

O/0763/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003684694

BY CHLOEDIGITAL LIMITED

TO REGISTER THE TRADE MARK:

chloédigital

IN CLASSES 16, 25 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 430183 BY

CHLOE, SOCIÉTÉ PAR ACTIONS SIMPLIFIÉE

BACKGROUND AND PLEADINGS

1. On 22 August 2021, CHLOEDIGITAL Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 15 October 2021 and registration is sought for the goods and services set out in Annex 1 to this decision.

2. On 14 January 2022, the application was opposed by CHLOE, Société par actions simplifiée (“the opponent”) based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b), the opponent relies upon the following trade marks:

Chloé

UKTM no. 1141453

Filing date 7 October 1980; registration date 7 October 1980

(“the First Earlier Mark”)

CHLOE

UKTM no. 1371787

Filing date 28 January 1989; registration date 11 September 1992

(“the Second Earlier Mark”)

CHLOE

UKTM no. 801544207

Filing date 12 June 2020; registration date 23 December 2020

(“the Third Earlier Mark”)

3. The section 5(2)(b) opposition based upon the First and Second Earlier Marks is directed at the applicant’s class 25 goods only, and the section 5(2)(b) opposition based upon the Third Earlier Mark is directed at the applicant’s class 42 services only. The opponent relies upon the goods and services set out in Annex 2 to this decision. The opponent claims that the goods and services are identical or similar and that the marks are similar, with the result that there is a likelihood of confusion.

4. Under section 5(3), the opponent relies upon the First, Second and Third Earlier Marks. It also relies upon the following marks:

CHLOE

UKTM no. 1187760

Filing date 30 December 1982; registration date 30 December 1982

("the Fourth Earlier Mark")

CHLOE

UKTM no. 1252938B

Filing date 24 October 1985; registration date 24 October 1985

("the Fifth Earlier Mark")

CHLOE

UKTM no. 910951762

Filing date 8 June 2012; registration date 29 November 2012

("the Sixth Earlier Mark")

5. The opposition under this ground is directed at the application in its entirety. The opponent claims a reputation for the goods and services set out in Annex 2 to this decision. The opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character or repute of the earlier marks.

6. Under section 5(4)(a), the opponent relies upon the sign CHLOE which it claims to have used throughout the UK since approximately the mid-1950s in relation to "clothing, perfumery/cosmetics, eyewear, jewellery, bags, leather goods, clothing and fashion accessories and retail services relating to the same; non-digital publications and publishing services". The opponent claims that use of the applicant's mark would be contrary to the law of passing off.

7. The applicant filed a counterstatement denying the claims made. Although the applicant originally sought to put the opponent to proof of use of the Sixth Earlier Mark in relation to class 42 services, the Registry wrote out to the applicant to clarify that

the opponent relied upon only its class 35 services in relation to that mark and, consequently, the proof of use request was unnecessary.

8. The applicant is represented by Amagufa Solutions Limited and the opponent is represented by HGF Limited.

9. Both parties filed evidence in chief. The opponent did not file evidence in reply. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

10. The opponent filed evidence in chief in the form of the witness statement of Ascher Sabbah dated 13 December 2022, accompanied by 12 exhibits. Mr Sabbah is Chief Financial Officer for the opponent, a position he has held since 8 January 2019. His evidence goes to the use and reputation of the opponent's marks.

11. The applicant filed evidence in the form of the witness statement of Chloe Watts dated 14 February 2023, which is accompanied by 7 exhibits. Ms Watts is the founder, main shareholder and sole director of the applicant. Her evidence discusses the applicant's use of the applied-for mark, the reason for the choice of name and the market within which the applicant operates.

12. The applicant's evidence was accompanied by written submissions dated 14 February 2023.

13. Both parties' submissions in lieu were dated 6 April 2023.

14. I have taken the evidence and submissions into consideration in reaching my decision and will refer to them below where necessary.

DECISION

Section 5(2)(b)

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

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

(a)...

(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.”

16. 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.”

17. The trade marks upon which the opponent relies qualify as earlier trade marks pursuant to their earlier filing dates. No request for proof of use has been made in respect of the goods and services relied upon and, consequently, the opponent is entitled to rely upon the full breadth of its specifications.

18. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia*

Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P:

(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 be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, is not sufficient;

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

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

Comparison of goods and services

19. As noted above, the opponent's section 5(2)(b) claim is directed at the applicant's class 25 goods and class 42 services only. With that in mind, the competing goods and services are as follows:

Opponent's goods and services	Applicant's goods and services
<p>The First Earlier Mark <u>Class 25</u> Articles of clothing for women and children.</p>	<p><u>Class 25</u> Clothing, footwear, headwear; aprons [clothing]; babies' pants [underwear]; bandanas [neckerchiefs]; bath robes; bathing suits / swimsuits; bathing trunks / bathing drawers; beach clothes; bibs, not of paper; bibs, sleeved, not of paper; clothing containing slimming substances; clothing for gymnastics; clothing incorporating LEDs; clothing of imitations of leather; clothing of leather; clothing; coats; dresses; dressing</p>
<p>The Second Earlier Mark <u>Class 25</u> Articles of clothing included in class 25 for women.</p>	
<p>The Third Earlier Mark <u>Class 9</u></p>	

Downloadable files containing digital models of perfume bottles, cream bottles, cosmetic bottles, watches and watch parts (such as watchbands, watch dials), glasses, sunglasses, jewelry, handbags, coin purses, wallets, key rings, clothes, belts, foulards, shoes, leather accessories, cufflinks, writing instruments, stationery, in particular for use in product development, in product life cycle management, in production and manufacturing (for example, 3D printing), in product data management, in computer games and downloadable applications, especially on mobile telephones and/or tablets and in visual effects and visual simulations of all types; video games; downloadable applications, especially on mobile telephones and/or tablets.

Class 42

Computer programming services, namely creating content for virtual and 3D goods.

gowns; ear muffs [clothing]; embroidered clothing; fingerless gloves; gloves [clothing]; hats; headbands [clothing]; headscarves / headscarfs; headwear; heels; hoods [clothing]; hosiery; jackets [clothing]; jerseys [clothing]; knickers / panties; knitwear [clothing]; latex clothing; layettes [clothing]; leggings [leg warmers] / leg warmers; leggings [trousers]; leotards; mittens; money belts [clothing]; outerclothing; pyjamas / pajamas; ready-made clothing; sandals; scarves / scarfs; shirts; shoes; short-sleeve shirts; skirts; sleep masks; slippers; slips [underclothing]; socks; sweat-absorbent socks; sweat-absorbent stockings; sweat-absorbent underwear / sweat-absorbent underclothing; sweaters / jumpers [pullovers] / pullovers; tee-shirts; tights; underwear / underclothing; waterproof clothing.

Class 42

Computer security consultancy; computer software consultancy; computer software consultancy; computer system design; computer technology consultancy; computer virus protection services; rental of computer software; consultancy in the design and development of computer hardware; creating and designing website-based

	<p>indexes of information for others; creating and maintaining websites for others; data security consultancy; development of computer platforms; graphic arts design; graphic design of promotional materials; hosting computer sites; information technology [IT] consultancy; information technology services provided on an outsourcing basis; providing information relating to computer technology and programming via a website; internet security consultancy; maintenance of computer software; packaging design; platform as a service [PaaS]; server hosting; software as a service [SaaS]; technological consultancy; website design consultancy; all of the aforesaid services relating to the provision of technical support and digital strategy advice to influencers to enable them to build and maintain their online presence and none of the aforesaid relating to the creation of content for virtual and 3D goods.</p>
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20. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 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.”

21. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, 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.”

23. The applicant submits that the users of the goods are different; for the opponent, it states, the users are “consumers” (which I take to mean members of the general public) and for the applicant, it states, the users are “professional and semi-professional digital influencers and content creators”. Whilst that may be the case in practice, I must undertake a notional assessment of the similarity of the parties’ goods and services, taking into account all of the ways in which the marks may be used (not just the ways in which they are used in practice). Consequently, I do not consider that this line of argument assists the applicant.

Class 25

Clothing; aprons [clothing]; babies' pants [underwear]; bandanas [neckerchiefs]; bath robes; bathing suits / swimsuits; bathing trunks / bathing drawers; beach clothes; bibs, not of paper; bibs, sleeved, not of paper; clothing containing slimming substances; clothing for gymnastics; clothing incorporating LEDs; clothing of imitations of leather; clothing of leather; clothing; coats; dresses; dressing gowns; ear muffs [clothing]; embroidered clothing; fingerless gloves; gloves [clothing]; hoods [clothing]; hosiery; jackets [clothing]; jerseys [clothing]; knickers / panties; knitwear [clothing]; latex clothing; layettes [clothing]; leggings [leg warmers] / leg warmers; leggings [trousers]; leotards; mittens; money belts [clothing]; outerclothing; pyjamas / pajamas; ready-made clothing; scarves / scarfs; shirts; short-sleeve shirts; skirts; slippers [underclothing]; socks; sweat-absorbent socks; sweat-absorbent stockings; sweat-absorbent underwear / sweat-absorbent underclothing; sweaters / jumpers [pullovers] / pullovers; tee-shirts; tights; underwear / underclothing; waterproof clothing.

24. All of these terms in the applicant’s specification are either identical on the principle outlined in *Merix* to “articles of clothing for women and children” in the specification of the First Earlier Mark and/or “articles of clothing included in class 25 for women” in the specification of the Second Earlier Mark. To the extent that any of these terms are not identical on the principle outlined in *Merix* to the opponent’s goods, they will overlap in nature, method of use, purpose, trade channels and user and will be highly similar.

Footwear, headwear; hats; headbands [clothing]; headscarves / headscarfs; headwear; heels; sandals; shoes; sleep masks; slippers.

25. All of these terms in the applicant's specification are types of footwear or headgear. In my view, they will be sold through the same trade channels and to the same users as "articles of clothing for women and children" in the specification of the First Earlier Mark and/or "articles of clothing included in class 25 for women" in the specification of the Second Earlier Mark. The method of use will overlap to the extent that they will all be worn on the body and their purpose will overlap to the extent that they are to provide some sort of protection/covering for the body. The specific natures will clearly differ. There is no competition or complementarity. I consider the goods to be similar to a medium degree.

Class 42

26. In its written submissions in lieu, the opponent has dealt with the applicant's class 42 services in 3 different categories. I will adopt these groupings, breaking them down further where I consider it necessary to do so.

Computer security consultancy; computer software consultancy; computer software consultancy; computer technology consultancy; consultancy in the design and development of computer hardware; data security consultancy; information technology [IT] consultancy; information technology services provided on an outsourcing basis; providing information relating to computer technology and programming via a website; internet security consultancy; technological consultancy; website design consultancy; all of the aforesaid services relating to the provision of technical support and digital strategy advice to influencers to enable them to build and maintain their online presence and none of the aforesaid relating to the creation of content for virtual and 3D goods.

27. The opponent submits as follows:

"The Opponent acknowledges that consultancy services on software differ in nature and method of use to the Opponent's class 9 goods. However, there are

points of convergence between the goods and services and complementarity between consulting on software and providing a piece of software. Also, companies that provide software can also consult on software and technology services and IT consultancy is often available in the same places customers would go to purchase software.”

28. The opponent’s “downloadable applications, especially on mobile telephones and/or tablets” are a type of software and are not subject to any limitation. Consequently, I accept the opponent’s submission that there would be an overlap in trade channels between these goods and the terms *computer software consultancy; computer software consultancy; computer technology consultancy; providing information relating to computer technology and programming via a website; technological consultancy; information technology [IT] consultancy; information technology services provided on an outsourcing basis; all of the aforesaid services relating to the provision of technical support and digital strategy advice to influencers to enable them to build and maintain their online presence and none of the aforesaid relating to the creation of content for virtual and 3D goods*. There will also, clearly, be an overlap in user. I also agree with the opponent’s submission that the goods and services are complementary. The nature, method of use and purpose of the goods and services clearly differ. Consequently, I consider them to be similar to a medium degree.

29. *Computer security consultancy and data security consultancy; all of the aforesaid services relating to the provision of technical support and digital strategy advice to influencers to enable them to build and maintain their online presence and none of the aforesaid relating to the creation of content for virtual and 3D goods* in the applicant’s specification are specialist types of consultancies which are not specifically related to software. I accept that there may be an overlap in purpose with the opponent’s “downloadable applications, especially on mobile telephones and/or tablets” because they may all be aimed at securing the user’s devices. To that extent, a user may purchase an application which is aimed at protecting the device/computer on which it is downloaded. The users could clearly overlap. Whilst there may be some competition, I consider this to be very limited given that a mobile application is unlikely to fulfil the role of a consultant specialising in this area. There may also be

complementarity. Consequently, I consider the goods and services to be similar to a medium degree.

30. This is in contrast to *internet security consultancy; all of the aforesaid services relating to the provision of technical support and digital strategy advice to influencers to enable them to build and maintain their online presence and none of the aforesaid relating to the creation of content for virtual and 3D goods* which relates specifically to internet security. In my view, this is unlikely to be something for which you could download an application. Consequently, I consider it unlikely that there will be any overlap in purpose with the opponent's class 9 goods. I also do not consider it likely that there will be an overlap in trade channels and I have no evidence before me to suggest such an overlap. The nature and method of use clearly differ. I accept that there may be some overlap in user. However, there is no competition or complementarity. Consequently, I consider the goods and services to be dissimilar. I cannot identify any other goods or services in the opponent's specification which put it in any stronger position.

31. Similarly, *consultancy in the design and development of computer hardware; website design consultancy; all of the aforesaid services relating to the provision of technical support and digital strategy advice to influencers to enable them to build and maintain their online presence and none of the aforesaid relating to the creation of content for virtual and 3D goods* are services with specific purposes that are unlikely to overlap with the opponent's goods and services. They are not related to software and, consequently, are unlikely to overlap in trade channels (and I have no evidence before me that they would). The method of use and nature will clearly differ. There is no competition or complementarity. Consequently, I consider them to be dissimilar.

Computer system design; creating and designing website-based indexes of information for others; creating and maintaining websites for others; development of computer platforms; all of the aforesaid services relating to the provision of technical support and digital strategy advice to influencers to enable them to build and maintain their online presence and none of the aforesaid relating to the creation of content for virtual and 3D goods.

32. In relation to these services, the opponent submits as follows:

“Although the Applicant’s design and development services differ in nature and method of use to the Opponent’s “video games” and “downloadable applications”, providers of the software goods would also offer services for the development of the same.

Further, IT design/development services and software goods (such as video games or Apps) are likely to be provided via the same trade channels – e.g. an App store or a software design company that also allows users to access non-downloadable software on their website or to download software from the developer’s website.

The Opponent submits that the goods and services are similar to at least a medium degree.”

33. The applicant’s services involve the creation/maintenance of platforms, systems and websites for influencers looking to build and promote their online presence. I do not accept that there is an overlap with the opponent’s “video games” and “downloadable applications, especially on mobile telephones and/or tablets” and I have no evidence before me to suggest that there would be. However, I accept that there is some overlap in nature and user with the opponent’s “computer programming services, namely creating content for virtual and 3D goods”. Whilst the limitation to the applicant’s services put these further away than they might otherwise have been, there is still some overlap. The purpose will clearly differ and I consider it unlikely that there would be an overlap in trade channels. However, there may be an overlap in method of use. Consequently, I consider them to be similar to a medium degree.

Computer virus protection services; rental of computer software; hosting computer sites; maintenance of computer software; platform as a service [PaaS]; server hosting; software as service [SaaS]; all of the aforesaid services relating to the provision of technical support and digital strategy advice to influencers to enable them to build and maintain their online presence and none of the aforesaid relating to the creation of content for virtual and 3D goods.

34. In relation to these services, the opponent submits as follows:

“We submit that these services must be considered alongside the Opponent’s Class 9 “video games” and “software applications”. Services such as “Platform as a service; software as a service” are software, albeit delivered in a different fashion to the Opponent’s goods in class 9.

These goods and services share the same purpose, channels of trade and end-users and are similar to at least a medium degree.”

35. I accept the opponent’s submission in relation to *Rental of computer software; platform as a service [PaaS]; software as a service [SaaS]; all of the aforesaid services relating to the provision of technical support and digital strategy advice to influencers to enable them to build and maintain their online presence and none of the aforesaid relating to the creation of content for virtual and 3D goods* in the applicant’s specification. All of these services could overlap with the opponent’s “downloadable applications, especially on mobile telephones and/or tablets” which is not limited in purpose. There may also be an overlap in trade channels and user. I consider the goods and services to be in competition. Consequently, they are similar to between a medium and high degree.

36. I do not consider that the same applies to *hosting computer sites; server hosting; all of the aforesaid services relating to the provision of technical support and digital strategy advice to influencers to enable them to build and maintain their online presence and none of the aforesaid relating to the creation of content for virtual and 3D goods* in the applicant’s specification. These services are quite distinct from those in the opponent’s specification (or, indeed, the opponent’s goods) and I can see no point of overlap in purpose, nature, trade channels or method of use. There is no competition or complementarity. I accept that there will be an overlap in user, but that is not sufficient for a finding of similarity. I consider the services to be dissimilar.

37. I accept that *computer virus protection services* may overlap with the opponent’s “downloadable applications, especially on mobile telephones and/or tablets” to a

medium degree for the same reasons set out above in relation to the opponent's other computer security related services.

38. That leaves *maintenance of computer software; all of the aforesaid services relating to the provision of technical support and digital strategy advice to influencers to enable them to build and maintain their online presence and none of the aforesaid relating to the creation of content for virtual and 3D goods* in the applicant's specification. I accept that there is likely to be an overlap in trade channels between these services and the opponent's "downloadable applications, especially on mobile telephones and/or tablets" because the same businesses that provide software applications are also likely to be responsible for maintaining them. The users will clearly overlap, and I consider the goods and services to be complementary. The nature, method of use and purpose of the goods and services clearly differ. I consider them to be similar to a medium degree.

Graphic arts design; graphic design of promotional materials; packaging design; all of the aforesaid services relating to the provision of technical support and digital strategy advice to influencers to enable them to build and maintain their online presence and none of the aforesaid relating to the creation of content for virtual and 3D goods.

39. I have no submissions from the opponent in relation to these services. I can see no point of overlap with the opponent's specification and, in my view, they are dissimilar.

40. As some degree of similarity of goods and services is essential for a likelihood of confusion, the opposition based upon section 5(2)(b) must fail in relation to those services that I have found to be dissimilar.

The average consumer and the nature of the purchasing act

41. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc*,

Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

42. The average consumer for the parties’ goods and services is likely to be either a member of the general public or a business user. The cost of the goods and services will vary, as will the frequency of purchase. However, even where the cost is low, various factors will still be taken into account. For example, for clothing goods the user might consider aesthetics, materials and durability. For software goods the user might consider functionality and ease of use. For the services, the user is likely to consider factors such as customer service standards, suitability for particular requirements and reputation. Consequently, I consider that at least a medium degree of attention will be paid during the purchasing process. However, I recognise that for some of the more technical goods and services, or where they will have an impact on the user’s business/security, a higher level of attention may be paid.

43. The goods and services are likely to be purchased following perusal of signage on physical premises, labels, advertisements or websites. Consequently, visual considerations will dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants or word-of-mouth recommendations may be made.

Comparison of trade marks

44. 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 marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

45. 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.

46. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p style="text-align: center;">Chloé (the First Earlier Mark)</p> <p style="text-align: center;">CHLOE (the Second and Third Earlier Marks)</p>	<p style="text-align: center;">chloédigital</p>

47. The applicant's mark consists of the conjoined words chloédigital. There are no other elements to contribute to the overall impression which lies in the combination of these words. However, I note that the word 'digital' will not be distinctive for the applicant's class 42 services. The First Earlier Mark consists of the word CHLOE, in

title case, with an accent above the E. The overall impression of the mark lies in the word itself. I note that the accent may or may not be noticed by the average consumer. The Second and Third Earlier Marks consist of the word CHLOE, in upper case. There are no other elements to contribute to the overall impression which lies in the word itself.

48. In my view, there will be a significant proportion of average consumers who overlook the presence of the accent in the First Earlier Mark and the applicant's mark. Consequently, I consider that the same findings will apply to all three earlier marks for those average consumers. I will conduct my assessment on that basis.

49. Visually, the opponent's marks are replicated identically in the first five letters of the applicant's mark. The only point of difference is the word DIGITAL in the applicant's mark which has no counterpart in the First Earlier Mark. I consider them to be visually similar to between a medium and high degree.

50. Aurally, the opponent's marks are likely to be pronounced KLO-EEE or KLO-AYE. The applicant's mark will be pronounced KLO-EEE-DIG-ITT-ALL or KLO-AYE-DIG-ITT-ALL. In my view, the marks are aurally similar to between a medium and high degree.

51. Conceptually, the word CHLOE will be recognised as a female forename. The word DIGITAL in the applicant's mark will be given its ordinary dictionary meaning. It is the only point of conceptual difference between the marks, although not a distinctive one for the class 42 services. I consider the marks to be conceptually similar to between a medium and high degree.

Distinctive character of the earlier trade marks

52. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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 originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

53. 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 and services, 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.

54. I will begin by assessing the inherent distinctiveness of the earlier marks. They all consist of the female forename CHLOE. This is a common first name in the UK and I consider it to be inherently distinctive to a medium (or average) degree. I do not consider that the accent in the First Earlier Mark increases its distinctive character.

55. I will now consider whether the distinctiveness of the earlier marks have been enhanced through use. The relevant market for assessing enhanced distinctiveness is the UK market. In this regard, I note the following from the opponent’s evidence:

- a) The opponent operates 10 boutiques in the UK, including at famous retailers such as Harrods, Selfridges and Harvey Nichols.
- b) Between 2016 and 2020, the opponent's website attracted over 2.3 million unique visitors from the UK.¹
- c) The following sign (in various colours) appears on the opponent's website and applied to goods on the websites of third-party retailers:²



The First Earlier Mark also appears, in title case.

These websites display goods such as women's jumpsuits, tops, sweaters, trousers, jackets, dresses, cardigans, shirts, flat and heeled sandals, trainers, tote bags, shoulder bags, card holders, purses, perfume, ballet shoes, ankle boots, cross body bags, sunglasses, clutch bags, bangles and jumpers.

- d) The opponent has provided the following wholesale turnover figures for the UK:

2020	In excess of £9million
2021	In excess of £9million

I note that only part of the figures for 2021 will relate to the period prior to the relevant date.

- e) Invoices have been provided dated between 9 November 2018 and 8 July 2022 addressed to UK customers which display the following mark:³

¹ Exhibit AS4

² Exhibit AS3 and AS5A

³ Exhibit AS5B

Chloé

Of those dated prior to the relevant date, they refer to goods including jackets, boots, dresses, day bags, mini bags, ankle boots, sunglasses, trousers, tops, gold charms, bracelets and earrings. I note that, for example, the opponent's day bags sell for in excess of £1,400 each and a jacket is priced at in excess of £1,800.

- f) The opponent has provided the following information regarding advertising spend in the UK:

2016	In excess of £900,000
2017	In excess of £1million
2018	In excess of £200,000
2019	In excess of £400,000
2020	In excess of £400,000

- g) I note that the opponent's perfumes, women's clothing, jewellery and bags have been advertised in various publications including *Grazia* (March 2016), *Look*, *The Sunday Times Style*, *Elle* and *Harper's Bazaar* (July 2017), *Cosmopolitan* and *Marie Claire* (January 2018), *Vogue* (October 2019) and *Harper's Bazaar* (February 2021).⁴

- h) An article in *Who What Wear UK* describes the opponent's handbags as one of the "most popular designer bags ever created".⁵

56. There are clearly issues with the opponent's evidence. I have no breakdown of the turnover figures provided to enable me to assess what proportion of them relate to the goods relied upon. Clearly, there is no evidence of use in relation to the class 9 goods and class 42 services for which the Third Earlier Mark is registered. In relation to class

⁴ Exhibit AS6

⁵ Exhibit AS9

25 goods, I must look at the evidence as a whole and it seems clear to me that the opponent is a well-known fashion house that produces a broad range of women's clothing. Consequently, I consider that the distinctiveness of the First and Second Earlier Marks has been enhanced through use to between a reasonably high degree in relation to women's clothing.

Likelihood of confusion

57. 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 and services down to the responsible undertaking 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 and 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 and 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 has retained in his mind.

58. I have found as follows:

- a) The goods and services vary from being identical to similar to a medium degree (except where I have found them to be dissimilar).
- b) The average consumer will be a member of the general public or a business user, who will pay at least a medium degree of attention (although the level of attention paid may be higher for some of the goods and services).

- c) The purchasing process will be predominantly visual, although I do not discount an aural component.
- d) The marks are visually, aurally and conceptually similar to between a medium and high degree.
- e) The earlier marks are inherently distinctive to a medium (or average) degree. The distinctiveness of the First and Second Earlier Marks has been enhanced through use to a between a reasonably high degree in relation to women's clothing.

59. In relation to the applicant's 25 goods, I consider it unlikely that the marks will be mistakenly recalled or misremembered as each other, as the word DIGITAL will be distinctive for these goods and is unlikely to be overlooked. I note the applicant's submission that because the earlier marks are well known, consumers are more likely to notice the difference between the marks. However, that is not what the law tells us. The law is clear that the more well known a mark, the more likely it is that confusion will occur. In my view, the enhanced distinctiveness of the First and Second Earlier Marks for women's clothing means that the average consumer is likely to conclude that only one undertaking would be using the word CHLOE/Chloé in relation to these goods. Consequently, they will conclude that the marks originate from the same or economically linked undertakings and there will be indirect confusion.

60. In relation to the applicant's class 42 services, I consider the word DIGITAL to be non-distinctive and, consequently, it may be overlooked by the average consumer, resulting in a likelihood of direct confusion. Even if the difference is recognised, I consider that the average consumer will conclude that this mark indicates a different branch of the same undertaking, resulting in a likelihood of indirect confusion. This will apply where I have found the goods to be similar to at least a medium degree.

Proposed fall back specification

61. In its written submissions in lieu, the applicant proposed the following amendment to class 25 in order to overcome the opposition:

“...all of the aforesaid goods only as free marketing merchandise relating to the provision of technical support and digital strategy advice to influencers to enable them to build and maintain their online presence.”

This limitation does not relate to a sub-category of the goods themselves, but refers to the way in which the applicant intends to use them. Consequently, this is not an acceptable limitation. In any event, given that the opponent’s specification is not limited, this would not overcome the opposition as these goods would still be identical or similar to the opponent’s goods.

62. In relation to the applicant’s class 42 services, it proposes the following fall back specification:

“...none of the aforesaid services relating to computer services for registering, managing and tracking computer network domain names, domain name registry services, namely, coordinating the registration of domain names for identification of users and internet protocol addresses on the Internet or verification of identities for the purpose of permitting or denying access to information and services.”

No explanation is provided as to how this would overcome the opposition. In my view, it clearly would not. It does not appear to put the applicant’s services further away from those with which they conflict in the opponent’s specification.

63. The opposition based upon section 5(2)(b) succeeds in relation to all goods and services, with the exception of the following:

Class 42 Consultancy in the design and development of computer hardware; graphic arts design; graphic design of promotional materials; hosting computer sites; internet security consultancy; packaging design; server hosting; website design consultancy.

Section 5(3)

64. 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 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.”

65. 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.”

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

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

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *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'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails

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

67. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks and the applicant's mark are similar. Secondly, the opponent must show that the earlier marks have 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 marks will cause the public to make a link between them in the sense of the earlier marks being brought to mind by the later 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 purpose of section 5(3) that the goods and 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

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

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

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

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

69. In determining whether the opponent has demonstrated a reputation for the goods and services relied upon, it is necessary for me to consider whether its marks will be known by a significant part of the public concerned with those goods and services. 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 undertaking in promoting it".

70. I have already summarised the opponent's evidence of use above. In my view, it demonstrates a reasonably strong reputation for women's clothing (for which the First and Second Earlier Marks are registered). There is less evidence in relation to the opponent's handbags. However, given that there is a reasonable amount of examples of them being advertised in well known publications and they have been described as one of the most iconic, I will proceed on the basis that the opponent also has a modest reputation for handbags (for which the Fifth Earlier Mark is registered). Whilst there is some evidence of use in relation to jewellery, perfumes and other leather goods, I do not consider the evidence provided sufficient to establish the extent of the use or to justify a finding of reputation for these goods.

Link

71. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

I have found the marks to be visually, aurally and conceptually similar to between a medium and high degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

I consider the applicant's class 25 goods to be identical or similar to the goods for which the opponent has a reputation.

I can see no point of similarity between the applicant's class 42 services and the goods for which the opponent has a reputation.

In relation to the applicant's class 16 goods, the opponent claims that these are "a neighbouring market" to fashion goods. In this regard, the opponent relies upon Exhibit AS12 which shows that:

- 1) Louis Vuitton sells notebook covers, pencil cases and clothing.
- 2) Cartier sells jewellery, bags and stationery.
- 3) Mulberry sells stationery.
- 4) Montblanc sells pens, pencil cases and bags.
- 5) Gucci sells notepads and pencil cases.
- 6) S. T. Dupont sells leather goods (including bags) and fountain pens.

None of these exhibits are dated. However, I accept that they show that some retailers sell a range of goods which includes the goods for which the opponent has a reputation and (a very limited number of) goods within the applicant's class 16 specification. This evidence does not establish that this is common practice and, in my view, does not go so far as to suggest that these are neighbouring markets; it simply shows that there are some very limited

instances of cross-over, normally where a business has reached the pinnacle of reputation within its chosen field (such as Montblanc for pens or Cartier for jewellery).

The goods clearly differ in nature, method of use and purpose. They are unlikely to overlap in trade channels, and any cross over will be at a very general level and relate to retailers that sell a range of goods. The users will clearly overlap, but that is at a very superficial level, simply because they are all consumer goods. There is no competition or complementarity. In my view, the goods are dissimilar.

The strength of the earlier mark's reputation

The earlier marks have reasonably strong reputation for women's clothing and a modest reputation for handbags.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

The earlier mark is inherently distinctive to a medium (or average) degree and this has been enhanced through use to a reasonably high degree in relation to women's clothing and to a slightly higher than medium degree in relation to handbags.

Whether there is a likelihood of confusion

I have found there to be a likelihood of confusion in relation to the class 25 goods.

As I have found the class 16 goods and the class 42 services in the applicant's specification to be dissimilar to the goods for which the opponent has a reputation, there can be no likelihood of confusion.

72. For the applicant's class 25 goods, given the similarity between the marks and the applicant's goods and the goods for which the opponent has a reputation, a link will clearly be made in the mind of the relevant public. For the applicant's class 16 goods and class 42 services, I consider the distance between them and the goods for which the opponent has a reputation to be sufficient to avoid a link being made. If a link is made, it will be too fleeting for damage to arise.

Damage

73. I must now consider whether any of the types of damage pleaded will arise.

74. The opponent submits as follows:

"The Applicant will benefit from the Opponent's investment in the advertising and promotion of its mark, leading to an unfair advantage to the Applicant. The applicant is likely to gain sales, goodwill and enhanced status with its customers as a result of the association with the Opponent's marks. It will be easier for the Applicant to sell goods and services as the brand message established by the Opponent in its mark will attach to the Applicant's mark and to the goods and services sold under it, and/or the goods and services it is used for."

75. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

"80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate

case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

76. To the extent that the relevant public believe that the goods of the applicant originate from the opponent, there will clearly be unfair advantage. However, even if they do not consider that the goods originate from the same undertaking, I consider that the applicant will still gain unfair advantage. The opponent’s reasonably strong (or modest in the case of handbags) reputation for high-end/luxury goods will transfer to the applicant and the applicant will gain from familiarity with the consumer as a result of the opponent’s reputation. Consequently, I consider that damage is made out.

77. As damage is made out on the basis of unfair advantage in relation to those goods for which I have found a link, it is not necessary to consider the other heads of damage.

78. The opposition based upon section 5(3) succeeds in relation to the applicant’s class 25 goods only.

Section 5(4)(a)

79. Section 5(4)(a) of the Act states as follows:

“5(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”.

80. Subsection (4A) of section 5 of the Act 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.”

81. Again, I can deal with this ground relatively swiftly. I note that the applicant has filed evidence of use which dates back to 2013. This could be relevant in establishing an earlier relevant date. However, even if I proceed on the basis that I need only consider this ground as at the prima facie relevant date, I do not consider that it puts the opponent in any stronger position than it is under the section 5(2)(b) ground.

82. I am satisfied that the opponent has a significant goodwill for women’s clothing. Whilst the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it has been acknowledged that they are unlikely to produce different outcomes in practice.⁶ Certainly, I believe that to be the case here. For the same reasons set out above, I consider that there would be deception of a substantial number of members of the public where the applicant’s mark is used on goods which are in the same or similar field to those for which the opponent has goodwill. However, this would be a narrower range of goods and services than those for which the opposition based upon section 5(2)(b) was successful. It is for this reason that the ground does not put the opponent in any stronger position.

83. For the avoidance of doubt, my finding would not have been any different even if I had found the opponent to have goodwill for the broader range of goods shown in the evidence (i.e. bags, perfume, jewellery and purses).

⁶ *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501

CONCLUSION

84. The opposition is successful in relation to the following goods and services, for which the application is refused:

Class 25 Clothing, footwear, headwear; aprons [clothing]; babies' pants [underwear]; bandanas [neckerchiefs]; bath robes; bathing suits / swimsuits; bathing trunks / bathing drawers; beach clothes; bibs, not of paper; bibs, sleeved, not of paper; clothing containing slimming substances; clothing for gymnastics; clothing incorporating LEDs; clothing of imitations of leather; clothing of leather; clothing; coats; dresses; dressing gowns; ear muffs [clothing]; embroidered clothing; fingerless gloves; gloves [clothing]; hats; headbands [clothing]; headscarves / headscarfs; headwear; heels; hoods [clothing]; hosiery; jackets [clothing]; jerseys [clothing]; knickers / panties; knitwear [clothing]; latex clothing; layettes [clothing]; leggings [leg warmers] / leg warmers; leggings [trousers]; leotards; mittens; money belts [clothing]; outerclothing; pyjamas / pajamas; ready-made clothing; sandals; scarves / scarfs; shirts; shoes; short-sleeve shirts; skirts; sleep masks; slippers; slippers [underclothing]; socks; sweat-absorbent socks; sweat-absorbent stockings; sweat-absorbent underwear / sweat-absorbent underclothing; sweaters / jumpers [pullovers] / pullovers; tee-shirts; tights; underwear / underclothing; waterproof clothing.

Class 42 Computer security consultancy; computer software consultancy; computer software consultancy; computer system design; computer technology consultancy; computer virus protection services; rental of computer software; creating and designing website-based indexes of information for others; creating and maintaining websites for others; data security consultancy; development of computer platforms; information technology [IT] consultancy; information technology services provided on an outsourcing basis; providing information relating to computer technology and programming via a website; maintenance of computer software; platform as a service [PaaS]; software as a service [SaaS];

technological consultancy; all of the aforesaid services relating to the provision of technical support and digital strategy advice to influencers to enable them to build and maintain their online presence and none of the aforesaid relating to the creation of content for virtual and 3D goods.

85. The opposition is unsuccessful in relation to the following goods and services, for which the application may proceed to registration:

Class 16 Advertisement boards of paper or cardboard; albums / scrapbooks; announcement cards [stationery]; bags [envelopes, pouches] of paper or plastics, for packaging; books; cards / charts; catalogues; colouring books / colouring books; comic books; covers [stationery] / wrappers [stationery]; desk mats; desktop cabinets for stationery [office requisites]; document files [stationery]; document holders [stationery]; drawing instruments; drawing materials; drawing pads; drawing pens; drawing pins / thumbtacks; drawing rulers; drawing sets; embroidery designs [patterns]; envelopes [stationery]; erasing products; paper flyers; folders for papers / jackets for papers; greeting cards; index cards [stationery]; magazines [periodicals]; manifolds [stationery]; manuals [handbooks] / handbooks [manuals]; marking pens [stationery]; musical greeting cards; note books; office requisites, except furniture; padding materials of paper or cardboard / stuffing of paper or cardboard; pads [stationery]; paper; passport holders; pen cases / boxes for pens; pen clips; pencil holders; pencil lead holders; pencil leads; pencil sharpeners, electric or non-electric; pencil sharpening machines, electric or non-electric; pencils; penholders; pens [office requisites]; perforated cards for Jacquard looms; periodicals; photo-engravings; photograph stands; photographs [printed]; pictures [printed]; placards of paper or cardboard; place mats of paper; postcards; posters; printed coupons; printed publications; printers' blankets, not of textile; printing blocks; printing sets, portable [office requisites]; printing type; prints [engravings]; protective covers for books; rubber erasers; school supplies [stationery] rapers [erasers] for offices; sealing compounds for stationery purposes; signboards of paper or cardboard; silver paper; slate pencils; square

rulers for drawing; stamp pads; stamp stands; stamps [seals]; stationery; stickers [stationery]; tags for index cards; tickets; tissues of paper for removing make-up; towels of paper; trading cards, other than for games; transfers [decalcomanias] / decalcomanias; trays for sorting and counting money; type [numerals and letters] / letters [type]; wrapping paper / packing paper; writing materials; writing or drawing books; writing paper.

Class 42 Consultancy in the design and development of computer hardware; graphic arts design; graphic design of promotional materials; hosting computer sites; internet security consultancy; packaging design; server hosting; website design consultancy.

COSTS

86. As both parties have enjoyed a roughly equal degree of success, I decline to award costs.

Dated this 10th day of August 2023

S WILSON

For the Registrar

ANNEX 1

Class 16

Advertisement boards of paper or cardboard; albums / scrapbooks; announcement cards [stationery]; bags [envelopes, pouches] of paper or plastics, for packaging; books; cards / charts; catalogues; colouring books / colouring books; comic books; covers [stationery] / wrappers [stationery]; desk mats; desktop cabinets for stationery [office requisites]; document files [stationery]; document holders [stationery]; drawing instruments; drawing materials; drawing pads; drawing pens; drawing pins / thumbtacks; drawing rulers; drawing sets; embroidery designs [patterns]; envelopes [stationery]; erasing products; paper flyers; folders for papers / jackets for papers; greeting cards; index cards [stationery]; magazines [periodicals]; manifolds [stationery]; manuals [handbooks] / handbooks [manuals]; marking pens [stationery]; musical greeting cards; note books; office requisites, except furniture; padding materials of paper or cardboard / stuffing of paper or cardboard; pads [stationery]; paper; passport holders; pen cases / boxes for pens; pen clips; pencil holders; pencil lead holders; pencil leads; pencil sharpeners, electric or non-electric; pencil sharpening machines, electric or non-electric; pencils; penholders; pens [office requisites]; perforated cards for Jacquard looms; periodicals; photo-engravings; photograph stands; photographs [printed]; pictures [printed]; placards of paper or cardboard; place mats of paper; postcards; posters; printed coupons; printed publications; printers' blankets, not of textile; printing blocks; printing sets, portable [office requisites]; printing type; prints [engravings]; protective covers for books; rubber erasers; school supplies [stationery] rapers [erasers] for offices; sealing compounds for stationery purposes; signboards of paper or cardboard; silver paper; slate pencils; square rulers for drawing; stamp pads; stamp stands; stamps [seals]; stationery; stickers [stationery]; tags for index cards; tickets; tissues of paper for removing make-up; towels of paper; trading cards, other than for games; transfers [decalcomanias] / decalcomanias; trays for sorting and counting money; type [numerals and letters] / letters [type]; wrapping paper / packing paper; writing materials; writing or drawing books; writing paper.

Class 25

Clothing, footwear, headwear; aprons [clothing]; babies' pants [underwear]; bandanas [neckerchiefs]; bath robes; bathing suits / swimsuits; bathing trunks / bathing drawers; beach clothes; bibs, not of paper; bibs, sleeved, not of paper; clothing containing slimming substances; clothing for gymnastics; clothing incorporating LEDs; clothing of imitations of leather; clothing of leather; clothing; coats; dresses; dressing gowns; ear muffs [clothing]; embroidered clothing; fingerless gloves; gloves [clothing]; hats; headbands [clothing]; headscarves / headscarfs; headwear; heels; hoods [clothing]; hosiery; jackets [clothing]; jerseys [clothing]; knickers / panties; knitwear [clothing]; latex clothing; layettes [clothing]; leggings [leg warmers] / leg warmers; leggings [trousers]; leotards; mittens; money belts [clothing]; outerclothing; pyjamas / pajamas; ready-made clothing; sandals; scarves / scarfs; shirts; shoes; short-sleeve shirts; skirts; sleep masks; slippers; slips [underclothing]; socks; sweat-absorbent socks; sweat-absorbent stockings; sweat-absorbent underwear / sweat-absorbent underclothing; sweaters / jumpers [pullovers] / pullovers; tee-shirts; tights; underwear / underclothing; waterproof clothing.

Class 42

Computer security consultancy; computer software consultancy; computer software consultancy; computer system design; computer technology consultancy; computer virus protection services; rental of computer software; consultancy in the design and development of computer hardware; creating and designing website-based indexes of information for others; creating and maintaining websites for others; data security consultancy; development of computer platforms; graphic arts design; graphic design of promotional materials; hosting computer sites; information technology [IT] consultancy; information technology services provided on an outsourcing basis; providing information relating to computer technology and programming via a website; internet security consultancy; maintenance of computer software; packaging design; platform as a service [PaaS]; server hosting; software as a service [SaaS]; technological consultancy; website design consultancy; all of the aforesaid services relating to the provision of technical support and digital strategy advice to influencers to enable them to build and maintain their online presence and none of the aforesaid relating to the creation of content for virtual and 3D goods.

ANNEX 2

The First Earlier Mark

Class 25

Articles of clothing for women and children.

The Second Earlier Mark

Class 25

Articles of clothing included in class 25 for women.

The Third Earlier Mark

Class 9

Downloadable files containing digital models of perfume bottles, cream bottles, cosmetic bottles, watches and watch parts (such as watchbands, watch dials), glasses, sunglasses, jewellery, handbags, coin purses, wallets, key rings, clothes, belts, foulards, shoes, leather accessories, cufflinks, writing instruments, stationery, in particular for use in product development, in product life cycle management, in production and manufacturing (for example, 3D printing), in product data management, in computer games and downloadable applications, especially on mobile telephones and/or tablets and in visual effects and visual simulations of all types; video games; downloadable applications, especially on mobile telephones and/or tablets.

Class 42

Computer programming services, namely creating content for virtual and 3D goods.

The Fourth Earlier Mark

Class 3

Perfumes; toilet waters; soaps; non-medicated preparations for the care of the skin, for use in the bath; non-medicated preparations in the form of lotions for the care of the body.

The Fifth Earlier Mark

Class 14

Jewellery, watches, cufflinks.

Class 18

Pocket wallets, card cases included in Class 18, purses (not of precious metal or coated therewith), handbags, articles of luggage.

The Sixth Earlier Mark

Class 35

Retail store services in relation to hair lotions, perfumes, eau de toilette, eau de parfums, colognes, bath and shower preparations, soaps, body deodorants, cosmetics, creams, lotions, gels and powders for the face, body and the hands, non-medicated toilet preparations, skin creams and skin lotions, sun care preparations, make-up preparations, hair care preparations, shampoos, gels, sprays, mousses and balms for hair styling and hair care, hair lacquers, essential oils, dentifrices, anti-perspirants, after-shave, eyewear, spectacles, sunglasses, cases, containers, chains and chords for spectacles and sunglasses, portable telephone cases and holders, goods made from precious metals or semi-precious metals, goods coated with precious metals or semi-precious metals, jewellery, precious stones, watches, watch straps, watch bracelets, key fobs and keyrings of precious metal or semi-precious metals, goods made of leather and imitations of leather, wallets, coin purses, handbags, suitcases, travelling bags, card cases, key cases, key fobs, backpacks, clutch bags, beach bags, shopping bags, briefcases, sling bags for carrying infants, travelling sets, trunks, vanity cases, cosmetic bags, clothing, footwear and headgear, scarves, belts, ties, bandanas, gloves, sunvisors, socks, stockings, pantyhose, swimwear, boas, shawls, sarongs, mittens, shoulder wraps, blouses, shirts, tee-shirts, knitwear, jacket, dresses, skirts, trousers and suits, caps, hats, scarves, lingerie, sleepwear, coats, boots, shoes, slippers, provided via the internet and other computer and electronic communication networks; promotion services through provision of sponsored links to third party websites; advertising services.