

**O/0026/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER 3729430**

**IN THE NAMES OF VICTORIA AND LAWRENCE OSBORNE**

**TO REGISTER:**



**AS A TRADE MARK FOR GOODS IN CLASSES 6 AND 31**

**-AND-**

**OPPOSITION NUMBER 432158 THERETO**

**BY LOUIS VUITTON MALLETIER**

## BACKGROUND AND PLEADINGS

1. On 6 December 2021, an application was filed in the names of Lawrence and Victoria Osborne (“**the Applicants**”) for this trade mark:



**“the Applicants’ Logo”**

seeking registration for the following goods:

### **Class 6**

*trellis (metal -) for supporting plants; arches of metallic materials for supporting plants; archways of metallic materials for supporting plants; metal pipe supports; tree supports (metal -); metal plant cages; metal garden stakes; metal tent stakes; stakes of metal for plants or trees; metals; metal slugs; metal edgings; metal handles; metal frames; metal rods; metal doors; metal cladding; metal rings; metal rails; metal knockers; metal doorknockers; metal tubing; metal fencing; welding metals; metal gates; heavy metals; metal hinges; metal brackets; metal staircases; metal decking; metal hardware; metal boards; all the aforesaid in relation to plant and planting, garden and gardening apparatus, equipment and paraphernalia.*

and

### **Class 31**

*plants; live plants; dried plants; roses [plants]; grasses [plants]; living plants; house plants; potted plants; cuttings (plant -); climbing plants; bulbs (plant -); plants (live -); flowering plants; aloe vera plants; seedlings for planting; bulbs for planting; natural flowering plants.*

2. Louis Vuitton Malletier (“**the Opponent**”) opposes the application, based on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“**the Act**”). As detailed in the following paragraphs, the opposition relies on three trade mark registrations and on use of two figurative signs for the Opponent’s intertwining Louis Vuitton monogram. All three of the Opponent’s trade mark registrations were applied for on dates earlier than the Applicants’ contested trade mark, so each is an “earlier trade

mark” for the purposes of the section 5 claims.<sup>1</sup>

3. “**Earlier Mark 1**”: UK00801127687



Filing date: 16 April 2012, with a priority date of 14 November 2011

Registered: 26 July 2013.

The Opponent relies on Earlier Mark 1 for its section 5(2)(b) claim that the parties’ marks are similar, that the applied-for goods in Class 6 are similar to the following of the Opponent’s registered goods in Class 6 ‘*common metals and their alloys; metal components for leatherware especially closure systems, plates, locks, padlocks, handles, buckles, buttons (handles)*’, and that there is likelihood of consumer confusion.

4. “**Earlier Mark 2**”: UK00801294251



Filing date: 25 September 2015, with a priority date of 18 June 2015

Registered: 2 September 2016, for goods including ‘*perfumes; perfumery products*’ in Class 3.

“**Earlier Mark 3**”: UK00801127687



Filing date: 1 April 1996

Registered: 11 November 1997 for various goods including ‘*trunks, travelling bags, chests, bags, handbags, pocket wallets, purses, card holders*’ in Class 18, and ‘*clothing*’

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<sup>1</sup> Section 6 of the Act – the priority dates are still earlier.

in Class 25

5. The Opponent relies on Earlier Marks 2 and 3 for its section 5(3) ground. It claims that Earlier Marks 2 and 3 have a reputation for the above goods in Classes 3, 18 and 25, that the parties' marks are similar, and that use of the applied-for trade mark in respect of any of the applied-for goods would bring to mind the Opponent's reputed Earlier Marks 2 and 3 and would take unfair advantage of, or would be detrimental to, the distinctive character or repute of those Earlier Marks.
6. Under section 5(4)(a) of the Act, the Opponent claims unregistered rights arising from its use since 2000 throughout the UK of the same two signs – i.e. the intertwined LV monogram, with or without a circle – for the same goods in classes 3, 18 and 25 for which it claims a reputation under its section 5(3) ground. It claims to have acquired goodwill that would prevent use of applied-for mark under the law of passing off.

*The defence*

7. The Applicants filed a defence and I note the following points from their counterstatement:
  - i. It is denied that the applied-for mark offends against any of the grounds claimed;
  - ii. It is claimed that the goods are wholly dissimilar;
  - iii. The contested mark features the letters L and V in a composite mark, wherein those letters are not interlinked, and the stylisation is very different from the Earlier Marks. The respective marks have at best a low degree of similarity; the Applicants' Logo does not share the figurative elements of the Earlier Marks and the differences are not likely to be overlooked by consumers;
  - iv. Likelihood of confusion is denied;
  - v. The Applicants requested that the Opponent prove use of its earlier marks "in relation to alleged overlapping scope." The Applicants were prepared to admit, subject to proof of use, that the Opponent may have the benefit of a reputation for goods claimed in classes 3, 18 and 25, but denied that any repute extends to the Applicants' mark and interests;
  - vi. The contested goods relate to plants (in Class 31) and to plant and planting, garden and gardening apparatus, equipment and paraphernalia (in Class 6). If the claimed

reputation is substantiated then in any event none of the contested goods is closely allied or readily linked to the Opponent's reputed goods (i.e. perfumery, bags and clothing);

- vii. The Applicants' use of the applied-for trade mark causes no detriment to the Opponent's Earlier Marks 2 and 3, nor takes any unfair advantage;
- viii. The inclusion of an L and a V refers to the Applicants' forenames and use of the contested trade mark is with due cause;
- ix. The Applicants have been trading for some time in a niche and separable area, not one shared by the Opponent, nor one into which the Opponent is ever likely to venture. They have encountered no actual confusion or any presumption that the parties are linked in some way.

#### **Papers filed, the hearing and representation**

- 8. The attorneys for the Opponent are D Young & Co LLP; the attorneys for the Applicants are Birketts LLP. During the evidence rounds the Opponent filed evidence in chief; the Applicants also filed evidence in chief, along with written submissions addressing each of the grounds and amplifying points made in their counterstatement. An oral hearing of the matter was held before me by video conference on 10 July 2023. At the hearing, Jamie Muir Wood of counsel acted for the Opponent; Melanie Harvey of Birketts acted for the Applicants. Both sides filed skeleton arguments in advance of the hearing. I have read all the papers filed and refer to their contents where I consider it warranted to do so.

#### **EVIDENCE / SUBMISSIONS FILED**

- 9. The Opponent's evidence in chief comprised a Witness Statement of Laure Kainane (12 August 2022) with Exhibits LK1-LK9 and a Second Witness Statement of Laure Kainane (12 September 2022) introducing Exhibit LK10. Ms Kainane is Senior IP In-House Counsel for the Opponent and her evidence relates to the use of the Earlier Marks, and the extent of the claimed reputation.
- 10. The Applicants' evidence comprised a Witness Statement by Victoria Osborne, dated 21 November 2022, introducing Exhibits VO1-VO7. This evidence outlined the trading history of the Applicants since June 2020, including exhibiting its wares at events such as prominent flower and gardening shows in the UK. During the evidence rounds, written

submissions were filed on behalf of the Applicants. These submissions included an acceptance by the Applicants that the Opponent has the benefit of goodwill and reputation vested in their monogram.

### **Relevance of assimilated law**

11. 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.

## **DECISION**

### **THE SECTION 5(2)(b) CLAIM**

12. The Act states:

“Section 5 Relative grounds for refusal of registration.

- (2) A trade mark shall not be registered if because—
  - (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”.

### **Genuine Use**

13. The Opponent raises its section 5(2)(b) ground of opposition against the applied-for goods in Class 6 (only). The Opponent relies on the following goods under its Earlier Mark 1 registration:

*Class 6 'common metals and their alloys; metal components for leatherware especially closure systems, plates, locks, padlocks, handles, buckles, buttons (handles)'*

All of the Opponent's earlier marks had been registered for more than five years at the application date of the contested trade mark and are therefore subject to the use provisions under section 6A of the Act. The Applicants requested proof of use;

consequently, the Opponent can rely on its registered goods only to the extent that the evidence filed establishes that the trade mark had been put to genuine use in respect of the above specified goods within the five years up to the date on which the contested trade mark application was filed. The relevant period in which the Opponent must establish use of Earlier Mark 1 is therefore 7 December 2016 - 6 December 2021.

14. There was no disagreement between the parties as to the applicable law. Arnold LJ, in *easyGroup v Nuclei*, gave a summary of the legal principles regarding genuine use, which included the following:<sup>2</sup>

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark.
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark.
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin.
- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns. Internal use by the proprietor does not suffice. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter. But use by a non-profit making association can constitute genuine use.
- (5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark.
- (6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including:

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2 *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, at paragraph 105 - citations omitted.  
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- (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question;
- (b) the nature of the goods or services;
- (c) the characteristics of the market concerned;
- (d) the scale and frequency of use of the mark;
- (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them;
- (f) the evidence that the proprietor is able to provide; and
- (g) the territorial extent of the use.

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus, there is no de minimis rule.

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use.

15. The onus is on the Opponent to have filed evidence of genuine use of its mark. The assessment must consider what the evidential picture as a whole shows, not whether each piece of evidence shows use by itself.<sup>3</sup>

16. Mr Muir Wood also referred me to the *Titanic Spa* case in the context of how to approach characterising on what goods an opponent may rely where the evidence does not bear out use of each good specified in an earlier registration:<sup>4</sup>

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3 *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.

4 *Property Renaissance Ltd (t/a Titanic Spa) v. Stanley Dock Hotel Ltd (t/a Titanic Hotel)* [2016] EWHC 3103 (Ch); [2017] E.T.M.R. 12 at §47(iii)ff (citations omitted). (Per paragraph 11 of Mr Muir Wood's skeleton argument.)



- “iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment;
- iv) ... the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used;
- v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, ... use in relation to holdalls justified a registration for luggage generally;
- vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration;
- vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them.

17. During the evidence rounds, the submissions filed on behalf of the Applicants included that “based on the Opponent’s evidence in support of the interpretation of [Earlier Mark 1], the scope of protection to be drawn upon in these proceedings amounts to **metal components for leatherware especially closure systems, plates, locks, padlocks, handles, buckles, buttons (handles) for bags, and luggage**”.<sup>5</sup>

18. In her skeleton argument,<sup>6</sup> Ms Harvey seems to rein back slightly on the apparent

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5 Paragraph 22

6 Paragraph 10

concession above, stating that “evidence has been adduced limited to leatherware closure systems, locks, padlocks and buckles on their luggage and or bags” but that “no evidence has been adduced for the broader term **Common metals and their alloys** nor metal components for leatherware especially plates, handles, buttons (handles) carrying Earlier Mark 1” - the text made bold and the underlining are my own emphasis.

19. I accept that the evidence may fail to show use specifically in relation to *plates, handles, buttons (handles)*. However, the case law requires that for the purposes of determining the scope of the goods on which an opponent may rely, a tribunal should frame a notional fair specification that reflects how the average consumer would fairly describe the goods in relation to which the trade mark has been used. I noted no evidence of separately-sold goods such as handles, plates, or buckles, though such items are parts of the Opponent’s bags; however, given that the Applicants accept that the evidence establishes genuine use in respect of *metal components for leatherware especially closure systems, locks, padlocks*, I find that the inclusion or removal of “*plates, handles, buckles, buttons (handles)*” makes no material difference and would entail no advantage nor disadvantage to either party. The Opponent’s specification in Class 6 includes “*metal components for leatherware ...*”, followed by “*especially*”, which is an adverb that emphasises the goods that follow it, but does not limit the scope of the foregoing goods - the listed goods that follow it are essentially just particular examples of the category.
20. Submissions at the hearing focussed on the disagreement as to whether or not the evidence may be considered to warrant a finding of genuine use for goods under the broader term “common metals and their alloys” per se, extending beyond the separately specified “metal components for leatherware”. Mr Muir Wood directed me to a few images in the evidence that he argued showed use of the mark in connection with metal goods that are not components for leatherware. For example, an LV Padlock Key Holder at **Exhibit LK2** taken from a page from the Opponent’s website:<sup>7</sup>



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7 at pages 31/42 and 32/42.

**Exhibit LK3** includes more pages from the Opponent’s website. The website print-outs do not date from the relevant period, but the witness states that “use has been continuous for years” and “that it is not possible to access archived pages”. Other images from the website include this LV Padlock Chain Bag Charm:



and this LV Padlock Key Ring:



Mr Muir Wood also referred to other images in Exhibit LK3, including an image of a £19,300 white gold and diamond pendant, but I am not satisfied that such jewellery items fall within the scope of “common metals” - they would be considered precious metals.<sup>8</sup> Other jewellery items, based on the “iconic padlock” bearing the monogram are shown in a 2016 article from thejewelleryeditor.com. No information is given on sales of these goods in the relevant territory during the relevant period, but in any event I do not consider the evidence taken as a whole warrants a finding of genuine use in respect of “*common metals and their alloys*”. The evidence simply shows certain goods bearing the monogram that are made of metal (of some sort). I therefore find that this evidence has no bearing on the scope of goods in Class 6 permitted protection under Earlier Mark 1.

<sup>8</sup> Another image of a key ring at page1/4 of Exhibit LK3 is attached to a strip of material, which may or may not be a piece of leatherware.

21. Taking the evidence overall, I consider a fair specification for the goods relied on by the Opponent in Class 6 to be: *metal components for leatherware especially closure systems, locks and padlocks*. I will deal with the section 5(2)(b) claim based on such earlier goods.

The case law principles for this ground are very well established and not disputed:

- (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 be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks 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 the goods**

- 22. Section 60A(1)(a) of the Act provides that for the purpose of the Act goods and services are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.
- 23. When considering whether goods are similar, all the relevant factors relating to the goods should be taken into account. Those factors include, inter alia:<sup>9</sup>
  - i. the physical nature of the goods;
  - ii. their intended purpose;
  - iii. their method of use / uses;
  - iv. who the users of the goods and services are;
  - v. the trade channels through which the goods reach the market;
  - vi. in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
  - vii. whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors);

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9 See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case.

viii. whether they are complementary to each other. Complementary has been described as meaning that *“there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”*.<sup>10</sup> Complementary is an autonomous criterion capable of being the sole basis for the existence of similarity.<sup>11</sup> Complementary may be distinguished from ‘use in combination’, where goods are merely used together, whether by choice or convenience but are not essential or important to one another’s use such that they would be assumed to share a source.<sup>12</sup>

24. When interpreting terms in a specification it is *“necessary to focus on the core of what is described [... and that] trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise”*, although *“where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”*.<sup>13</sup>

25. For the purposes of making a comparison, goods can be grouped together where the same reasoning applies.<sup>14</sup>

26. The goods to be compared are shown in the tables below:

<b>Opponent’s fair specification</b>
<i>metal components for leatherware especially closure systems, locks and padlocks</i>

10 *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82  
11 *Kurt Hesse v OHIM*, Case C-50/15 P  
12 As Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL O/255/13 - *“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”*  
13 *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12  
14 *Separode Trade Mark* BL O/399/10, paragraph 5

### Applicants' goods in Class 6

*trellis (metal -) for supporting plants; arches of metallic materials for supporting plants; archways of metallic materials for supporting plants; metal pipe supports; tree supports (metal -); metal plant cages; metal garden stakes; metal tent stakes; stakes of metal for plants or trees; metals; metal slugs; metal edgings; metal handles; metal frames; metal rods; metal doors; metal cladding; metal rings; metal rails; metal knockers; metal doorknockers; metal tubing; metal fencing; welding metals; metal gates; heavy metals; metal hinges; metal brackets; metal staircases; metal decking; metal hardware; metal boards; all the aforesaid in relation to plant and planting, garden and gardening apparatus, equipment and paraphernalia.*

(my underlining)

27. Having in mind the relevant factors, I find that almost all of the Applicants' goods in Class 6 - goods such as *metal plant cages; metal garden stakes; metal gates; metal staircases; metal decking* - are self-evidently dissimilar to the Opponent's *metal components for leatherware*. While the respective goods may have in common that they are made of metal, that is clearly insufficient to give rise to similarity. Having in mind the relevant factors identified in case law, I therefore find the goods covered by the Opponent's fair specification to be dissimilar to the following contested goods.

*trellis (metal -) for supporting plants; arches of metallic materials for supporting plants; archways of metallic materials for supporting plants; metal pipe supports; tree supports (metal -); metal plant cages; metal garden stakes; metal tent stakes; stakes of metal for plants or trees; metal slugs; metal edgings; metal frames; metal rods; metal doors; metal cladding; metal rails; metal knockers; metal doorknockers; metal tubing; metal fencing; welding metals; metal gates; heavy metals; metal hinges; metal brackets; metal staircases; metal decking; metal hardware; metal boards; all the aforesaid in relation to plant and planting, garden and gardening apparatus, equipment and paraphernalia.*

28. Where there is no similarity, there is no likelihood of confusion to be considered.<sup>15</sup> The

15 See for instance, Lady Justice Arden at paragraph 49 *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.  
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opposition must fail against the above goods that I have found to be dissimilar.

29. Of the goods applied for in Class 6, the only ones that I have not included in the above list of self-evidently dissimilar goods are: *metals; metal handles; metal rings*. This is because these three goods are (arguably) closer to the goods of the fair specification in their physical nature than are the self-evidently dissimilar goods above; for instance, *metal handles* may feature as *metal components for leatherware* and *metal rings* may feature in a *closure system* on leatherware. Nonetheless, the limiting descriptions in the respective specifications remain significant. The contested *metals; metal handles; metal rings* are all qualified as being in relation to *plant and planting, garden and gardening apparatus, equipment and paraphernalia*; the Opponent's *metal components* are limited as being *for leatherware*. Any similarity deriving from an overlap in physical nature of the goods must be considered in the context of the other relevant case law factors – intended purpose, uses, users, trade channels, whether they compete or are complementary with one another. None of these factors appears engaged as between *metal components for leatherware especially closure systems, locks and padlocks* and *metals; metal handles; metal rings all the aforesaid in relation to plant and planting, garden and gardening apparatus, equipment and paraphernalia*. The overlap in nature in my view gives rise to a low degree of similarity.
30. At the hearing Mr Muir Wood referred to “at least a low degree of similarity” between the parties’ goods arising based on a ‘gardening bag’; the implication is that a ‘gardening bag’ could be considered both as gardening paraphernalia and as an item of leatherware and therefore metal components (which may include metal rings and metal handles) may give rise a higher degree of similarity. I have reservations about this line of thinking. I am not familiar with the concept of a ‘gardening bag’ as such; I’m aware of green waste bags, but those are not leatherware. Is a ‘gardening bag’ a bag for carrying about a pair of secateurs, gardening gloves, garden twine? I have no evidence that leather bags, featuring metal components, exist for that specific purpose. I note that “paraphernalia” is defined in the Oxford online dictionary as “miscellaneous articles, especially the equipment needed for a particular activity” as in the example “*drills, saws, and other paraphernalia necessary for home improvements*”. It seems to me something of an unnatural strain to describe a leather bag as gardening paraphernalia. Nonetheless, I am content to accept Mr Muir Wood’s estimation that there is “at least a low degree of similarity” and shall continue to consider the other aspects of the section 5(2)(b) ground



on that basis.

### **The average consumer and the nature of the purchasing act**

31. It is necessary to decide who is the average consumer for the parties' goods and how the goods are purchased. "Average consumer" in the context of trade mark law means the "typical consumer." 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 type of goods or services in question. In view of my findings above, the goods in this instance are:

*metals; metal handles; metal rings in relation to plant and planting, garden and gardening apparatus, equipment and paraphernalia*

and

*metal components for leatherware especially closure systems, locks and padlocks*

32. Only the Opponent made submissions as to the nature of the average consumer of the parties' goods. Mr Muir Wood submitted in his skeleton argument as follows:

*"The average consumer of the goods concerned is likely to be a member of the public. The degree of care taken will depend on the value of the goods. Since there is no limitation on value, the likelihood of confusion should be assessed on the basis of the lowest degree of attention and thus an average rather than a high degree of attention should be considered."*

33. I accept that analysis. Some of the goods, being component parts, may be targeted to, say, manufacturers of leatherware, whose business level of attention may be higher than a member of the general public, but since the goods may also be offered for sale to the general public and may be inexpensive items, I agree that the level of attention may be considered "average" or medium, rather than high.

34. The parties made no submissions or evidence as to where or how "*metal components for leatherware especially closure systems, locks and padlocks*" are sold. Clearly such goods may feature as components on bags or purses, but that is not the consideration here. A consumer purchases a bag as a whole – not as a collection of its component parts - clasps, locks leather, thread and so on. Leatherware goods such as bags may be

sold in specialist luggage shops, or perhaps in fashion or shoe shops, but I doubt that those same outlets also sell what are the Opponent's relevant goods in the present case – i.e. *metal components for leatherware especially closure systems, locks and padlocks*. It seems to me more likely that such goods would be sold perhaps in a craft shop or perhaps even by a key cutting business, which often offer shoe and leatherware repair.

35. The applied-for goods at issue under this ground are *metals; metal handles; metal rings in relation to plant and planting, garden and gardening apparatus, equipment and paraphernalia*. It seems to me that such goods would be sold for instance at garden centres or in DIY stores like B&Q, or by specialist providers of garden metalware (such as the Applicants). The respective marks would be seen on the goods themselves, whether stamped or labelled, and on sales and promotion materials for those goods. Visual considerations may therefore be regarded as of primary importance in the purchasing process, though it is also possible that the goods may be requested orally from a sales assistant, so I also take into account the way the marks sound.



### **Comparison of the marks**

36. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.<sup>16</sup> *Sabel* 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 in *Bimbo* 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.”<sup>17</sup>
37. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

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16 *Sabel BV v Puma AG*, Case C-251/95

<sup>17</sup> *Bimbo SA v OHIM*, Case C-591/12P (paragraph 34)

<p><b>The Opponent's Earlier Mark 1:</b></p>	
<p><b>The Applicant's contested trade mark:</b></p>	

38. The Opponent's Earlier Mark 1 comprises two letters overlapped to form a monogram device. Those two letters are (alphabetically) L and V. The overall impression of the mark derives from those two letters and their configuration.
39. The Applicant's contested trade mark is also a figurative mark, though its dark square background is fairly banal and contributes little to the overall impression. The overall impression derives rather from the text 'L V Bespoke' and the device that sits above it. The text is the more distinctive element – it sticks more readily in the mind than the figurative element alone and will be how the consumer would refer to the mark. Still, the device is far from negligible and given its central position it is only a little less dominant than the text element. The colour tone scheme applied to the device and the text also contributes to the overall impression, but modestly so.

### **Visual comparison**

40. The Applicant submits that the only similarity between the marks is the inclusion of the letters L and V, but that the Opponent's trade mark protection "is tied to the fixed appearance of their monogram and not the letters L and V per se." Ms Harvey referred to there being a "low degree of similarity" between the Earlier Marks and the Applicants' Logo.<sup>18</sup>
41. For the Opponent, Mr Muir Wood submitted in his skeleton argument as follows:

*"Visually, [Earlier Mark 1] contains the letters 'L' and 'V'. In light of the use made and the knowledge that they stand for 'Louis Vuitton', they will be considered in that order. [the Applicants' Logo] contains the same two letters, in the same order, followed by the*

<sup>18</sup> Her skeleton argument at paragraph 6(c)(i).

word 'BESPOKE'. It also contains some slight figurative decoration. [Earlier Mark 1] does not claim any colours, so could be used in rose gold on a black background. Indeed, as Ms Kainane has explained, the Opponent is known for using a highly similar colour scheme. Accordingly, the [Earlier Mark 1] is visually similar to [the Applicants' Logo] to a moderate degree."

42. At the hearing, Mr Muir Wood submitted: "*they both start with the letters LV, whether overlapping or separated. The average consumer will notice that there's an addition of a figurative element, and the word bespoke in [the Applicants' Logo], which are not likely to go unnoticed visually. So there's similarity to at least a moderate degree. However, we say the figurative elements will be ignored, so that similarity increases slightly.*"

43. It seems to me that the reference to the letters being "*considered in that order*" is a tacit acknowledgement that taken at face, without any knowledge of brand use, Earlier Mark 1 is at least as likely to be perceived to be seen as V and L – in that order. This is because letters are firstly read from left to right, but here the letters of the monogram are aligned, so that neither is left nor right. In those circumstances, the consumer may typically read the letters from top to bottom – hence V and L, in that order. Case law indicates that the reputation of an earlier mark is not to be taken into account in relation to the assessment of similarity. In *Ravensburger AG v OHIM*, the General Court held that:

*".... The reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the likelihood of confusion, and not for the purposes of assessing the similarity of the marks in question, which is an assessment made prior to that of the likelihood of confusion (see, to that effect, judgment of 27 November 2007 in Case T-434/05 Gateway v OHIM – Fujitsu Siemens Computers (ACTIVY Media Gateway), not published in the ECR, paragraphs 50 and 51)."*<sup>19</sup>

On further appeal the CJEU held in *Gateway v OHIM*, Case C58/08 P, that it was not necessary for the General Court to make apparent the degree of renown of the earlier mark because it was not relevant in circumstances where the marks as a whole were not similar.

44. In any event I accept that the letters L and V are visually apparent in both marks, but I

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19 Case T-243/0, at paragraph 27.

do not accept the submission that “the figurative elements will be ignored”, increasing similarity. The monogrammatical configuration of the Opponent’s earlier figurative trade mark makes a significant contribution to its overall impression (and distinctive character).

45. The only point of commonality is the presence of the same two single letters L and V; case law indicates that it is not appropriate to apply complex colour arrangements to a mark registered in black and white,<sup>20</sup> but I acknowledge that Earlier Mark 1 could be rendered in a broadly comparable colour scheme. There is no monogram or overlapping of text in the Applicants’ Logo. The letters in the Applicants’ Logo are clearly separated; the word that looms largest in the mark is “bespoke”. I accept that that word is not distinctive on its own, but nor is it a negligible component of the mark as a whole. It supplies an additional seven letters that are entirely absent from Earlier Mark 1. The diamond-shaped arrangement of tilted squares of different sizes is a device that also contributes to the overall impression of the Applicants’ Logo and has no counterpart in Earlier Mark 1.
46. Having in mind the overall impressions of the marks and their notable differences, I find them to share a low degree of visual similarity.

### **Aural comparison**

47. For the average consumer who would say the Opponent’s Earlier Mark as L V (as opposed to V L) there is a direct aural overlap with the first two syllables (L V) of the Applicants’ mark. An aural difference arises from the additional two syllables of the second textual element ‘be-spoke’. The respective marks are aurally similar to a medium degree in those circumstances. (They are aurally dissimilar for the average consumer who would say the Opponent’s Earlier Mark as V L.)

### **Conceptual**

48. In his skeleton argument, Mr Muir Wood submitted that “conceptually, neither [Earlier Mark 1] nor [the Applicants’ Logo] has a particular concept, other than the idea of a brand called ‘LV’. At the oral hearing, Mr Muir Wood submitted that “*conceptually, we say that there is essentially identity or very high similarity because both signs refer to a brand LV. The figurative element is broadly decorative, so it doesn’t add anything to the concept of the [Applicants’ Logo] and the word ‘bespoke’ is a very generic addition to the word LV,*

*implying an enhanced range or especially made subset of goods under the brand. So we say this points to the average consumer seeing these conceptually as a brand on sub-brand, the shared concept being a brand called LV.”*

49. I again bear in mind the general case law steer away from bringing into play any reputation that may attach to an earlier mark (notably through its use) as a consideration in the assessment of similarity. An assessment of similarity of the marks is a step in the analysis to be taken before then feeding that factor of similarity into the mix with all other relevant factors in determining whether or not a likelihood of confusion may arise. (Case law recognises, for example, that in assessing the likelihood of confusion, it is permissible to take account of a conceptual difference between the marks as a factor that mitigates the risk of confusion from the visual and aural similarities between them.<sup>21</sup>) More pertinently, I note that in *Retail Royalty Company v Harringtons Clothing Limited*,<sup>22</sup> Phillip Harris, as the Appointed Person, considered the argument that the letters “AE” had, through their use, acquired an independent conceptual significance which would mean that the average consumer would always perceive them as meaning “AMERICAN EAGLE”. Mr Harris wrote:

*“74. The Opponent is trying to equate reputation in a trade mark sense with conceptual meaning. They are not the same thing. Reputation can mean different things, and in trade mark law the term is sometimes used loosely, but in this context, it concerns the factual extent to which a sign is recognised by a significant part of the public as a trade mark [original emphasis].*

*75. In contrast conceptual meaning is, in simple terms, something akin to recognition in dictionaries (beyond a mere trade mark acknowledgement) or a level of immediately perceptible notoriety/independent meaning, outside the confines of a purely trade mark context, of which judicial notice can be taken. Whilst a trade mark’s reputation might evolve or be converted into a conceptual meaning (possibly to its detriment in terms of genericity), it needs to be properly proven.*

*76. It is true that there are cases where an extensive reputation has been parlayed into conceptual meaning (for example C-361/04 P PICASSO/PICARO and C-449/18 MESSI)*

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21 See the CJEU judgment in Joined Cases C-449/18 P and C-474/18 P, EU:C:2020:722, EUIPO v Messi Cuccittini and J.M.-E.V. e hijos v Messi Cuccittini.

22 BL O/593/20

*but these are the exception rather than the rule and depend on their own facts. Furthermore, the “reputation” element in those cases related to the fame attached to the names of the individuals for their roles in society, rather than specifically to a trade mark function. In other words, it was a different sort of reputation.”*

50. I fully accept that the Earlier Marks (the monogram of the two letters L and V, whether circled or not) have acquired a significantly enhanced distinctive character – i.e. a character that denotes certain goods as originating from a particular undertaking and no other. I note, for example the survey evidence at **Exhibit LK9** from January 2021 (in collaboration with YouGov) shows that 53% of the 1533 UK respondents recognised (had seen before) the LV monogram. And when asked “to which brand of luxury fashion and accessories do you associate [the uncircled monogram of Earlier Mark 1], a significant percentage were able to volunteer that they associated it specifically with Louis Vuitton (the Opponent). Earlier Mark 1 – the monogram of Louis Vuitton – might well therefore have a concept, but in my view it is not comparable to the Messi or Picasso examples. The concept of the monogram and its association with the Opponent remains confined to *purely to a trade mark context*. In any event, the concept is tightly connected to the monogram as such; the evidence does not sufficiently establish the exclusive trade mark concept as extending to the plain letters L and V. So while the entwined L and V in Earlier Mark 1 may stand for Louis Vuitton, that same concept is not one that can be presumed to be shared by the same letters that appear in the Applicants’ Logo.
51. For a conceptual message to be relevant it must be capable of being immediately grasped by the average consumer.<sup>23</sup> I accept that the Applicants’ Logo incorporates the first initials of Lawrence and Victoria (the husband and wife who are the Applicants). However, this would not be apparent to the UK general public. Consequently, there is no contrastingly distinctive concept arising from those two letters that the average consumer, on encountering the Applicants’ trade mark, would immediately grasp.
52. Our alphabet has 26 letters, each of which may be the initial of who knows how many words; likewise two letters used together may stand for any number of two different words. Of course the Applicants’ mark has additional element of the ordinary dictionary word ‘bespoke’, which has a clear enough concept – as an adjective signifying goods or services made for a particular customer or user. However, that word is not distinctive. It

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23 This point is made in numerous judgments of the General Court and the Court of Justice of the European Union (“**CJEU**”) including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.

would be wrong to afford the Applicants the benefit of a distinguishing concept based on the absence of the non-distinctive word 'bespoke' from the Opponent's mark. Likewise, the absence of the broad concept of a monogram from the Applicants' Logo is not enough to give rise to a significant conceptual difference between the marks. In my view, in assessing the conceptual similarity between the respective marks the fairest conclusion is to regard the position as neutral; the marks neither share, nor are differentiated by a relevant conceptual message.

### **Distinctive character of the earlier trade mark**

53. The distinctive character of the earlier marks must be considered. The more distinctive an earlier mark, either by inherent nature or by use, then there is potentially a greater the likelihood of confusion (*Sabel*). In *Lloyd Schuhfabrik* 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 ...*

*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)."*<sup>24</sup>

54. The distinctive character of a trade mark can be appraised only, first, by reference to the goods specified in the registration and, secondly, by reference to the way it is perceived by the relevant public.<sup>25</sup>
55. As I have indicated earlier in this decision, two letters are, on an inherent basis, not

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<sup>24</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97  
<sup>25</sup> *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91



especially distinctive; the distinctiveness of the two letters in Earlier Mark 1 is increased by their particular presentation, entwined into a monogram. However, while the positioning of the letters in that way is inherently more distinctive, it may, as I noted previously, also have the effect of leading the relevant public to perceive the letters as V and L (in that order), perhaps more readily than L and V (in that order).

56. However, I also accept that evidence filed by the Opponent shows that the use of Earlier Mark 1 has educated the public that the monogram refers to Louis Vuitton (so L and V, in that order).
57. I must appraise the distinctiveness of the monogram when used in the relation to the goods of the fair specification on which the Opponent is able to rely for this section 5(2)(b) claim - namely, *metal components for leatherware especially closure systems, locks and padlocks*.
58. The Opponent has not claimed a reputation in respect of its goods in Class 6. I have previously noted that the evidence does not show that these are component goods sold separately by the Opponent, but do feature on items of the Opponent's leatherware, particularly its bags.<sup>26</sup> Through the Opponent's use of Earlier Mark 1 over a long period of time and with notable success in relation to luxury leatherware goods such as bags and purses, with metal components, I find that the distinctive character of the Earlier Marks has been enhanced and this extends to use of the mark in relation to metal components for leatherware. I would estimate the degree of distinctiveness of Earlier Mark 1 for its Class 6 goods as above medium.

### **Conclusion as to likelihood of confusion**

59. I turn now to make a global assessment of likelihood of confusion if the parties' marks were used concurrently in respect of their respective goods. This assessment takes account of my findings set out in the foregoing sections of this decision and of all of the various principles from case law outlined in my paragraph 21 above.
60. It requires a realistic appraisal of the net effect of the similarities and differences between the marks and the goods in issue, giving the similarities and differences as much or as little significance as the relevant average consumer would attach to them, noting that such

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<sup>26</sup> I have noted the third-party evidence that described as "iconic" a padlock bearing the monogram, but I do not consider the evidence of an "LV padlock chain bag charm" to be a component of leatherware as such.

a consumer is taken to be reasonably well-informed and reasonably observant and circumspect. The average consumer is a hypothetical person - a legal construct - created to strike the right balance between the various competing interests including, on the one hand, the need to protect consumers and, on the other hand, the promotion of free trade in an openly competitive market.<sup>27</sup>

61. Confusion can be direct or indirect. Whereas direct confusion involves the average consumer mistaking one trade mark for the other, indirect confusion is where the average consumer realises that the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related.
62. In *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, O/0368/23, Emma Himsworth K.C., as the Appointed Person, summarised the correct approach when assessing the likelihood of confusion where the only common element between the marks in issue has no or low distinctiveness as follows, at paragraph 44:

*“(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.*

*(2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.*

*(3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.*

*(4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.*

*(5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.*

*(6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant*

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<sup>27</sup> *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ, particularly paragraph 34.

*visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical.*"<sup>28</sup>

63. Although I have found Earlier Mark 1 to benefit from an enhanced distinctiveness (to a greater than medium degree) in respect of its Class 6 goods, those goods are similar to the Applicants' goods in Class 6 only to a low degree. I have also found the degree of visual similarity between the marks to be low, and that visual considerations are primary in the purchasing process. There is a medium degree of similarity in the pronunciation of the marks, but the shared element is simply the shared letters L and V, which, as two plain letters of the alphabet are of low inherent distinctive character. The conceptual position is neutral. The overall impressions of the marks are not similar and the Applicants' Logo has no monogrammatical feature, which is the aspect that enhances the distinctiveness of Earlier Mark 1.
64. A member of the public, as the average consumer paying a medium/average level of attention would not mistake the marks for one another; there will be no direct confusion. Nor is there any proper basis to find that the average consumer who would note the differences between the marks would be led conclude that since the marks share the letters L and V, the goods must come from the same or economically-related undertaking. I reject the Opponent's submission that the contested mark will be understood as a sub-brand of the Opponent. Not only is the common element between the marks low in distinctiveness, but the respective goods are essentially quite different, even if they have a low degree of similarity based on the case law factors.
65. Mr Muir Wood's skeleton argument referred to *Whyte & Mackay v. Origin Wine*,<sup>29</sup> which noted that in *Medion v Thomson* and subsequent case law, the European Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark. However, that case law makes clear that even where an element of the composite mark which is identical or similar to the earlier trade mark has an

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28 In formulating this summary, Ms Himsforth reviewed the case law in *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch) and *Nicoventures Holdings Limited v The London Vape Co Ltd* [2017] EHC 3303 (Ch), as well as guidance in the *Common Communication on the Common Practice of Relative Grounds of Refusal - Likelihood of Confusion (impact of non-distinctive/weak components)* dated 2 October 2014.

29 *Whyte & Mackay v. Origin Wine UK Ltd* [2015] EWHC 1271 (Ch); [2015] E.T.M.R. 29 (§§18-21).

independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors. Firstly, I do not accept that the plain letters L and V have distinctive significance which is independent of the significance of the whole, and secondly, I have carried out a global assessment taking into account all relevant factors and have anyway found no likelihood of confusion.

66. **OUTCOME UNDER SECTION 5(2)(b):** The opposition under section 5(2)(b) fails.

### **THE SECTION 5(3) CLAIM**

67. Section 5(3) of the Act, reads as follows:

(3) A trade mark which—

(a) is identical with or similar to an earlier trade mark, and

(b). [...]

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

68. And section 5(3A) states:

(3A) “Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.

69. The relevant case law for section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel Corporation*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure*, Case C-487/07 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.
- (g) 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; *Intel, paragraph 74*.
- (h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

- (i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

### Similarity of the marks

70. An initial requirement under section 5(3) is that the marks at issue must be at least similar. For its claim under section 5(3) of the Act the Opponent relies on two other of its earlier trade mark registrations – Earlier Marks 2 and 3. Earlier Mark 3 (the actual mark itself) is identical to the monogram mark registered under Earlier Mark 1 discussed under the section 5(2)(b) ground. Earlier Mark 2 (the actual mark) is also identical save for its being presented inside a circle; I note that at three of its extremities the monogram appears to be connected to the circle. In terms of similarity of the actual marks relied on by the Opponent for this section 5(3) ground, based on reputation, I find that Earlier Mark 2 is visually still less similar to the Applicants' Logo than is the uncircled monogram under Earlier Mark 3, whose direct equivalent I previously found to be low. My finding of a medium degree of aural similarity is unaffected by the addition of the circle. Likewise, the circle does not change my findings in relation to concept. Earlier Marks 2 and 3 satisfy the first requirement that there be at least some similarity in the marks.

### Reputation

71. The second requirement for success under this section 5(3) ground is that Earlier Marks 2 and 3 must enjoy a reputation in respect of the claimed registered goods.
72. A reputation under Earlier Mark 2 is claimed in respect of *perfumes; perfumery products* in **Class 3**; a reputation under Earlier Mark 3 is claimed in respect of '*trunks, travelling bags, chests, bags, handbags, pocket wallets, purses, card holders*' in **Class 18**, and '*clothing*' in **Class 25**.

73. By the time of the hearing, the Applicants did not dispute that the Earlier Marks enjoyed a reputation. Ms Harvey’s skeleton argument stated that the Applicants accept that Earlier Marks 2 and 3 are “a well-known brand within clothing, luxury luggage and bags including their related padlocks comprising part of said luggage/bags plus perfumery in the UK.”
74. At the hearing, Mr Muir Wood submitted that the Applicants’ characterisation of the monogram Earlier Marks as “well-known” for bags, perfumes and clothing (to paraphrase), constituted “an admission of a strong reputation, strong goodwill” and that “we’re not in sort of borderline territory”.
75. So how strong is the reputation, and for what goods? The CJEU in *General Motors* gives guidance on assessing the existence of a reputation. Paragraph 27 of that judgment requires that I “take into consideration all the relevant facts of the case, 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.” These factors must be relevant not only in establishing the existence of a reputation – and in this case the existence of a reputation is accepted – but also in gauging the strength of the reputation. There are some significant gaps in the evidence, notably a lack of information on sales figures and promotional expenditure. Market share is therefore unknown, and, more significantly, it is not possible to gauge sales levels for particular categories of goods.
76. That said, the Opponent has several outlets in London and other cities in England (and in Edinburgh) and there is considerable evidence of press coverage, social media promotion, twice-yearly UK distribution of “The Book”.<sup>30</sup>
77. I note, for instance, the UK version of the Opponent’s website drew visitors numbering between nearly 2 million up to over 4 million each month from May 2019 – December 2021.<sup>31</sup> Exhibit LK4 includes a Vogue article from October 2021 headed “Classic Louis Vuitton Handbags” which includes references to “coveted, revered, and virtually unchanged” “the interlocking L and V with floral pattern” has become one of the most recognizable marks in the world” “the famous logo ... that V overlapping the L, in tawny

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31 Paragraph 4 of the Second Witness Statement of Laure Kainane gives a table of figures indicating that in each of the years between 2017 and 2022 typically around 40,000 books were distributed in the UK. I take it that most of the recipients of The Book are any customers who have ordered a product (of some sort) from the Opponent.

gold over saddle brown”, the “iconic LV monogram”. And I have previously highlighted the degree of UK consumer recognition shown in the survey evidence of Exhibit LK9. The Mark is clearly known by a significant part of the relevant public.

78. The evidence overall is richer in respect of luxury bags/luggage/leatherware and I find it well established in the evidence that the monogram mark has a strong reputation for those goods. The evidence is far thinner in respect of clothing and stiller thin in respect of perfumes. Exhibit LK10 includes a selection of receipts for individual sales of various perfumes in London in the years 2018 – 2021. They show perfumes such as:



Each of these perfume goods retails for hundreds of pounds and they appear to bear the Earlier Mark on their caps (which is seen more clearly in a small number of images in Exhibits LK5 and LK8). However, the paucity of evidence of promotion and lack of information on sales totals makes it difficult to assess any claimed reputation for perfumes. However, given the Applicants’ inclusion of “*perfumery*” in its reference to the Earlier Mark being “*a well-known brand in the UK*” I also find that the reputation of the



Opponent's monogram as a luxury brand extends to perfume, though the strength of the reputation for those goods cannot be gauged.

### **Mental Link**

79. It is also necessary for the public, confronted with the Applicants' Logo, to call to mind the Opponent's monogram. Whether such a link exists must be assessed globally taking account of all relevant factors, including, as Mr Muir Wood set out in his skeleton argument:<sup>32</sup>
- (a) the degree of similarity between the conflicting marks;
  - (b) the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
  - (c) the strength of the earlier mark's reputation;
  - (d) the degree of the earlier mark's distinctive character, whether inherent or acquired through use; and
  - (e) the existence of the likelihood of confusion on the part of the public.
80. Having these factors in mind, I am not satisfied that the public would make a mental link between the contested mark and the Opponent's reputed Earlier Marks.
81. I acknowledge the significant strength of reputation of the Opponent's Earlier Marks, but that reputation attaches to the overall mark, which is a monogram of the letters L and V. The similarity with the Applicants' Logo is low. The marks overlap only in the letters L and V; those letters are of low inherent distinctiveness and in the Applicants' Logo they are presented conventionally equidistant. The goods in respect of which the Earlier Marks have a reputation are generally not similar to the goods applied for. Similarity of goods is not a requirement for success under section 5(3), but the degree of closeness of the reputed goods is a relevant factor. The goods in Classes 18 and 25 are not at all close to the goods applied for in Classes 6 and 31.
82. I note Mr Muir Wood's submission at the hearing that "there is at least a low degree of

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32 See judgment of the CJEU at §42 *Intel Corporation Inc. v. CPM United Kingdom Ltd* (C-252/07) EU:C:2008:655; [2009] E.T.M.R. 13

similarity between perfumes and Class 31 - plants, especially dried plants, because of the fact that dried plants can in fact be used as pot pourri, and things like that, which are of themselves perfumed.” The point was put in stronger terms in his skeleton argument, where he submitted that “there is identity between ‘dried plants’ and ‘perfumery products’, since the former can be used as the latter.” He argued that “there is also similarity arising from the possibility of ‘perfumery products’ and ‘plants’ being sold through the same stockists and thus it being assumed that they share an origin.”

83. I have already observed that the extent and strength of the Earlier Mark’s reputation for its claimed goods in Class 3 is not well established by the evidence. I have no evidence to support the submission that perfumes and plants are typically sold through the same stockist. A perfume is a carefully formulated liquid, typically for personal application. Having in mind the criteria for similarity set out previously in this decision – including physical nature, method of use, users, trade channels, complementarity, as well as method of production/manufacture – I find that any similarity between the Applicants’ goods in Class 31 (including dried flowers) and the goods in Class 3 for which the Earlier Mark has a reputation is low and is based on a shared characteristic of fragrance provision.
84. I have previously rejected any likelihood of confusion in respect of (different) goods of low similarity. Making a mental link / bringing a mark to mind, is a less exacting process, a lower threshold than for generating a likelihood of confusion. At the hearing, Mr Muir Wood referred to there being an insurance brand called LV, and did not suggest that the link would be made to that service provider, but argued that in the present case the goods are not “wildly, vastly different” and that consequently a link will be made. Since there is nothing in the applied-for specification to limit where the goods may be sold, he presented the possibility that a pop-up shop selling LV bespoke plants may open in a particular location where the Opponent itself is “known to have a very high reputation for perfumes and where perfumes and ‘smellies’ (for want of a better phrase) and plants all have some link and association with each other” as “products which are sold in plant shops which can be used to change the aroma of the home” and that in those circumstance a “link is likely to be made” and “that the plants described as LV bespoke will be seen to be special one-off limited edition plants associated with the brand.”
85. I find the elaboration of the above scenario is a valiant attempt to establish the section 5(3) ground and the necessary link. Nonetheless, for the reasons I have given in my

preceding few paragraphs, I do not find that a consumer buying any of the Applicants' goods in Class 6 or 31 will bring to mind the Opponent's Earlier Marks 2 or 3.

86. Mr Muir Wood cited the *Intel* case law in his skeleton argument, noting that in the absence of such a link in the mind of the public, the use of the later mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark and that the existence of such a link is anyway not sufficient, in itself, to establish that there is one of those types of injury. Since I have found no link will be made, the section 5(3) ground inevitably fails.
87. Even if the very particular scenario painted by Mr Muir Wood were to force a mental link among the relevant section of the public, I am not convinced that the necessary injuries would also follow merely by virtue of the common presence of the two letters. It does not seem to me that if there were an advantage to the Applicants, that it would be unfair, or that use would be apt to reduce the distinctiveness of the Earlier Mark, whose distinctiveness derives majorly from its figuration as a monogram. Nor is there anything disreputable in the nature of the Applicants' goods. I also consider that the Applicants, who for some time and with some recognition have been using the trade mark applied for, are likely to be able to rely on due cause for use of their contested trade mark, featuring the plain two letters L V, the initials of the Applicants' first names, Lawrence and Victoria, thereby anyway defeating the claim based on section 5(3).
88. **OUTCOME UNDER SECTION 5(3):** The opposition under section 5(3) fails.

### **THE SECTION 5(4)(a) CLAIM**

89. Section 5(4)(a) of the Act states that:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

- a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

[...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark ...”

### Relevant legal principles

90. The above legislative provisions mean that a registered trade mark application may be successfully opposed if the proprietor of an “earlier right” can show that use of the contested trade mark is liable to be prevented by the law of passing off. The essential requirements that a claimant must establish to sustain a passing off claim are:<sup>33</sup>
- (a) a protectable goodwill in the UK owned by the claimant at the relevant date;
  - (b) a misrepresentation made by the defendant which is liable to deceive the public; and
  - (c) damage to the claimant’s goodwill caused by the misrepresentation.
91. The concept of goodwill has been described as “*the benefit and advantages of the good name, reputation and connection of a business*” and “*the attractive force which brings in custom.*” The same case law commented that “*it is the one thing which distinguishes an old-established business from a new business at its first start*”.<sup>34</sup>
92. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309, it is noted (with footnotes omitted) that:
- “To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:*
- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and*
  - (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.*

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33 The “classical trinity” per Lord Oliver in *Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341 HL, the “Jif Lemon” case.

34 House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217

*While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.*

*In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:*

- (a) the nature and extent of the reputation relied upon;*
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;*
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;*
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and*
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.*

*In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”*

93. In *SWORDERS TM O-212-06* Mr Allan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

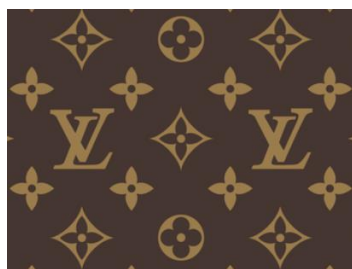
94. In the present case the Witness Statement of Victoria Osborne states that the Applicants’ have been trading as L V Bespoke since 1 June 2020. An example of the use is shown at Exhibit LV01:



95. The evidence establishes that the monogram signs, which are the unregistered trade marks in respect of which the Opponent claims goodwill, had been used for years before the Applicants first used their contested trade mark. I find that the Opponent had actionable goodwill associated with the relevant signs in respect of *perfumes, trunks, travelling bags, chests, bags, handbags, pocket wallets, purses, card holders and clothing* not only at the date on which the Applicants applied for their trade mark, but also in June 2020, the date of claimed first use. The first requirement of the tort – goodwill – is therefore satisfied; the next consideration is misrepresentation.
96. I find that one may treat the issue of misrepresentation under the section 5(4)(a) ground of opposition as being broadly comparable with the issue of likelihood of confusion under section 5(2)(b). The considerations are not formally the same: it is sufficient for passing off purposes that “*a substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the present case, I see no reason why the difference between the legal tests would produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.<sup>35</sup>

<sup>35</sup> See judgment of Kitchin LJ in the Court of Appeal (infringement case) *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41.

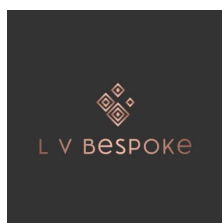
97. I do not overlook that the goodwill associated with the Opponent's leatherware, bags and clothing, has arisen, in part, from long and prominent use of this pattern:



98. Ms Kainane describes this as “the Monogram which is the LV Logo in combination with flowers”, created in 1896 by George Vuitton, son of Louis. The pattern features extensively on the Opponent's goods and I confirm that it includes the relevant sign. None of the claims is based on the pattern as such, though the Opponent submits that the manner of use of the Monogram is significant because the diamond-shaped device and colour scheme used in the applied-for mark is reminiscent of that used in the brown and gold pattern in which the Opponent has used its LV Logo.<sup>36</sup> To illustrate the Opponent's concerns, Ms Kainane presents these two images side by side:



The evidence includes colour images of the Applicants' Logo and the Opponent's pattern:



99. Despite the Opponent's submission that the contested mark is reminiscent of the Opponent's pattern, I see nothing to suggest any fraudulent intent. I do not find there to be any contrived similarity. The geometric device, with its coppery or rose gold metallic complexion, on a soft black background is not even particularly reminiscent of the Opponent's pattern. All of the points of difference that I have noted in my previous analysis of similarity – including the additional text, the lack of overlapping letters – continue to apply.

36 See particularly paragraph 8 of First Witness Statement of Ms Kainane and Exhibit LK4.  
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100. The Applicants have been trading for some time in a niche and separable area, not one shared by the Opponent, nor one into which the Opponent is ever likely to venture. Victoria Osborne states that the Applicants have encountered no actual confusion or any presumption that the parties are linked in some way; given that the overlap between these non-competing traders rests primarily on their sharing two letters in their signs, this assertion by the witness is unsurprising, and nor am I aware that the Opponent has initiated passing off proceedings against the Applicants. I find that the Opponent has failed to establish the required misrepresentation, in the absence of which the section 5(4)(a) ground cannot succeed.

101. **OUTCOME UNDER SECTION 5(4)(a):** The opposition under section 5(4)(a) fails.

### **COSTS**

102. The opposition has failed on all grounds. The Applicants are entitled to a contribution towards their costs in defending their trade mark application. In line with the scale published in the annex to Tribunal Practice Notice (2/2016), I award the following costs:

Considering the Opponent's statement of grounds and preparing counterstatement	<b>£500</b>
Considering and commenting on the other side's evidence during the evidence rounds (and preparing own evidence to the extent it was relevant)	<b>£2000</b>
Preparing for and attending the hearing	<b>£1500</b>
TOTAL	<b>£4000</b>

103. I order Louis Vuitton Malletier to pay Lawrence and Victoria Osborne the sum of £4000 (four thousand pounds). This sum is to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

**Dated this 16<sup>th</sup> day of January 2024**

*Matthew Williams*

**For the Registrar**