

O/0776/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003717008

IN THE NAME OF RYAN MAHONEY

FOR THE SERIES OF TWO TRADE MARKS

MARNII

marnii

IN CLASSES 42 AND 45

AND

THE OPPOSITION THERETO UNDER NO. 431239

BY MARNI GROUP S.R.L.

Background and pleadings

1. On 02 November 2021, Ryan Mahoney (“the applicant”) applied to register the series of two trade marks shown on the cover page of this decision in the UK. The application was published for opposition purposes on 19 November 2021 in respect of the following services:

Class 42: *Up-dating of computer software; Design, maintenance and up-dating of computer software.*

Class 45: *Video dating services; Internet dating services; Dating services; Computer dating services; Agency services (Dating -); Dating agency services; Dating services provided through social networking; Internet based dating, matchmaking and personal introduction services.*

2. On 21 February 2022, MARNI GROUP S.R.L. (“the opponent”) opposed the application under Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) relying on the on the following five trade marks:

UK00801530528 (“The first earlier mark”)

MARNI

Filing date: 23 January 2020; Registration date: 22 September 2020

Priority date: 23 December 2019; Priority country: Italy; TM from which priority claimed: 302019000098698

Under Section 5(2)(b) the opponent relies on some of the registered services namely *bar services; cafeteria services; restaurant services* (in Class 43) and opposes some of the applied-for services, namely those in class 45, i.e. *Video dating services; Internet dating services; Dating services; Computer dating services; Agency services (Dating -); Dating agency services; Dating services provided through social networking; Internet based dating, matchmaking and personal introduction services.*

Under Section 5(3) the opponent opposes all of the applied-for services and claims that the mark has a reputation for all of the services for which it is registered, namely:

Class 35: *Bill-posting; shop window dressing; administration of consumer loyalty programs; advertising; marketing; organization of exhibitions for commercial or advertising purposes; business management services relating to franchising; business management advisory services relating to franchising; retail or wholesale services, online sales services, sales services through downloadable applications all associated with the sale of eau de Cologne, lipstick cases, balms, other than for medical purposes, hair conditioners, joss sticks, massage candles for cosmetic purposes, make-up powder, cosmetics, cosmetic creams, deodorants for human beings or for animals, detergents, other than for use in manufacturing operations and for medical purposes, air fragrance reed diffusers, cleansing milk for toilet purposes, after-shave lotions, hair lotions, lotions for cosmetic purposes, lip glosses, mascara, beauty masks, cosmetic pencils, cosmetic kits, potpourris [fragrances], cosmetic preparations for baths, toiletry preparations, cosmetic preparations for skin care, perfumery, antiperspirants [toilettries], laundry bleach, make-up preparations, shaving preparations, sachets for perfuming linen, perfumes, air fragrancng preparations, lipsticks, bath salts, not for medical purposes, cakes of toilet soap, soap, shampoos, nail polish, talcum powder, for toilet use, make-up, candles, perfumed candles, wicks for candles, lamp wicks, silver plate [knives, forks and spoons], whetstone holders, manicure sets, pedicure sets, razor cases, cutlery, knives, spoons, table knives, forks and spoons of plastic, table knives, forks and spoons for babies, scissors, table forks, nail files, eyelash curlers, razors, electric or non-electric, shaving cases, computer software applications, downloadable, containers for contact lenses, eyeglass cases, bags adapted for laptops, decorative magnets, protective helmets, riding helmets, USB flash drives, eyeglass cords, animated cartoons, computers, downloadable image files, downloadable music files, eyeglass frames, eyewear, pince-nez, anti-glare glasses, sunglasses, goggles for sports, smartglasses, eyeglasses, smartwatches, smartphones, lighting apparatus and installations, lamp globes, chandeliers, arc lamps, electric lamps, lamps, lamp shades, ceiling lights, sockets for electric lights, lampshade holders, lamp mantles, lamp reflectors, amulets [jewelry], rings [jewelry], split rings of precious metal for*

keys, spun silver [silver wire], shoe jewelry, hat jewelry, bracelets [jewelry], bracelets made of embroidered textile [jewellery], watch bands, busts of precious metal, cabochons, watch cases [parts of watches], clock cases, watch chains, chains [jewelry], clasps for jewelry, jewellery charms, charms for key rings, necklaces [jewelry], crucifixes as jewelry, crucifixes of precious metal, other than jewelry, chronographs [watches], chronometers, diamonds, tie clips, threads of precious metal [jewelry], gold thread [jewelry], jewelry findings, cufflinks, jewelry, ivory jewelry, cloisonné jewelry, jewelry of yellow amber, badges of precious metal, medals, lockets [jewelry], coins, works of art of precious metal, earrings, ornaments of jet, gold, unwrought or beaten, clocks, wristwatches, watches, control clocks [master clocks], clocks and watches, electric, pearls [jewelry], precious stones, key rings [split rings with trinket or decorative fob], retractable key rings, jewelry rolls, rosaries, presentation boxes for jewelry, boxes of precious metal, jewelry boxes, presentation boxes for watches, tie pins, pins [jewelry], ornamental pins, brooches [jewelry], jewellery hat pins, spinel [precious stones], statues of precious metal, figurine of precious metal, paste jewelry [costume jewelry], chronometric instruments, alarm clocks, jewelry, precious and semi-precious stones, plastic jewelry, stationery, books, calendars, diaries, note books, photographs [printed], paintings [pictures], framed or unframed, mounted posters, unmounted posters, pens [office requisites], fountain pens, clothing for pets, umbrella rings, saddle trees, saddlery, key cases, fastenings for saddles, harness for animals, mountaineering sticks, hiking sticks, walking sticks, umbrella sticks, vanity cases, not fitted, trunks [luggage], travelling trunks, bags, bags [envelopes, pouches] of leather, for packaging, saddlebags, beach bags, bags for sports, shopping bags, wheeled shopping bags, chain mesh purses, purses, handbags, travelling sets [leatherware], tool bags, empty, bridles [harness], reins for guiding children, bridoons, straps for soldiers' equipment, kid, game bags [hunting accessories], briefcases, conference folders, school satchels, leatherboard, cases of leather or leatherboard, halters, girths of leather, shoulder belts [straps] of leather, collars for animals, horse collars, horse blankets, covers for animals, leather cord, leather straps, straps of leather [saddlery], harness straps, straps for skates, compression cubes adapted for luggage, leather, unworked or semi-worked, labels of leather, horseshoes, moleskin [imitation of leather], umbrella covers, whips, knee-pads for horses, casings, of

leather, for springs, covers for horse saddles, pads for horse saddles, trimmings of leather for furniture, harness fittings, leather leashes, sling bags for carrying infants, imitation leather, walking stick handles, grips for holding shopping bags, umbrella handles, suitcase handles, slings for carrying infants, pouch baby carriers, cat o' nine tails, chin straps, of leather, bits for animals [harness], muzzles, parasols, blinkers [harness], umbrellas, fur, goldbeaters' skin, animal skins, cattle skins, curried skins, chamois leather, other than for cleaning purposes, parts of rubber for stirrups, business card cases, credit card cases [wallets], card cases [notecases], pocket wallets, music cases, randsels [Japanese school satchels], reins, net bags for shopping^ furniture coverings of leather, haversacks, nose bags [feed bags], bags for campers, travelling bags, bags for climbers, boxes of leather or leatherboard, boxes of vulcanized fiber, hat boxes of leather, butts [parts of hides], walking stick seats, riding saddles, leathercloth, saddlecloths for horses, stirrups, stirrup leathers, umbrella or parasol ribs, luggage tags, tefillin [phylacteries], frames for umbrellas or parasols, handbag frames, traces [harness], attaché cases, suitcases, suitcases with wheels, garment bags for travel, motorized suitcases, valves of leather, rucksacks cupboards, coatstands, benches [furniture], chests, not of metal, sideboards, settees, baskets, not of metal, console tables, picture frames, tea carts, kennels for household pets, cradles, cushions, pet cushions, covers for clothing [wardrobe], meat safes, divans, display stands, coat hangers, pillows, beds, bookcases, mannequins, furniture, nesting boxes for household pets, works of art of wood, wax, plaster or plastic, screens [furniture], armchairs, split rings, not of metal, for keys, umbrella stands, magazine racks, lap desks, chairs [scats], stools, sofas, mirrors [looking glasses], hand-held mirrors [toilet mirrors], tables, indoor window blinds of textile, trays, not of metal, fans for personal use, non-electric, bottle openers, electric and non-electric, basins [receptacles], cooking pot sets, drinking glasses, tankards, bottles, coffeepots, non-electric, mugs, shoe horns, candelabra [candlesticks], decanters, stew-pans, corkscrews, electric and non-electric, tablemats, not of paper or textile, epergnes, baskets for household purposes, crystal [glassware], mixing spoons [kitchen utensils], soap dispensers, figurines of porcelain, ceramic, earthenware, terra-cotta or glass, oven mitts, gardening gloves, toilet cases, fitted picnic baskets, including dishes, works of art of porcelain, ceramic, earthenware, terra-cotta or glass, make-up brushes, shaving brushes, combs, table

plates, saucers, soap holders, potholders, ceramics for household purposes, heat-insulated containers, piggy banks, cookie jars, nutcrackers, coffee services [tableware], liqueur sets, tea services [tableware], services [dishes], brushes, toilet sponges, make-up sponges, cups, place mats, not of paper or textile, cosmetic utensils, cooking utensils, non-electric, kitchen utensils, utensils for household purposes, toilet utensils, tableware, other than knives, forks and spoons, vases, towels of textile, bath linen, except clothing, household linen, bed linen, table linen, not of paper, tablemats of textile, picnic blankets, blankets for household pets, woollen blankets, bed throws, handkerchiefs of textile, pillowcases, foulard [fabric], flags of textile or plastic, cheviots [cloth], sheets [textile], dust ruffles, wall hangings of textile, table runners, not of paper, baby buntings, cloth, tapestries of textile, curtains, curtains of textile or plastic, shower curtains of textile or plastic, window curtains, fabric, tablecloths of textile, place mats of textile, table napkins of textile, bed covers, waterproof clothing, clothing incorporating LEDs, clothing of imitations of leather, latex clothing, clothing of leather, motorists' clothing, cyclists' clothing, clothing for gymnastics, embroidered clothing, dresses, suits, jumper dresses, bath robes, non-slipping devices for footwear, clothing, bandanas [neckerchiefs], bibs, not of paper, berets caps being headwear, underwear, sweat-absorbent underwear, boas [necklets], teddies [underclothing], braces for clothing [suspenders], corsets [underclothing], galoshes, skull caps, leotards, footwear, boots for sports, stockings, sweat-absorbent stockings, socks, sweat-absorbent socks, breeches for wear, bathing trunks, albs, shirts, short-sleeve shirts, bodices [lingerie], sports singlets, headwear, hats, top hats, paper hats [clothing], coats, hoods [clothing], hat frames [skeletons], chasubles, belts [clothing], money belts [clothing], tights, collars [clothing], detachable collars, camisoles, layettes [clothing], corselets, bathing suits, masquerade costumes, beach clothes, neckties, ascots, bathing caps, shower caps, panties, headbands [clothing], pocket squares, fittings of metal for footwear, ready-made linings [parts of clothing], scarfs, sashes for wear, gabardines [clothing], boot uppers, gaiters, jackets [clothing], garters fishing vests, stuff jackets [clothing], skirts, overalls, aprons [clothing], girdles, mittens, gloves [clothing], fingerless gloves, ski gloves, welts for footwear, ready-made clothing, clothing containing slimming substances, paper clothing, knitwear [clothing], jerseys [clothing], kimonos, leggings [leg warmers], leggings [trousers], liveries, rash guards, hosiery, sports jerseys,

sweaters, muffs [clothing], maniples, hairdressing capes, pelerines, mantillas, sleep masks, skorts, miters [hats], boxer shorts, slippers [underclothing], babies' pants [underwear], underpants, wet suits for water-skiing, vests, trousers, slippers, ear muffs [clothing], parkas, pelisses, furs [clothing], shirt yokes, bibs, sleeved, not of paper, pajamas, cuffs, ponchos, heel protectors for shoes, tips for footwear, stocking suspenders, sock suspenders, brassieres, adhesive bras, heelpieces for stockings, sandals, bath sandals, saris, sarongs, neck gaiters, footmuffs, not electrically heated, shoes, esparto shoes or sandals, bath slippers, gymnastic shoes, beach shoes, football boots, sports shoes, ski boots, shawls, wimples, inner soles, overcoats, outerclothing, dress shields, petticoats, trouser straps, shirt fronts, half-boots, lace boots, boots, fur stoles, soles for footwear, studs for football boots, heels, heelpieces for footwear, pockets for clothing, tee-shirts, judo uniforms, karate uniforms, togas, footwear uppers, ankle boots, turbans, combinations [clothing], uniforms, valenki [felted boots], headscarves, veils [clothing], dressing gowns, visors being headwear, cap peaks, wooden shoes, appliques [haberdashery], fabric appliques [haberdashery], decorative articles for the hair, buttons, bows for the hair, numerals or letters for marking linen, hair ornaments in the nature of hair wraps, hair decorations, ornamental novelty badges [buttons], hair scrunchies, hair bands, belt clasps, hair barrettes, buckles [clothing accessories], artificial blossoms for attachment to clothing, artificial flowers of textile, ankle garters, sewing kits, bobby pins, ribbons for the hair, birds' feathers [clothing accessories], hair clamps, feathers [clothing accessories], sewing boxes, brooches [clothing accessories], ornamental novelty pins, other than jewellery, hat pins, other than jewellery, ornamental cloth patches, wallpaper, textile wallpaper, door mats, textile wallcoverings, bath mats, carpets, yoga mats, tatami mats, carpeting, door mats of textile, floor mats, business management of a franchising network relating to the sale of all the aforesaid goods; temporary shop and comer shop services in shopping center in relation to the sale of all the aforesaid goods.

Class 43: Rental of temporary accommodation; hotel reservations; hotel services; bar services; cafeteria services; personal chef services; restaurant services; ice cream parlors.

UK00916412728 (“The second earlier mark”)

MARNI

Filing date: 27 February 2017; Registration date: 13 July 2017

Under Section 5(3) the opponent opposes all of the applied-for services and claims that the mark has a reputation for all of the services for which it is registered, namely:

Class 35: *Advertising; Business management; Business administration; Office functions; Dissemination of advertising matter; Dissemination of advertising matter; Rental of advertising space; Commercial and industrial business management assistance and consultancy; Professional business consulting; Modelling for advertising or sales promotion; Franchising, namely services provided by a franchisor consisting in providing assistance to, managing and developing a commercial business (services for others); Provision of information relating to fashion; Computerised services for others for online sales of a variety of goods, Presentation of goods on communications media, including online, for sales purposes; The bringing together, for others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods; The aforesaid services may be provided via retail outlets, wholesale warehouses, mail order catalogues or by means of electronic media, including via websites; Services relating to e-commerce included in this class, including online sales via websites on which users can view, search and buy goods of various kinds; Retailing and wholesaling of cosmetics, spectacles, mobile telephones, jewellery, clocks and watches, bags, accessories of leather, clothing, footwear, haberdashery articles.*

UK00901756048 (“The third earlier mark”)

MARNI

Filing date: 14 July 2000; Registration date: 03 January 2008

Under Section 5(3) the opponent opposes all of the applied-for services and claims that the mark has a reputation for all of the goods for which it is registered, namely:

Class 3: *Perfumery, namely perfume, eau de parfum and eau de toilette.*

Class 9: *Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data-carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; Animated cartoons; apparatus for changing record player needles; asbestos clothing for protection against fire; asbestos gloves for protection against accidents; breathing apparatus for underwater swimming; breathing apparatus, except for artificial respiration; bullet-proof vests (Am); bullet-proof waistcoats; bullet-proof waistcoats [vests (Am)]; cabinets for loudspeakers; cases especially made for photographic apparatus and instruments; cases fitted with dissecting instruments [microscopy]; cleaning apparatus for phonograph records; cleaning apparatus for sound recording discs; clothing for protection against accidents, irradiation and fire; clothing for protection against fire; computer keyboards; computer operating programs recorded; computer operating programs, recorded; computer peripheral devices; computer programmes [programs], recorded; computer software [recorded]; containers for contact lenses; containers for microscope slides; divers' apparatus; divers' masks; diving suits; earplugs for divers; eyeglass cases; eyeglass chains; eyeglass cords; eyeglass frames; filters for respiratory masks; fire beaters; fire blankets; fire boats; fire engines; fire hose nozzles; floats for bathing and swimming; furniture especially made for laboratories; garments for protection against fire; gloves for divers; gloves for protection against accidents; gloves for protection against X-rays for industrial purposes; holders for electric coils; interfaces [for computers]; juke boxes [for computers]; knee-pads for workers; magnets; masts for wireless aerials; micrometer screws for optical instruments; monitors [computer programs]; motor fire engines; nets for protection against accidents; oxygen transvasing apparatus; pince-nez cases; pince-nez*

chains; pince-nez cords; pince-nez mountings; plotters; protection devices against Roentgen rays, not for medical purposes; protection devices against X-rays [Roentgen rays], not for medical purposes; protection devices against X-rays, not for medical purposes; protection devices for personal use against accidents; protective helmets; protective masks; protective suits for aviators; push buttons for bells; railway traffic safety appliances; reflecting discs for wear, for the prevention of traffic accidents; reflecting discs, for wear, for the prevention of traffic accidents; respirators [other than for artificial respiration]; respirators for filtering air; respiratory masks [other than for artificial respiration]; retorts' stands; road signs, luminous or mechanical; safety nets; safety restraints [other than for vehicle seats and sports equipment]; safety tarpaulins; shoes for protection against accidents, irradiation and fire; signs, luminous; solderers' helmets; spark-guards; spectacle cases; spectacle frames; stands for photographic apparatus; steering apparatus, automatic, for vehicles; swimming belts; swimming jackets; teeth protectors; tripods for cameras; water wings; workmen's protective face-shields; turnstiles, automatic; vehicle breakdown warning triangles.

Class 14: *Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; Agates; anchors [clock and watch-making]; barrels [clock- and watchmaking]; cases for clock- and watchmaking; cases for watches [presentation]; clock cases; clock hands [clock- and watchmaking]; clockworks; coins; copper tokens; dials [clock- and watchmaking]; jet, unwrought or semi-wrought; key rings [trinkets or fobs]; medals; movements for clocks and watches; objects of imitation gold; olivine [gems]; ormolu ware; ornaments of jet; pearls made of ambroid [pressed amber]; pendulums [clock- and watchmaking]; semi-precious stones; spinel [precious stones]; straps for wristwatches; watch bands; watch cases; watch chains; watch crystals; watch glasses; watch springs; watch straps.*

Class 18: *Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; Attaché cases; backpacks; bandoliers; beach bags; briefcases; card cases [notecases]; chain mesh*

purses, not of precious metal; collars for animals; covers for animals; dog collars; gold beaters' skin; goldbeaters' skin; gut for making sausages; handbag frames; handbags; haversacks; horse blankets; knee-pads for horses; music cases; muzzles; net bags for shopping; nose bags [feed bags]; pocket wallets; purses; purses, not of precious metal; rucksacks; school bags; school satchels; shopping bags; sling bags for carrying infants; straps for skates; straps for soldiers' equipment; suitcase handles; umbrella covers; umbrella handles; umbrella or parasol ribs; umbrella rings; umbrella sticks; vanity cases [not fitted]; walking cane handles; walking stick handles; walking stick seats; wheeled shopping bags; frames for umbrellas or parasols; game bags [hunting accessory].

Class 21: *Household or kitchen utensils and containers (not of precious metal or coated therewith); unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.*

Class 25: *Clothing, footwear, headgear; Babies' diapers of textile; babies' napkins of textile; boot uppers; cap peaks; dress shields; fittings of metal for shoes and boots; footwear uppers; hat frames [skeletons]; heelpieces for boots and shoes; heelpieces for shoes; heelpieces for stockings; heels; inner soles; iron fittings for boots; iron fittings for shoes; non-slipping devices for boots; non-slipping devices for boots and shoes; non-slipping devices for shoes; pockets for clothing; shirt yokes; soles for footwear; studs for football boots [shoes]; tips for footwear; visors [hatmaking]; welts for boots; welts for boots and shoes; welts for shoes; heel pieces for stockings; heelpieces for boots; ready-made linings [parts of clothing]; shirt fronts.*

Class 27: *Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile); Artificial turf; wallpaper.*

UK00811007074 (“The fourth earlier mark”)

MARNI

Filing date: 27 March 2018; Registration date: 16 October 2018

Priority date: 27 November 2008; Priority country: Switzerland; TM from which priority claimed: 584043

Under Section 5(3) the opponent opposes all of the applied-for services and claims that the mark has a reputation for all of the goods for which it is registered, namely:

Class 8: *Table cutlery; cutlery; table forks, knives and spoons; table forks, knives and spoons of silver; parts and components included in this class for all the above goods; bellows for indoor fireplaces.*

Class 11: *Apparatus for lighting, heating, steam generating, cooking, refrigeration, ventilation, installations for water supply and for sanitary purposes; vehicle reflectors; fireplaces; decorative water fountains; lamps; parts and elements included in this class for all the above goods.*

Class 19: *Fireproof materials for buildings (not of metal); palings, not of metal; tile floorings; wooden parquet floor boards, glass tiles; parquet floorings; figurines (statuettes) of stone, concrete or marble; wall panels; parts and elements included in this class for all the above goods.*

Class 20: *Furniture; mirrors; frames; seats; cupboards; cushions; desks; divans; door handles; figurines made of bone, ivory, plaster, plastic, wax and wood; flower baskets; door handles for furniture, key chains; magazine racks; office furniture; pillows; parts and elements included in this class for all the above goods.*

Class 24: *Fabrics for textile use, fabrics of imitation animal skins, fabrics for boots and shoes, bath linen, bed linen, blankets, curtains; furniture covers; pocket handkerchiefs; hand towels for kitchen use.*

WO0000001530528 ("The fifth earlier mark")

MARNI

International registration date: 23 January 2020

Designation date: 23 January 2020

Date of protection of the international registration in UK: 15 October 2020

Priority date: 23 December 2019; Priority country: Italy; TM from which priority claimed: 302019000098698

Under Section 5(3) the opponent opposes all of the applied-for services and claims that the mark has a reputation for all of the services for which it is registered, namely:

Class 35: *Bill-posting; shop window dressing; administration of consumer loyalty programs; advertising; marketing; organization of exhibitions for commercial or advertising purposes; business management services relating to franchising; business management advisory services relating to franchising; retail or wholesale services, online sales services, sales services through downloadable applications all associated with the sale of eau de Cologne, lipstick cases, balms, other than for medical purposes, hair conditioners, joss sticks, massage candles for cosmetic purposes, make-up powder, cosmetics, cosmetic creams, deodorants for human beings or for animals, detergents, other than for use in manufacturing operations and for medical purposes, air fragrance reed diffusers, cleansing milk for toilet purposes, after-shave lotions, hair lotions, lotions for cosmetic purposes, lip glosses, mascara, beauty masks, cosmetic pencils, cosmetic kits, potpourris [fragrances], cosmetic preparations for baths, toiletry preparations, cosmetic preparations for skin care, perfumery, antiperspirants [toiletries], laundry bleach, make-up preparations, shaving preparations, sachets for perfuming linen, perfumes, air fragrancing preparations, lipsticks, bath salts, not for medical purposes, cakes of toilet soap, soap, shampoos, nail polish, talcum powder, for toilet use, make-up, candles, perfumed candles, wicks for candles, lamp wicks, silver plate [knives, forks and spoons], whetstone holders, manicure sets, pedicure sets, razor cases, cutlery, knives, spoons, table knives, forks and spoons of plastic, table knives, forks and spoons for babies, scissors, table forks, nail files, eyelash curlers, razors, electric or non-electric, shaving cases, computer software applications, downloadable, containers for contact lenses, eyeglass cases, bags adapted for laptops, decorative magnets, protective helmets, riding helmets, USB flash drives, eyeglass cords,*

animated cartoons, computers, downloadable image files, downloadable music files, eyeglass frames, eyewear, pince-nez, anti-glare glasses, sunglasses, goggles for sports, smartglasses, eyeglasses, smartwatches, smartphones, lighting apparatus and installations, lamp globes, chandeliers, arc lamps, electric lamps, lamps, lamp shades, ceiling lights, sockets for electric lights, lampshade holders, lamp mantles, lamp reflectors, amulets [jewelry], rings [jewelry], split rings of precious metal for keys, spun silver [silver wire], shoe jewelry, hat jewelry, bracelets [jewelry], bracelets made of embroidered textile [jewellery], watch bands, busts of precious metal, cabochons, watch cases [parts of watches], clock cases, watch chains, chains [jewelry], clasps for jewelry, jewellery charms, charms for key rings, necklaces [jewelry], crucifixes as jewelry, crucifixes of precious metal, other than jewelry, chronographs [watches], chronometers, diamonds, tie clips, threads of precious metal [jewelry], gold thread [jewelry], jewelry findings, cufflinks, jewelry, ivory jewelry, cloisonné jewelry, jewelry of yellow amber, badges of precious metal, medals, locket [jewelry], coins, works of art of precious metal, earrings, ornaments of jet, gold, unwrought or beaten, clocks, wristwatches, watches, control clocks [master clocks], clocks and watches, electric, pearls [jewelry], precious stones, key rings [split rings with trinket or decorative fob], retractable key rings, jewelry rolls, rosaries, presentation boxes for jewelry, boxes of precious metal, jewelry boxes, presentation boxes for watches, tie pins, pins [jewelry], ornamental pins, brooches [jewelry], jewellery hat pins, spinel [precious stones], statues of precious metal, figurine of precious metal, paste jewelry [costume jewelry], chronometric instruments, alarm clocks, jewelry, precious and semi-precious stones, plastic jewelry, stationery, books, calendars, diaries, note books, photographs [printed], paintings [pictures], framed or unframed, mounted posters, unmounted posters, pens [office requisites], fountain pens, clothing for pets, umbrella rings, saddle trees, saddlery, key cases, fastenings for saddles, harness for animals, mountaineering sticks, hiking sticks, walking sticks, umbrella sticks, vanity cases, not fitted, trunks [luggage], travelling trunks, bags, bags [envelopes, pouches] of leather, for packaging, saddlebags, beach bags, bags for sports, shopping bags, wheeled shopping bags, chain mesh purses, purses, handbags, travelling sets [leatherware], tool bags, empty, bridles [harness], reins for guiding children, bridoons, straps for soldiers' equipment, kid, game bags [hunting accessories], briefcases, conference

folders, school satchels, leatherboard, cases of leather or leatherboard, halters, girths of leather, shoulder belts [straps] of leather, collars for animals, horse collars, horse blankets, covers for animals, leather cord, leather straps, straps of leather [saddlery], harness straps, straps for skates, compression cubes adapted for luggage, leather, unworked or semi-worked, labels of leather, horseshoes, moleskin [imitation of leather], umbrella covers, whips, knee-pads for horses, casings, of leather, for springs, covers for horse saddles, pads for horse saddles, trimmings of leather for furniture, harness fittings, leather leashes, sling bags for carrying infants, imitation leather, walking stick handles, grips for holding shopping bags, umbrella handles, suitcase handles, slings for carrying infants, pouch baby carriers, cat o' nine tails, chin straps, of leather, bits for animals [harness], muzzles, parasols, blinkers [harness], umbrellas, fur, goldbeaters' skin, animal skins, cattle skins, curried skins, chamois leather, other than for cleaning purposes, parts of rubber for stirrups, business card cases, credit card cases [wallets], card cases [notecases], pocket wallets, music cases, randsels [Japanese school satchels], reins, net bags for shopping^ furniture coverings of leather, haversacks, nose bags [feed bags], bags for campers, travelling bags, bags for climbers, boxes of leather or leatherboard, boxes of vulcanized fiber, hat boxes of leather, butts [parts of hides], walking stick seats, riding saddles, leathercloth, saddlecloths for horses, stirrups, stirrup leathers, umbrella or parasol ribs, luggage tags, tefillin [phylacteries], frames for umbrellas or parasols, handbag frames, traces [harness], attaché cases, suitcases, suitcases with wheels, garment bags for travel, motorized suitcases, valves of leather, rucksacks cupboards, coatstands, benches [furniture], chests, not of metal, sideboards, settees, baskets, not of metal, console tables, picture frames, tea carts, kennels for household pets, cradles, cushions, pet cushions, covers for clothing [wardrobe], meat safes, divans, display stands, coat hangers, pillows, beds, bookcases, mannequins, furniture, nesting boxes for household pets, works of art of wood, wax, plaster or plastic, screens [furniture], armchairs, split rings, not of metal, for keys, umbrella stands, magazine racks, lap desks, chairs [scats], stools, sofas, mirrors [looking glasses], hand-held mirrors [toilet mirrors], tables, indoor window blinds of textile, trays, not of metal, fans for personal use, non-electric, bottle openers, electric and non-electric, basins [receptacles], cooking pot sets, drinking glasses, tankards, bottles, coffeepots, non-electric, mugs, shoe horns, candelabra

[candlesticks], decanters, stew-pans, corkscrews, electric and non-electric, tablemats, not of paper or textile, epergnes, baskets for household purposes, crystal [glassware], mixing spoons [kitchen utensils], soap dispensers, figurines of porcelain, ceramic, earthenware, terra-cotta or glass, oven mitts, gardening gloves, toilet cases, fitted picnic baskets, including dishes, works of art of porcelain, ceramic, earthenware, terra-cotta or glass, make-up brushes, shaving brushes, combs, table plates, saucers, soap holders, potholders, ceramics for household purposes, heat-insulated containers, piggy banks, cookie jars, nutcrackers, coffee services [tableware], liqueur sets, tea services [tableware], services [dishes], brushes, toilet sponges, make-up sponges, cups, place mats, not of paper or textile, cosmetic utensils, cooking utensils, non-electric, kitchen utensils, utensils for household purposes, toilet utensils, tableware, other than knives, forks and spoons, vases, towels of textile, bath linen, except clothing, household linen, bed linen, table linen, not of paper, tablemats of textile, picnic blankets, blankets for household pets, woollen blankets, bed throws, handkerchiefs of textile, pillowcases, foulard [fabric], flags of textile or plastic, cheviots [cloth], sheets [textile], dust ruffles, wall hangings of textile, table runners, not of paper, baby buntings, cloth, tapestries of textile, curtains, curtains of textile or plastic, shower curtains of textile or plastic, window curtains, fabric, tablecloths of textile, place mats of textile, table napkins of textile, bed covers, waterproof clothing, clothing incorporating LEDs, clothing of imitations of leather, latex clothing, clothing of leather, motorists' clothing, cyclists' clothing, clothing for gymnastics, embroidered clothing, dresses, suits, jumper dresses, bath robes, non-slipping devices for footwear, clothing, bandanas [neckerchiefs], bibs, not of paper, berets caps being headwear, underwear, sweat-absorbent underwear, boas [necklets], teddies [underclothing], braces for clothing [suspenders], corsets [underclothing], galoshes, skull caps, leotards, footwear, boots for sports, stockings, sweat-absorbent stockings, socks, sweat-absorbent socks, breeches for wear, bathing trunks, albs, shirts, short-sleeve shirts, bodices [lingerie], sports singlets, headwear, hats, top hats, paper hats [clothing], coats, hoods [clothing], hat frames [skeletons], chasubles, belts [clothing], money belts [clothing], tights, collars [clothing], detachable collars, camisoles, layettes [clothing], corselets, bathing suits, masquerade costumes, beach clothes, neckties, ascots, bathing caps, shower caps, panties, headbands [clothing], pocket squares, fittings of metal for footwear, ready-

made linings [parts of clothing], scarfs, sashes for wear, gabardines [clothing], boot uppers, gaiters, jackets [clothing], garters fishing vests, stuff jackets [clothing], skirts, overalls, aprons [clothing], girdles, mittens, gloves [clothing], fingerless gloves, ski gloves, welts for footwear, ready-made clothing, clothing containing slimming substances, paper clothing, knitwear [clothing], jerseys [clothing], kimonos, leggings [leg warmers], leggings [trousers], liveries, rash guards, hosiery, sports jerseys, sweaters, muffs [clothing], maniples, hairdressing capes, pelerines, mantillas, sleep masks, skorts, miters [hats], boxer shorts, slips [underclothing], babies' pants [underwear], underpants, wet suits for water-skiing, vests, trousers, slippers, ear muffs [clothing], parkas, pelisses, furs [clothing], shirt yokes, bibs, sleeved, not of paper, pajamas, cuffs, ponchos, heel protectors for shoes, tips for footwear, stocking suspenders, sock suspenders, brassieres, adhesive bras, heelpieces for stockings, sandals, bath sandals, saris, sarongs, neck gaiters, footmuffs, not electrically heated, shoes, esparto shoes or sandals, bath slippers, gymnastic shoes, beach shoes, football boots, sports shoes, ski boots, shawls, wimples, inner soles, overcoats, outerclothing, dress shields, petticoats, trouser straps, shirt fronts, half-boots, lace boots, boots, fur stoles, soles for footwear, studs for football boots, heels, heelpieces for footwear, pockets for clothing, tee-shirts, judo uniforms, karate uniforms, togas, footwear uppers, ankle boots, turbans, combinations [clothing], uniforms, valenki [felted boots], headscarves, veils [clothing], dressing gowns, visors being headwear, cap peaks, wooden shoes, appliques [haberdashery], fabric appliques [haberdashery], decorative articles for the hair, buttons, bows for the hair, numerals or letters for marking linen, hair ornaments in the nature of hair wraps, hair decorations, ornamental novelty badges [buttons], hair scrunchies, hair bands, belt clasps, hair barrettes, buckles [clothing accessories], artificial blossoms for attachment to clothing, artificial flowers of textile, ankle garters, sewing kits, bobby pins, ribbons for the hair, birds' feathers [clothing accessories], hair clamps, feathers [clothing accessories], sewing boxes, brooches [clothing accessories], ornamental novelty pins, other than jewellery, hat pins, other than jewellery, ornamental cloth patches, wallpaper, textile wallpaper, door mats, textile wallcoverings, bath mats, carpets, yoga mats, tatami mats, carpeting, door mats of textile, floor mats, business management of a franchising network relating to the sale of all the aforesaid goods;

temporary shop and comer shop services in shopping center in relation to the sale of all the aforesaid goods.

Class 43: *Rental of temporary accommodation; hotel reservations; hotel services; bar services; cafeteria services; personal chef services; restaurant services; ice cream parlors.*

3. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM.¹ As a result, the opponent's first, second, third and fourth earlier marks were automatically converted into comparable UK trade marks. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

4. Under Section 5(2)(b), the opponent claims that the marks are nearly identical and that the services are similar, resulting in a likelihood of confusion.

5. Under Section 5(3), the opponent claims that the high degree of similarity between the marks would cause the relevant public to mistake the applicant's mark and the opponent's marks or otherwise believe that the applicant's mark is a variation of the opponent's marks, leading to the applicant's mark taking unfair advantage of the reputation and distinctiveness of the opponent's marks and causing detriment to their reputation and distinctiveness. The opponent also claims that its reputation could be damaged by the dilution of the earlier marks or by the use of the applicant's mark on services of poor quality, over which it has no control.

6. The opponent's marks qualify as "earlier trade marks" in accordance with Section 6 of the Act, as their filing (or priority) dates are earlier than the filing date of the applicant's mark. Only the third earlier mark had completed its registration process more than five years before the filing date of the applicant's mark, and it is subject to the use provisions specified in Section 6A of the Act. However, given that when filling

¹ The same applies to IRs designating the EU

in the Form TM8 the applicant made an express choice not to put the opponent to proof of use, the opponent can, as a consequence, rely upon all of the goods and services it has identified.

7. The applicant filed a counterstatement in which he denied that the marks are highly similar and that the parties' services in classes 42 and 45 are similar. Although the applicant did not address the similarity with the other goods and services, he stated that the applied-for services "are completely different to what the opposition have already trademarked" which can be taken as a general denial that the goods and services involved are similar. Further, in the later part of the counterstatement the applicant accepted that the opponent's brand MARNI is a "*a well-established*" and "*fantastic brand*". He states (reproduced as written):

"The first reason for my defence in response to the applicant for cancellation is that the difference between the marks as already been deemed entirely separate by the official gov.uk website when registering Marnii as a limited company so if you were to search Mamii on Google for example there is not one listing showing for the opponents company, our brand is distinguishably different which leads onto my second reason for defence.

The classes initially submitted as part of my trade mark application were classes 9, 42 and 45. As you will be able to see classes 42 and 45 are entirely separate from the trade mark in place for our opponent. Out of consideration and courtesy for theirs in place I processed an application to have class 9 removed which has been done. The opponent's actually made part of their appeal on the apparent grounds that class 45, which is for "Video dating services; Internet dating services; Dating services; Computer dating services; Agency services (Dating -); Dating agency services; Dating services provided through social networking; internet based dating, matchmaking and personal introduction services" is similar to the opponents services of "bar services; cafeteria services; restaurant services". They are clearly and in every way very different and I'm actually shocked by this statement. They've stated that "In particular, the respective services are often provided in conjunction with one another." They're definitely not. We are an online dating app, how can this be

provided in conjunction with bar, restaurant or cafeteria services? I don't know if they've misunderstood our classes of service. To conclude my defence, I completely disagree that there is a high degree of similarity between the trade marks at issue. They are two entirely separate and distinguishably different brands offering entirely different services. My brand has been taken from my surname and represents a relationship between two people.

To carry on from my previous counter statement and to provide additional information much of the dispute is based round distinctiveness of the brand - the difference in the brand is huge and the categories we are filing for are completely different to what the opposition have already trademarked. This, as previously mentioned is evident from the listings shown on Google - if you type in Marni you will not see Marnii and vice versa. They are recognised by the search engines and the general public as two entirely separate brands.

From a financial viewpoint we launched in February 2021 and have been operating at a loss since. We do however remain as passionate as ever with our brand and in no way whatsoever was this based around Marni. I for one had ever heard of the company. Since looking over what they offer and the differences in the brands I feel that it would be huge mistake to just accept defeat. It almost feels like David vs Goliath. We have nothing but respect for Marni who are clearly a well-established and a fantastic brand. It cannot however be overlooked that the name Marni was not created by them. It originates from several languages, including Hebrew, meaning "rejoice", and Latin as a variant of "Marina", meaning "of the sea". It also has derivations from Gaelic and Swahili. "Marni" and "Marnie" are the two most common spellings of the female first name, ranking 2,446 and 1,498, respectively, out of 4,275 for females of all ages in the 1990 U.S. Census. It is our brand Marnii that has no real meaning and simply derived from the pronunciation of my surname. The domain names Marnii.co.uk and Marnii.com have been owned by my family for several years.

After having a brief look over Marni's public accounts filed with HMRC their turnover actually increased considerably from 2020 to 2021. After we launched

in February 2021 their turnover for that year increased by £477,075. This is a clear indication that our brand in no way whatsoever impacts on their turnover”.

8. Both parties filed evidence. I shall refer to the evidence to the extent that I consider necessary.

9. The opponent is represented by Haseltine Lake Kempner LLP and the applicant represented himself. Neither party requested a hearing, and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EU Law

10. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

The evidence

11. The opponent’s evidence consists of a witness statement by Barbara Calò dated 23 November 2022 with 21 accompanying exhibits (BC01 – BC21). Ms Calò is the CEO of the opponent.

12. The applicant’s evidence consists of a witness statement by Ryan Mahoney (i.e. the applicant himself) dated 24 January 2023 with seven accompanying exhibits (RM01 – RM07).

DECISION

Section 5(2)(b)

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

“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”.

14. 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.”

15. 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 great 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;

(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 services

16. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the CJEU stated that:

“23. 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 complementary.”

17. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- (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.

18. The General Court (“GC”) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa.

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

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

20. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

21. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

22. Under this ground the opponent relies on the first earlier mark only. Further, the opposition under this ground is partial, being directed to the services in class 45.

23. The services to be compared are as follows:

The applicant's services	The opponent's services
<p>Class 45: <i>Video dating services; Internet dating services; Dating services; Computer dating services; Agency services (Dating -); Dating agency services; Dating services provided through social networking; Internet based dating, matchmaking and personal introduction services.</i></p>	<p>Class 43: <i>bar services; cafeteria services; restaurant services</i></p>

24. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International

Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

25. The only reason advanced by the opponent in its statement of ground for its claim that bar, cafeteria and restaurant services in class 43 are similar to dating services in class 45 is that *“the respective services are often provided in conjunction with one another”*. In its submissions in lieu the opponent provided further reasons stating that:

- Restaurants and bars are often used as a place for social functions and interaction, with the owners either hosting or sponsoring activities as pub quizzes, movie nights, ladies’ nights, sports events, jazz nights and music concerts and festivals. Events such as speed dating could also be hosted by a bar or restaurant, and dates commonly involve visiting venues such as bars and restaurants which means that there is an overlap in the average consumer;
- In her evidence Ms Calò explained the opponent’s concerns with the application as there is a direct link between fashion and dating. Fashion, looking good and attracting a partner go hand-in-hand. There is, therefore, a connection between fashion and dating.

26. I am quite surprised at those reasons. The arguments that people who date might visit bars and restaurants is, in my view, untenable. This fact, even if it was true, creates only a casual coincidental link between the services which does not give rise to a complementary relationship in a trade mark sense. Dating services and bar/restaurant/cafeteria services are not *“indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”* Further, the opponent’s argument clearly ignores the fact that all but one of the terms listed in the applied-for specification refer to video dating services, Internet-based dating services or agency dating services, which would not fit into the narrative of restaurants and bars offering speed dating events. But even considering that the specification includes the term *dating services* at large, there is no evidence that bar/restaurant/cafeteria services would normally provide dating services or that dating services and bar/restaurant/cafeteria services have converged

in the market to such an extent that consumers would expect them to be provided by the same undertakings. Finally, even if there is an overlap in the average consumer of the services, that is also coincidental, and does not give rise to any similarity in a trade mark sense, otherwise all the goods and services which target members of the general public could be said to be similar.

27. As regards the opponent's reference to the relationship between fashion and dating services, it is sufficient to say that the mark relied upon for the purpose of Section 5(2)(b) does not cover clothes or any other fashion goods in class 25.

28. The parties' services have a different nature and purpose and are directed at different consumers, namely those who wish to find a partner and those who wish to eat and drink. The services do not coincide in providers or distribution channels and are neither complementary nor in competition with each other. These services are considered to be dissimilar.

29. As I found that the services at issue are dissimilar, the opponent's claim under Section 5(2)(b) is bound to fail. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

30. Accordingly, the opposition under Section 5(2)(b) fails.

Section 5(3)

31. Section 5(3) states:

“(3) A trade mark which-

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

32. Section 5(3A) states:

“(3A) 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”.

33. 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*).

34. The relevant date for the assessment under Section 5(3) is the filing date of the application at issue, being 02 November 2021.

Reputation

35. 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.”

36. The following account is based on evidence supplied by Ms Calò, which I have no reason to question:

- The opponent is an Italian luxury fashion house that was founded in 1994 by Consuelo Castiglioni. It designs, manufactures, distributes and retails, amongst other products, clothing, shoes, bags, accessories and eyewear under the mark MARNI. Over the course of several decades, the opponent has cemented its status among the most prominent Italian and global fashion houses. Its goods are sold online and in hundreds of retail stores around the world, including the UK and EU. The fashion house became widely known for its original prints, with collaborations from artists such as photographer Richard Prince, British pop star Sir Peter Blake and musician Kim Gordon. More recently, the opponent has collaborated with premium outerwear label Stutterheim and household fashion retailer H&M;
- In 2013, the opponent became part of the OTB Group, which took a majority stake in the business. In 2015, this increased to a 100% ownership of the business. OTB Group is an international fashion group specialising in global luxury goods, and in addition to the opponent, it houses global well-known brands such as Diesel, Jil Sander, Maison Margiela, Amiri and Viktor & Rolf;
- When the opponent's founder, Consuelo Castiglioni, stepped down on 21 October 2016, Francesco Risso became Marni's Creative Director. Risso is well regarded in his own right, starting out his career at global luxury fashion house Prada. His appointment at the opponent was a high profile one, which in turn raised the profile of the Marni brand;
- The opponent's mark MARNI has a reputation for celebrating the individual using bold colourful graphics;
- The opponent has continuously offered for sale clothing, footwear, bags and closely associated accessories under the mark MARNI in the UK since 2001 via retail outlets or online. In 2003, Marni Retail UK Limited was set up to specifically oversee the retail of MARNI branded products in the UK;

- The opponent sells its MARNI branded goods in the UK through its own store located in Mayfair, at 95 Mount Street, London, W12TA and two concession stores at Harrods in Belgravia and at Selfridges on Oxford Street. It also operates at the outlet store at Bicester, near Oxford as well as online via the UK section of its website at www.marni.com. In addition, the opponent sells MARNI branded goods in the UK and EU via third party retailer websites, as well as physical retail stores;
- In the period between 2015 and 2019, annual turnover for goods sold under the mark MARNI in the EU fluctuated between €58million and €68million for a total of €324million;
- In the period between 2014 and 2021, annual turnover for goods sold under the mark MARNI in the UK through the opponent's MARNI retail outlets fluctuated between £2million and £6million for a total of £33million;
- In the period between 2018 and 2021, UK online sales of MARNI branded products via the website www.marni.com fluctuated between €200,000 and €300,000 for a total of €900,000;
- In the period between 2016 and 2021, the annual number of UK online orders of MARNI branded products made via the website www.marni.com oscillates between 600 units and 1,500 units for a total of 5,300 units;
- The mark MARNI has been extensively advertised throughout the UK and EU, including high profile fashion magazines such as Vogue, Elle, Another Magazine, Wallpaper and Harper's Bazaar;
- UK advertising spend from 2015 to 2019 relating to products bearing the MARNI mark is €911,012 broken down as follows: €164,842 (2015), €271,975 (2016), €257,732 (2017), €156,142 (2018) and €60,321 (up to September 2019);

- The opponent operates various social media. Although Ms Calò gives the following numbers of followers, they appear to reflect the situation at the date her witness statement was given, rather than at the relevant date: 1.7million Instagram followers, 285,000 Facebook followers, 8,000 Twitter followers, and 7,910 YouTube followers. Ms Calò states that a large number of these followers are based in the UK and EU. However, the precise number of UK followers is given only in relation to Instagram, and appears to be around 30,000 followers per month (in 2021) which, compared to the total of 1.7 million Instagram followers previously provided, appears to be a relatively small proportion;
- The opponent has attended the Milan Fashion Week since 1998 and in September 2022 (which is after the relevant date) the New York Fashion Week for the first time. The Milan Fashion Week is one of the big four fashion weeks that occur each year (the others being held in Paris, London and New York) and attract visitors and designers from all over the world;
- Clothing and accessories branded with the mark MARNI are frequently worn by celebrities such as the British singers and actors Harry Styles and Rita Ora.

Assessment of the evidence

37. The first thing I should say is that it does not seem to me that the applicant has accepted that the opponent's mark MARNI had a reputation in the UK at the relevant date. Whilst the applicant admitted that MARNI is a "*well-established*" and "*fantastic*" brand, he also stated that he had never heard of the opponent's company and that having looked at what the opponent offers (assumably prompted by the opposition at issue), he concluded that the brands are sufficiently different and that "*it would be huge mistake to just accept defeat*".

38. The second point I should mention is that whilst the opponent claimed reputation for a wide range of goods and services in classes 3, 8, 9, 11, 14, 18, 19, 20, 21, 24, 25, 25, 35 and 43, there is no evidence of use (let alone reputation) in relation to most of the goods and services for which reputation is claimed. Clearly, all of the evidence

points to the opponent being an Italian fashion house selling items of clothes, footwear and fashion accessories. The evidence also indicates that most of the opponent's trade is in the EU, the UK turnover figures of £33-34million representing approximately 10% of the turnover of €324million generated in the EU, which cannot, by any stretch, be described as more than a small proportion of the opponent's whole trading activities. My impression that the UK is not one of the big markets internationally for the opponent is borne out by the following facts:

- a) the UK turnover figures (which amount to between £2million and £6 million per annum in the period between 2014 and 2021) appear to be very small in the context of the UK fashion industry as a whole. Although there no evidence as to the size of the market, I expect the UK overall market for clothing and other fashion goods to be very large, running in the region of billions. Further, the evidence indicates that the cost of the opponent's goods is very high, for example, a silk and cotton dress is advertised for £1,280, a pair of silk and cotton trousers are advertised for £720 and a pair of leather shoes bear a price tag of £530, meaning that, given the turnover figures, the quantity of items sold must be very low indeed, in the context of the market as a whole;
- b) Ms Calò stated that the opponent has always attended the Milan Fashion Week since 1998 and recognised the importance of the London Fashion Week as one of the main international fashion events, however, the opponent has never attended the London fashion week.

39. Overall, my conclusion is that the evidence filed establishes that the opponent is an Italian fashion brand aimed at the higher end of the market. Whilst the brand might be well-established and might have a reputation in Italy and the EU, the evidence falls short of establishing that the mark MARNI is known by *a significant part of the UK public concerned by the products or services covered by the mark*. The fact that the opponent has a market presence in the UK, does not mean that it also has a reputation in the UK. My reasons for reaching such conclusion are as follows.

40. As I have said, the UK turnover figures for the years 2014-2021 are very small in the context of the UK fashion industry as a whole and appear to be particularly small

in the two years prior to the relevant date of 2 November 2021, being around £2million per annum in 2020 and 2021. Admittedly, use in the UK is said to have commenced in 2001, but there is no information about the intensity of such use until 2014. There are no advertising figures for the two and a half years prior to the relevant date, and the figure given for 2019 shows that UK advertising spend dropped from around £156 thousands (in 2018) to around £60 thousands (in the first semester of 2019). The number of UK Instagram followers in 2021 appear to be also low as it is around 30,000 which is about 1.7% of the total number of the opponent's 1.7 million followers. In its submissions in lieu the opponent states that its *"business was affected by the Covid pandemic in 2020 and 2021, which accounts for the reduced turnover for these years, such effects being felt by many businesses in the retail and clothing sector."* I reject the argument. First, the pre-Covid UK sales figures are approximately £4million in 2018 and 2019, which I still consider to be low in the context of the relevant market as a whole. Second, what I am required to assess here is whether the opponent has demonstrated that it had a reputation at the relevant date. Whilst, in certain circumstances, owners of trade marks can invoke *"proper reasons for non-use"* when defending their registrations against revocation actions (which is how it appears the opponent has framed its argument about the effects of the Covid pandemic on its business), the case-law relating to Section 5(3) does not contemplate discounts and does not introduced a lower threshold for assessing reputation, based on the existence of obstacles to the use of the mark.

41. In terms of marketing activity, there is evidence that MARNI received some press coverage in the UK prior to the relevant date, for example, there are extracts of online articles published by well-known magazines such as, for example, The Guardian, Telegraph, Daily Mail, Vogue, Marie Claire and Grazia, however, most of these articles refer to a collaboration between MARNI and the UK high street retailer H&M from 2012 (which is nearly ten years before the relevant date), or captures some pieces of MARNI collections (with the brand MARNI appearing in very small writing in the description of the items worn by the model), or a report on the MARNI collections presented at Milan fashion week. This is far from showing that the mark MARNI has been the subject of substantial advertising campaigns within the UK. Finally, there is evidence of MARNI pieces being worn by the two UK celebrities Harry Styles and Rita Ora, however, it is impossible to gauge the impact of these fashion statements on the relevant public. In

my view, this evidence of marketing and promotion is not sufficient, on its own or coupled with the relatively low turnover figures, to establish that the mark MARNI had acquired the requisite reputation in the UK at the relevant date.

42. In conclusion, I am not satisfied that the brand MARNI was known at the relevant date by a significant part of the UK public concerned by the products or services covered by the mark.

43. As the applicant's mark was filed on 19 November 2021, the legislation post-Brexit applies, which means that the reputation required to sustain a claim under Section 5(3) must be in the UK. As I found that the opponent's mark did not have a reputation in the UK at the relevant date, the claim under Section 5(3) fails at the first hurdle.

The Link

44. In case I am wrong, I will consider whether there would be a link and damage, had the opponent demonstrated that it had a reputation in the UK.

45. 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. The marks at issue are MARNI versus MARNII. They coincide in the first five letters MARNI and differ in the addition of the last letter 'I' in the applicant's mark. Visually and aurally, the marks are highly similar. Conceptually, both marks will be perceived as invented words with no meaning, which means that a conceptual comparison is not possible;

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. The applied-for services are design, maintenance and up-dating of computer software in class 42 and dating services in class 45. The opponent

relies upon a wide range of goods and services in classes 3, 8, 9, 11, 14, 18, 19, 20, 21, 24, 25, 25, 35 and 43, which are not obviously similar to the applied-for services. Save for the registered services in class 43 (which I have already concluded are dissimilar to the applied-for services) and goods in class 25, the opponent did not put forward any reason for suggesting that the goods and services in question are similar. The opponent's arguments that the applied-for services are similar to the opponent's fashion goods can be summarised as follows:

- a) fashion is important to find a partner;
- b) is common for fashion brands to promote their collections on dating websites – in this connection Ms Calò provided a copy of an article from 2016 stating that the brand Diesel would promote its collection on the dating apps Tinder and Grindr;
- c) a television show called "Dress to Impress", which was aired on ITV in 2017, was a dating show where dating competitors would compete *"to win the heart of a fashion-conscious singleton."*

I reject these arguments, as none of the points raised means that there is a complementary relationship between the applied-for services and the opponent's fashion goods in a way that customers may think that the responsibility for those goods lies with the same undertaking. In particular, the fact that a company might decide to advertise its goods on another business' website is not a factor which should be taken into account (see *Canon*) when assessing the similarity of the goods and services and I am not aware of any case-law which suggests otherwise. The goods and services have a different use, nature, purpose, and method of use, they reach the consumer through different trade channels and are not complementary nor in competition. Therefore, the contested services and the opponent's goods and services are dissimilar. This appear to be subsequently accepted by the opponent in its

submissions in lieu.² That said, the relevant public for the respective goods and services is the same, consisting of the general public.

The strength of the earlier mark's reputation. If the opponent's mark had any reputation in the UK at the relevant date, it would be modest and associated with the fashion goods covered by the earlier marks, i.e. clothing and footwear in class 25, bags in class 18 and jewellery in class 14.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use. The word MARNI is unlikely to convey any meaning to the average consumer. As such, it is inherently distinctive to a high degree. The use made of the mark in the UK is not sufficient to have elevated that degree of distinctiveness.

Whether there is a likelihood of confusion. Although the marks are highly similar and the level of attention paid during the purchase - which is mainly visual - is likely to be medium, and the distinctiveness of the opponent's earlier MARNI mark is high, I do not consider these factors to be sufficient to outweigh the fact that the respective goods and services are entirely dissimilar. I find that there is no likelihood of confusion on the part of the general public.

46. I bear in mind that my finding of no likelihood of confusion does not mean that there can be no link made between the marks. A link merely requires a 'bringing to mind', not confusion as to the origin of the goods and services. Weighing all the above factors, I find that the general public, when faced with the applicant's MARNII/marnii marks in use in relation to the contested services in class 42 and 45 would not call the opponent's earlier MARNI mark to mind, despite the high degree of similarity between the marks, and the high degree of distinctiveness of the opponent's mark, owing to the respective goods and services being entirely dissimilar and the opponent's reputation being very small or modest. The necessary link is not established. But even if it was established, it would not be more than a fleeting and superficial one, and would not cause any damage.

² See paragraph 71

OUTCOME

47. The opposition fails under all grounds, and the applicant's mark will proceed to registration.

COSTS

48. As the applicant has been successful, it is entitled to a contribution towards its costs. As the applicant is a litigant in person, the official letter of 13 March 2023 stated:

“If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party”

49. On 11 April 2023, the applicant filed a completed costs pro-forma, in which he claims the following:

- 7 hours for drafting a notice of defence and 4 hours for considering the forms filed by the other party;

- 14 hours for preparing the evidence and considering the other party evidence.

50. The requests made in relation to the time spent upon drafting a notice of defence and considering the notice of opposition, preparing the gathering of evidence, and considering the other party's evidence appear to me to be reasonable. However, I notice that the applicant applied an hourly rate of £60, which is not the correct rate for litigants in person. The Litigants in Person (Costs and Expenses) Act 1975, the Civil Procedure Rules Part 46 and the associated Practice Direction, set the amount payable to litigants in person at £19 per hour. I therefore award costs to the opponent on the following basis:

Preparing a Form TM8 and counterstatement and considering the notice of opposition (11 hours) = (11 x £19) = £209

Preparing and gathering evidence (14 hours) = (14 x £19) = £266

Total: £475

51. I therefore order MARNI GROUP S.R.L. to pay Ryan Mahoney the sum of £475. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 14th day of August 2023

**Teresa Perks
For the Registrar**