

O/0893/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004056879 BY DOPEDREAMZ
LIMITED TO REGISTER:



AS A TRADE MARK IN CLASSES 14, 16, 25 & 26

AND

IN THE MATTER OF THE OPPOSITION
THERE TO UNDER NO. 449085

BY

RDSTR IP 2 AB

BACKGROUND AND PLEADINGS

1. On 28 May 2024, Dopedreamz Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the applicant’s mark”). The applicant’s mark was published on 14 June 2024 and registration is sought for the following goods:

Class 14: Badges of precious metal; Jewellery; Key rings and key chains; Ornamental pins; Precious and semi-precious stones and metals.

Class 16: Cards; Motivational cards; Paper and cardboard; Printed visuals; Printed matter; Stationery; Stickers.

Class 25: Casual clothing; Clothing, footwear, and headwear; Jackets; Jerseys; Loungewear and leisure clothing; Parts of clothing, footwear, and headwear; Shorts and pants; Tracksuits; T-shirts; all of the aforementioned being streetwear and none of the aforementioned for use in relation to skiing, snowboarding or cold-weather outdoor activities.

Class 26: Badges for wear, not of precious metal; Embroidered badges; Haberdashery; Ornamental novelty badges and buttons; Pins.

2. On 13 August 2024, the applicant’s mark was opposed by RDSTR IP 2 AB (“the opponent”). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).¹ Under both grounds of opposition, the opponent relies on the following trade marks:²

¹ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

² The opponent’s marks are comparable marks based on earlier EUTMs. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. These comparable marks enjoy the same filing and registration dates as their European counterparts.

DOPE

("the first earlier mark")

Trade mark number: UK00911518313

Filing date: 25 January 2013

Registration date: 21 June 2013

Relying on the following goods:

Class 25: Clothing, footwear, headgear; shirts, hoodies, jersey shirts; vests; sweaters; braces for clothing; collars (clothing); underwear; clothing; sweat absorbent underwear; clothing apparel; outerwear; jackets; (other than for protection against accidents and injuries); headbands (clothing); clothing of imitations of leather; clothing of leather; t-shirts; camisoles; hats; caps; shirts; socks; beach wear; gloves (clothing); gloves (other than for protection against accidents and injuries); sports headgear (other than helmets); pants; jeans; tights; shorts; swimwear; shorts; footwear for use in snowboarding and skiing; sports and leisure shoes and boots.



("the second earlier mark")

Trade mark number: UK00911333895

Filing date: 9 November 2012

Registration date: 13 May 2013

Relying on the following goods:

Class 25: Clothing, footwear, headgear; shirts, hoodies, jersey shirts; vests; sweaters; braces for clothing; collars (clothing); underwear; clothing; sweat absorbent underwear; clothing apparel; outerwear; jackets; (other than for protection against accidents and injuries); headbands (clothing); clothing of imitations of leather; clothing of leather; t-shirts; camisoles; hats; caps; shirts; socks; beach wear; gloves (clothing); gloves (other than for protection against

accidents and injuries); sports headgear (other than helmets); pants; jeans; tights; shorts; swimwear; shorts; footwear for use in snowboarding and skiing; sports and leisure shoes and boots.

DOPE

("the third earlier mark")

Trade mark number: UK00911518371

Filing date: 25 January 2013

Registration date: 21 June 2013

Relying on the following goods:

Class 25: Clothing, footwear, headgear; shirts, hoodies, jersey shirts; vests; sweaters; braces for clothing; collars (clothing); underwear; clothing; sweat absorbent underwear; clothing apparel; outerwear; jackets; (other than for protection against accidents and injuries); headbands (clothing); clothing of imitations of leather; clothing of leather; t-shirts; camisoles; hats; caps; shirts; socks; beach wear; gloves (clothing); gloves (other than for protection against accidents and injuries); sports headgear (other than helmets); pants; jeans; tights; shorts; swimwear; shorts; footwear for use in snowboarding and skiing; sports and leisure shoes and boots.

3. Under section 5(2)(b), the opponent claims that the marks are similar and that the respective goods are identical or similar, with the result that there is a likelihood of confusion.
4. Under Section 5(3), the opponent claims that its earlier marks have developed a significant reputation through their extensive use in the UK in relation to all of the goods identified above and that use of the applicant's mark in relation to the goods concerned will take unfair advantage of, and be detrimental to, the distinctive character or repute of the opponent's earlier marks.

5. The applicant filed a counterstatement, denying the opponent's claims and putting the opponent to proof of use and reputation in respect of its earlier marks.
6. The opponent is represented by Morgan, Lewis & Bockius UK LLP, and the applicant is represented by LEGALVISION LAW UK LTD.
7. Both parties filed evidence in chief during the proceedings with the opponent also electing to file evidence in reply. No hearing was requested and only the opponent filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

EVIDENCE

8. The opponent's evidence in chief consists of the witness statement of Elin Glommen, dated 20 December 2024 together with exhibits EG1 to EG4. Ms Glommen is the Chief Executive Officer of both the opponent and Ridestore AB. Her evidence serves to show the use the opponent has made of its earlier marks and the reputation it claims to hold. I note that submissions were also filed alongside the evidence.
9. The applicant's evidence consists of a witness statement of Jenaro Denver Henry, dated 19 February 2025, together with exhibits JDH1 to JDH4. Mr Henry is a director, shareholder and founder of the applicant. His evidence concerns the adoption and intended meaning of the applicant's mark, the applicant's goods and branding, and third-party and dictionary use of the word DOPE.
10. The opponent's evidence in reply consists of the second witness statement of Elin Glommen dated 22 April 2025. The witness statement is accompanied by exhibit EG1.³ I note that submissions were also filed with the evidence in reply.

³ I note that there are two exhibits in these proceedings labelled EG1. As such, I will refer to the exhibit from the second witness statement as 2EG1.

11. I do not intend to summarise the evidence and submissions in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

My approach

12. Considering the earlier marks relied upon within this opposition, it is my view that the first earlier mark, namely the word mark DOPE, presents the opponent with its strongest case. I say this because it provides equal protection in respect of the goods relied upon to the second and third earlier marks. Further, as the first earlier mark is a word mark, it is the word that is protected, irrespective of colour, form or typeface.⁴ In the event that I find a likelihood of confusion in respect of that mark, any finding in respect of the remaining marks does not further the opponent's case. Conversely, if no likelihood of confusion exists in respect of the first earlier mark, the opponent is unlikely to be in a stronger position under the remaining marks, which contain additional stylisation but cover the same goods. I will therefore focus my assessment on that mark. If required, I will return to the remaining marks later in this decision. For the avoidance of doubt, I shall refer to the opponent's first earlier mark as 'the earlier mark' throughout the remainder of this decision.

Proof of use

13. The opponent's mark qualifies as an earlier trade mark under section 6 of the Act by virtue of its earlier filing date. As it completed its registration process more than five years before the filing date of the applicant's mark, it is subject to the use provisions in section 6A of the Act.

14. The relevant statutory provision is Section 6A of the Act, which states:

⁴ *LA Superquímica v European Union Intellectual Property Office* (EUIPO), Case T-24/17, paragraph 39

“(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.”

15. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

16. 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.”

17. 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 Merken 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, 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].”

18. Section 6A of the Act (cited above) sets out that the relevant period for the present assessment is the five-year period prior to the filing date of the applicant’s mark, being 28 May 2024. The relevant period is, therefore, 29 May 2019 to 28 May 2024 (“the relevant period”).

Evidence of use

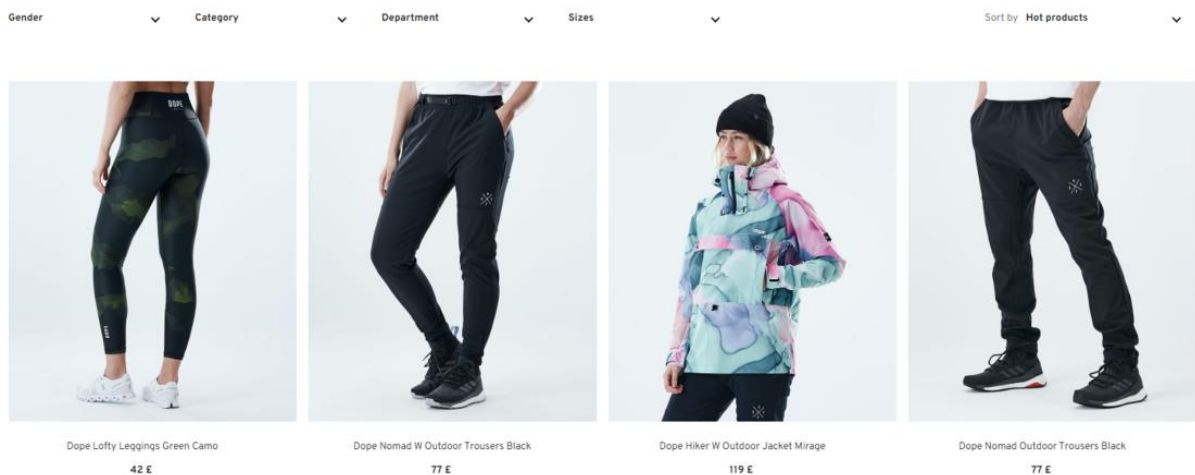
19. I note the following from the opponent’s evidence:

20. The opponent owns the brand “DOPE”. The brand was founded in 2006 and specialises in the sale of snow wear and outerwear for men and women.⁵

21. Ms Glommen states that the opponent advertises its goods in the UK on its websites www.ridestore.com/uk.dope and www.dopesnow.com/uk. Dated printouts of goods being sold on these websites are included in exhibit EG1. I

⁵ Paragraph 7 of the first witness statement of Elin Glommen

note that the printout dates range from 30 June 2020 to 29 January 2024. The goods shown include leggings, jackets and snowboard jackets, fleece jumpers and outdoor trousers. An example is shown below:



22. Exhibit EG2 contains 14 invoices dated between 22 August 2019 and 13 December 2020 relating to sales in a number of EU Member States, including Belgium, Finland, Germany, France, Poland, Estonia, Austria, Lithuania and Romania. The invoices concern approximately 22 items in total, with individual invoices generally recording sales of between one and three items. Jackets and trousers/pants appear with the greatest frequency, although the invoices also record sales of a T-shirt, a hoodie, a beanie hat and face coverings.

23. Although no invoices pertaining to UK sales have been included, Ms Glommen provides the following UK sales figures:

Date	Sales (exclusive of VAT)
2020	£11,017,127
2021	£2,129,463
2022	£4,130,064
2023	£5,344,076
2024	£2,625,891

24. The above figures have not been broken down in relation to each good relied upon. Phillip Johnson, sitting as the Appointed Person, stated in *W Sternoff LLC v Peter Kertels*, (“*Eros Bodyglide*”) BL O/0984/25:

“26. Where global sales figures are provided for multiple goods sold under one trade mark this is not going to be evidence of use for any of those goods. The sales could all be in relation to good A or all in relation to good B or a split between the two. This is why particularisation is so important as without it the figures provide no evidence of use for either good A or good B. The same applies where the same good is sold under trade mark A and trade mark B.

27. Evidence of sales is only useful for establishing genuine use where it sets out the sales revenue for a particular and identified good (or service) and it is clear that that good or service is sold under the trade mark. Only where there is only one good being sold and it is sold under only one trade mark can global figures be sufficient.”

25. I do not take the above comments of Professor Johnson to automatically mean that there cannot be genuine use if the turnover is not broken down. Instead, I must be satisfied that, on balance of the evidence as a whole, it is reasonable to infer a level of use that is sufficient to be deemed genuine. Where it relates to a wide range of goods, the absence of a breakdown may make it difficult to apportion turnover with any accuracy. However, where the evidence relates mainly to one or two goods or services, it may be reasonable to draw such an inference, provided the level of use appears sufficient.

26. Exhibit EG3 contains printouts from 14 online articles and blog posts that refer to “DOPE” branded goods from within the relevant period. I note that the articles included all list the prices in pounds sterling, so I am satisfied that these articles would have been targeted at consumers in the UK. By way of example, details of three articles/blog posts are as follows:

- An article from www.snowmagazine.com (20 December 2021) titled “Could this be the best value ski jacket out there?”. The article features a Dope

branded ski jacket for £158 and says, “Set up by two snowboarding brothers, frustrated with the lack of options for outdoor sport brands in their native Sweden, Dope Snow have grown to become one of the country’s largest e-retailers...they aim to offer premium quality ski and snowboard jackets, pants and clothing at a more favourable price than their big-name competitors.”

- A blog post from www.theskicompany.com (31 January 2023) titled “Packing for your self-catered ski holiday in The Three Valleys”. The blog post refers to Dope’s UK website in relation to ski jackets and trousers and says “...my sources tell me these are the current go-to brands for latest hip looks on the snow.”
- An article from www.omotgtravel.com (27 February 2024) titled “Cool gear for extreme sports”. The article features several items of “DOPE” branded goods such as a snowboarding jacket, gloves, a beanie hat and a hoodie. The article says, “Swedish firm Dope Snow is a firm favourite of sports enthusiasts in Scandinavia and now fans outside Sweden can join in the fun too.”

27. Ms Glommen states that the “DOPE” trade marks are frequently used on social media to refer to the “DOPE” goods. Exhibit EG4 includes printouts of various “Dope Snow” Facebook posts dated from 13 January 2019 to 17 December 2020. From the posts dated within the relevant period, I note that the mark “DOPE” is visible on beanie hats, hoodies, jackets, fleeces and gloves.

Variant use

28. Before I consider whether the evidence constitutes sufficient use of the earlier mark, it is necessary to address the mark shown in use and determine whether this is either use of the mark as registered and/or use of an acceptable variant of the same.

29. The opponent's registration is for the word mark "DOPE"; however, the evidence includes use of the earlier mark in its registered form and as follows:

a) DOPE SNOW



b)



c)



d)

30. As previously mentioned, the earlier mark is registered in word-only format and, as such, it is protected for the word itself, not the form in which it is presented. As such, the font in the evidenced mark must not be taken into account.⁶ It is also settled law that use of a trade mark includes its independent use and its use as part of a composite mark, provided that it continues to be indicative of the origin of the product.⁷

31. The first example consists of the registered word "DOPE" followed by the word "SNOW". The word "SNOW" is plainly allusive of skiing, snowboarding and related winter activities. Its addition does not alter the distinctive character of the

⁶ See *La Superquímica v EUIPO*, Case T-24/17, *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, and *PW Branding, Inc v Zabou Group Limited*, BL O/0234/25.

⁷ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

registered mark. I therefore find that “DOPE SNOW” is an acceptable variant of the earlier mark for the purposes of section 6A.

32. Turning to the second example, the letters “D”, “O”, “P” and “E” are arranged separately around a crossed-line device. Although consumers may recognise those letters as spelling DOPE, their unusual arrangement and integration with the figurative element make a significant contribution to the overall impression of the sign. In my view, those features alter the distinctive character of the earlier mark. I therefore do not regard this sign, viewed in isolation, as an acceptable variant of the registered mark.

33. The third and fourth examples comprise the word DOPE presented with a mountain device above it and the term MMIX beneath. The word DOPE remains clearly visible and continues to perform an independent origin-indicating function within each composite sign. In accordance with *Colloseum*, I therefore find that these examples constitute use of the earlier mark as registered.

34. If I am wrong in that finding, I would in any event regard the signs as acceptable variants. The mountain device is decorative and allusive of the outdoor context in which the goods are used, while MMIX is subordinate in size and position. Neither element alters the distinctive character of the word DOPE.

Assessment of the evidence

35. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each piece of evidence shows use by itself.⁸ Genuine use depends upon a variety of factors, including the nature of the goods and the characteristics of the market, the consistency of sales over time and whether the use is warranted to create or maintain a share in that market.

⁸ *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, General Court of the European Union, Case T 415/09

36. While itemised turnover figures, details of advertising expenditure and UK invoices would have assisted the opponent, the evidence must be assessed as a whole. The evidence includes UK-facing webpages showing the mark used throughout the relevant period in relation to various clothing goods, including jackets, trousers and hooded garments. Those webpages must be considered alongside the UK turnover figures, the invoices demonstrating actual sales of those goods within the EU during the relevant period, and the press and social media evidence showing the continued promotion of the opponent's goods.

37. I have found that the second example shown under variant use does not constitute an acceptable variant of the earlier mark. However, even excluding those instances of use from my assessment, the remaining evidence is sufficient to establish genuine use. In particular, the evidence shows consistent use of the mark (or an acceptable variant) in relation to jackets, trousers, outerwear, hoodies, hats and other clothing goods, supported by evidence of actual sales and turnover.

38. Considering the evidence as a whole, I am satisfied that the opponent has demonstrated genuine use which shows ongoing commercial activity. That being said, I do not consider the opponent has demonstrated use for all goods for which its mark is registered, and I will now consider a fair specification.

Fair specification

39. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

40. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the

legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

41. I first note that in her witness statement, Ms Glommen states that the opponent specialises in snow wear and outerwear. However, the purpose of arriving at a fair specification is to identify the category of goods for which genuine use has been demonstrated, not the particular market sector in which those goods were sold.

42. Exhibit EG1 contains extracts from the opponent’s UK-facing websites throughout the relevant period, showing the earlier mark used in relation to various clothing items, including jackets, hooded garments, trousers and leggings. I consider this evidence identifies the nature of the goods offered by the opponent under the earlier mark.

43. UK turnover figures were also provided for the period 2020 to 2024. I accept that those figures have not been broken down by product or product category and, therefore, do not permit any precise assessment of the level of sales attributable to particular goods. However, this is not a case where the evidence relates to a broad range of unrelated goods. Rather, the evidence consistently shows use of the earlier mark in relation to a relatively confined range of clothing items. Read alongside the website evidence, invoices, press coverage and social media material, I consider it reasonable to infer that the turnover figures relate, at least in part, to the clothing goods shown throughout the evidence.

44. Exhibit EG2 contains 14 invoices dated between 22 August 2019 and 13 December 2020 relating to sales made in various EU Member States. The invoices concern approximately 22 items in total, with individual invoices generally recording sales of between one and three items. Jackets and trousers appear with the greatest frequency, although the invoices also show sales of a T-shirt, a hoodie, a beanie hat and face coverings. I consider the invoices demonstrate genuine commercial sales of those goods.

45. I do not consider the evidence justifies retaining the unrestricted terms “clothing”, “clothing apparel” or “footwear”. Whilst use has been shown for certain clothing items, those broad terms encompass a number of independently identifiable sub-categories which are not fairly represented by the use shown. At the same time, it would be unduly restrictive to confine the opponent to the precise products shown in the invoices. The jackets shown are fairly described as “jackets” and “outerwear”, the trousers as “pants”, and the beanie as a “hat”. I also consider the evidence sufficient to establish genuine use in relation to hoodies and T-shirts. Taking the evidence as a whole, and applying *Euro Gida* and *Merck*, I consider the following to be a fair specification:

Class 25: Outerwear; jackets; hoodies; T-shirts; pants; hats.

Section 5(2)(b)

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

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

[...]

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

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

47. Section 5A states:

“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.”

Section 5(2) case law

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of goods

49. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

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

50. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

51. In *Gérard Meric v OHIM*,⁹ (“*Meric*”), the General Court (“GC”) held that 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 and vice versa.

52. Following on from my assessment of genuine use, the goods to be compared are as follows:

Opponent’s goods	Applicant’s goods
Class 25: Outerwear; jackets; hoodies; T-shirts; pants; hats.	Class 14: Badges of precious metal; Jewellery; Key rings and key chains; Ornamental pins; Precious and semi-precious stones and metals. Class 16: Cards; Motivational cards;

⁹ Case T-133/05

	Paper and cardboard; Printed visuals; Printed matter; Stationery; Stickers. Class 25: Casual clothing; Clothing, footwear, and headwear; Jackets; Jerseys; Loungewear and leisure clothing; Parts of clothing, footwear, and headwear; Shorts and pants; Tracksuits; T-shirts; all of the aforementioned being streetwear and none of the aforementioned for use in relation to skiing, snowboarding or cold-weather outdoor activities. Class 26: Badges for wear, not of precious metal; Embroidered badges; Haberdashery; Ornamental novelty badges and buttons; Pins.
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53. The opponent submits that the respective goods in class 25 are identical. They go on to submit that the goods covered by classes 14, 16 and 26 of the application are similar to the class 25 goods covered by the earlier mark. This is because the goods might be purchased/offered at the same sales outlets and are aimed at the same relevant public. They assert that due to this complementary relationship, it is likely that a significant part of the relevant public may believe that the goods covered by the application are produced/provided by the same undertaking.¹⁰

54. The applicant submits that the competing goods in class 25 differ by way of their intended uses. They argue that the applicant's class 25 goods are intended to be worn more casually in urban settings whereas the opponent's goods are intended to be worn to keep the user warm during outdoor, cold weather activities such as skiing or snowboarding. In relation to the remaining goods to be compared, they

¹⁰ Paragraphs 33 and 34 of the opponent's submissions dated 20 December 2024.

submit that the goods are dissimilar because they are unlikely to be sold alongside one another, they are unlikely to be purchased by the same consumers, they are not in any competition nor are they complementary.¹¹

55. For the avoidance of doubt, I must carry out a notional assessment based upon the parties' respective marks and the goods contained in their specifications. The actual target market and the activities they carry out are not relevant to my assessment.¹²

Class 14

56. I am of the view that the applicant's *Badges of precious metal; Jewellery; Key rings and key chains; Ornamental pins* and *Precious and semi-precious stones and metals* have a different nature, intended purpose and method of use from the opponent's goods in class 25. The goods are not in any competition. Although the goods may be worn together, I do not consider them to be important or indispensable to one another to the extent that consumers would believe that they are derived from the same undertaking. They are therefore not complementary. Whilst I accept that the goods may be sold alongside one another and have the same users, I consider this too limited to warrant a finding of similarity. Accordingly, these goods are dissimilar.

Class 16

57. For the same reasons I have given in the preceding paragraph, I consider *Cards; Motivational cards; Paper and cardboard; Printed visuals; Printed matter; Stationery* and *Stickers* to be dissimilar to the opponent's goods in class 25. The competing goods have a different nature, purpose and method of use. They are not in competition, nor are they complementary. Whilst trade channels and users may overlap at a high level (for example, the goods may be sold in a large

¹¹ Paragraphs 20 and 21 of the applicant's submissions dated 20 February 2025.

¹² *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66]; *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22].

department store or supermarket), this overlap is not sufficient for a finding of similarity.

Class 25

58. Before I conduct my comparison for the goods in class 25, I note that the applicant's class 25 goods are limited to streetwear and exclude goods for use in relation to skiing, snowboarding or cold-weather outdoor activities. Whilst I have taken that limitation into account, it does not impact on the comparison I must make. I say this because the opponent's evidence establishes genuine use of the earlier mark for jackets, outerwear, hoodies, T-shirts, pants and hats. Such goods are not limited to skiing, snowboarding or cold-weather activities so they remain the same in nature, purpose and method of use regardless of how they are marketed. For example, a T-shirt remains a T-shirt notwithstanding the context in which it is promoted or used. Therefore, whilst the limitation may narrow the applicant's commercial focus, it does not remove the overlap between the respective goods.

59. The terms *Jackets*; *T-shirts* and *pants* appear in both specifications. They are clearly identical.

60. The applicant's *Casual clothing* and *Clothing* are broad terms that would encompass the opponent's terms such as *outerwear*. They are therefore identical in line with *Meric*.

61. The applicant's specification includes the term *headwear*. I consider this would encompass the term *hats* in the opponent's specification. Consequently, they are identical in line with *Meric*.

62. I consider *Loungewear* and *leisure clothing* to be casual clothing made of soft materials. This would include goods in the opponent's specification such as *t-shirts*, *hoodies* and *pants*. I therefore find these goods to be identical in line with *Meric*.

63. *Tracksuits* are a two-piece set of casual athletic clothing consisting of trousers and a jacket. I am of the view that this term in the applicant's specification is identical to the opponent's *pants* and *jackets*. Alternatively, I consider these goods to be highly similar based on their shared nature, purpose and method of use. They would also be sold alongside one another and have the same users.

64. I consider that *jerseys* in the applicant's specification and *hoodies* in the opponent's specification would overlap in purpose, nature and method of use. I say this because they would typically be made of the same or similar materials and they would be worn on the upper body. I am of the view that they would be sold in close proximity to one another and share the same users. Consequently, I find there is a medium to high degree of similarity.

65. To my mind, the closest comparator to the applicant's *shorts* is the opponent's *pants*. Both would be made of the same or similar materials and are to be worn on the lower body though I acknowledge that pants are typically longer than shorts. I consider the goods would be sold alongside each other and share the same users. I do not consider that they would be complementary. Overall, I find these goods similar to a high degree.

66. I consider that the applicant's *footwear* differs in nature compared to the opponent's earlier goods however, there is an overlap in method of use and purpose because the respective goods are worn on the body to protect the user from the elements or for fashion purposes. The goods would be sold in close proximity to one another, and it is not uncommon for producers of clothing to also make and sell footwear. There is also an overlap in users though I do not consider the goods to have a competitive or complementary relationship. On balance, I find these goods to be similar to a medium degree.

67. To my mind, *Parts of clothing, footwear, and headwear* are used to manufacture finished items of clothing, footwear and headwear. Accordingly, they may overlap in nature compared to the opponent's goods as they would be made from the same

or similar materials. However, I consider the purpose and method of use would differ. There is a degree of complementarity because the goods are important to one another to the extent that users may believe they are derived from the same undertakings. Users and trade channels may also overlap. Overall, I consider there to be a low to medium degree of similarity.

Class 26

68. I consider the applicant's *Badges for wear, not of precious metal; Embroidered badges; Haberdashery; Ornamental novelty badges and buttons and Pins* have a different nature, purpose and method of use compared to the opponent's goods. While users may overlap, the goods are not in competition, nor are they complementary. Further, there is nothing before me to suggest that trade channels would overlap. Consequently, I find these goods to be dissimilar.

69. If there is no similarity between the goods, there can be no likelihood of confusion under section 5(2)(b): see *eSure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA, paragraph 49. The opposition therefore fails under section 5(2)(b) with respect to the goods in classes 14, 16 and 26.

The average consumer and the purchasing act

70. As the case law above indicates, it is necessary to determine who the average consumer is for the goods and services at issue. I must then determine the manner in which the goods and services are likely to be selected by the average consumer.

71. 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.

72. In *Iconix* (cited above), 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.

73. The average consumer of the goods at issue will primarily comprise members of the general public. The cost of the goods in issue is likely to vary and the goods will be purchased relatively frequently. Various factors are likely to be taken into

consideration during the purchasing process, such as materials used, available sizes, cut, aesthetic appearance and durability for the goods. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

74. The goods will be purchased either from a clothing or department store, either visiting a physical shop or ordering from the internet or a printed catalogue. This means that the mark will be seen and so the visual element of the mark will be the most significant.¹³ Although I do not discount an aural element, as the consumer may in some cases be assisted by a member of staff, even in those circumstances, the consumer will view the mark before making a purchase, therefore visual considerations will dominate.

Comparison of the marks

75. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

76. 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.”

¹³ *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, at [50].

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

78. The respective trade marks are shown below:

The earlier mark	The applicant's mark
DOPE	

79. The earlier mark is in word-only format and consists of the word “DOPE”, presented in an upper-case font. The overall impression lies in the word itself.

80. The applicant's mark consists of the words “Dope Dreamz” presented in a white stylised cursive font displayed over a black rectangular background. The overall impression is dominated by the wording. The stylisation makes a secondary contribution while the black background being negligible.

81. Visually, the marks coincide through use of the word “DOPE”. This is the entirety of the opponent's mark and the first element of the applicant's mark. I bear in mind that beginnings of marks are where the average consumer tends to pay more attention.¹⁴ However, I note that this is a rule of thumb, rather than a rule of law.¹⁵ A point of difference lies in the additional word “DREAMZ” that appears in the applicant's mark and has no counterpart in the opponent's mark. This results in the applicant's mark being noticeably longer than the opponent's mark. Whilst

¹⁴ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

¹⁵ Paragraph 21 of case BL O/0648/24, Dr Brian Whitehead, sitting as the Appointed Person.

I have taken into account the stylised presentation of the applicant's mark, I bear in mind that the opponent's mark is registered in word-only format and is therefore not limited to any particular font or script. Taking these factors into account, I find that the marks are visually similar to a low to medium degree.

82. The word "DOPE" is an ordinary English dictionary word and will be pronounced in the normal way. The point of aural overlap lies in this word as it will be pronounced identically in both marks. The applicant's mark contains an additional word, namely "DREAMZ". Despite its spelling, I consider this will be articulated as "dreams". This creates a point of difference as this word does not appear in the opponent's mark. On balance, I find there to be a medium degree of aural similarity.

83. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

84. The word "DOPE" is an informal slang term which is capable of conveying a number of meanings. For example, it may refer to an ignorant person, illegal drugs, or something regarded as "excellent".¹⁶ I consider that the word "DREAMZ" in the applicant's mark will be understood as a fanciful misspelling of the word "dreams". Consumers will therefore perceive that word as meaning mental activity occurring during certain phases of sleep or a cherished hope or aspiration.¹⁷ When viewed together, "DOPE" may be perceived as qualifying "DREAMZ", giving rise to the idea of dreams that are "dope", in the sense of being excellent. Nevertheless, the meaning of DOPE remains perceptible within the applicant's mark and I do not consider that the conceptual meaning of the word "DOPE" is altered by its combination with the word "DREAMZ". Further, I do not consider that the stylisation of the applicant's mark will convey any meaning to consumers. The

¹⁶ <https://www.collinsdictionary.com/dictionary/english/dope>

¹⁷ <https://www.collinsdictionary.com/dictionary/english/dream>

marks therefore share the same concept that will be conveyed by the word “DOPE” however, the applicant’s mark introduces a second concept that is not present in the opponent’s mark. On balance, I consider the marks to have a medium degree of conceptual similarity.

Distinctive character of the earlier mark

85. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-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).”

86. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks

can be enhanced through use, and I note that the opponent has filed evidence of use for its earlier mark. I will, therefore, consider whether this is sufficient to give rise to a finding that the distinctiveness of the opponent's mark has been enhanced through use. Before doing so, I will consider the inherent position.

87. The opponent's mark consists solely of the word "DOPE". That word may convey a number of meanings. In the context of clothing, a proportion of consumers may understand it as slang for "excellent", suggesting that the clothing, or the wearer's appearance in it, is particularly good. To that extent, the mark has a degree of laudatory allusion. On balance, I find the mark to possess no more than a medium degree of inherent distinctiveness.

88. I now turn to consider the position with regard to an enhanced degree of distinctive character. I have already outlined the opponent's evidence when assessing genuine use. I do not intend to reproduce that evidence in full but have borne it in mind in reaching my decision on enhanced distinctiveness. The relevant date for this assessment is the filing date of the applicant's mark being 28 May 2024 and the relevant market for assessing enhanced distinctiveness is the UK market.

89. Whilst I recognise that there has been some coverage in UK publications, I have no information about the reach of these articles. I also acknowledge that one of the articles says "Set up by two snowboarding brothers, frustrated with the lack of options for outdoor sport brands in their native Sweden, Dope Snow have grown to become one of the country's largest e-retailers..." However, it is unclear which country the article is referring to. If the article did mean to describe the opponent as one of the largest e-retailers in the UK, then I consider this claim would have been sufficiently substantiated in the evidence. However, there is no information pertaining to advertising expenditure in the UK. While I note that printouts of Facebook posts have been provided, there is no indication as to how many UK consumers were exposed to the mark.

90. I also note that the turnover figures reflect a respectable but low level of use in the context of the market. Whilst I found the opponent's evidence sufficient to show genuine use, I remind myself that the bar for proving enhanced distinctiveness is considerably higher. This is because it requires a level of knowledge of the mark amongst average consumers leading to the mark having a greater capacity to identify the goods as coming from a particular undertaking, not simply that there has been an attempt to create or maintain a market for goods under the mark. In my view, the evidence filed is not sufficient to establish any enhanced distinctiveness.

Likelihood of confusion

91. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he or she has retained in their mind.

92. Earlier in this decision I found the similarity of the goods range from low to medium through to identical. I concluded that the average consumer would comprise members of the general public who would pay a medium degree of attention during the purchasing process. I found that the goods would be selected primarily by visual means, although I did not discount an aural aspect to the purchasing process. I found the respective marks to be aurally and conceptually similar to a

medium degree and visually similar to a low to medium degree. I found the opponent's mark to hold no more than medium degree of inherent distinctiveness, though the level of distinctiveness has not been enhanced through the use made of it.

93. Taking all the relevant factors into account and even bearing in mind the principle of imperfect recollection, I consider it unlikely that the marks will be mistakenly recalled or misremembered as each other, even when paying a medium degree of attention for identical goods. This is on the basis that I do not consider the average consumer would overlook the presence of the word "DREAMZ" in the applicant's mark which creates a noticeably longer mark. As such, there is no likelihood of direct confusion.

94. I will now consider whether there is a likelihood of indirect confusion. I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., 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)".

95. These examples are not exhaustive but provide helpful focus.

96. I recognise that the Court of Appeal has emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.¹⁸ In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.¹⁹

97. Even where the goods are identical, I see no logical basis upon which the average consumer, having recognised that the marks are different, would conclude that they originate from the same or economically linked undertakings. The differences between the marks are not consistent with the examples identified in *L.A. Sugar*. Further, the shared element "DOPE" is not so distinctive that consumers would assume it to be used exclusively by a single undertaking. Whilst collaborations between fashion brands are not uncommon, I do not consider that the addition of the word "DREAMZ" would be perceived as a logical brand extension,

¹⁸ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

¹⁹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

collaboration or sub-brand. In the applicant's mark, "DOPE" also qualifies "DREAMZ" and contributes to the combined idea of dreams that are "dope" or excellent. Although this does not prevent the meaning of "DOPE" from remaining perceptible, it gives the applicant's mark a different overall conceptual message and points away from "DREAMZ" being understood merely as an indicator of a sub-brand or extension of the earlier mark. Rather, any similarity arising from the shared element "DOPE" is more likely to be attributed to coincidence than to a shared commercial origin. Consequently, I find no likelihood of indirect confusion.

Conclusion

98. The section 5(2)(b) ground has failed. Having found no likelihood of confusion in relation to the opponent's strongest earlier mark, the opponent cannot be in a better position under its remaining earlier marks. It follows that there is no need for me to consider those marks further. I will now proceed to consider the section 5(3) ground.

Section 5(3)

99. Section 5(3) of the Act states:

"(3) A trade mark which-

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".

100. Section 5(3A) of the Act 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".

101. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-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 C-383/12P, *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) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L’Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a

change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

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

102. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are identical or similar. Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the

public to make a link between them. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. The relevant date for the assessment under section 5(3) is the filing date of the applicant's mark being 28 May 2024.

103. I remind myself that under the present ground, the opponent relied upon its three earlier marks. However, for the reasons I have outlined above in paragraph 12, I consider it appropriate to focus my assessment on the opponent's first earlier mark as it presents the opponent's strongest case.

Reputation

104. 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."

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

106. I have previously summarised the opponent's evidence at paragraphs 19 to 27 above. I have already found that, whilst the evidence was sufficient to establish genuine use, it was not sufficient to establish that the distinctive character of the earlier mark had been enhanced through use at the relevant date. Whilst I acknowledge that reputation and enhanced distinctive character are different, the nature, factors, and evidence used to prove them are the same. For the same reasons as given at paragraphs 89 to 90, I do not consider the evidence to be sufficient to establish the required reputation and the claim under this ground fails at the first hurdle.

Conclusion

107. The opposition under Section 5(3) fails.

CONCLUSION

108. The opposition under sections 5(2)(b) and 5(3) of the Act has failed. Subject to any appeal against this decision, the application may proceed to registration for all of the goods applied for.

COSTS

109. The applicant has succeeded and is entitled to a contribution towards its costs.

Awards of costs in proceedings commenced on or after 1 February 2023 are governed by Annex A of Tribunal Practice Notice ('TPN') 1 of 2023. Using that TPN as a guide, I award the applicant the sum of **£850** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the Statement of Grounds and preparing the Counterstatement:	£250
Filing evidence:	£600
Total:	£850

110. I therefore order RDSTR IP 2 AB to pay Dopedreamz Limited the sum of **£850**.

The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of September 2026

Catrin Williams

For the Registrar