

O/0713/26

TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO.3914395  
BY ROADGET BUSINESS PTE. LTD  
TO REGISTER

**SHEIN *ICON***

AS A TRADE MARK  
IN CLASS 25  
AND OPPOSITION THERETO (UNDER NO.442930)  
BY  
DSQUARED2 TRADEMARKS LIMITED

## Background & Pleadings

1. Roadget Business Pte. Ltd (“the applicant”) applied for the trade mark set out on the title page of this decision on 22 May 2023. It has an EUIPO priority date of 12 May 2023. The mark was published for opposition purposes on 4 August 2023 in class 25 for the following goods:

*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. Dsquared2 Trademarks Limited (“the opponent”) opposed the application in full on 8 September 2023 under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following International Registration (“IR”) under sections 5(2)(b) and 5(3).

| IR No. WO1579137                                                                                                                                                         | Goods relied on:                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                        |
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| <b>ICON</b><br><br>Designation date:<br>25 February 2021<br><br>Date of protection of the IR in the UK:<br>23 November 2021<br><br>Priority date: 26 August 2020 (EUIPO) | Class 9: Sunglasses; eyewear, spectacles; pince-nez cases, chains for spectacles; contact lenses; containers for contact lenses; correcting lenses (optics); cords for spectacles; eyeglass frames and optical goods; none of the aforesaid goods in the field of electric meters; none of the aforesaid for use in relation to the power sports industry, including motorcycles, utility terrain vehicles, all-terrain vehicles, personal watercraft and snowmobiles; none of the aforementioned goods in relation to tools/products for professional craftsmen or work wear and protective equipment. |

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|  | <p>Class 18: Leather and imitation leather, animal skins; trunks and suitcases; umbrellas and parasols; walking sticks; whips, harness and saddlery, card cases (wallets); key cases (leather goods); attaché cases; briefcases (leather goods), attaché cases, document portfolios [cases]; moleskin (imitation leather), imitation leather; beach umbrellas; whips and saddlery goods, wallets; coin purses not of precious metal; handbags, backpacks, wheeled bags, bags for climbers, bags for campers, travel bags, beach bags, school bags, shopping bags; suitcases and boxes designed to contain toiletries; travel sets (leather goods); toiletry sets and make-up bags (empty); collars and clothing for animals; net bags for shopping; bags and net bags for shopping; bags and small bags (envelopes, pouches) of leather for packaging; none of the aforesaid for use in relation to the power sports industry, including motorcycles, utility terrain vehicles, all-terrain vehicles, personal watercraft and snowmobiles.</p> <p>Class 25: Clothing; footwear, headgear; shirts; clothing of leather or imitation leather; clothing items, women's clothing; men's clothing; clothing for children and babies; hoods (clothing);</p> |
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|  | <p>belts (clothing); gloves (clothing); sashes for wear; scarves; shawls, neckties, hosiery; socks; shoes; bedroom slippers; clothing for sports, skiing and the beach; swaddling clothes; underwear, coats; overalls; short-sleeved shirts; tee-shirts; turtlenecks; slips (underwear); suits; trousers; jackets; pullovers; vests; sweaters; dresses; shirt yokes; shirt fronts; ready-made linings (parts of clothing); stuff jackets; pelerines; gabardines (clothing); waterproof clothing; pockets for clothing, pocket squares; jerseys (clothing); knitwear (clothing); underwear (lingerie); dressing gowns; none of the aforesaid for use in relation to the power sports industry, including motorcycles, utility terrain vehicles, all-terrain vehicles, personal watercraft and snowmobiles; none of the aforementioned goods in relation to tools/products for professional craftsmen or work wear and protective equipment.</p> <p>Class 35: Retail services, online retail services and mail order retail services in relation to clothing, footwear, headgear, jewellery, precious stones, watches, clocks, precious metals and their alloys, bracelets, brooches, cufflinks, perfumery, cosmetics, skincare; retail services, online retail services and mail order retail services in relation to medals,</p> |
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|  | <p>ornaments, shoe ornaments, objects of imitation gold, ornamental pins, tie pins, tie clips and watch straps; retail services, online retail services and mail order retail services in relation to leather and imitations of leather, bags, travelling bags, cases, suitcases, briefcases, straps of leather or imitation leather, handbags, garment bags, haversacks, rucksacks, trunks, purses, wallets, key cases, pouches, canes, sticks, saddlery and belts; advertising; marketing; promotional services; organisation, operation and supervision of loyalty programmes and of sales and promotional incentive schemes; fashion show exhibitions for commercial purposes; advertising and marketing services provided by means of social media; information, advisory and consultancy services in relation to the aforesaid services; none of the aforementioned services to be provided in connection with the power sports industry, including motorcycles, utility terrain vehicles, all-terrain vehicles, personal watercraft and snowmobiles; none of the aforementioned being in relation to shampoos or haircare goods.</p> |
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3. The opponent's IR has a priority date that is earlier than the priority date of the application and is therefore an earlier mark, in accordance with section 6 of the Act, but had not been granted protection in the UK for five years or more before the priority

date of the application and therefore is not subject to the proof of use requirements in section 6A of the Act.

4. Under section 5(4)(a) of the Act, the opponent relies on the sign **ICON**. Furthermore it has claimed use of the sign throughout the UK since 2015 on the goods and services set out in Annex 1 of this decision.

5. The applicant filed a counterstatement in which it denied all grounds of the opposition and put the opponent to proof of its claims.

6. Both sides have been professionally represented during these proceedings. The applicant has been represented by Harbottle & Lewis LLP (“Harbottle”) and the opponent by Murgitroyd & Company (“Murgitroyd”).

7. Both sides filed evidence in these proceedings and a hearing was requested. I heard the matter on 21 August 2025, via video conference. The applicant was represented by Beth Collett of Counsel, as instructed by Harbottle. The opponent was represented by Alan Fiddes of Murgitroyd.

8. I make this decision based on a reading of all the material before me and the submissions made at the hearing.

9. 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 that predate the UK’s withdrawal from the EU.

## **Evidence**

10. The opponent filed evidence in chief dated 1 February 2024 in the name of Stefania Panigada, who is the Group Legal Counsel for the opponent. Ms Panigada appended 8 exhibits.

11. The applicant filed evidence in the name of Samuel Flack, dated 2 May 2024. Mr Flack is an Associate Attorney at Harbottle, who are the applicant's legal representatives, and he appended 22 exhibits

12. Ms Panigada filed a second witness statement, and two further exhibits dated 2 August 2024 as the opponent's evidence in reply.

13. I do not intend to summarise the evidence in full. I have read all of the material and will refer to it when it becomes relevant to do so during the course of this decision.

## **DECISION**

### **Section 5(2)(b)**

14. Section 5(2)(b) of the Act reads as follows:

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

[...]

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

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

15. Section 5A is also relevant and reads:

“5A. [...] Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only”.

16. 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**

17. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*,<sup>1</sup> the court stated at paragraph 23 of its judgment that:

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

18. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case,<sup>2</sup> for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

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<sup>1</sup> Case C-39/97

<sup>2</sup> [1996] R.P.C. 281

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

19. For the purpose of a comparison, it is appropriate to group related goods together, where they are sufficiently comparable to do so.<sup>3</sup>

20. In addition, I find the following case law to be helpful when comparing specifications, where in *Gérard Meric v Office for Harmonisation in the Internal Market*,<sup>4</sup> the General Court (“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.”

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<sup>3</sup> *Separate Trade Mark* decision, BL O-399-10 (AP)

<sup>4</sup> Case T- 133/05.

## **Class 25**

21. In its skeleton argument, the applicant admitted its class 25 goods were similar to the opponent's class 25 goods.<sup>5</sup> In fact the following terms appear in both the applicant's and opponent's class 25 specification, namely *shirts; belts; gloves; scarves; coats; suits; trousers; jackets; pullovers; vests; dresses; underwear; lingerie*. As such these terms are self-evidently identical. Moreover I find that the opponent's class 25 terms *Clothing* and *headgear* at large will encompass all of the applicant's remaining class 25 goods and are therefore considered identical on the *Meric* principle.

22. As class 25 represents the opponent's best case, I do not intend to compare the other goods and services as they do not put the opponent in any stronger a position.

## **Average consumer and the purchasing process**

23. 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 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

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<sup>5</sup> Applicant's skeleton argument, paragraph 23.

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.

24. With regard to clothing, in *New Look Ltd v OHIM*,<sup>6</sup> the GC stated:

“43 It should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.

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<sup>6</sup> Joined cases T-117/03 to T-119/03 and T-171/03.

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

25. The average consumer for the contested goods is the general public. The contested goods are not an everyday purchase, but they are likely to be at least semi regular. The price range will vary from relatively inexpensive to expensive, according to garments, e.g. a suit would cost proportionately more than a scarf. Consumers will likely select goods from a physical retail outlet or online equivalents. As such I would pitch the level of attention paid by consumers as being medium. The act of purchasing is likely to be mainly visual for aesthetic reasons but there will also be additional considerations of sizes, fabrics and suitability for purpose. However, I do not wholly discount aural considerations such as word of mouth recommendations.

### **Mark comparisons**

26. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) 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 CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*<sup>7</sup>, 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

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<sup>7</sup> Case C-591/12P.

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

27. 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.

28. The respective marks to be compared are:

| Opponent's IR | Applicant's mark         |
|---------------|--------------------------|
| <b>ICON</b>   | <b>SHEIN <i>ICON</i></b> |

29. The opponent's IR is a single word, **ICON**, in block capitals with no additional aspect such as stylisation. The overall impression is derived solely from the word itself.

30. The applicant's mark consists of two words, being **SHEIN ICON**. The first word is in very slightly stylised block capitals, and the second word is in italicised block capitals. Both words contribute to the overall impression of the mark, although in my view **SHEIN** contributes considerably more as an invented word, as the word **ICON** is a dictionary word which may be considered allusive to goods which have qualities which are considered to stand out from others.

### Visual Similarity

31. The respective marks share the word **ICON**. This is the entirety of the opponent's IR and the second word of the applicant's mark. Although the **ICON** word element is italicised in the applicant's mark, the earlier IR, being a word only mark, can be used in any font. Clearly the point of difference is the applicant's first word **SHEIN** which has no counterpart in the opponent's mark. The applicant, in its skeleton argument,<sup>8</sup> drew my attention to settled case law that consumers usually pay more attention to the beginnings of marks rather than their endings.<sup>9</sup> Overall I find there is a medium degree of visual similarity.

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<sup>8</sup> Skeleton argument, paragraph 9.

<sup>9</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

### **Aural similarity**

32. In an aural comparison, the shared word **ICON** will be pronounced identically in each case. The additional first element in the applicant's mark, **SHEIN**, is an invented word so consumers may not know exactly how the mark should be pronounced. To my mind the most likely pronunciations would be either SHE-INN or SHEEN. Whichever pronunciation is used, this element has no counterpart in the opponent's mark. Overall, I find there is a medium degree of aural similarity.

### **Conceptual similarity**

33. In terms of a conceptual comparison, it is settled case law that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>10</sup>

34. The shared word **ICON** is a known dictionary word for which the applicant supplied the Collins English Dictionary definition, being "a very famous person or thing considered as representing a set of beliefs or a way of life".<sup>11</sup> Moreover in the applicant's evidence, Mr Flack made reference to the use of the word **ICON** in relation to the phrase "fashion icons" being "individuals who introduce new styles of fashion which subsequently spread throughout fashion culture and are then mirrored by consumers."<sup>12</sup> I accept that some celebrity images are so ubiquitous such that their clothing or appearance does influence culture more widely and to my mind many consumers may see the word **ICON** in this way. At the very least an icon is generally considered to be someone or something which have qualities that stands out from others. This word may be seen as allusive for class 25 goods for some garments or style of garment, e.g. little black dress or denim jeans. Either concept will obviously apply identically to the shared words in the respective marks.

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<sup>10</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R.-I-643; [2006] E.T.M.R. 29.

<sup>11</sup> Skeleton argument, paragraph 16.

<sup>12</sup> Samuel Flack's witness statement at paragraph 8 and Exhibit SF2.

35. The applicant's first element, **SHEIN**, is an invented word and therefore has no immediately graspable concept. But as it precedes **ICON** in the word order, it may be seen by some consumers that the **ICON** can be attributed to **SHEIN**.

36. Taking all of the above into account the respective marks are conceptually similar to a low degree based on the shared word **ICON**.

### **Distinctive character of the earlier registered trade mark**

37. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

38. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,<sup>13</sup> 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-2779, 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

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<sup>13</sup> Case C-342/97

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

39. I will first consider the inherent distinctiveness of the earlier IR. The word **ICON** is a known dictionary word, but one which I consider to be allusive in relation to fashion items. I have considered the guidance given in *Formula One Licensing BV v OHIM*<sup>14</sup> which confirmed that a registered mark must be assumed to have some distinctive character. Taking that in to account I find that the earlier IR is inherently distinctive only to between a low to medium degree.

40. Evidence was provided in these proceedings to support the opponent’s 5(3) and 5(4)(a) grounds, so I can consider whether the use made of this mark has enhanced its distinctiveness. I remind myself of the *Windsurfing Chiemsee* factors set out above as to what I should consider.

41. The opponent stated they first used the IR in the UK in 2015 and gave the following turnover figures for all its goods and services provided under the mark.<sup>15</sup> The figures are not broken down by class. Moreover, it is not stated if these figures are all attributable to the UK.

|      |               |
|------|---------------|
| 2019 | €1,636,970.90 |
| 2020 | €5,072,255.89 |
| 2021 | €10,887,928   |
| 2022 | €8,179,900    |
| 2023 | €2,023,961.40 |

42. The opponent provided invoices for UK customers issued either by its authorised manufacturer, distributor or one of the other companies within the opponent’s group. The invoices contain details for large volumes of garments, often of the same type, e.g. sweatshirts, so I assume these are wholesale orders with retailers. There is some

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<sup>14</sup> Case C-196/11P

<sup>15</sup> The years 2020, 2021 and 2022 were broken down in to 6 month amounts. I have rounded up to a full year for convenience.

mention of the **ICON** mark within the text of the invoices, where it is used as reference to describe caps, sweatshirts, t-shirts, shirts, gilets, pants, shorts, overalls, pyjamas and trainers.<sup>16</sup> The images from social media and magazines features mainly show t-shirts, sweatshirts, trousers, caps, underwear and trainers.

43. The opponent has social media channels on all available platforms under the name DSQUARED2 and has provided follower numbers on each platform which range from tens of thousands to two million in 2023. There are references to the **ICON** brand in the text comments put out on the social media posts, however some take the form of hashtags, namely #D2ICON NAOMI CAMPBELL, @Arianagrande in Dsquared #ICON cap and #D2xIBRA: Be an ICON.<sup>17</sup> The opponent has supplied screenshots from various social media posts where images of **ICON** branded garments are featured. Typically, the word **ICON** is used as an emblazoning across the front or back of outer garments such as sweatshirts and T-shirts and across the back of garments or on the waistband for goods such as underwear. Two illustrative examples from 2020 and 2018 are shown below.<sup>18</sup>



44. There were some images used within the evidence, notably the Zlatan Ibrahimovic feature from GQ magazine and Naomi Campbell feature from Designscene.net where the **ICON** branded garments they are wearing also have the mark DSQUARED2

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<sup>16</sup> Exhibit SP2

<sup>17</sup> Exhibit SP2

<sup>18</sup> Exhibit SP2

emblazoned on them.<sup>19</sup> Zlatan Ibrahimovic is also featured wearing **ICON** branded garments which also have his surname as an emblazoning, as per the image above.

45. No overall advertising expenditure figures have been given but the opponent has provided examples of invoices dated 2020 from various media outlets for advertising slots.<sup>20</sup> It is unclear to me whether the related advertisements featured **ICON** branded fashion items but the opponent has provided screenshots of magazine features which do show **ICON** branded garments in the publications set out below.

- SHORTLIST (August 2017)
- GRAZIA (April 2018)
- GQ (July 2019)
- WONDERLAND (Summer 2019)
- 10 FOREVER (Autumn/Winter 2020)
- ANOTHER (Spring /Summer 2020)
- GAY TIMES (no date given)
- ROLLACOASTER (Autumn/Winter 2020)
- THE FACE (no date given)
- THE GENTLEWOMAN (Spring /Summer 2020)
- WONDERLAND (Spring 2020)
- ATTITUDE (various months in 2021 & 2022)
- MAN ABOUT TOWN (2022 & 2023)

46. Where the screenshots of the magazine covers are given, there is a purchase price in pounds sterling indicating they are available in the UK but no indication has been given of the print circulation of the magazines, or whether the features also appear online and if so, how widely read the features are.

47. The opponent states in evidence that its founders have been the recipients of several high profile awards for their design work from the Spanish magazine Icon,

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<sup>19</sup> Exhibit SP5

<sup>20</sup> Exhibit SP3.

amfAR Sao Paolo and the Taormina Art Award.<sup>21</sup> However, my first concern is that these are not awards based in the UK and secondly it is unclear that the awards were given for the **ICON** brand in particular. It appears that they were awarded to the founders of DSQUARED2 for their contribution to fashion design itself as a creative art and for their overall body of work.

48. I find that **ICON** has been used solus but is also used in conjunction with the opponent's house mark, DSQUARED2, on various garments. However, the way it has been used, both solus and with the house mark, is that of an emblazoning on a garment rather than shown on a label, swing tag or point of sale display which does not look like the most obvious trade mark use, i.e. being able to trace a brand origin. The emblazoning presentation indicates, to my mind, that **ICON** is being used descriptively to identify the wearer as being an icon. I find this to be especially the case in those images where the wearer is a famous individual and could be considered as an icon in their own field of endeavour such as football, music or modelling.

49. Taking into account the factors set out above, coupled with a lack of UK specific turnover figures and no figures that have been broken down by goods, I find that the opponent's evidence is deficient in significant areas and has not enhanced its distinctiveness through use of the IR.

### **Likelihood of confusion**

50. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no 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 factors are interdependent, and include the principle that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must be alert to the fact that the average consumer rarely has the opportunity to

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<sup>21</sup> Stefania Panigada's first witness statement, paragraph 25.

make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

51. I find the following case law to be useful in assessing the likelihood of confusion.

52. In *L.A. Sugar Limited*,<sup>22</sup> Iain Purvis KC, 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:

- (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.).

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<sup>22</sup> *L.A. Sugar Limited v By Back Beat Inc*, Case 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. I bear in mind that the categories listed above in *L.A. Sugar* are not an exhaustive list of all the ways in which indirect confusion can occur. They are merely examples of the way in which it could or tends to occur.

54. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,<sup>23</sup> Arnold LJ approved Mr Purvis's formulation but added:

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

55.. However, it is also settled case law that it is not sufficient to find a likelihood of confusion if a mark merely calls to mind another mark.<sup>24</sup> This is considered mere association not indirect confusion.

56. So far in this decision I have found:

- The respective class 25 goods are identical.
- The marks are visually and aurally similar to a medium degree.
- The marks are conceptually similar to a low degree based on the shared word.
- The purchasing process is predominantly visual.
- The inherent distinctiveness of the earlier mark is between a low and medium degree.

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<sup>23</sup> [2021] EWCA Civ 1207

<sup>24</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

57. Taking direct confusion first, I find that the respective marks share the word **ICON**. Taking into account the case law relating to the notion of imperfect recollection, I find the shared word element is outweighed by the additional invented word, namely **SHEIN**, in the applicant's mark which makes a visual, aural and conceptual difference such that the average consumer is not likely to directly confuse the marks, that is to mistake one mark for the other, even for identical goods paying a medium degree of attention. As such I do not find there is a likelihood of direct confusion.

58. Having found no likelihood of direct confusion, I turn to the possibility of indirect confusion. I remind myself of the guidance given in *L.A. Sugar* that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common element to a shared undertaking, taking the one mark to be a possible brand extension or sub brand of the other mark. I am also alert to the guidance in *Duebros* that a finding of indirect confusion should not be made simply because two marks share a common element.

59. I have previously found that the word **ICON** is allusive but has some inherent distinctiveness as per *Formula One Licensing*. Whereas **SHEIN**, being an invented word, is highly distinctive. However the applicant's mark does not form a meaningful unit as a whole, i.e. it is not greater than the sum of its parts. The applicant's mark contains the entirety of the IR and does not alter its meaning in any way. As such I find that it is plausible in this situation to consider one mark as a brand extension or sub brand of the other. Overall I find there is a likelihood of indirect confusion.

60. The opposition claim brought under section 5(2)(b) of the Act succeeds.

### **Section 5(3)**

61. The opponent claims that its IR has a reputation for all the goods and services it has registered. Moreover it claims that

“The Applicant is seeking an unfair advantage by seeking to benefit from the reputation and attractiveness of the earlier significant right by misappropriating

goodwill. The Opponent has acquired a substantial reputation as a result of its longstanding use of its mark. The Opponent's mark is therefore undoubtedly a well known mark. Use of the contested mark would gain an unfair advantage as it would misappropriate and ride on the coat tails of the Opponent's attractive fame and reputation which has been built up over a significant period of time.

The contested mark would therefore need little advertising or promotion as consumers will wrongly believe that the contested goods are reputable and provided by the Opponent, or that the Applicant is endorsed by the Opponent, or is an economically linked undertaking. Also, the Applicant would benefit from increased sales and custom by riding on the coat tails of the Opponent's reputation, particularly as the Opponent's goods and services have a sterling reputation.

Use of the contested mark would therefore unfairly exploit the repute of the Opponent's mark.”

62. Section 5(3) of the Act 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 (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

63. Section 5(3A) of the Act 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.”

64. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). The law appears to be as follows:

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

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

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

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

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

(f) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair

advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

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

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

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

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

65. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its registration and the application are similar. Secondly, the opponent must show that its registration has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, 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 registration being brought to mind by the contested 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.

66. The relevant date for the assessment under section 5(3) is the priority date of the application, namely 12 May 2023.

## **Reputation**

67. 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."

68. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it."

69. Having found that the marks are similar to some degree, I turn to the consideration of reputation. As outlined above, for an opposition under section 5(3) to get off the ground it is first necessary for the opponent to show that it has the necessary reputation. I must be satisfied that **ICON** is known by a significant part of the relevant public. I have reviewed the evidence previously in this decision and found that there were deficiencies in the material provided. The opponent has indicated sales in the UK although the turnover was not broken down by reference to particular goods or services. I find that the opponent has established sales for caps, sweatshirts, t-shirts, shirts, gilets, pants, shorts, overalls, pyjamas and trainers and consequently for the retail services related to the same goods. There was no evidence of sales for the class 9 goods, the class 18 goods or for the retail services connected with anything other than those clothing goods identified above. However, I was unable to determine the level of sales specifically attributed to UK. I was also unable to determine the level of exposure of the **ICON** mark to consumers as there was no information regarding circulation or online views of the magazine articles the **ICON** branded items were featured in. The opponent states that its UK website received over 10 million sessions according to Google analytics between 2015 and 2023<sup>25</sup> but has not provided any further information on what sales resulted from these sessions for **ICON** branded items, or indeed what **ICON** branded items were available for sale. I also noted that **ICON** was used solus but also with the house mark DSQUARED2. To my mind the significance of the collaborations with the famous celebrities is likely to result in the house mark DSQUARED2 holding the reputation rather than the **ICON** brand which,

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<sup>25</sup> Stefania Panigada's first witness statement, paragraph 24.

as I identified when used as an emblazoning on a garment, was less likely to be seen as a trade mark and more likely to be seen as a descriptor of the wearer.

70. Overall, I find that the opponent has not demonstrated the requisite reputation. As such the opposition brought under Section 5(3) falls at this hurdle.

#### **Section 5(4)(a)**

71. Under section 5(4)(a), the opponent relies on the sign **ICON** for which it has claimed use in the UK since 2015 for the goods and services set out in Annex 1 of this decision.

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

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

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

(aa) [...]

(b) [...]

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

73. 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.”

74. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

75. In *Reckitt & Colman Products Limited v Borden Inc. & Ors*,<sup>26</sup> Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

“First, [the plaintiff] must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”

76. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

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<sup>26</sup> [1990] RPC 341, HL, page 406.

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

## Relevant date

77. In terms of the relevant date for assessment of section 5(4)(a), in *Advanced Perimeter Systems Limited v Multisys Computers Limited*,<sup>27</sup> Mr Daniel Alexander QC (as he was then), sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in SWORDERS Trade Mark:<sup>28</sup>

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

78. The application has a priority date of 12 May 2023. Therefore, all factors will be assessed as at that date.

## Goodwill

79. The first hurdle for the opponent is to show that they had the required goodwill at the relevant date. The issue of what constitutes goodwill was discussed in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd*<sup>29</sup> viz,

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

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<sup>27</sup> BL O-410-11

<sup>28</sup> BL O-212-06

<sup>29</sup> [1901] AC 217 (HOL)

80. In *Smart Planet Technologies, Inc. v Rajinda Sharm*<sup>30</sup>, Mr Thomas Mitcheson QC (as he was then), sitting 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.”*

81. Goodwill arises as a result of trading activities and accrues to the business that the public thinks is responsible for the goods and services. The relevant market for assessing goodwill is the UK. I reviewed the opponent’s evidence earlier in the decision and though the opponent did not furnish me with turnover details specifically attributed to the UK, I will proceed on the basis that at least some proportion of the figures given by the opponent come from UK sales. As such I will carry out the assessment on the basis that the opponent has established a protectable goodwill in its **ICON** sign at the relevant date for *caps, sweatshirts, t-shirts, shirts, gilets, pants, shorts, overalls, pyjamas and trainers* and for *retail services in relation to caps, sweatshirts, t-shirts, shirts, gilets, pants, shorts, overalls, pyjamas and trainers*.

### **Misrepresentation**

82. I will now go on to consider the second hurdle, that of misrepresentation. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

*“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is*

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<sup>30</sup> BL O/304/20

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

83. On the subject of how many of the relevant public must be deceived or confused for the opponent to be successful in a claim under this ground, I bear in mind the decision in *Lumos Skincare Limited v Sweet Squared Limited and others*<sup>31</sup>, where Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's

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<sup>31</sup> [2013] EWCA Civ 590.

actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

84. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires “a substantial number of members of the public are deceived” rather than whether the “average consumers are confused”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*<sup>32</sup>, it is doubtful whether the difference between the legal tests will produce different outcomes. In my view, this is the case here. Whilst I accept that the opponent has demonstrated sufficient goodwill in those clothing goods set out above, its claim under Section 5(4)(a) does not provide any better an outcome than for section 5(2)(b). Therefore I do not need to consider this ground further.

### **Overall conclusion**

85. The opposition has succeeded.

### **Costs**

86. The opponent has been successful in these proceedings. As such it is entitled to a contribution towards the costs incurred. Awards of costs for proceedings commenced after 1 February 2023 are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. Bearing in mind the guidance given in that TPN, I award costs as follows:

£200 Official fee

£500 Preparing Notice of Opposition and considering counterstatement

£1000 Preparing evidence and considering other side's evidence

£1300 Preparation for and attending the hearing

**£2800 Total**

100. I order Roadget Business Pte.Ltd to pay DQUARED2 TRADEMARKS LIMITED the sum of £2800. This sum is to be paid within 21 days of the expiry of the appeal

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<sup>32</sup> [2012] EWCA (Civ) 1501

period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 10<sup>th</sup> day of August 2026**

**June Ralph**

**For the Registrar**

**The Comptroller-General**

## **Annex 1**

Goods and services claimed by the opponent under section 5(4)(a):

Sunglasses; eyewear, spectacles; pince-nez cases, chains for spectacles; contact lenses; containers for contact lenses; correcting lenses (optics); cords for spectacles; eyeglass frames and optical goods; none of the aforesaid goods in the field of electric meters.

Leather and imitation leather, animal skins; trunks and suitcases; umbrellas and parasols; walking sticks; whips, harness and saddlery, card cases (wallets); key cases (leather goods); attaché cases; briefcases (leather goods), attaché cases, document portfolios [cases]; moleskin (imitation leather), imitation leather; beach umbrellas; whips and saddlery goods, wallets; coin purses not of precious metal; handbags, backpacks, wheeled bags, bags for climbers, bags for campers, travel bags, beach bags, school bags, shopping bags; suitcases and boxes designed to contain toiletries; travel sets (leather goods); toiletry sets and make- up bags (empty); collars and clothing for animals; net bags for shopping; bags and net bags for shopping; bags and small bags (envelopes, pouches) of leather for packaging.

Clothing; footwear, headgear; shirts; clothing of leather or imitation leather; clothing items, women's clothing; men's clothing; clothing for children and babies; hoods (clothing); belts (clothing); gloves (clothing); sashes for wear; scarves; shawls, neckties, hosiery; socks; shoes; bedroom slippers; clothing for sports, skiing and the beach; swaddling clothes; underwear, coats; overalls; short-sleeved shirts; tee-shirts; turtlenecks; slips (underwear); suits; trousers; jackets; pullovers; vests; sweaters; dresses; shirt yokes; shirt fronts; ready- made linings (parts of clothing); stuff jackets; pelerines; gabardines (clothing); waterproof clothing; pockets for clothing, pocket squares; jerseys (clothing); knitwear (clothing); underwear (lingerie); dressing gowns.

Retail services, online retail services and mail order retail services in relation to clothing, footwear, headgear, jewellery, precious stones, watches, clocks, precious metals and their alloys, bracelets, brooches, cufflinks, perfumery, cosmetics, skincare; retail services, online retail services and mail order retail services in relation to medals, ornaments, shoe ornaments, objects of imitation gold, ornamental pins, tie pins, tie

clips and watch straps; retail services, online retail services and mail order retail services in relation to leather and imitations of leather, bags, travelling bags, cases, suitcases, briefcases, straps of leather or imitation leather, handbags, garment bags, haversacks, rucksacks, trunks, purses, wallets, key cases, pouches, canes, sticks, saddlery and belts; advertising; marketing; promotional services; organisation, operation and supervision of loyalty programmes and of sales and promotional incentive schemes; fashion show exhibitions for commercial purposes; advertising and marketing services provided by means of social media; information, advisory and consultancy services in relation to the aforesaid services.