

O-170-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2491277
IN THE NAME OF ICEBREAKER LIMITED

AND

OPPOSITION THERETO UNDER NO 98571
BY GILMAR S.P.A.

TRADE MARKS ACT 1994

IN THE MATTER of application
No 2491277 in the name of
Icebreaker Limited and
opposition thereto under
No 98571 By Gilmar S.p.A.

Background

1. On 27 June 2008, Icebreaker Limited (“Icebreaker”) made an application under No 2491277 for registration of the trademark ICEBREAKER REALFLEECE. The application claims a priority date of 17 June 2008 based on an earlier application made in New Zealand. Registration is sought in respect of the following specifications of goods:

Class 24:

Fabrics, all being made wholly or principally of real woollen fleece

Class 25:

Clothing; footwear; headgear; all being made wholly or principally of real woollen fleece.

2. Following publication of the application in the *Trade Marks Journal*, Notice of Opposition was filed on behalf of Gilmar S.p.A (“Gilmar”). The grounds of opposition are based on sections 5(2)(b) and 5(4) of the Act. Under section 5(2)(b) Gilmar relies on its earlier registration no. 1175324. Under section 5(4)(a), it relies on a number of earlier rights to which I will refer later in this decision. Gilmar’s objections are directed solely at the application for registration insofar as it relates to goods in class 25.

3. Icebreaker filed a counterstatement in which, essentially, it denied the claims made. Both parties filed evidence in these proceedings which I do not intend to summarise but will refer to as necessary in this decision. Neither party requested to be heard but both filed written submissions in lieu of attendance at a hearing. I reach this decision taking all this material into account.

Decision

The objection based on section 5(2)(b) of the Act

4. I deal first with the objection founded on section 5(2)(b) of the Act. Section 5(2)(b) reads:

- “5- (2) A trade mark shall not be registered if because -
- (a) ...

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

5. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

6. In these proceedings Gilmar is relying on its registration No 1175324. This registration has an application date of 20 May 1982 which, clearly, is prior to that of the application for registration. As such it qualifies as an earlier mark under the above provisions.

7. Section 6A of the Trade Marks (Proof of Use, etc) Regulations 2004 read as follows:

“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 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)

(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)....”

8. Also of relevance is section 100 of the Act which states:

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

9. The earlier mark was registered on 30 May 1984 and the application for registration was published on 10 October 2008. The earlier mark is therefore subject to the Trade Marks (Proof of Use, etc.) Regulations 2004 and I go on to consider whether genuine use has been shown of this mark. In doing so, I take into account that the relevant period is the five year period ending with the date of publication of Icebreaker’s application, i.e. 11 October 2003 to 10 October 2008.

10. The guiding principles to be applied in determining whether there has been genuine use of a mark are set out in *Ansul BV v Ajax Brandbeveiliging BV* [2003]RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. From these cases it is clear that:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

11. In its written submissions Icebreaker claims that Gilmar has not provided any evidence of use of the earlier mark, as registered, during the relevant period and thus the opposition on this ground should be rejected. For its part Gilmar accepts that the evidence of use it has provided does not show the mark as registered but relies on the provisions of section 6A(4) in this regard. This allows use of the mark in a form differing in elements which do not alter the distinctive character of the mark as registered. This test has been broken down by the Appointed Person in the *NIRVANA* case (BL O/262/06) as follows:

“33...The first question...is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...”

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above the second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the difference at all.”

12. The Appointed Person had regard to a number of authorities. In *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25 the Court of Appeal dealt with issues relating to use of a trade mark in a form which does not alter the distinctive character of the mark in the form in which it was registered. In that case Lord Walker stated:

“43 ...The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

"Bare ruin'd choirs, where late the sweet birds sang"

is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of "whose eyes?-- registrar or ordinary consumer?" is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgement, to analyse the "visual, aural and conceptual" qualities of a mark and make a "global appreciation" of its likely impact on the average consumer, who: "normally perceives a mark as a whole and does not proceed to analyse its various details."

13. Also of relevance are the comments, in the same decision, of Sir Martin Nourse, where he stated, at paragraph 12:

“Mr Bloch accepted that, in relation to a particular mark, it is possible, as Mr Salthouse put it, for the words to speak louder than the device. However, he said that it does not necessarily follow that the entire distinctive character of the mark lies in the words alone. That too is correct. But there is yet another

possibility. A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or to put it the other way round, the words have dominance which reduces to insignificance the other recognisable elements...”

14. The mark as registered consists of the word ICEBERG within a lozenge shaped device. Icebreaker refers to the fact that the letters within the mark have serifs on them which, it says, is unusual. Gilmar submits such serifs are common to capital letters in a number of typefaces. In my view, whilst the letters which form the word ICEBERG as registered do have serifs, there is nothing about them which is particularly striking or unusual. The evidence shows the word ICEBERG to have been used in a variety of typefaces but the difference in the earlier mark as registered and the evidence of use shown is the absence of the lozenge. In my view the lozenge will simply be seen as a border or frame to the word within it, with the word ICEBERG being the dominant and distinctive element. I do not consider the absence of the lozenge alters the distinctive character of the trade mark. Consequently, the use of the mark as shown in the evidence satisfies the provisions of section 6A(4)(a).

15. Icebreaker submits that Gilmar’s use of the word ICEBERG has been shown “in relation only in relation to certain designer outerwear, namely cardigans, sweaters, skirts, t-shirts, vests, shirts, dresses, jackets, jeans and trousers” and thus the specification of goods should be limited to “designer clothing other than underwear”.

16. I presume from this that Icebreaker is trying to draw a distinction between designer clothing and more “off the peg” clothing. I reject this argument. The distinction is not reflected in the specification of goods as registered and applied for nor is it shown in the evidence of use filed. In *McQueen Clothing Co Trade Mark Application* [2005] RPC 2, Geoffrey Hobbs Q.C., sitting as the Appointed Person said:

“When assessing the objections to registration in the present case, it is necessary to assume normal and fair use of the marks for which registered trade mark protection has been claimed”.

17. Even if the specifications were worded to reflect this market distinction, I am mindful of the findings of the Court of First Instance (now General Court) in *Saint-Gobain SA v OHIM* Case T-364/05 where it said:

“67...With regard to the conditions under which the goods at issue are marketed, the applicant’s argument that the goods covered by the earlier marks are sold almost exclusively in shops and supermarkets, whereas the mark applied for refers solely to goods sold by mail order, is without foundation. As has already been held, on a comparison of the goods, nothing prevents the goods covered by the earlier mark from also being sold by mail order.....Furthermore, it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods sets out in the registration of the earlier mark. That description in no

way limits the methods by which the goods covered by the earlier mark are likely to be marketed.”

18. In its notice of Opposition, Gilmar claims to have used its earlier mark on all of the goods for which it is registered, i.e. *Articles of clothing; but not including footwear other than woven or knitted footwear*, however, in its written submissions dated 30 March 2010, it says “the evidence [shows] use of the mark in relation to outer clothing and, given the specification for the registration, and taking into account the views [of Icebreaker], an appropriate specification for the goods [...] for the purposes of this opposition, would be:

“Articles of outer clothing; but not including footwear other than woven or knitted footwear”.

19. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 it was said:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having

adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

20. In *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03, it was said:

“42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45. It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services

defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or subcategories.

53 [...] although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

21. I also take note of the decision in *Animal Trade Mark* [2004] FSR 19 wherein it was said:

"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 picky 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.”

22. With the above in mind, I go on to consider the evidence of use with a view to determining on which goods use has been shown.

23. Massimo Marani, who is Gilmar’s Chief Financial Officer, has filed a witness statement dated 25 June 2009. In it, he states that Gilmar first started using the mark ICEBERG in relation to clothing in the UK in 1982. He gives the following details of sales of “wear” made under the mark within the years covered by the relevant period:

2003	2004	2005	2006	2007	2008
€1,509,983.71	€1,421,941	€625,074	€267,869	€185,514	€249,061

24. Marketing expenditure is given as follows:

2003	2004	2005	2006	2007	2008
311,376	281,161	246,906	169,602	223,517	166,587

25. Whilst Mr Marani’s witness statement is silent on the matter, I take it that the marketing expenditure figures are also given in euros. These figures are said to relate to both clothing and “accessories” such as bags, wallets, watches, bracelets, necklaces, glasses and sunglasses. I am not provided with any further information that would allow me to say how much of this expenditure relates to clothing alone.

26. The evidence shows use of the mark on many differing items of clothing. For example, MM36 shows use inter alia on trousers, tops, dresses, jackets, shorts and cardigans. MM35 shows use inter alia on tunics, dungarees and raincoats. MM30 shows use on ponchos as well as coats (at least one of which appear to be made from fleece (p602)). I have been unable to find any use in relation to woven or knitted footwear. Clothing is regularly sub-divided by category such as under clothing or outer clothing. Outer clothing is a term which describes the goods for which use has been shown and is one which is readily and clearly definable within the trade and by the average consumer and, taking the evidence as a whole, is one which accurately describes the use made of the mark.

27. The turnover figures during the relevant period have, to a large extent, been declining and, whilst they are not, in my view, likely to represent a significant trade in terms of the relevant market as a whole, I have no doubt they have created and preserved a market share. Under the provisions of section 6A of the Act, I therefore find there has been genuine use of the earlier mark in relation to “articles of outer clothing”.

28. With this in mind, I go on to consider the opposition under section 5(2)(b). This reads:

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

(a) ...

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

29. In determining the question under Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B. V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel BV v Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;
- (e) 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 v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) 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*, paragraph 24;
- (g) 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*, paragraph 26;
- (h) 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*, paragraph 41;

- (i) 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*, paragraph 29.

30. In essence the test under Section 5(2)(b) is whether there are similarities in marks and goods which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

Similarity of the goods

31. Following my findings in paragraph 27 above, the goods to be compared are as follows:

Icebreaker's goods	Gilmar's goods
Clothing; footwear; headgear; all being made wholly or principally of real woollen fleece	Articles of outer clothing

32. In considering this issue, I am mindful of the guidance provided by the CFI in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) ("Meric")* Case T-133/05, at paragraph 29, which states:

"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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)."

33. As "articles of outer clothing" is a subset of "clothing" and could include clothing made wholly or principally of real woollen fleece, the goods are identical.

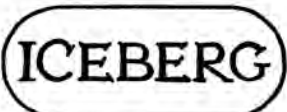
Relevant public and the purchasing act

34. All of the respective goods are everyday consumer goods bought by the general public. They may be bought in a variety of ways, e.g. in a retail store, online or by mail order. Because of the need to ensure they meet the purchaser's individual needs and/or tastes as to such matters as what material they are made from and their size or style, these are goods which will be bought with some, though not

necessarily the highest, degree of care, with more care likely to be taken over a higher cost item, such as a bespoke outfit which is likely to be bought less frequently than a lower cost item, such as a t-shirt. I am also mindful of the comments of the General Court in cases such as *Société Provençale d'Achat et de Gestion (SPAG) SA v OHIM* Case T-57/03 and *React Trade Mark* [2000] RPC 285, where guidance is provided that, bearing in mind the manner in which clothing goods will normally be purchased, it is the visual impression of the marks that is the most important. This would normally be from a clothes rail, a catalogue or a website rather than by oral request. Notwithstanding this, aural and conceptual considerations remain important and should not be ignored.

Similarity of the marks and their dominant and distinctive components

35. When assessing this factor I must do so with reference to the visual, aural and conceptual similarities between the respective marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). For ease of reference, I set out below the respective marks:

Icebreaker's mark	Gilmar's mark
ICEBREAKER REALFLEECE	

36. Icebreaker's mark consists of two elements: the words ICEBREAKER and REALFLEECE. REALFLEECE naturally breaks down into the two descriptive words, REAL and FLEECE and thus the word ICEBREAKER is, in my view, the dominant and distinctive element within the mark given that the application seeks registration for articles made from real woollen fleece. Gilmar's mark also consists of two elements: the word ICEBERG which is presented within a lozenge shaped border.. As set out in paragraph 14 above, the word ICEBERG is the dominant and distinctive element within this mark.

37. Both marks start with the letters I-C-E-B. Gilmar submits that "the next two letters in the mark ICEBERG, "E" and "R" are also found as the fifth and sixth letters of the mark applied for, albeit with their sequence reversed." Whilst this is not disputed by Icebreaker, I do not think this increases the degree of similarity between the marks. Icebreaker's mark consists of two, ten letter words whereas Gilmar's mark is a single, seven letter word. In my view, whilst both marks start with the same four letters, and have a degree of visual similarity because of it, the degree is an extremely low one given the clear differences in the marks.

38. From an aural perspective, similar considerations apply. As both marks start with the same four letters there is a degree of aural similarity however Icebreaker's mark consists of two separate words of three and two syllables respectively whereas Gilmar's mark consists of a single two syllable word. The marks have an extremely low degree of aural similarity.

39. The word ICEBERG is an ordinary dictionary word with a well known meaning of a body of ice floating in the sea. ICEBREAKER is also an ordinary dictionary word. It

may bring to mind a type of boat which is reinforced to enable it to clear a passage through frozen waters or, alternatively may be recognised as something that eases the flow of conversation at e.g. a social event. REALFLEECE is not, as far as I know, a dictionary word but naturally breaks down into its component parts and brings to mind wool which has been sheared from a sheep or similar animal. When taken as a whole, Icebreaker's mark brings to mind something made of a fleece and which will keep out the cold in icy weather. To the extent that both marks have something to do with ice there is a degree of similarity from a conceptual viewpoint however in my view that similarity is again extremely low in the overall comparison of the respective marks.

The distinctive character of the earlier mark

40. The mark ICEBERG is said by Mr Marani to have been first used in the United Kingdom, in relation to clothing, in 1982. Turnover figures are given which range from €1,114,077 in 1998, generally staying around the €1.5m mark for the years 1999 to 2004 before dropping to €185,514 and €249,061 in 2007 and 2008 respectively. Whilst nothing has been provided which allows me to determine the size of the relevant market as a whole it is likely that Gilmar's share, based on the turnover figures given, is extremely small. Invoices provided at MM25 show sales to 3 stores in the London and Essex areas. Whilst advertising figures have been given, they are said to relate to a wide range of goods sold under the mark and do not allow me to establish how much, if any, was spent on marketing clothing as opposed to other goods. Whilst it is clear the mark has been used I am unable to say on the basis of the evidence filed that the distinctiveness of the mark has been enhanced through that use such that it has any reputation. That said, whilst the word ICEBERG is a dictionary word, it has no particular meaning in relation to the goods and is therefore inherently distinctive.

Likelihood of confusion

41. In reaching a decision on whether there is a likelihood of confusion, I must make a global assessment based on all relevant factors. I have found that identical goods are involved and that there is an extremely low degree of similarity from the visual, aural and conceptual viewpoints. On a global appreciation and considering all relevant factors including imperfect recollection, I consider the differences between the marks outweigh the similarities such that there is no likelihood of confusion. The average consumer would not mistake one mark for the other nor be confused as to the economic origin of the goods sold under the respective marks. **The opposition based on section 5(2)(b) of the Act therefore fails.**

The objection based on section 5(4)(a) of the Act

42. Section 5(4)(a) reads:

“5.(4)A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b).....”

A person thus entitled to prevent the use of a trade mark is referred to in the Act as the proprietor of an “earlier right” in relation to the trade mark.”

43. The requirements for a passing off action have been restated many times and can be found in the decision of Geoffrey Hobbs QC sitting as the Appointed Person in *Wild Child Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponent’s goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods offered by the applicant are goods of the opponent; and
- (3) that the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.

44. Clearly there is an evidential burden on an opponent who relies on a passing off claim. The opponent also has to establish the claim at the relevant date. The Act does not set out the relevant date at which the matter must be judged. Article 4.4(b) of First Council Directive 89/104, however, makes the position clear:

(b) rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent mark;”

45. In the event that an applicant is not shown to have used his mark in advance of the filing date of his trade mark application, the relevant date will be the filing date.

46. Under this ground, Gilmar relies on seven earlier rights. In its Notice of Opposition, Gilmar refers to its earlier rights ICEBERG, SPORT ICE, ICE JEANS, ICE ICE ICEBERG, ICE J, ICE B and ICE ICEBERG. It says that each of these marks was first used in the UK in 1982 in relation to “a wide range of clothing and fashion accessories”. It goes on to say that “[a]s a result of its use of the marks containing the element “ICE”, the opponent has acquired a reputation in such marks and the mark applied for is likely to be taken as another mark in the opponent’s range. It is also likely to be confused with the mark ICEBERG for the reasons given in relation to the ground of opposition based on UK registration no. 1175324”.

47. I have already found, at paragraph 40 above, that Gilmar's evidence of use of its mark ICEBERG is insufficient to find it has a reputation in respect of clothing. The reputation it claims under this ground is said to extend to "fashion accessories" but nowhere in its Notice of Opposition (nor indeed in its written submissions) does Gilmar set out what these "fashion accessories" might be nor is whatever Gilmar intends it to mean explained in any way.

48. The need for precision and clarity in a party's pleaded case has been emphasised in a number of reported cases. The following is from *Julian Higgins' Trade Mark Application* [2000] RPC 321:

"If the pleadings do not identify the right issues, the issues the parties propose to argue about, then it cannot be expected that with any consistency the right evidence will be adduced at the hearing. The pleadings are supposed to identify the issues to which evidence will be directed. If the pleadings do not properly identify the issues someone, sooner or later, is going to be taken by surprise."

and this from *Demon Ale Trade Mark* [2000] RPC 345:

"Considerations of justice, fairness, efficiency and economy combine to make it necessary for the pleadings of the parties in Registry proceedings to provide a focused statement of the grounds upon which they intend to maintain that the tribunal should or should not do what it has been asked to do. The statement should not be prolix. It should, however, be full in the sense indicated by Mr Simon Thorley Q.C. in *COFFEEMIX Trade Mark* [1998] R.P.C. 717 at 722:

"It must be full in the sense that it must outline each of the grounds ... relied upon and state the case relied upon in support of those grounds. It should be as succinct as possible, but it must be complete".

49. The term "fashion accessories" is one that could cover any number of goods. Absent specific information I am left to guess at what goods are relied upon by Gilmar. That is not a position from which I can make a determination. Gilmar has failed to establish that its earlier right ICEBERG has the requisite goodwill or reputation and therefore the objection under section 5(4)(a) based on this right fails.

50. The remaining six marks relied upon under this ground, I will deal with together. Again, I have no idea what "fashion accessories" Gilmar relies upon, however, in respect of its claim to have a reputation for each of these earlier rights in relation to "clothing", the evidence simply does not support it. Whilst there are some, very limited, references in the evidence to some of the earlier rights claimed, (see e.g. exhibit MM32, page 815 (ICE JEANS) and page 889 (ICE ICE ICEBERG), exhibit MM27 page 417 (ICE J), page 414 (ICE B) and page 550 (ICE ICEBERG)) I have no evidence of e.g. turnover or marketing expenditure for any of the individual rights relied upon nor any evidence of where, when or on what particular goods they may have been used. In view of this, Gilmar's claim that "the mark applied for is likely to be taken as another mark in [Gilmar's] range" does not even get off the ground. The objection under section 5(4)(a) fails in its entirety.

51. The opposition has failed on all counts and Icebreaker is entitled to an award of costs in its favour. I take into account the fact that Gilmar filed a significant volume of evidence which was not particularly focussed on the issues to be determined. I also take into account that no hearing took place.

52. I award costs to Icebreaker on the following basis:

Considering Notice of Opposition and preparing and filing a counterstatement	£300
Preparing and reviewing evidence and submissions	£1500
Total	£1800

53. I order Gilmar S.p.A to pay Icebreaker Limited the sum of £1800. 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 26 day of May 2010

**Ann Corbett
For the Registrar
The Comptroller-General**