

O/263/19

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1332180

AND THE REQUEST

BY

CASABLANCA EVENTS ET ANIMATION

TO PROTECT THE FOLLOWING TRADE MARK IN THE UK



AND

THE OPPOSITION UNDER NUMBER 410119 THERETO

BY

WE BRAND S.A.R.L

Background and Pleadings

1. CASABLANCA EVENTS ET ANIMATION (the Holder) applied to protect the International Trade Mark in the UK as shown on the front cover page on 2 March 2017 under number 1332180. The Holder claims a priority date of 26 September 2016 based on its Moroccan trade mark number 17810. The designation includes the colour claim blue and black. It was accepted and published in the UK Trade Marks Journal on 30 June 2017 for goods and services in classes 6, 9, 11,12,14,16,18, 21, 24, 25, 28, 35, 38, 39 and 41 as outlined below:

Class 6: Common metals and their alloys; building materials of metal; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of metal; ironmongery and small items of metal hardware; pipes of metal; safes; ores.

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic recording media, sound recording disks; compact disks, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; software; fire-extinguishing apparatus.

Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

Class 12: Vehicles; apparatus for locomotion by land, air or water.

Class 14: Precious metals and their alloys; jewelry, precious stones; timepieces and chronometric instruments.

Class 16: Paper, cardboard; printing products; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paintbrushes; typewriters and office requisites (except furniture); instructional or teaching material (except apparatus); plastic materials for packaging (not included in other classes); printing type; printing blocks.

Class 18: Leather and imitation leather; animal skins; trunks and suitcases; umbrellas and parasols; walking sticks; whips, harness and saddler¹.

Class 21: Utensils and containers for household or kitchen use; combs and sponges; brushes (except paintbrushes); brush-making materials; articles for cleaning purposes; steel wool; unworked or semi-worked glass (except building glass); glassware, porcelain and earthenware not included in other classes.

Class 24: Fabrics and textiles; bed throws; table covers

Class 25: Clothing, footwear, headgear.

Class 28: Games, toys; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

¹ I will consider this to be a typographical error and for the purposes of this decision proceed as if it should read "harnesses and saddles".

Class 35: Advertising; commercial business management; commercial administration; office functions.

Class 38: Telecommunications.

Class 39: Transport; packaging and storage of goods; travel organization.

Class 41: Education; training; entertainment; sporting and cultural activities.

2. WE BRAND S.A.R.L. (the Opponent) opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (the Act) relying on the following three marks:

MARK 1: European Union Trade mark (EUTM) EU 960021 for the mark **WE** which was filed on 19 October 1998 and registered on 16 July 2007. The Opponent relies on all its goods in classes 3, 18, 24, 25 and 26 listed below:

Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks.

Class 24: Textiles and textile goods, not included in other classes; blankets and travelling rugs.

Class 25: Clothing, footwear, headgear.


Class 26: Ribbons and braids; buttons, hooks and eyes, pins and needles.

MARK 2: EUTM 11312667 for the mark **WE** which was filed on the 1 November 2012 and registered on 1 April 2013. The Opponent relies on all its goods and services in class 9, 14 and 35 listed below.

Class 9: Spectacles including sunglasses; spectacle frames; cases and containers for spectacles.

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 including watches.

Class 35: Advertising; business management; business administration; office functions; retail business services and the bringing together of cosmetics, perfumery, glasses, jewellery, leather products, clothing and clothing accessories and shoes, for the benefit of third parties in order to give consumers the possibility to examine and buy these products; sale promotion; business mediation in the purchase and sale of products; business mediation services in the trading of products to wholesalers; office functions in the field of drafting and closing of franchise agreements regarding the before mentioned services; the aforesaid services also offered via electronic channels, including the Internet.

MARK 3: International Registration (IR) EUTM 1213402 for the mark  which designated the EU for protection on 20 May 2014 and on which protection was conferred on 23 June 2015. The Opponent relies on all its goods and services in classes 18, 25 and 35 as set out below:

Class 18: Leather and imitation leather; leather handbags, wallets, purses and briefcases; umbrellas and parasols; trunks and traveling bags; bags

Class 25: Clothing, footwear, headgear, bonnets, hats and caps; belts.

Class 35: Advertising; business management; business administration; administrative services; retail business services relating to, and the bringing together (excluding transport) of products made of leather, clothing, clothing accessories, footwear and headgear for third parties in order to enable consumers to view and buy these products; sales promotion; business mediation in the purchase and sale of products; mediation in commercial matters in the marketing of products in the context of the services of wholesalers; administrative services in connection with preparing and concluding of franchise agreements relating to the aforesaid services; the aforesaid services also provided via electronic channels, including the internet.

3. The Opponent argues that the respective goods and services are identical or similar and that the marks are similar.

4. The Holder filed a defence and counterstatement denying the grounds of opposition and refuting that the marks are similar, requesting that the Opponent provide proof of

use of its first earlier mark relied upon namely EU 960021. In its written submissions it challenged the Opponent's evidence submitting that it "does not clearly demonstrate that the first mark has been genuinely or extensively used in the EU during the relevant period."

5. In these proceedings the Opponent is represented by Nucleus IP Limited and the Holder by Bird & Bird. Only the Opponent filed evidence by way of the witness statement of Benoit Nasr dated 22 August 2018 which was accompanied by written submissions dated 24 August 2018. Neither party requested a hearing and only the Holder filed submissions in lieu of a hearing dated the 4 February 2019. I have considered both parties submissions and the Opponent's evidence in my deliberations and shall refer to them where necessary.

The evidence

6. The Opponent's evidence consists of a witness statement from Mr Benoit Nasr. He is the manager of WE Brand S.a.r.l. a position he has held since 16 August 2014. He states that EUTM 960021 in its stylised form was first used in the EU as early as 1999. Mr Nasr states that during the relevant period which he calculates as between 30 June 2012 and 30 June 2017 the mark was used extensively and continuously in Belgium, Netherlands, Luxembourg, France, Austria and Germany for the following goods:

- Class 3: Perfumes.
- Class 18: All kinds of bags, rucksacks, leather products, wallets;
- Class 24: Textiles and textile goods, not included in other classes, blankets and travelling rugs;
- Class 25: Clothing, footwear, headgear;

Class 26: Ribbons and braids buttons, hooks and eyes, pins and needles.

7. Mr Nasr states that the total value of the goods provided in the EU under the mark during the relevant period is in excess of €1.6 billion and that the annual value of the goods provided under the mark are set out as follows:

- Feb 2012 - Jan 2013: € 285 millions
- Feb 2013 - Jan 2014: € 285 millions
- Feb 2014 - Jan 2015: € 270 millions
- Feb 2015 - Jan 2016: € 270 millions
- Feb 2016 - Jan 2017: € 270 millions
- Feb 2017 - Jan 2018: € 270 millions

8. Mr Nasr continues that the trademark has been promoted throughout the EU by way of magazine spreads, outdoor media, instore advertising, online advertisements on their website and on third party sites, via their WE FASHION app, blogs, editorial spreads, printed material, press releases, TV advertisements and via the loyalty program WE IS ME.

9. Mr Nasr exhibits at BN1 what is described as examples of “campaign visuals/ advertisements” and “exposure via the EU press and online” which display the WE trademark in its stylised form.

10. The company spends in excess of €45.7 million on advertising to promote the trademark in the EU which Mr Nasr breaks down as follows between 2011 and 2017:

- 2011: € 7.1 millions
- 2012: € 7.4 millions
- 2013: € 6.8 millions
- 2014: € 7.9 millions
- 2015: € 7.0 millions
- 2016: € 7.6 millions
- 2017: € 9.0 millions

11. It is noted, however that none of the figures provided by Mr Nasr are broken down to particularise the income derived from sales of each of the categories as pleaded, nor are there any specific figures demonstrating the breakdown for advertising and promoting each division of the business.

12. Mr Nasr concludes that the evidence filed demonstrates that the company has used the mark during the relevant period in relation to the aforementioned goods under classes 3, 18, 24, 25 and 26. He states that the mark has acquired a significant reputation and goodwill in the EU and an enhanced distinctiveness for the said goods.

Proof of Use

13. In these proceedings, the Opponent is relying upon its EU registrations shown above, which qualify as earlier trade marks under section 6 of the Act. As its second and third earlier marks have been registered (or protection conferred) within the five-year period ending on the date of publication of the Holder's mark designating the UK, they are not subject to the proof of use provisions contained in section 6A of the Act. Consequently, the Opponent is entitled to rely upon all the goods and services of its registrations under these marks without having to establish genuine use. In relation to mark one however the mark had been registered for more than five years ending on

the date of publication of the Holder's mark designating the UK and therefore it is subject to the proof of use provisions.

14. Ordinarily for the Opponent to rely upon the first mark it must meet the use conditions for each and every class it intends to rely on. I note however that for its goods in classes 18 and 25 (with the exception of walking sticks and goods made of leather and imitation leather) these are covered by its third earlier mark which is not subject to proof of use. The Holder concedes that it does not require the Opponent to prove use in relation to these goods. Consequently, it is only necessary for me to consider whether or to what extent the Opponent has shown genuine use of its first mark in relation to its goods in classes 3, 24 and 26 and in relation to "*walking sticks*" and "*goods made of leather/imitation leather*" in class 18 at this stage. If reliance on its first mark, for the whole of its specified goods in classes 18 and 25, is critical to my decision I will formally consider if the use conditions are met for these goods later in my decision.

15. The relevant provisions regarding Proof of Use are set out 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 European Union 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 Union.

(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.”

16. Section 100 of the Act is also relevant it states that:

“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.”

17. Accordingly, under section 6A(3)(a) of the Act the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the later mark’s designation in the UK. Consequently, the relevant period is 1 July 2012 to 30 June 2017.

18. What constitutes genuine use has been subject to a number of judgements. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J. summarised the law relating to genuine use as follows:

“114.....The Court of Justice of the European Union (CJEU) has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29];

Centrotherm at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

19. As the first earlier mark is an EUTM, the comments of the CJEU in *Leno Marken BV v Hagelkruis Beheer BV*, Case C-149/11 are relevant. The court noted 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.”

....

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.”

...

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).”

20. 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."

21. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, 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."

22. The GC restated its interpretation of *Leno Merken* 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 what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union. On the basis of the above caselaw therefore it is not a requirement to demonstrate use in the UK as it is sufficient to demonstrate use within the community area.

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

- a. The scale and frequency of the use shown
- b. The nature of the use shown
- c. The goods and services for which use has been shown
- d. The nature of those goods/services and the market(s) for them
- e. The geographical extent of the use shown

24. Use does not need to be quantitatively significant in order to be genuine, however, proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the [European Union] market for the goods or services protected by the mark” is not genuine use.

25. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is

nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

26. I also note Mr Alexander’s comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14). He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round- or lose it”” [original emphasis].

27. If any question arises in UK proceedings as to the use to which a EU registered trade mark has been put, it is for the proprietor to show what use has been made of the mark. Therefore, an Opponent wishing to rely on its mark must first of all prove the use which has been made of it during the relevant period.

28. It is clear from the guidance that a number of factors must be considered when assessing whether genuine use of the mark has been demonstrated by the evidence filed. The responsibility is on the appropriate party, in this case the Opponent, to provide sufficiently solid evidence to counter the application, a task which should be relatively easy to attain.² An assessment of genuine use is a global assessment,

² Awareness Limited v Plymouth City Council, Case BL O/236/13

which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself³.

29. The evidence consists of a brief statement from Mr Nasr's and one exhibit containing 235 pages. The exhibit referred to by Mr Nasr comes from a range of sources including fashion magazines and screen shots from websites. They are divided into bundles headed "Best Clippings 2013/2014/2015/2016", "Stills", "Shoots", "Editorial", "Online", "Kids", "Events", "TV/Celebrities" "Influencers", "Outdoor" and "Roamler". I have reproduced a selection below for illustration purposes:

i. BEST CLIPPING 2013



Best Clipping 2013

³ Case T-415/09, New Yorker SHK Jeans GmbH & Co KG v OHIM, GC

ii. STILLS



Editorial value: 655

Date: 01-07-13



Editorial value: 3.586

Date: 02-03-13

iii. ONLINE

Deelredag 19 december 2013. Het laatste nieuws het eerst op NU.nl

Lifestyle

Voorpagina
Met binnen
Algemeen
Jaaroverzicht
Economie
Beurs
Sport
Tech
Achtstap
Opmerkelijk
Cultuur en Media
Wetenschap
Gezondheid
Lifestyle
Auto
NUfoto
Datblog
Redactieblog
Waar
BI Verkeer
NU.nl-apps
Cafe.nl

Gepubliceerd: 30 maart 2013 09:44
Laatste update: 30 maart 2013 14:01

Deel 8+1

WE Fashion recyclet kleding

Vanaf augustus verkoopt de winkelketen WE Fashion kleding die is gemaakt van oude, afgedankte kleding. De verlopen kleren worden sinds een jaar in de winkels van de keten verzameld.

Een jaar geleden startte de keten onder de noemer WE Recycle met het verzamelen van afgedankte kleding in haar Nederlandse winkels. In augustus introduceert de moderatier de eerste twee producten die gemaakt zijn met vazen van gedragen kleding.

De keten werkt bij dit project samen met Recycle-Movement (RE-MO), innovatiecentrum Texperim en Agenticap NL. Het project is een eerste stap naar het volledig recyclen van producten, waarmee de keten wil bijdragen aan een beter milieu.

Creativiteit

'Samen met RE-MO laten wij zien dat je met een beetje creativiteit en anders denken over het productieproces hele mooie nieuwe kleding kunt maken. Op deze manier proberen wij het milieu minder en zoogen we ervoor dat hoogwaardige kledingrecycling niet verloren gaat in minderwaardige producten, zoals bijvoorbeeld kledingmaterialen of, nog erger, in de vulverbranding terecht komen', aldus Wouter Kok, CEO van de keten.

De twee gerecycledeledingstukken, een trui en een vest voor mannen, zullen te koop zijn in winkels van de keten in Nederland, België, Frankrijk, Duitsland, Oostenrijk en Zwitserland.

Door NU.nl Hans Blaasmaert

Editorial value: 60.824 Date: 31-03-13

Esquire
voor de elite

De nieuwste manier om te zien te worden. Het is niet alleen de manier om te worden, maar de manier om te worden.

STYLING: LONNIE, AUTOS: VINCENZO, SHIRT: BIRKENHEAD, JEANS: CIPRIANO, HOSIËRIJ: BOUTIQUE, SHIRT: BIRKENHEAD, JEANS: CIPRIANO, HOSIËRIJ: BOUTIQUE, SHIRT: BIRKENHEAD, JEANS: CIPRIANO, HOSIËRIJ: BOUTIQUE

De nieuwste manier om te zien te worden. Het is niet alleen de manier om te worden, maar de manier om te worden.

Feestdagencollectie van WE en Van Gils

Speciaal voor de feestdagen presentiert WE een exclusieve collectie, bestaande uit twee pakken, shirts, vesten en een jas, ontworpen door het Nederlandse modehuis Van Gils.

De samenwerking valt binnen de WE & Friends collectie, waarmee WE regelmatig een samenwerking aangaan met internationale designers, designers, in de vorm van.

De collectie bestaat uit pakjes die zijn ontworpen door de Nederlandse designer van WE, maar ook met andere designers. De WE & Friends collectie wordt ook wel de WE & Friends collectie genoemd. De WE & Friends collectie wordt ook wel de WE & Friends collectie genoemd.

De collectie bestaat uit pakjes die zijn ontworpen door de Nederlandse designer van WE, maar ook met andere designers. De WE & Friends collectie wordt ook wel de WE & Friends collectie genoemd.

Editorial value: 6.721 Date: 01-12-13

LINDA NIEUWS .NL

LINDA.MODE

WE Fashion - WE Live Summer



Inspiratie voor een nieuwe zomerklare kledingkast

Het is de winter defibrilator voorbij is en het zonnetje zich steeds vaker laat zien, heeft iedereen ook weer zin in de aankomende zomer. En daar hoort natuurlijk ook een nieuwe trousse kledingkast bij. Dus haal die bezem door je garderobe.

Het is het altijd ligt om wat wijze raai op te doen. Daarom geven wij je een voorbeeld van de nieuwe zomercollectie van WE: WE Live Summer. Laas je inspireren.

WIKAS maakt LINDA mode met

vroegst, 11 april 2014 - Auteur: Marthe Schel

LEZEN • DELEN •

1

Editorial value: € 1.924	Date: 11-04-14
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iv. EVENTS

LIFESTYLEMAGAZINES



IN WE AT WE

LOUIS VUITTON

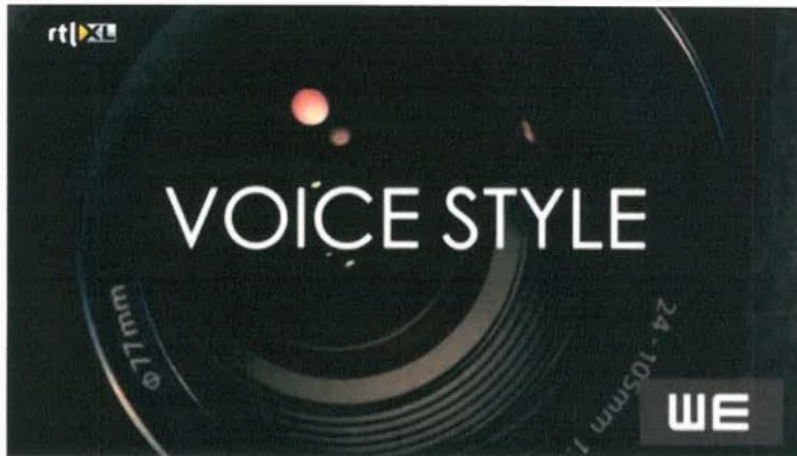
AMERICAN EXPRESS

Editorial value: 384	Date: 18-05-13
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2

v. TELEVISION

THE VOICE KIDS



Rozemarijn, de WE Fashion Reporter, neemt jou mee backstage bij de styling. Wat dragen de finalisten en hebben de stylisten nog fashion tips?

Editorial value: € 29.991

Date: 01-02-2014

vi. CELEBRITY



Dolan

vii. INFLUENCERS



143

TV Clipping Zondag met Lubach Date: 10 januari 2016

viii. OUTDOOR



227

ix. ROAMLER

Wednesday, October 12th, 2011, 10:16 / Voorstraat 1, Utrecht

Zo ziet het WE Fashion steigerdoek eruit.

Maak een foto van het WE Fashion steigerdoek inclusief omgeving. Wees zo creatief mogelijk. Let op, een simpele foto van het doek wordt dus niet goedgekeurd.



Wat zijn de eerste drie woorden die je te binnen schieten als je denkt aan WE Fashion?

Man, vrouw en betaalbaar

Waarom noem je deze drie woorden?

Het was vroeger een HE en SHE, maar nu is het samen. En ik zie de WE niet als heel goetkoop, maar wel als betaalbaar.

Zo ziet het WE Fashion steigerdoek eruit.

Maak een foto van het WE Fashion steigerdoek inclusief omgeving. Wees zo creatief mogelijk. Let op, een simpele foto van het doek wordt dus niet goedgekeurd.



Wat zijn de eerste drie woorden die je te binnen schieten als je denkt aan WE Fashion?

Kyssi, stijlvol, betaalbaar

Waarom noem je deze drie woorden?

Kyssi, omdat zij momenteel onderdeel is van de campagne. Stijlvol en betaalbaar spreken denk ik voor zich.



Wednesday, October 12th, 2011, 19:19 / Leidsestraat 86, Amsterdam

Zo ziet het WE Fashion steigerdoek eruit.

Maak een foto van het WE Fashion steigerdoek inclusief omgeving. Wees zo creatief mogelijk. Let op, een simpele foto van het doek wordt dus niet goedgekeurd.



Wat zijn de eerste drie woorden die je te binnen schieten als je denkt aan WE Fashion?

Let op de visuur op de foto is de lamp aan het verwissenen. 3 woorden: trendy, modern, creatief

Waarom noem je deze drie woorden?

Omdat ze wel altijd leuke kleding hebben die meegaat met de mode. Ze kunt er altijd iets apart vinden

233



234

30. The Holder filed lengthy submissions regarding the Opponent's evidence and in short challenged the extent and quality of the evidence as being insufficient to adequately demonstrate use of its first mark.

31. At the outset I must point out that there are a number of deficiencies in the evidence filed. It is clear from the decisions in *Awareness Plymouth* and *Gucci* that the onus is on the Opponent to put forward its best evidence and Mr Nasr, in his capacity as the company's manager, would be in the best position to do so.

32. Generally, a large proportion of the prints are illegible and only a small number show the first mark in its registered form. What can be read are taken from print outs of fashion shoots/magazines which mainly display various items of clothing and footwear attributed to the mark in various formats for example WE, WE Fashion, WE Kids, WE MEN, HE+SHE+WE and www.wefashion.com. None of the prints display the mark on the items of clothing or footwear themselves and at best what has been filed would in my view amount to use in relation to retail services as it is unclear whether the goods themselves are theirs or whether they are selling other people's goods through the website or in their retail outlets. Most of the images themselves are undated save for the addition of "editorial values and dates" overlaid in a box inserted at the bottom of some of the pages. Since there is no commentary, narrative or explanation provided it is hard to determine what these print-outs are purporting to show. In addition, no translation has been provided for any of the print-outs/articles. A number of documents appear to be outside the relevant period, for example, the Press France Report. Whilst I accept the Holder's submissions regarding this evidence, for the most part it relates to goods in classes 18 and 25 for which the Holder does not necessarily require proof of use, as explained earlier.

33. There is no cross reference between the printouts within the exhibit and any of the figures contained in Mr Nasr's statement. There is no indication of the turnover generated by the sales of the goods; merely general figures of the "value of the goods

provided under the trademark”. It is not clear to me what Mr Nasr means by this statement and whether he means value of the stock, sales, profit, cost or turnover. There is no specific financial breakdown as to how much is apportioned to each category of goods and therefore it is difficult to assess whether there has been any use of the mark for the items relied upon even when taking a global approach to the evidence as a whole. It is not for me to speculate as to how much of the “annual value of the goods” is attributable to each item nor is it a matter for me to interpret the documents filed without explanation from the witness as to what they mean. No accounts, invoices or sales figures broken down by category are produced. The absence of any breakdown means there is no way for me to determine with any precision the level of sales attributable to each item.

34. I am mindful of the decision in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, where Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in

the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

35. I take account of the decision on appeal in *Palmerwheeler Ltd v Prnnet* – BL-O/484/13 (AP) where Amanda Michaels sitting as the Appointed Person, considered the position regarding evidence which failed to indicate which exhibits were relied upon in support of which parts of the specifications. She upheld the hearing officer’s decision that he had not applied a higher standard of proof than was appropriate. She held that the witness statement had made broad claims to use, which was not supported when read with the exhibits and which did not provide cogent proof of use across the range of goods and services claimed by the Registered Proprietor. Ms Michaels reaffirmed the position in *Awareness Plymouth* namely that the onus is on the Proprietor to file sufficiently solid evidence. In the case before me, for whatever reason, the Opponent has chosen not to file cogent evidence or to provide sufficiently clear readable copies or sufficient explanation to what has been filed. I can only assess the matter on what is before me.

36. In relation to the Opponent's goods in class 3 and in particular perfume, I can only see three pages of the Opponent's exhibit which makes reference to perfume; namely pages 111, 113 and 122 reproduced below:

Page 111



Editorial value: € 1620 Date: 18 november 2015

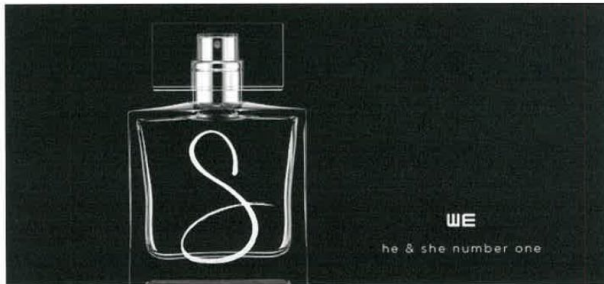
Page 113



113 Editorial value: € 1785 Date: 1 november 2015

THE *New Girl* IN TOWN
THE NEW GIRL IN TOWN

WE FASHION LANCEERT PARFUM VOOR MANNEN EN
VROUWEN



Editorial value: € 384

Date: 11 november 2015

37. Page 111 shows a picture of a perfume bottle attributed to HE+SHE+WE in Grazia magazine with the 18 November 2015 being attributed as the date of the article. No price is displayed in any currency and the first mark is not displayed on the bottle itself. The print quality of page 113 is so poor that only a very faint outline of what looks like a perfume bottle can be seen and the mark WE is barely visible in the narrative underneath the number “3”. Page 122 shows a bottle of perfume with a stylised S on the front, with the mark “WE” displayed on the right-hand side and the slogan “he & she number one” underneath. The print out is headed “The New Girl In TOWN” and “WE FASHION LANCEERT PARFUM VOOR MANNEN EN VROUWEN”. No explanation has been included regarding this page but to my mind it looks like a magazine advertisement for perfume attributed to the mark. Other than these 3 pages there is no other reference to perfume within the evidence. No financial figures are provided apportioning any sales or advertising expenditure to perfume and there is no reference to perfume in the Press France Report at page 176 (even if there had been as I mentioned earlier the report was prepared outside the relevant period and therefore would be of little evidential value). Leaving the variation of use of the mark in relation to page 111 to one side, even if these three

pages were legible, in my view without any additional evidence they would be insufficient by themselves to demonstrate use of the mark for perfume. The generality of the statement and the poor quality of the print-outs are of such limited value that I am unable to find it is sufficient to have created or maintained a share in the market for perfume which is a very large market.

38. As the Opponent's third mark does not include "goods made of leather and imitations of leather" I must consider whether the Opponent has demonstrated use in relation to these goods. As far as I can see from the evidence the only reference to leather goods is at page 163 where leather footwear is attributed to WE MEN. The Press France Report makes reference to belts of various colours, a leather jacket and a grey bag but as previously noted this report is outside the relevant period. For these reasons the Opponent in my view has failed to demonstrate use for goods made of leather or imitation leather the result of which is that it is unable to rely on these items in its opposition.

39. In relation to the Opponent's Soaps; Essential oils; Cosmetics; Hair lotions; Dentifrices; Walking sticks; Textiles and textile goods; blankets and travelling rugs; Ribbons and braids; Buttons, hooks and eyes, pins and needles in classes 3, 18, 24 and 26, I cannot find any reference at all to any of these goods within Mr Nasr's statement. There is nothing that I can categorically point to that demonstrates, even at a base level, that the mark has been put to actual use in relation to these goods.

40. On the basis of my assessment, the Opponent is unable to rely on the first mark in relation to the following goods in its opposition:

- Class 3: Soaps; Perfumes; Essential oils; Cosmetics; Hair lotions; Dentifrices.
- Class 18: Walking sticks; goods made of leather or imitation leather.
- Class 24: Textiles/textile goods; blankets and travelling rugs.
- Class 26: Ribbons and braids; Buttons, hooks and eyes, pins and needles.

41. In relation to the first mark's goods in classes 18 and 25 there is an overlap with Mark 3. Whilst I accept that Mark 1 is the nearest to the Holder's mark in terms of the mark and the goods, it is subject to proof of use, however the Holder has conceded that it does not require it to demonstrate use in relation to those goods that overlap with Mark 3.

Decision section 5(2)(b)

42. The opposition is based upon section 5(2)(b) of the Act which states:

“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”.

43. 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.

The principles:

(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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods and services

44. The Opponent submits that the “goods and services of the mark applied for are all identical or similar to the goods and services cover by the Opponent’s earlier rights.”

[sic]

45. The Holder submits that “there is not any relevant arguable similarity for any of the goods or services applied for in classes 6,11,12, 16, 21, 28, 38 and 41, or for most of the goods in class 9 and some of the goods in class 18.” The Holder concedes that there is identity with large parts of the respective goods /services in classes 14, 24, 25 and 35 and some of the goods in classes 9 and 18. It argues that since the Opponent has not shown use in relation to its class 24 goods that it is unable to rely on this specification.

46. When conducting a goods and services comparison, I am mindful of the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc Case C-39/97*, where the court stated at paragraph 23 of its judgment that:

“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”.

47. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

(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.

48. In addition, in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

49. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T- 133/05, the General Court (GC) stated that even if goods or services are not

identically worded they can still be considered identical if one term is encompassed within another broader term and vice versa:

“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 für 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”.

50. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) warned against construing specifications for services too widely, stating that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase”.

51. Taking into account my earlier assessment as to what goods the Opponent is able to rely upon, I note that there is no overlap between the Opponent’s goods in classes 3 and 26 and therefore I need not include these goods in my analysis. In relation to the remaining goods I found that the Opponent has not demonstrated use of its first mark in relation to goods in class 24 or “*walking sticks*” and “*goods made of leather/imitation leather*” in class 18 and therefore it is unable to rely on these in its opposition. This effectively leaves the comparison on its goods and services in classes 9, 14, 18 (except for the aforementioned goods), 25 and 35.

52. Taking into account the above caselaw the following goods and services are identical.

Opponent's Marks	Holder's mark
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 including watches. (Mark 2)	Class 14: Precious metals and their alloys; jewelry, precious stones; timepieces and chronometric instruments.
Class 18: Leather and imitation leather; leather handbags, wallets, purses and briefcases; umbrellas and parasols; trunks and traveling bags; bags. (Mark 1 and Mark 3)	Class 18: Leather and imitation leather; animal skins; trunks and suitcases; umbrellas and parasols;
Class 25: Clothing, footwear, headgear, bonnets, hats and caps; belts. (Mark 1 and Mark 3)	Class 25: Clothing, footwear, headgear.
Class 35: Advertising; business management; business administration; administrative services; office functions; (Mark 3)	Class 35: Advertising; commercial business management; commercial administration; office functions.

53. The contested “*Whips, harnesses and saddles*” in class 18 are all equestrian goods that may be made of leather or imitation leather. However, taking into account the decision in *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

54. Since “*whips, harnesses and saddles*” will be considered to be finished articles and “*leather or imitation leather*” are the raw materials from which the goods are made I do not consider them to share method of use, nature, distribution channels or the same end consumer. To say that they are complementary is too far removed from the core purpose of the goods in question. There is no similarity between these goods.

55. However, I need to consider the matter further and whether there is any similarity with “*whips, harnesses and saddles*” in class 18 and the Opponent’s retail services for leather products in class 35 for its second mark.

56. I take into consideration the decision in *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services compared to goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for

the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

57. There is some degree of connectivity between "*whips, harnesses and saddles*" and "*retail business services and the bringing together of leather products for the benefit of third parties in order to give consumers the possibility to examine and buy these products;*" The goods and services are closely related, they share trade channels and are complementary. Whips, harnesses and saddles are all leather products and therefore the average consumer would consider that the retailing services for these goods would originate from the same undertaking as the actual goods. Therefore, I consider there to be a medium degree of similarity between them.

58. The contested "*optical apparatus and instruments*" in class 9 would in my view be regarded as optical devices and on this basis, I consider them to encompass "*spectacles*" and therefore are identical on the basis of *Meric*.

59. In relation to the remaining contested goods/services in order for there to be a likelihood of confusion between the marks it is essential for there to be identity or similarity between the goods or services. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that (my emphasis):

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be

shown. **If there is no similarity at all, there is no likelihood of confusion to be considered.** If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

60. I find the remaining contested goods and services are dissimilar in that I see no obvious similarity between them. The goods and services belong in different markets and could not compete with one another. There is no complementarity between them where one could be used or was indispensable to the other so that consumers would think that the same or linked undertakings were responsible.

Class 6: Common metals and their alloys; building materials of metal; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of metal; ironmongery and small items of metal hardware; pipes of metal; safes; ores.

Class 9: Scientific, nautical, surveying, photographic, cinematographic, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic recording media, sound recording disks; compact disks, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; software; fire-extinguishing apparatus.

Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

Class 12: Vehicles; apparatus for locomotion by land, air or water.

Class 16: Paper, cardboard; printing products; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paintbrushes; typewriters and office requisites (except furniture); instructional or teaching material (except apparatus); plastic materials for packaging (not included in other classes); printing type; printing blocks.

Class 21: Utensils and containers for household or kitchen use; combs and sponges; brushes (except paintbrushes); brush-making materials; articles for cleaning purposes; steel wool; unworked or semi-worked glass (except building glass); glassware, porcelain and earthenware not included in other classes.

Class 28: Games, toys; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Class 38: Telecommunications.

Class 39: Transport; packaging and storage of goods; travel organization.

Class 41: Education; training; entertainment; sporting and cultural activities.

61. For these reasons the opposition fails under section 5(2)(b) in relation to all the goods and services in classes 6, 9 (with the exception of optical apparatus and instruments), 11, 12, 16, 21, 28, 38, 39 and 41. I will only therefore go on to consider

the likelihood of confusion in relation those contested goods and services that I have found to share identity or similarity as outlined above.

62. Since the Opponent was not able to demonstrate use in relation to walking sticks or goods made from leather/imitation leather in class 18 nor any of its class 24 goods it is unable to rely on them in its opposition and therefore the opposition fails in relation to these goods. The Holder has no corresponding goods in classes 3 or 26 and therefore even though the Opponent has not demonstrated use in relation to these goods it will have no bearing on the outcome of the decision.

Average Consumer

63. When considering the opposing marks, I must determine, first of all, who the average consumer is for the goods and services and the purchasing process. The average consumer is deemed reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods and services in question.⁴

64. 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

⁴ Lloyd Schuhfabrik Meyer, case c- 342/97.

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.”

65. Even discounting the goods and services for which I found no similarity the contested goods and services cover a broad range of items. They range from precious metals, jewellery, leather bags, spectacles and clothing to advertising/ management services.

66. Neither party has addressed the position regarding the average consumer or the level of attention undertaken in the purchasing process. To my mind the average consumer of the goods at issue, which are general consumer goods, is a member of the general public who is likely to choose the goods through self-selection from rails or shelves of brick and mortar retail outlets or their online webpage equivalents. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the General Court stated that:

“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.”

67. Whilst overall, I consider the purchasing process to be predominantly a visual one, aural considerations cannot be discounted, following word of mouth recommendations

or following discussions with sales assistants. I consider, therefore, that purchasers will pay an average degree of attention in their selection process depending on the price, suitability, fit and quality of the item in question.

68. In relation to the contested services in class 35 the average consumer is likely to be a business user wishing to purchase or sell advertising space or engage the services of a commercial undertaking and therefore they may pay a slightly higher level of care in their selection process. Again, the selection process is more likely to be visual for these services for example following internet searches, however, again aural considerations cannot be discounted in the form of recommendations or telephone enquiries.




Comparison of marks

69. 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 the marks, 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.”

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

71. The respective trade marks are shown below:

Holder's mark	Earlier mark 1 and mark 2	Earlier mark 3
		

72. The Holder submits:

”there is a very limited amount of visual similarity between the marks at issue.”

“the only common element is that both marks have the same element ‘we’ at the beginning.”

“the word casablanca is separated by colour and the ‘a’ letters in “casa” are heavily stylised. These stylisations are the main dominant elements of the Applicant’s mark.”

“From a visual perspective the Opponent’s marks are for the word “WE” in a very heavily stylised upper case whereas the Applicant’s mark has the element

“we” in lower case. For such a common word as “we” this makes a large difference.”

73. The Holder considers that there is only a low level of visual and aural similarity between the marks and that conceptually the marks are very different. The Holder has submitted additional lengthy submissions on the similarity or otherwise of the marks.

74. The Opponent submits that the conflicting signs are visually aurally and conceptually similar. In particular:

“Visually the marks are similar to the extent that they coincide in the word WE. And that WE is the first and most prominent element in the Applicant’s mark.”

“Aurally the pronunciation of the signs coincides in the sound of the letters WE.”

“Conceptually the relevant public will perceive the earlier sign as the English pronoun indicating the first person plural. The contested mark as a whole does not have any particular meaning. However, the applicant’s mark also contains the word WE which has an identical meaning to the opponent’s marks.”

75. Whilst I have taken note of all the parties’ arguments in relation to the similarity or otherwise of the marks, I will undertake my own comparison which is as follows:

Holder’s mark

76. The Holder’s mark comprises of a number of elements:

- i. the words “we” and “casablanca” presented conjoined in lower casing.
- ii. the “we” and the “casa” elements are presented in blue font whilst the “blanca” element is presented in black.
- iii. A blue arch above the word casa presented in blue.

iv. The letters A of the element casa are presented in capitals in a different stylised font and are adjoined to the other letters.

v. The second letter A of the element casa is inverted.

77. Despite it being presented as one word, the mark is made up of the ordinary English word “we” and the famous place name “casablanca”. In my view neither word dominates the other in the overall impression and they can be said to make an equal contribution to the mark which is emphasised by their presentation as a single conjoined word. The stylisation does not detract from the words themselves. I do not accept the Holder’s submissions that the difference in colour separates the word Casablanca into two distinct elements “casa” and “blanca”. In my view the word Casablanca will be viewed in its entirety and as a reference to a geographical location. The colour, stylisation of the letters and the arc make a limited contribution and play a lesser role in the overall impression of the mark.

Opponent’s First and Second Marks

78. The Opponent’s first and second marks consist of the single word “WE” presented in capitals in a stylised font. The overall impression of the marks reside in the word “WE” and it is this word which is the dominant and distinctive element of the marks with the stylisation in lettering playing a lesser role.

Opponent’s third Mark

79. The Opponent’s third mark consists of the word “WE” presented in white on a black rectangular background. Other than the colour, the word WE is presented

identically to mark 1 and mark 2. The word “WE” plays a greater role in the overall impression of the mark, the box is merely a black background playing a minor role.

Visual

80. The only point of visual similarity is the word “WE/we” which is the first element of the Holder’s mark and the only/dominant component of the Opponent’s marks. The Holder’s mark has a number of additional elements namely the additional word Casablanca, the stylisation, the colour combination and the arc above the word casa. The word We is presented differently in both marks in relation to casing and stylisation, however, these differences may be disregarded because notional and fair use of a word mark protects the word itself irrespective of font⁵ or colour⁶, provided those changes do not affect the distinctive character of the mark. This was confirmed by the GC in *La Superquimica v EUIPO* EU T:2018:668 which held:

“It should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type...”

81. In addition, whilst the GC held in *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16, that use of a word mark in stylised form was not identical to a word only mark, it raised the question as to what extent the stylisation goes beyond notional and fair use of a mark. In my view there is nothing remarkable about the graphic

⁵ Bentley Motors Limited v Bentley 1962 Limited BL O/159/17

⁶ Specsavers International Healthcare Limited & Others v Asda Stores Limited [2014] C-252/12

representation of the lettering of the word WE in either mark to detract from the word itself. On this basis as the relevant public is likely to notice the “we” element of the Holder’s mark first, because beginnings of trade marks tend to have more visual impact than their endings⁷ the marks share between a low to medium degree of visual similarity.

Aural

82. The aural similarities lie in the common word “We” which will be pronounced identically in all marks. The additional element Casablanca in the Holder’s mark will mean it is articulated as “we-casablanca” regardless of the difference in colourisation or the words being conjoined.

83. Since marks are normally read from left to right the “we” element of the Holder’s mark will be the first element that is articulated and greater aural emphasis will be placed on this word. On this basis I consider the marks will be aurally similar to a medium degree with the presence of the shared element “we”.

Conceptual

84. Neither party has filed evidence regarding the average consumer’s understanding of the marks. The Opponent states that its marks will be perceived as the “English pronoun indicating the first person plural” and comments that the Holder’s mark as a whole has no particular meaning. The two elements “we” and “Casablanca” in the Holder’s mark will be seen as distinguishable words which in combination do not form anything meaningful as a whole, even though the words are conjoined. Both words

⁷ El Corte Ingles, SA v OHIM, cases T-183/02 and T-184/02

will be given their ordinary meaning and the average consumer will readily identify Casablanca as a Moroccan city and will know the meaning of the ordinary word “we” as the plural pronoun.

85. The Holder offers two alternatives regarding how its “Casablanca” element can be perceived. For a conceptual message to be relevant it must be immediately obvious to the average consumer⁸. I do not believe that the average UK consumer will break down the “Casablanca” element into two separate Spanish/Portugese words and be perceived as white house. It is more likely to be perceived as one word. On this basis due to the shared presence of the element “we” and “Casablanca” being perceived as a geographical location, the marks will share a medium degree of conceptual similarity.

Distinctiveness of earlier marks

86. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

⁸ Ruiz Picasso v OHIM [2006] e.c.r.I-643; [2006] E.T.M.R.29.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

87. 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).

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).”

88. Registered trade-marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer to those with high inherent characteristics such as invented words which have no

allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion.

89. The Opponent has filed evidence and claimed an enhanced degree of distinctive character through use of its first mark. Notwithstanding my earlier findings regarding lack of genuine use, no evidence has been filed at all to demonstrate use of its mark in the UK and therefore I am only able to consider the position based on inherent characteristics. All three of the Opponent's marks are for the word WE considered to be a common English word and the plural personal pronoun. Neither the stylisation of the word or the black background in mark 3 elevate their distinctiveness. Since the marks have no apparent suggestive or allusive association to the Opponent's goods or services I consider their level of inherent distinctive character is medium.

Likelihood of confusion

90. When considering whether there is a likelihood of confusion between the marks I must consider whether there exists direct confusion, where one mark is mistaken for the other or whether there is any indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or related source.

91. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“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 recognised 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, 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.”

92. In determining whether there is a likelihood of confusion there are a number of factors to bear in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent’s trade marks, the average consumer for the services and the nature of the purchasing process. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

93. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which

has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

94. When comparing the marks, I take into account the visual similarities between them as a result of the shared presence of the word “we” which I found to be similar between a low to medium degree. The marks share a medium degree of aural and conceptual similarity. I take into account that the inherent distinctiveness of the earlier marks is medium with no further enhancement attributed to them through use. I note that the average consumer is reasonably well informed and circumspect and a member of the public or business user who will pay at least an average degree of attention in the selection process. I have found the goods and services to be identical or similar to a medium degree.

95. Due to the similarity and identity of the goods and services and the purchasing process, I believe that when coming across the Holder’s mark there is sufficient commonality between the marks for the “we” element to be considered as a house mark and for “Casablanca” to be considered as a geographical descriptor. When comparing the marks the average consumer may well notice the difference with the inclusion of the element Casablanca and the stylisation, but nevertheless conclude that the later mark is a brand extension or a variant of the earlier marks and that the respective goods and services come from the same or economically linked undertakings. It is for these reasons that I find there would be a likelihood of indirect confusion.

Outcome

96. The opposition under section 5(2)(b) of the Act succeeds in part; subject to any successful appeal, the registration/protection is refused for the following goods and services:

Class 9: Optical apparatus and instruments

Class 14: Precious metals and their alloys; jewelry, precious stones; timepieces and chronometric instruments.

Class 18: Leather and imitation leather; animal skins; trunks and suitcases; umbrellas and parasols; whips, harnesses and saddles;

Class 25: Clothing, footwear, headgear.

Class 35: Advertising; commercial business management; commercial administration; office functions.

97. The following goods and services may proceed to registration; the opposition having failed for those goods and services that I have determined are dissimilar or where I have found that the Opponent has not demonstrated use of its mark in relation to those goods/services:

Class 6: Common metals and their alloys; building materials of metal; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of metal; ironmongery and small items of metal hardware; pipes of metal; safes; ores.

Class 9: Scientific, nautical, surveying, photographic, cinematographic, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for

conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic recording media, sound recording disks; compact disks, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; software; fire-extinguishing apparatus.

Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

Class 12: Vehicles; apparatus for locomotion by land, air or water.

Class 16: Paper, cardboard; printing products; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paintbrushes; typewriters and office requisites (except furniture); instructional or teaching material (except apparatus); plastic materials for packaging (not included in other classes); printing type; printing blocks.

Class 18: walking sticks;

Class 21: Utensils and containers for household or kitchen use; combs and sponges; brushes (except paintbrushes); brush-making materials; articles for cleaning purposes; steel wool; unworked or semi-worked glass (except building glass); glassware, porcelain and earthenware not included in other classes.

Class 24: Fabrics and textiles; bed throws; table covers.

Class 28: Games, toys; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Class 38: Telecommunications.

Class 39: Transport; packaging and storage of goods; travel organization.

Class 41: Education; training; entertainment; sporting and cultural activities.

Costs

98. As the Holder has had the greater share of success, it is entitled to a contribution towards its costs. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Note 2 of 2016. Applying that guidance, I award costs to the Holder on the following basis:

Considering the Opponent's statement and
preparing a defence and counterstatement

£200

Considering the Opponent's evidence	£1,000 ⁹
Preparing submissions in lieu of a hearing	£400
Total	£1,600

99. I order WE BRAND S.A.R.L. to pay CASABLANCA EVENTS ET ANIMATION the sum of £1,600 as a contribution towards 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 17 May 2019

Leisa Davies

For the Registrar

⁹ Despite the fact that the Holder did not file evidence, I have set the level of costs for this element, to reflect the amount of exhibits it had to go through in relation to the Opponent's proof of use.