

INTELLECTUAL
PROPERTY OFFICE

Trade Marks Registry

Cardiff Road
Newport
South Wales
NP10 8QQ

Switchboard: 01633 814000
Direct Line: 01633 811028
Fax: 01633 811175
Minicom: 0645 222250
Website: www.ipo.gov.uk

World Intellectual Property Organisation (WIPO)
International Bureau
34, chemin des Colombettes
1211 Geneva 20
Switzerland

Our Ref: INT OPP 72234/TS/DR
Your Ref:
Date: 17 February 2011

Please quote our complete reference on all correspondence

Dear Sirs

**NOTIFICATION OF A TOTAL REFUSAL OF PROTECTION BASED ON AN
OPPOSITION BY THE UNITED KINGDOM INTELLECTUAL PROPERTY
OFFICE IN ACCORDANCE WITH ARTICLE 5 OF THE MADRID PROTOCOL**

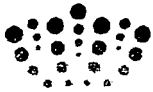
RE: International Registration number : 1033667
For the mark : 28BLACK
Holder of the International Registration : CALIDRIS 28 AG (SA)
Opposition number : 72234

I must advise you that following receipt of an opposition to the above Trade Mark, it is necessary to issue this formal provisional refusal letter. This provisional refusal covers all of the goods and services of the International Registration.

Please find attached a copy of the Form TM7 (Notice of Opposition) that was received by the United Kingdom Trade Mark Registry. Copies of these documents have been sent to the holder informing them of this provisional refusal.

We also attach:
Copies of the marks referred to in the statement of case.
Form TM8, for any reply to this opposition to be filed.

If the holder of the International Registration wishes to file a counterstatement, they must complete the attached Form TM8 and **return it to this office** together with the counterstatement within **two months** of the date of this letter. This period cannot be extended, except in the circumstances described below. The holder should note that failure to file a Form TM8 and counterstatement will result in the provisional refusal being upheld.



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If both parties to this dispute wish to negotiate and want to enter a 'cooling off period' then the time for filing the Form TM8 can be extended for a further seven months by the filing of a Form TM9c.

The Form TM8 and counterstatement should be received on or before **17 April 2011** unless a cooling off period is entered into by the parties.

Yours faithfully

Deborah Rich
TRIBUNAL SECTION
ASSISTANT CASEWORK EXAMINER

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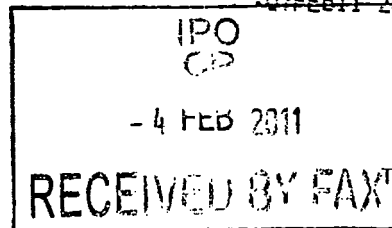
Boult Wade Tennant

FAX No. 02074307600

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**INTELLECTUAL
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3548512/ 0001 002882 TMD7.....
07FEB11 200.00 ACCOUNT M10336

Form TM7

Official Fee £200 due with this form

Trade Marks Registry
Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

Notice of opposition and statement of grounds

Please read the notes below before filing in this form

1. Trade Mark number.	M1033667
2. Full name of the applicant, international registration holder, or registered proprietor.	Calidris 28 AG (SA)
3. Full name and address (including postcode) of the opponent.	Michael Hicks Westward, St Agnes, Isles of Scilly, Cornwall, TR22 0PL, United Kingdom
4. Full name and address (including postcode) of the opponent's representative (if any).	BOULT WADE TENNANT VERULAM GARDENS 70 GRAY'S INN ROAD LONDON WC1X 8BT
5. Are there any related proceedings currently with the Registry or the courts? If so, give application, registration or opposition number.	
6. State the date that you notified the applicant, international registration holder, or registered proprietor that you intended to oppose the trade mark application, International designation or amendment. (Please see note below)	TM7a sent on 4 January 2011
7. Do you want a Preliminary Indication on section 5(1) and/or (2) grounds to be issued?	Yes

(REV APR09)

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Form TM7

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FAX No. 02074307800

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8. Declaration	I believe that the facts stated in this notice and in the attached statement of grounds are true
Your signature.	
Your name in BLOCK CAPITALS.	ALEXANDRA ELLIS
Date.	4 February 2011
9. Name and daytime phone number of the person we should contact in case of query	Alexandra Ellis 020 7430 7500
10. Your reference.	TBA/PEH/EAE/T112968GB02
11. Number of sheets attached to this form.	This is sheet 1 of: 12

Notes Number every extra sheet and say in question 11 above how many you have used.

An opposition launched without giving the applicant, international registration holder or the registered proprietor a reasonable opportunity to withdraw the application, international designation or amendment, may result in the opponent being ineligible for an award of costs.

Filing a form TM7a, notice of threatened opposition, may qualify as giving notice subject to the applicant being provided with a reasonable opportunity to withdraw the application.

Boxes 3 and 4: at least one of these should be located in the European Economic Area (EEA) or the Channel Islands

Before completing this form you should read the explanatory notes available.

(REV APR09)

Form TM7

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FAX No. 02074307600

P. 004

Use this sheet if you are basing your opposition on sections 5(1) or 5(2) of the Trade Mark Act on the basis of an earlier registered or pending mark.

Please note that opposition based on these grounds can only be made by the proprietor of an earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

- ☐ 5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark
- ☐ 5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
- ☒ 5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

Details of earlier trade mark

Number: 2,456,752

Is it a UK, Community or International mark? United Kingdom

Representation of the mark:

Please see attached representation

1. What goods or services covered by the earlier trade mark are relied upon for the grounds stated above?

- ☒ All
- ☐ Some (please specify)

(REV APR09)

Form TM7

2012

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P. 005

2. **Statement of use provision**— Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication date of the opposed application?

☐ Yes ☒ No

- 3(a). If yes, and the mark has been used, for which of the goods and services listed at question 1 is use claimed?

☐ All
☐ Some (please specify)

Or,

- 3(b). If yes and the mark has not been used, please state any proper reasons for non use.

Details of the mark you are opposing

4. Which goods or services in the application do you claim are identical or similar to those covered by the earlier mark and listed at question 3 (or at question 1 if the statement of use does not apply)?

☐ All
☒ Some (please specify)

Class 3 and Class 25

Use this space to give any further information to explain why you consider that there is a likelihood of confusion e.g. why you consider the respective marks or goods and/or services to be similar?

Please see attached Statement of Grounds

(REV APR09)

Form TM7

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FAX No. 02074307600

P. 006

Use this sheet if you are basing your opposition on section 5(3) of the Trade Marks Act on the basis of an earlier registered or pending mark.

Please note that opposition based on these grounds can only be made by the proprietor of an earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

☒ 5(3) It is identical with or similar to an earlier mark which has a reputation.

Details of the earlier trade mark

☐ Number: 2,458,752

Is it a UK, Community or International mark? United Kingdom

Representation of the mark:

Please see attached representation

1. For which goods or services covered by the earlier mark does it have a reputation?

☒ All

☐ Some (please specify)

2. State the goods or services in the application for which you say that use of the applicant's mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

☒ All

☐ Some (please specify)

3. What do you say the unfair advantage or detriment would be?

Please see attached Statement of Grounds

(REV APR09)

Form TM7

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4. **Statement of use provision**— Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication of the opposed application?

☐ Yes ☒ No

- 5(a). If yes, for which goods and services listed at question 1 is use claimed?

☐ All
☐ Some (please specify)

Or,

- 5(b). If yes and the mark has not been used, please state any proper reasons for non use.

Use this space to give any further information to explain why you are opposing the application on this ground.

Please see attached Statement of Grounds

(REV APR09)

Form TM7

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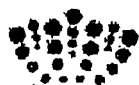
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Intellectual Property Office - Results

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**INTELLECTUAL
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Case details for Trade Mark 2456752

Explanation of terms used on this page

Case history including, where available, licensee details

Mark

Trade Mark 2456752 consists of 2 pages of images

[Previous](#)

[Page 1](#)

[Next](#)

28
twentyeight

Mark text:

28 twentyeight

28 twentyeight

Series of:

2

Status

Status:

Registered

Classes:

03, 04

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Intellectual Property Office - Results

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Relevant dates

Filing date: 24 May 2007
Next renewal date: 24 May 2017
Registration date: 06 February 2009

Publication in Trade Marks Journal

First advert:
Journal: 6753
Publication date: 19 September 2008
Registration:
Journal: 6775
Publication date: 27 February 2009

List of goods or services

Class 03: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; essential oils, cosmetics, hair lotions; dentifrices.
Class 04: Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions, fuels (including motor spirit) and illuminants; candles and wicks for lighting.

Names and addresses

Proprietor: Michael Hicks
 Westward, St Agnes, Isles of Scilly, Cornwall,
 TR22 0PL
Residence country: United Kingdom
Customer's ref: JEBS/ELP/T92762GB00
ADP number: 0911299001

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Intellectual Property Office - Results

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Service:	Boult Wade Tennant Verulam Gardens, 70 Gray's Inn Road, London, WC1X 8BT
ADP number:	0000042001

Earlier rights notification

Opted in for notifications

Explanation of terms used on this page

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P. 011

UK TRADE MARKS ACT 1994

International Registration No. 1033667 designating the United Kingdom
28BLACK
In classes 3, 25, 32 & 33
In the name of Callidris 28 AG (SA)
-and-
Opposition thereto by Michael Hicks

STATEMENT OF GROUNDS

1. The opponent is the registered proprietor of the following trade mark:
 - UK Registration No. 2456752 28 twentyeight / 28 twentyeight (Figurative) (series of 2) in classes 3 and 4.
2. Full details of this earlier mark are identified in the Notice of Opposition and attachments.
3. The opponent is therefore the proprietor of an earlier trade mark for the purposes of Section 6 of the UK Trade Marks Act 1994.
4. The mark opposed, International Registration No. 1033667 designating the United Kingdom, is an application to register the mark 28BLACK in classes 3, 25, 32 and 33.
5. The identical "28" element is wholly contained within 28BLACK. 28 is distinctive in relation to the goods of interest. The other element of the opponent's UK Registration No. 2456752 is "twentyeight" which is phonetically identical to "28".
6. The mark subject of International Registration No. 1033667 designating the United Kingdom is therefore similar to the opponent's earlier registration listed in paragraph 1.
7. The opponent's Registration No. 2456752 covers "bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; essential oils, cosmetics, hair lotions; dentrifices" in class 3.
8. The mark subject of International Registration No. 1033667 designating the United Kingdom covers "perfumery, essential oils, hair lotions, cosmetics" in class 3.
9. The following goods are therefore identical: "essential oils, hair lotions, cosmetics".

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10. Insofar as "perfumery" is not identical to the goods contained within the opponent's earlier trade mark in paragraph 1, it is very closely similar. "Perfumery" is of a similar nature to the other goods, particularly in relation to "essential oils", both being substances, extracts or preparations for diffusing agreeable or attractive smells. "Perfumery" is also of a similar nature to "hair lotions" and "cosmetics" insofar as they are all beauty or self improvement products. They therefore all have similar uses, namely to beautify or enhance an individual's appearance. In addition "perfumery" is sold alongside goods covered by the opponent's trade mark (particularly cosmetics and hair lotions) in retail outlets, such as department stores, chemists and supermarkets. The channels of trade are therefore identical.
11. The mark subject of International Registration No. 1033667 designating the United Kingdom covers "Clothing, namely sports and leisure clothing; shoes, footwear and boots, namely sports and leisure shoes and boots; stockings, pants, socks; suspenders, also made of leather; ties, namely bow ties; gloves; headgear, namely headbands and sweatbands; belts" in class 25. These class 25 goods are similar to the goods covered by the opponent's earlier Registration No. 2456752 insofar as they have the same users and channels of trade, such that there would be a likelihood of confusion, including a likelihood of association, between the marks. For example, this is because manufacturers who sell clothing also often have associated perfumery and cosmetics product lines, for example CHANEL, HUGO BOSS and GIVENCHY, and such products in classes 3 and 25 will therefore be thought of by the average consumer as coming from the same undertaking.
12. As a result of the foregoing, the mark subject of International Registration No. 1033667 designating the United Kingdom is similar to the opponent's earlier trade mark referred to in paragraph 1, and is to be registered for goods identical with and similar to those covered by the opponent's earlier mark. As such, there exists a likelihood of confusion on the part of the public, which includes a likelihood of association with the earlier trade mark.
13. Registration of International Registration No. 1033667 designating the United Kingdom would therefore be contrary to Section 5(2)(b) of the UK Trade Marks Act 1994.
14. The mark subject of International Registration No. 1033667 designating the United Kingdom also covers goods which may not be considered similar to the goods covered by the opponent's earlier trade mark. The earlier trade mark of the opponent enjoys a reputation in the United Kingdom, and use of the mark subject of International Registration No. 1033667 designating the United Kingdom would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character, and/or repute, of the opponent's earlier trade mark.
15. Registration of International Registration No. 1033667 designating the United Kingdom would therefore be contrary to Section 5(3) of the UK Trade Marks Act 1994.
16. The opponent requests that International Registration No. 1033667 designating the United Kingdom be refused in its entirety.
17. The opponent requests an award of costs in its favour.

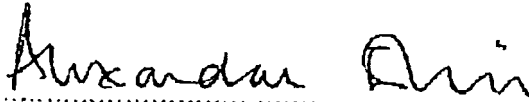
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FAX No. 02074307600

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I believe that the facts and statements contained in this Statement are true to the best of my knowledge.



Alexandra Ellis

BOULT WADE TENNANT

4 February 2011

1208324; EAE; CEH



INTELLECTUAL
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Form TM8

Nil Fee

Notice of defence and counterstatement

Trade Marks Registry
Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

Please read the guidance notes on the next page before filling in this form.

1. Trade mark number.	
2. Full name of the applicant or registered proprietor.	
3. Opposition, invalidation, revocation or rectification number.	
4. Name and address (including postcode) of the agent (if any).	
5. Do you want the opponent to provide proof of use? (see note)	
6. If you answered "yes" to question five, please state for which goods and services you require proof.	
7. Counterstatement	

(REV APR09)

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Form TM8

Counterstatement (continued from previous sheet)

8. Are there any related proceedings currently with the Registry or Courts? If so, please provide details.	
9. Do you want a Preliminary Indication on section 5(1) and/or (2) grounds to be issued?	
10. Declaration	I believe that the facts stated in this notice of defence and counterstatement are true.
Your signature.	
Your name in BLOCK CAPITALS.	
Date.	
11. Name and daytime phone number of the person we should contact in case of query.	
Your reference.	
Number of sheets attached to this form.	This is sheet 1 of

Notes If you need more space for your counterstatement you may attach separate sheets. Number each one and say in question 11 how many sheets you have used.

Boxes 2 and 4: At least one of these should be located in the European Economic Area (EEA) or the Channel Islands

Box 5: Only applies in opposition, or similarly in the case of invalidation proceedings, where the person opposing or invalidating your mark may have provided a statement of use and only applies to grounds of opposition or invalidation raised under sections 5(1) and 5(2) and 5(3) of the Trade Marks Act.
If more than one trade mark is being relied upon, please indicate in respect of which trade mark you would like the opponent to provide proof of use.

Costs proceedings before the comptroller

Preparing a statement and considering the other side's statement

From £200 to £600 depending on the nature of the statements, for example their complexity and relevance.

Preparing evidence and considering and commenting on the other side's evidence

From £500 if the evidence is light or £2000 if the evidence is substantial. The award could go above this range in exceptionally large cases but will be cut down if the successful party had filed a significant amount of unnecessary evidence.

Preparing for and attending a hearing

Up to £1500 per day of hearing, capped at £3000 for the full hearing unless one side has behaved unreasonably. From £300 to £500 for preparation of submissions, depending on their substance, if there is no oral hearing.

Expenses

- (a) Official fees arising from the action and paid by successful party (other than fees for extensions of times)
- (b) The reasonable travel and accommodation expenses for any witnesses of the successful party required to attend a hearing for cross examination.