

O-0855-26

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 4200760

IN THE NAME OF

JORDAN BOWES

TO REGISTER THE FOLLOWING TRADE MARK:

Planet Dreams

IN CLASS 25

AND

OPPOSITION THERETO (UNDER NO. 456131)

BY

FLICK FASHIONS LIMITED

BACKGROUND

1) On 08 May 2025, Jordan Bowes ('the applicant') applied to register the trade mark **Planet Dreams** in the UK in respect of 'Clothing' in Class 25.

2) The application was published in the Trade Marks Journal on 23 May 2025 and notice of opposition was later filed by Flick Fashions Limited ('the opponent'). The opponent claims that the trade mark application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The following marks, and goods covered by the same, are relied upon:

- **UKTM 2060937 ('937)**

DREAMS

Class 25: Articles of clothing.

Filing date: 13 March 1996

Date of entry in register: 25 October 1996

- **UKTM 3904128 ('128)**

DREAMS LONDON

Class 25: Clothing; footwear; headgear.

Filing date: 24 April 2023

Date of entry in register: 21 July 2023

- **UKTM 2216417 ('417)**

DREAM

Class 25: Clothing.

Filing date: 07 December 1999

Date of entry in register: 27 April 2001

3) It is claimed that the respective goods are identical and the respective marks are similar, such that there exists a likelihood of confusion under section 5(2)(b) of the Act.

4) The trade marks relied upon by the opponent are earlier marks, in accordance with section 6 of the Act. As UKTMs '937 and '417 both completed their registration procedure more than five years prior to the application date of the contested mark, they are subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use for 'Articles of clothing' and 'clothing' respectively. UKTM '128 is not subject to the proof of use conditions.

5) The applicant filed a counterstatement denying the opponent's claims and requesting proof of use for the relevant earlier marks.

6) The opponent is represented by Stratagem Intellectual Property Management Limited. The applicant is without legal representation. The opponent filed evidence which consists of a witness statement from Tahir Sharif¹ with exhibits FF01-FF15B. That evidence was also accompanied by written submissions.² The applicant has filed nothing beyond the counterstatement. No hearing was requested and neither party filed written submissions in lieu. I now make this decision based on the papers before me.

DECISION

7) The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained

¹ Dated 18 November 2025

² Dated 18 November 2025

EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. Accordingly, this decision will refer to decisions of the EU courts which predate the UK's withdrawal from the EU.

Approach

8) Of the three marks relied upon, it strikes me that mark '937 clearly represents the opponent's best prospect of success, subject to the proof of use conditions being met. However, the content of the opponent's submissions suggests that it considers mark '128 to also represent one of its strongest cases. I will, therefore, consider the opposition based upon those two marks first. I will return to consider mark '417 later.

Proof of use

9) Section 6A of the Act states:

“(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) – (5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

10) Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Consequently, the burden lies with the opponent to prove it has made genuine use of its mark.

11) In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

12) The relevant period in which genuine use of mark ‘937 must be established is the five-year period ending on the date of filing of the contested mark. In the case before me, that period is **09 May 2020 to 08 May 2025**.

13) I have carefully considered the opponent’s evidence. I will now summarise the most pertinent aspects of it.

14) Mr Tahir has been the opponent’s Executive Director since 1983. He states that the opponent and its predecessors in business have been providing clothing since 1982.

15) Relevant sales figures for clothing in the UK bearing the DREAMS mark are provided, as per the following table:³

Year	Sales (£)
2025 (Jan – May)	821,451.00
2024	1,548,575.00
2023	1,403,110.90
2022	1,889,003.70
2021	1,178,363.59

³ Witness statement of Mr Tahir, [5]

2020	916,335.34
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16) It is said that 'Style codes' are used on invoices instead of the mark DREAMS and that those codes relate to goods bearing the DREAMS mark. Some example images are provided of goods which are said to relate to those codes.⁴ These show items of women's clothing including jeans, trousers, tops and dresses. All of the goods appear to bear the same mark on the neck/waist label or swing tag. An example of such use is shown below on a pair of jeans:



17) Further examples of goods bearing labels and hang tags are provided showing the same hand-written type representation of the mark, as depicted above. There are also examples of use of the plain unstylised word DREAMS and DREAMS LONDON (as depicted in paragraph 19 below).⁵ The goods are various kinds of women's tops and trousers.

18) Tables are provided listing various 'style codes' with corresponding images of clothing items. Some items also have a corresponding invoice number. The images are of various items of women's clothing such as tops, cardigans, trousers and dresses.⁶ Many are dated within the relevant period.

⁴ Exhibit FF02

⁵ Exhibit FF03

⁶ Exhibits FF04 – FF05A-C

19) A selection of invoices are provided.⁷ A number of these have UK addresses and are dated within the relevant period. The products listed therein are various items of clothing. Each invoice shows a style code for the products which is said to correspond to DREAMS branded goods, the same as those shown in earlier exhibits. Many invoices are also headed with the following mark:

DREAMS
L O N D O N

20) Mr Sharif explains that the opponent does not typically advertise or produce catalogues but it does attend trade exhibitions. A list of those attended between 2018 and 2025 is provided. These are in various UK locations, including London, the West Midlands and Birmingham. The amount spent on attending those shows is also provided.⁸ It is said that total spend on exhibitions in the period 2020 – 2025 was over £400,000. Photographs of exhibition stands are also in evidence.⁹ These show use on signage of the hand-written representation of DREAMS (as depicted in other exhibits) and the DREAMS LONDON mark (as depicted in the preceding paragraph).

21) Screenshots from the opponent's UK website are provided which date from 2023 and 2024. These show the DREAMS LONDON mark (as shown in paragraph 19 above) on use at the top of the web pages. The goods on the page are items of women's clothing.¹⁰

22) That completes my summary of the evidence.

Form of the mark

23) The earlier mark has been used in the following three forms:

⁷ Exhibits FF06-FF11

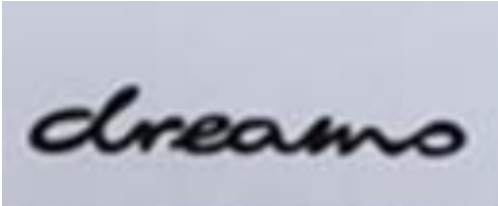
⁸ Exhibit FF12A

⁹ Exhibit FF12B

¹⁰ Exhibit FF15A

i) DREAMS

ii) **DREAMS**
L O N D O N

iii) 

Form i) is use of the mark as registered and can obviously be relied upon by the opponent. Form ii) is acceptable use of the registered mark because the addition of the wholly descriptive word LONDON does not alter the distinctiveness of the mark.¹¹ Lastly, form iii) is also use upon which the opponent may rely because the dominant and distinctive element of the mark remains the word DREAMS despite the hand-written stylisation.

Sufficiency of use

24) Viewing the evidence in the round, I am satisfied that the opponent has made genuine use of the earlier mark during the relevant period in relation to various items of women's clothing. In reaching this finding, I have borne in mind, in particular, the invoices dated within the relevant period to UK customers, the various images of items of women's clothing bearing the mark which are representative of the goods listed in those invoices and the sales figures. Although the scale of use does not appear to have been particularly substantial, it is sufficient to satisfy me that there has been real commercial exploitation of the mark within the relevant sector which

¹¹ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

would have been sufficient to create/maintain a market for the goods. Further, given the variety of women's clothing that is shown in evidence, including tops, dresses, cardigans, jeans and trousers, I find that a fair specification¹² is 'Women's clothing' in class 25.

Section 5(2)(b)

25) Section 5(2)(b) of the Act states:

“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.”

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

¹² As per *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of goods

27) In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) the General Court held 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

The applicant’s ‘Clothing’ is identical to the opponent’s ‘Women’s clothing’ covered by mark ‘937 because the latter falls within the former. The applicant’s goods are also self-evidently identical to the ‘clothing’ covered by mark ‘128.

Average consumer and the purchasing process

28) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

29) In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

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

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

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

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

30) The average consumer for the respective goods in class 25 is the general public. The purchasing act will be primarily visual because the goods will be selected after perusal of racks/shelves in high-street stores or from photographs/images on Internet

websites or in catalogues. That is not to say, though, that the aural aspect should be ignored since the goods may sometimes be the subject of discussions with sales representatives, for example. The cost of the goods is likely to vary. However, factors such as size, material, comfort/fit, aesthetics and/or suitability for purpose are likely to be considered by the consumer regardless of cost. The opponent submits that the level of attention paid will be ‘relatively low’¹³. In my view, and bearing in mind all of the aforementioned factors, a medium degree of attention is likely to be paid during the purchase.

Comparison of marks

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

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

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

32) The marks are, as follows:

¹³ Submissions dated 18 November 2025, page 6

Earlier marks	Contested mark
Mark '937: DREAMS Mark '128: DREAMS LONDON	Planet Dreams

Overall impressions

33) Mark '937 consists of the single word DREAMS in which its overall impression lies.

34) Mark '128 consists of the words DREAMS LONDON. LONDON is descriptive of the place of origin of the goods. It is the distinctive word DREAMS which dominates the overall impression of mark '128.

35) The contested mark consists of the two words, 'Planet Dreams'. The opponent contends that the word 'Dreams' dominates the mark. It reasons that 'planet' is a 'generic and descriptive term' and 'in this sector, "planet" may merely suggest a stylised retail space or branded outlet i.e. a metaphorical or 'trendy' planet of fashion, rather than contributing a source-identifying function independent of DREAMS'. It is not obvious to me that the word 'Planet' is a generic or descriptive term in relation to the relevant goods or that it will be perceived in the manner contended by the opponent and there is no evidence before me to satisfy me otherwise. I find that both words are distinctive and neither word dominates the other. Rather, both words contribute equally to the overall impression.

Visual similarity

36) Visually, mark '937 and the contested mark coincide in the presence of the word, DREAMS. The contested mark also contains the word Planet at the beginning which is not present in the earlier mark. I find a medium degree of visual similarity between the contested mark and mark '937.

37) Turning to consider the visual similarity with earlier mark '128, both marks contain the word DREAMS. However, mark '128 contains the word LONDON after DREAMS whereas the word Planet precedes DREAMS in the contested mark. I find a low degree of visual similarity between the contested mark and mark '128.

Aural similarity

38) Aurally, the contested mark consists of three syllables, PLAN-ET-DREAMS. Mark '937 consists of only one syllable, DREAMS. Clearly, the marks coincide in the identical pronunciation of DREAMS. However, they differ owing to the presence of the first two syllables in the contested mark which are absent from the earlier mark. I find a below-medium degree of aural similarity between the contested mark and mark '937.

39) Clearly the contested mark and mark '128 share the common vocalisation of the word DREAMS. I also acknowledge, as the opponent points out, that both marks contain three syllables overall. However, aside from the common DREAMS syllable, the other two syllables in the marks are entirely different to the ear, being LON-DON on the one hand and PLAN-ET on the other. Those differing syllables also occupy different positions within the marks, being at the end of the earlier mark and at the beginning of the contested mark. Overall, there is a low degree of aural similarity between mark '128 and the contested mark.

Conceptual similarity

40) DREAMS in mark '937 will be perceived immediately as meaning a series of thoughts/mental images experienced during sleep or as referring to a person's aspirations or ambitions. Although the same word appears in the contested mark, it is qualified by the preceding word, Planet, being a well-known word describing a large celestial body. The combination of those two words in the contested mark results in

an overall concept of a planet (large celestial body) filled with dreams. I find the contested mark to be conceptually similar to mark '937 a below-medium degree.

41) The word DREAMS in mark '128 will be perceived in the same way as in mark '937. The word LONDON will be perceived as merely describing where the goods come from (the well-known capital of the UK) which does not introduce any distinctive conceptual difference between the marks. I find the contested mark to be conceptually similar to mark '128 to a below-medium degree.

Distinctive character of the earlier marks

42) The distinctive character of the earlier marks must be considered. The more distinctive each of them is, either by inherent nature or by use, the greater the likelihood of confusion between each of them and the contested mark (*Sabel BV v Puma AG*). 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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

43) The word DREAMS will be perceived in the manner already explained earlier in this decision. That is not a meaning which has any relevance to the goods at issue; it is neither descriptive nor allusive in relation to them. As such, I find mark '937 to have a medium degree of inherent distinctiveness.

44) The word LONDON in mark '128 is entirely descriptive and non-distinctive. As such the distinctiveness of that mark also rests in the word DREAMS. Mark '128 also has a medium degree of inherent distinctiveness.

45) I now turning to the question of whether the evidence before me is sufficient to show that the inherent distinctiveness of either or both marks has been enhanced through use. Whilst I accept that the evidence shows use of both marks in relation to women's clothing, the sales figures appear to be modest bearing in mind the enormity of the relevant market. Further, aside from regular attendance at UK trade shows between 2018 and 2025, there is nothing in the evidence to suggest that there has been any substantial advertising or promotion of the mark. I find no enhanced distinctiveness through use for either earlier mark.

Likelihood of confusion

46) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

47) I will first consider the likelihood of direct confusion between the contested mark and mark '937. The respective goods are identical. The marks are visually similar to a medium degree and aurally similar to a below-medium degree. Conceptually, there is a below-medium degree of similarity. The earlier mark also has a medium degree of distinctiveness. Weighing all these factors, I find that an average consumer, paying a medium level of attention, is unlikely to mistake one mark for the other, even allowing for imperfect recollection. There is no likelihood of direct confusion between the contested mark and mark '937. It logically follows that there is also no likelihood of direct confusion with mark '128 which, with all other factors being equal, is even less visually and aurally similar to the contested mark.

48) I will now consider the likelihood of indirect confusion. In this connection, I bear in mind that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 (*L.A. Sugar*), Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, explained that:

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

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

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

distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

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

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

49) I also keep in mind that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

50) I bear in mind that the categories listed above in *L.A. Sugar* are, of course, not an exhaustive list of all the ways in which indirect confusion can occur; they are merely examples of the way in which it tends to occur.

51) I can see no proper basis for concluding that the average consumer is likely to believe that the goods covered by the contested mark come from the same, or a linked undertaking to, those of mark '937. The common element is not so strikingly distinctive. Therefore, Mr Purvis' category a) is not applicable. Turning to Mr Purvis' category b), I do not consider that the word 'Planet' is likely to be viewed as a non-distinctive addition to the earlier mark, let alone one which is of the kind that one would expect to see in a sub-brand or brand extension in relation to the relevant goods at issue. Mr Purvis' category c) is also, clearly, not applicable. Nor can I identify any other way in which indirect confusion is likely to arise between the contested mark and mark '937, falling outside of the categories identified by Mr Purvis. I also do not accept the opponent's

contention that the word 'Dreams' retains an independent distinctive role in the contested mark. As I have already indicated, the two words in that mark combine to form a unit with an overall conceptual meaning that differs to the meaning of each of those words when taken alone. Therefore, the circumstances in *Medion*¹⁴ do not apply here, as contended by the opponent. In my view, the average consumer is likely to put the common use of the word DREAMS down to mere coincidence and nothing more. The opposition under Section 5(2)(b) of the Act based upon mark '937 fails.

52) I can also see no proper basis for concluding that the consumer is likely to believe that the goods covered by the contested mark come from the same, or a linked, undertaking to those of mark '128. Again, the common element is not so strikingly distinctive. Therefore, Mr Purvis' category a) is not applicable. Turning to Mr Purvis' category b), this, again, is clearly not applicable here. As regards Mr Purvis' category c), I am also not persuaded that this scenario applies here. 'Planet Dreams' consists of two distinctive words which combine to form a conceptual unit. 'DREAMS LONDON', on the other hand, consists of one distinctive word plus an entirely descriptive word which do not combine to form a conceptual unit. The position of the word 'DREAMS' is also different in the respective marks, being at the end of the contested mark and at the beginning of the earlier mark. These changes are far from being entirely logical and consistent with a brand extension. I also cannot identify any other way in which indirect confusion is likely to arise between the contested mark and mark '128, falling outside of the categories identified by Mr Purvis. In reaching this view, I have borne in mind, again, that 'DREAMS' in the contested mark does not have an independent distinctive role therein. I find that the average consumer is likely to put the common use of the word DREAMS down to mere coincidence and nothing more. The opposition under Section 5(2)(b) of the Act based upon mark '128 fails.

53) The opponent has failed based upon marks '937 and '128. The opponent is patently in no stronger position in relation to earlier mark '417. The opposition based on that mark must, logically, also fail.

¹⁴ *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, C-120/04

OUTCOME

54) The opposition fails.

COSTS

55) The applicant has been successful and is, in principle, entitled to an award of costs. The official letter, dated 04 February 2026, advised the applicant that, if they intended to make a request for an award for costs they should complete and return the relevant costs proforma by 04 March 2026. The same letter stated, inter alia, that:

“If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.”

No costs proforma was filed by the applicant and it has paid no official fees in these proceedings. Bearing this in mind, I make no award of costs.

Dated this 23rd day of September 2026

**Beverley Hedley,
For the Registrar**