O/0260/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 4095103
IN THE NAME OF CHI CLOTHING LTD
TO REGISTER THE FOLLOWING TRADE MARK:

CHI CLOTHING

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 451044
BY DK COMPANY VEJLE A/S

Background and pleadings

1. Chi Clothing Ltd ("the applicant") applied to register the trade mark "CHI CLOTHING" in the UK on 3 September 2024, under number 4095103. It was accepted and published in the Trade Marks Journal on 13 September 2024 in respect of goods:

> Class 25: *Clothes; Clothing; Swaddling clothes; Baby clothes; Beach clothes; Nappy pants [clothing]; Denims [clothing]; Jackets [clothing]; Shorts [clothing]; Work clothes; Drawers [clothing]; Drawers as clothing; Clothes for sports; Aprons [clothing]; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Clothes for sport; Linen clothing; Headbands [clothing]; Headbands for clothing; Kerchiefs [clothing]; Gloves [clothing]; Gloves as clothing; Bottoms [clothing]; Capes (clothing); Furs [clothing]; Trunks being clothing; Maternity clothing; Jerseys [clothing]; Babies' pants [clothing]; Layettes [clothing]; Clothing layettes; Clothing for leisure wear; Woolen clothing; Gabardines [clothing]; Oilskins [clothing]; Bodies [clothing]; Clothing for babies; Hoods [clothing]; Ready-to-wear clothing; Garments for protecting clothing; Tops [clothing]; Gussets for underwear [parts of clothing]; Belts [clothing]; Belts for clothing; Collars [clothing]; Playsuits [clothing]; Pockets for clothing; Veils [clothing]; Knitwear [clothing]; Corsets [clothing, foundation garments]; Paper hats for use as clothing items; Silk clothing; Fabric belts [clothing]; Mitts [clothing]; Hats (Paper -) [clothing]; Paper hats [clothing]; Beach clothing; Belts (Money -) [clothing]; Money belts [clothing]; Braces for clothing; Chaps (clothing); Ready-made clothing; Embroidered clothing; Casual clothing; Knitted clothing; Gussets for bathing suits [parts of clothing].*

2. DK Company Vejle A/S ("the opponent") opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed at all the goods. The opponent relies upon the following trade marks and the following goods for which they are registered:

(i) **ICHI**

UK registration no. 916009185
Filing date: 8 November 2016
Registration date: 4 June 2019

Goods registered (all of which are relied upon for opposition purposes):

Class 9: Glasses; sunglasses; eyeglass cases; spectacle frames; cases for sunglasses; straps for sunglasses.

Class 14: Jewellery, precious stones not including bars of precious metal, coins of precious metal and ingots of precious metal; watches and chronometric instruments not including watches and chronometric instruments made from solid gold or solid silver.

Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; umbrellas.

Class 25: Clothing, footwear, headgear.

Class 35: Retail store services in the field of clothing, footwear, headgear, bags and purses.

Referred to as "the '185 mark"

(ii) **ICHI**

UK registration no. 901303684
Filing date: 9 September 1999
Registration date: 14 November 2000
Goods registered (all of which are relied upon for opposition purposes):

Class 14: Jewellery of non-precious metal.

Class 18: Suitcases, handbags, travelling bags, key cases, purses, wallets, rucksacks, train cases.

Class 25: Clothing for men and women; belts (clothing); headgear; footwear.

Referred to as "the '684 mark"

(iii) **ICHI**

UK registration no. 915615214
Filing date: 5 July 2016
Registration date: 26 October 2016
Goods relied upon for opposition purposes:

Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; umbrellas.

Class 25: Clothing, footwear, headgear.

Class 35: Retail store services in the field of clothing, footwear, headgear, bags and purses.

Referred to as “the ‘214 mark”

3. These marks are comparable marks created pursuant to Article 54 of the Withdrawal Agreement. The marks have the same legal status as if they had been applied for and registered under UK law, and retain the original filing and registration dates of the EU Trade Marks from which they were created.

4. The opponent’s marks qualify as ‘earlier trade marks’ in accordance with section 6 of the Act. The earlier marks had been registered for more than five years at the filing date of the applicant’s mark and are, therefore, subject to the use requirements in section 6A of the Act.

5. In its statement of grounds, the opponent contends that the competing marks are similar and that the parties’ goods and services are either similar or identical. On this basis, the opponent submits that there is a likelihood of confusion.

6. The applicant filed a counterstatement denying the ground of opposition. It also indicated that it would require the opponent to provide proof of use.

7. The opponent is professionally represented by Patrade A/S whereas the applicant is not professionally represented. During the evidence rounds, the opponent filed evidence and written submissions, and the applicant filed a witness statement, though it contained written submissions as opposed to evidence of fact. Neither party requested a hearing but both filed written submissions in lieu of a hearing. This decision is taken following careful consideration of all the papers before me.

Relevance of EU law

8. 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[1] requires tribunals applying assimilated law to

[1] As amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023

follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence

9. The opponent's evidence consists of a witness statement provided by Ms Charlotte Rask Boddum (dated 15 May 2025) and Exhibits 1 to 8. The opponent's written submissions are contained within Exhibit 1. Ms Boddum is the Partner at Patrade A/S, which is the legal representative of the opponent. This is a position that she has held for more than 20 years. She provides evidence of use of the opponent's marks.

10. I have taken all the evidence into account in reaching my decision and will refer to it below where necessary.

Proof of use

11. Section 6A of the Act reads as follows:

> "(1) This section applies where –
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> > (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.
>
> (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. It is as follows:

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

…

(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(3) and (4) to the United Kingdom include the European Union."

13. Pursuant to the above provisions, the relevant period for assessing whether there has been genuine use of the opponent's marks is the five-year period ending with the filing date of the applicant's mark, i.e. 4 September 2019 to 3 September 2024. Within this period, the relevant territory is the EU for the period up to 31 December 2020 and the UK thereafter.

14. In *easyGroup Ltd v Nuclei Ltd & Ors*,[2] Arnold LJ summarised the law relating to genuine use as follows:

> "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 V*erein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I9223, 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].

[2] [2023] EWCA Civ 1247

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]. (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. Moreover, section 100 of the Act states that:

"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."

<u>Preliminary issue: relevant territories</u>

16. In Exhibit 2, Ms Boddum states that the opponent DK Company Vejle A/S is a part of the DK Company conglomerate which operates in the EU and UK, as well as internationally. Ms Boddum states that the place of use shown throughout the evidence is the United Kingdom. As stated previously, the relevant territory is the EU for the period up to 31 December 2020. However, I remind myself that sales in one Member State may be sufficient for showing use during the period in which the EU is the

relevant territory. In *Leno Merken BV v Hagelkruis Beheer BV,*[3] the Court of Justice of the European Union ("CJEU") noted that:

> "36. It should, however, be observed that … the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase 'in the Community' is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.
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> …
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> 50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as 'genuine use', it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national mark.
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> …
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> …
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> 55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A de minimis rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down

[3] Case C-149/11

> (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)."

17. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited,*[4] Arnold J (as he then was) reviewed the case law since *Leno* and concluded as follows:

> "228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in Leno are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.
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> 229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issue in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument is not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

[4] [2016] EWHC 52

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that 'genuine use in the Community will in general require use in more than one Member State' but 'an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State'. On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

18. The General Court ("GC") restated its interpretation of *Leno* in *TVR Automotive Ltd v OHIM*[5] (see paragraph 57 of that judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark ("EUTM")). Consequently, in trade mark opposition and cancellation proceedings the Registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods and/or services being limited to that area of the Union. Ms Boddum has not provided any sales figures, marketing expenditure, or other information relating to outside the UK. The UK was part of the EU until IP completion day, and it is my view that the volume of sales for the years 2019 and 2020, taken with the rest of the evidence, is enough to show that use was made of the marks to create or maintain a share of the market for the goods. I have therefore taken into account the UK sales figures for the years 2019 and 2020 (in which the EU was the relevant territory).

[5] Case T-398/13

Sales figures

19. In her witness statement, Ms Boddum states that Exhibit 5 shows turnover figures for clothing items sold under the opponent's marks in the UK between 2019 and 2024. Exhibit 5 also shows a breakdown of figures across the various retailers within the UK. The figures are as follows:

Year	Sales figures
2019	£1,942,785
2020	£1,486,571
2021	£1,577,555
2022	£2,094,645
2023	£2,094,277
2024	£2,150,012

20. As the relevant period spans 4 September 2019 to 3 September 2024, I am mindful that the turnover figures for the years 2019 and 2024 are likely to include sales made before and after the relevant period started and finished. Although I cannot be sure of what proportion of the sales from 2019 and 2024 ought to be discounted, I am mindful that the figures for 2019 and 2024 are likely to be lower than the amounts shown in the table above.

21. Exhibit 3 contains invoices for UK sales made in 2019 to 2024. The invoices from 2019 (pages 2 to 31) and some of those from 2024 (pages 184 to 190) fall outside of the relevant period, which is 4 September 2019 to 3 September 2024. I note that in Exhibit 2, Ms Boddum cites *Laboratoire de la mer*[6] and states that these invoices were included on the basis that events outside of the relevant period may "confirm or better assess the extent to which the earlier mark was used during the relevant period and the real intentions of the proprietor at that time". Although I acknowledge the inclusion of these invoices for contextual reasons (as outlined in *Laboratoire de la mer*), it is my

[6] C-259/02

view that the invoices which fall within the relevant period form the key basis of my analysis of use, and therefore I have focussed on them.

22. The invoices in Exhibit 3 which fall within the relevant period were issued to UK-based customers to a wide range of different locations across the UK, such as Londonderry, Northumberland, Tynemouth, Hertfordshire, London, Tenby, Edinburgh, Cheshire, Glasgow, Ammanford, Corsham, Cumbria, Towchester, and Westhoughton. Moreover, as some invoices demonstrate that goods were sold to online distributers or telemarketers such as QVC UK (e.g. page 171) and ASOS.com Ltd (e.g. page 32), I also recognise that it is likely that the goods will be distributed wider than these retailers' locations.

23. The invoices are supported by Exhibits 4.1 to 4.6, which show images of catalogues featuring the opponent's clothing sold under the opponent's marks. Exhibits 4.1 to 4.6 are catalogues dated: autumn/winter 2019; spring/summer 2020; autumn 2021; spring, summer and autumn 2022; autumn 2023; and spring 2024, respectively. The opponent's marks can be seen on the images of the catalogue pages.

Advertising activities

24. In Exhibit 2, Mrs Boddum states that the opponent has been "actively marketing its trade marks through social media platforms". Exhibits 6 and 7 show a number of screenshots of posts made on the opponent's Facebook and Instagram accounts. Some of the text on the screenshot is written in what I believe to be German, although the majority of the post captions themselves is written in English so they appear to be aimed at the English-speaking market. However, it is not clear as to how many consumers have been exposed to these posts within the EU up to 31 December 2020 and the UK thereafter. I also note that in Exhibit 2, Ms Boddum states that the opponent's Instagram page has almost 80,000 followers. Whilst I recognise that some of these followers might be based in the UK (or the EU prior to 31 December 2020), there is nothing in the exhibits or witness statement which confirms if the followers are based in the relevant territories or not.

25. Exhibit 8 contains screenshots of the opponent's website (https://www.ichi.biz) via the WayBack Machine. Each screenshot bears the opponent's marks and includes the

date that the website image was captured on WayBack Machine. For example, the screenshots on page 2 shows 7 August 2020 and 27 September 2020, and the screenshots on page 3 show 22 January 2021. All of the images within Exhibit 8 fall within the relevant period, and most of the images are written in English (except on page 4), which suggests that the goods sold through the opponent's website are aimed at English-speaking customers. However, there are no further details about the location of the intended customer base on the images or within Ms Boddum's statements.

<u>Forms of the marks</u>

26. Throughout the invoices in Exhibit 3, some of the images in Exhibit 4.5, and on the opponent's website screenshots in Exhibit 8, the marks appear in the following manner:

ICHI

27. This is identical to the '214 mark as filed, so it is acceptable for showing use of the '214 mark. Due to the use of the very basic typeface which does not alter the distinctive character of the marks, I also find that it is an acceptable variant of the word-only '185 and '684 marks too.

28. The opponent's marks also appear in Exhibits 4.1, 4.2, 4.3, 4.6, and some of the images within Exhibit 4.5 in different colours. For example, page 2 of Exhibit 4.1 shows the word 'ICHI' written in white over the top of background images:

29. The screenshots in Exhibit 7 also demonstrate use of the marks in different coloured text on clothing items and bags, such as shown below:

30. As the use of colours is a non-distinctive element,[7] it is my view that the use of different colours does not alter the marks' distinctive characters as wholes. It is therefore my view that these are acceptable variant forms of the opponent's marks.

31. Other images such as the screenshots of social media posts in Exhibits 6 and 7 show the word 'ICHI' surrounded by coloured borders:

32. In *Hyphen GmbH v EU IPO,*[8] the GC held the following:

> "28. ..a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see judgment of 10 June 2010, ATLAS TRANSPORT, T 482/08, not published, EU:T:2010:229, paragraph 31 and the case-law cited; judgments of 5 December 2013, Maestro de Oliva, T 4/12, not published, EU:T:2013:628, paragraph 24, and 12 March 2014, Borrajo Canelo v OHIM — Tecnoazúcar (PALMA MULATA), T 381/12, not published, EU:T:2014:119, paragraph 30).
>
> 29. For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true (judgment of 24 September 2015, Klement v OHIM —

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[7] As per *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290

[8] Case T-146/15

Bullerjan (Form of an oven), T 317/14, not published, EU:T:2015:689, paragraph 33).

30. It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole (judgment of 21 January 2015, Sabores de Navarra v OHIM — Frutas Solano (KIT, EL SABOR DE NAVARRA), T 46/13, not published, EU:T:2015:39, paragraph 37 and the case-law cited).

31. It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character (judgment of 21 June 2012, Fruit of the Loom v OHIM — Blueshore Management (FRUIT), T 514/10, not published, EU:T:2012:316, paragraph 38).

32. It is in the light of those considerations that it must be determined whether the Board of Appeal was correct in finding, in paragraph 9 of the contested decision, that it had not been proven that the European Union trade mark rights had been used in a manner so as to preserve them either in the form registered or in any other form that constituted an allowable difference in accordance with the second subparagraph of Article 15(1)(a) of Regulation No 207/2009."

33. As paragraph 31 demonstrates, any additions to a registered mark must not alter the distinctive character of the mark in the form in which it was registered. As the circular borders are non-distinctive and do not alter the distinctive character of the marks, I find that these are also acceptable variants of the opponent's marks.

34. The marks appear in Exhibit 4.4 as follows:

ICHIfied

35. In *Colloseum Holdings AG v Levi Strauss & Co.,*[9] which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

> "31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.
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> 32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.
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> 33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.
>
> 34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.
>
> 35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark

[9] Case C-12/12

must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)." (emphasis added)

36. The Oxford English Dictionary states that "-ified" is a suffix "forming adjectives modelled on adjectives in -ed suffix derived from verbs in -ify suffix, in cases where a corresponding verb in -ify suffix does not (yet) exist, e.g. devilified adj., Englishified adj., jazzified adj., etc". As a dictionary-defined suffix which amplifies the preceding verbal element, it is my view that the average consumer would understand its meaning but not see the addition of the pink "fied" suffix as itself being distinctive. Instead, it is my view that the distinctive character of the word "ICHI" remains unaltered (as per *Hyphen GmbH v EU IPO* cited above), as it can be identified as the distinctive element within "ICHI fied". Furthermore, the striking visual differences created by ICHI being presented in large black uppercase letters and the suffix "fied" being written as a separate element in smaller pink lowercase letters results in the distinctive word ICHI being readily identified within the compound (rather than the distinctive element 'ICHI' being lost within a larger word), as the way the two elements are presented means that ICHI continues to be perceived as indicative of the origin, as per *Colloseum* (cited above). On this basis, it is my view that it is an acceptable variant. However, if I am wrong in this finding, then as majority of the use shows the opponent's marks as filed (or with the acceptable variants above) throughout the evidence, my finding that the use of the word "ICHI" followed by "fied" does not affect my overall conclusion on the issue of use.

Sufficient use

37. The evidence has its limitations. As stated previously, there are no details in relation to the size of the relevant market or the share of that market held by goods bearing the opponent's marks. There are no details on the amount spent on advertising, and it is not clear how many consumers in the relevant territories have been exposed to the social media marketing activities.

38. However, an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole.[10] Whilst there is no indication of market

[10] *New Yorker SHK Jeans GmbH & Co. KG v OHIM,* Case T-415/09

share, the turnover figures provided by Ms Boddum show that just over £11m was generated through the sale of clothing bearing the opponent's marks in the UK in 2019 to 2024. These sales figures are supported by the invoices issued to different UK-based business customers, therefore showing dated evidence that the sales were geographically widespread in the UK territory. On the face of it, the figures (which represent sales made between 2019 and 2024) seem reasonably modest in the context of the UK market for clothing, which I understand to be very large. However, these appear to be the prices paid by the retailers rather than the consumers, and therefore would be lower than the standard retail price. As the authorities cited above show, use does not need to be quantitatively significant for it to be considered genuine. Taking the evidential picture as a whole, i.e. the turnover figures and the invoices which demonstrate sales made in the UK in the relevant period, I am satisfied that there has been genuine use of the opponent's marks.

Fair specification

39. In determining a fair specification for the opponent's marks, I consider *Merck KGaA v Merck Sharp & Dohme Corp & Ors*[11] in which the Court of Appeal set out the proper approach to partial revocation (which applies equally to the framing of a fair specification) as follows:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods

[11] [2017] EWCA Civ 1834

or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

40. This approach was approved by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1),*[12] subject to the proviso that it must be seen in light of more recent guidance by the CJEU that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use (for example, *Ferrari SpA v DU*[13] at paragraphs 36-53).

The '185 mark

Class 9: glasses; sunglasses; eyeglass cases; spectacle frames; cases for sunglasses; straps for sunglasses.

[12] [2024] UKSC 36
[13] (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106

41. Although I can see eyewear in some of the images in several of the catalogue images such as Exhibit 4.1, I cannot see that any of the product codes within the images relate to the eyewear items, as the product codes appear to relate to the clothing items only. I cannot see any eyewear listed in the invoices in Exhibit 3. Whilst I can also see eyewear in some of the screenshots in Exhibit 6, the captions only mention the clothing in the photo. It is therefore not clear if the eyewear appears in the images as a decorative feature, or if it is being sold under the opponent's mark. I am also unable to see any related eyewear accessories or components such as frames or cases in any of the exhibits. I therefore find that opponent cannot rely on *glasses; sunglasses; eyeglass cases; spectacle frames; cases for sunglasses; straps for sunglasses*.

> Class 14: Jewellery, precious stones not including bars of precious metal, coins of precious metal and ingots of precious metal; watches and chronometric instruments not including watches and chronometric instruments made from solid gold or solid silver.

42. Throughout Exhibits 4.1, 4.2, 4.3, 4.4 and 4.5, I can see jewellery items such as necklaces and earrings within the images. However, I cannot find any evidence from cross-referencing the product codes in the images with the invoices that they are for sale under the opponent's mark, so it is not clear if the products are merely decorative or if they are being advertised for sale. For example, in Exhibit 4.4, pages 5 to 16 show the model wearing several styles of earrings and necklaces. However, the product codes included in the images relate to the clothing items. I cannot see any product codes for the jewellery, so it is not clear if they are being sold under the opponent's mark. It is my view that the opponent has not demonstrated that they are selling jewellery goods, precious stones, or coins bearing the opponent's mark, and therefore it cannot rely on *jewellery, precious stones not including bars of precious metal, coins of precious metal and ingots of precious metal*.

43. I can only find one image which shows a watch (page 5 of Exhibit 4.1). However, when I cross-reference the product codes listed in the image with the product codes in the invoices in Exhibit 3, the codes all relate to the clothing items. I cannot see any evidence amongst the images and invoices that the opponent is selling any type of watch under the opponent's mark, and find therefore that it cannot rely on *watches*

and chronometric instruments not including watches and chronometric instruments made from solid gold or solid silver.

Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; umbrellas.

44. Exhibit 3 shows product codes for "13390 duffel bag" (for example, on pages 25 and 26). I cannot see the item in the catalogue, but it is being sold through the invoices bearing the opponent's mark (or acceptable variants thereof). In addition to this, Exhibit 4.3 shows a leather bag being sold under the mark. However, I cannot find any examples within the images or invoices of *leather and imitations of leather, animal skins*, or *hides* as unworked materials on their own, or anything which suggests that the opponent sells *trunks* or *umbrellas.* I therefore find that the opponent can rely on *travelling bags* only.

Class 25: clothing, footwear, headgear.

45. In the witness statement, Ms Boddum states that the turnover figures relate to "the sale of clothing items". The images and the invoices all show various items of women's clothing being sold under the opponent's mark, such as dresses, blouses, skirts, and blazers. I cannot see any evidence of men's clothing, children's clothing, or unisex clothing. I therefore identify *women's clothing* as a subcategory within *clothing* (as per paragraph 246 of *Merck KGaA*), and find that the opponent can rely on this subcategory rather than *clothing* at large.

46. I can also see examples of footwear being sold under the marks, such as in the images in Exhibit 4.1. These are slip-on heels and heeled boots (e.g. on pages 3 and 4). I cannot see any evidence of men's footwear or children's footwear. I therefore find that the opponent may only rely on *women's footwear* as an independent subcategory within *footwear.*

47. Page 8 of Exhibit 7 shows examples of headwear featuring ICHI on the front. To the best of my knowledge, the types of beanie and bucket-style hats shown in the exhibits are unisex styles and are worn widely by men and women. I therefore do not find that there are any independent subcategories within *headgear*. I therefore find

that in class 25, the opponent can rely on *women's clothing*, *women's footwear*, and *headgear* at large.

> Class 35: Retail store services in the field of clothing, footwear, headgear, bags and purses.

48. It is my view that the evidence does not demonstrate use of the mark in relation to these services. I cannot see any details in relation to any retail stores owned by the opponent or the services relating to them. I therefore find that the opponent cannot rely on *retail store services in the field of clothing, footwear, headgear, bags and purses*.

The '684 mark

> Class 14: jewellery of non-precious metal.

49. For the same reasons that I gave in my previous finding in relation to the '185 mark, the opponent is unable to rely on *jewellery of non-precious metal.*

> Class 18: suitcases, handbags, travelling bags, key cases, purses, wallets, rucksacks, train cases.

50. As stated previously, I am able to see evidence in the invoices and images of bags sold under the opponent's mark. As these could fall under both *handbags* and *travelling bags*, I find that the opponent is able to rely upon these terms. However, as I can see no evidence in relation to *suitcases, key cases, purses, wallets, rucksacks*, or *train cases*, I find that the opponent is unable to rely upon these goods.

> Class 25: clothing for men and women; belts (clothing); headgear; footwear.

51. As stated previously, I can only find evidence of women's clothing and footwear for sale, rather than any clothing or footwear for men. As these constitute subcategories within the wider terms *clothing* and *footwear*, I am of the view that the opponent may only rely on *clothing for women* and *women's footwear*. However, as stated in my finding for the '185 mark, the opponent may rely on *headgear* at large. I am unable to see *belts (clothing)* in any of the images or invoices, so I find that the opponent is unable to rely on them.

The ‘214 mark

> Class 18: leather and imitations of leather; animal skins, hides; trunks and travelling bags; umbrellas.

52. As per my finding for the ‘185 mark, the opponent can only rely on *travelling bags*.

> Class 25: clothing, footwear, headgear.

53. In line with my findings for the ‘185 mark and ‘684 mark, I find that the opponent can rely on *women’s clothing, women’s footwear,* and *headgear* at large.

> Class 35: retail store services in the field of clothing, footwear, headgear, bags and purses.

54. As per my previous findings for the ‘185 mark and the ‘684 mark, the opponent cannot rely on these services.

55. In summary, I therefore find that the opponent may rely on the following goods:

Mark	**Goods**
The ‘185 mark	Class 18: travelling bags Class 25: women’s clothing, footwear, and headgear.
The ‘684 mark	Class 18: handbags, travelling bags Class 25: clothing for women; headgear; women’s footwear
The ‘214 mark	Class 18: travelling bags Class 25: women’s clothing, footwear, headgear

Section 5(2)(b)

56. Section 5(2)(b) of the Act is as follows:

> "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".

57. 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."

58. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor:*[14]

(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

[14] [2025] UKSC 25

when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

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

Comparison of goods

59. In *Canon,*[15] the CJEU stated, at paragraph 23 of its judgment, that when considering whether goods are similar, all the relevant factors relating to the goods

[15] Case C-39/97

should be taken into account. The CJEU stated that those factors include their nature, intended purpose, method of use and whether they are in competition with each other or are complementary.

60. The relevant factors identified by Jacob J. (as he then was) in *Treat*[16] for assessing similarity were:

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
>
> (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

61. In *Kurt Hesse v OHIM,*[17] the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),*[18] the GC stated that "complementary" means:

> "…there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

[16] [1996] R.P.C. 281
[17] Case C-50/15 P
[18] Case T-325/06

62. In *Gérard Meric v OHIM,*[19] the GC confirmed that even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53)) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

The goods to be compared are shown in the table below:

The opponent's goods	The applicant's goods
The '185 mark Class 18: travelling bags Class 25: women's clothing, footwear, and headgear. **The '684 mark** Class 18: handbags, travelling bags Class 25: clothing for women; headgear; women's footwear. **The '214 mark** Class 18: travelling bags Class 25: women's clothing, women's footwear, headgear.	Class 25: Clothes; Clothing; Swaddling clothes; Baby clothes; Beach clothes; Nappy pants [clothing]; Denims [clothing]; Jackets [clothing]; Shorts [clothing]; Work clothes; Drawers [clothing]; Drawers as clothing; Clothes for sports; Aprons [clothing]; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Clothes for sport; Linen clothing; Headbands [clothing]; Headbands for clothing; Kerchiefs [clothing]; Gloves [clothing]; Gloves as clothing; Bottoms [clothing]; Capes (clothing); Furs [clothing]; Trunks being clothing; Maternity clothing; Jerseys [clothing]; Babies' pants [clothing]; Layettes [clothing]; Clothing layettes; Clothing for leisure wear; Woolen clothing;

[19] Case T-33/05

	Gabardines [clothing]; Oilskins [clothing]; Bodies [clothing]; Clothing for babies; Hoods [clothing]; Ready-to-wear clothing; Garments for protecting clothing; Tops [clothing]; Gussets for underwear [parts of clothing]; Belts [clothing]; Belts for clothing; Collars [clothing]; Playsuits [clothing]; Pockets for clothing; Veils [clothing]; Knitwear [clothing]; Corsets [clothing, foundation garments]; Paper hats for use as clothing items; Silk clothing; Fabric belts [clothing]; Mitts [clothing]; Hats (Paper -) [clothing]; Paper hats [clothing]; Beach clothing; Belts (Money -) [clothing]; Money belts [clothing]; Braces for clothing; Chaps (clothing); Ready-made clothing; Embroidered clothing; Casual clothing; Knitted clothing; Gussets for bathing suits [parts of clothing].

63. In its submissions filed in Exhibit 2 during the evidence rounds, the opponent contends that "all of the goods covered by the earlier marks is reproduced in their entirety", and that the parties' goods are either identical or at least very highly similar. In its submissions made in the witness statement, the applicant argues that its "product line… (is) entirely distinct from those of 'ICHI'" as it focuses on "leisurewear and sportswear with a holistic lifestyle appeal".

64. In so far as the applicant's claim that the parties' product lines are distinct from each other, as per the CJEU judgment in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*[20] (particularly paragraph 66), it is necessary to consider all the circumstances in which the opponent's mark might be used. As a result, even though the applicant has suggested that it focuses on a specific type of clothing, my

[20] Case C-533/06

assessment must take into account only the opponent's mark and any potential conflict with the applicant's mark. Any differences between the actual goods provided by the parties, are not relevant unless those differences are apparent from the competing marks and their specifications.

65. For the purposes of comparing goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.[21] I have therefore assessed the applicant's goods by dividing the terms into groups as per below:

> *Clothes; Clothing.*

66. As the opponent's narrower terms *women's clothing* for the '185 and '214 marks and *clothing for women* for the '684 are included within the applicant's wider terms *clothes* and *clothing*, they are identical under the principle outlined in *Meric.*

> *Beach clothes; Denims [clothing]; Jackets [clothing]; Shorts [clothing]; Work clothes; Drawers [clothing]; Drawers as clothing; Clothes for sports; Aprons [clothing]; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Clothes for sport; Linen clothing; Headbands [clothing]; Kerchiefs [clothing]; Gloves [clothing]; Gloves as clothing; Bottoms [clothing]; Capes (clothing); Furs [clothing]; Maternity clothing; Jerseys [clothing]; Layettes [clothing]; Clothing layettes; Clothing for leisure wear; Woolen clothing; Gabardines [clothing]; Oilskins [clothing]; Bodies [clothing]; Ready-to-wear clothing; Garments for protecting clothing; Tops [clothing]; Belts [clothing]; Belts for clothing; Collars [clothing]; Playsuits [clothing]; Veils [clothing]; Hoods [clothing]; Paper hats for use as clothing items; Paper hats [clothing]; Knitwear [clothing]; Corsets [clothing, foundation garments]; Silk clothing; Fabric belts [clothing]; Mitts [clothing]; Hats (Paper -) [clothing]; Beach clothing; Belts (Money -) [clothing]; Money belts [clothing]; Ready-made clothing; Embroidered clothing; Casual clothing; Knitted clothing.*

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[21] *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38

67. These are sub-types of clothing which may fall within the wider categories *clothing for women* or *women's clothing*. I have included *hoods* amongst these goods as a finished item of clothing rather than as a constituent part of a piece of clothing, as in my experience, it is possible to buy hoods akin to a balaclava to be worn on the head (other than the type of hood attached to a jacket). They are therefore identical under the principle outlined in *Meric.*

> *Swaddling clothes; Baby clothes; Nappy pants [clothing]; Babies' pants [clothing]; Clothing for babies.*

68. These types of clothing have different end users, i.e. babies and young children, rather than women. They broadly have the same nature and purpose, i.e. fabric items which are worn on the body, although goods such as *swaddling clothes* and *nappy pants [clothing]* serve additional functions relating to the care of babies. The goods will sometimes be sold through the same trade channels in the case of large clothing shops or department stores which sell multiple types of clothing, although there will also be instances where they are sold through separate trade channels, i.e. women's clothing shops and baby shops. When they are sold in the same trade channels, they are likely to appear in different sections of the retail environment. They are not complementary in that one is not essential to the other. Given the difference in end user, they are not in competition with each other. Taking all these factors into account, I find that there is a medium level of similarity between the goods.

> *Trunks being clothing; Chaps (clothing); Braces for clothing.*

69. To the best of my knowledge, these goods are typically items of men's clothing, rather than women's clothing. They will therefore have different users, i.e. men rather than women. They have the same nature and purpose, i.e. fabric items which are women to cover the body, although *braces for clothing* will serve an additional function of holding up other items of clothing. The goods will sometimes be sold through the same trade channels in the case of large clothing shops or department stores which sell multiple types of clothing, although there will also be instances where they are sold through separate trade channels, i.e. women's clothing shops and men's clothing shops. When they are sold in the same trade channels, they are likely to appear in different sections of the retail environment. They are not complementary in that one is

not essential to the other. Although they are unlikely to be in competition with each other given the general difference in user, there may be an element of competition for consumers who shop in both men's and women's clothing stores. Taking all these factors into account, I find that there is a medium level of similarity between the goods.

> *Headbands for clothing; Gussets for bathing suits [parts of clothing]; Pockets for clothing; Gussets for underwear [parts of clothing].*

70. These goods form constituent parts of the finished products. I have included *headbands for clothing* amongst this category, as it is my view that it differs from regular headbands in that it appears to be a constituent part of clothing (as opposed to a piece of clothing per se). In *Les Éditions Albert René v OHIM,*[22] the GC found that:

> "61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different."

71. *Headbands for clothing, gussets for bathing suits [parts of clothing], pockets for clothing,* and *gussets for underwear [parts of clothing]* are used to manufacture finished items of clothing. As such, they have a different purpose to the opponent's *women's clothing* or *clothing for women*, which are worn to cover the body. Users of the goods overlap in that they may be purchased by both tradespeople who manufacture clothing as well as the public at large, such as people who make their own clothing or customise their clothes. The physical nature of the respective goods overlaps since they may be made from the same materials. They could be sold directly to trade, or to the public such as within haberdashery shops. They may be manufactured by the same undertakings. Parts of clothing in particular are of importance to finished articles of clothing, and consumers may think that responsibility for them lies with the same undertakings, resulting in a degree of complementarity. It is therefore considered that the goods have a low to medium level of similarity with the opponent's goods.

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[22] Case T-336/03

Average consumer and the purchasing act

72. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*,[23] the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)*,[24] where he pointed out that:

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

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

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

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

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

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

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[23] [2025] UKSC 25

[24] [2024] EWCA Civ 262

73. In its submissions filed during the evidence rounds, the opponent argues that "there is no fact that would warrant a finding of a higher level of attention than the averagely attentive and circumspect consumer". In its submissions, the applicant does not specifically mention the level of attention paid by the average consumer.

74. The average consumer for the goods will be members of the general public as well as trade customers. The cost of purchase is likely to vary, and the goods will be purchased on a reasonably frequent basis. Several factors may influence the average consumer when purchasing the goods, such as, inter alia, the type of material, the quality, and the aesthetic appearance. I therefore consider that that the average consumer will pay a medium level of attention when selecting the goods, although this may be slightly higher for trade customers. The goods are likely to be self-selected from shelves within retail outlets, via online retailers, or in catalogues. In *New Look Limited v OHIM,*[25] the GC stated that:

> "50. […] Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion."

75. Visual considerations are therefore likely to be the primary factor when purchasing the goods. However, I do not discount the role that aural selection may play when purchasing, such as through word-of-mouth recommendations or when placing telephone orders.

Comparison of marks

76. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions

[25] Joined cases T-117/03 to T-119/03 and T-171/03

created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM,*[26] 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."

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

78. The respective trade marks are shown below:

The opponent's marks	**The applicant's mark**
ICHI (the '185 and '684 marks) **ICHI** (the '214 mark)	CHI CLOTHING

79. In its submissions filed in the evidence rounds, the opponent submits that "in the contested sign, the letters "CHI" must be considered the most dominant and distinctive part", and that ""CLOTHING" as a verbal element is descriptive in whole for the contested goods, being clothing items". In its submissions, the applicant does not address the dominant and distinctive parts of the competing marks.

80. The opponent's '185 and '684 marks are plain word marks written in upper case. As word-only marks with no other elements, the marks' overall impressions lie in the

[26] Case C-591/12P

word “ICHI”. Although the opponent’s ‘214 mark is a figurative mark, it only contains the black uppercase word “ICHI” written in a very basic typeface. As there are no other verbal or figurative elements within the mark, the mark’s overall impression lies in the verbal element “ICHI”.

81. The applicant’s mark is a plain word mark written in upper case. As “CHI” will be perceived by the average consumer as an invented term, it is the distinctive and dominant element within the applicant’s mark. The word “CLOTHING” will be seen as descriptive in relation to the goods by the average consumer. Whilst it still contributes to applicant’s mark’s overall impression, it is to a much lesser degree.

My approach

82. As the opponent’s ‘185 and ‘684 are identical, and the ‘214 mark is the same verbal element in a basic typeface, for ease of reference, I will focus my assessment on the ‘185 mark. However, for the avoidance of doubt, the same findings will also apply to the opponent’s other ‘684 and ‘214 marks. I will therefore continue to refer only to the opponent’s ‘185 mark.

Visual comparison

83. In its submissions filed in the evidence rounds, the opponent submits that the marks are visually similar to a high degree due to the coinciding letters “CHI” which constitute three quarters of the dominant component of the applicant’s mark. It also argues that “the beginning of a sign has a significant influence on the general impression made by the mark”. The opponent also contends that “the letter “I” in the prior marks is easily overseen by the average consumers due to the virtual form of the letter, being visually inferior to the remaining letters in the prior marks”. In its submissions filed in Kiam Richards’ witness statement, the applicant argues that the competing marks bear no visual similarity to each other due to the “visual distinctiveness of “Chi” vs “ICHI””.

84. The competing marks are visually similar as both contain the letters “CHI”. The marks differ visually as the opponent’s mark also contains “I” before the letters “CHI”, and the applicant’s mark also contains the word “CLOTHING” as its second word. Whilst I acknowledge the descriptive nature of the word “CLOTHING”, it is not entirely

visually negligible either. This results in the lengths of the competing marks being different, with the opponent's mark being one word of four letters, and the applicant's mark being two words of three and eight letters respectively. I disagree with the opponent suggestion that the first letter "I" will be overlooked in the opponent's mark. The opponent has not explained in either sets of its submissions what it means by "due to the virtual form of the letter" and has not offered any evidence to support this statement. Instead, it is my view that finding that the initial "I" would be overlooked in the word "ICHI" constitutes an artificial dissection of the mark. Moreover, as the opponent acknowledges, the beginnings of words tend to have more visual and aural impact than the ends,[27] which, in my view, results in the visual difference created by the additional letter "I" as the first letter having a significant impact on the visual identity of the opponent's mark. It is my view that it is therefore less likely that consumers will overlook its inclusion in the opponent's mark. Bearing in mind my analysis of the marks' overall impressions, I am of the view that the marks are visually similar to a low to medium degree.

<u>Aural comparison</u>

85. In its submissions filed in the evidence rounds, the opponent argues that "they will be pronounced as "I – CHI", with a significant weigh (sic) of expression and phonetic on the element "CHI". The opponent also cites *Liberte* (T-206/12) and conjoined cases *Pensa Pharma* (T-544/12) and *Pharma* (T-546/12), and submits that "the average consumers will generally omit "CLOTHING" from their aural expressions of the contested mark due to the very virtue of descriptiveness related to "CLOTHING"". In its submissions filed in Kiam Richards' witness statement, the applicant submits that 'ICHI' "may be pronounced in multiple ways such as "i-she" or "itchy," depending on linguistic background", and that the word 'Chi' is "phonetically distinct".

86. The competing marks are similar as they both contain the one-syllable verbal element "CHI", which will be pronounced "chee". The marks are different as the opponent's mark also contains the letter "I" at the beginning of the mark. Whilst the opponent has argued that "significant weigh (sic) of expression and phonetic on the element "CHI"", it has not provided any evidence as to why this would be the case. It

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[27] See paragraph 81 of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

is my view that the average consumer would pronounce the word “I-CHI” (phonetically identical or similar to the English word “itchy”), with equal weight on each syllable.

87. The applicant’s mark also contains the word “CLOTHING”. In *Pensa Pharma v OHIM,*[28] the GC at [107] stated that:

> “…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 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.”

88. Moreover, in *Onyinye Udokporo v Enrich International Ltd,*[29] Phillip Johnson as the Appointed Person followed the GC’s approach, stating at [18] that:

> “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.”

89. It is my view that, as the word ‘CLOTHING’ is descriptive in relation to the class 25 goods, the average consumer would not articulate this word when saying the applicant’s mark. The beginnings of words tend to have more visual and aural impact than the ends,[30] which, in my view, results in the aural difference created by the additional letter “I” as the first letter in the opponent’s mark being more aurally significant. Bearing in mind my analysis of the marks’ overall impressions, I am of the view that the marks are aurally similar to a medium degree. If I am wrong in this finding, and the word ‘CLOTHING’ is pronounced, then it is my view that the marks are aurally similar to a low to medium degree.

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[28] Case T-544/12

[29] BL O/1141/25

[30] See paragraph 81 of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Conceptual comparison

90. In its submissions filed in the evidence rounds, the opponent submits that "none of the marks has a general or common meaning to the relevant public in the United Kingdom". In its submissions filed within Kiam Richards' witness statement, the applicant submits that ""Chi" (氣/气) is a term deeply rooted in Eastern philosophy, widely recognised to mean life force, energy, or spirit", and that ""ICHI" is a Japanese word meaning "one"". In its submissions in lieu, the opponent replies that the average consumer in the UK will not be aware of these meanings, and that the average consumer will either perceive "CHI" as "a short, invented word, or alternatively as a personal name".

91. The applicant also argues that ""ICHI" operates under a slogan "The self-expression tool," whereas ours, "Protect Your Energy," is conceptually and thematically different". However, the assessment of conceptual similarity should not take into account the purported current use of the mark. As I have previously explained, when assessing the likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark might be used if it were registered.[31] As a result, even though the applicant has suggested that the competing marks are used in conjunction with slogans, my assessment of conceptual similarity must not be limited to that. As it would be inappropriate to factor in the current use of the competing parties' marks in combination with additional components when assessing the marks' similarity, I have disregarded this point.

92. The Oxford English Dictionary defines the word "Chi" in several ways, including as the "circulating physical life-force whose existence and properties are the basis of much Chinese philosophy and medicine". Although I acknowledge that "Chi" is a dictionary-defined word, I am of the view that the average consumer of the goods (who is a member of the public at large) will not be aware of the specific meaning of the word. Whilst some consumers will understand the meaning of "CHI" or recognise it as a word connected to Chinese culture, it is my view that they do not form a significant proportion of consumers. Whilst some consumers may also recognise "Chi" as a shortening of a name, I am of the view that these consumers will also not form a

[31] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06

significant proportion of consumers. Instead, it is my view that the average consumer will view “Chi” in the applicant’s mark as an invented term. The average consumer will however recognise the word “CLOTHING” as an everyday, dictionary-defined term.

93. Although the applicant states that the opponent’s mark “ICHI” means “one” in Japanese, I agree with the opponent that the average consumer in the UK would not be aware of this meaning. Instead, I find that “ICHI” will be understood as an invented term which has no specific meaning in relation to the goods. The average consumer will therefore not assign conceptual meanings to the words “ICHI” or “CHI” in the competing marks, but will understand the second word “CLOTHING” in the applicant’s mark based on its ordinary dictionary meaning. On this basis, insofar as the marks convey any concept, the competing marks are dissimilar.

Distinctive character of the earlier trade mark

94. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV,*[32] the CJEU stated that:

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
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> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as

[32] Case C-342/97

originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

95. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

96. Although the opponent has filed evidence of use, I do not consider this evidence to be sufficient for the purposes of demonstrating that the opponent's mark had an enhanced degree of distinctive character at the relevant date of 3 September 2024. Whilst I acknowledge that the evidence demonstrates genuine use of the opponent's mark and sales of ICHI-branded goods into the UK, it is considered that the evidence does not show what share of the relevant market was held by goods sold under the opponent's mark. Whilst the evidence contains sales figures for 2019 to 2024, I am unable to ascertain how significant those sales were. On the face of it, the sales figures are likely to only represent a reasonably small proportion of the relevant UK market. Furthermore, although the evidence contains screenshots of the opponent's social media posts, it is my view that this is not sufficient to demonstrate the extent to which the average consumer of the goods within the UK has been exposed to the opponent's mark. In addition to this, the evidence contains no figures in relation to advertising spend in the UK. Taking all of these factors into account, it is my view that the evidence submitted does not support the establishment of enhanced distinctiveness. I therefore only have the inherent position to consider.

97. The opponent does not refer to a specific level of distinctiveness of its mark in any of the submissions made, but in its submissions filed during the evidence round, it refers to "the distinctiveness of the earlier mark".

98. As previously explained, the average consumer of the goods will perceive the word "ICHI" as an invented term with no specific meaning in relation to the goods. On this basis, it carries a high level of inherent distinctiveness.

Global assessment – conclusions on likelihood of confusion

99. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no set formula for establishing a likelihood of confusion between marks; it is a global assessment where a number of factors need to be borne in mind.

100. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful 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 that they have retained in their mind.

101. In its submissions filed during the evidence rounds, the opponent argues that "taking also into account the principles of interdependence and the imperfect recollection of the public at issue, there is reason to assume that the relevant public in the United Kingdom may be misled into thinking that the identical or similar goods and services bearing the highly similar conflicting signs come from the same undertaking or, as the case may be, from undertakings that are economically-linked". It therefore contends that there exists a likelihood of confusion, including a likelihood of association. In its submissions made in Kiam Richards' witness statement, the applicant states that there is no likelihood of confusion due to the visual and phonetic differences, the "culturally recognisable nature of "Chi"", and the different brand identity. He also highlights that there are "over 60 live marks using "Chi" or phonetically similar terms in the UK". He argues that "the fact that the opponent did not object to these marks when applying for their own registration undermines their claim of a likelihood of confusion".

102. I do not consider the applicant's comments regarding other "Chi" marks to be relevant for the purpose of assessing whether there is a likelihood of confusion. In *Zero Industry Srl v OHIM,*[33] the GC stated that:

> "73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '… there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71). "

103. As there is no evidence that the registered marks are in use or that consumers have become accustomed to differentiating between them, the existence of other registered marks cannot have any bearing on whether there exists a likelihood of confusion between the opponent's mark and the applicant's mark.

104. Earlier in this decision I found that the applicant's goods range from being similar to a low to medium degree to being identical to the opponent's goods. The average consumer of the class 25 goods will be the general public, as well as trade customers. The average consumer is likely to pay a medium degree of attention when purchasing the goods, although this may be slightly higher for trade customers. I have found the marks to be visually similar to a low to medium degree, aurally similar to a medium degree if the word "CLOTHING" is not articulated (or low to medium degree if it is articulated), and insofar as the marks convey any concept, they are conceptually dissimilar. The earlier mark has a high level of inherent distinctive character. The opponent's mark "ICHI" is a word-only mark, and therefore its overall impression lies solely in the word "ICHI". The applicant's mark "CHI CLOTHING" is also a word-only

[33] Case T-400/06

mark. Due to the descriptive nature of "CLOTHING", the word "CHI" plays a greater role in the mark's overall impression.

105. It is considered that the average consumer paying a medium level of attention would not overlook the visual and aural differences between the two competing marks "ICHI" and "CHI CLOTHING". In particular, the key visual and aural differences between the dominant components of the marks' overall impressions exist at the beginning of the mark, where differences have more visual and aural impact than the ends. Furthermore, whilst the word "CLOTHING" is descriptive, it is not entirely negligible either and still contributes to the overall impression of the applicant's mark. Although the opponent's mark is highly distinctive, it is my view that the noticeable visual and aural differences are likely to prevent the average consumer from mistaking one mark for the other, especially when paying a medium level of attention. I therefore find that there is no likelihood of direct confusion, notwithstanding the identical nature of some of the goods.

106. This leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc,*[34] Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

[34] BL O/375/10

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)."

107. I bear in mind that these categories are not intended to be an exhaustive list. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors,*[35] Arnold LJ approved Mr Purvis's formulation but added:

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

108. It is not sufficient that a mark merely calls to mind another mark (as per *Duebros Limited v Heirler Cenovis GmbH).*[36] This is mere association not indirect confusion. A

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[35] [2021] EWCA Civ 1207
[36] BL O/547/17

finding of indirect confusion should not be made merely due to a shared element within marks. As per *L.A. Sugar Limited v By Back Beat Inc*[37] (set out above), indirect confusion should be identified in cases where the average consumer is likely to notice the differences between the competing marks but assume an economic link between the two undertakings based on their similarities.

109. It is my view that the average consumer would notice the differences between the two marks but would not assume an economic link between the two undertakings. The visual and aural differences between the competing marks are not consistent with a brand extension or sub-brand of a house mark, so I do not consider it likely to be interpreted in this manner by the average consumer. In particular, I can see no reason why an undertaking would take a distinctive invented word "ICHI" and alter it to "CHI CLOTHING", resulting in what would be understood by the average consumer as a different invented word and a different mark. Moreover, whilst the opponent's mark could fairly be described as strikingly distinctive, the average consumer is likely to appreciate the differences between the verbal elements in the marks, and therefore the circumstances in which the average consumer could assume that only the opponent would be using "ICHI" in a trade mark would not arise, as they would not imperfectly recall "CHI CLOTHING" as "ICHI". I therefore find that there is no likelihood of indirect confusion between the competing marks.

Conclusion

110. The opposition under section 5(2)(b) has failed in its entirety. Subject to any successful appeal, the application will continue to registration.

Costs

111. As the opposition has been unsuccessful, ordinarily the applicant would be entitled to an award of costs. However, as it has not instructed professional representatives, it was invited by the Tribunal to indicate whether it intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings. It was made clear by letter dated 28 July 2025 that, if the pro-forma was not completed by 25 August

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[37] BL O/375/10

2025, costs may not be awarded. The applicant did not return a completed pro-forma to the Tribunal and, on this basis, no costs are awarded.

Dated this 25th day of March 2026

K SERRAVALLE

For the Registrar