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OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

OPERATIONS DEPARTMENT

B206a

Notification to the opponent of a decision

Alicante, 10/07/2013

CLEVELAND
10 Fetter Lane
London EC4A 1BR
REINO UNIDO

Your reference: PJH/CL/52357
Opposition number: B 001543910
Contested trade mark number: W00982020
Name of the opponent: Tulliallan Burlington Limited

Please see the attached decision which ends the abovementioned opposition proceedings. It was taken on 10/07/2013.

Mauro BUFFOLO

Enclosures (excluding the cover letter): 10 pages.

Please note that the decisions of the Opposition Division will not be signed by the responsible officials, but will only indicate their full name and carry a printed seal of the Office in accordance with Rule 55(1) CTMIR.

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OPPOSITION No B 1 543 910

Tulliallan Burlington Limited, 31 Hill Street, London W1J 5LS, United Kingdom (opponent), represented by Cleveland, 10 Fetter Lane, London EC4A 1BR, United Kingdom (professional representative)

a g a i n s t

Burlington Fashion GmbH, Oststr. 5, 57392 Schmallenberg, Germany (applicant), represented by Betten & Resch, Theatinerstr. 8, 80333 München, Germany (professional representative).

On 10/07/2013, the Opposition Division takes the following

DECISION:

1. Opposition No B 1 543 910 is upheld for all the contested goods namely:

Class 3: Soaps for cosmetical purposes, soaps for textiles, perfumery, ethereal oils, products to clean, care for and beautify the skin, the scalp and the hair; toilet articles, included in this class, deodorants for personal use, pre shave and after shave products.

Class 14: Jewellery, watches.

Class 18: Leather and imitations of leather, namely suitcases, bags (included in this class); small leather articles (included in this class), especially purses, wallets, key cases; umbrellas and sunshades.

2. International registration No W 982 020 is refused protection in the European Union or all of the contested goods. It may proceed for the remaining goods.
3. The applicant bears the costs, fixed at EUR 650.

REASONS

The opponent filed an opposition against some of the goods of the international registration designating the European Union No W 982 020, namely against the goods in Classes 3, 14 and 18. The opposition is based on, inter alia, the Community trade mark registration No 3 618 857. The opponent invoked Article 8(1)(b), 8(4) and Article 8(5) CTMR.

REPUTATION – ARTICLE 8(5) CTMR

For reasons of procedural economy, the Opposition Division will first examine the opposition in relation to earlier CTM, trade mark No 3 618 857, for which the opponent claimed repute in the EU in general and UK in particular.

According to Article 8(5) CTMR, upon opposition by the proprietor of an earlier trade mark within the meaning of Article 8(2) CTMR, the contested trade mark shall not be registered where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier Community trade mark, the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Therefore, the grounds of refusal of Article 8(5) CTMR are only applicable when the following conditions are met.

- a) The signs must be either identical or similar.
- b) The opponent's trade mark must have a reputation. The reputation must also be prior to the filing of the contested trade mark; it must exist in the territory concerned and for the goods and/or services on which the opposition is based.
- c) Encroachment upon reputation: the use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition under Article 8(5) CTMR (judgment of 16/12/2010, joined cases T-345/08 and T-357/08, 'BOTOCYL', paragraph 41). However, the fulfilment of all the above mentioned conditions may not be sufficient. The opposition may still fail if the applicant establishes due cause for the use of the contested trade mark.

In the present case, the applicant did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

b) The signs



Earlier trade mark

BURLINGTON

Contested sign

The relevant territory is the European Union.

However, for reasons of procedural economy, the analysis below focuses on the United Kingdom public.

Visually, the signs are similar to the extent that they both contain the word Burlington written in very similar typeface. On the other hand, they differ in that, while the CTM application is a single word the opponent's sign is a figurative sign which combines the words BURLINGTON ARCADE with a graphical element that reproduces in a stylised manner some architectural elements of the opponent's premises facade. Therefore the signs have a certain degree of visual similarity.

Aurally, the signs are similar to the extent that they both contain the word Burlington, and to that extent the signs are aurally similar. The pronunciation differs in the sound of the word ARCADE of the earlier sign which has no counterpart in the contested sign.

Conceptually, while the public in the relevant territory will perceive the word ARCADE of the earlier sign as *a covered passageway with arches along one or both sides or as a covered walk with stores along one or both sides*, the word BURLINGTON can be perceived by a part of the public as referring to the famous area of the Burlington gardens in London. Therefore the signs are conceptually similar.

c) Reputation of the earlier trade mark

Evidence on reputation

According to the opponent, the earlier trade mark has a reputation in the United Kingdom, among other countries.

Reputation implies a knowledge threshold which is only reached only when the earlier mark is known by a significant part of the relevant public for the goods or services it covers. The relevant public is, depending on the goods or services marketed, either the public at large or a more specialised public.

In the present case the EU was designated in the IR on 19/08/2008. However, the contested trade mark has a priority date of 26/02/2008. Therefore, the opponent was required to prove that the trade mark on which the opposition is based had acquired a reputation in the United Kingdom, prior to that date. The evidence must also show that the reputation was acquired for the goods and services for which the opponent has claimed reputation, namely:

Class 3: Cosmetics and toiletries, namely non-medicated toilet and bath preparations; perfumes; perfume; eau de parfum; eau de toilette; soaps; body soaks; body scrubs; shampoos and non-medicated preparations for the hair; anti-perspirants and deodorants for personal use; essential oils; massage oil; hand and body lotions and creams; body talc; shaving creams; aftershave lotions and balms.

Class 16: Stationery; writing implements and colouring implements; erasers; notepads; rulers.

Class 21: Glassware, porcelain and earthenware.

Class 29: Preserved, dried and cooked fruits and vegetables; jellies; jams and fruit sauces; milk and milk products.

Class 30: Coffee, tea, cocoa; flour and preparations made from cereals; cakes; biscuits; confectionery; mustard, condiments; ices; spices.

Class 32: Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 35: Rental and leasing of advertising space; organisation of exhibitions for commercial or advertising purposes; organisation of trade fairs for commercial purposes; advertising and promotion services and information services relating thereto; the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a range of general merchandise retail stores.

Class 36: Rental of shops and offices; leasing of, or management of real estate; leasing of, or space between or within, buildings; real estate management services; information services relating to the rental of shops and offices; real estate services; fund investments; mutual funds.

Class 41: Entertainment services; organisation of competitions; organisation of exhibitions; provision of recreation information; presentation of live performances; provision of sports facilities; provision of live music and live entertainment; provision of facilities for live band performances; provision of live entertainment; provision of live music; provision of live musical performances; provision of live shows.

In order to determine the mark's level of reputation, all the relevant facts of the case must be taken into consideration, including, in particular, the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

On 25/01/2012 and 27/02/2012 the opponent filed, in particular, the following evidence:

- A witness statement by Ms Nicola Helen Amsel, professional investigator specialised in intellectual property investigations, Fellow of the Institute of Professional Investigators. The investigation focused principally on the year period up to February 2008. From the wealth of the documents submitted it appears that the trade mark BURLINGTON ARCADE is since its beginning in 1819 very renowned for being a fashionable shopping centre in London with a reputation that exceeds the UK boundaries to all the world as a main touristic destination. The trade mark BURLINGTON ARCADE, according to the evidence, refers to the arcade built near the Burlington gardens in order to host a number of selected shops which retail different kind of luxury goods.
- Press clips: the opponent submitted a variety of press clips from different newspapers of national and international coverage such as "The Times", "Evening Standard", "Wall Street Journal" and the "Independent" among many others dated in the relevant period. They all refer to the trade mark in terms of a very reputed or known or fashionable shopping centre in London. They all underlie the prestige (or positive image) associated with it, its success, its long-standing presence in the market (since 1819). From the material submitted the Burlington Arcade is a shopping centre which gathers, in the same physical place, the arcade, various retail shops of prestigious or fashionable brands or tee saloon etc..

- A search at the British Library main catalogue which identified many hard copy materials (from the beginning of last century up to date) relating to the Burlington Arcade history or architecture.
- Various copy of the "Weekly Summary" made for the opponent by an independent source, namely the FootFall Ltd company provider of information services based on the retail and retail property industries. According to one of this report dated 08/01/2007, the annual performance in terms of weekly visitors was in average of 40.000 visitors per wee
- Mr. John Heaslop's statement describing the opponent's contribution for the advertising expenditure for the period from the 01/04/2006 to the 31/03/2007 was of £250.000.

The Opposition Division finds that the evidence submitted by the opponent does demonstrate that the earlier trade mark acquired a reputation through use in UK.

It is clear from the evidence that the earlier trade mark has been subject to long-standing and intensive use and is generally known in the relevant market, where it enjoys a consolidated position among the leading brands, as has been attested by diverse independent sources. The evidence shown and the various references in the press all unequivocally show that the mark enjoys a high degree of recognition among the relevant public in the fields of retailing services.

The applicant maintains that, from the evidence submitted, the opponent did not show a use of the opponent's figurative sign but only of the word BURLINGTON ARCADE and, therefore, the opponent wouldn't have proved the reputation of the registered sign. The argument must be rejected because the main components of the opponent's sign are the word elements while the figurative elements plays only an ancillary and decorative role. Moreover, the elements that are more likely to be retained and used by the public in order to identify the opponent's services is by using the word element BURLINGTON ARCADE. Therefore the opposition Division must conclude that the opponent's has successfully proven the reputation of the word BURLINGTON and ARCADE.

d) The 'link' between the signs

Preliminarily, it must be considered that, despite the wording of Article 8(5) CTMR, dissimilarity between goods and services is not a requirement for its applicability (judgment of 22/03/2007, T-215/03, 'VIPS', paragraph 33). When the contested trade mark covers goods or services which are identical or similar to those on which the opposition is based, the earlier mark with a reputation must enjoy protection which is at least as extensive as where the subsequent trade mark covers dissimilar goods or services (judgment of 09/01/2003, C-292/00, 'Davidoff', paragraphs 24 to 26, and judgment of 23/10/2003, C-408/01, 'Adidas', paragraphs 19 to 22).

As seen above, the earlier mark is reputed and the signs are similar to some extent. In order to establish that a later trade mark will encroach upon the reputation of an earlier mark, it is necessary to demonstrate that, given all the relevant factors, the relevant public will establish a link (or association) between the signs. The necessity of such a 'link' between the conflicting marks in consumers' minds is not explicitly mentioned in Article 8(5) CTMR but has been confirmed in the judgment of 23/10/2003, C-408/01, 'Adidas', paragraphs 29 and 31 and the judgment of 27/11/2008, C-252/07, 'Intel

Corporation', paragraph 66. It is not an additional requirement but merely reflects the need to determine, after all the factors relevant to the particular case have been assessed, whether the association that the public might establish between the signs is such that either detriment or unfair advantage is likely to occur.

Possible relevant factors for the examination of a 'link' include (judgment of 27/11/2008, C-252/07, 'Intel Corporation', paragraph 42):

- the degree of similarity between the signs;
- the nature of the goods and services, including the degree of similarity or dissimilarity between those goods or services, and the relevant public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of likelihood of confusion on the part of the public.

This list is not exhaustive and other criteria may be relevant depending on the particular circumstances. Moreover, the existence of a 'link' may be established on the basis of only some of these criteria.

First of all the degree of similarity of the sign is high because they share the more distinctive element of the opponent's sign, namely the word BURLINGTON. The other elements of the opponent's sign are clearly ancillary in relation to this word.

As far as the nature of goods is concerned, the Opposition Division considers that the goods in class are identical and, in spite that the other goods have been found different, the distance between these goods in class 14 and 18 and the services for which the opponent has proved a very high degree of reputation, namely *the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a range of general merchandise retail stores*. In fact, considering the history and the renown of the BURLINGTON ARCADE as a shopping centre make very likely that the public, confronted with the applicant's goods, will associate them with the services of the opponent. In fact, the opponent's trade mark is a label and a guaranty of quality and prestige that will be associated with any of the goods and services retailed through the various points of sales situated in the opponent's premises.

Therefore, taking into account and weighing up all the relevant factors of the case at hand, the Opposition Division concludes that when encountering the contested mark the relevant consumers will be likely to associate it with the earlier sign, that is to say, establish a mental 'link' between the signs. However, although a 'link' between the signs is a necessary condition for further assessing whether detriment or unfair advantage are likely, the existence of such a link is not sufficient, in itself, for a finding that there may be one of the forms of damage referred to in Article 8(5) CTMR (judgment of 26/09/2012, T-301/09, 'CITIGATE', paragraph 96).

e) Encroachment upon reputation

Use of the contested mark will fall under Article 8(5) CTMR when any of the following situations arise:

- it takes unfair advantage of the distinctive character or the repute of the earlier mark;
- it is detrimental to the repute of the earlier mark;
- it is detrimental to the distinctive character of the earlier mark.

Although in opposition proceedings detriment or unfair advantage may be only potential, a mere possibility is not sufficient for Article 8(5) CTMR to be applicable. While the proprietor of the earlier mark is not required to demonstrate actual and present harm to its mark, it must however 'adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment' (judgment of 06/06/2012, T-60/10 'ROYAL SHAKESPEARE', paragraph 53).

It follows that the opponent must establish that detriment or unfair advantage is probable, in the sense that it is foreseeable in the ordinary course of events. For that purpose, the opponent should file evidence or at least put forward a coherent line of argument, showing what the detriment or unfair advantage would consist of and how it would occur, which could lead to the prima facie conclusion that such an event is indeed likely in the ordinary course of events.

In the present case the opponent claims that the use of the contested trade mark would take unfair advantage of the distinctive character or the repute of the earlier trade mark and be detrimental to the distinctive character and repute of the earlier trade mark.

Detriment to the distinctive character of an earlier reputed mark (also referred to as 'dilution', 'whittling away' or 'blurring') is caused when that mark's ability to identify the goods/services for which it is registered and used as coming from its proprietor is weakened because use of a later similar mark leads to dispersion of the identity of the earlier reputed mark by making it less distinctive or unique (judgment of 27/11/2008, C-252/07, 'Intel', para. 29).

However, it must be taken into consideration what the Court also said in relation to the concept of "uniqueness" and that "the use of the mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique". The concept of uniqueness must be seen more therefore as meaning that a trade mark has a clear and individualised image (or not blurred image) for the public independently from the circumstances that it can actually coexist with one or few other signs.

The applicant in its last reply, does not contest the opponent's sign reputation but considers the fact that the opponent did not direct the opposition also against class 25 is a clear evidence that in fact their signs coexisted for a long period of time and, therefore, the opponent cannot claim that the application would be detrimental or would take unfair advantage of the distinctive character of the opponent's sign.

This argument cannot be accepted. In fact it could actually indicate that consumers are used to seeing the marks without confusing them. Moreover, it is important to note that the Office shall in principle be restricted in its examination to the trade marks in conflict.

Only under special circumstances may the Opposition Division consider evidence of the coexistence of other marks in the market (and possibly in the registry) on a national/Community level as an indication of 'dilution' of the distinctive character of the opponent's mark.

This has to be assessed on a case-by-case basis and such an indicative value should be treated with caution as there may be different reasons as to why similar signs coexist, e.g. different legal or factual situations in the past, or prior rights agreements between the parties involved. From the argument and evidence submitted by the applicant it cannot be inferred that the opponent, for the mere fact that it does not attack the class 25 has accepted a certain degree of coexistence with the applicant trade marks.

On the other hand the opponent must prove a likelihood of detriment on the basis of logical deductions made from an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case (see judgment of 16/04/2008, T-181/05, 'Citi', para. 78 as cited in judgment of 22/05/2012, T-570/10, 'Outils Wolf', para. 52).

According to the material or documentation submitted by the opponent, it appears quite clearly that the opponent's sign, in spite the fact that it coexists with the applicant's sign containing the word BURLINGTON and used by the applicant for socks, has acquired through the time a specific and clear individuality in UK and abroad. The fact that the signs coexist it is likely because they are not confused or associated by the public of reference which is familiarised with the presence of both of them.

However, as the opponent pointed out, this do not tantamount to concede that, considering the near uniqueness of the opponent's sign, especially in the field of luxury goods, there would not be a dilution if the same word BURLINGTON would now be used in other circumstances and for other goods than those for which the applicant used its trade mark.

Moreover, as the opponent argues, certain coexistence does not prevent any expansion of the Applicant's activities being impermissible in view of the damage it would cause to the Opponent's established reputation.

In fact, the Court has stated that "the more "unique" the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character" (judgment of 27/11/2008, C-252/07 'Intel' para. 74 and judgment of 28/10/2008, T-131/09 'Botumax'). Indeed, the earlier mark must possess an exclusive character in the sense that it should be associated by the consumers with a single source of origin – since it is only in this case that a likelihood of detriment to distinctiveness may be envisaged. If the same sign, or a variation thereof, is already in use in connection with a range of different goods, there can be no immediate link with any of the goods it distinguishes and, thus, there will be little or no room for further dilution.

Accordingly, the risk of dilution appears, in principle, to be higher if the earlier mark consists of a term which is distinctive per se. In such a case, re-use of the term in question by the contested trade mark is more likely to result in a dilution of the earlier mark.

The word BURLINGTON, which is the element of the trade marks that is giving rise to a similarity of signs enjoy a significant degree of inherent distinctive character which became even greater due to its reputation. In fact, in the present case, the word element "BURLINGTON" has no inherent meaning, but is a fanciful term with which the public will be faced in relation to the goods covered by the widely known earlier trade mark. Consequently, the use of an identical word element by another trade mark

registered for goods which may concern the general public will unquestionably result in the dilution of the distinctive character of the widely known earlier trade mark.

As seen above, encroachment upon reputation is an essential condition for Article 8(5) CTMR to apply. Encroachment may take three different forms. For an opposition to be well founded in this respect, it is sufficient if only one of these forms is found to occur. In the present case, as seen above, the Opposition Division has concluded that the contested trade mark would be detrimental to the distinctive character of the earlier trade mark. It follows that there is no need to examine whether other forms also apply.

Conclusion

Considering all the above, the opposition is well founded under Article 8(5) CTMR. Therefore, the contested trade mark must be rejected for all the contested goods.

Given that the opposition is entirely successful under Article 8(5) CTMR it is not necessary to examine the remaining grounds and earlier rights on which the opposition was based.

COSTS

According to Article 85(1) CTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the applicant is the losing party, it must bear the opposition fee as well as the costs incurred by the opponent in the course of these proceedings.

According to Rule 94(3), (6) and (7)(d)(i) CTMIR, the costs to be paid to the opponent are the opposition fee and the costs of representation, which are to be fixed on the basis of the maximum rate set therein.



The Opposition Division

Asta LUKOSIUTE

Mauro BUFFOLO

Birgit FILTENBORG

According to Article 59 CTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 CTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. According to Rule 94(4) CTMIR, such a request

must be filed within one month[✓] from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 has been paid (Article 2(30) CTMFR).