

O-221-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2565308

BY

**DANIEL FOOTWEAR LIMITED
TO REGISTER THE TRADE MARK**



ROJO

IN CLASSES 25 AND 35

**AND THE OPPOSITION THERETO UNDER NUMBER 102075
BY ROJO AUSTRALIA PTY LTD**

Background

1. On 17 June 2011, Rojo Australia Pty Ltd (“the opponent”) filed notice that it opposed trade mark application number 2565308 achieving registration. The relevant details of the application are:

ROJO

Class 9: *Clothing, footwear and headgear.*

Class 35: *Retail services connected with clothing, footwear, headgear, bags, jewellery, accessories.*

2. The trade mark application was filed on 24 November 2010 and was published in the Trade Marks Journal on 18 March 2011. The current owner is Daniel Footwear Limited (“the applicant”).

3. The opponent claims that registration of the trade mark would be contrary to sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”), which state:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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.”

4. Both grounds are based on the opponent’s earlier trade mark number 2310452, ROJO, which was applied for on 12 September 2002 and which completed its registration procedure on 21 February 2003. The earlier mark had been registered for more than five years on the date on which the application was published in the Trade Marks Journal. Consequently, the earlier mark is subject to proof of its use under section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004). The applicant requests such proof in its counterstatement, as well as denying the grounds of opposition. The period during which the opponent is required to show genuine use of its mark for the purposes of the opposition is 19 March 2006 to 18

March 2011. The earlier trade mark is registered in several classes. Although the notice of opposition stated that the opponent relied upon various goods in classes 9, 14 and 25, its statement of use was made only in respect of the following goods:

Class 9: *goggles; support straps for goggles;*

Class 25: *clothing, footwear, headgear.*

5. This was refined at the hearing before me on 6 May 2014, so that the opponent now only relies upon goggles, clothing, footwear and headgear.

6. At a pre-hearing review a week before the hearing, I allowed an amendment to the pleadings to correct anomalies in the notice of opposition. The anomalies had been picked up in the opponent's primary evidence/submissions¹, and the applicant, in its evidence and submissions, had treated the pleadings as the opponent had intended them to read. The grounds are pleaded as follows:

- Under section 5(1) of the Act, the opponent relies upon clothing, footwear and headgear to attack clothing, footwear and headgear in the application.
- Under section 5(2)(a), the opponent relies upon goggles, clothing, footwear and headgear (but no longer relies upon support straps for goggles) to attack retail services connected with clothing, footwear, headgear, bags, jewellery and accessories.

7. Both parties filed a mixture of evidence and submissions. The applicant chose neither to attend the pre-hearing review or the substantive hearing. At both of these, the opponent was represented by Mr Thomas St Quintin, of Counsel, instructed by Potter Clarkson LLP.

Evidence

8. The applicant's primary evidence is from Mr Daniel Buck, its CEO. The opponent's primary evidence is from Mr David Salveson, who has been one of its directors since 2000. The opponent has also filed evidence and submissions from other individuals connected with the business, and from its trade mark attorney, Mr John Peacock, in order to rebut the applicant's criticisms of each exhibit in Mr Salveson's evidence, and in response to Mr Buck's statement.

9. Mr Salveson states that the opponent's goods have been distributed and/or promoted within the UK primarily by the opponent's UK distributors, Snow Clothing Limited and by a company related to Snow Clothing Limited, called Shoreditch Design Ltd. The rights to distribution by the latter have recently been terminated and now UK promotion and distribution is handled by a company owned by the opponent's shareholders, Rojo Distribution (Europe) Ltd. Exhibit 1 consists of a list of UK retail outlets for the opponent's goods, which are located throughout England, Scotland and Wales. The applicant submits that the authenticity of the list cannot be verified; that there is no indication as to when the list was compiled; and that there is

¹ Witness statement of John Peacock of 8 March 2013, paragraph 18.

no evidence to support the opponent's claim that the outlets stocked, distributed or sold any goods under the ROJO mark in the UK during the relevant period. The opponent submits that Mr Salveson's witness statement was made from his own knowledge or the records of his company and that it is verified by a statement of truth. Nevertheless, Mr Salveson has made a second witness statement in which he confirms that the list of stockists in Exhibit 1 all distributed, stocked or sold ROJO clothing, footwear, headgear, goggles and socks during the relevant period. Mr Salveson states that the list of stockists in Exhibit 1 was prepared by him and the opponent's UK agents to manage the opponent's distributor's promotion of ROJO products. The list was begun in 2007 and is updated from season to season.

10. Mr Salveson states that Exhibit 2 consists of a selection of products (boots, jackets, trousers, knitted hats, bandanas, gloves, socks, mid- and base-layer tops) from the opponent's website. The mark ROJO is visible on some pages at the top of the screen, as are the words "ROJO Guarantee". Mr Salveson states that the pages in the exhibit illustrate how the mark is used in practice and the range of goods which are for sale in the UK. He confirms that purchases from the UK via the website have been possible throughout the relevant period. The applicant points out that the majority of the snapshots are undated and that, for the remainder, there is a copyright date of 2012, which is after the relevant date. Mr Salveson, in his second witness statement, confirms that the extracts "demonstrate the type (and not the actual) goods [sic] that were available to purchase during the relevant period, and how the ROJO trade mark is used in practice".

11. Exhibit 3 consists of invoices to the opponent from Snowsport Industries (GB) Limited in respect of the costs of hiring a trade stand to exhibit the opponent's goods at UK trade fairs. The invoices are dated in 2008 and 2009; Mr Salveson states that the opponent has attended the 'Slide Show' trade fairs annually between 2006 and 2011, and also other UK trade fairs since 2007, such as Manchester Slide Trade Show, and the Daily Mail Ski and Snowboard Show. He states that the opponent also attended the Derby, Reading and Edinburgh 'Snow Baw' in 2011. Mr Salveson states that ROJO products have been exhibited at all these trade shows (second witness statement). He attaches to his second witness statement a list of his trips to the UK (he is based in Australia) during 2007 to 2013 where he attended trade shows featuring the ROJO brand and/or met with UK ROJO distributors. This is to meet the applicant's criticisms of Exhibit 3, that there is no indication on the invoices as to where and if the trade shows took place, and what the opponent was exhibiting.

12. Mr Salveson exhibits two copy invoices (Exhibit 4) issued to the opponent by Ashwyk Ltd, a printer based in Tilford (Surrey). The invoices are in respect of the opponent's ROJO brochures for 2009, and the ROJO 2010/2011 winter edition brochure. Mr Salveson confirms that the brochures were available for distribution in the UK, and that catalogues for 2006, 2007 and 2008 were supplied directly by the opponent to its UK distributors for promotional use to UK customers; 2012 and 2013 catalogues have also been supplied for use in the UK market. The applicant criticises this exhibit as merely verifying that brochures were printed but there is no indication as to where or when these brochures were made available on the UK market. Further, the invoices do not provide any information about the content of the brochures and the goods advertised in the brochures. The applicant refers to the

opponent's 2012 and 2013 brochures as being irrelevant as they are after the relevant date. Mr Salveson responds to these criticisms in his second witness statement. He confirms his first statement in relation to the invoices and states:

“These brochures were distributed to retailers for the purpose of promoting to retailers the ROJO products which they could order for resale to consumers via their retail business. Although the actual invoices do not provide information as to the goods featured in the printed brochures, the actual goods themselves are clearly visible in the brochures attached as Exhibit 9 to my earlier Witness Statement dated 8 March 2013.”

Exhibited as Annex 2 to Mr Salveson's second witness statement is a witness statement from Joe De Wykerslooth, the managing director of Ashwyk Ltd. He states:

“3. Rojo Australia Pty Ltd and its related company Rojo Distribution (Europe) Limited have been a printing client of my company since 2009.

4. I have been aware of the brand 'ROJO' in the UK since 2009. My company has printed a number of 'ROJO' product brochures for distribution in the UK market between the years 2009 to 2012 these brochures illustrate use of the 'ROJO' trade mark in relation to a range of clothing products and to the best of my knowledge these books are used by retailers to place forward orders for the following season of products which features the ROJO trade mark.”

Attached to Mr Wykerslooth's statement is a selection of invoices issued to Rojo Distribution (Europe) Ltd. I note that, for example, the 3 December 2009 invoice refers to the job name as “Rojo winter book 2010/2011”.

13. Exhibit 5 to Mr Salveson's first witness statement is a copy invoice issued to the opponent from a domain name provider for hosting the opponent's website rojoouterwear.com from November 2008 to March 2009. Mr Salveson states that the opponent's UK distributors took over maintenance of the domain name after 2009 and the opponent does not have access to any further invoices relating to the maintenance of its website. He states that the opponent maintains the global domain name which is the access driver to all regional websites, to which “the forward slash” UK site was connected. The applicant submits that the invoice provides no real and substantive evidence of use of the opponent's mark in the UK in relation to clothing, footwear, headgear and goggles. To meet the point, Mr Salveson states in his second witness statement that the website was in use and was accessible to UK customers throughout the relevant period. He states that the products available in the opponent's UK ROJO product brochures, attached as Exhibit 9 to his first witness statement, were available in the UK (and globally) via the website and that they were sold directly to consumers from this site via the UK linked site, operated under licence by the distributor.

14. Mr Salveson provides turnover figures from sales, via the opponent's UK distributors, of its ROJO goods in the UK:

2006	£40,000
2007	£100,000
2008	£150,000
2009	£300,000
2010	£400,000
2011	£500,000
Total	£1,490,000

15. Exhibit 6 to Mr Salveson's first witness statement consists of invoices issued by the opponent to its UK distributors which he states relate to supply of the opponent's goods under the ROJO mark. Mr Salveson states that this is not the sum total of invoices as the opponent has not been able to access all invoices from distributors.

16. There are twelve invoices dated 17 November 2006, 24 July 2007, 13 December 2007, 8 January 2008, 5 August 2008, 27 August 2008, 1 September 2008, 21 July 2009, 26 October 2009, 27 November 2009, 26 July 2010 and 12 January 2011 to three companies, Snow Clothing, TJK UK and Shoreditch Design Limited. As explained earlier in his statement, Snow Clothing and Shoreditch Design Limited were former UK distributors for the opponent. ROJO appears at the top of the invoices. The articles all have codes which start with W and then either 7, 8, 9 or 10. The codes for the 13 December 2007 and 8 January 2008 invoices all start with W8; whilst the codes for the 27 November 2009 start with W10. Many of the listed articles have whimsical names. There are hats, scarves, gloves, beanies, neck warmers, headbands, socks, jackets, goggles, tops, bandanas and boots. The items are specified as being for women, girls or kids. The applicant submits that none of the goods are described as ROJO goods and therefore the invoices do not assist, other than possibly to show ROJO being used as a mark for a retail service, which is not covered by the earlier mark's specification. The applicant claims that, for the clothing sector, twelve invoices to three companies do not show genuine use of the mark. It submits that invoice 44388, addressed to Shoreditch Design Limited must be disregarded as there is no address for the company and therefore no indication that this invoice related to the UK market. I note that other invoices do show the UK address of Shoreditch Design Limited.

17. In reply, the opponent has filed several witness statements from individuals who have been connected with the opponent's UK distributors (under their various corporate names: Snow Clothing, Shoreditch Design Limited and Surfanic International Ltd). Stephen Snares is a former Head Designer at Surfanic International Ltd, the former UK distributor for the opponent. Mr Snares states that he held this position between 2006 and April 2013. He was of the understanding that Surfanic International Ltd, previously called Snow Clothing, was the opponent's UK distributor until 2012, distributing ROJO products. He states that it was his job to develop products for items produced under the label Surfanic and for submitting custom made products under the ROJO label which were made exclusively for the national UK retailer TK Maxx. He states that the company (Surfanic International Ltd) made a significant number of product lines which carried the ROJO trade mark. Mr Snares states that he was responsible for trade show presentations and confirms that products bearing the ROJO trade mark were displayed at events such as the

Daily Mail Ski & Snowboard Show (held annually in October) and at Slide (held annually in February). These events gave coverage of the ROJO brand to both wholesalers and retailers across the UK in the snow sports industry. Mr Snares states that the product categories exhibited at these shows included beanies, socks, boots, snow outerwear, micro fleece base layer products and next to the skin base layers.

18. Mr Snares states that, since April 2013, he has been working directly for the opponent to supply UK retailers with ROJO products to be released in the UK market from October 2013. He states that the opponent is now undertaking a direct selling role in the UK, having terminated its licence to Surfanic. Mr Snares states that he is aware that ROJO branded articles of clothing have been available in a number of retail outlets, including TK Maxx and TopGear throughout the UK since at least 2006.

19. Esther Brown was employed as administration manager at Surfanic International Ltd between 2003 and 2012. She was responsible for liaising with ROJO customers (retailers), making sure that the stores were stocked and that the ROJO website sent orders to customers. She states that ROJO products were also supplied in volume to TK Maxx stores across the UK. She refers to the same trade shows as Mr Snares.

20. Andrew Nicholls is an independent sales agent acting on behalf of clothing wholesalers to sell products on their behalf. At the time of his statement, 7 August 2013, Mr Nicholls states that he was selling ranges for Rojo, Surfanic, SnoKart, Mudd and Water, EKO and United Nude. He states that as sales agent for ROJO, he is responsible for promoting products bearing the ROJO mark to fashion lifestyle stores and also to specific retailers due to some of the technical products which are made by Rojo. Mr Nicholls states that he has been Rojo's sales agent for the last 12 months, which is after the relevant date. Mr Nicholls states that he has been aware of the ROJO brand in the UK since 2006. He is aware that the ROJO brand was present at the Manchester Slide Show in 2007 (a wholesale to retail snow sports trade show) and that it has featured at this show every year since 2007. Mr Nicholls states that he was directly involved in presenting the ROJO brand at the 2011 Derby, Reading and Edinburgh Snow Baw shows. Mr Nicholls states that he is aware that ROJO clothing was available throughout the UK in TK Maxx, Glide and Slide, Carters, and Top Gear from 2007 to 2011. He states that in 2011 ROJO branded clothing products were also stocked in the following UK retail outlets: Snowear, In Training, Love and Piste, Calusa, Mike Davies Leisure, Owen Sports, Elements, Shepperton Sports, Ski Warehouse and Log Cabin.

21. Amanda Bradfield has been the director of Top Gear (Essex) Limited since July 2010. She states that her company sold ROJO branded footwear for the opponent and its related company Rojo Distribution (Europe) Limited during 2010. Ms Bradfield states that she and her company met with the opponent and Rojo Distribution (Europe) Limited at the ISPO trade show in Germany in February 2011 and placed a further order in relation to ROJO branded footwear.

22. Exhibit 7 to Mr Salvesson's first witness statement is described as comprising a summary of some of the UK sales made by the opponent's UK distributors. Mr

Salveson states that the opponent does not have access to its UK distributor's database and therefore the information does not relate to all of the UK sales made. In Mr Salveson's second witness statement, he points out that the goods in the sales list correspond to the goods featured in the ROJO product brochures in Exhibit 9. He gives an example of the "THESE ARE THE DAYS" jackets, which appears on page 13 of the ROJO Winter 2010/2011 brochure and which is shown on the sales list under TRW10300 001, dated 15 February 2011, to the customer name TJX UK, customer account "TKM01". Elsewhere in his second statement, Mr Salveson refers to the list including sales to TK Maxx. He states that ROJO branded goods were sold throughout the UK in TK Maxx stores (and that there are over 240 such stores in the UK and Ireland). A similar range of goods are listed as in the invoices, described above, with the same whimsical names. The sales lists are dated in 2010 and 2011 and show various end-customers, including names which appear in the list in Exhibit 1.

23. The applicant criticises the sales lists as making no reference to the opponent or to the trade mark ROJO; further, there is no evidence of a distribution agreement with Shoreditch Design Ltd. It claims the sales lists are of no relevance because they do not verify genuine use of the mark. In response, Mr Salveson exhibits (Exhibit 12) a copy of the distribution agreement between K.T.O. Futures Limited, now Surfanic International Ltd, which traded as Snow Clothing; the agreement was in effect between 2007 and 2012. During this period, the licence was transferred to Shoreditch Design Ltd, a company related to Surfanic International Ltd. The earlier invoices in Exhibit 6 are to Snow Clothing and the later invoices are to Shoreditch Design Ltd; likewise, the sales report in Exhibit 7 dated 15 February 2011 is headed Shoreditch Design Ltd.

24. Mr Salveson states that the agreement required that UK distributors spend 5% of sales on advertising, which consisted of trade show participation, consumer shows, and product information supplied to various trade and consumer publications. He states that examples of such magazines are "Cooler", a magazine owned by Factory Media in the UK, and the English version of the European-wide magazine known as "Onboard". Exhibit 8 shows two extracts from Onboard dated August 2009 and October 2009. Jackets are shown with the word ROJO appearing directly above the pictures and the website rojoouterwear.com. The applicant submits that these do not show use of the mark in the UK because there is nothing to indicate that the magazines were ever placed on the UK market. To answer this, Mr Salveson confirms in his second witness statement that the Onboard extracts were available throughout the UK during the relevant period. Mr Peacock, the opponent's trade mark attorney, has filed a witness statement (28 January 2014) in which he states that Onboard is published in English, French, German and Spanish and distributed in over 40 countries. I note that the extracts in Exhibit 8 show the cover price in pounds sterling.

25. Exhibit 9 consists of ROJO product catalogues from Winter 2007/08, Winter 2008/09, Winter 2009/10, Winter 2010/11 and Winter 2011. Mr Salveson confirms that the catalogues were made available for distribution in the UK at the time of publication; the Winter 2007/08 and Winter 2008/09 catalogues include the contact details for Snow Clothing, the opponent's UK distributor. The applicant criticises this exhibit because, it submits, the brochures do not show that the opponent has used

the mark in the UK and no evidence to support the claim that the brochures were placed on the UK market. In reply, Mr Salvesson states that the ROJO product catalogues were printed and circulated throughout the UK market and were circulated through the opponent's UK distributors.

26. The catalogues show a variety of clothing items for women and girls. The front pages of the catalogues bear the mark ROJO. The representations of the models wearing clothing are dark in some places, but it is clear to see in some cases that the items bear the mark ROJO; in the case of socks, the mark is woven into the cuffs. I note that the same whimsical names appear in the catalogues as appear in the invoices in Exhibit 6 and the sales lists in Exhibit 7. Where it is possible to see the mark on the goods themselves, I have cross-referred the brochures in which such goods appear with the invoices. The invoices are numbered 51079, 45723, 44388, 32257 and 25592 and are dated (respectively), as 26 July 2010, 27 November 2009, 21 July 2009, 13 December 2007 and 17 November 2006:

Winter 2010/2011

- Spliced mid/base layer, code W10MF0601, appears on invoice 45723;
- Curiosity hoodie, code W10MF0604, appears on invoices 45723 and 51079;
- VIP gloves, code W10RAC1800B, appear on invoices 45723 and 51079;
- Leather gloves, code W10RAC1800A, appear on invoices 45723 and 51079;
- Chatterbox gloves, code W10RAC1803, appear on invoices 45723 and 51079;
- Thin Lizzy socks, code W10F1730, appear on invoices 45723 and 51079;
- Star cross goggles, code W10AC7082R, appear on invoices 45723 and 51079;
- Snow Forever goggles, code W10AC7015R, appear on invoices 45723 and 51079;
- Supalogo beanie, code W10AC2963, appears on invoices 45723 and 51079;
- Supascript bandana, code W10AC2951, appears on invoices 45723 and 51079;
- A Mountain Moment hat, code W10AC2913, appears on invoices 45723 and 51079;
- Vertigo mittens, code W10AC2916, appear on invoices 45723 and 51079;
- Quando cap, code W10AC2949, appears on invoice 45723;
- Micro headband, code W10AC886M, appears on invoice 45723 and 51079, and on invoice 22592 with code W7AC886M;
- Micro neck warmer, code W10AC002M, appears on invoices 45723 and 51079, and on invoice 22592 with code W7AC002M;
- Girls' Best Vest gilet, code W10MF1154, appears on invoice 45723 and on invoice 44388 with code W9MF1154.
- Girls' What's in a Name beanie, code W10AC2894, appears on invoices 45723 and 51079;
- Girls' Sherpa Pom Pom hat, code W10AC2893, appears on invoices 45723 and 51079.

Winter 2009/10

- Girls' Tall Top beanie, code W9AC2853, appears on invoice 44388;
- Girls' Eskimo Junior hat, code W9AC275, appears on invoices 45723 and 44388.

Winter 2008/09

- Grace jacket, code W801518JS, appears on invoice 32260;
- Zip-up neck warmer, code W8AC278, appears on invoice 44388 as W9AC278, 45723 as W10AC278, and 22592 as W7AC278;
- Eskimo Jo hat, code W8AC024, appears on invoice 42723 as W10AC024 and on invoice 22592 as W7AC024;

Winter 2007/08

- Girls' trousers Winners R Grinners, code W701511, appears on invoice 22592.

27. Other items in the brochures on which ROJO is visible, but which do not appear on the exhibited invoices, include Rain Tec Gilet, Snowdrift headband, Flaked Out neck warmer, Live Wire and Chatterbox jackets, Reversible shaped headband, Double Layer neck warmer (all 2010/11), Dreamweaver jacket, Super Stripe beanie, Polar Winter hat, girls' Diamonds Rule and Cute As jackets, girls' In Tune trousers, girls' Playing for Keeps mid/base layer, girls' Snowflake, Bird of a Feather and Diamond socks, girls' Hot Pot hoodie (all 2008/09), Spellbound jacket, Heaven Sent trousers, girls' Check Me Out and Crystal Pop jackets, headband and neck warmer (all 2007/08). Further, I note examples of the above listed items which appear in the invoices in Exhibit 6 are also listed in the sales lists for various end customers in Exhibit 7, such as Leather glove, Supalogo beanie, A Mountain Moment beanie, Micro neck warmer, Chatterbox glove, Snow Forever goggles, Star Cross goggles, What's In a Name beanie, Vertigo Mitten, Thin Lizzy socks and Sherpa Pom Pom. There are many more names which are replicated across the invoices, in the brochures and in the sales lists; those I have set out above are the items on which I can see the word ROJO on the actual garments and goggles.

28. The last exhibit to Mr Salveson's first statement is Exhibit 10, which he states is a copy invoice issued by Alibi Publishing Ltd to the opponent in relation to a ROJO advertisement published in the 2009-2010 edition of 'The Outdoor Direct' magazine. The applicant submits that the invoice is made out to Rojo Distribution Europe and that there is no evidence that this invoice relates to an advertisement for the mark ROJO for the relevant goods, or that it relates to an advertisement in a magazine made available in the UK. Further, there is no copy of the advertisement. In reply, Mr Salveson repeats his statement that the advertisement published in the 2009-2010 edition of The Outdoor Direct magazine was published and made available in the UK during the relevant period.

29. Daniel Buck gives evidence for the applicant. He states that the applicant is an independent retailer with 25 stores in the UK, at Alderley Edge, Banbridge, Birmingham, Castleford, Cheshire Oaks, Edinburgh, Glasgow, Hale, Harrogate and Hatfield, Horsforth, Livingston, Leeds, Loughton, Liverpool, Mill Hill, Newcastle, Portsmouth, Stanmore, Swindon, York, Tunbridge and Wilmslow. Mr Buck states

that the applicant also has an extensive e-commerce store (daniel footwear.com). He states that the trade mark ROJO has been used in the UK since 1996 in relation to retail services connected with clothing, footwear, headgear, bags, jewellery and accessories. The trade mark has been used in relation to ROJO branded footwear since 1996. Mr Buck states that, at the time of his statement, 7 May 2013, there were four ROJO stores, in London, Belfast, Beverley and in North Yorkshire, specialising in selling designer footwear, bags, clothing and accessories from a number of well known designers such as Lulu Guinness, DKNY, Timberland, Ugg and Marc Jacobs. There is also an online store, rojoshoes.co.uk.

30. Mr Buck states that the first branch of ROJO was opened in Belfast in 1998 and a branch in London was opened in 2000. Another branch was opened in Hertfordshire in 2007; however, I note that this branch is not included in the 'four' branches present at the time of Mr Buck's statement. Mr Buck states that women's shoes are the backbone of the applicant's business, but that it also sells a wide range of women's clothing and accessories. He states that the past six years' turnover for ROJO stores amounts to £9.6 million; this figure is in respect of Northern Ireland, Ireland and England. The annual advertising figure for ROJO is £20,000. Mr Buck states that he is not aware of any use by the opponent of ROJO in the UK.

Proof of use

31. Section 6(A) Act states:

“(1) This section applies where—

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if—

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes—

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

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

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

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

(7) Nothing in this section affects—

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

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

32. The enquiry under section 6A of the Act is essentially identical to that set out under section 46. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

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

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

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

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

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

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

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

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

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]"

33. The assessment can only be made on the basis of the evidence filed by the opponent, because Section 100 of the Act states:

“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.”

34. The applicant has criticised each of Mr Salvesson’s exhibits to his first witness statement, calling for them to be disregarded because, *individually*, they do not show genuine use. This is not the correct approach. It is a matter of viewing the picture as a whole, including whether individual exhibits corroborate each other. In Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, in relation to the need to get a sense from the overall picture of the evidence, notwithstanding that individual pieces may not, of themselves, be compelling, the General Court (“GC”) said:

“53 In order to examine whether use of an earlier mark is genuine, an overall assessment must be carried out which takes account of all the relevant factors in the particular case. Genuine use of a trade mark, it is true, cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (*COLORIS*, paragraph 24). However, it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (see, to that effect, judgment of the Court of Justice of 17 April 2008 in Case C-108/07 P *Ferrero Deutschland v OHIM*, not published in the ECR, paragraph 36).”²

35. In *Plymouth Life Centre*, BL O/236/13, Mr Daniel Alexander QC, sitting as the appointed person, observed that:

“Providing evidence of use is not unduly difficult. If an undertaking is sitting on a registered trade mark, it is good practice in any event from time to time to review the material that it has to prove use of it.”

In *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd* (‘CATWALK’), BL O/404/13, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, stated:

“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.

² See also the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person in *Brandconcern BV v Scooters India Limited* (“Lambretta”) BL O/065/14, referring to this case from the GC.

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."

36. The opponent has provided various types of evidence. Some are weightier than others, but it is the collective weight which is important in deciding whether the opponent has 'shown' genuine use; in particular, whether the individual exhibits are corroborative of one another. Mr Salveson provides examples of the current use of ROJO on the website and states that this demonstrates the type of goods that were sold and how the ROJO mark was used during the relevant period. He provides brochures which span the relevant period, which show the mark on the front cover and elsewhere and on a significant number of the goods. Mr Salveson provides invoices from the opponent to its UK distributors, the dates of which correspond to the dates of the brochures in relation to advance seasonal orders. The same stock codes appear on the invoices as in the brochures for the items, which are individually named, save for the initial W plus either 7, 8, 9 or 10, depending on which year's winter season (hence the W) items are being sold. The names and stock codes are consistently used through several seasonal brochures and on the invoices spanning the relevant period. The names of the goods appear on the sales lists showing the sales made by the UK distributor to the individual end consumers, the retail customers. Some of the retail customers appearing in the sales list are shown in the list of current retail outlets compiled by the opponent in Exhibit 1. Mr Snares states that he produced ROJO designs for sale in TK Maxx. TK Maxx appears in the sales lists. Mr Nicholls refers to ROJO goods being sold at, inter alia, Mike Davies (Swansea), a name which appears in the list of stockists in Exhibit 1, and in the sales list in Exhibit 7.

37. There is a statement from the opponent's UK printer which verifies the printing of the seasonal ROJO catalogues over several seasons. The former UK distributor, Snow Clothing, is shown as a contact in the 07/08 and 08/09 brochures. It is unlikely that there would have been repeat orders for brochures unless they were genuinely being used to create or preserve a market share in the goods. It is also highly unlikely that printers' invoices would refer to the content of brochures, which is a criticism by the applicant. The opponent has done what it can to meet this unrealistic criticism: Mr Wykerslooth, the printer, exhibits a selection of invoices whereby the job names can be seen as, for example, Rojo winter book 2010/2011. Promotional efforts were made in outdoor pursuit magazines, with advertisements showing the website which Mr Salveson states acts as a driver to the national versions of the website (managed by distributors), including the UK. The cover price of the Onboard magazine is clearly visible in sterling, indicating the UK market. Promotional efforts were consistently made during the period at trade fairs, corroborated by the invoices from Snowsport Industries (GB) Limited and by the statements of Andrew Nicholls and Stephen Snares.

38. In *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-234/06 P, the CJEU stated:

“73 The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The frequency or regularity of the use of the trade mark is one of the factors which may be taken into account (see *Sunrider v OHIM*, paragraph 71; see also, to that effect, *La Mer Technology*, paragraph 22).

74 By stating, at paragraph 35 of the judgment under appeal, that the evidence is very limited with regard to 1994 and non-existent for the period from 1996 to 1999, the Court of First Instance did not in any way require the appellant to establish continuous use of the trade mark THE BRIDGE (No 642952) throughout the whole of the period in question. In accordance with the Court's case-law cited in paragraphs 72 and 73 of the present judgment, the Court of First Instance examined whether that trade mark had been put to genuine use during that period. To that end, the Court of First Instance assessed, at paragraphs 32 to 36 of the judgment under appeal, whether the scale and frequency of use of that mark were capable of demonstrating that it was present on the market in a manner that is effective, consistent over time and stable in terms of the configuration of the sign.”

39. Mr Salveson has provided turnover figures which, although modest in the vast clothing market³, have consistently increased over time and which add to the picture provided by the exhibits. I have listed the items on which I can see the ROJO trade mark, for example on lapels, on hats, on gloves and on socks. I think that Mr St Quintin had better copies of the brochures than I was able to view because he took me to pictures of models which he said showed the mark on the clothes, although I couldn't see them on my copies. Based upon the images on which I can see the mark, it is a reasonable inference that there will be at least some of the many items of clothing in the brochures, other than the ones I have listed in paragraph 26, which also show the mark on the goods. Further, in the clothing market it is usual for the trade mark to appear on the neck labels of garments. Use of the mark on the actual goods rebuts the applicant's contention that if there is any use, it is only in relation to retail services (in contrast with the applicant's own evidence, which refers to retailing of well-known third parties' goods, but no ROJO goods).

40. In my view, the opponent has marshalled together the evidence it has been sitting on, as far as it was able to considering the limited access to its distributor's records, and has shown actuality of use of its mark ROJO in the UK in the relevant

³ General Court Case T-334/01 *MFE Marienfelde GmbH v OHIM*: “32 In interpreting the concept of genuine use, account must be taken of the fact that the rationale for the requirement that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a trade mark application is to restrict the number of conflicts between two marks, in so far as there is no sound economic reason resulting from an actual function of the mark on the market (Case T-174/01 *Goulbourn v OHIM – Redcats (Silk Cocoon)* [2003] ECR II-789, paragraph 38). However, that provision is not concerned either with assessing the commercial success of an undertaking or monitoring its economic strategy, or designed to reserve the protection of trade marks for large-scale commercial uses of them.”

period. It has shown that it both promoted and sold its goods under the mark ROJO in order to maintain or create an outlet for the goods or a share in the UK clothing market. The volume of sales, the duration of the period of sales, the frequency of the sales and the stability of the mark used combine to show that genuine use has been made of the earlier mark.

41. The next question is whether that use is fairly described by the statement of use made by the opponent, or whether the scope of use is narrower. Mr St Quintin submitted that the opponent's use was in relation to clothing, footwear and headgear for women and girls. I agree that the use of the mark has only been in relation to goods for women and girls. It will therefore be necessary to reflect that in framing a fair specification upon which the opponent may rely for the purposes of this opposition.

42. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*⁴, Mr Geoffrey Hobbs QC, sitting as the Appointed Person said:

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

43. In his skeleton argument Mr St Quintin provided me with sales figures from the invoices in Exhibit 6, to which he added at the hearing, broken down into categories of goods. These were as follows:

- Clothing (body clothing, outerwear, gloves, mittens, neck warmers and scarves): AUS\$32,203 and £51,212⁵;
- Footwear: AUS\$12,686 and £11,239;
- Headgear: AUS\$16,613 and £19,169;
- Goggles: AUS\$6,719

44. I do not place reliance on these figures to assess genuine use in terms of turnover because Mr Salveson has given turnover figures and has said that the invoices in Exhibit 6, from where Mr St Quintin derives these figures, are not the sum total of invoices. The Salveson and invoice figures will not match. However, Mr St Quintin's breakdown is useful for the purpose of assessing what categories of goods the invoice items exemplify. My list, in paragraph 26, of items in the brochures which are cross-referenced to the invoices includes mid and base-layers, the latter being a type of underwear (like thermal vests) (covered by Mr St Quintin's category of body clothing).

⁴ BL O/345/10.

⁵ Some invoices are shown in Australian dollars and others in sterling.

45. In *Animal Trade Mark* [2004] FSR 19, Jacob J (as he then was) said that the test is the description which would be used by the average consumer for the goods on which the mark has been used:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

46. Jacob J was considering the issue of clothing and a fair specification, in which the earlier mark was registered for clothing, footwear, headgear, baseball caps, sweatshirts and T-shirts. The use of the mark had been on goods with an image connected to surfing. He went on to say:

“23 So, should “clothing” in the specification be qualified in some other way? The term covers a very wide spectrum of different sorts of garments. But putting aside such specialist things as diving suits, wetsuits, bullet-proof vests and so on, there is a core of goods which are likely to be bought by ordinary consumers for different purposes in their daily wear. The same woman or girl is likely to own T-shirts, jeans, dresses, both formal and informal. Both parties' goods could easily end up in the same wardrobe or drawer. He or she knowing of the range of goods for which use has been proved would, I think, take “clothing” to be fair as a description. He or she might limit the clothing to “casual clothing” but I have concluded in the end that “clothing” is appropriately fair.”

47. In the present case, the goods are sold in a variety of outlets, including TK Maxx and sports outlets, the names of which suggest snow sports or skiing. Mr Nicholls stated that he is responsible for promoting products bearing the ROJO mark to “fashion lifestyle” stores. TK Maxx is one such store. Customers might buy a padded jacket or thermal trousers for skiing from such an outlet, but they might equally buy such items for walking the dog in the wind and rain. The clothing

goods in the brochures, the invoices and the sales lists are varied. Clothing is a fair term to cover such goods.

48. In relation to footwear, socks are shown in the evidence, as are boots. There are no other types of footwear. In relation to hats, there is evidence of sales of caps, headbands, bandanas and knitted hats, but no other type of headgear. In *Animal*, Jacob J said this about footwear and hats:

“I finally turn to other disputed items in Class 25. First “footwear.” The dispute is whether “casual” should qualify this. There has been use for casual shoes. It would seem to me here that it would be appropriate to cut the specification down to “casual footwear”—there is not the same breadth of use as for items of clothing. Next “headgear.” The only use has been in relation to knitted hats, fleece hats, and sun hats. The claimant wants to retain “headgear” in all its width, which would include all sort of headgear, for instance top hats, bowler hats and judges' wigs. Applying the Thomson test and I think “headgear” is too wide. The claimant offers no lesser specification and I accordingly accede to the defendant's suggestion to limit the specification to the three kinds of headgear for which use has been proved.”

49. I consider a fair description of the opponent's goods to be:

Class 9: Goggles for women and girls.

Class 25: Clothing, socks, boots, knitted hats; headbands, bandanas, caps; all for women and girls.

Proof of use outcome

50. The opponent may rely upon its earlier mark in respect of:

Class 9: *Goggles for women and girls.*

Class 25: *Clothing, socks, boots, knitted hats; headbands, bandanas, caps; all for women and girls.*

The grounds under sections 5(1) and 5(2)(a) of the Act

51. The parties' marks are as follows:

Opponent's mark	Applicant's mark
ROJO	ROJO

52. In *LTJ Diffusion SA v Sadas Vertbaudet SA* Case C-291/00 the CJEU stated:

“54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

The only possible difference on a close inspection is the very slight alteration in the font style between the two marks. This is a difference so insignificant that it would go unnoticed by the average consumer. In any event, the GC, in case T-346/04, *Sadas SA v OHIM*, stated that nothing prevents a word mark from being used in any script. The parties’ marks are identical.

53. The applicant’s clothing, footwear and headgear encompass the opponent’s goods, meaning they are also identical, as per *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM) Case T-133/05*⁶. Since the goods and marks are identical, the opponent’s section 5(1) ground succeeds. **The application is refused for clothing, footwear and headgear.**

Section 5(2)(a)

54. As the marks are identical, there is no need to set out the case-law relating to the comparison of marks. In terms of the other factors relevant to likelihood of confusion, I note the well-established principles from the CJEU in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(c) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(d) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

⁶ Goods and services can be considered as identical when the goods and services of the earlier mark are included in a more general category, included in the specification of the trade mark application. Vice versa, if the goods or services of the application are included in a more general category included in the specification of the earlier mark, they must be identical.

(e) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant.

(f) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(g) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

Comparison of goods and services

55. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

56. ‘Complementary’ was defined by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”

57. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

58. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held 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.”

59. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"... 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."

60. The issue of similarity between retail services and goods was considered by the General Court, in *Oakley, Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-116/06. The court's judgment in this cancellation action dealt with the similarity between goods and a retail services specification which was both unrestricted and restricted in scope. The conflict was between an earlier mark which was registered for goods in classes 18 and 25 and a later mark which had been registered for "Retail and wholesale services, including on-line retail store services; retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks, and wallets'. The GC upheld OHIM's decision that the goods in classes 18 and 25 were similar to "retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks, and wallets" since there is a complementary relationship between retail of the goods and the goods themselves:

"54 Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bau- und Heimwerkermärkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods."

62 It follows from all of the foregoing that the Board of Appeal was right to consider that services consisting of 'retail and wholesale of clothing, headwear, footwear, athletic bags, backpacks and knapsacks and wallets', and 'retail and wholesale services, including on-line retail store services', are similar to the goods covered by the earlier trade mark."

61. Retailing of clothing is similar to clothing because they are complementary and share similar trade channels. However, the goods and services are different in purpose and nature and not in competition. There is a reasonably average degree of similarity between the opponent's goods and the applicant's retail services connected with clothing, footwear and headgear.

62. In relation to the comparison between the opponent's goods and the applicant's retailing connected with bags and jewellery, there is no similarity within the parameters of the caselaw. Even though the GC has held that there is a certain (average) similarity between clothing and bags (in *El Corte Inglés SA v OHIM*, Case T- 443/05 and *Gitana SA v OHIM*, Case T-569/11) on account of aesthetic harmony, this is on the basis of complementarity and channels of trade. The comparison here is further removed: it is not between clothing and bags, but is between clothing and retailing of bags. The GC has held that there is no similarity between clothing and jewellery (in *Oakley* and in *Beyond Retro Ltd v OHIM*, Case T-170/12).

63. The applicant's term retailing of accessories is vague. It is difficult to establish what it covers. I do not think it covers goggles: these are sports goods. However, it could cover the sorts of goods which the opponent's brochures show in their "accessories" section, such as hats, headbands, gloves and scarves. In a department store, these sorts of goods might well be found in an accessories section. These goods are clothing, covered by the opponent's specification. On the logic applied to clothing and retailing of clothing, if accessories cover clothing items of certain types, there is an average degree of similarity between clothing and retailing of accessories (complementarity and channels of trade being the areas of similarity).

Average consumer and purchasing process

64. The average consumer is reasonably well informed and reasonably circumspect and observant, but his or her level of attention is likely to vary according to the category of goods or services. The average consumer for both parties' goods and services is the general public since the items offered for sale are general consumer items. Clothing may be tried on for size and comfort and varies considerably in price. A reasonable level of attention will be paid to its purchase, but not the highest level of attention.

65. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Joined cases T-117/03 to T-119/03 and T-171/03 the GC said:

"50. The applicant has not mentioned any particular conditions under which the goods are marketed. 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."

66. Assistance by sales staff is part of a retail service, as described by the CJEU in C-418/02 *Praktiker Bau- und Heimwerkermärkte*⁷. In relation to the goods and the retailing of the goods, the purchase will be primarily visual and will cause a reasonable, but not the highest level of attention to be paid. There may be a difference in attention levels in relation to retailing of expensive jewellery, where a higher level of attention may be paid to the selection of the retailing service (but not as high as would be paid if it were the expensive jewellery itself).

Distinctive character of the opponent's mark

67. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*⁸ 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).”

68. Neither party submitted that ROJO is anything other than an invented word. Mr Peacock, the opponent's attorney, states that as far as he is aware, it has no meaning. I will proceed on this basis because even though I know it is the Spanish word for red, I bear in mind the comments of Ms Amanda Michaels, sitting as the Appointed Person, in *Topy Trademarks Limited v Cofra Holding AG*, BL O/092/11:

“25. What the Hearing Officer had to consider was how the mark would be perceived by the average UK consumer. Whilst of course there are many persons whose mother tongue is not English who live and work in the UK,

⁷ “34 In that regard, it should be noted that the objective of retail trade is the sale of goods to consumers. That trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. That activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor.”

⁸ Case C-342/97

such persons are not the average UK consumer for the purposes of considering the pronunciation or meaning of a word.”

Invented words have a high degree of distinctive character. Although I have found that the opponent has proven genuine use on a range of goods for women and girls, the relatively modest scale of that use within the clothing sector does not enhance what is already a high level of (inherent) distinctive character.

Is there a likelihood of confusion?

69. Where there is no similarity between the goods and services, neither identity between the marks nor a good degree of distinctive character in the earlier mark will help the opponent’s case. The CJEU said in *Waterford Wedgwood plc v OHIM* Case C-398/07:

“35 It must be noted that the Court of First Instance, in paragraphs 30 to 35 of the judgment under appeal, carried out a detailed assessment of the similarity of the goods in question on the basis of the factors mentioned in paragraph 23 of the judgment in *Canon*. However, it cannot be alleged that the Court of First Instance did not take into account the distinctiveness of the earlier trade mark when carrying out that assessment, since the strong reputation of that trade mark relied on by Waterford Wedgwood can only offset a low degree of similarity of goods for the purpose of assessing the likelihood of confusion, and cannot make up for the total absence of similarity. Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

Consequently, the section 5(2)(a) ground fails in respect of retail services connected with bags and jewellery.

70. The parties’ marks are identical. This is important because a greater degree of similarity between the marks may be offset by a lesser degree of similarity between the goods and services (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). The earlier mark is highly distinctive. In relation to those goods for which there is an average degree of similarity a likelihood of confusion is inevitable in relation to retail services connected with clothing, footwear, headgear and accessories on the basis of notional and fair use across the range of goods covered by the parties’ specifications.

Does the applicant’s evidence of concurrent trading affect this conclusion?

71. Mr Buck states that his company is an independent retailer with 25 stores. However, he goes on to say that there are four ROJO stores. The implication is that the 25 stores do not relate to the mark ROJO for retail services. The website name is daniel footwear.com, although there is an assertion of use in relation to a website called rojoshoes.co.uk. There is no mention, and there are no exhibits, showing use by the applicant of the mark ROJO on clothing, footwear or headgear. The evidence

attests to retail services selling third party-branded goods. There are no exhibits at all to support Mr Buck's statement.

72. In *Samuel Smith Old Brewery (Tadcaster) v. Philip Lee* (trading as 'Cropton Brewery') [2011] EWHC 1879 (Ch); [2012] FSR 7 Arnold J. Said, at paragraph 95, that:

"... it is relevant to consider what opportunity there has been for confusion to occur and what opportunity there has been for any such confusion to be detected."

The brand names which Mr Buck states are sold in the four ROJO stores include Lulu Guinness, DKNY, Timberland, Ugg and Marc Jacobs. Mr Buck refers to the stores as specialising in 'designer' goods. In contrast, the opponent's goods are the sort of goods one would wear in outdoor pursuits (skiing, hiking, winter walking etc). They are not what I would describe as 'designer' goods normally associated with the brands the applicant sells. The applicant's turnover figures do not suggest that it can fall into the bracket of single, very famous stores. With the applicant only having four ROJO branded shops in the UK and selling a different type of merchandise to that of the opponent, I doubt whether either party has come to the attention of the other party's customers⁹. Trade from four stores is not concurrent trading on a scale which might indicate that there has been adequate opportunity for the capacity for confusion to have been properly tested and found not to exist.

73. The applicant's evidence does not persuade me that I should alter my finding regarding a likelihood of confusion.

Outcome

74. The result of the opposition is as follows:

(i) the opposition succeeds under section 5(1) in respect of clothing, footwear and headgear. **The application is refused for clothing, footwear and headgear;**

(ii) the opposition succeeds under section 5(2)(a) in respect of retail services connected with clothing, footwear, headgear and accessories. **The application is refused for retail services connected with clothing, footwear, headgear and accessories;**

(iii) the opposition fails in respect of retail services connected with bags and jewellery. **The application may proceed to registration in respect of retail services connected with bags and jewellery.**

⁹ See, to that effect, the Court of Appeal in *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45 and Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18.

Costs

75. Mr St Quintin submitted that scale¹⁰ costs should follow the event, but that if the opposition were to be partially successful (as it has been), the opponent ought still to have its costs because there had been no narrowing of its specification by the applicant.

76. In BL O/197/11 *Wm Morrison Supermarkets Plc v Nisa-Today's (Holdings) Limited*, Ms Amanda Michaels, sitting as the Appointed Person, said in a case where one party was largely, but not wholly, successful:

“22. The starting point for the exercise of the discretion, as set out in CPR 44.3 and reflected in Johnsey, is that costs should follow the event. As CPR 44.3(2)(a) puts it “the general rule is that the unsuccessful party will be ordered to pay the costs of the successful party”. Nevertheless, as CPR 44.3(4) indicates, the judge “must have regard to all the circumstances” which may include “whether a party has succeeded on part of his case, even if he is not be wholly successful.” The court may therefore make different orders for the costs incurred in relation to discrete issues and should consider doing so where a party has been successful on one issue but unsuccessful on another.

...

Approaching the matter in accordance with CPR 44.3, it seems to me that NISA ought be considered the successful party and to have its costs, subject to a deduction of an amount to reflect the fact that it was not wholly successful in the invalidation application or in respect of the opposition based on sub-section 5(2)(b). NISA was only unsuccessful in both the invalidation and opposition proceedings in relation to a fairly narrow range of goods, yet in my judgment some credit should be given to Morrisons to reflect the result. Without a breakdown of the parties’ costs by reference to the issues, a process which it would be disproportionate to ask the parties to undertake at this stage, making such a reduction is necessarily a rough and ready process. Doing the best I can, in my judgment it would be appropriate to reduce the costs awarded to NISA by 20% to reflect its partial level of success (save as stated in sub-paragraph 27(d) below).”

77. Accordingly, since the opponent has had the lion’s share of success but has not been wholly successful, it is entitled to a contribution to its costs, offset by the partial failure of its opposition. The opponent has been successful in relation to all three of the categories of class 25 goods and in four out of the six categories of retail services in class 35. Its success rate, as a rough and ready measure, has been about 80%. Applying the scale of costs, I assess the costs contribution as follows:

Preparing a statement and considering the counterstatement	£300
Opposition fee	£200

¹⁰ The scale of costs is set out in Tribunal Practice Notice 4/2007.

Preparing evidence and evidence in reply	£1500
Attending the hearing	£800
Sub-total	£2800
Set-off @ 20%	-£560
Total	£2240

78. I order Daniel Footwear Limited to pay to Rojo Australia Pty Limited the sum of £2240. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of May 2014

**Judi Pike
For the Registrar,
the Comptroller-General**