

O/0088/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 3936413
IN THE NAME OF DELUX BATHROOMS AND TILING SOLUTIONS LIMITED
FOR THE TRADE MARK**

GRANLUSSO

IN CLASSES 11, 20 AND 35

AND

**THE OPPOSITION THERETO UNDER NUMBER 447399
BY LUSSO UK HOLDINGS LIMITED**

Background and pleadings

1. Delux Bathrooms and Tiling Solutions Limited (“the applicant”) filed an application for the trade mark GRANLUSSO (number 3936413) on 21 July 2023 (“the relevant date”) for goods and services in classes 11, 20 and 35.

2. Lusso UK Holdings Limited (“the opponent”) opposes the application under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following four earlier trade mark registrations for its section 5(2)(b) and 5(3) grounds:¹

(i) 3349396

LUSSO

Filing date: 30 October 2018; registration date: 1 March 2019

Relying on all goods in classes 11 and 20.

(ii) 3665268 (series of two marks)



LUSSO LUXURY LIVING

Filing date: 6 July 2021; registration date: 7 January 2022

Relying on the second mark in the series only; relying on all goods in classes 11 and 20 for section 5(2)(b) and all goods and services in classes 3, 6, 9, 11, 16, 19, 20, 21, 24 and 42 under section 5(3).

¹ The full list of goods and services for the earlier marks is set out in the annex to this decision.

(iii) 3605344

LUSSO PIETRA

Filing date: 5 March 2021; registration date: 16 July 2021

Relying on all goods and services in classes 11 and 20 for section 5(2)(b) and all goods in classes 11, 19 and 20 for section 5(3).

(iv) 3605340

LUSSO DECO

Filing date: 5 March 2021; registration date: 16 July 2021

Relying on all goods in classes 11 and 20.

3. Under section 5(2)(b) of the Act, the opponent claims that the parties' goods and services are identical or highly similar and that the marks are highly similar, leading to a likelihood of confusion. It claims a family of LUSSO marks with enhanced distinctiveness and an increased risk of a likelihood of confusion by virtue thereof.

4. Under section 5(3) of the Act, the opponent claims a reputation in its marks for the goods relied upon, such that the relevant public will believe that the parties' goods and services are used by the same undertaking or an economically connected undertaking. It claims that there will also be unfair advantage because the contested mark will ride on the coat-tails of the opponent's reputation; in particular, unfairly benefitting from the opponent's marketing and advertising efforts. If the applicant's goods and services do not meet the same standard as the opponent's goods and services, this could cause damage to the reputation of the opponent's marks. The third type of damage claimed is that the use of the applicant's mark would damage the distinctive character of the opponent's marks because the relevant public would mistakenly consider that there is a connection with the opponent, leading to a loss of sale due to diversion of custom.

5. Under section 5(4)(a) of the Act, the opponent claims that it has used the sign LUSSO throughout the UK since 2014 in relation to *bathroom installations, bathroom furniture, bathroom fittings and accessories; furniture; retail services in relation to furniture, bathroom installations, bathroom furniture, bathroom fittings and*

accessories. It claims goodwill in the business distinguished by LUSSO and the opponent claims that use of the application is contrary to the law of passing off because its use would cause misrepresentation and damage to the opponent's goodwill.

6. The applicant filed a defence and counterstatement, denying the grounds of opposition. It denies that the opponent's marks form a family of marks and it puts the opponent to proof of the same and of reputation and goodwill. The applicant states:

"It is admitted that the Applicant's Mark is similar to the Opponent's Earlier Marks due to the commonality of the word element LUSSO, but there are other elements present in the various Marks that are not *de minimis* that serve to differentiate those various Marks."

7. The applicant claims that it has used GRANLUSSO since August 2019 in relation to the goods and services of the application. It claims that there has been honest concurrent use such that no likelihood of confusion exists, nor unfair advantage or material harm to the earlier marks. The applicant states that the detriment to repute claim is unsupported.

8. The opponent is represented by Appleyard Lees IP LLP and the applicant by McIldowies Solicitors. Only the opponent filed evidence. Neither party requested to be heard and only the opponent filed written submissions in lieu of attending a hearing. I make this decision after careful consideration of all the papers on file, referring to them as necessary.

Section 5(2)(b) of the Act

9. 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.”

10. 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.”²

11. 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.³

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

² This section also applies to the grounds raised under sections 5(3) and 5(4)(a) of the Act.

³ 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.

(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 and services

12. 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.”

13. 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.

14. 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:⁴

“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

⁴ Case T-325/06.

customers may think that the responsibility for those goods lies with the same undertaking...”.⁵

15. 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.”

16. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J (as he then was) held:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

17. In my assessment of the section 5(2)(b) ground, I will concentrate upon earlier marks (i) and (ii) as they are the closest to the applicant's mark and earlier marks (iii) and (iv) are no wider in their specification coverage (for the goods relied upon under

⁵ 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.

this ground). I will come back to earlier marks (iii) and (iv) if necessary. The goods and services for comparison are:

Earlier marks (i) and (ii)	Applicant's mark
<p>Earlier mark (i): Class 11: <i>Apparatus for sanitary purposes; Basin taps; Basins being part of water supply installations; Bath fittings; Bath installations; Bath panels; Bath plumbing fixtures; Bath spouts; Bath taps; Bathroom basins [parts of sanitary installations]; Bathroom installations; Bathroom installations for sanitary purposes; Bathroom installations for water supply purposes; Bathroom sinks; Bathroom wash basins; Baths; Bathtubs; Controlled mixers being parts of shower installations; Fitted liners for shower trays; Fittings (Bath -); Fittings for basins; Fittings for sanitary purposes; Heated towel rails; Installations for sanitary purposes; Mixing taps [faucets]; Sanitary apparatus and installations; Sanitary installations; Shower apparatus; Shower attachments; Shower bath fittings; Shower bath installations; Shower fittings; Shower head sprayers; Shower heads; Sink units; Sinks; Tap water faucets.</i></p>	<p>Class 11: <i>Toilet potties; Bathtub enclosures; Bathroom installations; Bathroom sinks; Bathroom wash basins; Light fixtures; Shower bath installations; Shower bath fittings; Shower cubicles; Shower installations.</i></p> <p>Class 20: <i>Bathroom mirrors; Bathroom furniture; Bathroom vanities; Bathroom cupboards; Bathroom cabinets.</i></p> <p>Class 35: <i>Retail services in relation to Bath installations; Wholesale services in relation to Bath installations; Retail services in relation to Bath fittings; Wholesale services in relation to Bath fittings; Wholesale services in relation to Bath cubicles; Retail services in relation to Bath cubicles; Retail services in relation to Bath screens; Wholesale services in relation to Bath screens; Retail services in relation to Bath taps; Wholesale services in relation to Bath taps; Retail services in relation to Bath tubs; Wholesale services in relation to Bath tubs; Retail services</i></p>

Class 20: Bathroom cabinets; Bathroom cupboards; Bathroom fittings in the nature of furniture; Bathroom furniture; Bathroom mirrors; Bathroom stools; Bathroom vanities; Bathroom vanities [furniture]; Bathroom vanity units incorporating basins; Mirrors enhanced by electric lights; Vanity units [furniture]; Vanity units incorporating basins; Washstands [furniture].

Earlier mark (ii): Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating purposes; sinks, sinks incorporating drainers, basins; taps; apparatus for sanitary purposes; apparatus for the supply of water for sanitary purposes; basin taps; basins being part of water supply installations; bath fittings; bath installations; bath panels; bath plumbing fixtures; bath spouts; bath taps; bathroom basins [parts of sanitary installations]; bathroom installations; bathroom installations for sanitary purposes; bathroom installations for water supply purposes; bathroom sinks; bathroom wash basins; baths; bathtubs; controlled mixers being parts of shower installations; fitted liners for

in relation to Bathroom installations; Wholesale services in relation to Bathroom installations; Retail services in relation to Bathroom installations for water supply purposes; Retail services in relation to Bathroom installations for sanitary purposes; Wholesale services in relation to Bathroom installations for water supply purposes; Wholesale services in relation to Bathroom installations for sanitary purposes; Retail services in relation to Bathroom sinks; Wholesale services in relation to Bathroom sinks; Retail services in relation to Bathtub enclosures; Wholesale services in relation to Bathtub enclosures; Retail services in relation to Bidets; Wholesale services in relation to Bidets; Retail services in relation to Electric shower apparatus; Retail services in relation to Electric showers; Wholesale services in relation to Electric shower apparatus; Wholesale services in relation to Electric showers; Retail services in relation to Fittings for basins; Wholesale services in relation to Fittings for basins; Retail services in relation to Fittings for sanitary purposes; Wholesale services in relation to Fittings for sanitary

shower trays; fittings (bath -); fittings for basins; fittings for sanitary purposes; heated towel rails; installations for sanitary purposes; mixing taps [faucets]; sanitary apparatus and installations; sanitary installations; sanitary ware; sanitary ware made of porcelain; sanitary ware made of stoneware; shower apparatus; shower attachments; shower bath fittings; shower bath installations; shower fittings; shower head sprayers; shower heads; sink units; sinks; tap water faucets; toilet bowls; toilet bowls and seats sold as a unit; toilet lids; toilet seat lids; toilet seats; toilets; toilets [water-closets]; toilets incorporating cisterns; lighting and lighting fixtures; parts and fittings for all the aforesaid goods; plumbing fixtures; shower room installations and fixtures; ventilation installations; stone baths; stone basins; parts and fittings for all the aforesaid goods.

Class 20: Furniture; furniture for house, office and garden; Non-metallic hardware, namely door, gate and window fittings not of metal; furniture fittings not of metal; hardware namely bolts, screws, nuts, dowels, furniture casters, door fasteners, door fittings, handles, knobs,

purposes; Retail services in relation to Fittings for the draining of water; Wholesale services in relation to Fittings for the draining of water.

locks, curtain hooks, curtain rails, curtain tie backs, curtain rings, curtain rods, not of metal; fitted kitchen furniture and fitted bedroom furniture and kits of parts for assembly into kitchens and bedrooms and their constituent parts being items of furniture; fitted bathroom furniture and shower room furniture and kits of parts for assembly into bathrooms and shower rooms and their constituent parts being items of furniture; articles of furniture including cupboards, cabinets, tables, chairs, sofas, stools, storage chests, display units, drawers, chests of drawers, drawer units, beds, wardrobes, bedside tables, shelving, shelves, shelf units, spacing units and spacers, mirrors, picture frames, dressing tables, benches, racks, sink units; basin units; worktops and table tops; countertops; upstands; furniture panels; furniture doors; bathroom cabinets; bathroom cupboards; bathroom fittings in the nature of furniture; bathroom furniture; bathroom mirrors; bathroom stools; bathroom vanities; bathroom vanities [furniture]; bathroom vanity units incorporating basins; mirrors enhanced by electric lights; vanity units [furniture]; vanity units

<p><i>incorporating basins; bathroom furniture with marble basins; washstands [furniture]; door handles; handles for furniture; blinds; cushions; statues, figurines and works of art and ornaments and decorations, made of materials such as wood, wax, plaster or plastic, included in the class; kitchen worktops; parts, fittings, fixtures and fittings for all the aforesaid goods.</i></p>	
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18. The law requires that goods and services be considered identical where one party's description of its goods and services encompasses the specific goods and services covered by the other party's description (and vice versa): *Gérard Meric v OHIM*.⁶ The opponent's class 20 goods in the specifications of both of the earlier marks are identical to all of the class 20 goods in the application because the terms are self-evidently the same, or practically so.

19. The applicant's *bathtub enclosures; bathroom installations* are identical to bath installations in both earlier marks. The applicant's *bathroom sinks; bathroom wash basins; shower bath installations; shower bath fittings* are identical to bathroom sinks; bathroom wash basins; shower bath installations and shower bath fittings in both earlier marks. The applicant's *shower cubicles; shower installations* are identical on the *Merice* principle to *bathroom installations* and *shower bath installations* in both earlier marks. It is not entirely clear to me what the applicant's *toilet potties* are. According to the classification search tool on the Intellectual Property Office's website, "toilet potties" are proper to class 21, not to class 11. Toilet seats for children and toilet bowls for children are, however, proper to class 11. Since the applicant has applied for the goods in class 11, its term may be said to cover toilets or toilet seats

⁶ Case T-33/05, GC

for children (i.e. seats which fit onto toilets for small children and toddlers to use).⁷ Such goods are covered by the opponent's sanitary apparatus and installations in both of its earlier marks, and by toilets, toilet bowls and/or toilet seats in earlier mark (ii).

20. In class 11, that leaves the applicant's *light fixtures*. These are not covered by the class 11 specification in earlier mark (i). I note that the class 20 specification of earlier mark (i) covers 'mirrors enhanced by electric lights.' Such goods are not lights *per se*, but may be bought as part of fitting out a bathroom to create an overall lighting look. In addition, buying a shower installation is likely to entail also buying lighting for the shower, and some lights include extractor fans to remove steam. Such goods are likely to be bought in the same outlets as showers and mirrors enhanced by electric lights. There is a low degree of similarity between the applicant's *light fixtures* and the opponent's bathroom installations and mirrors enhanced by electric lights in earlier mark (i). Earlier mark (ii) covers 'lighting fixtures' in the class 11 specification. These are identical goods to the applicant's *light fixtures*.

21. The applicant's class 35 services can be taken together because they are all concerned with retail and wholesale of goods which are installed in bathrooms. The opponent's class 11 goods are identical to the subject goods of the applicant's retail and wholesale services. The goods are indispensable to the retail and wholesale services relating to them. In addition to the complementary relationship between the goods and the retailing and wholesaling thereof, there is an overlap in the trade channels through which the goods and services reach the average consumer.⁸ They are similar to a medium degree.

Average consumer and the purchasing process

22. As the caselaw cited above indicates, it is necessary to decide who the average consumer is for the goods and services at issue and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."⁹

⁷ *Pathway IP Sarl v Easygroup Ltd* [2018] EWHC 3608 (Ch)

⁸ See *Oakley, Inc v OHIM*, Case T-116/06, GC

⁹ *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).

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 consumers who have a spectrum of attributes such as age, gender, ethnicity and social group. For this reason the European case law frequently refers to "the relevant public" and "average consumers" rather than, or interchangeably with, "the average consumer": see, for example, *Case C-252/07 Intel Corporation Inc v CPM United Kingdom Ltd* [2008] ECR I-8823 at [34]. It follows that assessment from the perspective of the average consumer does not involve the imposition of a single meaning rule akin to that applied in defamation law (but not malicious falsehood). Thus, when considering the issue of likelihood of confusion, a conclusion of infringement is not precluded by a finding that many consumers of whom the average consumer is representative would not be confused. To the contrary, if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, then a finding of infringement may properly be made.

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."¹⁰

23. The parties' goods and services will be purchased by the general public, and the applicant's wholesaling services by plumbers and bathroom designers. The opponent submits that the goods have a medium purchase value, that there is a high number of products to choose from and that the level of attention will be relatively low. I do not agree. The selection of the goods and services is likely to entail at least a medium level of attention because they are not everyday purchases, will entail some degree of financial outlay, may involve aesthetic considerations and are intended to have a degree of longevity. The purchasing process will be primarily visual, but with an aural aspect where over-the-counter purchases are made and advice is sought.

Distinctiveness of the earlier marks

24. The assessment as to whether there is a likelihood of confusion includes considering whether the distinctive character of the earlier marks has been enhanced (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.¹¹

25. The dominant element of earlier marks (i) and (ii) is LUSSO because, in the case of earlier mark (ii), LUXURY LIVING has no or very weak distinctive character. The

¹⁰ Approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc and anor* [2025] UKSC 25, at paragraph 30.

¹¹ *Sabel BV v Puma AG*, Case C-251/95

opponent submits that LUSSO is Italian for luxury (although provides no dictionary definitions). The opponent submits that, to the average UK consumer, LUSSO has little direct meaning “but will be perceived as a nice looking and sounding Italian word with allusions of luxury.” I am not sure why LUSSO would be approximated to ‘luxury’ if the UK average consumer does not know its meaning in Italian; it shares little in common with ‘luxury’ and so is unlikely to be evocative. I consider that LUSSO, which is the only coinciding element with the applicant’s mark, will be seen as an invented word. It does not describe or allude to the goods or to their characteristics. The earlier marks have a high degree of inherent distinctive character.

26. 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).”

27. The opponent has filed evidence from Wayne Spriggs, who is its Director and CEO.¹² Mr Spriggs explains that the opponent, which was incorporated in 2019, has a subsidiary, Lusso Stone Ltd, which has used the earlier mark (i) since at least 2015. The subsidiary assigned earlier mark (i) to the opponent in 2021 and the subsidiary

¹² Witness statement and exhibits dated 19 September 2024.

has continued to use earlier mark (i) ever since, with the opponent's consent. LUSSO products are sold throughout the UK via the opponent's website and its showroom.

28. Exhibit WS5 comprises financial account extracts. The subsidiary's financial report for 2020 says that the majority of the company's sales are made within the UK. Turnover in 2021 was £23,981,464 and in 2022 was £32,377,384. Mr Spriggs states that in the financial year of 2022 to 2023, the opponent's turnover for products sold under the LUSSO mark in the UK was £37,786,631. For the partial year of 1 January 2023 to 20 July 2023, the turnover figure is £20,808,528 (although I note that this period must overlap with the financial year of 2022 to 2023). Mr Spriggs states that Mintel's 2023 UK Bathroom and Bathroom Accessories Market report estimated that the market was worth £1.7 billion. He states that the turnover achieved by the opponent in 2023 (the applicant's mark was filed on 21 July 2023) under the mark LUSSO equates to a 2% market share and that this is a significant amount because the market is populated by a large number of smaller undertakings.

29. A selection of sales invoices are provided in Exhibit WS8 spanning England, Scotland and Northern Ireland. The invoices date from 2019 to 2023. Mr Spriggs states "In many cases the LUSSO branded products are sold with an additional range name which appears on invoices but the products are sold as LUSSO products and supplied in LUSSO branded packaging." The invoices show the sale of waste covers (basin or bath fittings), baths, shower screens, showers, taps, basins, shower trays, toilet handles, toilet seats, toilet cisterns (all class 11), shower shelving units, storage boxes, vanity units, splashbacks, mirrors, cabinets and toilet cabinets (all class 20). Exhibit WS6 comprises screenshots from the opponent's website, lussostone.com, taken from the Wayback Machine, the internet archive, from 23 September 2017 to the relevant date. Earlier mark (i) features at the top, with tabs across the top (variously) as follows: baths, basins, counter tops, vanity units, toilets, taps, showers, hardware, radiators, accessories, collections and bathroom suites. The baths and basins are said to be "luxury hand-finished." The screenshots say that the opponent supplied a Lusso bath to Claridge's hotel and that a bespoke service is available (from 24 September 2020). Examples of product packaging in Exhibit WD7 are shown below:



30. Exhibit WS7 also shows earlier mark (i) on goods, such as:



31. Exhibit WS1 contains a post from the opponent's LUSSO blog, showing earlier mark (i), from 16 December 2019. The post states that The Sunday Times featured the opponent as one of the UK's top 30 fastest growing companies. Mr Spriggs states that the opponent has won several prestigious awards in relation to the LUSSO mark, including:

- The Sunday Times Virgin Atlantic Fast Track 100 (ranked 18th in 2018, 27th in 2019 and 56th in 2020);
- The Sunday Times World first SME Export Track League (ranked 6th in 2019);
- North East Fastest Growing Medium Sized Business – Ward Hadaway (2021);
- The Sunday Times Profit Track 100 League (ranked 23rd in 2021);
- Small Business Entrepreneur of the Year – Great British Entrepreneur Awards (2021);
- FEBE Growth 100 (ranked 66th in 2022);
- Alantra Digital Fast 50 (ranked 8th in 2022);
- Scale Up Business of the Year – British Business Excellence Awards (shortlisted in 2022);
- Leading Artisan Bathroom Manufacturer – LUXlife Magazine (2022);
- Best Bathroom Collection – Living Etc Style Awards (2023);

- Design Product of the Year - Archiproducts Design Awards (2023).

32. Exhibit WS3 comprises copies of articles which feature the LUSSO mark, as follows:

- Luxury London Living in March 2023, showing a bath priced at £2,377, which was described as a design leap and a statement piece to shake up bathroom design:



- Ideal Home in April 2023, with a readership per issue of 84,518. The article refers to a Lusso vanity unit in a luxury bathroom;
- Dezeen in March 2023;
- Home & Gardens in December 2022, with a readership per issue of 56,602;
- These Three Rooms in March 2023, which refers to the opponent as a luxury bathroom brand. The article is about marble in bathrooms and shows a marble LUSSO bath:



- The Northern Echo in November 2018, with a readership per issue of 7,971, refers to the opponent as a luxury bathroom retailer and also refers to it selling its goods to Claridge's hotel;

- Living Etc in February 2022, with a readership per issue of 72,711, refers to the opponent's "Pietra collection".

33. The opponent spent £3.1 million in 2022 and £1.7 million to 20 July 2023 on advertising, spending on digital agency services, Google, Facebook, Bing and Instagram. A selection of invoices showing the opponent's marketing spend is provided in Exhibit WS4 from December 2020 to March 2023.

34. Although the turnover figures are not broken down by class or goods-type, since the invoices particularise goods in classes 11 and 20 and the majority of the other evidence focusses on such goods, I infer that the majority of the turnover figures relate to goods in classes 11 and 20. Earlier mark (i) is evidenced in the invoices rather than the other three earlier marks. The evidence as a whole shows that the opponent is entitled to claim an enhanced level of distinctive character (which is already inherently high) for earlier mark (i). The goods relied upon for earlier mark (ii) are more extensive and the evidence does not show use in relation to all of them; for example, apparatus for cooking and refrigerating. The evidence is also very thin on examples of earlier mark (ii): only the packaging example for an unidentified (and undated) item shows earlier mark (ii), and it shows the stylised version of the series mark which is not relied upon. The class 11 specification includes lighting and I note that the financial report for the year ended 31 December 2023 refers to the opponent's lamp collection being awarded Design Product of the Year at the 2023 Archiproducts Design Awards in Milan. However, in an (undated) Facebook post by the opponent about the award, it is earlier mark (i) which is featured (which does not cover lighting). Given my findings about the turnover figures, corroborated by the itemised invoices, I am not prepared to find that there has been sufficient exposure on the market at a date sufficiently antecedent to the relevant date such that there is an enhanced level of distinctive character in relation to earlier mark (ii). There is also scant use in relation to Lusso Pietra and none in relation to Lusso Deco. It follows that the opponent cannot claim an enhanced degree of distinctive character for these marks and, moreover, that its claim to a family of LUSSO marks fails.¹³

¹³ *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06

Comparison of marks

35. *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.”

36. 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.

37. The marks to be compared are:

Opponent's marks	Applicant's mark
(i) LUSSO (ii) LUSSO LUXURY LIVING	GRANLUSSO

38. As noted earlier in this decision, the applicant admits that the marks are similar “due to the commonality of the word element LUSSO”, but submits that “there are other elements present in the various Marks that are not *de minimis* that serve to differentiate those various Marks.”

39. Earlier mark (i) and the applicant's mark consist of a single word in which the overall impression of each resides. The stylisation of LUSSO is not negligible, but will not have a significant impact in the overall impression. Earlier mark (ii) is dominated by LUSSO because (a) it will be read first, and (b) because the words LUXURY LIVING have a very weak, or no, distinctive character.

40. The minimal stylisation of earlier mark (i) will have little impact on the visual similarity assessment. The applicant's mark consists of nine letters. The parties' marks coincide in the final five letters of the applicant's mark, LUSSO, which are the same, and in the same sequence, as the entirety of earlier mark (i) and the dominant and distinctive component of earlier mark (ii). Taking into account the different beginning of the applicant's mark compared to the earlier marks, I find that the applicant's mark is visually similar to a medium degree to earlier mark (i) and visually similar to a lower degree to earlier mark (ii).

41. The applicant's mark has three syllables, the second and third of which are identical to the entirety of earlier mark (i) and to the dominant and distinctive component of earlier mark (ii). There is a medium degree of aural similarity with earlier mark (i); although two thirds of the syllables are the same, the first syllable in the applicant's mark is different and this will be the syllable heard first. There are three words in earlier mark (ii), the second and third of which do not coincide with the applicant's mark. These are words of weak, or no, distinctive character and it is possible that they will not be articulated, LUSSO being regarded as the brand name to which people will refer when ordering or discussing the opponent's goods sold under earlier mark (ii) because the other words are merely non-distinctive or descriptive and therefore subordinate. In *Enrich International Ltd v Onyinye Udokporo*, Mr Phillip Johnson, sitting as the Appointed Person in Case BL O/1141/25, referred to the decision of the GC in T-544/12 *Pensa Pharma v OHIM* at [107]:¹⁴

“the relevant public generally pays greater attention to the beginning of a sign than to the end. In those circumstances, that public will focus its attention on the element ‘pensa’ in the contested mark and not on the element ‘pharma’ in

¹⁴ EU:T:2015:355

that mark. It may be presumed that that public, which generally tends to contract long marks consisting of two words into a single word, will not pronounce the word ‘pharma’, inasmuch as that word is superfluous because of the nature of the goods and services covered by the contested mark, namely pharmaceutical goods and services”.

42. Mr Johnson said:

“15. The General Court continues to take the view that secondary or descriptive elements of marks are not necessarily spoken: see T-68/2021 *Hauz 1929 v EUIPO*, EU:T:2021:127, [40]; T-560/20 *Yadex International v EUIPO*, EU:T:2021:714, [75]; T-357/21 *Jose Alfonso Arpon v EUIPO*, EU:T:2022:405, [52]; T-1144/23 *Enedo Oyj v EUIPO*, EU:T:2025:207, [88]. These cases follow the general pattern of the jurisprudence before the UK left the EU and so they remain strongly persuasive, and I therefore consider them as reflecting English law: see *Lipton v BA Cityflyer Ltd* [2024] UKSC 24, [158].

16. In my view, the principle that descriptive or secondary elements in a mark may not be pronounced when the mark is spoken is distinct from the rule that negligible elements of marks can be disregarded in the comparison of marks (see C-3/03/P *Matratzen Concord* [2004] ECR I-3657). The former is a reflection of the fact that in everyday life people often say things in a simplified or shortened form (even though they may be aware of the entire mark). The latter principle, on the other hand, reflects the fact that negligible or insignificant elements of the mark will be forgotten (or not memorised in the first place).

17. Accordingly, if Philip Harris, sitting as the Appointed Person, in *Purity Wellness Group v The Stockroom (Kent)* (O/115/22), [31]-[32] was suggesting (and I am not sure he was) that all descriptive elements of a mark must be considered as spoken in the aural comparison (unless those elements are negligible) I disagree with him; rather, I consider that I should follow the approach of the General Court outlined above.

18. Accordingly, it was open to the Hearing Officer to treat the word “LEARNING” as descriptive in relation to education-related services. And in light of this finding, it was likewise perfectly acceptable for the Hearing Officer to conclude that this element of the mark would not usually be verbalised. I therefore reject this ground of appeal.”

43. Accordingly, I find that if LUXURY LIVING would not be articulated, which seems to me more likely, then the aural similarity is the same as for earlier mark (i): medium. On the other hand, if all the words are spoken, there is a lower degree of aural similarity.

44. In relation to the conceptual comparison, the opponent submits that “GRAN” is a descriptive element, suggesting “Great” or “Grand” and is applied as a prefix to LUSSO, which it claims is the dominant and distinctive element. In my view, LUSSO in the applicant’s mark cannot be said to be a dominant and distinctive element without artificially dissecting the mark. The opponent also submits that GRAN is Italian for great and, as mentioned earlier, that LUSSO is Italian for luxury which “will be perceived as a nice looking and sounding Italian word with allusions of luxury.”

45. Although marks should not be artificially dissected, that does not mean that elements of marks cannot evoke meanings.¹⁵ To the English-speaker, there is a natural break between GRAN and LUSSO. I am unconvinced that the UK average consumer will know that LUSSO has allusions of luxury or means anything. However, I think GRAN will evoke meaning for some consumers. It is placed at the front of the mark and is similar to the English and French words Grand/Grande, with which the average consumer will be familiar, as meaning grand or great. Some average consumers will not see the reference, in which case the applicant’s mark will have no meaning and the applicant’s mark will be conceptually neutral to earlier mark (i). If the meaning of grand, or great, is evoked, that is an extra meaning not present in earlier mark (i). Consequently, the applicant’s mark will be conceptually dissimilar to earlier mark (i). Earlier mark (ii) includes the words LUXURY LIVING, which have an obvious

¹⁵ *Usinor SA v OHIM*, Case T-189/05, paragraphs 62 to 68 and *Aitic Penteo v OHIM* Case T-585/10, paragraph 72, both GC, the latter concerning words which contain only one element which is familiar to the average consumer.

concept. If there is no evocation of grand or great in the applicant's mark, it will be conceptually dissimilar to earlier mark (ii). If grand is evoked in the applicant's mark, that has a degree of conceptual similarity to LUXURY (in LUXURY LIVING): something grand is often luxurious (a grand entrance, a grand hotel or a grand staircase, for example). This creates a low level of conceptual similarity between the applicant's mark and earlier mark (ii).

Likelihood of confusion

46. 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, the parties' goods and services range from identical through to similar to a low degree.

47. There are two types of confusion, direct and indirect.¹⁶ 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. Given the differences between the marks, it is unlikely that they will be imperfectly recalled to the extent that they are directly confused.

48. However, I find that there is a likelihood of indirect confusion. 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

¹⁶ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207.

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).”

49. 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*.¹⁷

¹⁷ *Ibid.*

50. The dominant and distinctive element of the earlier marks makes up half of the applicant's mark. Of itself, this does not necessarily lead to a likelihood of confusion. However, that element is highly distinctive, and has an enhanced distinctive character in the case of earlier mark (i). It is also an element which, in the applicant's mark, is subject to a natural break between GRAN and LUSSO. To some average consumers, the first part of the mark, prior to the natural break, evokes a known word, either great or grand. That group of average consumer is likely to view the applicant's mark as denoting a brand extension, or brand evolution, such as offering a more luxurious range of bathroom goods and services offered under the LUSSO umbrella. That the opponent is known for luxurious goods is borne out in the evidence described earlier; for example:

- the opponent supplied a LUSSO bath to Claridge's hotel;
- Luxury London Living featured a bath priced at £2,377, which was described as a design leap and a statement piece to shake up bathroom design;
- These Three Rooms referred to the opponent as a luxury bathroom brand, showing a luxurious freestanding marble bath.

51. Average consumers for whom the application evokes the meaning of grand will assume that the parties' goods and services are provided by the same or an economically linked undertaking, despite the at least medium level of attention. I find this in relation to all the applicant's goods (many of which are identical to the opponent's) and services compared to earlier mark (i), including light fixtures. I also reach the same conclusion in relation to earlier mark (ii). Whilst this mark's distinctiveness is not enhanced, the coinciding element, LUSSO, is still inherently highly distinctive. It is the dominant and distinctive element of earlier mark (ii) and the other words will be seen as very much subordinate in terms of origin significance. In the case of earlier mark (ii), the applicant's light fixtures are identical to the opponent's lighting fixtures. As the section 5(2)(b) succeeds on the basis of earlier marks (i) and (ii), there is no need for me to consider earlier marks (iii) and (iv).

52. In its counterstatement, the applicant pleaded that there has been honest concurrent use such that no likelihood of confusion exists. However, the applicant did not file evidence. Even though the opponent has referred in its submissions to the

applicant selling bathroom and housing interior products, there is no evidence to enable me to gauge the extent of any such use to decide whether the average consumer has become accustomed to the goods and services of both parties and is able to distinguish between them. If the applicant wanted to rely upon such a defence, it is up to the applicant to prove honest concurrent use. Accordingly, this defence fails and, for the same reason, does not have a bearing on the section 5(3) or 5(4)(a) grounds of opposition.

53. The section 5(2)(b) ground succeeds.

Section 5(3) of the Act

54. Section 5(3) states:

“(3) A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

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

55. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12 P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

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

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that

this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

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

56. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public. In view of my findings earlier, there is no qualifying reputation in earlier mark (ii). I found an enhanced level of distinctive character in relation to earlier mark (i), which has a qualifying reputation under this ground. Notably, LUSSO has a 2% share of the market which is full of smaller players and is, therefore, a significant percentage share. The opponent, which shares the principal

part of its name with its trade mark, LUSSO, has won several business awards. It has a reputation for luxurious goods, as evidenced by its supply of a LUSSO bath to Claridge's, its awards for Leading Artisan Bathroom Manufacturer and Best Bathroom Collection, and the price point and appearance of its goods.

57. I have already found a likelihood of confusion with the goods of earlier mark (i). In terms of light fixtures for which there is a lower level of similarity, I remain of the view that the relevant public will assume that the parties' goods and services come from the same or an economically linked undertaking. There is no requirement for goods and services to be similar under section 5(3), but the relative distance between them is a factor to take into account. In the present case, light fixtures are a feature of interior design, as are bathrooms and components of bathrooms. The opponent's strong reputation and the high level of the distinctiveness of LUSSO will cause the relevant public to bring to mind earlier mark (i) and, given the relative proximity of all the parties' goods and services, there will be confusion.

58. Confusion will cause unfair advantage to arise because the applicant will gain sales off the back of the confusion with the opponent's mark. Even if I am wrong about confusion, the strength of the earlier mark's reputation and its high level of distinctiveness will cause a link to be made between the parties' marks, which the applicant concedes are similar. The opponent's LUSSO goods are known for being luxurious and for being design or statement pieces; for example, Claridge's, which is a hotel known for luxury, bought a LUSSO bath. In addition to its trade origin message, earlier mark (i) communicates powerful messages of luxury, exclusivity, strong design and high quality. There will be an undoubted image transfer to the applicant's mark. The applicant's mark will benefit from that image transfer and gain an unfair advantage: unfair because the applicant's mark will benefit from the power of attraction of earlier mark (i) and get a marketing and sales 'leg-up' without having to do so much groundwork as would normally be required for a new mark.

59. As I have found both confusion and unfair advantage under section 5(3), I do not need to look at detriment to repute and distinctiveness, or to consider earlier marks (iii) and (iv).

60. The section 5(3) ground succeeds.

Section 5(4)(a)

61. 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.”

62. 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.”

63. 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)."

64. 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."

65. The opponent's pleaded goodwill is in relation to *bathroom installations, bathroom furniture, bathroom fittings and accessories; furniture; retail services in relation to furniture, bathroom installations, bathroom furniture, bathroom fittings and accessories*. The evidence shows that the opponent, at the relevant date, had a strong level of goodwill in its business associated with the sign LUSSO at least in relation to *bathroom installations, bathroom furniture, bathroom fittings and accessories*. LUSSO was highly distinctive of the opponent's business at the relevant date. Its goodwill is wide enough to cover all of the goods in the application and the opponent's goodwill lies in the goods which are the subject of the applicant's class 35 services. In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that "*a substantial number*" of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal's later judgment in *Comic*

Enterprises Ltd v Twentieth Century Fox Film Corporation [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

66. The factors at play in this ground are equal to those in the section 5(2)(b) ground as regards earlier mark (i) which is, essentially, the same as the sign relied upon for the section 5(4)(a) ground. If anything, the opponent is in a better position under section 5(4)(a) because it has a strong level of goodwill in relation to a bathroom fixtures and fittings business, which covers all of the goods of the application, including light fixtures for bathrooms. There would be misrepresentation and damage would follow; for example, diversion of sales and damage to reputation if the goods and services were of inferior quality, particularly given the opponent's reputation for luxurious and high-quality goods. **The section 5(4)(a) ground succeeds.**

Overall outcome

67. The opposition succeeds under all three grounds. The application is refused.

Costs

68. 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 have awarded below the scale for the opponent's submissions in lieu of a hearing because they include an amount of repetition from its submissions filed during the evidence rounds. 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	£100
Total	£1700

69. I order Delux Bathrooms and Tiling Solutions Limited to pay to Lusso UK Holdings Limited the sum of £1700. 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 2nd day of February 2026

Judi Pike
For the Registrar

Annex

Earlier mark (i) 3349396:

Class 11: Apparatus for sanitary purposes; Basin taps; Basins being part of water supply installations; Bath fittings; Bath installations; Bath panels; Bath plumbing fixtures; Bath spouts; Bath taps; Bathroom basins [parts of sanitary installations]; Bathroom installations; Bathroom installations for sanitary purposes; Bathroom installations for water supply purposes; Bathroom sinks; Bathroom wash basins; Baths; Bathtubs; Controlled mixers being parts of shower installations; Fitted liners for shower trays; Fittings (Bath -); Fittings for basins; Fittings for sanitary purposes; Heated towel rails; Installations for sanitary purposes; Mixing taps [faucets]; Sanitary apparatus and installations; Sanitary installations; Shower apparatus; Shower attachments; Shower bath fittings; Shower bath installations; Shower fittings; Shower head sprayers; Shower heads; Sink units; Sinks; Tap water faucets.

Class 20: Bathroom cabinets; Bathroom cupboards; Bathroom fittings in the nature of furniture; Bathroom furniture; Bathroom mirrors; Bathroom stools; Bathroom vanities; Bathroom vanities [furniture]; Bathroom vanity units incorporating basins; Mirrors enhanced by electric lights; Vanity units [furniture]; Vanity units incorporating basins; Washstands [furniture].

Earlier mark (ii) 3665268:

Class 3: Cleaning preparations; cleaning fluids; polish; polishing preparations; polish for furniture and flooring; shampoos; shampoo-conditioners; hair shampoos; body shampoos; shampoo bars.

Class 6: Metallic hardware; door knobs of metal; statues and works of art of common metals; metallic flooring; splashbacks of metal.

Class 9: Apparatus, instruments and cables for electricity, electrical and electrical components, electrical switches, electrical sockets, electrical lighting fittings.

Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating purposes; sinks, sinks incorporating drainers, basins; taps; apparatus for sanitary purposes; apparatus for the supply of water for sanitary purposes; basin taps; basins being part of water supply installations; bath fittings; bath installations; bath panels; bath plumbing fixtures; bath spouts; bath taps; bathroom basins [parts of sanitary installations]; bathroom installations; bathroom installations for sanitary purposes; bathroom installations for water supply purposes; bathroom sinks; bathroom wash basins; baths; bathtubs; controlled mixers being parts of shower installations; fitted liners for shower trays; fittings (bath -); fittings for basins; fittings for sanitary purposes; heated towel rails; installations for sanitary purposes; mixing taps [faucets]; sanitary apparatus and installations; sanitary installations; sanitary ware; sanitary ware made of porcelain; sanitary ware made of stoneware; shower apparatus; shower attachments; shower bath fittings; shower bath installations; shower fittings; shower head sprayers; shower heads; sink units; sinks; tap water faucets; toilet bowls; toilet bowls and seats sold as a unit; toilet lids; toilet seat lids; toilet seats; toilets; toilets [water-closets]; toilets incorporating cisterns; lighting and lighting fixtures; parts and fittings for all the aforesaid goods; plumbing fixtures; shower room installations and fixtures; ventilation installations; stone baths; stone basins; parts and fittings for all the aforesaid goods.

Class 16: Pictures, art pictures, paintings.

Class 19: Building and construction materials and elements not of metal; non-metallic doors, gates, windows and window coverings; non-metallic flooring materials; non-metallic flooring in the nature of wood, wood effect material, tiles and ceramic tiles; tiles including for use in bathrooms, bedrooms, kitchens, shower rooms and WCs, whether for use on the floor, walls or otherwise; building materials used to fit or install, the above, including grout, mortar, cement, and plaster; building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal; storage units [structures] of non-metallic materials; storage units [structures] of wood and substitutes for wood, or of plastic; non-metallic shelves [structures]; shelves [structures] of wood and substitutes for wood; shelf units [structures] not of metal; shelf units [structures] of wood and substitutes for wood; cornices; plinths; upstands; splashbacks; non-metallic wall

panels; glass panels; glass splashbacks; timber panels; cladding materials (non-metallic); cladding panels made of glass; non-metallic blanks for use in the manufacture of kitchen, bedroom and bathroom receptacles; blanks of wood and substitutes for wood, or of plastic, for use in the manufacture of kitchen, bedroom and bathroom receptacles; stone lanterns; statues, figurines and works of art made of materials such as stone, concrete and marble included in the class; stone; natural stone; worked natural stone; stone slabs; building stone; marble; slate; stone surfacings; wall stone; flooring stone; paving stone; reclaimed stone for use in walling, flooring and paving; tiles of stone, marble, slate, limestone, terracotta, porcelain and ceramics; wall tiles; floor tiles; tiles and slabs for paving; mosaic tiles; stone mosaics; artificial stone; manufactured stone; limestone [calcareous stone]; stone sculptures; agglomerated stone materials; carvings of stone; construction materials of artificial stone; construction materials of natural stone; manufactured building elements (non-metallic-); stone for building; fire surrounds [mantles and mantelpieces] of stone; artificial stone; stone veneers [building materials]; pedestals and plinths of stone and marble; staircases; staircases of stone and marble; carvings of stone and marble; works of stonemasonry; fire surrounds of stone and marble; garden ornaments of stone and marble; decorative objects, works of art, ornaments, models, sculptures, statues and statuettes, figures and figurines, busts, monuments and plaques, all made of materials namely, stone and marble, included in the class; parts, fittings, fixtures, components and accessories for any or all of the aforesaid goods.

Class 20: Furniture; furniture for house, office and garden; Non-metallic hardware, namely door, gate and window fittings not of metal; furniture fittings not of metal; hardware namely bolts, screws, nuts, dowels, furniture casters, door fasters, door fittings, handles, knobs, locks, curtain hooks, curtain rails, curtain tie backs, curtain rings, curtain rods, not of metal; fitted kitchen furniture and fitted bedroom furniture and kits of parts for assembly into kitchens and bedrooms and their constituent parts being items of furniture; fitted bathroom furniture and shower room furniture and kits of parts for assembly into bathrooms and shower rooms and their constituent parts being items of furniture; articles of furniture including cupboards, cabinets, tables, chairs, sofas, stools, storage chests, display units, drawers, chests of drawers, drawer units, beds, wardrobes, bedside tables, shelving, shelves, shelf units, spacing units and spacers, mirrors, picture frames, dressing tables, benches, racks, sink units; basin

units; worktops and table tops; countertops; upstands; furniture panels; furniture doors; bathroom cabinets; bathroom cupboards; bathroom fittings in the nature of furniture; bathroom furniture; bathroom mirrors; bathroom stools; bathroom vanities; bathroom vanities [furniture]; bathroom vanity units incorporating basins; mirrors enhanced by electric lights; vanity units [furniture]; vanity units incorporating basins; bathroom furniture with marble basins; washstands [furniture]; door handles; handles for furniture; blinds; cushions; statues, figurines and works of art and ornaments and decorations, made of materials such as wood, wax, plaster or plastic, included in the class; kitchen worktops; parts, fittings, fixtures and fittings for all the aforesaid goods.

Class 21: Statues, figurines, plaques and works of art, made of materials such as porcelain, terra-cotta or glass, included in the class.

Class 24: Soft furnishings.

Class 42: Bathroom design services; consumer product design; custom design services; design of bathrooms; design of furnishings; design of heating; design services relating to baths; design services relating to the installation of baths; design services relating to the installation of sanitary fittings; furniture design; planning [design] of bathrooms.

Earlier mark (iii) 3605344:

Class 11: Apparatus for sanitary purposes; Basin taps; Basins being part of water supply installations; Bath fittings; Bath installations; Bath panels; Bath plumbing fixtures; Bath spouts; Bath taps; Bathroom basins [parts of sanitary installations]; Bathroom installations; Bathroom installations for sanitary purposes; Bathroom installations for water supply purposes; Bathroom sinks; Bathroom wash basins; Baths; Bathtubs; Controlled mixers being parts of shower installations; Fitted liners for shower trays; Fittings (Bath -); Fittings for basins; Fittings for sanitary purposes; Heated towel rails; Installations for sanitary purposes; Mixing taps [faucets]; Sanitary apparatus and installations; Sanitary installations; Shower apparatus; Shower attachments; Shower bath fittings; Shower bath installations; Shower fittings; Shower head sprayers; Shower heads; Sink units; Sinks; Tap water faucets.

Class 19: Stone; natural stone; worked natural stone; stone slabs; building stone; marble; slate; stone surfacings; wall stone; flooring stone; paving stone; reclaimed stone for use in walling, flooring and paving; tiles of stone, marble, slate, limestone, terracotta, porcelain and ceramics; wall tiles; floor tiles; tiles and slabs for paving; mosaic tiles; stone mosaics; pedestals and plinths of stone and marble; staircases; staircases of stone and marble; carvings of stone and marble; works of stonemasonry; fire surrounds of stone and marble; garden ornaments of stone and marble; decorative objects, works of art, ornaments, models, sculptures, statues and statuettes, figures and figurines, busts, monuments and plaques, all made of materials namely, stone and marble, included in the class.

Class 20: Bathroom cabinets; Bathroom cupboards; Bathroom fittings in the nature of furniture; Bathroom furniture; Bathroom mirrors; Bathroom stools; Bathroom vanities; Bathroom vanities [furniture]; Bathroom vanity units incorporating basins; Mirrors enhanced by electric lights; Vanity units [furniture]; Vanity units incorporating basins; Bathroom furniture with marble basins; Washstands [furniture].

Earlier mark (iv) 3605340:

Class 11: Apparatus for sanitary purposes; Basin taps; Basins being part of water supply installations; Bath fittings; Bath installations; Bath panels; Bath plumbing fixtures; Bath spouts; Bath taps; Bathroom basins [parts of sanitary installations]; Bathroom installations; Bathroom installations for sanitary purposes; Bathroom installations for water supply purposes; Bathroom sinks; Bathroom wash basins; Baths; Bathtubs; Controlled mixers being parts of shower installations; Fitted liners for shower trays; Fittings (Bath -); Fittings for basins; Fittings for sanitary purposes; Heated towel rails; Installations for sanitary purposes; Mixing taps [faucets]; Sanitary apparatus and installations; Sanitary installations; Shower apparatus; Shower attachments; Shower bath fittings; Shower bath installations; Shower fittings; Shower head sprayers; Shower heads; Sink units; Sinks; Tap water faucets.

Class 20: Bathroom cabinets; Bathroom cupboards; Bathroom fittings in the nature of furniture; Bathroom furniture; Bathroom mirrors; Bathroom stools; Bathroom

vanities; Bathroom vanities [furniture]; Bathroom vanity units incorporating basins; Mirrors enhanced by electric lights; Vanity units [furniture]; Vanity units incorporating basins; Washstands [furniture].