

O-227-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2609100
BY JACOB ARMANI
TO REGISTER THE TRADE MARK**

MARCO POLO

IN CLASSES 12 & 20

AND:

**CONSOLIDATED OPPOSITIONS THERETO UNDER NOS.
103541 & 103542
BY MARC O'POLO INTERNATIONAL AB
& MARC O'POLO INTERNATIONAL GMBH**

BACKGROUND

1. On 2 February 2012, Jacob Armani applied to register **MARCO POLO** as a trade mark. The application was accepted and published for opposition purposes on 30 March 2012 for the following goods:

Class 12 – Strollers; buggies; safety car seats for children; Vehicle seat belts, vehicle seat Belts for children; vehicle safety seats for children and babies; vehicle safety harnesses and restraints, all for use with carry cots, vehicle safety seats or pram babies; vehicle booster seats for children; anchorage fittings sold in kit form, for use with any of the aforesaid goods; vehicle safety apparatus for children; baby carriages; prams; pushchairs; buggies; wheeled trollies and transporters all in incorporating or for use with carry cots or car seats; prams; pushchairs; buggies; buggy boards; pushchairs boards; covers and liners for pushchairs and prams including those with integrated foot muffs, cosy toes and or hoods; tricycles; trailers; cycle seats for babies and children; parts and fitting for all the aforesaid goods; all included in class 12.

Class 20 - Cribs; high chairs; baby walkers; bouncing seats; baby rocking chairs; sleeping bags for baby and children; carry cots; baby carriers;

2. On 29 June 2012, Marc O’Polo International AB and Marc O’Polo International GmbH (“the opponents”) filed notices of opposition. Following amendment, these oppositions are now only directed at the following goods in Mr Armani’s application:

Class 12 - Covers and liners for pushchairs and prams including those with integrated foot muffs, cosy toes and or hoods; parts and fitting for all the aforesaid goods; all included in class 12.

Class 20 - Cribs; high chairs; baby walkers; bouncing seats; baby rocking chairs; sleeping bags for baby and children; carry cots; baby carriers;

3. The oppositions are based upon grounds under sections 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”) for which the opponents rely upon all of the goods and services in the following trade marks:

CTM no. 10097624 for the trade mark **Marc O’Polo** applied for on 5 July 2011; the status of this trade mark is “opposed”. It has been applied for in respect of:

Class 20 - Furniture, mirrors, picture frames; Pillows; Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

Class 24 - Woven goods and textiles, Not included in other classes, In particular bed linen, Towels, Coverlets, Table linen; Bed and table covers.

Class 25 - Clothing, In particular bathrobes, Footwear, Headgear.

UK designation of International Registration (“IR”) no. 1114889 for the trade mark:

Marc O’Polo

applied for on 9 December 2011 (and claiming an international convention priority date of 8 December 2011 from Germany). The date of protection in the UK is 4 October 2012 and the trade mark is protected for the following goods and services:

Class 8 - Hand tools (hand-operated); cutlery, forks and spoons; razors; tableware, table cutlery, runcible spoons, serving cutlery, knives.

Class 20 - Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; frames, cushions, decorative cushions, pillows, seat cushions, coat hangers, magazine racks, coatstands (furniture), trays (not of metal), interior and home furnishing objects of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics, holders for curtains, curtain holder, not of textile material, bottle closures, not of metal.

Class 21 - Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes; pot covers, flower pots, flower-pot covers, tins, soap dishes and boxes, crockery, tableware, other than knives, forks and spoons, coffee and tea services, drinking vessels, coffee and teapots, glass, cups, cans, jugs, decanters, drinking bottle, cooking, roasting and baking ware, pots, pans, coasters, bottle cooler, wine cooler, champagne cooler, trays, bread baskets, domestic, egg cups, candlesticks, candelabras, soap dispensers, perfume sprayer and atomizers, vases, bottle openers, corkscrews, ice pails, salt cellars, pepper pots, pepper mills, napkin rings, napkin holders, knife rests, tea warmer candle holders, pot cloth, pot gloves, underplates, table plates, dishes, salad bowls, storage boxes/cases, oil vinegar cruets, cooking spoons, basting spoons, for kitchen use, mixing spoons, champagne buckets; serving utensils, silverplate.

Class 24 - Textiles and textile goods, not included in other classes; bed and table covers; bed linen, bed sheets, fitted bed sheets, bed ticks, mattress covers, sheet, goods of terry-towelling, towels, bath linen, bath towels, beach towels, facecloths, blankets, coverlets, table linen, cloth napkins, table mats, table

runners, place mats, household linen, pillowcases, covers for decorative cushions, pillowcases, seat covers, chair back covers, throws, curtains, drapes, net curtains, fabric, handkerchiefs of textile, wallpapers of textile, quilts, tablecloths on the roll, kitchen textiles, dishtowels, shower curtains of textile or plastic, holders for curtains, curtain holders of textile material.

Class 27 - Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wallhangings (non-textile); carpet bridges, rugs, bathroom rugs, bath mats.

Class 35 - Retail services, wholesale services, on-line services or mail order catalogue services in the fields: clothing, articles of clothing, fashion accessories, belts, footwear, headgear, cosmetics, body care preparations, beauty care preparations, perfumeries, essential oils, spectacles, spectacle frames, eyeglass frames, sunglasses, fittings for spectacles and sunglasses, spectacle cases, leather and imitations of leather and goods made thereof, bags, handbags, trunks, luggage, rucksacks, umbrellas, parasols, purses, pocket wallets, key cases, watches and chronometric instruments, watch straps, jewellery, costume jewellery, jewelry, interior furnishings, furniture, mirrors, frames, picture frames, cushions, decorative cushions, pillows, holders for curtains, curtain holders, bottle closures, textiles and textile goods, bed covers, bed linen, fitted bed sheets, goods of terry-towelling, towels, coverlets, quilts, table linen, tablecloths, table mats, table runners, tablecloths on the roll, cloth napkins, kitchen textiles, dishcloths, home textiles, shower curtains of textile or plastic, holders for curtains, curtain holders of textile materials, cutlery, table ware, runcible spoons, table cutlery, forks, spoons, knives, silverplate, kitchenware, household goods, combs, sponges, brushes, paint brushes (excluding for painting purposes), glassware, porcelain, earthenware, crockery, carpets, rugs, mats, bath mats, bathroom rugs, floor coverings, wallpapers.

4. On 9 August 2012, Mr Armani filed counterstatements in which he denies the grounds of opposition. Mr Armani: (i) points to a UK trade mark registration which he owns i.e. no. 2602546 for the trade mark Marco Polo applied for on 25 November 2011 and registered on 2 March 2012 in respect of “Perambulators and push-chairs, and parts and fittings therefor included in Class 12”, and (ii) queries what he considers to be the broad/unclear terms contained in the opponents’ specifications, adding that in his view, there is no evidence that the opponents produce similar goods to his. Insofar as the competing trade marks are concerned, Mr Armani says that while they may be similar they are not identical.

5. The proceedings were consolidated. Only the opponents filed evidence. While neither party asked to be heard, the opponents filed written submissions during the evidence rounds and in lieu of attendance at a hearing; I will refer to these submissions as necessary below.

The opponents' evidence

6. This consists of a witness statement dated 3 December 2012 from Richard Mark Hiddleston, a trade mark attorney and solicitor at Elkington & Fife LLP, the opponents' professional representatives. Attached to Mr Hiddleston's statement as exhibit RMH1 are extracts obtained from the *New Oxford Dictionary of English* (2001 edition) which he notes provides the following definitions:

- Bed – a piece of furniture for sleep or rest, typically a framework with a mattress and coverings.
- Crib – a child's bed with barred or lattice sides; a cot.
- Furniture – large moveable equipment, such as tables and chairs, that are used to make a house, office, or other space suitable for living and working.

DECISION

7. Sections 5(2)(a) and 5(2)(b) of the Act read as follows:

“5(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, or

(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, or

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

8. 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,

(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.”

9. In these proceedings the opponents are relying upon the two trade marks shown in paragraph 3 above, both of which constitute earlier trade marks under the above provisions. Given the interplay between the date on which Mr Armani’s application was published and the date on which the UK designation of the opponents’ IR achieved protection in the UK, this earlier trade mark is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004. Insofar as CTM no. 10097624 is concerned, should it be necessary, the opponents will not be able to rely upon this trade mark until such time as it achieves registration (as I mentioned above it is currently under opposition).

Section 5(2)(b) – case law

10. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the cases of the Court of Justice of the European Union (CJEU) mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing process

11. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services and then to determine the manner in which these goods and services will be selected by the average consumer in the course of trade. Although in their notices of opposition the opponents indicate they are relying upon all of the goods and services in their earlier trade marks, their submissions focus on their own goods and services in classes 20, 24, 25 and 35. As a consequence, it is the average consumer of these goods and services and those of Mr Armani that I will consider. Whilst the average consumer of all of these goods and services will be a member of the general public, the average consumer of Mr Armani's goods is also likely to be a parent or someone buying on their behalf. As all of the goods are likely to be self selected in traditional retail settings and from the pages of

a catalogue or website, visual considerations will, in my view, dominate the selection process, although not, I think, to the extent that aural considerations can be ignored. The goods at issue are not, for the most part, likely to be highly expensive. While some may be purchased relatively infrequently, for example, the opposed goods in Mr Armani's application and furniture and household textiles in the opponents' earlier trade marks, others, for example clothing, will be purchased on a more regular basis. Considered overall, I think that the average consumer will pay a reasonable level of attention (i.e. no higher than the norm) to the purchase of the vast majority of the goods at issue. As to the manner in which the average consumer will select the opponents' services, visual considerations having encountered the trade mark on, for example, signage in the high street and in advertisements in publications in catalogues and on the Internet, are, once again, likely to dominate the selection process. Considered in the context of the goods at issue and much like with the selection of the goods themselves, I think the average consumer will pay a reasonable level of attention to the selection of the services at issue.

Comparison of trade marks

12. The competing trade marks are: MARCO POLO and Marc O'Polo and

Marc O'Polo

In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34, the CJEU said in relation to what constitutes an identical trade mark:

“51 There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

52 However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question (see, to that effect, *Case C-342/97 Lloyd Schuhfabrik Meyer* [1999] E.C.R. I-3819 at para.[26]).

53 Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

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.”

13. Mr Armani’s trade mark consists of the words MARCO and POLO presented in upper case as two separate words. Each of the opponents’ trade marks consist of the word Marc presented in title case accompanied by a letter O in upper case an apostrophe symbol and the word Polo also presented in title case. Although the UK designation is presented in a slightly stylised script, the degree of stylisation present is minimal and does not serve to further distinguish the competing trade marks. Whilst in his counterstatement Mr Armani denies that the competing trade marks are identical, he appears to accept that they are similar. Having applied the guidance in *Sadas*, I have come to the conclusion that the visual differences I have identified above, will not, when considered in combination, go unnoticed by the average consumer. As a consequence, the opposition based upon section 5(2)(a) of the Act is dismissed. However, whilst not identical, the competing trade marks are, in my view, highly similar visually, and, despite their differing presentations, aurally and, (to the extent that any message will be triggered in the average consumer’s mind), conceptually identical.

Comparison of goods and services

14. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market.
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods,

for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

15. In reaching a conclusion, I will also keep in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 i.e.

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by 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).”

16. In relation to what constitutes complementary goods and services, the comments of the Court of First Instance (now the General Court) in *Boston Scientific Ltd v OHIM* case T-325/06 are relevant:

“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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

17. The only evidence filed in these proceedings is the dictionary definitions I have reproduced above. Consequently, in approaching the degree of identity/similarity in the competing goods and services, I have only the opponents’ submissions and my own experience to assist me.

Mr Armani’s goods in class 12

18. In their submissions, the opponents argue that the following of their goods and services should be considered similar to Mr Armani’s goods in class 12.

Opponents' goods and services	Mr Armani's goods
<p data-bbox="186 233 467 264">CTM no. 10097624</p> <p data-bbox="186 306 784 447">Class 24 - Woven goods and textiles, Not included in other classes, In particular bed linen, Towels, Coverlets, Table linen; Bed and table covers.</p> <p data-bbox="186 489 651 558">Class 25 - Clothing, In particular bathrobes, Footwear, Headgear.</p> <p data-bbox="186 600 613 632">UK designation no. 1114889</p> <p data-bbox="186 674 781 995">Class 24 - Textiles and textile goods, not included in other classes; bed and table covers; bed linen, bed sheets, fitted bed sheets, mattress covers, sheets, goods of terry-towelling, towels, bath linen, bath towels, blankets, coverlets, pillowcases, covers for decorative cushions, pillowcases, seat covers, chair back covers, throws, quilts.</p> <p data-bbox="186 1037 784 1314">Class 35 - Retail services, wholesale services, on-line services or mail order catalogue services in the fields: clothing, cushions, decorative cushions, pillows, textiles and textile goods, bed covers, bed linen, fitted bed sheets, goods of terry-towelling, towels, coverlets, quilts, home textiles.</p>	<p data-bbox="824 233 1430 411">Covers and liners for pushchairs and prams including those with integrated foot muffs, cosy toes and or hoods; parts and fitting for all the aforesaid goods; all included in class 12.</p>

In relation to the goods in CTM no. 10097624 the opponents say:

“14. The nature of the opponents’ goods in class 24 are all textile in nature and are therefore identical to the applicant’s goods. The purpose of the respective goods are again identical in that each set of goods is intended to provide warmth and protection from the weather for the user. The manufacturer of these items are all likely to be the same, since both will include the production and manufacture of textiles and woven products.”

In relation to the goods in UK designation no. 1114889, the opponents repeat the arguments reproduced above in relation to class 24. In relation to the services they say:

“16...Similarly the opponents’ retail services include retail services relating to such items. Again, these goods and services are all likely to be manufactured or

provided by the same manufacturer and to be purchased by the same relevant consumer. In addition, these products are all likely to be sold through the same retail outlets and from the same areas within department stores.”

19. In approaching Mr Armani’s specification in class 12 it is, in my experience, more likely that it is the liners that will have the integrated foot muffs and cosy toes, whereas both the covers and liners may have integrated hoods. The users of Mr Armani’s goods will, most likely, be parents or those buying on a parent’s behalf. Such goods come in a range of different materials. For example, rain covers for pushchairs and prams are invariably made of PVC whereas liners for such goods are made from a variety of materials including, for example, cotton.

20. The goods in the opponents’ earlier trade marks are, broadly speaking, textiles and textile goods at large, textiles for household use (in class 24) and articles of clothing (in class 25). Dealing with the opponents’ goods in class 24 first, the users of these goods will also be members of the general public but not necessarily parents etc. As such goods are or may be made from a range of natural and/or man-made fibres, there is clearly some similarity insofar as the physical nature of the competing goods is concerned. The purpose of Mr Armani’s goods is very specific i.e. to provide a baby or infant being transported in a pushchair or pram from protection against the elements and to make the journey for the baby or infant as comfortable as possible (by keeping it dry, warm, cool etc.). The opponents’ specifications’ in class 24 include textiles and textile goods at large and a range of named goods i.e. bed and table covers, bed linen, bed sheets, fitted bed sheets, mattress covers, sheets, goods of terry-towelling, towels, bath linen, bath towels, blankets, coverlets, pillowcases, covers for decorative cushions, seat covers, chair back covers, throws, quilts and table linen, all of which are for household use. With the exception of, perhaps, blankets and quilts (which would have a similar physical nature and intended purpose to Mr Armani’s goods and which would, in my experience, be sold in the same bespoke retail outlets and the same areas of department stores), the purpose and method of use of the opponents’ goods is not in any meaningful way similar to the goods in Mr Armani’s application. Similarly, with the exception of perhaps blankets and quilts, Mr Armani’s goods are, in my view, neither in competition with nor (in the sense outlined in *Boston Scientific*) complementary to the opponent’s goods in class 24. As to the trade channels, the opponents argue that the manufacturers of the competing goods may be the same; in the absence of evidence on this point, I am simply not in a position to conclude that this is the case. When considered from a retail perspective, other than perhaps blankets and quilts, one would not, in my experience, expect to find the opponents’ goods for sale in, for example, the same part of a department store as Mr Armani’s goods (the latter of which would be sold alongside pushchairs and prams). Considered overall, Mr Armani’s goods in class 12 are, in my view, similar (albeit to a relatively low degree) to the opponents’ blankets and quilts.

21. Turning to the opponents’ goods in class 25, once again the users and physical nature of Mr Armani’s goods may be similar. As the opponents’ goods in class 25 includes clothing for babies and infants (which may incorporate some of the same

features as Mr Armani's goods i.e. foot muffs, cosy toes and hoods), the purpose of the goods may be similar although the method of use will differ. Whilst the respective goods are unlikely to be complementary in the sense outlined in *Boston Scientific*, as the average consumer may prefer to use an article of clothing to keep its baby warm as opposed to a padded liner for its pram or pushchair, there is, I think, an element of competition between the respective goods. As to the trade channels, there is no evidence that a manufacturer of clothing would also manufacture Mr Armani's goods. However, when considered from a retail perspective, it is, in my experience, quite usual to find clothing for babies and infants sold in proximity to prams, pushchairs and their related accessories. Whilst, considered overall, I think the degree of similarity between Mr Armani's goods and the opponents' clothing in class 25 is still relatively low, the degree of similarity is, in my view, somewhat higher than that in relation to the opponents' goods in class 24.

22. Insofar as the opponents' services in class 35 are concerned, its services which relate to the sale of the goods in class 24 are, in my view, a further step away from a trade in the goods in that class upon which I have already commented above. As to the opponents' services in class 35 which relate to the goods in class 25, while there may be some similarity between, for example, the retailing of babies' and infant's clothing and Mr Armani's goods, as this is once again a further step away from a trade in the clothing itself, this does not put the opponents in any better position overall. Finally, as the parts and fittings in Mr Armani's specification all relate to the named goods in class 12, they are likely to be highly similar to the named goods and my comments above apply equally to them.

Mr Armani's goods in class 20

23. In their submissions, the opponents' argue that the following of their goods and services should be considered identical or similar to Mr Armani's goods in class 20.

Opponents' goods and services	Mr Armani's goods
<p>Both earlier rights</p> <p>Class 20 - Furniture, Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.</p> <p>UK designation no. 1114889</p> <p>Class 24 - Textiles and textile goods, not included in other classes; bed covers; bed linen, bed sheets, fitted bed sheets, mattress covers, blankets, coverlets,</p>	<p>Cribs; high chairs; baby walkers; bouncing seats; baby rocking chairs; sleeping bags for baby and children; carry cots; baby carriers;</p>

<p>pillowcases, covers for decorative cushions, quilts.</p> <p>CTM no. 10097624</p> <p>Class 24 - Woven goods and textiles, Not included in other classes, In particular bed linen, Coverlets, bed covers.</p>	
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The opponents submit:

“21...Highchairs and baby rocking chairs are clearly forms of chairs and would be included and be identical to furniture.

22. Cribs are again a form of specific type of bed designed for children and young infants and would therefore be included within the term furniture and should therefore again be considered identical to furniture...

24. Bouncing seats are specifically designed for young infants to provide seating and also entertainment while they are sitting. As such, these items again should therefore be considered as included within furniture and therefore identical.

25. Baby walkers are again items of furniture which are specifically designed to assist young infants in walking and learning to walk and again should be considered identical.

26. Carry cots, baby carriers are items specifically designed to be moved and to be transportable but are also designed for sleeping for infants and young children. As such, these items are again items of furniture. In the alternative, they are similar in the sense that they are likely to be produced by the same manufacturer, to be sold to the same consumer and to be sold through the same retail outlets, as in particular baby cribs and other items of baby furniture.

27. In the alternative, all of the above goods should be considered similar to furniture. In particular, the term furniture will include all forms of furniture including baby furniture. As such, these items are all likely to be produced by the same manufacturer, to be sold to same customer and to be sold through the same retail outlets. In terms of their nature, these items are all designed effectively as items of furniture or to be used in the home to assist with living. As such, the nature and purpose of these goods is the same. In the alternative, the nature of these goods is complementary to furniture.

28. Moreover, the applicant’s goods in class 20 can all be made from wood, cork, reed, wicker or plastics. In particular, it is common for cribs, baby rocking chairs and other chairs to be made from wicker or cane or plastics. As such, all of these items would be included within the term “Goods...of...”. In the alternative, these

goods should again be considered similar in terms of their nature, purpose and channels of trade.

29. Sleeping bags for baby or children are all likely to be made from textiles or other woven goods. In addition, the purpose of these goods is to aid sleep and to provide warmth for babies and children. As such, these items are identical in terms of their nature and purpose, inter alia, to [the goods shown above in class 24].

30. As such, the nature and purpose of these respective goods are identical. In addition, these products are again likely to be produced by the same manufacture and to be sold through the same retail outlets...these products are likely to be purchased by the same customers and to be sold through the same retail outlets.

31. Moreover, sleeping bags for babies and children are clearly complementary to the goods covered by the opponents' marks in class 24."

24. The terms cribs, high chairs and baby rocking chairs in Mr Armani's specification would all, in my view, be encompassed by the term furniture in the opponents' earlier trade marks and as a consequence these goods are, on the principle outlined in *Gérard Meric*, identical.

25. As bouncing seats and baby walkers may (and often are) made of, inter alia, plastic, they are identical to "Goods (not included in other classes of....[at least] plastics" in the opponents' earlier trade marks. However, if that conclusion is considered to be too broad brush, the term furniture in the opponents' specifications includes babies' furniture; the users and physical nature of babies' furniture and bouncing seats and baby walkers may be the same. The intended purpose of bouncing seats and baby walkers is, as the opponents say, to provide seating for babies and infants whilst also providing entertainment and helping them to learn to walk; to the extent that babies' furniture and bouncing seats and baby walkers provide seating there is some similarity. Babies' furniture is, in my experience, sold in the same types of bespoke retail outlets as bouncing seats and baby walkers and in the same areas of department stores. I think it unlikely that bouncing seats and baby walkers are in competition with babies' furniture or that they are, in the sense outlined in *Boston Scientific*, complementary to babies' furniture. Consequently, even if my primary conclusion above is wrong, the similarities I have identified between the opponents' babies' furniture and Mr Armani's bouncing seats and baby walkers still, in my view, results in a degree of similarity between the competing goods, albeit, I think, a relatively low degree.

26. Carry cots and baby carriers are primarily designed to transport babies from one location to another. While there may be similarities in the users and physical nature of these goods and the opponents' babies' furniture, their intended purpose and method of use are different and they are, in my view, neither in competition with nor complementary to babies' furniture. While there is no evidence they will be produced by

the same manufacturer, both sets of goods will be sold in the same types of bespoke retail outlets and in the same areas of department stores. Overall, I consider there to be a degree of similarity between the competing goods, albeit once again a low degree. That leaves sleeping bags for babies and children. The users and physical nature of such goods may be the same as the opponents' goods in class 24. The purpose of Mr Armani's goods is, as the opponents argue, to provide babies and children with warmth and to aid sleep. Goods such as blankets and quilts in the opponents' specification have a similar purpose. Although the respective goods are not complementary in the sense outlined in *Boston Scientific*, as one may be chosen instead of the other, there is, I think, an element of competition between the goods. As to channels of trade, sleeping bags for babies and children may well be sold in the same types of bespoke retail stores as the opponents' blankets and quilts and, when sold in department stores, may be sold in the same areas of the store. Overall, I consider there to be a reasonable degree of similarity between the competing goods.

Distinctive character of the opponents' trade marks

27. The distinctive character of the opponents' trade marks can be appraised only, first, by reference to the goods and services for which they have been applied for/protected and, secondly, by reference to the way they will be perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As far as I am aware (and there is no evidence to the contrary), the opponents' earlier trade marks neither describe nor are non-distinctive for the goods and services for which they have been applied for/protected. Whilst not in the category of an invented word, they are, absent use, deserving of at least a normal degree of inherent distinctive character (the minimal degree of stylisation present in the UK designation does not improve the opponents' position in this respect).

Likelihood of confusion

28. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of the opponents' earlier trade marks as the more distinctive these trade marks are the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

29. Earlier in this decision I concluded that the competing trade marks are visually highly similar, aurally and conceptually identical and that the earlier trade marks are possessed of at least a normal degree of inherent distinctive character. Having further concluded that the average consumer is a member of the general public who would buy the goods by predominantly visual means and who would pay a reasonable degree of attention when doing so, I characterise the degree of similarity in the competing goods and services as ranging from identical to relatively low. Applying those conclusions to the matter at hand, I am more than satisfied that the very high degree of overall similarity between the competing trade marks will offset even a low degree of similarity in the goods and is likely to result in direct confusion i.e. Mr Armani's trade mark will be mistaken for the trade marks of the opponent. The opposition to the opposed goods in classes 12 and 20 succeeds.

30. In reaching this conclusion, I have not overlooked Mr Armani's comments to the effect that he has a similar trade mark already registered for similar goods. As the application date of this trade mark is 25 November 2011, it only predates the application date of the opponents' UK designation (8 December 2011) and not its CTM application (5 July 2011). Regardless, the presence of this earlier trade mark does not assist Mr Armani for the reasons outlined in Tribunal Practice Notice ("TPN") 4/2009 the relevant part of which reads as follows:

"1. A number of counterstatements in opposition and invalidation actions have sought to introduce as a defence that the applicant for registration/registered proprietor has a registered trade mark (or trade mark application) for the same or a highly similar trade mark to that which is the subject of the proceedings that predates the earlier mark upon which the attacker relies.

2. Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6 of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds.

3. The position was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) T-269/02:

"24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of

its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (Case T 6/01 Matratzen Concord v OHIM - Hukla Germany (MATRATZEN) [2002] ECR II 4335, paragraph 55). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities."

Overall conclusion

31. The opposition to the opposed goods has been successful. Although the opposition is based upon two earlier trade marks (one of which is still at the application stage) as the UK designation is both protected and contains all the necessary goods in classes 20 and 24 for the opponents to succeed, there is no need to await the final outcome of the opponents' community trade mark. Mr Armani's trade mark application will, in due course, proceed to registration for:

Class 12 – Strollers; buggies; safety car seats for children; Vehicle seat belts, vehicle seat Belts for children; vehicle safety seats for children and babies; vehicle safety harnesses and restraints, all for use with carry cots, vehicle safety seats or pram babies; vehicle booster seats for children; anchorage fittings sold in kit form, for use with any of the aforesaid goods; vehicle safety apparatus for children; baby carriages; prams; pushchairs; buggies; wheeled trollies and transporters all in incorporating or for use with carry cots or car seats; prams; pushchairs; buggies; buggy boards; pushchairs boards; tricycles; trailers; cycle seats for babies and children; parts and fitting for all the aforesaid goods; all included in class 12,

and, unless subject to any successful appeal, will be refused in respect of:

Class 12 - Covers and liners for pushchairs and prams including those with integrated foot muffs, cosy toes and or hoods; parts and fitting for all the aforesaid goods; all included in class 12.

Class 20 - Cribs; high chairs; baby walkers; bouncing seats; baby rocking chairs; sleeping bags for baby and children; carry cots; baby carriers.

32. As the opponents have been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of TPN 4 of 2007. Using that TPN as a guide but keeping mind the similarity in the pleadings and the fact that the proceedings were consolidated at an early stage, I award costs to the opponents on the following basis:

Preparing statements and considering Mr Armani's statements:	£300
Evidence:	£200
Opposition fees:	£400 (i.e. 2 x £200)
Written submissions:	£300
Total:	£1200

33. I order Jacob Armani to pay to Marc O'Polo International AB and Marc O'Polo International GmbH the sum of **£1200**. 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 30th day of May 2013

C J BOWEN
For the Registrar
The Comptroller-General