

O/0064/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 4086911
IN THE NAME OF ABDULWAHED BIN SHABIB DISTRIBUTION
FOR THE TRADE MARK**



IN CLASSES 3, 18 & 25

AND

**THE OPPOSITION THERETO UNDER NUMBER 451023
BY CAPRICE SCHUHPRODUKTION GMBH & CO. KG**

Background and pleadings

1. Abdulwahed Bin Shabib Distribution (“the applicant”) filed an application for the trade mark shown on the cover page of this decision (number 4086911) on 13 August 2024 (“the relevant date”) for goods in classes 3, 18 and 25.

2. Caprice Schuhproduktion GmbH & Co. KG (“the opponent”) opposes the application under sections 5(2)(b), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following two earlier trade mark registrations for its section 5(2)(b) ground:

(i) 903564937



Filing date: 8 January 2004; priority date 16 July 2003 (Germany); registration date: 23 March 2005

Class 25: *Shoes and footwear and parts for shoes, namely soles, heels, boot uppers.*

(ii) 915960826



Filing date: 24 October 2016; registration date: 23 February 2017

Class 25: *Footwear, soles for shoes and boots, heels for shoes and boots, insoles for shoes and boots (non-orthopaedic).*

3. The section 5(2)(b) ground is directed at the class 18 and 25 goods of the application. The opponent claims that the parties’ marks and goods are closely similar, leading to a likelihood of confusion.

4. The earlier marks are subject to the provisions of section 6A of the Act because they had been registered for five years or more at the date on which the application

was filed (“the relevant date”). The opponent has made a statement that the earlier marks have been put to genuine use.

5. Section 5(4)(a) of the Act is directed against the entirety of the application. The opponent claims that it has used the following three signs throughout the UK since 2003 in relation to *Footwear, soles for shoes and boots, heels for shoes and boots, insoles for shoes and boots (non-orthopaedic); shoes; boots; sandals:*

CAPRICE

The logo consists of the word "CAPRICE" in a bold, serif font. A stylized butterfly is positioned above the letter "I".

The logo consists of the word "CAPRICE" in a bold, serif font. A stylized butterfly is positioned to the right of the word, with its wings partially overlapping the letter "E".

6. The opponent claims that its business, distinguished by the three signs, has goodwill and that the use of the application would cause misrepresentation and damage to its goodwill. On this basis, the opponent claims that use of the application is contrary to the law of passing off.

7. The section 3(6) ground is directed against the entirety of the application. I will set out the pleadings in full because the only documentation filed by the applicant has been its counterstatement (it filed no evidence).

“16. Further, or in the alternative, the Application has been filed in bad faith for the reasons set out below. These are the best particulars that the Opponent can provide at this time, but the Opponent reserves the right to augment these particulars if any further information or evidence comes to light following the filing of this opposition.

a. As set out above, the Applicant's Mark is very closely similar to the Opponent's Marks. It cannot be a coincidence that the Applicant's Mark








incorporates both the word/name "CAPRICE" in combination with a butterfly device, neither of which has any descriptive meaning in respect of the Applicant's Goods.

b. The Applicant's Goods are closely similar to the Opponent's Goods.

c. The Opponent's Earlier Marks have been used for many years. The close similarity of the Applicant's Mark to the Opponent's Earlier Marks suggests that the Applicant was aware of the Opponent and the Opponent's business prior to the Application being filed. The Applicant's Mark is intended to ride on the coat-tails of the Opponent's goodwill and reputation.

d. The Applicant's Mark is likely to deceive customers as to the origin and/or legitimacy of the products marketed thereunder. Such an application cannot have been filed in accordance with honest commercial and business practices and therefore cannot have been filed in good faith.

e. The Applicant owns a number of trade mark applications and registrations in the United Kingdom. A number of these applications/registrations appear to have been filed in bad faith since they incorporate a range of third-party trade marks, or are closely similar to third-party marks. These include:

Applicant's application/registration	Third-party registration
UK00004086885 	UK00917919022 
UK00004086887 	UK00915743801 ARMANI
UK00004073362 	UK00002292693 TOMMY ¹
UK00004073464 	UK00906474051 UNDER ARMOUR
UK00004073523 	UK00912952933 
UK00004062584 Calvin Bags	UK00906710107 Calvin Klein

17. The pattern of behaviour by the Applicant, to file applications for trade marks which are closely similar to trade marks registered and owned by third parties, suggests that the Applicant has acted in bad faith.

18. By virtue of the above, it is submitted that the Applicant's decision to file the Application falls short of acceptable standards of commercial behaviour and that the intent of the Applicant in doing so is to mislead the public and to obtain an unfair commercial benefit riding on the coat-tails of the goodwill and

¹ The mark shown on the UK register for this number is TOMMY: this is, therefore, a typographical error in the opponent's table.

reputation attached to the Opponent's Earlier Marks. This constitutes an abuse of the trade mark system.

19. For these reasons, the Application should be rejected by virtue of the provisions of Section 3(6) of the TMA. The Opponent acknowledges that an allegation of bad faith is a serious allegation and one which will need to be supported in evidence. As such, the Opponent intends to supplement this Statement of Grounds with evidence at the appropriate point in the proceedings.”

8. The applicant filed a defence and counterstatement, denying the grounds of opposition and putting the opponent to proof that it has used its earlier marks and that it has goodwill. The applicant’s denial of the section 3(6) ground is as follows:

“25. The applicant denies the application was filed in bad faith. An allegation of bad faith is a serious allegation which must be distinctly proved. The mere fact that a trade mark bears some similarity to another trade mark is not in itself a marker of bad faith.

26. The opponent has not advanced any explanation on why it considers the application to be in bad faith other than pointing to other applications filed by the applicant. Many of the marks listed in on pages 4 and 5 of the Statement of Grounds of Opposition could be construed as parodies. The right to publish parodies is an important aspect of free speech (Human Rights Act s12) and is not sufficient to amount to bad faith. It is not an inherently dishonest business practice to use a sign which brings another trader to the mind of some consumers in an amusing but inoffensive way (Swatch AG v Apple Inc [2021] EWHC 719 (Ch)).

27. In any event there is nothing intrinsically wrong with the applicant filing the current application. The applicant has a bone fide intention to use the mark on the goods in question. The mark in question is equally capable of having a parodic character whilst at the same time functioning as a trade mark. The

mark applied for will not divert trade from the Opponent or any other party, nor will it deceive the public.”

9. The opponent is represented by Mathys & Squire LLP and the applicant by Lincoln IP. Only the opponent filed evidence. It also filed written submissions in lieu of attendance at a hearing. As mentioned above, the applicant has filed no documents other than its defence and counterstatement. I make this decision after careful consideration of all the papers on file, referring to them as necessary.

Evidence

10. The opponent’s evidence comes from Christian Burmeister and Harry Rowe. Mr Burmeister is the opponent’s Head of Sales International.² His evidence is aimed at proving genuine use and goodwill in relation to the earlier marks and signs. Mr Rowe is a Managing Associate at the opponent’s professional representatives. He provides information about other trade mark applications and proceedings involving the applicant.³

Proof of use

11. Section 6A of the Act states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

² Witness statement dated 1 April 2025 and exhibits.

³ Witness statement dated 2 April 2025 and exhibits.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

12. As the earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant.⁴ It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union.”

13. The relevant period for proof of use is the five years ending on the filing date of the contested application: 14 August 2019 to 13 August 2024. This means that the opponent can rely upon EU use (including in the UK) for the period of 14 August 2019 to 31 December 2020. From 1 January 2021 to 13 August 2024, any use shown must have been UK use. The burden of proof lies with the opponent, as the proprietor of the earlier marks, to show genuine use because Section 100 of the Act states:

⁴ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM or International Registration designating the EU ("IR(EU)"). The earlier marks subject to proof of use were originally protected in the UK as EUTMs. They are now comparable marks which are recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing and registration dates.

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

14. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:⁵

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

⁵ 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.

(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: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(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: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (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:

Ansul at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(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: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

15. Mr Burmeister states that the opponent sells its footwear directly to consumers via its outlet in Germany, its website and via local distributors in the UK and the EU. Its key local distributors in the UK include Clinkard Group Ltd (Middlesbrough), TJX Ltd (Watford), North Shoes Ltd (Bourne), Pavers Ltd (York), Humphries Ltd (Redditch), Morely Stores Ltd (London) and Wards Shoe Shop Ltd (Worksop). Earlier mark (i) was used first, with a transition being made to earlier mark (ii) in September 2017 (prior to the proof of use period). Mr Burmeister states that earlier mark (i) continued to be used whilst existing stock bearing earlier mark (i) was sold. Only earlier mark (ii) has been displayed on the opponent’s website during the proof of use period, as evidenced by screenshots from the English language version of the opponent’s website throughout the relevant period, using the Wayback Machine, the internet archive.⁶ Earlier mark (ii) is shown on the pages of the catalogues in Exhibit CB1 and inside the depicted footwear, which is all for women. The catalogues date from throughout the relevant period for proof of use. Mr Burmeister states that the catalogues were distributed to local distributors, online retailers, and to direct customers, being published twice yearly in English and German.

⁶ Exhibit CB2.

16. Mr Burmeister states that the opponent’s website receives more than 130,000 visitors, annually. Website analytics are shown in Exhibit CB3 which Mr Burmeister states give examples of the number of website visitors in 2024, broken down by the online routes from which those visitors accessed the opponent’s website; such as via Google.com, directly to the opponent’s website, or through social media sites. Exhibit CB4, from the Wayback Machine, shows use of earlier mark (ii) during the proof of use period on the websites of Wards and Humphries, in relation to women’s footwear.

17. Mr Burmeister states that during 2019 to 2024 more than 470,000 of the opponent’s goods were manufactured for sale in the UK:

Year	Total number of products manufactured
2019	56,000
2020	97,000
2021	65,000
2022	100,000
2023	105,000
2024	47,000

18. During the relevant period for which EU use is relevant, more than 3.2 million of the opponent’s products were manufactured for EU sale:

Year	Total number of products manufactured
2019	1,095,000
2020	2,105,000

19. For the proof of use period, Mr Burmeister states that total revenue for its goods sold in the UK was approximately €14.8 million. During the period for which EU use is relevant, the figure was approximately €89 million (excluding the UK). Exhibit CB5 comprises invoices to distributors across the UK from throughout the proof of use period. These show earlier mark (ii) at the top of each invoice, and detail ‘shoes’ as the items.

20. During the proof use period, the annual amount spent on advertising and marketing in the UK was approximately £60,000. During the relevant period for which EU use is relevant, the figure was approximately €575,000 for the EU (Mr Burmeister does not say whether this includes or excludes the UK). The opponent's goods were advertised by means of leaflets, posters, catalogues, website advertising and social media posts. Exhibit CB6 comprises examples of such materials, all showing earlier mark (ii) in relation to women's footwear. Mr Burmeister exhibits materials which he states relate to the opponent's attendance at trade shows in the UK and the EU during the proof of use period. Mr Burmeister states that the trade shows are attended by buyers from all over the world, including from the UK and that invitation cards were sent to numerous retailers. He states that the opponent has won or been shortlisted for a number of awards, as detailed in Exhibit CB9. The awards include winning (for the second time) the award for 'Ladies Footwear Brand of the Year' at the Footwear Industry Awards 2020, in Birmingham; Women's Footwear of the Year 2021 at the Drapers Footwear of the Year awards (and being a finalist in the following three years); International Brand of the Year at the UK Boutique Star awards in 2022; and being a finalist at the 2022 Footwear Industry Awards in four categories, winning in one of them.

21. I am satisfied that the evidence shows use of earlier mark (ii). The evidence shows continuous and consistent UK use throughout the relevant period. The only use shown is for women's footwear, which is a discrete category. There is no use shown for soles for shoes and boots, heels for shoes and boots, insoles for shoes and boots (non-orthopaedic), which comprise a discrete category of parts for footwear.⁷

22. There is no documentary evidence of the use during the proof of use period for earlier mark (i). However, Mr Burmeister has made an unchallenged statement that existing goods bearing earlier mark (i), superceded by earlier mark (ii) in September 2017, continued to be sold. What is not said is how long it took for existing stock to be sold and whether that continued into the relevant period, which began two years after the change to the mark. In the world of fashion, two years is a comparatively long time. However, in my view, use of mark earlier (ii) counts as acceptable variant

⁷ *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834.

use of mark (i). This is because the differences between the marks do not affect their distinctive character. The different typefaces are acceptable variants of each other, as per *Dreamersclub Ltd v KTS Group Ltd*.⁸ The devices in each mark are, essentially, the same butterfly, one simply being the black version. The only other difference between the devices is their position in the marks; marks which both contain the same word, CAPRICE. Although the butterflies are not non-distinctive, it is the word which is the dominant and distinctive component of both marks. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, said that:

“15.... where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.”

23. Accordingly, simply moving the butterfly has not changed the distinctive character of the marks. As per *Easygroup Limited v Easy Live (Services) Limited and ors*, [2025] EWCA Civ 946, at [73], the average consumer will be more influenced by the continuing presence of the butterfly than by the change in its position or presentation.⁹ Finally, the CJEU stated in *Bernhard Rintisch v Klaus Eder*, Case C-553/11, at [24], that “registration as a trade mark of the form in which another registered trade mark is used, a form which differs from that in which the latter mark is registered, while not altering its distinctive character, is not a bar to the application of Article 10(2)(a) of Directive 89/104.” Taking all this into account, I find that the opponent may rely upon the use of both earlier marks for its section 5(2)(b) ground in relation to *women’s footwear*.

⁸ Mr Phillip Johnson, sitting as the Appointed Person, Case BL O/091/19. See also the comments of Mr Thomas Mitcheson KC, sitting as the Appointed Person in *NEM S.R.L v Massman Companies, Inc*. Case BL O/1134/24: “20. Moreover, when citing *Dreamersclub* it is clear that the Hearing Officer was at that stage confining himself to a comparison between the different stylisations of the word/letters ‘NEM’ in the two marks. This was an appropriate case to cite for that comparison. It does not mean that he was applying the same reasoning to a comparison of the marks as a whole, which he correctly identified also contained figurative elements.”

⁹ See also *Athleta (ITM) INC. v Sports Group Denmark A/S & Anor* [2025] EWCA Civ 1584 at paragraph 54.

Section 5(2)(b) of the Act

24. Section 5(2)(b) states:

“5. (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.”

25. Section 5A states:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”¹⁰

26. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are taken from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

¹⁰ This section also applies to the ground raised under section 5(4)(a) of the Act.

The principles

- (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 goods

27. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

28. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

29. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, the General Court (“GC”) stated that complementary means:¹¹

“82 ... there is a close connection between [the goods], 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...”.¹²

30. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. 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.”

31. The applicant’s class 18 goods for comparison with the opponent’s *women’s footwear* are:

Adhesive tags of leather for bags; attaché cases; backpacks for carrying infants; bags [envelopes, pouches] of leather, for packaging; bags for campers; bags for climbers; bags for sports; bags; beach bags; briefcases; garment bags for travel;

¹¹ Case T-325/06, the General Court.

¹² In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods and services.

handbags; luggage tags / baggage tags; rucksacks / backpacks; school bags / school satchels; sling bags for carrying infants; slings for carrying infants; suitcase handles; suitcase packing organizers / luggage organizers; suitcases; tool bags , empty; travelling bags; travelling sets (leatherware); travelling trunks; trunks (luggage).

32. In *El Corte Inglés SA v OHIM (PiraÑam)*, Case T-443/05, the GC considered whether “Leather and imitations of leather goods not included in other classes” was similar to “Clothing, footwear and headgear”. The class 18 goods would include goods such as bags, wallets, purses and other leather or imitation leather accessories. The court acknowledged that the goods in classes 18 and 25 could be made of leather or imitation leather but, while it could be taken into account, this factor was not enough on its own to find similarity owing to the wide variety of goods which could be made of those materials. The court also said that it was apparent that the distribution channels of some of the goods were identical, so this was a factor to be taken into account. The court confirmed that there was a slight similarity between the goods. It also stated that:

“49 Goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image (‘look’) of the consumer concerned.

50 The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in class 25 and the various clothing accessories which complement them such as handbags in class 18. Any such coordination depends on the consumer concerned, the type of activity for which that look is put together (work, sport or leisure in particular), or the marketing strategies of the businesses in the sector. Furthermore, the fact that the goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them

and strengthen the perception that the same undertaking is responsible for the production of those goods.

51 It is clear that some consumers may perceive a close connection between clothing, footwear and headgear in class 25 and certain 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which are clothing accessories, and that they may therefore be led to believe that the same undertaking is responsible for the production of those goods. Therefore, the goods designated by the mark applied for in class 25 show a degree of similarity with the clothing accessories included in 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which cannot be classified as slight."

33. The GC referred to the above case in its judgment in *Giordano Enterprises Ltd v OHIM*, Case T-483/08, in which it specifically considered footwear against leather and imitation leather goods not included in other classes, such as handbags and purses. As before, it reached the conclusion that the goods are similar "at least to a certain degree".

34. Referring to the above two cases in *Gitana SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-569/11, the GC stated:

"45 Moreover, in respect of the relationship between the 'goods in leather and imitations of leather' in Class 18 covered by the trade mark sought and the goods in Class 25 covered by the earlier mark, it is apparent also from settled case-law that the 'goods in leather and imitations of leather' include clothing accessories such as 'bags or wallets' made from that raw material and which, as such, contribute, with clothing and other clothing goods, to the external image ('look') of the consumer concerned, that is to say coordination of its various components at the design stage or when they are purchased. Furthermore, the fact that those goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and support the impression that the same undertaking is responsible for the production of those goods. It follows that

some consumers may perceive a close connection between clothing, footwear and headgear in Class 25 and certain ‘goods made of these materials [leather and imitations of leather] and not included in other classes’ in Class 18 which are clothing accessories. Consequently, clothing, shoes and headgear in Class 25 bear more than a slight degree of similarity to a category of ‘goods made of these materials [leather and imitations of leather] and not included in other classes’ in Class 18 consisting of clothing accessories made of those materials (see, to that effect, *PiraÑAM diseño original Juan Bolaños*, paragraph 42 above, paragraphs 49 to 51; *exē*, paragraph 42 above, paragraph 32; and *GIORDANO*, paragraph 42 above, paragraphs 25 to 27).”

35. In *Asos Plc v OHIM*, Case T-647/11, the GC upheld a decision by OHIM (now the EUIPO) Fourth Board of Appeal that there was no similarity between clothing, footwear and headgear and “bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses”. The court stated:

“45 It is apparent from the case-law that goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image (‘look’) of the consumer concerned. The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say, coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in Class 25 and the various clothing accessories which complement them, such as handbags in Class 18 (*PiraÑAM diseño original Juan Bolaños*, cited in paragraph 15 above, paragraphs 49 and 50).

46 In the present case, in the contested decision, the Board of Appeal held that the ‘bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses’ in Class 18 — contrary to the ‘clothing, footwear, headgear’ in Class 25, which had an aesthetic function — essentially had a practical function, namely that of

containing sports equipment, documents, banknotes and coins, are not perceived as part of the external image, have no aesthetic function and are not included in the marketing strategy for fashion accessories. The Board of Appeal consequently held that the abovementioned goods, coming within Class 18, were not complementary to 'clothing, footwear, headgear' in Class 25. It added that it was unlikely that, when buying a briefcase or a wallet, the purchaser would be asked about the colour of the suits or shoes normally worn or, when buying a sports bag, the colour of his tracksuit.

47 That appraisal by the Board of Appeal must be upheld.

48 Firstly, the 'bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses' in Class 18, unlike the 'clothing, footwear, headgear' in Class 25, have an essentially utilitarian function and not an essentially aesthetic function. There is therefore no reason for the consumer to coordinate them with the 'clothing, footwear, headgear' in Class 25. In contrast to handbags, coming within Class 18, the goods at issue in Class 18 do not contribute to the external image of consumers.

49 Secondly, the purchase of the goods at issue in Class 18 is viewed independently from the purchase of 'clothing, footwear, headgear' in Class 25. The average consumer will purchase 'bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses' without worrying about the concomitant possession or purchase of 'clothing, footwear, headgear' in Class 25. Conversely, for the average consumer, the decision to buy 'clothing, footwear, headgear' in Class 25 is generally not influenced by, or subject to, the purchase or possession of the goods at issue in Class 18.

50 It follows that the 'bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses' in Class 18 cannot be considered to be clothing accessories.

51 In addition, even if the goods at issue in Class 18 were to share with the goods at issue in Class 25 the same distribution channels and have the same end users, that would not suffice for the conclusion that there is a similarity between those goods. Lastly, the intervener's argument that those goods in Class 18 and the 'clothing, footwear, headgear' in Class 25 are generally produced by the same manufacturer has not been substantiated.

52 It follows that the Board of Appeal acted correctly in holding that the 'bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses' in Class 18 and referred to in the application for the mark sought and the goods in Class 25, covered by the earlier mark, were not similar."

36. The main point for me to consider which has emerged from these cases is that, depending upon the goods in class 18, they may be complementary to (women's) footwear as being part of the effort to achieve a co-ordinated look, such that the goods will be regarded as being the responsibility of the same undertaking. The last of the judgments which I have set out above was handed down on 29 April 2014. This was some ten years prior to the relevant date in these proceedings. In that time, fashions have changed. It seems to me that the wearing of tracksuits and trainers as general fashionable casual wear, as opposed to mainly for participating in sport, is now more prevalent than it was in 2014. Trainers are worn as fashion items, as well as for sports. It may be that the image-conscious wearer of trainers, perhaps attending a gym, will want a co-ordinated sports bag to complete the overall look, rather than a sports bag to fulfil a simply utilitarian function.

37. With that in mind, I turn to the applicant's class 18 goods. I consider that the following goods are not similar to the opponent's *women's footwear* because they serve only a practical purpose and would not be part of a co-ordinated look, even if they are made from the same materials. It is unlikely that they share the same trade channels: *Adhesive tags of leather for bags; bags [envelopes, pouches] of leather, for packaging; garment bags for travel; luggage tags / baggage tags; suitcase handles; suitcase packing organizers / luggage organizers; tool bags, empty*. I also consider it unlikely that anyone would co-ordinate their footwear with *attaché cases; briefcases;*

backpacks for carrying infants; bags for campers; bags for climbers; rucksacks / backpacks; school bags / school satchels; sling bags for carrying infants; slings for carrying infants; suitcases; travelling bags; travelling sets (leatherware); travelling trunks; trunks (luggage) and it is unlikely that the goods would share trade channels. They are not similar. As there is no similarity between these goods and the opponent's goods, the opposition fails under section 5(2)(b) against the applicant's class 18 goods in this paragraph.¹³

38. That leaves *bags for sports; bags; beach bags; handbags*. *Bags* covers *handbags* and, for the reasons given by the GC, *bags* and *handbags* may be part of a coordinated look along with the choice of women's footwear. The goods will share end users, may share trade channels and be made of the same materials. The goods are similar to a medium degree. I have already mentioned trainers (covered by the wide terms *women's footwear*) in connection with *bags for sports*. Likewise, I find that they are similar to a medium degree. For the same reasons, *beach bags* are similar to a medium degree to sandals, which are covered by the opponent's *women's footwear*.

39. The applicant's class 25 goods for comparison with the opponent's *women's footwear* are:

Clothing; coats; dresses; dressing gowns; headbands [clothing]; headscarves; hoods [clothing]; jackets [clothing]; jumper dresses/ pinafore dresses; knitwear [clothing]; leggings; leg warmers; trousers; petticoats; pyjamas; ready-made clothing; ready-made linings [parts of clothing]; scarves; shirts; short-sleeves shirts; stuff jackets [clothing]; suits; sweaters; jumpers; pullovers; tee-shirts; trousers; pants; waistcoats / vests.

40. *Clothing* covers socks and hosiery for women. These are not footwear but they are items of clothing.¹⁴ The method of use of socks, hosiery and women's footwear is highly similar. Both share a similar purpose, to cover the feet, and they are likely to share trade channels. They are similar to a medium degree.

¹³ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

¹⁴ See *Thom Browne Inc and another v Adidas AG and others* [2024] EWHC 2990 (Ch) at paragraph 551.

41. As for other items of clothing covered by the wide term, and the other specific terms in the applicant's specification, all of which cover goods for women, I note that in *Advance Magazine Publishers Inc v OHIM* the GC said:¹⁵

“33 Lastly, concerning more broadly the similarity of items of hosiery, on the one hand, and items of headgear and footwear as a whole, on the other, it should be noted that, according to settled case-law, the clothing, footwear and headgear in Class 25 have a common purpose because they are manufactured to cover, conceal, protect and adorn the human body (see, to that effect, judgment of 10 September 2008 in Case T-96/06 *Tsakiris-Mallas v OHIM — Late Editions (exé)*, not published in the ECR, paragraph 30, and judgment of 24 March 2010 in Case T-364/08 *2nine v OHIM — Pacific Sunwear of California (nollie)*, not published in the ECR, paragraph 33).”

42. This was cited by the Court of Appeal in *Roger Maier and Another v ASOS*:¹⁶

“74. Mr Wyand has submitted and I did not understand Mr Alexander seriously to dispute that there is a degree of similarity between all items of clothing. In that connection Mr Wyand referred us to the decision of the General Court in Case T-509/12 *Advance Magazine Publishers Inc v OHIM* given on 27 February 2014 in which it was noted (at paragraph [33]) that clothing, footwear and headgear in Class 25 have a common purpose because they are all manufactured to cover, conceal, protect and adorn the human body. For my part I am therefore content to accept that the threshold requirement for a recognisable degree of similarity between all of the goods and services in question is satisfied in this case...”

43. Although the goods are different in nature, they have a similar purpose which is to protect the body, and usually to help the wearer look good. They are all worn on the body, although this degree of similarity is on the low side because the method of

¹⁵ Case T-509/12

¹⁶ [2015] EWCA Civ 220

use will differ according to the type of good (apart from socks and hosiery, for which there is a highly similar method of use to women's footwear). The goods are not in competition but they are complementary to a degree in that women's footwear is frequently displayed in clothing catalogues, on websites or on models so as to complement items of clothing (or vice versa) as part of a complete outfit. The respective goods are likely to be sold through the same trade channels. I find that there is a medium degree of similarity between the parties' goods.

Average consumer and the purchasing process

44. As the caselaw cited above indicates, it is necessary to decide who the average consumer is for the goods at issue and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."¹⁷ 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*. In *Lidl Great Britain Limited & anor v Tesco Stores Limited & anor* [2024] EWCA Civ 262, Lord Justice Arnold explained:

"16. First, the average consumer is both a legal construct and a normative benchmark. They are a legal construct in that consumers who are ill-informed or careless and consumers with specialised knowledge or who are excessively careful are excluded from consideration. They are a normative benchmark in that they provide a standard which enables the courts to strike a balance between the various competing interests involved, including the interests of trade mark owners, their competitors and consumers.

17. Secondly, the average consumer is neither a single hypothetical person nor some form of mathematical average, nor does assessment from the perspective of the average consumer involve a statistical test. They represent

¹⁷ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch).

consumers who have a spectrum of attributes such as age, gender, ethnicity and social group.

18. Thirdly, assessment from the perspective of the average consumer is designed 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.

19. Fourthly, the average consumer's level of attention varies according to the category of goods or services in question.

20. Fifthly, 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.”¹⁸

45. The average consumer of the goods is a member of the general public. The level of attention paid will clearly vary depending on the type and cost of the bags, clothing or women's footwear. However, consumers generally care about their appearance and choose such goods to meet their particular needs, such as protection against rain or cold, and durability. Although the cost of the goods varies greatly, it is not usually an impulse purchase made without paying much attention. In my view, average consumers of the goods pay a 'normal' or medium degree of attention during the selection process. The goods are likely to be selected from shelves and displays in stores, from printed catalogues or from websites. Therefore, the selection process is likely to be primarily visual. However, sales assistance and word of mouth orders/recommendations may also play a part in the selection process, so the way the marks sound must also be considered.

¹⁸ Approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc and anor* [2025] UKSC 25, at paragraph 30.



Comparison of marks

46. *Sabel BV v. Puma AG* 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 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.”

47. 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.

48. The marks to be compared are:

Opponent's marks	Applicant's mark
	

49. The dominant and distinctive component of the earlier marks is CAPRICE, with the butterfly devices playing a lesser role. The stylisation of the words is not negligible, but will not have a significant impact in the overall impression. The applicant's mark

is comprised of the words CAPRICE COLLECTION, above and below a butterfly device, all within a circular border. The eye is somewhat drawn to the butterfly because it is in the centre of the mark, but there is a natural propensity to read the words, when viewing a trade mark. They will be read from top to bottom. COLLECTION, in the context of goods, has less distinctive weight than CAPRICE, which I consider to be co-dominant in the overall impression with the butterfly device.

50. Although both parties' marks contain devices of butterflies, they look different. The parties' marks all contain the word CAPRICE, with the applicant's mark also containing the word COLLECTION. However, bearing my comments above in mind regarding the reduced distinctive weight afforded to COLLECTION, it plays less of a part in the visual impression of the mark. The difference in stylisation of CAPRICE in the parties' marks has a part to play visually, but it is not as visually significant as the presence in all the marks of CAPRICE. The marks are visually similar to a medium degree.

51. Aurally, the marks coincide in the word CAPRICE in each mark, which will be articulated first in the case of the later mark, and differ in respect of COLLECTION. The other aspects of each mark will not be articulated. The marks are aurally similar to a medium to high degree.

52. Both marks contain the concept of a butterfly. CAPRICE is a noun meaning "an unexpected action or decision which has no strong reason or purpose".¹⁹ Both marks contain CAPRICE. In the case of the later mark, CAPRICE could be said to denote the COLLECTION ('The Caprice Collection' of various goods). Given that there is some, but not a great deal of conceptual difference arising from the additional word COLLECTION, I find that the marks are conceptually highly similar.

Distinctiveness of the earlier mark

53. The assessment as to whether there is a likelihood of confusion includes considering whether the distinctive character of the earlier marks has been enhanced

¹⁹ *Collins Online Dictionary*, accessed 9 January 2026.

(i.e. more distinctiveness has been acquired) through the use made of them. If a mark has an inherently high, or an enhanced, level of distinctiveness, the likelihood of confusion is increased.²⁰

54. I will firstly consider the inherent distinctive character of the earlier marks. The dominant element CAPRICE is an ordinary English word. It does not describe or allude to the goods or to their characteristics. Neither do the butterfly devices. The earlier marks have a medium degree of inherent distinctive character.

55. Distinctive character is a measure of how strongly an earlier mark identifies the goods or services for which it is registered, determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identifies the goods or services as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

“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).”

56. Earlier in this decision, I found that the earlier marks had only been used in relation to women’s footwear. Only use in the UK is relevant for the purposes of establishing enhanced distinctive character. For the five years prior to the relevant date, UK turnover was approximately €14.8 million and more than 470,000 of the opponent’s goods were manufactured for sale in the UK. In the context of the UK footwear market,

²⁰ *Sabel BV v Puma AG*, Case C-251/95.

which is huge, €14.8 million does not seem substantial. UK marketing figures for the five years stood at £60,000, which is a relatively small amount.

57. I bear in mind that the opponent has won trade awards for goods in relation to which earlier mark (ii) is used (taking into account the dates of the awards). However, in terms of the end user, the evidence does not show me that the mark is known enough to benefit from an enhanced level of distinctive character. Distinctive character feeds into the assessment as to whether there is a likelihood of confusion and, for women's footwear, it is the perception of the end user which plays the decisive role in that assessment.²¹ All things considered, I decline to find that the distinctiveness of either mark has been enhanced beyond its inherent level of medium. If I am wrong about that, there would only be a modest uplift above medium.

Likelihood of confusion

58. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. In this case, for the goods which I have found to be similar, the degree of similarity is medium.

59. There are two types of confusion, direct and indirect.²² Direct confusion occurs where marks are mistaken for one another, flowing from the principle that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them which has been retained in the mind. The earlier marks are distinctive to a medium level. There will be a medium level of attention paid to the purchase, which is primarily visual. The marks are visually similar to a medium degree, aurally similar to a medium to high degree, and conceptually highly similar. The overall impression is dominated by the same word, CAPRICE, and all the marks contain the concept of a butterfly. I consider that the

²¹ Case BL O/0014/24 Pangaea Laboratories Limited v Pangaia Materials Science Limited, Mr Phillip Johnson, sitting as the Appointed Person, paragraph 10.

²² *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207.

visual differences between the marks, in what is primarily a visual purchase, will be sufficient to avoid direct confusion, but the factors I have outlined will lead, instead to indirect confusion.

60. This type of confusion was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *Back Beat Inc v L.A. Sugar (UK) Limited*, BL O/375/10:

“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).”

61. That the three categories in that case are non-exhaustive was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others*.²³ The goods are similar to a medium degree and I consider it likely that the average consumer will consider the presence of the same dominant element, CAPRICE, which has no meaning for the goods, and the butterfly devices as alternative versions of the parties’ marks, or a branding upgrade. The word COLLECTION does nothing to alter this perception, simply being a word to indicate a collection of goods denoted by the CAPRICE-plus-butterfly mark. For instance, if the average consumer has encountered the opponent’s marks in relation to women’s footwear, they are likely to consider that branching out into clothing and various bags denotes a new venture by the opponent, into a ‘collection’ or range of goods beyond women’s footwear. I find that that there is a likelihood of confusion.

62. I add here that I would reach this conclusion even if the only mark which had survived the proof of use assessment was earlier mark (ii). There is no appreciable difference between the global comparison in relation to earlier mark (ii) compared to earlier mark(i). Both earlier marks lead to the same outcome, which applies whether or not the earlier marks have a modest uplift through their use, in terms of distinctive character.

63. I also do not think it would make a difference if the applicant’s goods in class 25 were limited to men’s clothing. Men’s and women’s clothing are frequently sold via the same trade channels, so whilst the level of similarity between the parties’ goods may be less than medium, this is not strong enough to counteract the other factors which are in the opponent’s favour; in particular, the high degree of conceptual similarity. In any event, the average consumer (men and women buy for each other)

²³ *Ibid.*

will still consider that the parties' marks denote an extension of the goods offered under the marks, whilst retaining the brand message of CAPRICE and a butterfly device.

64. The section 5(2)(b) ground succeeds except in relation to the goods set out in paragraph 37.

Section 5(4)(a)

65. Section 5(4)(a) states:

“(4) 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 of 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,

(aa) [...]

(b) [...]

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.”

66. 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 or date of the priority claimed for that application.”

67. The three elements which the opponent must show are well known. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 (IPEC), Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

68. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217, at 223:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

69. The evidence shows that the opponent, at the relevant date, had goodwill in its business associated with the signs equivalent to earlier marks (i) and (ii) in relation to *women’s footwear*. It also relies upon the sign CAPRICE for this ground. There is use of the word CAPRICE on the UK distributors’ websites. It is also the unchallenged evidence of Mr Burmeister that each of the opponent’s products sold bore one of the earlier marks relied upon under section 5(2)(b) along with the word CAPRICE. He states that the revenue figures include sales for the word-only sign. I note that there is use on the opponent’s website of the word-only sign. The opponent may rely upon all three signs for its section 5(4)(a) ground.

70. However, I do not think that this ground puts the opponent in a better position than its section 5(2)(b) ground. It succeeds in relation to the goods which I have found to be similar. I do not think that the opponent's goodwill in relation to *women's footwear* can stretch to the applicant's goods which I found were dissimilar under section 5(2)(b): the goods are too far apart and the extent of the opponent's goodwill, which resides in a single category of product, is not strong enough to bridge the gap.²⁴ I find that the opponent's section 5(4)(a) ground succeeds only to the same extent as section 5(2)(b). Damage would follow; for example, diversion of sales and damage to reputation if the goods were of inferior quality.

Section 3(6)

71. Section 3(6) of the Act states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

72. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240], as follows:

“(i) [...]

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 (*[Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemaerker (C-320/12) EU:C:2013:435 (“Malaysia Dairy”)]*, para 29; *[Sky plc v SkyKick UK Ltd (C-371/18) EU:C:2020:45 (“Sky CJEU”)]*, para 73).

²⁴ *Harrods Limited v Harrodian School Limited* [1996] RPC 697.

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 (“*Koton*”)], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 (“*Hasbro*”)], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87).”

73. An allegation of bad faith is a serious one which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

74. I have set out at the beginning of this decision the opponent’s table of marks of third parties next to marks owned by the applicant which the opponent claims show a pattern of filing trade mark applications in bad faith. The applicant’s response in its defence and counterstatement is its only engagement with these proceedings. For convenience, I repeat its denial of the ground here:

“25. The applicant denies the application was filed in bad faith. An allegation of bad faith is a serious allegation which must be distinctly proved. The mere fact that a trade mark bears some similarity to another trade mark is not in itself a marker of bad faith.

26. The opponent has not advanced any explanation on why it considers the application to be in bad faith other than pointing to other applications filed by the applicant. Many of the marks listed in on pages 4 and 5 of the Statement of Grounds of Opposition could be construed as parodies. The right to publish parodies is an important aspect of free speech (Human Rights Act s12) and is not sufficient to amount to bad faith. It is not an inherently dishonest business practice to use a sign which brings another trader to the mind of some consumers in an amusing but inoffensive way (Swatch AG v Apple Inc [2021] EWHC 719 (Ch)).

27. In any event there is nothing intrinsically wrong with the applicant filing the current application. The applicant has a bone fide intention to use the mark on the goods in question. The mark in question is equally capable of having a parodic character whilst at the same time functioning as a trade mark. The mark applied for will not divert trade from the Opponent or any other party, nor will it deceive the public.”

75. The opponent’s evidence, from Mr Rowe, consists of a witness statement which simply introduces four exhibits, without explaining their relevance. The opponent’s written submissions in lieu of a hearing give some explanation as to their perceived relevance. In its submissions, the opponent highlights that “despite having been presented with the evidence in the Rowe Statement, the Applicant failed to file any evidence in reply in order to seek to rebut the allegation of bad faith.” This is unsatisfactory: the explanation as to the relevance of the four exhibits should have been in the witness statement so that the applicant could decide whether to file evidence in response. That said, the evidence is all about the applicant, so the applicant cannot be surprised at the content, which is:

- Exhibit HR1 comprises screenshots of three pages from the applicant’s website, obtained on 2 April 2025. The first page shows eight groups of products: groceries, beverages, luggage, confectionery, gourmet products, pastry and bakery, personal care and electronics. The second and third pages give details about the opponent’s business interests, which are listed as real estate, engineering, catering, healthcare, electronics, home appliances, food

products and power tools. The opponent's written submissions explain that there is no mention of clothing or headgear.

- Exhibit HR2 comprises a copy of search results obtained from a search on 2 April 2025 for “abdulwahed bin shabib distribution “caprice””. This shows that the applicant filed the opposed application in the UK. The opponent's written submissions say that the search does not provide any results which point to use of the contested mark.
- Exhibit HR3 comprises a copy of search results obtained on 2 April 2025 on the search platform Darts-IP for cases in which the applicant is listed as a party to opposition proceedings in various jurisdictions (mostly in Europe). The list includes the marks shown in the table provided by the opponent in its statement of grounds. The opponent submits that the typeface of Clark & Mark is the exact same typeface of *Clarks*, owned by a third party.
- Exhibit HR4 comprises extracts from the UK trade mark register obtained on 1 April 2025. These consist of the case details for various applications made by the applicant which include the marks shown in the table provided by the opponent in its statement of grounds. CALVIN BAGS (class 18) was opposed and then withdrawn. Clark & Mark (class 18) was opposed and withdrawn. Upper Armour (classes 18 and 25) was opposed and withdrawn. TOMMY (classes 3, 18 and 25) was opposed and withdrawn. Armani Brothers (classes 3, 18 and 25) is opposed. The South Face (classes 3, 18 and 25) is opposed. There are other cases not included in the opponent's table.

76. The applicant is correct in submitting that the fact that a trade mark bears some similarity to another trade mark is not, per se, a marker of bad faith. However, the opponent's statement of grounds and evidence about the applicant's other applications shows that the contested mark is not the first or only of the applicant's marks to bear more than a passing resemblance to third parties' trade marks. It is a notorious fact that at least some of the marks highlighted by the opponent have a reputation in the UK, such as Armani, The North Face and Under Armour (for clothing). Such evidence can show a pattern of behaviour which may lead to a conclusion that a mark has been applied for in bad faith.

77. Similar fact evidence was considered in *Trump International Ltd v DTTM Operations LLC* [2019] EWHC 769 (Ch). The controlling mind behind the applicant in that case was shown to have a history of applying for trade marks without any intention to use them, including famous third-party marks, and of being involved in numerous trade mark proceedings in the UK and elsewhere. The application for the trade mark TRUMP TV was found to have been made in bad faith. Carr J said:

“In relation to allegations of copyright infringement, it is necessary to decide, as a matter of fact, whether copying has occurred. As with claims of bad faith, direct evidence of copying is rarely available. In this context, it is well established that similar fact evidence may be admissible.” The case law is considered in *Copinger and Skone James on Copyright*, Vol 1, 17th Edition at [21-393]:²⁵

“...where the issue in a copyright case is whether the similarity between the claimant's work and the defendant's work is due to copying or is a coincidence, it is relevant to know that the defendant has produced works which bear a close resemblance to works other than the work in question which are the subject of copyright. Whereas similarity between two works might be mere coincidence in one case, it is unlikely that there could be coincidental similarity in, say, four cases. The probative force of several resemblances together is much better than one alone

This reasoning may well apply, depending on the facts, to an allegation that a third-party trade mark has been applied for in bad faith. The probative force of several instances of such applications, by the same or a connected party who has applied to register a third-party trade mark, is obvious. Such instances, if based on solid grounds, are likely to require evidence from the applicant to refute the inference of bad faith that may otherwise be drawn from them.”

78. The applicant states in its defence that many of the marks listed in the opponent's table “could be construed as parodies” and that the contested application is equally capable of having a parodic character whilst at the same time functioning as a trade

²⁵ At [42].

mark. It relies upon *Swatch AG v Apple Inc* [2021] EWHC 719 (Ch) for its proposition that it is not bad faith to apply for parodies as trade marks. In that case, Apple had objected to Swatch's application for ONE MORE THING, which was a phrase associated with Apple's CEOs when making announcements at industry events, to the point that compilations of ONE MORE THING moments had been made by Apple 'fans' on YouTube. Parody was one of the legs to Apple's bad faith ground. The present case can be distinguished from the *Swatch AG v Apple Inc* case. Two of the considerations of Mr Iain Purvis QC, sitting as a Deputy judge of the High Court, were that there was "no evidence that Swatch had made a practice of parodic advertising in the past, against any party, let alone Apple" and that it was "not clear how the suggested parodic use of the mark would be effective when, on the Hearing Officer's findings, it was only associated with Apple by only a small number of people."²⁶ In the present case, there is a pattern of previous filings of marks which are similar to those of third parties, and those third-party marks have a reputation amongst the general public in the UK.

79. The applicant characterises parodical marks as signs which bring another trader to the mind of some consumers in an amusing and inoffensive way, which is taken from *Swatch AG v Apple Inc*:

"52. 'Poking fun' and 'parody' cover a multitude of possibilities from gentle and affectionate teasing to full-frontal attacks. I do not consider that it is an inherently dishonest business practice to use a sign which brings another trader to the mind of some consumers in an amusing but inoffensive way. Such an activity would not necessarily undermine the interests of the third party in any material way. The point at which parodic or humorous activity of that kind would transgress the boundaries of honest business practices must depend on the nature of the humour, the intensity of its use and its consequent impact on the business interests of the recipient.

[...]

²⁶ Paragraph 44, points (iii) and (iv).

54. (i) [...]

(ii) He [the Hearing Officer] then makes the point that using a mark as part of a parody of another trader is difficult to reconcile with the use of the marks in accordance with their essential function, of indicating the commercial source of the goods. But, again, this must depend on the actual use in question. Using a phrase in a humorous parodic skit may well not be trade mark use. However, I do not see why a mark may not have parodic character whilst at the same time being perfectly capable of functioning as a trade mark. For example DUNK DIFFERENT could be a perfectly good trade mark for biscuits, whilst no doubt conjuring up for some people a wry or even amusing allusion to Apple's famous slogan."

80. The applicant's reliance on parody, which the applicant itself says is use of a sign in an amusing and inoffensive way, is flawed. Where is the joke or gentle teasing in relation to the opponent's earlier marks and signs? The applicant has taken the same word, CAPRICE, and used a butterfly device. There is nothing amusing about this combination. The applicant says that the contested mark is equally capable of having a parodic character whilst at the same time functioning as a trade mark, but this presupposes that there is something humorous about the contested mark, as in Mr Purvis' DUNKING DIFFERENT example. As an isolated instance, there may be no bad faith. However, there is a pattern of behaviour, as in the TRUMP TV case, and I consider that the wording of the counterstatement implicitly acknowledges that there has been a pattern of behaviour of applying for marks similar to those of third parties:

"Many of the marks listed in on pages 4 and 5 of the Statement of Grounds of Opposition could be construed as parodies."

81. That is to say, if they were not similar to the marks of third parties, the applicant's other applications could not be parodies. There must be similarities for the parody to work. So, this must be an acceptance by the applicant that it has made several applications for marks which are similar to those of third parties (whether or not they actually are parodies).

82. *Alexander* was a case involving the same controlling mind as in the Trump TV case. Mr Geoffrey Hobbs QC, sitting as the Appointed Person, upheld the Hearing Officer's finding of bad faith.²⁷ At paragraph 35 of his decision (quoted at paragraph 25 of Mr Hobbs' decision), the Hearing Officer said:

“Taken together with the opponent's evidence that (1) none of the marks applied for in the UK (or US) appear to have been used, (2) the absence of any apparent commercial logic for the filing pattern of the applicant and/or Mr Gleissner's other companies, and (3) the evidence that companies controlled by Mr Gleissner have been found to have abused legal systems, I find that opponent has also made out a prima facie case that, at the time of filing the application, the applicant had no intention of using the mark in accordance with its essential function. That is to say using the mark to distinguish the goods/services of the applicant from those of other traders.”

83. In the present case, the applicant has implicitly admitted that it has applied for several trade marks which are similar to those of third parties for the reasons I have given at paragraph 80. It has given no indication that any of them have been used and indeed the opponent's evidence shows that several of them were withdrawn after opposition in the UK, and that there are ongoing opposition proceedings in other jurisdictions. It is the nature of those applications which is key: they mimic the marks of third parties. The applicant's defence of parody also falls down because there is nothing funny or mickey-taking about the contested application. It cannot be a coincidence that the mark consists of the same word CAPRICE and the device of a butterfly, when neither element is descriptive of any of the parties' goods; and even less of a coincidence when viewed alongside its other applications which all ape the trade marks of third parties. In the *Alexander* case, Mr Hobbs said this:

“7. CKL's [the applicant's] case as presented in these submissions was that the evidence tendered by the opponent established no basis sufficient in point of fact or in point of law to justify rejection of the contested application for

²⁷ Case BL O/036/18.

registration on the ground of bad faith. Having chosen to file no evidence directed to the specifics of the facts and matters relied on by the opponent, CKL was, in essence, asking the Registrar to say that it had no case to answer.”

84. The applicant in the present case has chosen the same course of action. In *Accessible Labs Ltd v Rui Qu (Shanghai) Enterprise Management Consulting Company Limited*, Mr Daniel Alexander KC, sitting as the Appointed Person, said:²⁸

“43. Third, *SkyKick* notes that the application of the law presents evidential difficulties. It is rare that an opponent to a trade mark application mark will have direct evidence that the applicant intended to do so for reasons which do not accord with the proper objects of securing trade mark registration. Lord Kitchin said in *SkyKick* at [154]:

“It may be very difficult for a claimant seeking a declaration of invalidity of a registered trade mark to prove the subjective intention or motive of the applicant in filing the application to register that mark in respect of particular goods and services. Accordingly, from the earliest consideration of this issue by the CJEU, it has been recognised that this subjective aspect of the objection will generally have to be established by reference to what have been described as relevant, consistent and objective criteria.”

85. In *Skykick*, the Supreme Court stated at paragraph 240 that:

“(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).”

²⁸ Case BL O/0534/25.

86. I consider that there is a prima facie case to answer, particularly given the applicant's own raising of its own pattern of trade mark filings being potentially parodical, without explaining how the contested mark could be said to be a parody. The opponent has pointed out the applicant's pattern of filing marks which ape those of third parties and, in the light of that pattern, the non-coincidental inclusion of the word CAPRICE and the device of a butterfly. This combination of factors is sufficient to raise a prima facie case. In *Maya Appliances Pvt. Ltd v Prapaharan Sivaratnam*, Mr Iain Purvis KC, sitting as the Appointed Person, said:²⁹

"27. It is obviously wrong to expect a party to Cancellation proceedings to be able to give direct evidence of the motivation of someone who has adopted their mark. All they can reasonably be expected to do in the vast majority of cases is to make inferences from the objective facts and invite the other party to respond to this. If they establish a prima facie case consistent with bad faith, then in the absence of a response from the other party the Cancellation should succeed.

87. In the present case, the opponent has done all that it was able to do, in the circumstances of the case. As the opponent has met the burden of raising a prima facie case, it has rebutted the presumption of good faith. It is incumbent on the applicant to explain and provide a plausible explanation for the contested application. It has made no attempt to do so in evidence. In *Accessible Labs Ltd*, Mr Alexander said:

"45. ... as Lord Kitchin said in *SkyKick* at [235] and [252]:

"235. I recognise that an inference that an application to register a trade mark was made in bad faith may be displaced by an explanation of an appropriate commercial rationale for making it. In my opinion, however, a failure to provide any satisfactory explanation may reinforce the inference and provide further support for a finding of bad faith.

...

²⁹ Case BL O/0052/25: the decision concerned cancellation proceedings, but the law is no different in relation to an opposition under section 3(6).

252. I recognise that such an applicant, when given an appropriate opportunity, may provide a reasonable explanation and justification for its actions and in that way answer and dispel any inference that it made the application in bad faith. If, however, it fails to do so, it is in my view open to the tribunal to find that the application was indeed made in bad faith in respect of those goods and services.”

46. *SkyKick* therefore reinforced the importance of a satisfactory explanation for making a UK trade mark application in circumstances where an inference that the mark was applied for in bad faith appeared justified, prima facie. Key questions are therefore (a) whether an explanation was provided at all and (b) whether the hearing officer had sufficient basis to find that the explanation provided was unconvincing with respect to motivation in applying for the mark and in particular intention to use it in the UK, taking the evidential picture as a whole.

47. As to that, the case law from the Court of Appeal prior to *SkyKick* suggests that where, in principle, evidence from those with knowledge of intention is available, it is reasonable to expect it to be adduced to rebut a prima facie case of bad faith. That proposition is supported by *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where Arnold LJ said at [180] of one of the grounds of appeal (namely that it was not realistic for the judge to expect that either witness testimony or documentary evidence would be available to explain Lidl's intentions) that despite the passage of time, the applicants for registration were best placed to explain their intentions. The court expected a proper explanation.

48. In the light of these authorities, where there is evidence from which it is proper to infer that an application for registration has been made in bad faith (on the basis that it was not applied for to protect one or more of the legitimate functions of a trade mark) an applicant can reasonably be expected to provide a sufficiently coherent explanation for the application specifically in the UK including as to its scope. An applicant may be able to justify the application (including its scope) on the basis of credible evidence as to its purposes in making it, for example by reference to the width of the underlying business, actual or reasonably contemplated, which the trade mark is intended to protect.

If no adequate or sufficiently credible explanation is provided or one which justifies the UK application, there may be a proper basis for a finding of bad faith in whole or in part.”

88. The objective, relevant and consistent indicia point towards a conclusion that the application was made in bad faith, and the applicant has not rebutted that conclusion. There is no evidence from the applicant as to how it arrived at a mark which includes the word CAPRICE and a device of a butterfly, no evidence of its commercial plans for the mark, and no evidence as to why it considers the contested mark to be parodical as well as indicating trade origin, which it stated in its counterstatement. In paragraph 240 of its *Skykick* judgment, the Supreme Court said:

“(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).”

89. The applicant has failed to rebut the prima facie case. The application constitutes an intention to take advantage of the trade mark registration system. The application was filed with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties (the opponent). This behaviour is an abuse of the trade mark system. It is contrary to the objective of a trade mark registration, as set out in *Skykick* at paragraph 240 (iv):

“... the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin ...”.

90. As I have decided that the contested mark is not a parody, I do not need to consider the applicant's references to freedom of speech. The section 3(6) ground succeeds in full.

Overall outcome

91. The opposition succeeds. The application is refused.

Costs

92. The opponent has been successful and is entitled to an award of costs, based on the scale published in Tribunal Practice Notice 1/2023. I award costs in favour of the opponent as follows:

Fee for Form TM7	£200
Preparing the notice of opposition and considering the counterstatement	£400
Preparing evidence	£1000
Written submissions in lieu of a hearing	£450
Total	£2050

93. I order Abdulwahed Bin Shabib Distribution to pay to Caprice Schuhproduktion GmbH & Co. KG the sum of £2050. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 28th day of January 2026

**Judi Pike
For the Registrar**