

O/399/21

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3438315
BY IT LUGGAGE LIMITED
TO REGISTER AS TRADE MARKS:**



IN CLASS 18

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 419290
BY SAMSONITE IP HOLDINGS S.À.R.L.**

BACKGROUND AND PLEADINGS

1. On 22 October 2019, it luggage Limited (“the applicant”) applied to register the series of trade marks displayed on the cover page of this decision, under number 3438315 (“the application”). It was accepted and published in the Trade Marks Journal on 1 November 2019 in respect of goods in class 18, namely, ‘*wide handle design luggage; wide handle design suitcases*’.

2. On 3 February 2020, Samsonite IP Holdings S.à.r.l. (“the opponent”) filed a notice of opposition. The opposition is brought under sections 3(1)(b), 3(1)(c) and 3(3)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods of the application.

3. Under sections 3(1)(b) and 3(1)(c) of the Act, the opponent argues that the marks convey a clear meaning and are merely descriptive of a characteristic of the goods concerned, i.e. that they are the lightest of their kind in the world. The opponent contends that the stylisation of the marks is minimal and that the device of a hand reaching for a suitcase handle designates the kind of the goods, i.e. wide handled design suitcases or items of luggage. On this basis, the opponent submits that the applicant’s marks are descriptive and non-distinctive and, as a result, are not capable of distinguishing the goods of one undertaking from those of another undertaking.

4. As for its claim under section 3(3)(b) of the Act, the opponent contends that weight is one of the most important factors in the purchasing decision for consumers and plays an important role in the marketing of these kinds of goods. According to the opponent, the applicant’s marks falsely communicate that its goods are the lightest of their kind in the world and are, therefore, deceptive. In support of its claim, the opponent refers to other trade mark applications filed by the applicant in the UK and EU which have either been withdrawn or refused registration. Further, the opponent refers to court decisions in other jurisdictions regarding the advertising of the applicant’s goods.

5. The applicant filed a counterstatement denying the grounds of opposition. Moreover, the applicant submits that the other applications and decisions referred to by the opponent are not relevant to the matter before me.

6. Both parties filed evidence in chief and the opponent filed evidence in reply. The opponent also filed written submissions during the evidence rounds. A hearing took place before me, by video conference, on 29 April 2021. The opponent was represented by Mr Chris Aikens of Counsel, instructed by CMS Cameron McKenna Nabarro Olswang LLP. The applicant was represented by Miss Georgina Messenger of Counsel, instructed by Boulton Wade Tennant LLP.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive and, therefore, this decision continues to make reference to the trade mark case law of the EU courts.

EVIDENCE AND SUBMISSIONS

8. The opponent's evidence in chief comprises the witness statement of Ms Kara Louise Tompsett dated 10 August 2020, together with Exhibits KLT-1 to KLT-7, and that of Mr Richard Andrew Lamb dated 17 August 2020, together with Exhibits RAL-1 to RAL-10. Ms Tompsett is a trade mark attorney in the employ of CMS Cameron McKenna Nabarro Olswang LLP, the opponent's representatives in these proceedings, and confirms that she has conducted this matter. Mr Lamb is a Director of the opponent and confirms that he is responsible for intellectual property matters for the group of companies of which the opponent is a part.

9. The applicant's evidence consists of the witness statement of Mr Paul Richardson dated 17 November 2020, together with Exhibits PR-1 to PR-4. Mr Richardson confirms that he is the Commercial Director of the applicant, a position he has held since August 2000. He was also the General Manager of the applicant prior to his current post.

10. The opponent filed evidence in reply in the form of the second witness statement of Mr Lamb dated 15 January 2021, together with Exhibits RAL2-1 and RAL2-2.

11. As noted above, the opponent also filed written submissions during the evidence rounds.

12. Whilst I do not propose to summarise the evidence and submissions here, I have taken it all into consideration in reaching my decision and will refer to them below, as and where necessary.

DECISION

Sections 3(1)(b) and (c)

13. The relevant parts of section 3(1) of the Act are as follows:

“3(1) The following shall not be registered –

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) [...]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

14. The relevant date for determining whether the marks are objectionable under the above provisions is the filing date of the contested application, namely, 22 October 2019.

15. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b).¹

16. The position under the above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.² The average consumer will vary depending on the particular goods and services concerned. However, in this case, the average consumer will consist of members of the general public. A medium degree of attention will be paid for the goods at issue as the average consumer will consider factors such as size, weight and durability during the purchasing process.

17. As referred to by both parties at the hearing, the case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*³ as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of

¹ *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, paragraph 25

² *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

³ [2012] EWHC 3074 (Ch)

21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. [...] due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

18. For ease of reference, I will refer to the series of marks as the applicant's 'mark', unless it becomes necessary to differentiate between the marks which comprise the series.

19. I note that the applicant's mark is comprised of several elements. In my view, given their relative size and position in the composition of the mark, the words 'WORLD'S LIGHTEST' are the most dominant of these elements. The words 'WIDE HANDLE DESIGN' are smaller and positioned underneath, though still contribute to the overall impact of the mark. Above the words, there is an image of a human hand with its index finger extended as well as that of a handle, both of which have some visual impact. Finally, in respect of the second mark of the series, the use of colour also has a degree of visual impact.

20. At the hearing, Mr Aikens submitted that the words 'WORLD'S LIGHTEST WIDE HANDLE DESIGN' communicate to consumers that the goods sold under the applicant's mark, that being suitcases and luggage with a wider than average handle, are the lightest of their kind in the world. As such, it is the opponent's contention that the words are entirely descriptive of the kind, quality and/or intended purpose of the applied-for goods. In contrast, Ms Messenger submitted that the term 'WIDE HANDLE DESIGN' cannot be descriptive as it has no standard industry definition. On this basis, she argued that consumers would not be able to immediately perceive, without further thought, a description of the goods in the mark.

21. In its evidence, the opponent produced dictionary definitions for each constituent word of the applicant's mark.⁴ I am prepared to accept these definitions, which confirm rather than contradict my original impression of the natural meaning of the words. The words 'WORLD'S LIGHTEST' will be understood by the average consumer as meaning the least heavy of its kind in the world. Turning to the words, 'WIDE HANDLE DESIGN', it is not decisive that it may not have a standard industry definition. Irrespective of this, given the ordinary and natural meaning of the words, I am of the view that the average consumer would understand the term to be describing products that have wide handles as a design feature. Indeed, the applicant uses it to describe

⁴ Exhibit KLT-1

the goods in its specification. Taken in combination, it is clear that the words 'WORLD'S LIGHTEST WIDE HANDLE DESIGN' will be immediately understood by the average consumer as a descriptive claim as to the kind and/or quality of the applicant's goods, i.e. that the luggage and suitcases offered under the applicant's mark are the lightest with wide handles on the market. I accept that the words may not be taken literally because they form marketing hyperbole, or 'puff'. However, that does not mean that the term ceases to be descriptive. The average consumer is well accustomed to exaggerated language and high-level claims that are employed in marketing. The descriptive message is clear and direct; the average consumer would certainly understand the nature of the claim that is being made. The applicant's mark contains a grammatically correct statement about the goods requiring no form of mental processing or analysis. The statement does not possess even a degree of tension or originality in the way its sentiment is expressed, as was held in *Audi v OHIM*.⁵ To my mind, the word elements of the applicant's mark would, therefore, be excluded from registration under section 3(1)(c) of the Act.

22. Nevertheless, the applicant's mark does not consist exclusively of the word elements: it also contains images of a handle and a human hand. I must now consider the impact of these figurative elements and what overall impression the mark will have upon the average consumer in relation to the goods. At the hearing, Mr Aikens argued that the figurative elements are descriptive and reinforce the message conveyed by the words. This was disputed by Ms Messenger, who instead submitted that the figurative elements prevent the mark as a whole from being exclusively descriptive.

23. In *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*,⁶ Arnold J. held that a descriptive word with a minor figurative embellishment was, as a whole, devoid of any distinctive character. The mark under consideration was:



⁵ Case C-398/08

⁶ [2013] F.S.R. 29

24. Arnold J found that:

“116. Taking all of the evidence into account, I conclude that the CTM is precluded from registration by art.7(1)(c) in relation to the services in issue because NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the service. The figurative elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word NOW, I consider that the CTM is devoid of distinctive character and thus unregistrable by virtue of art.7(1)(b).

117. I would comment that it appears to me that PCCW only succeeded in obtaining registration of the CTM because it included figurative elements. Yet PCCW is seeking to enforce the CTM against signs which do not include the figurative elements or anything like them. That was an entirely foreseeable consequence of permitting registration of the CTM. Trade mark registries should be astute to this consequence of registering descriptive marks under the cover of a figurative figleaf of distinctiveness, and refuse registration of such marks in the first place.”

25. Moreover, in *QuickWash*,⁷ Mr Geoffrey Hobbs, sitting as the Appointed Person held that figurative elements can also be non-distinctive and simply reinforce meanings conveyed by words. The mark under consideration, in respect of detergents, was:



⁷ BL O/205/04

26. Mr Hobbs found that:

“I do not think that the hearing officer was guilty of excision or dismemberment in his assessment of the present mark. Devices can be distinctive or nondistinctive, just like any other kind of sign. What matters are the perceptions and recollections that the sign in question is likely to trigger in the mind of the average consumer of the goods concerned and whether they would be origin specific or origin neutral.

I think that the verbal elements of the mark I am considering speak loud and clear. It seems to me that the message they convey is origin neutral. The artistic presentation neatly and skilfully builds upon and reinforces the origin neutral message in a way that makes it even more effective than the words alone might have been for that purpose. I think that net result is a well-executed, artistically pleasing, origin neutral device.”

27. At the hearing, Ms Messenger sought to distinguish the applicant’s mark from that considered by Arnold J and Mr Hobbs by referring me to two prior decisions of this Tribunal. The first was BL O/368/20 in which the following trade mark (amongst others) was found to be distinctive by the Hearing Officer:



&pizza

28. The next was BL O/086/18, in which the following trade mark as a whole was also considered distinctive:



SearchChildcare
Powered by **pacey**

29. Ms Messenger pointed to these trade marks as examples of where combinations of descriptive elements were found to be distinctive as they created impressions which were sufficiently removed from those produced by the descriptive elements. She also relied upon them to argue that figurative components can only be ignored where they are no more than minor embellishments. Although I concur with the findings of the Hearing Officers in those cases, I agree with Mr Aikens that they can be distinguished from the present case. The Hearing Officer in *&pizza* considered the mark unusual and suggestive, rather than descriptive. To my mind, there is nothing unusual or suggestive about the applicant's mark. Moreover, the Hearing Officer in *Search Childcare* concluded that, although the words 'Search Childcare' and the magnifying glass device were descriptive, the mark as a whole was distinctive by virtue of the words 'powered by PACEY'. The applicant's mark does not contain any such words that would render it distinctive as a whole.

30. In my view, the device of a handle is a representation, or is at least indicative, of the wide handles possessed by the goods. Furthermore, the device of a human hand is a lifelike representation of the same. The two devices interact with one another in such a way that the handle appears to be held by one extended finger, indicating that the product to which the handle belongs must be very light. While Ms Messenger denied that the finger is holding the handle, it is clear to me that, in the context of the verbal elements, that is how the devices will be perceived. In light of the foregoing, it is considered that the figurative elements reinforce the descriptive content of the words, and vice versa, in a similar way to the mark considered by Mr Hobbs in *QuickWash*.

31. Furthermore, although often registered in black and white, consumers are used to trade marks being used in colour. In respect of the second mark in the series, the colours applied to the devices are considered typical of those objects, while the use of blue and grey for the wording is not an unusual combination. In addition, although the applicant's mark utilises a curved font, it is essentially a standard typeface.

32. Therefore, I find that neither the devices, nor the use of colour, nor the font are sufficient to divert the average consumer's attention away from, or modify, the

descriptive message conveyed by the words 'WORLD'S LIGHTEST WIDE HANDLE DESIGN'.

33. I must now stand back from my analysis of the individual components and envisage how the entire mark would be understood by consumers in respect of the applied-for goods.⁸ Even when considering the combination of all the elements, my finding above remains unaltered; the sum of all the elements does not create an impression that is removed from that of the individual elements. The applicant's mark in its entirety will be understood as a mere descriptive claim that the goods offered under the marks are the lightest with wide handles on the market. As such, I find that the applicant's mark as a whole consists exclusively of signs or indications which may serve, in trade, to designate the kind and quality of the goods in class 18.

34. Even if I am wrong in my finding under section 3(1)(c), I am of the view that the applicant's mark would also be excluded from registration in respect of the goods in class 18 under section 3(1)(b). I acknowledge, as Ms Messenger highlighted, that a minimum degree of distinctiveness is sufficient to avoid an objection under this ground.⁹ Nevertheless, I am of the view that the applicant's mark as a whole would not serve to identify the applied-for goods as originating from a particular undertaking and to distinguish those goods from those of other undertakings.¹⁰ The applicant's mark is devoid of distinctive character for the goods and would not be perceived as an indicator of trade origin which could be relied upon for a repeat purchase (or avoidance). Rather, the average consumer would perceive the applicant's mark (whether or not in colour) as an origin neutral claim that the goods offered under it are the lightest with wide handles on the market.

Acquired distinctiveness

35. Although, as the opponent has correctly identified, it has not been expressly pleaded by the applicant, evidence has been filed in these proceedings and I now turn

⁸ *Putterscope*, BL O/096/11, paragraph 8

⁹ Case T-34/00 *Eurocool Logistik GmbH v OHIM*,

¹⁰ Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM*, paragraph 34

to consider whether, by the relevant date of 22 October 2019, the applicant had established acquired distinctiveness for its goods in class 18.

36. In *Windsurfing Chiemsee*,¹¹ the Court of Justice of the European Union provided the following guidance about the correct approach with regard to the assessment of the acquisition of distinctive character through use:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

¹¹ Joined Cases C-108 & C-109/97

37. I note that no details have been provided by the applicant to indicate the size of the relevant market or its share of that market. Neither are there any sales figures in evidence. There is also a distinct lack of evidence as to any amounts spent by the applicant in promoting its mark. The applicant has claimed to have used the term 'WORLD'S LIGHTEST' in the UK in relation to trolley suitcases and holdalls since 2009.¹² However, there is no evidence before me to substantiate such an assertion. Moreover, the applicant has referred to its trade mark application for the term 'WORLD'S LIGHTEST', highlighting that it was accepted for publication on the basis of acquired distinctiveness. An official letter from the Registry dated 13 December 2018 in these terms has been exhibited.¹³ Nevertheless, as I reminded the parties at the hearing, other trade mark applications are not relevant to these proceedings. Whether or not the Registry considered that mark to be factually distinctive at that time is of no consequence: the mark considered in that case differed from that in the present proceedings and I have not had sight of any evidence upon which that decision was founded. Both parties have filed evidence of use of the marks from the websites of the applicant and third parties.¹⁴ However, these clearly demonstrate that the 'it luggage' brand serves as an indicator of trade origin for the applicant's goods. The applicant's mark, on the other hand, is used descriptively. In any event, the evidence of use provided is simply not sufficient for me to determine how intensive, geographically widespread or long-standing the use of the mark has been. Other evidence of the mark in use is either undated or postdates the application and, therefore, cannot go to the position before the relevant date. Overall, the evidence before me falls a long way short of establishing that a significant proportion of the relevant public identified goods as originating from a particular undertaking because of the applicant's mark.

38. The opposition under sections 3(1)(b) and (c) succeeds in its entirety.

¹² Witness statement of Mr Paul Richardson, §3

¹³ Exhibit PR-1

¹⁴ Exhibit KLT-2, Exhibit KLT-6 and Exhibit RAL-2

Section 3(3)(b)

39. As I have already found in favour of the opponent under sections 3(1)(b) and (c), I do not consider it necessary to go on to assess the opposition under section 3(3)(b) of the Act.

CONCLUSION

40. The opposition has succeeded and, subject to any appeal against my decision, the application will be refused.

COSTS

41. The opponent has been successful and is entitled to a contribution towards its costs. At the hearing, both parties agreed that costs should be awarded from the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,800** as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£400
Preparing evidence and considering the applicant's evidence	£700
Preparing for and attending a hearing	£500
Official fee	£200
Total	£1,800

42. I therefore order it luggage Limited to pay Samsonite IP Holdings S.à.r.l. the sum of **£1,800**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 27th day of May 2021

James Hopkins
For the Registrar,
The Comptroller-General