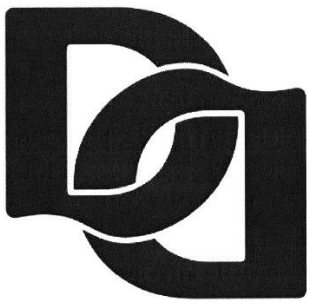
O/0583/26

TRADE MARKS ACT 1994

IN THE MATTER OF THE UK DESIGNATION
OF THE INTERNATIONAL REGISTRATION
NO. WO0000001771471
IN THE NAME OF DEICHMANN SE
FOR THE TRADE MARK:



IN CLASSES 18 AND 25

AND

THE OPPOSITION THERETO
UNDER NO. 447150
BY
DUNE BRAND LIMITED

BACKGROUND & PLEADINGS

1. Deichmann SE ("the holder") has sought protection in the UK for the International Registration no. WO0000001771471 ("the contested mark") in respect of the mark shown on the front page of this decision with a UK designation date of 1 December 2023 and a priority date of 27 September 2023 from Germany.[1] The contested mark was accepted and published in the Trade Marks Journal for opposition purposes on 26 January 2024 in respect of the following goods:

   Class 18: Folding briefcases; briefcases; holdalls; bum bags and hip bags; bags for campers; attaché cases; travel luggage; vanity cases sold empty; travelling sets; straps for handbags; saddle bags; cosmetic purses; shoulder bags; beach bags; bags; handbags; reusable shopping bags; sports and leisure bags not adapted to their content; rucksacks; trunks and suitcases; travelling bags; make-up cases sold empty; school bags; satchels; purses; wallets; key cases; umbrellas; parasols.

   Class 25: Clothing; footwear; headgear; insoles.

2. On 26 April 2024, Dune Brand Limited ("the opponent") opposed the contested mark on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").[2] For Sections 5(2)(b) and 5(3) grounds the following UK trade mark is relied upon:

[1] Trade mark from which priority claimed 30 2023 012 979.

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

Trade Mark no.	UK00003793134
Trade Mark	
Goods for which the mark is registered	**Class 18:** Leather and imitations of leather; luggage, bags, wallets and other carriers; trunks and travelling bags; suitcases; tote bags; shoulder bags; holdalls; briefcases; satchels; messenger bags; rucksacks; backpacks; backpacks with rolling wheels; carry-on bags; baggage tags; handbags; clutch bags; evening bags; beach bags; canvas bags; cross-body bags; overnight bags; leather bags and wallets; purses; card wallets; key cases; business card cases; toiletry and cosmetic bags, sold empty; vanity cases, sold empty; wash bags for carrying toiletries; umbrellas and parasols; bags for umbrellas; shoulder belts [straps] of leather; luggage straps. **Class 25:** Clothing, footwear, headwear; insoles for footwear; belts [clothing]; leather belts [clothing]; face masks [clothing].
Filing date	27 May 2022
Date of entry in register	28 October 2022

3. Under Section 6(1) of the Act, the opponent’s mark clearly qualifies as an earlier trade mark. The earlier mark had not been registered for five years or more before the designation date of the contested mark, and as a result it is not subject to the proof of use requirements as set out in Section 6A of the Act.

4. For the purposes of the claims under Sections 5(2)(b) and 5(3), the opponent relies upon all the terms in its specification.

5. Under Section 5(2)(b) of the Act, the opponent claims that, due to the high degree of distinctiveness of the earlier mark, the similarity between the competing marks and the identity/similarity between the competing specifications, a likelihood of confusion is inevitable.

6. Under Section 5(3), the opponent claims that in light of the reputation of the earlier mark "the identity and/or similarity" between the competing marks is such that the relevant public will believe that the goods emanate from the same undertaking, are provided with the opponent's consent, or there is an economic connection between the two users. It also contends that use of the respective goods is without due cause, and unfair advantage would be conferred to the holder as a result of the similarity between the significantly reputable earlier mark and the contested mark. The opponent also argues that it will be unable to control the quality of the goods by the holder and, if that quality is inferior, the distinctive character and repute of the earlier mark will be damaged. Lastly, the use of the contested mark will be detrimental to the distinctive character of the earlier mark by way of dilution.

7. Under Section 5(4)(a) of the Act, the opponent relies upon the following signs:

and

The opponent claims to have used them throughout the UK since year 2022 in relation to the same terms as they appear in Classes 18 and 25 of the earlier mark. It claims that the opponent has goodwill in its signs and the use of the contested mark would be contrary to the law of passing off.

8. In response, the holder filed a counterstatement. Under Section 5(2)(b), the holder denied similarity in relation to the competing marks and goods. Thus, it asserted that there will be no likelihood of confusion.

9. Under Section 5(3), the holder made no admission as to the reputation of the earlier mark and denied a link would be made between the marks. It also claimed that the contested mark is a variant of the holder's brand (), which "*has accrued an enviable reputation throughout Europe (including acquiring 'well known' status in the Applicant's home country, Germany). In this context, the Applicant has due cause to apply for and to use the mark the subject of the Application for the goods covered by the Application*."

10. Under Section 5(4)(a), the holder made no admission as to whether the earlier rights have accrued goodwill, while denying that the use of the contested mark will amount to misrepresentation that would cause damage to the opponent's reputation or goodwill or cause actual or foreseeable financial or reputational loss.

Evidence Filed and Representation

11. Only the opponent filed evidence in these proceedings. This comes in the form of a witness statement from Alice Arnold, who has been an employee since 17 July 2010 and commenced the role of Chief Financial & People Officer on 1 January 2024. Her witness statement is dated 10 October 2024 and is accompanied by 17 exhibits (Exhibits AA01-AA017). The purpose of the evidence is to prove enhanced distinctiveness, reputation and goodwill in the earlier mark and signs.

12. I have taken the above evidence into account in reaching my decision and will refer to the pertinent points below, where necessary.

13. The matter came to be heard by me via video conference on 5 November 2025. The holder was represented by Mr Jamie Muir Wood of Counsel,

instructed by Reddie & Grose LLP, and the opponent by Ms Eleanor Merrett of CMS Cameron McKenna Nabarro Olswang LLP.

Preliminary Matters

14. I note that the holder's evidence contains a copy of the EUIPO Opposition Division decision No B 3 217 629 involving the same contested mark and an earlier EUTM, which appears to be the same mark relying on the same goods in Classes 18 and 25 as the earlier mark in these opposition proceedings. The EUIPO Opposition Division found the marks to be visually similar to a low degree, aurally identical, and the conceptual comparison not being possible. This decision resulted in a finding that there exists no likelihood of confusion between the marks. However, I note that, at the hearing, Ms Merrett mentioned that the EUIPO decision is under appeal. In addition, Ms Merrett sought leave to file the holder's EUIPO submissions as late evidence in these proceedings, pointing out that the holder in its EUIPO submissions referred to the contested mark as the capital letter "Ds".[3] I note that Mr Muir Wood agreed to the admission of the late evidence. Although I granted this request at the hearing and have considered the EUIPO decision and the respective submissions, they are not relevant to the current assessment or to the decision I must make in this present case. This is because I am not bound by decisions of the EUIPO or any written submissions made by the parties in the EUIPO proceedings. In the same vein, I have considered the decisions of the Tribunal referenced by the opponent, which are, of course, determined on their own facts, and are, anyway, not binding or strong precedent for other cases before the Tribunal. Instead, my decision will be based on a multifactorial assessment of the relevant factors and the merits of this present case. Thus, I shall say no more about the EUIPO or the Tribunal decisions.

[3] I note that, at the hearing, Mr Muir Wood did not object to Ms Merrett's request to file late evidence.

15. I also acknowledge that, during the hearing, Ms Merrett argued that the WIPO Register denotes the contested mark as ‘DD’ on the Madrid Monitor. She posited that the holder presumably regarded the mark as two ‘D’ letters when applying for the contested mark. On this point, I agree with Mr Muir Wood’s submissions that this is irrelevant to the current assessment, as I shall consider this matter based on how the average consumer would perceive the marks, rather than the manner in which they are recorded on the WIPO Register or any other Register.

16. Lastly, I note that the holder in its counterstatement put forward a due cause claim in light of the earlier use of the single ‘D’ sign. However, at the hearing, Mr Muir Wood conceded with Ms Merrett’s submissions that the holder did not provide any evidence to support this claim, and therefore, it cannot proceed any further.

DECISION

Section 5(2)(b)

17. Section 5(2)(b) of the Act states:

> “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.”

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of Goods

19. In his skeleton argument and at the hearing, Mr Muir Wood admitted that the competing goods are identical either directly or in accordance with the *Meric* principle.

Average Consumer and the Purchasing Act

20. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

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

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

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

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by 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."

21. The parties agree that the average consumer will be a member of the general public paying a medium degree of attention when selecting the goods at issue.

22. Such goods are usually offered for sale in stores, such as retail outlets, brochures and catalogues, and online. In retail premises, the goods will be

displayed on shelves and racks, where they will be viewed and self-selected by consumers. Similarly, for online stores, consumers will select the goods relying on the images displayed on the relevant web pages. Nevertheless, the selection process may involve aural considerations, as advice may be sought from a sales assistant or representative. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment.[4]

Comparison of Trade Marks

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

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

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

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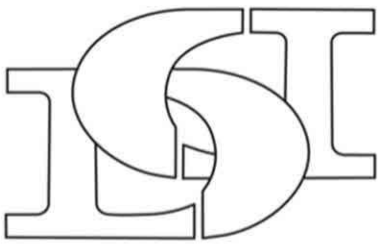
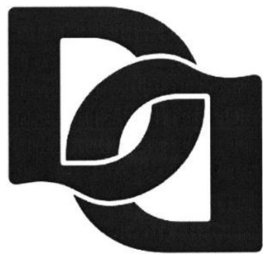
[4] See *New Look Ltd v OHIM Cases* T-117/03 to T-119/03 and T-171/03, at paragraph 50.

25. The marks to be compared are:

Earlier Mark	Contested Mark
	

<u>**Overall Impression**</u>

26. The parties disagree on how the average consumer would perceive the competing marks. In summary, Ms Merrett argued that the competing marks will be seen by the significant proportion of consumers as two interlocked ‘D’ letters. However, Mr Muir Wood’s primary position was that the earlier mark will be seen as segments of overlapping shapes or blocks in outline form and the contested mark as two links of a chain or interlocking black devices in the style of an Maurits Cornelis Escher drawing, being “*continuous devices which have somehow been linked together such that they cannot be pulled apart*.”[5] Alternatively, Mr Muir Wood asserted that the earlier mark will be seen (from left to right) as the ‘L’, ‘C’ and ‘I’ letters, and the contested mark as two interlocked ‘D’ letters.

27. The earlier mark is a figurative mark. Mindful of the need not to dissect a mark, I consider that a significant proportion of consumers will understand the mark as a whole featuring an outline of two interlocked ‘D’ letters, even if it may take a little work to make out the letters in the mark. I note that the left ‘D’ letter faces forward, while the right ‘D’ is flipped 180 degrees, facing

[5] Page 25 of the transcript.

the opposite direction. Also, the letters overlap at the top right of the forward-facing ‘D’. I consider that the overall impression rests in the mark as a whole, with no single letter being more dominant than the other.

28. The contested mark is a figurative mark. In the absence of evidence, I do not consider that this will constitute a significant proportion of average consumers who would perceive the contested mark as two links of a chain or as devices resembling an Escher-style patterned drawing. Instead, it is my view that the significant proportion of consumers will recognise the mark to be featuring two stylised interlocked ‘D’ letters in black with white outline. Again, in this case, the left ‘D’ faces forward, while the right ‘D’ is again flipped 180 degrees, facing the opposite direction. Further, there is an overlap at the bottom right of the forward-facing ‘D’. I consider that the overall impression of the mark lies in its entirety, with no single letter being more dominant than the other.

Visual Comparison

29. Visually, even though the competing marks contain two interlocked ‘D’ letters, their stylisation and position of the overlapping letters (top right vs bottom right) will be points of visual difference in the marks. At this point, I note that a mark registered in black and white provides protection of that mark in any colour.[6] Thus, the colour of the marks would, in my view, be covered by normal and fair use. I find that the marks are visually similar to between a low and medium degree.

Aural Comparison

30. Aurally, I agree with Ms Merrett’s submissions that the average consumer will articulate the verbal elements of the competing marks identically as two ‘D’ letters.

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[6] See *Specsavers International Healthcare Limited & Ors v Asda Stores Limited*, [2014] EWCA Civ 1294 and *J W Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, paragraph 47.

Conceptual Comparison

31. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court and the CJEU, including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

32. Ms Merrett argued that the marks are conceptually identical as they consist of two 'D' letters. As outlined above, while I accept a significant proportion of the average consumer will perceive that the competing marks are made up of two interlocked 'D' letters, they will not attribute any further meaning to the competing marks. Bearing in mind that a letter per se does not convey a clear concept in the sense described in the case law,[7] the position would be, effectively, the same in this present case, even if the marks would be seen as two interlocked letters with stylisation. The conceptual position is, therefore, neutral. For completeness, the stylisation and colour elements in the respective marks do not create a conceptual difference and will not convey any particular meaning.

Distinctive Character of the Earlier Trade Mark

33. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

> "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

[7] See, for example, *Poloplast v OHIM — Polypipe (P)*, Case T-189/09, at paragraph 83.

Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49).

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

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

35. The opponent in its statement of grounds puts forward that the earlier mark is inherently distinctive to a high degree. However, Mr Muir Wood submitted that the inherent distinctive character of the earlier mark is normal.

36. Aside from being recognised as two interlocked 'D' letters, the mark has no suggestive or descriptive relevance to the registered goods. Taking into account the stylisation of the mark, I find that the mark as a whole is inherently distinctive to a medium degree. I will now proceed to the assessment of enhanced distinctiveness of the earlier mark.

Enhanced Distinctiveness

37. Ms Merrett claimed that the earlier mark has acquired an enhanced distinctive character. However, Mr Muir Wood disputed the claim that the distinctive character of the earlier mark has been enhanced, drawing my attention to the criteria set out in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247. Mr Muir Wood, in his skeleton argument and at the hearing, challenged the opponent's evidence, and I will return to this matter later in this decision.

38. Having reviewed the evidence, I note that certain pieces are undated[8] or postdate the relevant date.[9] However, I accept that evidence dated after the relevant date may shed light on the position at the relevant date,[10] but I do not see that this applies here. This is because the evidence postdating the relevant date does not show, for example, that the exact same goods were made available on the opponent's or third-party distributor websites before the relevant date.[11] Further, there are instances in the evidence where the goods bear a different brand/sub-brand[12] or the earlier mark is not visible or legible on the goods.[13] At this point, I note that use in variant forms,[14] for example, solid versions in different colours or textures (including metallic or leather), would be permissible. It is my view that these variant elements are secondary to the mark's get-up and do not alter its distinctive character. However, I do not consider that the 'D' letters interlocking in a different position (as shown below) would constitute use of the earlier mark. Such use alters the distinctive character of the earlier mark, and I find this to be an unacceptable variant. Therefore, I will not make any reference to such exhibits, and my summary below will focus on

[8] For example, the photographs under paragraph 16 of the witness statement regarding the Dune's Lakeside store and Dune's Marble Arch store.
[9] For example, Exhibit AA-06 pages 3-5, Exhibit AA-07, Exhibit AA-08 pages 1-3, Exhibits AA-12-14, Exhibit AA-08 pages 1-8 are not dated with a year.
[10] *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16.
[11] For example, I note that Exhibit AA-07 shows goods for the 2024 season.
[12] See for example Exhibit AA-01 pages 2-11, Exhibit AA-09 page 7, and Exhibit AA-17 page 5.
[13] See for example Exhibit AA-17 page 5 and 8 (OK! March 2023).
[14] See *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22.

the evidence that falls within the relevant date and concerns the mark relied upon.

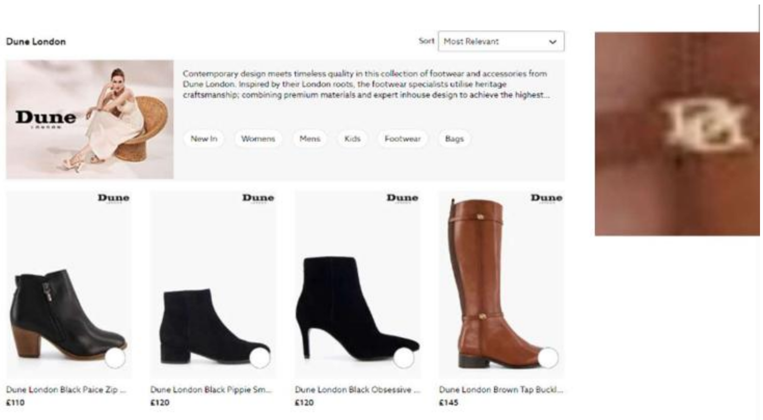


Exhibit AA-06

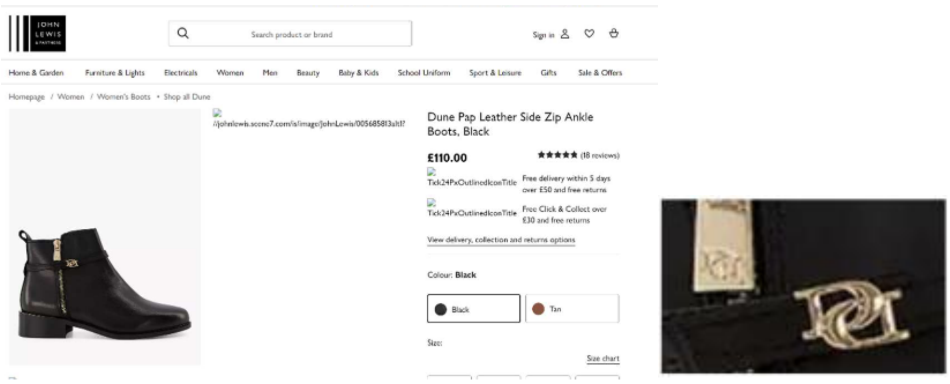


Exhibit AA-06

Exhibit AA-17

39. In her witness statement, Ms Arnold provides the background of the opponent in the following terms:

"3. The Dune business […] encompasses several companies including Dune Holdings Limited and Dune Brand Limited which I will refer to in this statement as Dune.

[…]

11. Dune was founded in 1992 by Daniel Rubin whose family lineage is in shoe manufacturing. His vision was to create an affordable luxury footwear and accessories brand and Dune celebrated its 30-year anniversary in 2022.

12. The business began as a small concession store on London's iconic Oxford Street which quickly accelerated to its first standalone store on the King's Road in London in 1993.

13. Since then, its presence has grown to over 142 store locations worldwide. Produced and shown to me at Exhibit AA-02 is a timeline of the brand's heritage, marking various milestones over the years."

40. Ms Arnold also provides a brief overview of the signs that the opponent has used over the years, explaining that the sign was used as an abbreviation of its house brand, Dune, along with other variations, including the back-to-back 'D' letters and the earlier mark in question. She indicates that the use of the earlier mark commenced in 2021 and it has been extensively featured across Dune's product range. This, according to the witness, includes footwear (on both the inner and outer soles, across the back as a monogram, and on zip pulls), bags (stamped or embossed into the product, used as a monogram, and incorporated into the metal hardware) and accessories. In addition, it is highlighted that the opponent currently operates 48 standalone stores across the UK, such as Glasgow, Cardiff, Leeds, London, Bristol, and Belfast, and 70 concessions in department stores, such as John Lewis, Selfridges, Boundary Mill, Fenwicks and in the Morley's group of department stores. Ms Arnold provides **Exhibit AA-03** and **Exhibit AA-04**, which list these stores in the UK from 2021 to 2024.

41. **Exhibit AA-05** includes three screenshots from a YouTube video titled "DUNE HAND BAGS at JOHN LEWIS | LATEST COLLECTION 2022 […]" from the YouTube account 'GazingPearl Life'. One of the screenshots is dated 19 August 2022, while the other two are marked as "2 years ago", where the earlier mark can be seen prominently on the front of the bags.

42. **Exhibit AA-06** contains clippings from the opponent's website *dunelondon.com* in GBP. I note that clippings of the goods shown in pages 1 and 2 dated 2021 and 2022, respectively, showcase bags featuring the earlier mark. For the clippings dated with year 2023, it is not specified whether they were taken before or after the relevant date. However, I can cross-reference with Exhibit AA-17 that the silver and gold metallic leather bags were available prior to the relevant date. I reproduce the relevant images from the exhibits:

Dune London Duchess 140 GBP premium gold leather www.dunelondon.com

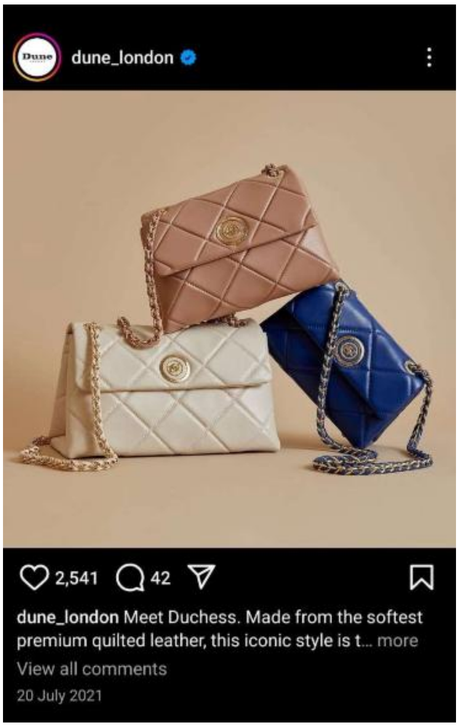
Dune London Duchess S 120 GBP silver metallic leather www.dunelondon.com

new! Magazine 18.04.23 – Duchess S & Duchess

Exhibit AA-06 Exhibit AA-17

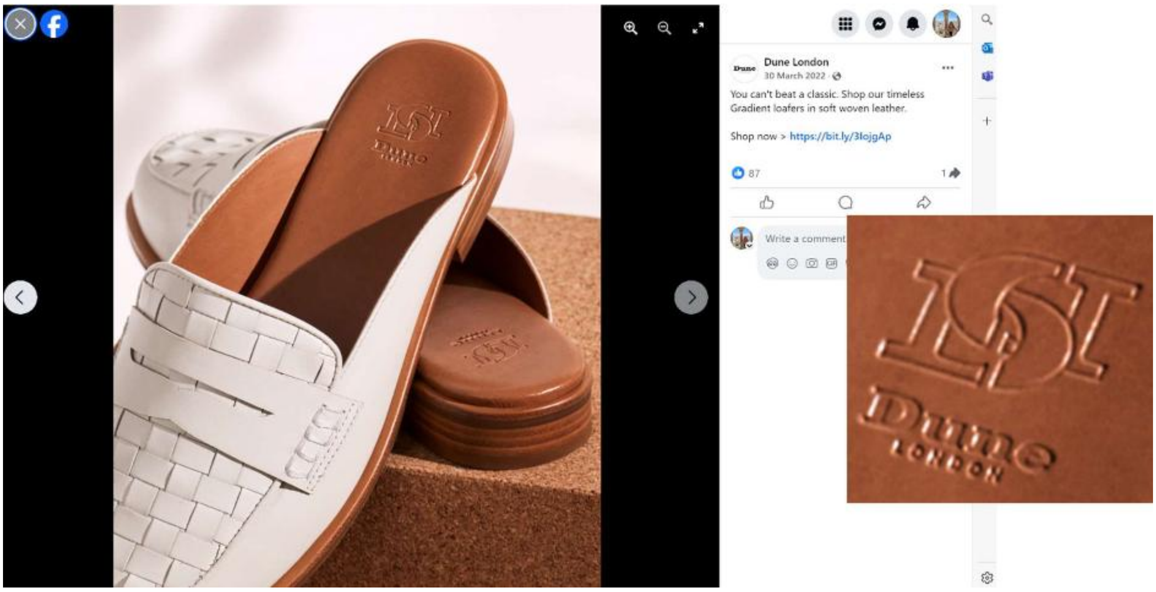
43. The opponent also uses social media and press coverage to promote its goods:

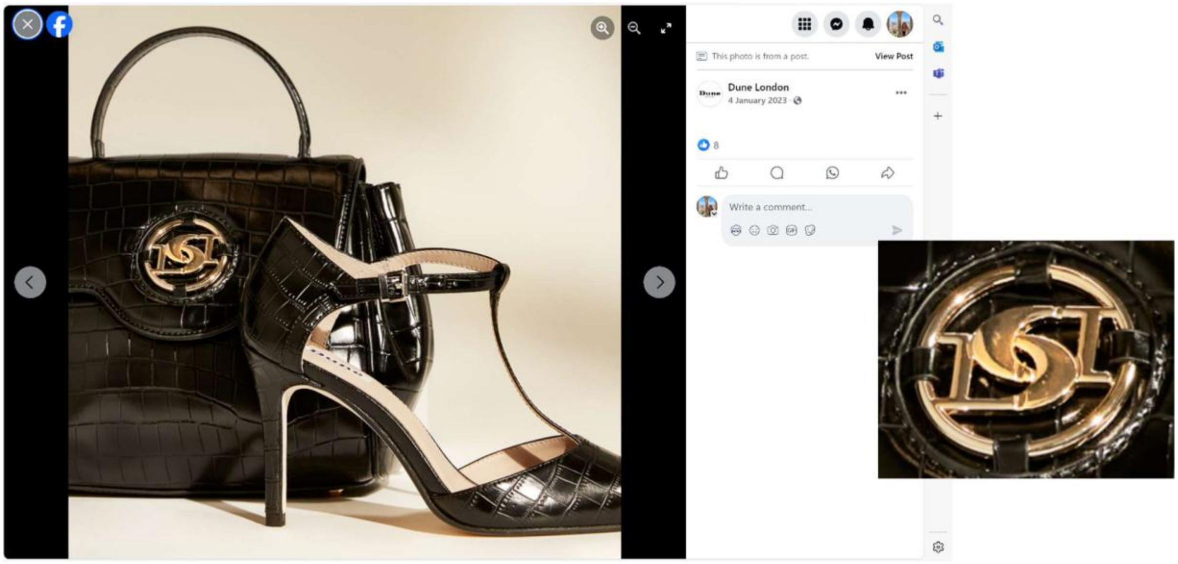
(i) **Exhibit AA-09 and Exhibit AA-15** include screenshots from the opponent's Instagram account 'dune_london'. I take into account those posts that are dated from before the relevant date (i.e. 27 September 2023), which demonstrate the opponent's goods, including bags, women's shoes, sunglasses, winter hat, trainers, and sandals[15] featuring the earlier mark. While there is no indication of how many followers the account had at the relevant date, the posts had gathered hundreds of likes, with some exceeding 2K likes. For example, the Instagram post below is dated 20 July 2021 and had received 2,541 likes and 42 comments.



(ii) The Facebook posts, provided with **Exhibit AA-16**, that are dated with a full date (and before the relevant date) relate to sandals, bags, and women's shoes. I note that these posts had accumulated significantly fewer likes compared to Instagram posts, with most getting only a handful to fewer than a hundred likes. Some examples are reproduced below.

[15] I have also considered those instances where the earlier mark is shown in the insoles of the sandals.





(iii) Exhibit AA-17 contains a compilation of press clippings from publications such as OK!, Woman, Evening Standard, *irishnews.com*, and new!. These clippings demonstrate various bags and boots that bear the earlier mark, in what appears to be style edits or "shop the look" advertisements. Additionally, the exhibit includes screenshots of Instagram posts (see examples below) from the account @bartabacmode, which received over 7K likes for a bag featured therein. While the image quality is low, rendering the mark indistinct, I am able to cross-reference the above Instagram posts and the Instagram post contained in Exhibit

AA-15 (shown below) to confirm that the bag depicted is, in fact, the same one bearing the earlier mark.

Exhibit AA-17

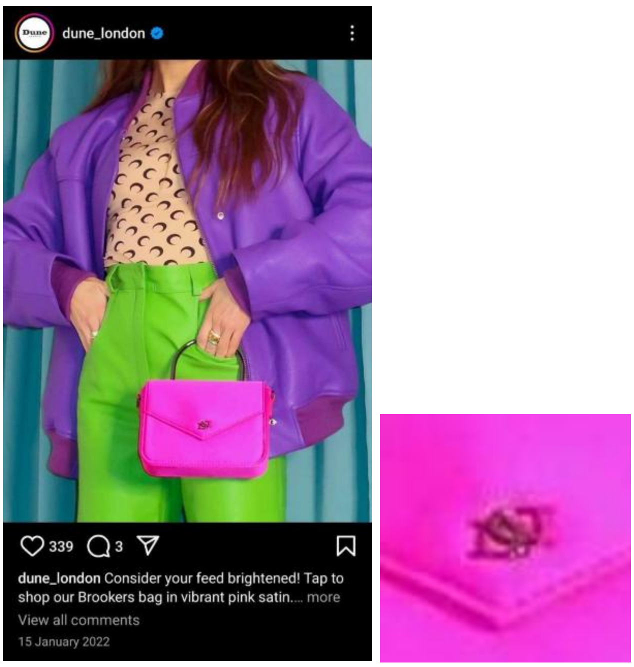


Exhibit AA-15

44. Ms Arnold provides with her witness statement the following sales figures:

(i) For footwear, the total net sales were significantly increased over the years based on the table shown below. Ms Arnold mentions that these figures "*also include the sale of footwear featuring [the earlier mark]*". This indicates that the numbers pertain to the entire Dune brand, along with its sub-brands, rather than solely to the earlier mark itself. However, I note that Ms Arnold further states that:

> "*Whilst the financial data on individual styles of shoes is not in the public domain, I have been informed that since 2021, Dune has accrued over **£5million** in sales on six leading styles of footwear all prominently featuring the DD Trade Mark which includes two styles in boots, three styles in shoes and one style in trainers. Sales of all footwear featuring the DD Trade Mark will well exceed this number."*[16]

	2020/2021	**2021/2022**	**2022/2023**	**2023/2024**
Store sales (standalone & concessions)	22,324,781	34,779,471	48,542,218	50,116,450
Web sales	17,825,027	20,839,268	24,074,411	26,019,452
Wholesale & Other	1,335,786	8,983,479	9,311,123	6,748,452
TOTAL	**41,485,593**	**64,602,218**	**81,927,752**	**82,884,355**

(ii) For accessories, which the witness identifies as being encompassed by various fashion items, including bags, bumbags, card holders, laptop bags, leather belts, luggage, make up/wash bags, passport holders, pouches, purses, umbrellas, vanity cases and wallets, the total net sales have seen a significant increase over the years. Similarly, here, Ms Arnold mentions that these figures "*also include the sale of footwear featuring [the earlier mark]*", which I consider to be an indication that the figures concern the entire Dune brand, including its sub-brands, rather than the earlier mark itself. Again, in this case, Ms Arnold states that:

> *"Whilst the financial data on particular styles of handbags is not in the public domain, I have been informed that since 2021,*

[16] See paragraph 30 of the witness statement.

*Dune has accrued over **£5.2 million** in sales across 21 leading styles of handbag featuring the DD Trade Mark. Sales of all handbags featuring the DD Trade Mark will well exceed this number.*"[17]

	2020/2021	2021/2022	2022/2023	2023/2024
Store sales (standalone & concessions)	4,544,609	6,323,691	10,357,981	10,635,436
Web sales	2,010,870	2,448,336	3,364,544	3,024,831
Wholesale & Other	1,950,760	5,567,154	6,844,580	7,236,303
TOTAL	**8,506,239**	**14,339,180**	**20,567,106**	**20,896,569**

45. Further, Ms Arnold provides figures of advertising expenditure in GBP across the different channels of business[18] from 2021 to 2024 for the entire Dune network (not separated per brand).

	2020/2021	2021/22	2022/23	2023/24
Dune web & Third party web	3,794,571	3,722,837	4,045,242	3,948,153
Wholesale & other		80,699	49,334	5,822
Central	2,783,971	1,822,492	2,187,112	1,978,505
TOTAL	6,578,542	5,626,027	6,394,440	5,932,480

46. Lastly, a table of advertising spend on Facebook and Instagram across the entire Dune network (not separated per brand) is provided with the witness statement.

[17] See paragraph 33 of the witness statement.
[18] Namely print, social media, online advertisements, billboards and other out-of-home (OOH) media, and specific media campaigns.

Year	Number of unique users reached with our Ads in UK	Impressions
Total	36,701,506	403,225,332
2024 up to 8 September	6,269,521	89,167,139
2023	22,196,458	263,149,886
2021	3,688,920.00	29,072,342.00
2020	6,345,579.00	21,835,965.00
Total		**£451,895.00**

47. That concludes my summary of the evidence.

Conclusions on Enhanced Distinctiveness

48. In his skeleton, and during submissions at the hearing, Mr Muir Wood posited that the evidence of use is limited, raising various deficiencies in the opponent's evidence. He submitted that the sales figures and advertising spend were not broken down between the different brands/sub-brands, and that the sales figures do not distinguish between sales that took place before or after the relevant date. In this regard, Mr Muir Wood drew my attention to the principles set out in *Plymouth v Awareness Plymouth City Council*[19] and *easyGroup*. In addition, Mr Muir Wood submitted that although the opponent has a number of online and physical stores and concessions, it cannot be inferred from the evidence that goods bearing the earlier mark were offered in all of them prior to the relevant date. He also referred me to the General Court's decision in *K-Way SpA v. EUIPO*, Case T-372-24, where it was ruled that when several marks are used "*[t]hat fact may be capable of preventing the consumer from perceiving a link between the use of the mark represented on the stores' shop name and the goods marketed in those stores, to which the mark concerned has not been affixed*."[20] At this point, I reiterate that this decision is not binding upon me, being both findings of fact and a decision which postdates the IP Completion date. Another criticism levelled by Mr Muir Wood is that the wording of Ms Arnold in paragraphs 30 and 33 of the

[19] Case BL O/236/13.
[20] Paragraph 38.

witness statement (reproduced in paragraph 44 of this decision) is ambiguous, while questioning whether those sales figures fall within the relevant date. He further underscored that the evidence shows primarily use of a 3D, metallic, and leather embossed logo on the goods as opposed to the outline form of the mark as registered, which is primarily visible on insole of various shoes and sandals. Lastly, Mr Muir Wood submitted that there is a lack of evidence demonstrating any actual sales of products bearing the earlier mark.

49. The factors which are relevant to the assessment of enhanced distinctiveness are the following: 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; and the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking and statements from chambers of commerce and industry or other trade and professional associations.

50. From 2021, the mark as registered, or permissible variations of it, has been used primarily on footwear and bags, as evidenced by social media posts, press clippings, and the opponent’s website. Although the evidence includes a table of sales figures for footwear, the corresponding table for accessories is not broken down by individual products. Moreover, both tables present the total sales figures for the entire Dune brand, encompassing both the opponent’s house brand and sub-brands (including the mark relied upon). As a result, neither table specifies the proportion of sales associated with the mark in question, which is admittedly a sub-brand rather than the house brand.

51. Turning to Ms Arnold’s statement that the opponent, since 2021, has accrued over £5million in sales on six leading styles of footwear and over £5.2million in sales across 21 leading styles of handbag bearing the earlier mark, I note Mr Muir Wood’s criticisms in relation to this narrative evidence. However, I remind myself that the holder elected not to file evidence or

written submissions during the evidence rounds in these proceedings to challenge the opponent's evidence, including the above narrative evidence. Thus, I will treat this narrative evidence as unchallenged, while assessing whether it is sufficient to establish the opponent's claim to enhanced distinctiveness at the relevant date.[21] In light of this, it is reasonable for me to infer that at least a reasonable proportion of such sales were made prior to the relevant date. That said, I find that the narrative evidence is insufficiently supported by the documentary evidence presented in this case. In more detail, Ms Arnold did not provide examples of leading styles of footwear and handbags in question or disclose, for example, the specific names of those styles to enable me to corroborate, against the documentary evidence before me, whether such goods bear the mark as registered or acceptable variants thereof. I also note that no example invoices, which should be readily available to the opponent, were adduced as evidence to substantiate any sales of such goods. As such, I consider that the above sales figures concerning the leading styles of the given goods are insufficient, and it is not possible for me to infer from the evidence as a whole the relevance of those sales figures regarding the registered mark and goods. Further, the opponent has not provided the market share that it possesses for what is undoubtedly a very significant market. Notwithstanding the evidence that the opponent offered such goods in various physical retail outlets and through online channels, it is not possible to identify the extent of use of the mark relied upon within the UK.

52. The same reasoning applies to the advertising spend figures. According to Ms Arnold, the total advertising spend encompasses various brands of the opponent. Thus, it is not possible to ascertain the proportion of the overall figures that relates to the marketing/advertising expenditure associated with the earlier mark. Further, while Exhibits AA-10 and AA-11 consist of a summary report and a post-campaign analysis, respectively, for the period between 2021 and 2023, they both appear to relate to the opponent's

[21] *TUI v Griffiths* [2023] UKSC 48. The case is ostensibly about expert witness evidence, but it is clear from paragraph 42 of the judgment that it is not limited to expert witnesses.

overall advertising expenditure for the Dune brand at large, rather than the earlier mark itself. Although Ms Arnold indicates that "*this spend relates to a vast number of shoes and bags featuring the DD Trade Mark*", this does not assist. Nevertheless, there are press clippings from nationwide publications, including some online news outlets. However, I have not been provided with any information as to how many UK consumers would have been exposed to these publications. Whilst there is evidence of the opponent's social media posts, it is not clarified whether the likes and views of these posts derive from UK-based users. Even the reported figures of over 3million unique Facebook and Instagram users in the UK for 2021, which is the year the opponent commenced use of the earlier mark,[22] pertain to Dune adverts in general, not to the earlier mark as such. Even if I were to infer from the evidence that a proportion of these users encountered the earlier mark, it remains difficult to assess and determine whether the evidence shows significant exposure of the mark within the UK.

53. In considering the evidence of use as a whole, it is clear that the opponent operates a large business with substantial sales and marketing figures for the entire Dune brand. However, given the gaps in the evidence detailed above, it is not possible to establish that the distinctiveness of the earlier mark has been enhanced through use to any material extent for the average consumer.

Likelihood of Confusion

54. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.[23] It is essential to keep in

[22] See paragraph 7 of the opponent's witness statement.

[23] See *Canon Kabushiki Kaisha*, paragraph 17.

mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.[24]

55. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

56. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis QC, sitting as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

[24] See *Lloyd Schuhfabrik Meyer*, paragraph 27.

(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)."

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.[25]

57. I recognise that there must be a proper basis for finding indirect confusion.[26] I also acknowledge that such a finding should not be made merely because the competing marks share a common element. It is not sufficient that a mark merely calls to mind another mark.[27]

58. Earlier in this decision I have concluded that:

- the competing goods are identical;
- the average consumer of the goods will be a member of the general public. The selection process is predominantly visual without discounting aural considerations. The degree of attention will be medium for the respective goods;

[25] See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.
[26] Ibid.
[27] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

- the competing marks are visually similar to between a low and medium degree, aurally identical, and conceptually neutral;
- the earlier mark has a medium degree of inherent distinctive character, and it was not enhanced above that degree.

59. The opponent claims that there is a likelihood of direct and indirect confusion because the contested mark will be viewed as a brand variant or a refreshed version of an existing brand. Mr Muir Wood, in his submissions, disagreed.

60. Taking all of the above into consideration, the factors persuade me that there is a likelihood of direct confusion for identical goods. I note that the identical goods at play are primarily selected via visual means, with the average consumer paying a medium degree of attention. I also bear in mind that the average consumer does not dissect the marks, and the overall impression of the competing marks lies in them as a whole. Given that consumers rarely have a chance to compare marks side by side and will instead encounter them in different settings at different times, I am satisfied that they will be imperfectly recalled. This is because the common presence of the interlocked 'D' letters (facing each other) will have a lasting impact on consumer's mind, and the stylisation and positioning of the overlapping letters may be overlooked or misremembered. In light of the principles of imperfect recollection and interdependence, a significant proportion of consumers may be directly confused and mistake the contested mark for the earlier mark or vice versa. For completeness, I consider that even when the average consumer encounters the marks aurally (e.g. in a physical retail store setting), they will directly confuse them as a result of their aural identity.

61. Turning to indirect confusion, I bear in mind that there should be a proper basis for a finding of a likelihood of indirect confusion. Even if the differences between the marks are identified, the common presence of the interlocked 'D' letters is likely to lead a significant proportion of consumers to conclude that the marks originate from the same or economically linked

undertakings, particularly as the goods are identical. Whether consciously or unconsciously, this will lead the average consumer through the mental process described in *L.A. Sugar*. In particular, it is my view that the difference in the stylisation and position of the overlapping letters of the contested mark is likely to be viewed as a variation of the earlier mark. For example, the contested mark may be perceived as a variant designed for a particular product line (e.g. shoes) to distinguish them from one another.[28] Further, I consider that it is not uncommon for undertakings in the fashion industry to rebrand themselves from time to time to accommodate changes in marketing considerations. Therefore, I am satisfied that the use of the interlocked 'D' letters in this case is unlikely to be perceived as merely coincidental. Consequently, I consider there to be a likelihood of indirect confusion.

Final Remark

62. At the hearing, and in her skeleton argument, Ms Merrett sought to rely upon a likelihood of post-sale confusion. Since I have already found that there is a likelihood of confusion, both direct and indirect, I do not consider that an assessment of post-sale confusion would take the opponent's case any further. Thus, I will proceed to the assessment of the next ground.

63. The opposition under this ground succeeds.

Section 5(3) of the Act

64. Section 5(3) of the Act states:

> "(3) A trade mark which-
>
> (a) is identical with or similar to an earlier trade mark,
>
> […]

[28] See *New Look Limited* at paragraph 51.

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

65. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

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

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

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

66. The conditions of Section 5(3) are cumulative. First, the opponent must show that the marks are similar. Second, the opponent must show that the earlier mark has achieved a level of knowledge, or reputation, amongst a significant part of the public. Third, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the holder's mark. Finally, assuming the first three conditions have been met, Section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of Section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. The relevant date for the assessment under Section 5(3) is the priority date of 27 September 2023 of the contested mark.

<u>Similarity between the marks</u>

67. The opponent relies on the same mark and goods here as it did under its Section 5(2)(b) ground. I have already assessed the similarity between the marks for the purposes of the opposition. I adopt those findings[29] as they apply equally here.

<u>Reputation</u>

68. In *General Motors*, Case C-375/97, the CJEU held that:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the

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[29] See paragraphs 29-31.

public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

69. At this point, I note that, at the hearing, Ms Merrett put forward a narrower claim of reputation in respect of footwear and bags only. Whilst enhanced distinctiveness and reputation are different,[30] the factors relevant to both assessments are the same. The evidence fell short of establishing such a claim, and I consider that this is also the case with regards to reputation.

70. The section 5(3) ground is dismissed.

Section 5(4)(a)

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

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

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

[30] *Enterprise Holdings Inc. v Europcar Group UK Ltd* [2015] EWHC 17 (Ch), Arnold J (as he then was).

(aa) […]

(b) […]

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

72. Subsection (4A) of Section 5 states:

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

Relevant date

73. The contested mark has a priority date of 27 September 2023, and that date is the relevant date. However, if the holder had used its mark prior to this date, then this use must also be taken into account.[31] As outlined earlier in this decision, the holder has not filed any evidence in these proceedings. Consequently, the opponent must show that it had goodwill in a business at the priority date, that is on 27 September 2023, and that the signs relied upon are associated with, or distinctive of, that business.

Goodwill

74. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217, at paragraph [224]:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation

[31] See *Advanced Perimeter Systems v Keycorp Limited* (MULTISYS), BL O-410-11, paragraph 43.

and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates."

75. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC (as he then was), as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

> "[...] a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

Does the evidence show that the opponent had protectable goodwill at the relevant date?

76. I bear in mind that the test for the existence of goodwill is far less onerous than the ones conducted above for enhanced distinctiveness and reputation. In *Mercis BV v Bunnyjuice* Inc, BL O/0064/24, Dr Brian Whitehead, sitting as the Appointed Person, said:

> "57. […] In trade mark law, the analysis of proof of use, reputation and enhanced distinctive character needs to be performed on a granular basis, looking at each of the individual goods and services in turn. […] In passing off law, however, goodwill attaches to a business, rather

than to isolated individual goods and services. Of course, when assessing goodwill, it is necessary to ask, 'What is the nature of the business?', but it is not appropriate to break the business down at the same level of granularity as is done for assessing trade mark use etc."

77. Goodwill, which is protectable under the law of passing off, must be more than trivial. I also bear in mind that a small business may nevertheless establish goodwill.[32] I also keep in mind that in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

> "27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.
>
> 28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

[32] See *Lumos Skincare Limited v Sweet Squared Limited and others* [2013].

78. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

> "[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

79. Further, in *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

> "62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by <u>s.2(2) of the Trade Marks Act 1994</u>. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in <u>BALI Trade Mark [1969] R.P.C. 472</u>. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

80. Before my assessment of whether the opponent has accrued a protectable goodwill under the signs relied upon, I note that Mr Muir Wood submitted that there is not any goodwill in the earlier signs. He also highlighted that it is the sign 'Dune' that the opponent uses on its social media accounts and press, and it is by this name that the opponent will be known. In considering this point, I am of the view that it is entirely possible for sub-brands to be able to generate their own protectable level of goodwill or contribute to the fabric of goodwill when used, for example, alongside a house mark.

81. I have summarised the opponent's evidence earlier in this decision.[33] I acknowledge that the opponent has provided overall sales figures and marketing spend for the entire Dune brand,[34] which I consider to be important. As such, I am of the view that consumers would have known the house brand Dune by the relevant date. However, the question here is whether the signs relied upon are distinctive and/or associated with that goodwill.

82. The omissions and difficulties covered earlier in this decision are also applicable under this ground. Even though I accept, for the same reasons advanced earlier, that a reasonable proportion of the sales figures of £5million for footwear and £5.2million for handbags under the earlier signs relied upon was made prior to the relevant date, this is not sufficient per se. In addition to the level of sales and the likely size of the market being very significant, use over a short period of time may be sufficient if the level of use is somewhat intensive. However, the evidence before me in the present case fails to point to this scenario, as there is no documentary evidence of actual sales, such as invoices, showing repeat custom or the scale of the customer base to enable me to corroborate the narrative evidence of Ms Arnold. Thus, this makes it impossible to determine the level of goodwill enjoyed by the business for those goods in relation to the signs relied upon. Further, even when considering the advertising material,

[33] See paragraphs 38-46.
[34] See paragraph 44.

such as social media posts and press clippings, the evidence did not particularise how these have impacted the relevant public, indicating how goodwill would be attributed or perceived, especially in this case where the signs would be seen as sub-brands. Taking the entirety of the use shown before me into account, together with the considerations I have made above regarding the lack of any other supporting evidence, I find that the opponent's evidence falls short of proving the existence of any protectable level of goodwill in either of its two signs relied upon as at the relevant date.

83. If I am wrong, I find that the opponent had generated a small but more than trivial goodwill which is distinctive of its signs among the general public in the UK in relation to footwear and bags. Although the test for misrepresentation is different from that for likelihood of confusion in that it entails "deception of a substantial number of members of the public" rather than "confusion of the average consumer", it is unlikely, in the light of the Court of Appeal's decision in *Comic Enterprises Ltd v Twentieth-Century Fox Film Corporation* [2016] EWCA Civ 41, that the difference between the legal tests will produce different outcomes. I believe that to be the case here. Thus, the same analysis applies with regard to the similarity of the marks and the goods as for the opponent's Section 5(2)(b) ground. Consequently, this ground of opposition would not have put the opponent in any stronger position.

84. The opposition based upon Section 5(4)(a) of the Act is dismissed.

OUTCOME

85. The opposition succeeds, and, subject to any successful appeal against this decision, the application will be refused in its entirety.

COSTS

86. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. I award costs as follows:

Official fee	**£200**
Preparing a statement and considering the other side's statement	**£350**
Preparing evidence	**£750**
Preparing for and attending the hearing	**£900**
Total	**£2,200**

87. I, therefore, order Deichmann SE to pay to Dune Brand Limited the sum of £2,200. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 6th day of July 2026

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General