

O/0598/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER UK00003914420

BY ROADGET BUSINESS PTE. LTD

TO REGISTER THE FOLLOWING TRADE MARK:

SHEIN Belle

IN CLASS 25

AND

AN OPPOSITION THERETO UNDER NUMBER 443545

BY BELLE LINGERIE LIMITED

BACKGROUND AND PLEADINGS

1. On 22 May 2023, Roadget Business Pte. Ltd (“the Applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the contested mark”). The application was accepted and published for opposition purposes on 4 August 2023 in respect of the following goods:

Class 25: *Clothing, namely, shirts, t-shirts, dresses, blouses, skirts, trousers, jumpers, pullovers, hooded pullovers, hooded sweatshirts, cardigans, suits, dress suits, coats, jackets, vests, underwear, lingerie, jeans, pants, swimsuits, tights, leggings, collars, scarves, belts; gloves; headwear, namely, hats and caps.*

2. On 12 October 2023, Belle Lingerie Limited (“the Opponent”) opposed the application in full based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The Opponent relies upon the following three trade marks (collectively “the earlier marks”):

(i) Trade mark number UK00003345083 (“the first earlier mark”)

Representation: Belle

Filing date: 12 October 2018

Registration date: 8 February 2019

Goods and services relied upon:

Class 25: *Clothing; Lingerie; Bodices [*lingerie*]; Maternity lingerie; Sportswear; Swimwear; Underwear; Bras; Nightwear; Fancy dress costumes.*

Class 35: *Advertising services relating to clothing.*

(ii) Trade mark number UK00003293937 (“the second earlier mark”)



Representation:

Filing date: 2 March 2018

Registration date: 4 January 2019

Goods and services relied upon:

Class 25: *Adhesive bras; Ankle socks; Anti-sweat underclothing; Articles of clothing; Articles of outer clothing; Articles of sports clothing; Articles of underclothing; Athletic clothing; Lingerie; Bodices [lingerie]; Maternity lingerie; Underwear; Swimwear; Sportswear; Clothing; Bras; Bodysuits; Knickers; Panties; Suspenders; Bridal garters; Nightwear; Sleepwear; none of the aforesaid being for persons 12 years and under.*

Class 35: *Retail services connected with the sale of clothing and clothing accessories; Online retail services relating to clothing; Online retail store services in relation to clothing; Online retail store services relating to clothing; Wholesale services in relation to clothing; Administration of business affairs; Administration of business affairs of retail stores; Advertising and promotion services; Retail services in relation to clothing; Retail services in relation to clothing accessories.*

(iii) Trade mark number UK00003203285 (“the third earlier mark”)

Representation: BELLE LINGERIE

Filing date: 20 December 2016

Registration date: 17 March 2017

Goods and services relied upon:

Class 25: *Clothing; underwear; swimwear; sleepwear; nightwear; stockings and suspenders.*

Class 35: *Retail services, wholesale services, online retail services and online wholesale services connected with the sale of clothing, underwear, swimwear, nightwear, stockings and suspenders; administration of business affairs of retail stores; advertising and promotional services; providing information about products via telecommunication networks for advertising and sales purposes; providing information and advice regarding the aforesaid services.*

3. Given their earlier filing dates, the Opponent's marks are earlier marks in accordance with section 6(1) of the Act. In accordance with section 6A of the Act, the third earlier mark is subject to proof of use whereas the first and second earlier marks are not. The Opponent may rely upon all the goods and services relied upon for the first and second earlier marks without needing to demonstrate use. The Opponent

made a statement of use in relation to the third earlier mark, a point I will return to below.

4. Under section 5(2)(b), the Opponent relies upon all of the goods and services listed under the respective earlier marks at paragraph 2, above. The Opponent claims that its earlier marks are similar to the contested mark by virtue of the shared element 'Belle' and that the parties' respective goods and services are similar, resulting in a likelihood of confusion.

5. Under section 5(3), the Opponent relies upon the goods underlined at paragraph 2, above. In its notice of opposition, the Opponent sought to rely, under this ground, on goods that do not appear in its specifications: 'loungewear' and 'activewear' in its first and second earlier marks; and 'lingerie', 'loungewear' and 'activewear' in its third earlier mark. I do not consider it will make any material difference to the outcome of this decision; however, I will consider only the terms for which the earlier marks are registered.

6. Under section 5(3), the Opponent claims to have a reputation in the UK in its earlier marks for the goods set out above. The Opponent claims that the similarity between the marks would cause the relevant public to believe they are used by the same undertaking or that there is an economic connection between them. It claims that use of the contested mark would, without due cause, take unfair advantage of, or be detrimental to, the reputation of the earlier marks.

7. The Applicant filed a defence and counterstatement denying the entirety of the Opponent's claims. The Applicant initially sought to put the Opponent to proof of use of its first and second earlier marks; however, following correspondence from the tribunal that such marks are not subject to proof of use, the Opponent filed an amended counterstatement withdrawing such request. The Applicant did not request proof of use of the Opponent's third earlier mark and so the Opponent may rely upon all the goods and services relied upon without demonstrating use. The Applicant put the Opponent to proof of its claimed reputation.

8. The Opponent is represented by Schofield Sweeney LLP and the Applicant by Harbottle & Lewis LLP.

9. During the evidence rounds, only the Opponent filed evidence. Neither party requested a hearing and neither party filed written submissions in lieu of a hearing.

EVIDENCE

10. The Opponent filed evidence in the form of the witness statement of Glynn Dutton (“GD WS”) dated 14 October 2024 and its corresponding 10 exhibits (labelled “GD1 – GD10”). Glynn Dutton is a director of the Opponent and his evidence is intended to demonstrate the Opponent’s claimed reputation. I do not intend to summarise this evidence but have taken the entirety of it into account and will refer to it throughout this decision, where relevant.

DECISION

Relevance of EU law

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

Section 5(2)(b)

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

“5(2) A trade mark shall not be registered if because –

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Relevant law

13. 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

14. It is settled case law that I must make my comparison of the goods on the basis of all relevant factors. These include the nature of the goods, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited* (*TREAT Trade*

Mark) [1996] RPC 281. As the General Court (“GC”) said in *Boston Scientific Ltd v OHIM*,¹ goods and services are complementary when:

“...there is 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.”

15. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“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.”

16. The parties’ specifications are listed at paragraphs 1 and 2 of this decision.

17. I will deal first with the limitation added to the specification of the Opponent’s second earlier mark, namely “*none of the aforesaid being for persons 12 years and under.*” It is not permissible to limit specifications of goods by reference to the intended target market.² Accordingly, I do not consider it appropriate to allow for the aforementioned limitation in the goods comparison. Even if the limitation were valid, the Opponent’s goods are not restricted and therefore include goods which could be sold to the same target market as the Applicant’s goods.

18. The first and third earlier marks are registered for *clothing* and the second earlier mark is registered for *articles of clothing*. These terms would encompass the Applicant’s *clothing, namely, shirts, t-shirts, dresses, blouses, skirts, trousers,*

¹ Case T-325/06.

² *Omega SA (Omega AG) (Omega Ltd) v Omega Engineering Incorporated* [2012] EWHC 3440 (Ch) at [47].

jumpers, pullovers, hooded pullovers, hooded sweatshirts, cardigans, suits, dress suits, coats, jackets, vests, underwear, lingerie, jeans, pants, swimsuits, tights, leggings. In accordance with *Meric*, these goods are identical.

19. The Applicant's *collars, scarves, belts and gloves* are clothing accessories. Whilst not identical to the Opponent's *clothing and articles of clothing*, they are similar. Though their specific uses and purposes differ, they are all goods that are worn on the body and there will be an overlap in the users. The goods reach the market through the same trade channels and will be found alongside each other in retail stores and on the same retail websites. I find a medium to high degree of similarity.

20. The Applicant's *headwear, namely, hats and caps* have some similarity of purpose to *clothing and articles of clothing* given that they are used to cover parts of the body, albeit different parts of the body. Similarly to the goods compared in the previous paragraph, these goods also strike me as liable to share trade channels and to be sold in the same retail stores and on the same retail websites. I find a medium to high degree of similarity.

The average consumer and the purchasing act

21. 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.

22. 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)* 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 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.

23. The average consumer of the goods at issue will be a member of the general public. Various factors will be taken into account during the purchasing process such as aesthetics, durability and material. The goods will vary in price, but none are likely to be particularly expensive and all will be purchased reasonably frequently. Taking all of this into consideration, I find it likely that a medium degree of attention will be paid during the purchase.

24. The goods are likely to be self-selected from the shelves of a retail outlet or their online or catalogue equivalents. Visual considerations are, therefore, likely to dominate the selection process. However, given that advice may be sought from retail assistants and orders may be placed via the telephone, I do not discount an aural component to the purchase.

Comparison of marks

25. It is clear from *Sabel* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in *Bimbo*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant 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.”

26. 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 trade 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.

27. The trade marks to be compared are as follows:

The earlier marks	The contested mark
(i) Belle	

(ii)  (iii) BELLE LINGERIE	
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Overall impression

28. The contested mark comprises two words: the invented word SHEIN, presented in upper case, and the dictionary word BELLE, presented in title case. The overall impression of the mark lies in the two words, though they do not create a unitary meaning. SHEIN is more distinctive in the mark than BELLE given it is invented. The words are slightly stylised, which adds to the overall impression but does not hold much weight compared to the words themselves.

29. The first earlier mark comprises the one word BELLE in word-only format. The overall impression resides in that one word.

30. The second earlier mark comprises the word BELLE in a stylised font, presented in pink. The word itself is the dominant element, with the stylisation playing a lesser role in the overall impression.

31. The third earlier mark comprises two dictionary words: BELLE and LINGERIE, the former of which is more distinctive given that LINGERIE, in the context of clothing goods, will be seen as descriptive or highly allusive. That being said, both words contribute to the overall impression.

Visual comparison

Belle v **SHEIN Belle**

32. These marks share the word BELLE, which is the only word in the earlier mark and the last word in the contested mark. This creates some visual similarity. However, the contested mark contains the additional word SHEIN, which renders the marks noticeably different in length. This creates the visual difference and, given that the difference is at the beginning of the marks, where consumers usually tend to focus, it heightens the difference.³ Overall, I find the marks visually similar to a low to medium degree.

Belle v **SHEIN Belle**

33. The same comparison discussed in the previous paragraph applies here, the only difference being the stylisation of the earlier mark, which creates a further difference between the marks. I find the marks visually similar to a low degree.

BELLE LINGERIE v **SHEIN Belle**

34. I repeat the comparison made at paragraph 32 and add that the earlier mark contains the additional word LINGERIE, a further difference between the two marks, which I find to be visually similar to a low degree.

Aural comparison

Belle v **SHEIN Belle**

35. The word BELLE in the contested mark will be pronounced in the ordinary way, as one syllable. The word SHEIN will be pronounced in one of two ways: (i) similarly to the word SHEEN, as one syllable; or (ii) similarly to the word SHINE, as one syllable.

³ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

Accordingly, the contested mark will either be pronounced 'SHEEN-BELLE' or 'SHINE-BELLE'.

36. The first earlier mark, BELLE, will be pronounced in the ordinary way, as one syllable. Whilst this element is shared between the marks, it is the only element articulated in the earlier mark but articulated last in the contested mark, creating aural difference. The differing number of syllables also creates a difference. Overall, I find these marks aurally similar to a low to medium degree, regardless of the pronunciation of the contested mark.

 **SHEIN Belle**

37. The second earlier mark will be pronounced identically to the first earlier mark. As such, the comparison in the previous two paragraphs applies equally here. I find these marks aurally similar to a low to medium degree, regardless of the pronunciation of the contested mark.

BELLE LINGERIE v SHEIN Belle

38. The contested mark will be pronounced as I have discussed above. The third earlier mark will be pronounced in accordance with the usual pronunciation of the ordinary words BELLE and LINGERIE, as four syllables. Whilst the shared word BELLE creates some aural similarity, the word being spoken in different positions in the marks reduces that similarity. The presence of the words LINGERIE and SHEIN in the respective marks create a significant difference given their differing number of syllables and very different sounds. Overall, I find the marks aurally similar to a low degree, no matter the pronunciation of the contested mark.

Conceptual comparison

Belle v **SHEIN Belle**

39. BELLE is an ordinary word which will likely be understood by the average consumer as meaning either 'beautiful', 'a beautiful person' or as a name; the concept of the first earlier mark is one of these meanings. The same concepts exist in the contested mark due to the presence of the word BELLE. Regardless of the meaning the average consumer attributes the word BELLE, it will be the same in both marks. The first word in the contested mark, SHEIN, is an invented word. Even when pronounced as an ordinary dictionary word (SHEEN or SHINE), given its spelling, it is unlikely to conjure any clear meaning in the minds of consumers, though its presence still creates a conceptual distinction between the marks. Overall, I find the marks conceptually similar to a medium degree.

Belle v **SHEIN Belle**

40. The concept associated with the second earlier mark is the same as the first earlier mark; the stylisation makes no material difference. Accordingly, I apply the same comparison here as in the previous paragraph, and find the marks conceptually similar to a medium degree.

BELLE LINGERIE v **SHEIN Belle**

41. The concept associated with the third earlier mark is likely to be 'beautiful lingerie'. As discussed at paragraph 39, the concept associated with the contested mark is a combination of the invented word SHEIN and the word BELLE meaning 'beautiful', 'a beautiful person' or being a name. The shared element BELLE creates less conceptual similarity between these marks than the first and second earlier marks because its combination with the word LINGERIE creates a concept that is slightly further removed

than the word BELLE alone. Overall, I find the marks conceptually similar to a low degree.

Distinctive character of the earlier marks

42. In *Lloyd Schuhfabrik Meyer* 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).

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

43. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods/services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

44. I will assess the inherent position first. The position with respect to each of the earlier marks is almost identical: all three contain the word BELLE, which will likely be understood as meaning ‘beautiful’, ‘a beautiful person’ or as a name. It therefore does not possess the distinctiveness of an invented word, though neither is it descriptive of the goods at issue. If the average consumer attributes BELLE with the meaning ‘beautiful’ it may be mildly allusive either of the effect the clothing will have on the wearer or of goods that are aesthetically pleasing. However, given this will require some thought on the part of the consumer, I do not consider it materially affects the distinctiveness. I consider the first earlier mark, which consists solely of BELLE, to be inherently distinctive to a medium degree. The stylisation in the second earlier mark does not materially affect the distinctiveness, neither does the word LINGERIE in the third earlier mark on the basis that it is descriptive or highly allusive for the goods at issue. The second and third earlier marks are inherently distinctive to a medium degree.

45. For reasons that will I will come to discuss, I am of the view that enhanced distinctiveness does not improve the Opponent’s position in this case. I will, however, briefly make a finding in relation thereto. The Opponent’s evidence demonstrates longstanding, intensive, geographically widespread use of the earlier marks⁴ with online use dating back to 2006,⁵ UK revenue that has shown an upward trajectory from ~£2.3m in 2016 to ~£5.8m in 2023,⁶ marketing and advertising costs totalling ~£1.8m between 2017 and 2023,⁷ various awards and press appearances as an ‘online lingerie retailer’ between 2017 and 2024,⁸ customer recognition by way of positive reviews on Google, eBay and Trustpilot (amongst others),⁹ and a social media presence since 2009 with a total number of 55,665 followers across all social media platforms.¹⁰ I note that none of this evidence has been challenged by the Applicant.

46. What the evidence is lacking is documentary evidence of its earlier marks used on goods: it overwhelmingly relates to use in relation to the online retail of lingerie. By its

⁴ All three earlier marks feature prominently in the evidence.

⁵ GD1.

⁶ GD10.

⁷ GD WS at [38].

⁸ GD WS at [31] and GD8.

⁹ GD WS at [35] and GD9.

¹⁰ GD WS at [23]-[24] and GD7.

own admission, the Opponent is “renowned [for being] one of the UK’s largest retailers of branded lingerie...” (my emphasis) and “stocks over 50 reputable womenswear brands”.¹¹ For this reason, whilst I am satisfied that the distinctive character of the earlier marks has been enhanced through use, to a high degree, such distinctiveness extends only to *online retail services relating to lingerie*.

47. This is a service which does not feature in the specification of the first earlier mark but would constitute a sub-category of *online retail services relating to clothing* in the second earlier mark and *online retail services and online wholesale services connected with the sale of clothing, underwear...* in the third earlier mark. I have not compared these services to the Applicant’s goods because the Opponent’s goods offered its strongest position. When considering the relevant factors set out at paragraphs 14 to 15, I would find *online retail services relating to lingerie* similar to a medium degree to the Applicant’s *clothing, namely, shirts, t-shirts, dresses, blouses, skirts, trousers, jumpers, pullovers, hooded pullovers, hooded sweatshirts, cardigans, suits, dress suits, coats, jackets, vests, underwear, lingerie, jeans, pants, swimsuits, tights, leggings*; and similar to a low degree to the Applicant’s *collars, scarves, belts, gloves, headwear, namely, hats and caps*.

48. Returning to my point in paragraph 45 relating to the benefit (if any) of the enhanced distinctiveness finding, I consider the outcome to be the same for the Opponent whether it relies (1) on goods that are identical or similar to a medium to high degree but for which the marks are distinctive to a medium degree or (2) on services that are similar to either a low or medium degree but for which the marks are distinctive to a high degree.

Likelihood of confusion

49. 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 consumers realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible

¹¹ GD WS at [6].

undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods/services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods/services and the nature of the purchasing process. In doing so, I must be alive to the fact 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 he/her has retained in his/her mind.

50. I have found the contested mark and the first earlier mark to be visually and aurally similar to a low to medium degree and conceptually similar to a medium degree. I have found the contested mark and the second earlier mark to be visually similar to a low degree, aurally similar to a low to medium degree and conceptually similar to a medium degree. I have found the contested mark and the third earlier mark to be visually, aurally and conceptually similar to a low degree. I have found the goods to be either identical or similar to a medium to high degree. I have found the earlier marks to have a medium degree of inherent distinctive character (only enhanced through use to a high degree in relation to services which I deemed to be similar to a low or a medium degree to the Applicant's goods). I have identified the average consumer as a member of the general public, who will pay a medium degree of attention to a predominantly visual purchase (though I do not discount an aural aspect).

51. I will discuss direct confusion first. On the basis of the additional, invented word SHEIN in the contested mark, which, given its dominance and distinctiveness within that mark, will not go unnoticed by the average consumer, I consider there to be no likelihood of direct confusion. Even considering the interdependency principle, this finding applies to all of the Applicant's goods, even those which are identical to the Opponent's goods. For the avoidance of doubt, whether the Opponent relies on identical goods and a medium degree of distinctiveness or on similar goods/services and a high degree of distinctiveness, the presence of the word SHEIN avoids direct confusion.

52. Turning to indirect confusion, I remind myself of the comments of Iain Purvis KC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:¹²

“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 recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.).

¹² BL O/375/10.

(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).”

53. The examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.¹³ In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor KC, sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

54. In *Whyte and Mackay Ltd v Origin Wine UK Ltd & Anor*,¹⁴ Arnold J (as he then was) considered the impact of the CJEU’s judgment in *Bimbo*,¹⁵ on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks – visually, aurally and conceptually – as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive

¹³ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at [81] to [82].

¹⁴ [2015] EWHC 1271 (Ch).

¹⁵ Case C-591/12P.

significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the component authority to carry out a global assessment taking into account all relevant factors.”

55. In considering a likelihood of indirect confusion, I have kept in mind the examples set out in *L.A. Sugar*, though these are by no means exhaustive. In my view, given that SHEIN and BELLE, in the contested mark, do not combine to form a unitary meaning, the mark’s ‘BELLE’ element retains an independent distinctive role. Particularly given the closeness between the parties’ goods, to my mind, the effect of this in the marketplace will give rise to a likelihood of confusion on the part of the average consumer. Notwithstanding that BELLE has a clear concept for the average consumer as a name or a word meaning ‘beautiful’ or ‘a beautiful person’, I find its role in the contested mark will lead the consumer to conclude that the marks originate from a shared or related undertaking. This extends to the third earlier mark despite the additional word LINGERIE on the basis that it is descriptive or highly allusive for the goods at issue and will therefore be seen as indicative of a particular product line. I therefore find a likelihood of indirect confusion between the contested mark and each of the earlier marks. For completeness, the same finding applies if I considered the opposition based on the Opponent’s *online retail services relating to lingerie* on the

basis that the lower degree of similarity with the Applicant's goods is outweighed by the higher degree of distinctiveness in the second and third earlier marks.

Outcome

56. The Opponent's claim under section 5(2)(b) succeeds in its entirety.

Section 5(3)

57. Section 5(3) states:

“5(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark [...]

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

58. Section 5(3A) states:

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

59. 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'Oréal 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; *General Motors, paragraph 26*.

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

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

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

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

60. The conditions of section 5(3) are cumulative. First, the marks at issue must be identical or similar. Secondly, the Opponent must satisfy me that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the contested mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/services 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.

Reputation

61. 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 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.”

62. Under section 5(3), the Opponent relies on its three earlier marks and various goods in Class 25, set out at paragraph 2 of this decision. When considering the evidence in relation to enhanced distinctiveness, I explained in paragraphs 45 and 46 that it overwhelmingly relates to *online retail services relating to lingerie* and that there was little use of the earlier marks in relation to goods themselves. Whilst I would have repeated my assessment of the evidence here and made the same finding in relation to reputation as I did for enhanced distinctiveness, such a finding would have extended to the same services, i.e. *online retail services relating to lingerie*. Since the Opponent did not rely on any services for section 5(3), I dismiss this ground of opposition for failure to demonstrate the requisite reputation in the goods relied upon.

Outcome

63. The section 5(3) ground of opposition fails.

CONCLUSION

64. The opposition has succeeded under section 5(2)(b) and, subject to any successful appeal against this decision, the application is refused in full.

COSTS

65. The Opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. I award the following:

Preparing a statement of grounds and considering the counterstatement	£300
Preparing evidence	£600
Official fee	£200
Total	£1100

66. I therefore order Roadget Business Pte. Ltd to pay Belle Lingerie Limited the sum of £1100. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 9th day of July 2026

MRS E FISHER

For the Registrar