

O/0605/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003810064
BY UMG RECORDINGS, INC.
TO REGISTER:**

CASABLANCA RECORDS

AS A TRADE MARK IN CLASS 25

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 438566
BY CBPARIS GROUP LIMITED**

BACKGROUND AND PLEADINGS

1. On 15 July 2022, UMG Recordings, Inc. (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 14 October 2022 in respect of the following goods:

Class 25: *Clothing; footwear; headgear; Clothing, namely, bathrobes, blouses, body suits, coats, coveralls, dresses, gowns, Halloween costumes, hosiery, jackets, jumpers, leggings, mittens, gloves, night gowns, overalls, pajamas, pants, robes, scarves, shawls, shirts, shorts, skirts, socks, suspenders, sweat jackets, sweat pants, sweat shirts, sweaters, swimwear, tank tops, ties, tights, tops, t-shirts, bottoms, undergarments, underwear, vests, and wrist bands; footwear; headwear, namely, bandannas, caps, ear muffs, hats, and visors; belts; bustiers; lingerie; aprons, booties; cloth bibs; creepers; infantwear and rompers.*

2. On 12 January 2023, the application was opposed in its entirety by CBParis Group Limited (“the opponent”) based upon Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

3. Under Section 5(2)(b), the opponent relies upon the following two trade marks:¹

UK00003336986 (“the first earlier mark”)

CASABLANCA TENNIS CLUB

Casablanca Tennis Club

(series of 2)

Filing date: 07 September 2018

Registration date: 30 November 2018

¹ The opponent initially relied upon an additional mark, but reliance on the third mark was dropped in the opponent’s submissions dated 27 August 2024.

The mark is registered for goods in classes 3, 14, 18 and 25, however the opponent relies only upon the following goods in class 25:

Class 25: *Clothing; footwear; headgear.*

UK00840813772 (“the second earlier mark”)

CASA BLANCA

Filing date: 28 August 2008

Priority date: 04 February 2003 (Germany)

Registration date: 23 November 2009

The mark is registered for goods in classes 18 and 25, however the opponent relies only upon the following goods in class 25:

Class 25: *Clothing, headgear; upper clothing for gentlemen and ladies; bathing garments for gentlemen and ladies; scarves, gloves, ties, headscarves*

4. By virtue of their earlier filing dates, the two trade marks relied upon by the opponent are “earlier marks” in accordance with Section 6 of the Act. The opponent’s first earlier mark had not been registered for more than five years at the filing date of the contested mark, and, as such, is not subject to the use conditions under Section 6A of the Act. However, the second earlier mark is more than five years old and, as such, is subject to proof of use.

5. Under Section 5(2)(b), the opponent claims that there is a likelihood of confusion because the marks are highly similar and the goods are identical or similar.

6. Under Section 5(3), the opponent relies upon the same earlier marks which are relied upon for the purpose of Section 5(2)(b), claiming reputation for the same goods identified above. The opponent claims that use of the applied-for mark will take unfair advantage of, or be detrimental to, the distinctive character and reputation of the earlier marks. In particular, the opponent claims that use of the applied-for mark in

relation to the applied-for goods is likely to mislead and/or confuse the average consumer into believing that the respective marks are in some way associated or connected, e.g. that they are part of the same 'family' of marks, and therefore that they emanate from the same undertaking causing damage to the opponent.

7. The applicant filed a defence and a counterstatement denying the claims made and putting the opponent to proof of use for the second earlier mark. In particular, the applicant denies the validity of the opponent's earlier marks, however, it provides no reason for it.

8. Both parties filed evidence during these proceedings; the opponent also filed written submissions in reply.

9. The opponent is represented by London IP Ltd. The applicant is represented by Abion UK Limited. A hearing took place before me, by video conference, on 21 May 2026. At the hearing, Philip Harris (of Abion UK Limited) appeared for the applicant and James Michener (of London IP Ltd) appeared for the opponent.

Relevance of EU Law

10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

11. The opponent's evidence came in the form of a witness statement from Dorien De Vroome dated 19 September 2024. Mr De Vroome is CFO at the opponent's company. His witness statement is accompanied by 18 exhibits, being those labelled Annex 1-18, and is aimed at demonstrating genuine use and reputation of the earlier marks.

12. The applicant's evidence came in the form of a witness statement from Matthew Bedford dated 13 January 2025. Mr Bedford is a Senior Associate at Abion UK Limited. His witness statement is only a vehicle for introducing two dictionary definitions contained in the two exhibits labelled Exhibit MB1-MB2.

13. I do not intend to summarise the evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

MY APPROACH

14. The two earlier marks relied upon by the opponent are 'CASABLANCA TENNIS CLUB' and 'CASA BLANCA'. The applicant's mark is 'CASABLANCA RECORDS'.

15. The earlier mark 'CASABLANCA TENNIS CLUB' is not subject to proof of use and covers the very broad terms *Clothing; footwear; headgear*. Notionally, this would encompass tennis wear, for which the words 'TENNIS CLUB' would be perceived as having weak or no distinctive character – hence, this element of the mark has the potential of being descriptive. The other earlier mark 'CASA BLANCA' is subject to proof of use and covers the same very broad terms *Clothing, headgear*, as well as specific items of clothing.

16. The main argument put forward by the applicant in relation to the evidence of use of the earlier mark 'CASA BLANCA' is that it shows use of 'CASABLANCA' (as one word) and that such use is not an acceptable variant of 'CASA BLANCA' (as two words) because it alters the conceptual meaning of the registered mark, insofar as 'CASABLANCA' (i.e. the mark that has been used) will be perceived as a geographical location whilst 'CASA BLANCA' (the mark that is registered) will be perceived as a foreign word meaning 'white house'. In this connection, in his skeleton argument Mr Harris stated:

“Without prejudice to further submissions at the Hearing, the Applicant will say that the evidence, such as it is (and without concession as to its overall sufficiency) shows use of the word CASABLANCA. This is an unacceptable

variant of CASA BLANCA. Although the difference in use is to combine the two words CASA and BLANCA, this is sufficient to alter the distinctive character of the registered mark, since CASA BLANCA means “white house” and CASABLANCA is the name of a city in Morocco”.

17. Even if the opponent’s evidence were sufficient to show use of the registered mark ‘CASA BLANCA’ (either as it is registered, or based on the conclusion that ‘CASABLANCA’ is an acceptable variant of ‘CASA BLANCA’), I would still have to carry out the assessment of the similarity between this mark and the application based on the mark as it is registered, which is ‘CASA BLANCA’. In relation to this mark, the opponent’s argument about the conceptual differences between ‘CASA BLANCA’ (in the earlier mark), and ‘CASABLANCA’ in the applied-for ‘CASABLANCA RECORDS’, would still need to be dealt with. However, this argument does not apply to the other earlier mark, ‘CASABLANCA TENNIS CLUB’, which is not subject to proof of use.

18. For reasons which will become apparent, I have decided to approach the Section 5(2)(b) ground based on the opponent’s mark ‘CASABLANCA TENNIS CLUB’. However, I will return to the opponent’s other mark ‘CASA BLANCA’ if it becomes necessary as part of the assessment I am required to make. Hence, I do not need to address the issue of proof of use at this stage of my decision.

DECISION

Section 5(2)(b)

19. Section 5(2)(b) of the Act reads as follows:

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

(a) ...

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

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

20. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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 greater 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; and

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“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 trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

22. The competing goods are as follows:

The applicant's goods	The opponent's goods
Class 25: <i>Clothing; footwear; headgear; Clothing, namely, bathrobes, blouses, body suits, coats, coveralls, dresses, gowns, Halloween costumes, hosiery, jackets, jumpers, leggings, mittens, gloves, night gowns, overalls, pajamas, pants, robes, scarves, shawls, shirts, shorts, skirts, socks, suspenders, sweat jackets, sweat pants, sweat shirts, sweaters, swimwear, tank tops, ties, tights, tops, t-shirts, bottoms, undergarments, underwear, vests, and wrist bands; footwear; headwear, namely, bandannas, caps, ear muffs, hats, and visors; belts; bustiers; lingerie; aprons, booties; cloth bibs; creepers; infantwear and rompers.</i>	Class 25: <i>Clothing; footwear; headgear.</i>

23. The applied-for goods are either self-evidently identical to the opponent's *Clothing; footwear; headgear* (because those terms are identically contained in both specifications) or are identical on the principle outlined in *Meric* because the applied-for terms are specific items of *Clothing; footwear; headgear* and, as such, are encompassed by the opponent's broad terms. These goods are identical.

Average consumer

24. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

25. In *Iconix Luxembourg Holdings* (cited above), the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

26. The average consumer of the competing goods in class 25 is a member of the general public. The goods are most likely to be the subject of self-selection from retail outlets, websites or catalogues. Visual considerations are, therefore, likely to dominate

the selection process. However, I do not discount an aural component to the purchase, particularly when advice is sought from a sales representative, or a purchase is made further to word-of-mouth recommendations.

27. The cost of the purchase is likely to vary, depending on the item of clothing, footwear and headgear but, overall, they will be relatively inexpensive. On average, consumers are likely to purchase these goods rather frequently. I find that consideration will be given to the materials used, the fit, the aesthetic appearance and the durability of the goods. Taking the above factors into account, I find that the average consumer will demonstrate a medium level of attention in respect of these goods.

Comparison of marks

28. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

29. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The respective marks are shown below:

The applied-for mark	The earlier mark
CASABLANCA RECORDS	CASABLANCA TENNIS CLUB Casablanca Tennis Club (series of 2)

Overall impression

30. Both marks are word-only marks.

31. The applicant's mark consists of the two words 'CASABLANCA' and 'RECORDS'. At the hearing, Mr Harris argued that the element 'CASABLANCA' is inherently low in distinctiveness because it is the name of a geographical location and there are plenty of people who wish to use the names of geographical places to indicate their goods. In this connection, Mr Harris observed that there might be plenty of marks, for example, that feature the word 'London' and that the same would be true for any geographical name, including 'CASABLANCA'. Accordingly, Mr Harris stated that if you have marks of low distinctive character, additional matter has all the more impact on the overall assessment of the mark. Whilst noting the opponent's submission that beginning of marks tend to be more focused upon,² Mr Harris argued that this is only a rule of thumb and that in the present case, the fact that the element 'CASABLANCA' (which is placed at the beginning of the applicant's mark) is low in distinctiveness is something the average consumer will be alive to and, thus, they will not focus on the beginning.

32. I respectfully disagree with Mr Harris. Each case must be assessed on its own facts. Nevertheless, the examination guide of the Manual of Trade Mark Practice indicates some of the criteria which should guide the assessment of the distinctiveness in relation to geographical locations, including the extent of any current association between the place name and the goods or services intended for protection, and the perception of those relevant consumers likely to encounter the sign when used as a trade mark. In this connection, the examination guide refers to the decision of the

² As per *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

CJEU in *Windsurfing Chiemsee v Boots Attenberger* ('Chiemsee') C-108/97 which confirms that when assessing whether the name is liable to be used as a designation of the geographical origin of the goods/services, the registering authority must consider the degree of familiarity amongst the relevant class of persons with the geographical name in question, the characteristics of the place designated by that name, and the nature of the goods/services concerned.

33. In the present case, 'CASABLANCA' is the name of the largest city in Morocco (Collins online dictionary). Neither party argued that it will be perceived as an invented word. Conversely, the opponent's argument that the common element of the marks is conceptually identical, implies an acceptance that the average consumer will attribute a conceptual meaning to this element of the mark, which can only be that of a geographical location – hence it is common ground that 'CASABLANCA' will be perceived as a geographical location in both marks. The Manual of Trade Mark Practice further states that when the assessment relates to towns, cities and regions located in countries outside of the UK they are unlikely to be as familiar to UK consumers as those which are within the UK. Consequently, whilst the UK average consumer might be aware that 'CASABLANCA' is the name of a city outside the UK, there is nothing to indicate that it is particularly well-known in the UK, or that the UK average consumer is particularly familiar with it. Furthermore, in this case there is no 'association' between 'CASABLANCA' as a city and the goods intended for protection, which in this case are clothing, a factor which the CJEU has confirmed is central to the assessment. In this connection, I bear in mind that in *Newport Creek* (BL-O/223/16), Mr Thomas Mitcheson KC sitting as the Appointed Person, stated that not all geographical locations must be attributed a low degree of distinctive character. He stated:

"18. The Opponent emphasised the next two sentences in paragraph 22 where the Hearing Officer stated "In this case, Newport is the name of at least three locations in the UK; one of which is a city in South Wales. Accordingly, far from being a highly distinctive mark, I accord the first of the earlier marks (for the word NEWPORT) very low distinctiveness." A number of issues arise from this passage.

20. Although I have rejected the broad submission that the Hearing Officer should not have referred to s.3(1)(c) at all, it does appear that she was attributing a very low level of distinctiveness based on the fact that Newport is a geographical location. As the Opponent pointed out, this does not follow for all geographical locations, and context is important. Thus BRAZIL might be a highly distinctive mark for computer software but not for coffee.

....

22. In my opinion neither the fact that NEWPORT is a geographical location nor the Formula One/Whyte and Mackay case law provides sufficient justification for the finding of very low distinctiveness for the goods in issue, and on this basis I am entitled to assess afresh this aspect of the case and the resultant likelihood of confusion between the marks for the relevant goods. Even if, contrary to my primary view, this is not strictly an error of law or of principle, I consider that it falls within Lord Neuberger's category (v) identified above. I consider that NEWPORT for textile goods is a moderately distinctive mark. It is of course correct that there are a number of geographical locations called Newport, but as noted above there is no evidence of any link between these locations and textile goods, nor is there any other descriptive element in the mark. No doubt the inhabitants of or near any of the locations called Newport are used to the word being used more usually in a descriptive sense, but for the population as a whole I do not consider that the average consumer would attribute a low level of distinctiveness just because Newport is a geographical term. There are many other geographical terms which would have much lower levels of inherent distinctiveness than NEWPORT generally or more particularly for goods in class 24."

34. As it can be seen, Mr Mitcheson attributed a moderate degree of distinctiveness to the trade mark 'NEWPORT', Newport being a city in Wales. Given the meaning of the word 'moderate' as "*something that is neither large nor small in amount or degree*" (Collins online dictionary), I consider that Mr Mitcheson meant medium and/or average.

35. Applying the above guidance, in the present case there is no evidence of any link between ‘CASABLANCA’ and clothing goods. Accordingly, I consider that the element ‘CASABLANCA’ in the applied-for mark ‘CASABLANCA RECORDS’ has a medium degree of distinctive character. The element ‘RECORDS’ has no relevant meaning in the context of the goods at issue, which are items of clothing, footwear and headgear. However, given that the word ‘CASABLANCA’ is distinctive and moreover it is longer than ‘RECORDS’ and it is present at the beginning of the mark, it is slightly more dominant in the overall impression.

36. Similar considerations apply to the element ‘CASABLANCA’ in the earlier mark ‘CASABLANCA TENNIS CLUB’. However, the word ‘TENNIS CLUB’ would be descriptive in relation to tennis/sport wear (as it is notionally covered by the registered terms *Clothing; footwear; headgear*), in which case they would have less weight in the overall impression. In addition, the evidence indicates that ‘CASABLANCA TENNIS CLUB’ is a collection which *“features t-shirts, silk shirts, terry cloth tracksuits and tailored suits – pretty much everything you need to wear on vacation, at dinner or on the court”*, examples of the collection being shown below:³



Hence, even in relation to goods which are not items of tennis wear the words ‘TENNIS CLUB’ might convey a message about the style of the goods which would be suitable to be worn either on the tennis court, or at tennis tournaments or at dinners/social events organised at a tennis club. In this connection, the evidence shows that the

³ Annex 1

brand 'CASABLANCA TENNIS CLUB' is a luxury brand (the luxury market falling within notional use of the registered goods) and the words "tennis clubs" seem to me have been adopted to reinforce the image of 'CASABLANCA' as a luxury fashion brand because tennis clubs are often seen as symbols of wealth and exclusivity. Consequently, I consider that the word 'TENNIS CLUB' have some allusive connotation and would be perceived as having less weight in the overall impression than the word 'CASABLANCA'.

Visual and aural similarity

37. Visually and aurally, 'CASABLANCA RECORDS' and 'CASABLANCA TENNIS CLUB' coincide in the 10 letter word 'CASABLANCA' which is identically contained in the beginning of both marks where consumer attention tend to focus; in my view, this principle applies to the marks at issue because the other elements of the marks, namely, the words 'RECORDS' (in the application) and 'TENNIS CLUB' (in the earlier mark) are not more distinctive than the coinciding element 'CASABLANCA' which is placed at the beginning of the marks. The marks differ in the words 'RECORDS' (in the application) and 'TENNIS CLUB' (in the earlier mark). Overall, I consider these marks to be similar to a medium degree.

Conceptual similarity

38. In his skeleton argument, Mr Harris stated: *"....CASABLANCA RECORDS indicates a record company called, fancifully, after the city of Casablanca. Similarly, CASABLANCA TENNIS CLUB is conceptually a tennis club, not a record company"*.

39. In his skeleton argument, Mr Michener stated: *"the common element of the marks is conceptually identical. There is nothing to indicate to the average consumer that the meaning of the word 'CASABLANCA' in the application is different because of the second word RECORDS. Indeed, as a result of the recognition of the opponent's goods sold under the name CASABLANCA in the marketplace, the word CASABLANCA has taken on a different meaning which the applicant copies."*

40. Insofar as both marks convey the concept of a city outside the UK called 'CASABLANCA', this concept is identically present in both marks. I also agree with Mr Michener that the words 'RECORDS' (in the application) and 'TENNIS CLUB' (in the earlier mark) do not alter the meaning of the coinciding word 'CASABLANCA'. As regards Mr Harris' submission that 'CASABLANCA RECORDS' will be understood a record company called after the city of 'CASABLANCA', whilst the mark does not include the word 'company' I nevertheless consider that 'CASABLANCA' qualifies 'RECORDS' and that the image of this mark is of record label based in the city of 'CASABLANCA' or simply a record label so named but without a connection to a place called Casablanca.

41. Turning to the mark 'CASABLANCA TENNIS CLUB', in its totality it refers to a tennis club based in CASABLANCA or called after the city of CASABLANCA. Like the visual and aural similarity, I consider that there is a medium degree of conceptual similarity insofar as both marks convey a reference to the same city of 'CASABLANCA'. This concept is an averagely distinctive one, given that, as I observed above, 'CASABLANCA' is not a UK city, and it is a long mark. The presence in the respective marks of the different concepts introduced by the words 'RECORDS' and 'TENNIS CLUB' cannot cancel out the medium degree of similarity created by the word 'CASABLANCA' that remains the same in both marks.

Distinctive character of the earlier mark

42. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; 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 section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

43. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words, which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

44. The earlier mark is ‘CASABLANCA TENNIS CLUB’. As I have already noted, the first element of the mark ‘CASABLANCA’ (which is also the coinciding element), is distinctive to a medium degree. Whilst the mark also contains the words ‘TENNIS CLUB’, this does not materially improve the opponent’s case because it is the distinctiveness of the common element that is the key.

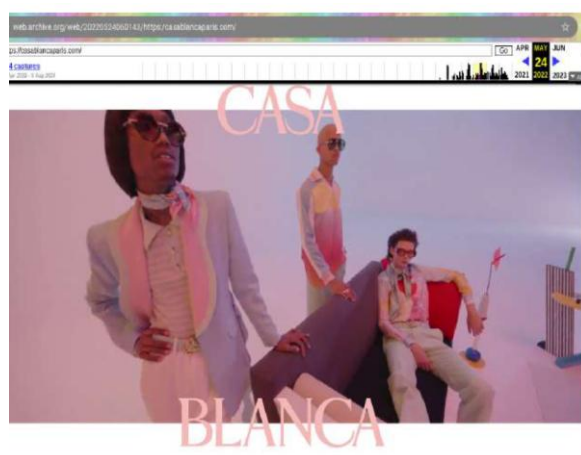
45. I will now consider whether the evidence the opponent has filed is sufficient to demonstrate that the distinctiveness of the earlier mark has been enhanced to any material extent.

46. Mr de Vroome, who gave evidence for the opponent, states that Casablanca Clothing Limited was incorporated on 14 November 2018. CBParis Group Limited (i.e. the opponent in these proceedings) acquired certain assets from Casablanca Clothing Limited in June 2023 and, as part of the acquisition, it became the owner of the earlier marks relied upon in this opposition including all goodwill and reputation in those

marks. A copy of the relevant document dated 5 June 2023 which assigns, among others, the two marks relied upon in these proceedings to the opponent is exhibited.⁴

47. Mr de Vroome states that the opponent's business was launched in November 2018 using the brand 'CASA BLANCA/CASABLANCA'. Exhibited in evidence are screenshots from various UK websites confirming the launch of the brand 'CASABLANCA' in the UK, with the earliest online article I can see being dated September 2019. An online article from 6 August 2024 (i.e. after the relevant date) states that the brand was launching in stores in the UK following two successful runway shows. This evidence says that 'CASABLANCA' is a Parisian menswear label under the creative direction of French Moroccan designer Charaf Tajer. It also says that the label is dedicated to Tajer's parents in ode to the place they met at an atelier in the fashion district of Casablanca. Casablanca is the name of the brand as well as the place where the clothes are manufactured. Another article (undated) states that the brand is stocked by luxury retailers such as Selfridges, and is worn by A-listers such as Travia Scott, Skepta, SAP Bari and Gigi Hadid.

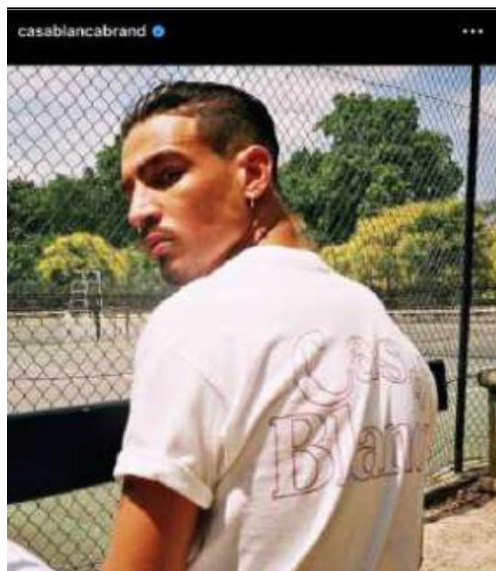
48. Mr de Vroome states that on 26 June 2019, the opponent launched its online shop selling clothing and accessories at www.casablanca-paris.com. Historic copies of the website homepage from the Wayback Machine Web Archive are exhibited.⁵ They are dated May 2022 and April 2020 (i.e. prior to the relevant date) and show the trade mark 'CASA BLANCA' presented as two words as shown below:



⁴ Annex 1

⁵ Annex 3

49. Further examples of goods and labels displaying both 'CASA BLANCA' presented as two words and 'CASABLANCA TENNIS CLUB' are produced, examples of which are shown below:





50. Mr de Vroome states that as well as selling directly to consumers via the website www.casablancaparis.com, items are sold to retailers including major UK wholesale customers such as SELFRIDGES (since the Fall/Winter 2019 collection), HARRODS (since the Fall/Winter 2020 collection) and HARVEY NICHOLS (since the Fall/Winter 2019 collection).

51. In terms of turnover, Mr de Vroome states that in 2020, the opponent had turnover of £3,7million and gross profit of nearly £1,3million and that in 2021, the opponent had turnover of £10.1million, and gross profit of £4,2million.⁶ Copies of extracts of UK Annual Accounts from the opponent's predecessor in title Casablanca Clothing Limited for 2020 and 2021 are exhibited. In addition, a collection of supporting invoices to UK and EU retailers/customers (with prices redacted) is also exhibited, which shows the mark 'CASABLANCA TENNIS CLUB' presented with the element 'CASABLANCA' prominently displayed as shown below:



52. Mr de Vroome also states that today, the opponent employs more than 90 people across the UK/EU.

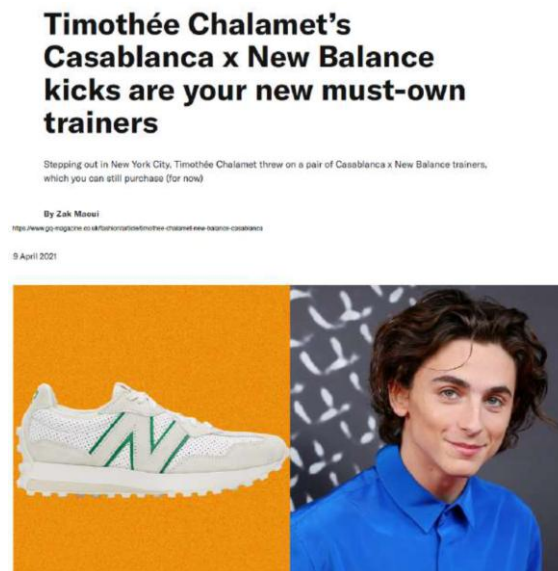
53. Mr de Vroome says that in 2021, online global luxury product resale marketplace "*The RealReal*", that ships to the UK and Europe, published a Luxury Product Resale Report. He explains that the "RealReal" is the world's largest online marketplace for authenticated, resale luxury goods, with more than 23million members registered in 2021. Mr de Vroome points out that in the report Casablanca products had a +358% increase in sales. However, there is no context provided, so it is not clear whether this increase considers sales generated specifically in the UK or include sales outside the UK. Nor does it provide any detail about the share of the market held by the opponent under the mark 'CASABLANCA'.

54. The next part of Mr de Vroome's evidence is about collaborations between the opponent and other brands as well as the endorsement of the opponent's brand by celebrities. The following collaborations are mentioned:

- 2020: the opponent entered into a large-scale collaboration over 2 years with footwear retailer New Balance to produce co-branded footwear using the earlier marks. Via the opponent's own e-commerce website, approximately 10.000

⁶ Annex 7

units have been sold with a total retail value of 258K GBP. Various online articles from 2021 are exhibited. They talk about the collaboration between CASABLANCA and NEW BALANCE and the celebrity endorsement of the co-branded footwear by Timothé Chalamet. An example is shown below:



- 2022: the opponent entered into collaborations with luxury Italian fashion house Bulgari in relation to bags (launched on 20 April 2022 in store in Bulgari Paris and Selfridges London) and luxury British accessories brand Globetrotter in relation to luggage (dispatched to Selfridges London for their exclusive pre-sale in July 2022). Example of the collaboration items are exhibited.⁷

55. Next, Mr de Vroome talks about the opponent's website www.casablancaparis.com, which he says, has increased its visitor numbers since 2019 (until 2022), going from 1,8million unique visitors to 10,8million page views.⁸ However, it is not clear what proportion of the website's visitors are from the UK – indeed, this is all the more important because the website www.casablancaparis.com is not a UK specific website targeting UK consumers and the invoices show sales outside the UK. The same issue applies to the turnover figures, because although the opponent is a UK company, the invoices exhibited show that it sold goods outside the UK, in various EU countries, including Italy, Germany and Spain.

⁷ Annex 10

⁸ Annex 11

56. In terms of marketing and promotion, Mr de Vroome says that the opponent has incurred substantial expenditure on advertising and publicity throughout the UK under the marks. Whilst examples of promotional material are exhibited, including extract from magazines and social media examples,⁹ no figures are given for the promotional investment incurred by the opponent. The examples of marketing material show 'CASABLANCA' being presented as both one word and two separate words.

57. Mr de Vroome mentions that the founder of the opponent's brand Charaf Tajer has won, or was appointed as finalist for the following awards:

- In 2020, Casablanca was a finalist for a Louis Vuitton prize for Young Fashion Designers.
- In 2021, Mr Tajer, founder of the brand and Creative Direct of opponent, was a finalist for the International Woolmark Prize, which celebrates outstanding fashion talents from around the globe who showcase the beauty and versatility of Merino wool, related to his work with the CASA BLANCA brand.
- In 2021 Mr Tajer was a finalist for the Andam Grand Prize which provides key industry recognition for emerging fashion designers related to his work with the brand 'CASABLANCA'. The prize is a French prize.
- In 2022, Mr Tajer was added to the Business of Fashion 500 in relation to his work with the brand 'CASA BLANCA'.
- In 2022, Mr Tajer won GQ Middle East Man of the Year in relation to his work with the brand 'CASA BLANCA'.

58. Details of these awards are exhibited,¹⁰ however, none of these awards appear to be UK specific.

⁹ Annex 12

¹⁰ Annex 13

59. In addition, Mr de Vroome's evidence includes examples of media coverage¹¹ including Vogue UK, and celebrity endorsement, including media examples of celebrities that have been photographed wearing Casablanca products in 2021 and 2022.¹²

60. Finally, Mr de Vroome introduces the following tables which, he says, include approximate wholesale figures in euros for the range of goods sold each relevant season. He also explains that these figures include the purchase of goods by the opponent's own ecommerce channel but does not include the retail value of the opponent's own e-commerce sales (which is direct to consumer):

HEADWEAR

Sum of Order Value After Discount (EUR)	Column Labels					
Row Labels	SS20	AW20	SS21	AW21	SS22	AW22
ASIA						
EUROPE	22.371	14.642	44.561	88.309		
MIDDLE EAST						
ROW						
STAFF						
UK	10.636	10.771	24.450	98.691	63.094	98.483
USA						
(blank)						
REGGWS						
Grand Total						

CLOTHING

Sum of Order Value After Discount (EUR)	Column Labels					
Row Labels	AW19	SS20	AW20	SS21	AW21	SS22
ASIA						
EUROPE	254.405	815.217	561.375	1.337.070	3.979.753	
MIDDLE EAST						
ROW						
STAFF						
UK	226.328	596.600	632.817	705.810	2.063.778	1.426.880
USA						
(blank)						
Grand Total						

¹¹ Annex 14

¹² Annex 15

Customer Category	(Multiple Items)	
PP_Season2	(All)	
Product Category 5	(All)	
Product Category 1	FOOTWEAR	
Sum of Order Value After Discount (El Column Label)		
Row Labels	SS22	AW22
EUROPE	30,374	206,643
UK	19,117	212,259
Grand Total	49,491	418,901

61. Even though the season is referred to, it is not clear to me (a) what years these figures relate to and (b) what is the total value of the goods sold, as the figures given are difficult to reconcile. This is because whilst the third table seems to suggest that the value of the goods sold in 2022 is 49K euros in the UK, and 418K in Europe, the first table appears to indicate higher figures. In fact, for the same period (I assume that SS22 and AW22 relate to 2022) the first table gives a total of 63K and 98K for headwear sold in the UK – this corresponds to a total of 161K euros, and it is more than the grand total of 49K indicated by the second table for 2022. Further the second table indicates a total of 1.4 million euros for the same period (I assume that SS22 relate to 2022) and 4.2 million euros for the period 2019-2021 (I assume that AW19 and AW21 relate to the years 2019-2021) for clothing sold in the UK. Hence the grand total for 2022 (i.e. 49K) seems to be lower than the total given for clothes (1.4million) and headwear (i.e. 161K) for the same period. In any event, bearing in mind that the relevant date for the assessment is 15 July 2022, and that the figures are not broken down, it is impossible to know what proportion of the grand total of 49K and the totals of 161K and 1.4million was generated prior to the relevant date (assuming that these are figures for 2022).

62. Drawing the threads together, my conclusion is that the evidence is insufficient to establish that the distinctiveness of the earlier mark 'CASABLANCA TENNIS CLUB' has been enhanced to any material extent. I now explain why.

63. Admittedly, goods branded under the trade mark 'CASABLANCA' appear to have targeted the market for luxury clothes. These goods have gained some press attention, and attracted some recognition in that market. This is demonstrated by the fact that the opponent has managed to produce some co-branded products with other brands, including New Balance and two luxury brands such as Bulgari and Globetrotter. However, there are countless reasons why brands collaborate together to create exclusive products, and the fact that a more established brand (such as New Balance, or Bulgari and Globetrotter) decide to collaborate with a relatively new brand ('CASABLANCA' was launched in late 2018 and the collaborations took place in 2020 and 2022) does not really establish that the new brand has actually acquired a level of recognition among the UK relevant public, which is what enhanced distinctiveness is about. Further, in this case, it is not clear what was the impact those collaborations had in the UK as 'CASABLANCA' is a French brand, and the opponent sells its goods both in the UK and in Europe. Hence, in the absence of a clear indication that the co-branded products targeted exclusively the UK market, and in the absence of UK specific sales figures, it is impossible to know how many goods were sold in the UK under those collaborations prior to the relevant date – in this connection it is not clear whether all of the 10,000 units of cobranded footwear were sold in the UK. Furthermore, the tables shown above indicates that a higher percentage of goods was sold in Europe compared to the UK, which leads to the conclusion that the UK is not the main market targeted by the opponent. Likewise, the turnover figures for the two years prior to the relevant date amounted to 3.7million euros for 2020 and 10million euros for 2021, but there is no indication of what proportion of turnover relate to goods sold in the UK which is an important point given that the invoices show sales in Europe and Mr de Vroome does not say that the turnover is UK specific. Finally, whilst there is evidence of marketing material and press coverage there are no marketing figures and there is no evidence that any of the awards won by the brand or its creator are UK specific. Lastly, there is the point that the length of use is relatively short, with the brand having been launched at the end of 2018 which is about 2 and a half years prior to the relevant date and the opponent not having open any shops in the UK until August 2024 (i.e. after the relevant date).

64. Accordingly, the evidence is insufficient to establish that the distinctiveness of the trade mark 'CASABLANCA TENNIS CLUB' or of the element 'CASABLANCA' of that mark has been enhanced as a result of the use the opponent has made.

Likelihood of confusion

65. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

66. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

67. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

68. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

69. Earlier in this decision I found that:

- The applicant's mark 'CASABLANCA RECORDS' and the earlier mark 'CASABLANCA TENNIS CLUB' are visually, aurally and conceptually similar to a medium degree.
- The parties' goods are identical.
- The average consumer is a member of the general public who will select the goods mainly visually, with a medium degree of attention.
- The earlier mark is inherently distinctive to a medium degree. The evidence filed by the opponent is insufficient to establish that the distinctiveness of the earlier mark has been enhanced to any material extent.

70. The opponent's case on the likelihood of confusion is that the coinciding element 'CASABLANCA' is the dominant element of both marks and retains an independent distinctive role within them, in addition to being high in distinctiveness.

71. The applicant's case is that the visual, aural and conceptual differences between 'CASABLANCA RECORDS' and, respectively 'CASA BLANCA' and 'CASABLANCA TENNIS CLUB' are sufficient to avoid any likelihood of confusion. In this connection, Mr Harries relied on the argument that 'CASA BLANCA' indicates a "white house" whereas 'CASABLANCA RECORDS' indicates a record company called after the city of Casablanca whereas 'CASABLANCA TENNIS CLUB' is conceptually a tennis club, not a record company.

72. For the reasons I have set out earlier in this decision, I shall focus on the earlier mark 'CASABLANCA TENNIS CLUB'.

73. Whilst I have found that the shared element 'CASABLANCA' has a medium degree of distinctiveness in both marks and that the other element 'RECORDS' in the application is only slightly less distinctive in the overall impression, I concord with the opponent that the marks 'CASABLANCA RECORDS' is likely to be seen either as a brand extension of 'CASABLANCA TENNIS CLUB' or as another mark used by the

same undertaking under the brand 'CASABLANCA'. In other words, I think that the word 'CASABLANCA' is sufficiently independently distinctive within both marks that when the marks are encountered on identical goods, or on goods which are similar by virtue of all being items of clothing, footwear and headgear, the average consumer will go beyond a mere speculation that there might be a connection and will arrive to the conclusion that there is a commercial connection between the proprietors of these marks. In this connection, whilst I have concluded that 'CASABLANCA TENNIS CLUB' refers to a tennis club based in the city of CASABLANCA or called after the city of CASABLANCA, and that the image of the mark 'CASABLANCA RECORDS' is that of record label based in the city of 'CASABLANCA' or simply a record label so named but without a connection to a place called Casablanca, 'CASABLANCA' remains independently distinctive in both marks. Further, as I have observed earlier, the words 'TENNIS CLUB' have a meaning in relation to the goods concerned and are likely to be interpreted as referring to the style or inspiration of the relevant clothing, footwear and headgear.

74. The main point which I think could be arguable here is that the word 'RECORDS' in 'CASABLANCA RECORDS' is distinctive and it is not a word providing purely descriptive information. However, this does not prevent the likelihood of indirect confusion from occurring. This is because the likelihood of confusion can still occur, when the non-coinciding element between the marks is of a lower or equal degree of distinctiveness than the shared element.¹³

75. In this case, the word 'RECORDS' in 'CASABLANCA RECORDS' is subsidiary to the word 'CASABLANCA' and whilst the combination read together do project the concept of a record label based in, or named after, the city of 'CASABLANCA', they work together in terms of the overall impression as the words 'CASABLANCA TENNIS CLUB' do in the earlier mark. 'CASABLANCA' is the most distinctive element of both marks, it is placed identically at the beginning of both marks, and it is independently distinctive in both marks which have a similar structure. Further, 'RECORDS' and 'TENNIS CLUB' do not make a substantial difference to the conceptual impact of the marks, which will be dominated by the concept of the city of 'CASABLANCA' and this

¹³ BL-O-0368/23 *Peninsula Face2Face*

in itself makes the idea of a brand extension more likely when the marks are encountered on identical goods.

76. There is a likelihood of indirect confusion.

77. For the sake of completeness, I will now briefly return to the point about the other mark of the opponent, being 'CASA BLANCA'. Even if I were to agree that there has been genuine use of 'CASA BLANCA' in relation to the goods concerned, this mark would not benefit from enhanced reputation for the same reasons which I have set out above. In addition, the fact that 'CASA BLANCA' is presented as two words, rather than one (as it is in the application) would create a further gap between the marks because it creates a clever play on words which is absent in the applied-for mark, as suggested by Mr Harris. This is even considering that the mark which I have considered contains the additional words 'TENNIS CLUB'; however, as I have concluded that these words are weakly distinctive, and since the opponent has succeeded under that mark, on balance, I do not consider that the other mark would improve the outcome for the opponent.

Section 5(3)

78. I can deal with this ground very briefly. I have already commented on the evidence filed by the opponent and I found that it comes nowhere near establishing enhanced distinctiveness, which refers to an increased recognition and capacity of a trade mark to identify the goods or services for which it is registered as coming from a particular undertaking as a result of extensive use. Whilst reputation and enhanced distinctiveness are different concepts, they are closely related and their assessment is based on the same factors.¹⁴ For the same reasons as those I have outlined above, I find that the opponent's evidence does not establish that the earlier mark(s) benefits from reputation and the ground under Section 5(3) fails at the first hurdle.

¹⁴ *General Motors*, Case C-375/97

OUTCOME

79. The opponent has been successful under Section 5(2)(b) and, subject to any appeal of my decision, the application will be refused registration.

COSTS

80. The opponent has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the sum of £2,300, calculated as follows:

Preparing opposition and considering the counterstatement:	£300
Filing evidence:	£1,000
Preparing for and attending a hearing:	£800
Official fees:	£200
Total:	£2,300

81. I therefore order UMG Recordings, Inc. to pay CBParis Group the sum of £2,300. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 13th day of July 2026

TERESA PINTO
For the Registrar