provisions under section 6A of the Act and the Opponent has duly provided a statement of use of Mark A in respect of all its goods and services. However, noting that Mark A is not registered for goods in class 18, the Applicant has indicated on its Form TM8 (Notice of defence and counterstatement) that it does not require the Opponent to provide proof of use. Consequently the Opponent is also able to rely on all goods and services under Mark A without having to prove use of that mark. Nonetheless, the Opponent has filed evidence in order to show that it has built up a reputation in the word FLORENTINO in class 25 goods through use both of Mark A and Mark B, which the Opponent describes collectively as “the FLORENTINO Brand.”
7. The Opponent requests that the application be refused in its entirety. The opposition is based on sections 5(2)(b) and 5(3) of the Act.
8. Based on **section 5(2)(b)** of the Act, the Opponent claims that the mark applied for is similar to the Opponent’s earlier trade marks and that the respective goods and services are identical or similar, such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks.
9. Based on **section 5(3)** of the Act, the Opponent claims to have a reputation in Marks A and B, such that use of the mark applied for by the Applicant, would, without due cause,

take unfair advantage of, or be detrimental to the distinctive character or reputation of the Opponent's earlier marks.

10. The Applicant filed a notice of defence and counterstatement in which it points to differences in the respective specifications and between the respective marks, denying that the marks are similar and claiming that there is no likelihood of confusion. The Applicant also filed written submissions in reply to the opposition, where it again denies confusion and states that since its company started trading in 2007, it has itself "*acquired a distinct reputation in leather goods like wallets and bags.*" The Applicant signals a degree of frustration as its submissions state that it has loyal customers who have contributed to a decade of steady growth. Current sales have reached 190, 000 pounds sterling per annum, the company has taken part in over ten leather goods exhibitions, has generated promotional materials and has a website under construction. However, although the submissions state that supporting documents would follow, the Applicant in fact submitted no evidence to support its submissions.
11. The Applicant's submissions as to having acquired a distinct reputation do not in explicit terms claim earlier rights to the mark, but it should anyway be noted that Tribunal Practice Notice 4/2009 makes clear that defences to section 5(2) claims based on the applicant for registration having used the trade mark before an opponent registered its mark are wrong in law. "*Section 5(2) of the Act turns on whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark.*"¹
12. The Applicant represents himself in these proceedings, and the Opponent is represented by Withers & Rogers LLP. Neither party has requested a hearing and I take this decision based on the papers received and taking account of relevant jurisprudence.

¹ See the decision of Ms Anna Carboni, sitting as the Appointed Person in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09.

The Opponent's evidence

13. The Opponent has provided evidence that comprises a witness statement by Florentino CACHEDA, dated 24 October 2016, together with Exhibits ET1 to ET18. Florentino CACHEDA has been the Manager of the Opponent company since 2002 and his witness statement gives an account of the eighteen supporting exhibits, which I summarise below.
14. The Opponent has claimed (in its notice of opposition) to have a reputation in all of the goods and services covered by Marks A and B and the witness statement refers to the reputation built up through use of both marks and reiterates the classes registered. However, the witness statement is said to relate to the reputation for class 25 goods². This appears to narrow the focus of the witness statement, but I take the evidence in the round and where appropriate consider whether, on its face, it may also relate to other goods specified.
15. The witness statement explains that in the UK the Opponent's goods are marketed and sold to trade since the goods are brought to market through retail partners. The Opponent first targeted the UK market under the FLORENTINO Brand in 2010, with "*ambitious plans for expansion*" (Exhibit ET15 is cited in evidence of this).
16. The witness statement gives sales figures under the FLORENTINO Brand in the UK as almost 225, 000 pounds sterling in 2011, peaking in 2013 at just over 285, 000 pounds sterling, and with sales in 2015 of over 185, 000 pounds sterling. Sample invoices are appended at Exhibit ET1 to substantiate these sales figures. Along with the figurative diamond device of Mark B, the word FLORENTINO can be seen at the top of the invoices. The invoices span 2012 – 2016 and include businesses in Northern Ireland and various counties in England and are for various clothing items in amounts ranging up to around 13, 600 pounds sterling. Exhibits ET2 – ET6 show example printouts from the websites of various UK retailers advertising FLORENTINO clothing for sale. No information is provided on market share, but the amounts evidenced strike me as a reasonably significant market presence distributed across the UK.

² Class 25 goods for Mark A are: "*Ready-made clothing (outerwear and underwear), footwear, headgear*" and for Mark B are: "*Ready-made clothing for women and Men; Footwear.*"

17. Exhibits ET7 – ET9 show evidence of FLORENTINO’s attendance at fashion trade shows, including five consecutive years (2010 – 2014) at Moda UK, which is stated to be the UK’s largest fashion trade exhibition, at which well-known, global fashion brands are also represented and attracting 12,000 industry visitors each year. The exhibits include clear display of the FLORENTINO name and Mark B at Moda UK.
18. Exhibit ET10 shows invoices confirming purchase of exhibiting space at Moda UK and evidencing expenditure of over 65,000 pounds sterling advertising the goods to the trade 2011-2014 under the FLORENTINO Brand.
19. Exhibits ET11 – ET13 are brochures for the Opponent’s men’s clothing collections 2014 – 2016. The Opponent claims its reputation is for high quality goods and from the brochures the goods appear targeted at the upper end of the menswear market. Mark B is prominent in the brochures. It is not made clear where, how or to what extent these brochures were circulated, but they are in English and it seems reasonable to infer that such materials would be used as part of marketing the goods to the trade.
20. The witness statement also refers to the Opponent’s paying for advertising in high profile trade and consumer publications. It does not give prices or circulation details but Exhibit ET14 shows a full-page advert (clearly bearing Mark B) placed in *Moda Magazine* in connection with Moda UK 2010. Exhibit ET15 shows another full-page advertisement taken out in January 2010 in *Drapers* magazine (said to be one of the UK’s leading fashion industry magazines). Mark B features prominently in the advert. Exhibit ET15 also includes a short Press editorial piece which trails FLORENTINO’s UK plans. The article describes FLORENTINO as “*a big name in its homeland of Spain ... setting its sights on the European market.*” The witness statement refers to this starting position as making the brand “*well placed to have a significant impact in the United Kingdom, which I consider it has duly had.*” This last statement is not specifically supported, but inferences may be drawn from other exhibits, including those that indicate subsequent sales to UK retailers.
21. The witness statement emphasises the international nature of the fashion industry. As evidence of the international prominence of the FLORENTINO Brand, Exhibit ET16 presents a 2014 article from the Spanish-language version of *Forbes* magazine. Circulation figures are not given, but I recognise *Forbes* as a well-known global publication. Exhibit ET17 presents a 2009 article from the German-language publication

Textil Revue. The extent to which these non-English-language publications can contribute to a reputation in the UK is very limited, but I acknowledge that they evidence a presence in a fashion arena that is international. Finally, Exhibit ET18 shows another article (August 2011) from www.drapersonline.com that again refers to the expansion of the Opponent's brand into the UK.

22. That completes my summary of the evidence filed. Some of the evidence is a little old and of very little or no probative value in establishing a UK reputation (notably some of the Press items). On the other hand there is clear evidence of coverage of the expansion of the Opponent's brand into the UK (under the marks relied on), not insignificant expenditure on promotional activities to key audiences over a number of years and not insignificant levels of sales to widely distributed UK retailers over recent successive years.

DECISION

Claim under section 5(2)(b) of the Act

23. The Opponent's claim is based in part on section 5(2)(b) of the Act, which states:

"... 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."

24. The following decisions of the EU courts provide the principles to be borne in mind when considering section 5(2)(b) of the Act:

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.

25. The principles are that:

- (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 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 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 the respective goods and services

- 26. In its counterstatement, the Applicant points to the breadth of the Opponent's registration, which covers several classes (as detailed in the Annex to this decision). However, the breadth of the Opponent's protection is not a relevant consideration because, as noted above, the Opponent is able to rely on both Mark A and Mark B without proving use. (Insofar as it claims reputation for purposes of section 5(3), the Opponent as I have noted, has focused its evidence on its class 25 goods.)
- 27. The Applicant also makes the following points in its submissions: "*The opponent is primarily involved in selling of shirts, jackets and trousers whereas my company is only involved in the sale of leather goods. We sell men's business portfolio bags, ladies' hand bags, men's wallets. It would seem that the line of business is also distinctly different to that of the trade mark involved in the dispute.*" However, since Mark B had been

registered for less than five years on the publication date of the opposed application, my task of comparing the goods must be made on the basis of notional and fair use of the goods in the parties' respective specifications.³ In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchin L.J. stated that:

"78. the court must ... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered.

*.... it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion."*⁴

28. In considering the extent to which the parties' respective goods may be identical or similar, I find it necessary to compare the Applicant's goods only with the goods and services in the Opponent's registration that are presented in the table at paragraph 34 below. (For the avoidance of doubt, I do not consider the goods registered in classes 3 and 14 to be similar to the Applicant's goods and the majority of services in class 35 offer nothing relevant to my comparison of goods below.) I give the words their natural meaning with neither undue extension nor constraint and I bear in mind the following principles from case law.
29. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, the General Court stated⁵ that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category designated by the trade mark application, or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.

³ Mark B contains the word FLORENTINO, so effectively includes Mark A and moreover, as has been noted, since the Applicant has not put the Opponent to proof of use, the Opponent is able to rely on notional rather than actual use of all the goods and services for which Mark A is registered.

⁴ See also paragraph 66 of the ruling of the Court of Justice of the European Union in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06; and *Oakley v OHIM* (Case T-116/06) states that consideration of likelihood of confusion is not to be restricted to the current marketing or trading patterns of the parties.

⁵ Case T- 133/05 at paragraph 29 of that judgment.

30. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise Nevertheless the principle should not be taken too far 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."

31. I also take account of the factors identified by the Court of Justice of the European Union in *Canon*, Case C-39/97, where at paragraph 23 of its judgment it states that:

"In assessing the similarity of the goods all the relevant factors relating to those goods .. 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".

32. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

33. I also take note that in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court described goods as “complementary” where :

“...there is a close connection between [the goods], 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”.

34. The relevant goods and services are:

Class	Applicant’s goods	Opponent’s goods / services
18	<i>Leather bags, hand bags, wallets, purses, rucksack, holdalls, hide, business bags and folios, and leather belts.</i>	<i>Umbrellas; Handbags; Travelling bags; Briefcases.</i>
25		<i>Mark A: Ready-made clothing (outerwear and underwear), footwear, headgear</i>
25		<i>Mark B: Ready-made clothing for women and Men; Footwear</i>
35		<i>Mark B: Retailing services and sale via global computer networks of ... wallets (leatherware), briefcases (leatherware)</i>

35. The Applicant’s “*hand bags*” are clearly identical to the Opponent’s “Handbags”. Moreover, in line with the principle in *Gérard Meric* I find the Applicant’s “*Leather bags*” to be a general category that readily and commonly includes the Opponent’s “*Handbags; Travelling bags; Briefcases*”. All those goods can therefore be considered identical. I also find that the Applicant’s “*business bags and folios*” include and are therefore identical

to the Opponent's "*briefcases*".⁶ (I understand "*folios*" in the sense of a portfolio, which is the term used in the Applicant's submissions, and is a large, thin case used for carrying drawings, documents, etc.) I further find that the Applicant's specification of "*rucksack, holdalls*" falls within the general category of "*travelling bags*" in the Opponent's registration and those goods are therefore identical.

36. The Applicant's "*wallets, purses*" and the Opponent's "*handbags*" are both used to store and carry daily personal effects, so are similar in physical nature, broad intended purpose and method of use. They are sometimes produced by the same undertakings, tend to be sold in the same retail outlets, often side-by-side and to a large extent the respective users are also the same. I find those goods to be similar to a reasonably high degree. The Opponent's registration in class 35 includes retailing services and sale of "*wallets (leatherware)*", but I find that this does not add significantly to the assessment of similarity of specifications.⁷
37. I find the Applicant's "*leather belts*" to be similar to the Opponent's "*ready-made clothing*" as registered in class 25 for both Mark A and B. The goods are mutually important and complementary in that they are worn together on the body serving both functional and aesthetic purposes, belts holding up clothing like trousers and skirts, or overlaid on dresses or shirts. They therefore have a common broad intended purpose and method of use. They also have the same respective users and are sold in the same retail outlets. I find those goods to be similar to a medium degree.
38. The only remaining item in the Applicant's specification is "*hide*." It is true that various goods in the Opponent's registration (such as bags or footwear) may commonly be made of leather and other forms of hide, but this does not equate to similarity, even in the physical nature of the goods. The average consumer of hide would be an artisan or manufacturer, distinct from a member of the general public at large, so the users are

⁶ I note that the Opponent's registration in class 35 includes retailing services and sale of "*briefcases (leatherware)*", but this adds nothing to the assessment of similarity of specifications.

⁷ As observed by Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person in *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, the criteria for determining whether, when and to what degree services are '*similar*' to goods are not clear cut. The General Court in *Oakley, Inc v OHIM*, Case T-116/06 held that retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and may therefore be similar to a degree; but the same case also highlights clear points of difference between retail services and goods including their nature, purpose and method of use.

different. The channels of trade through which hide is sourced and purchased are also quite distinct from those through which one would buy the other goods of the Applicant, and the goods also differ from hide in purpose and method of use. Consequently, I find no similarity between “hide” in the Applicant’s specification and the Opponent’s registered goods and services.

The average consumer and the purchasing process

39. It is necessary to determine who is the average consumer for the respective goods and services and how the goods and services are likely to be selected.
40. 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 relevant person is a legal construct and ... the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical....”

41. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question (*Lloyd Schuhfabrik Meyer, Case C-342/97*).
42. Most of the Applicant’s goods and the relevant goods of the Opponent are ordinary consumer items and the average consumer is a member of the public. (This is true even where – as is the practice of the parties in this case – the goods may be sold to trade for onward retail.) They are not everyday purchases and I would expect the process of purchasing a bag, belt, wallet and similar to entail at least a normal level of attention, ensuring the goods suits one’s needs, quality and aesthetic requirements.

43. The purchasing act for all goods will be visual as the goods bearing the mark are likely to be seen before purchase, self-selected from shelves in a shop or other outlet or from images on websites or in brochures. However, I do not discount aural considerations which may also play a part, including as word of mouth recommendations, in a shop or elsewhere.

Comparison of the marks

44. It is clear from *Sabel* 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 the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (CJEU) stated in *Bimbo* 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.”
45. It would therefore be wrong to artificially dissect the trade marks, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:
46. The respective trade marks are shown below:

<p>Mark A: FLORENTINO</p> <p>Mark B:</p> 	
<p>Opponent's earlier trade marks</p>	<p>Applicant's contested trade mark</p>

47. The Opponent's Mark A is simply the word FLORENTINO, which therefore comprises the entirety of the overall impression. The Opponent's Mark B is the word FLORENTINO in block capitals centred beneath a vertical rectangle that frames three horizontally oriented diamond shapes stacked atop another. I find that the dominant component contributing to the overall the impression is the word "FLORENTINO." The inclusion of the diamonds device is distinctive and is far from negligible, but since it is much smaller than the memorable and voiceable word "FLORENTINO" I find it secondary to that word, which dominates.
48. The overall impression of the Applicant's mark is that it consists of the word FLORENTINO in block capitals centred beneath an outline impressionistic rendition of a horse's head. I find that the horse head device looms larger in the overall impression than does the diamond device in the Opponent's Mark B. The inclusion of the horse head device is distinctive and very far from negligible, but because the word "FLORENTINO" is not only distinctive and memorable but also voiceable, I find that the latter word component is marginally dominant in the mark, with the device component secondary to that word. I find the words "*fine handmade leathersgoods manufacturer*" that appear beneath the word FLORENTINO to describe the nature of the goods and therefore of little distinctive importance in a trade mark sense. The smaller size of those words and their position within the mark contribute to their taking a subsidiary role overall.

Visual similarity

49. From a visual perspective all three marks share the word FLORENTINO. Since that word represents the entirety of Mark A, and since I find it to be the dominant component in the Applicant's mark (albeit marginally so), I find that Mark A is visually similar to the Applicant's mark to a reasonably high degree.
50. Mark B and the Applicant's mark clearly differ in their devices between the three-diamonds and the horse head respectively, and Mark B includes no secondary descriptive text. Nonetheless, it is clear from the case law (eg *MATRATZEN Concord*) that "*two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects, inter alia the visual, aural and conceptual aspects.*" The marks share the same distinctive word FLORENTINO (which I also consider to be the marginally dominant component) and I find Mark B and the Applicant's mark to be visually similar to a reasonable degree.
51. The Applicant refers to another point of distinction being "*the colour green background with yellowish golden writing and picture.*" I find the colour of the Applicant's mark to be very subtle and I do not think the distinction would strike the average consumer. Moreover, notional use fair use would allow the Opponent to use its Mark A or Mark B in colour, not simply black and white.⁸

Aural similarity

52. I find that it is likely that one would voice only the word FLORENTINO in the Applicant's mark. The horse head device has no aural role and I think it unlikely that the secondary descriptive text would be voiced. Likewise the diamond device in Mark B has no aural role and both Mark A and Mark B would be voiced as FLORENTINO, just as for the Applicant's mark. I see no reason why the pronunciation would not be consistent in all marks and they would likely be spoken as "FLOR – REN – TEE – NO." I find therefore

As Kitchin LJ stated in *Specsavers International Healthcare Ltd & Others v Asda Stores Ltd* [2012] EWCA Civ 24 at [96]: "A mark registered in black and white is, as this court explained in *Phones 4U* [2007] R.P.C. 5, registered in respect of all colours."

that all marks are aurally identical, or, if the secondary text of the Applicant's mark were spoken, the marks are aurally similar to a very high degree.

Conceptual similarity

53. Some may perceive in the word FLORENTINO an allusion to the Italian city of Florence, akin to Florentine, but I find that the average consumer would perceive it to be a word without meaning in the English language. Both parties refer in submissions to the word deriving from a personal name, but that would not strike the average consumer.⁹ I find the conceptual similarity of the marks in this component to be neutral. The device components in the Applicant's mark and in Mark B are clearly different in concept. The former image evokes the concept of a horse's head, the latter perhaps a playing card, but more likely just the concept of three simple diamond shapes framed in a basic pattern. Overall, I do not find the marks to be similar from a conceptual perspective.

Distinctive character of earlier trade marks

54. The distinctive character of the earlier marks must be considered. The more distinctive they are, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

*"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).*

⁹ The Applicant also refers to not being "aware of the name of Florentino when it was incorporated in 2007. Hence, it is very unlikely that the name or the word was copied." This point is not relevant as similarity is an objective assessment, not dependent on copying.

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)."*

55. FLORENTINO is not a standard English word, and since it neither directly describes nor alludes to the relevant goods or services it has a high level of inherent distinctiveness. I am also satisfied that the Opponent's evidence as to use of its mark, which I summarised earlier in this decision, is sufficient to show an enhanced level of distinctiveness in relation to the goods in Class 25, which is already high. I note particularly the evidence as to expenditure on promotional activities to key audiences over a number of years and evidence of reasonable levels of sales to widely distributed UK retailers over successive years.

Conclusion as to likelihood of confusion

56. I now turn to reach a conclusion as to the likelihood of confusion between the marks if they were used in relation to the goods specified.
57. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). Indirect confusion, was considered by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,¹⁰ where he noted that:

¹⁰ Case BL-O/375/10

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case)

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

58. I make a global assessment of likelihood of confusion that takes account of my findings set out in the foregoing sections of this decision and of the various principles from case law outlined in paragraphs 24 and 25 above.

59. In order for there to be a likelihood of confusion, it is necessary that there is at least some similarity between the goods in question.¹¹ Since I have found that there to be no similarity in respect of “hide”, there is no likelihood of confusion to be considered in that regard.
60. I have found that the relevant average consumer for the Applicant’s goods is a member of the public at large who would pay at least a reasonable level of attention when selecting the goods at issue.
61. In comparing the Applicant’s specified goods with the Opponent’s registration, I have found “*Leather bags, hand bags rucksack, holdalls business bags and folios*” to be identical, “*wallets, purses*” to be similar to a reasonably high degree and “*leather belts*” to be similar to a medium degree. I have found that visual considerations tend to predominate in the purchasing process and in comparing the marks I have found that the Applicant’s mark shares a reasonably high degree of visual similarity with Mark A and a reasonable degree of visual similarity with Mark B. I have found the marks to be aurally identical or else similar to a very high degree, but I have found that they are not conceptually similar. Case law shows that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight.¹²
62. I have found that the earlier marks have a high level of inherent distinctiveness, further enhanced by use in relation to the goods in Class 25. I find the word “FLORENTINO” to be distinctive and the dominant component in all marks. I note the point made in *Canon*, as to indirect confusion, that an association between marks such that the public might believe the respective goods or services to come from the same or economically-linked undertakings, produces a likelihood of confusion.
63. Notwithstanding the points of difference acknowledged in this decision, when I weigh in the balance all of the above factors I find in this case that there would be a likelihood of confusion on the part of the relevant UK public as to the origin of the goods at issue

¹¹ See for example paragraph 22 of *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97

¹² See ruling of the General Court in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, at paragraph 49.

(except “hide”). **Consequently, except in relation to “hide”, the opposition succeeds on the basis of s5(2)(b).**

The section 5(3) ground of opposition

64. Section 5(3) states that a trade mark that is similar to an earlier trade mark shall not be registered to the extent that the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.
65. I have already found a likelihood of confusion under section 5(2)(b) in respect of most of the Applicant’s goods. For efficiency I shall therefore consider the section 5(3) claim only in relation to the goods where the Opponent has not already succeeded under section 5(2)(b) – namely “*hide*.”
66. The relevant case law for section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel Corporation*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure*, Case C-487/07 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:
- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
 - (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.
 - (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph
 - (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.
- (h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.
- (i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

67. The conditions of section 5(3) are cumulative. Firstly, it must be shown that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the

relevant public. Secondly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between the marks, in the sense of the earlier marks being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed will occur. A link between the marks does not automatically mean that damage would follow. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. I deal with these elements, so far as is necessary, below.

Reputation

68. The Opponent has claimed a reputation for its mark in relation to all its registered goods and services, but its witness statement seems to narrow the focus to class 25 goods only. In any case, the evidence is richest in relation to that narrower tranche of the registered goods and services.¹³ The Opponent must show a reputation as at 16 April 2016, when the Applicant applied to register its mark.
69. The CJEU in *General Motors* gives guidance on assessing the existence of a reputation. Paragraph 27 of that judgment requires that I:

“...take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

70. I have previously found the Opponent's evidence of use of its marks (for promotional activities and on items sold) to be sufficient to enhance its distinctiveness. (The mark(s) will have been seen at the annual fashion exposition (Moda) and in trade publications and use will have enhanced a mark already possessed of an inherently high degree of

¹³ I note that the Opponent's witness statement refers to “belts” and “leather goods” amongst the sample invoices at Exhibit ET1 and that other exhibits include images of belts bearing the FLORENTINO mark. Exhibits also include images of bags, which are referenced for sale as part of the FLORENTINO collection. However, the evidence is primarily in relation to the goods within class 25 of the Opponent's registration.

distinctiveness.) The guidance in *General Motors* identifies market share as one of the factors in assessing the existence of a reputation. In the present case, the Opponent has provided no evidence as to market share, but I take note of the comments of the General Court in *Farmeco AE Dermokallyntika v OHIM*,¹⁴ where it stated that a finding that an earlier mark had a reputation:

“... is not called into question by the applicant’s argument that the turnover figures for sales and the amount spent on promoting the goods covered by the earlier marks ... have not been proved. It should be pointed out that the absence of figures is not, in itself, capable of calling into question the finding as to reputation. First, the list of factors to be taken into consideration in order to ascertain the reputation of an earlier mark only serve as examples, as all the relevant evidence in the case must be taken into consideration and, second, the other detailed and verifiable evidence produced by the opposing party is already sufficient in itself to prove the reputation of its mark ...”

71. It is, therefore, not necessarily fatal that market share does not form part of the Applicant’s evidence; it depends on what else the Applicant has been able to prove. There is evidence as to use of the mark over time (duration) and of sales with some geographical spread. Exhibit ET10 shows promotional investment of over £65,000 advertising Florentino-branded goods to the trade 2011-2014, via the Moda expo. The Opponent’s Witness Statement shows levels of sales (to trade) in 2015 of below £187,000, sales having been in the region of £285,000 in recent previous years. These figures are not insubstantial, and although the market for clothing is huge, it must be acknowledged that it also consists of many players.
72. On balance, I am prepared to accept the evidence shows enough to sustain a reputation in class 25 goods. The goods are evidenced to be targeted at the upper end of the menswear market and it seems reasonable that the mark(s) may have a reputation among a significant part of the relevant public, particularly if I factor in trade buyers as part of that relevant public.

¹⁴ Case T-131/09 at paragraph 59

Link

73. My assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors, including factors identified in *Case C-252/07 Intel Corporation [2008] ECR I-8823* as follows:
74. *The degree of similarity between the conflicting marks:* I have already considered similarity when considering the section 5(2)(b) claim, and for the purposes of this section 5(3) claim there is at least a reasonable degree of similarity between the conflicting marks.
75. *The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public:* I have already distinguished "hide" in the Applicant's specification from the Opponent's goods and services and found them not to be similar. Hide is a material that will be bought artisans and manufacturers, a section of the public quite distinct from the average consumer of the Opponent's class 25 goods. The channels of trade also differ, sales of hide presumably stemming from tanneries and related outlets.
76. *The strength of the earlier mark's reputation:* there is no express requirement as to the extent of the reputation necessary for section 5(3), beyond it being known to significant part of the public. "Significant" is an imprecise term, but on the evidence in this case I would estimate that in the UK the reputation of the Opponent's marks is not especially strong or extensive, particularly if compared with many other clothing brands.
77. *The degree of the earlier mark's distinctive character, whether inherent or acquired through use:* I have found the Opponent's mark has a high level of inherent distinctiveness, enhanced to some extent for goods in class 25 through promotion and use.
78. *The existence of the likelihood of confusion on the part of the public:* I have already found no likelihood of confusion in relation to "hide" for the purposes of section 5(2)(b).
79. In view of the distance between the goods remaining at issue for section 5(3), the fact that the level of reputation is not particularly strong, and the lack of overlap in the relevant

public, then despite a reasonable degree of similarity between the marks, I do not find that the later mark would the earlier marks bring to mind. Since the necessary link required under section 5(3) is therefore absent, it is unnecessary for me to proceed to consider whether any of the three types of damage claimed by the Opponent arise. **The Opponent’s claim under section 5(3) fails** (insofar as I have considered it in relation to “hide”).

Costs

80. The Opponent has been largely successful in its section 5(2)(b) claim and is entitled to a contribution towards its costs, which I assess based on the guidance in Tribunal Practice Notice 2/2016. I award the Opponent the sum of £810 (eight hundred and ten pounds) as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Reimbursement of the official fee for Notice of Opposition and Statement of Grounds:	£200
Preparing a statement of grounds and considering the other side’s statement:	£100
Preparation of evidence and considering the other side’s written submissions in lieu of oral hearing:	£600
Reduction by 10% to reflect Applicant’s entitlement to register “hide”	£90
Total:	£810

81. I therefore order Naiyer Iqbal to pay Eurogal Textil S.L. the sum of £810 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 2ND day of June 2017

Matthew Williams
For the Registrar, the Comptroller-General

Annex:

Full list of goods and services under the Opponent's earlier marks

Mark A: Word mark "FLORENTINO" Registration No. 3296324:

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

Class 18: *Umbrellas; Handbags; Travelling bags; Briefcases.*

Class 25: *Ready-made clothing (outerwear and underwear), footwear, headgear*

Class 35: *Publicity; business management; business administration; office functions; import and export; retail store services; commercial retailing via global computer networks*

Mark B: Figurative mark Registration No. 11695798:

- Class 3:** Fragrances for men.
- Class 14:** Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; Jewellery, precious stones; Horological and chronometric instruments; Ornaments [jewellery, jewelry (Am.)]; Ornaments of jet; Shoe ornaments of precious metal; Hat ornaments of precious metal; Agates; Clock hands [clock and watch making]; Alloys of precious metal; Pins [jewellery, jewelry (Am.)]; Ornamental pins; Amulets [jewellery, jewelry (Am.)]; Anchors [clock and watch making]; Rings [jewellery, jewelry (Am.)]; Earrings; Works of art of precious metal; Jet, unwrought or semi-wrought; Brooches [jewellery, jewelry (Am.)]; Busts of precious metal; Chains [jewellery, jewelry (Am.)]; Watch chains; Boxes of [jewellery, jewelry (Am.)]; Watch glasses; Chronographs [watches]; Chronometrical instruments; Chronometers; Stopwatches; Chronoscopes; Beads for making jewelry; Alarm clocks; Diamonds; Charms [jewellery, jewelry (Am.)]; Dials [clock and watch making]; Spinel [precious stones]; Statues of precious metal; Statuettes of precious metal; Paste jewellery; Cases for clock- and watchmaking; Cases for watches [presentation]; Copper tokens; Tie pins; Cuff links; Wire of precious metal [jewellery, jewelry (Am.)]; Badges of precious metal; Iridium; Jewelry of yellow amber; Cloisonné jewellery [jewelry (Am.)]; Jewelry; Jewelry cases [caskets]; Ingots of precious metals; Key rings [trinkets or fobs];

Clockworks; Ivory [jewellery, jewelry (Am.)]; Movements for clocks and watches; Medals; Locketts [jewellery, jewelry (Am.)]; Precious metals, unwrought or semi-wrought; Coins; Watch springs; Olivine [gems]; Gold, unwrought or beaten; Gold thread [jewellery, jewelry (Am.)]; Osmium; Palladium; Pendulums [clock and watch making]; Pearls [jewellery, jewelry (Am.)]; Pearls made of ambroid [pressed amber]; Precious stones; Semi-precious stones; Silver, unwrought or beaten; Spun silver [silver wire]; Silver thread; Platinum [metal]; Bracelets [jewellery, jewelry (Am.)]; Watch bands; Watches; Atomic clocks; Watch cases; Clocks; Wristwatches; Sundials; Clocks and watches, electric; Master clocks; Rhodium; Ruthenium; Tie clips; Barrels [clock and watch making].

Class 18:

Umbrellas; Handbags; Travelling bags; Briefcases; Briefcases.

Class 25:

Ready-made clothing for women and Men; Footwear.

Class 35:

Retailing services and sale via global computer networks of fragrances for clothing for men and men, of footwear and fashion accessories.