

O/0895/26

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION 1829854
IN THE NAME OF IICOMBINED CO., LTD.**

FOR THE FOLLOWING TRADE MARK:

TAMBURINS

IN CLASS 14

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 453439 BY
LOUIS VUITTON MALLETTIER**

BACKGROUND AND PLEADINGS

1. On 8 November 2024, IICOMBINED Co., Ltd. (“the holder”) applied to protect International Registration 1829854 (“the IR”) in the United Kingdom for the trade mark “TAMBURINS”. The IR claims a priority date of 18 July 2024 from an earlier registration.¹ The application was published for opposition purposes on 10 January 2025 in respect of the following goods:

Watches incorporating MP3 players; shoe jewellery; earrings; statues of precious metal and their alloys; precious metals; boxes of precious metal; jewellery made of precious metals; metal key rings; paste jewelry; necklaces; semi-wrought precious metals; semi-wrought precious stones and their imitations; rings [jewelry]; jewellery; jewellery boxes; clocks and parts therefor; clock cases; women's jewelry; key rings [split rings with trinket or decorative fob]; charms for key chains; coins; charms for jewellery; chains [jewellery]; watches incorporating cameras; cuff links; bracelets [jewelry]; pendants [jewelry]. (Class 14)

2. On 8 April 2025, Louis Vuitton Malletier (“the opponent”) opposed the application, in its entirety, under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. For the purpose of its objections under sections 5(2)(b) and 5(3), the opponent relies upon the following trade mark and the goods set out below, for which it is registered:

United Kingdom Trade Mark (“UKTM”) 903067857²:

TAMBOUR

Filing date: 27 February 2003

Registration date: 21 December 2004

¹ KR 4020240132613

² The opponent’s mark is a comparable mark based on an earlier EUTM. On 1 January 2021, comparable marks were automatically created in accordance with Article 54 of the Withdrawal Agreement between the UK and EU. They are now recorded on the UK register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing dates.

Jewellery including bracelets; horological and chronometric instruments and apparatus including watches, watch cases. (Class 14)

4. By virtue of raising an objection under section 5(2)(b), the opponent submits that the similarity between the parties' marks coupled with the similarity between the respective goods gives rise to a likelihood of confusion. Under section 5(3), the opponent contends that its earlier mark has established a substantial reputation and that use of the holder's mark would take unfair advantage of its reputation and/or be detrimental to the earlier mark's distinctiveness and cause reputational damage. Finally, under section 5(4)(a), the opponent claims to have used the sign **TAMBOUR** throughout the UK since 2002 in respect of *jewellery including bracelets and watches and watch cases* and that use of the holder's mark would have a negative effect on the goodwill acquired under its sign.

5. In its counterstatement, the holder denies each ground of opposition. It also puts the opponent to proof of use for all goods relied upon.

6. The opponent is represented by D Young & Co LLP and the holder by Withers & Rogers LLP. Both parties filed evidence during the course of the proceedings. Whilst neither party requested a hearing, both elected to file written submissions in lieu of the same. This decision is taken following a careful perusal of the papers.

Relevance of EU Law

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 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.

EVIDENCE

8. The opponent's evidence comes in the form of a witness statement from Ms Karine Chala, Senior IP In-House Counsel for the opponent, alongside ten supporting exhibits (KC1-KC10). Ms Chala's statement is dated 12 August 2025. I take the following from the opponent's evidence:

- Beginning with the opponent's history, Ms Chala explains that, in 1837, Louis Vuitton began an apprenticeship as a trunk maker in Paris before opening his own workshop in 1854, moving out of Paris in 1859 and opening an atelier outside of the city. Whilst the workshop started with only 20 employees, it remains active today with 170 craftsmen designing and creating leather goods and "special orders"³.

- Ms Chala submits that Louis Vuitton is now an "iconic brand" worldwide, not only for trunks and luggage but "a wide range of goods including toys, clothing and accessories". "TAMBOUR" is said to be one of the brands in the opponent's extensive portfolio.

- The TAMBOUR range was launched in 2002 as a line of watches which were "immediately recognisable through their drum-shaped case". Ms Chala submits that it has since grown into one of the world's leading luxury watch brands.

- An article from World Tempus published in July 2024 discusses the origins of the opponent's TAMBOUR watch and the evolution of various features. The article also references the opponent's receipt of the Audacity Prize at the 2021 Grand Prix d'Horlogerie de Geneve ("GPHG"), described in a later exhibit as "the Oscars of the watch industry"⁴. The range itself is described as "an icon among watches", with the article summarising that "A mere twenty years have passed since Louis Vuitton burst onto the scene and the Tambour's perfect performance shows how brilliantly the brand has achieved its objective and established its credentials with a watch whose character and identity are in a class of their own." I reproduce examples of the article's images below showing the Tambour in steel (CHF⁵ 18,000), Tambour in steel and rose gold (CHF 26,000) and Tambour in rose gold (CHF 51,500):

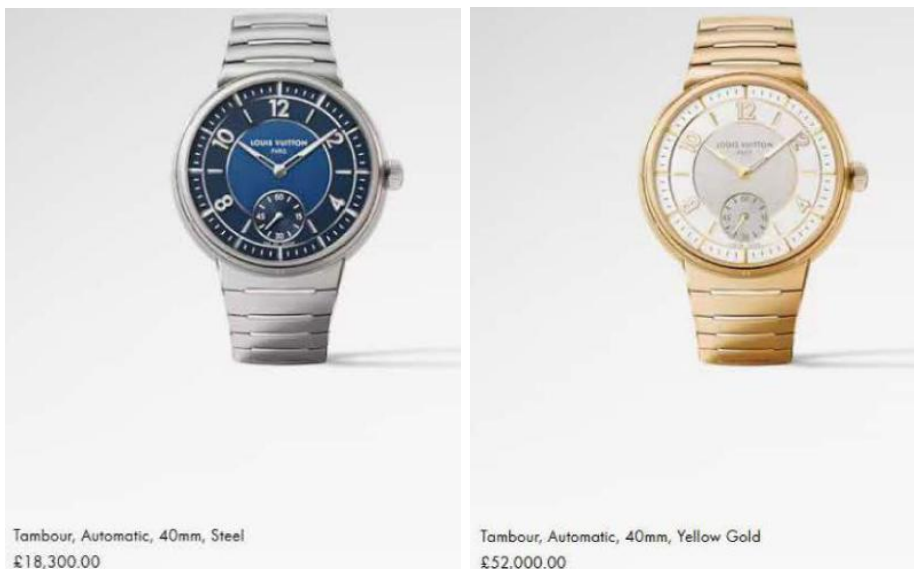
³ The company history is detailed in extracts from the opponent's website enclosed at KC1

⁴ *OracleofTime.com*, 14 November 2024

⁵ This appears to be shorthand used for the currency Swiss Franc



- The opponent's mark has been used "continuously and extensively" throughout the UK since its launch in 2002. Ms Chala encloses an excerpt from the opponent's 2002 annual report in which the launch of TAMBOUR is discussed. The excerpt explains that "*Tambour* was sold in about sixty Louis Vuitton stores in 2002... the collection will be offered in an additional sixty stores in 2003 and will be rapidly expanded with new models." It is not clear where the stores were situated.
- Screenshots of the opponent's current website⁶ show its line of Tambour watches for sale, with prices provided in GBP. As for any screenshots within the relevant period, Ms Chala explains that the opponent's UK site has not been archived correctly in the Wayback Machine platform, with screenshots of the site displaying an error message enclosed at Exhibit KC4. Ms Chala submits that the present-day screenshots are nonetheless "indicative of use of the earlier mark throughout the relevant period". I provide a sample of the listings below:



- Ms Chala provides a screenshot from the website *collectorsquare.com* to show that there is a market for second-hand TAMBOUR watches, with a graph providing various quotations for these goods between 2004 and 2024. A sample of listings from second-

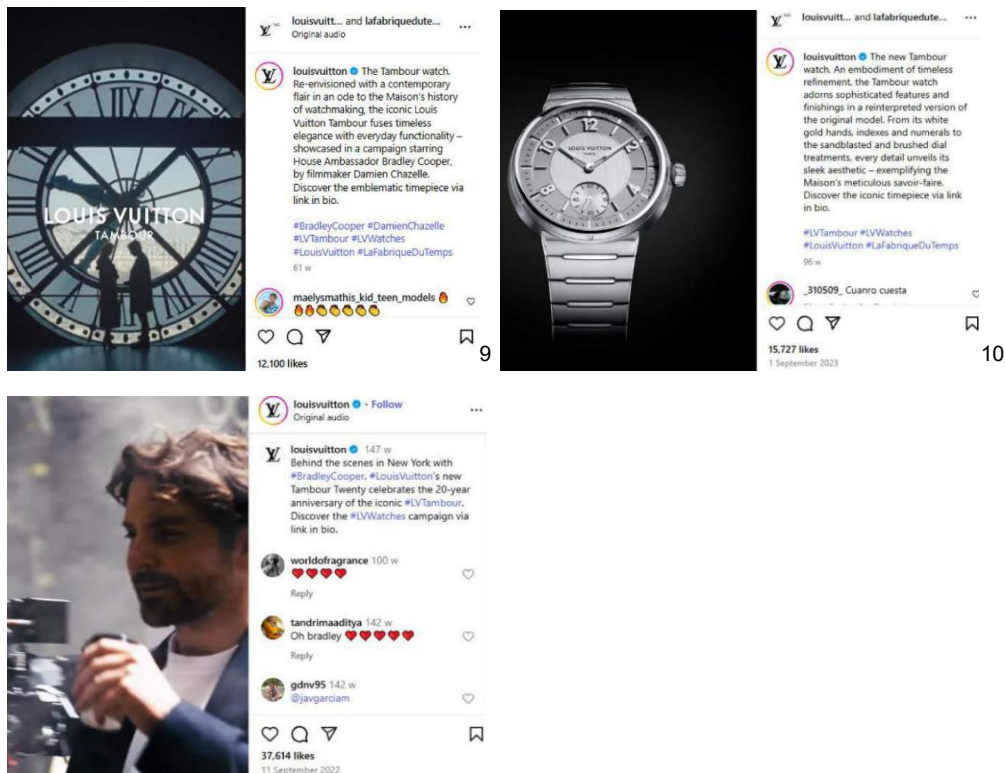
⁶ https://uk.louisvuitton.com/eng-gb/watches/watches-collections/tambour/_/N-t1jjeo3

hand websites www.watchcollectors.co.uk and www.vestiairecollective.com are also provided.

- Between July 2019 and July 2024⁷, “in excess of” 100 TAMBOUR watches were sold in the UK. Ms Chala’s statement indicates that the minimal sale price for a TAMBOUR (Automatic) watch since 2003 is £18,300.

- The opponent uses various social media platforms to promote goods available under the TAMBOUR mark. As at 9 July 2025, the opponent boasts over 56 million Instagram followers, over 5.4 million YouTube subscribers and over 9.7 million followers on X.

- Present day captures of the platforms being used to promote the opponent’s TAMBOUR goods are enclosed alongside examples taken from within the relevant period⁸. I provide a sample of the latter below:



- A number of the posts feature celebrities Sophie Turner and Bradley Cooper, with Mr Cooper having been announced as the opponent’s first dedicated watch

⁷ Whilst it would have been helpful to have an indication of precisely when the sales were made, I am willing to accept that at least the majority would have been placed during the relevant period.

⁸ Examples of Instagram posts are dated 15 June 2024, 5 May 2024, 1 September 2023, 13 July 2022 (Tambour Horizon Light Up Connected Watch), 23 & 25 April 2022 (Tambour Outdoor Chronograph GMT), 11 April 2022 & 15, 16, 17 April 2021 (Tambour Street Diver), 6 November 2021 (Tambour Carpe Diem), 9 November 2020 (Tambour Damier Graphite Race), 6 May 2024, 11 September 2022

⁹ Instagram “louisvuitton”, 5 May 2024

¹⁰ Instagram, 1 September 2023

ambassador in 2022.

- A number of screenshots from the opponent's YouTube platform ("Louis Vuitton") showcasing its TAMBOUR line are also provided, as listed here: "Bradley Cooper for the Tambour Watch", 1 September 2023¹¹; "Tambour Horizon Light Up Connected Watch Campaign", 14 January 2022¹², "Tambour Twenty Watch", 11 September 2022¹³; "The New Tambour Watch", 5 July 2023¹⁴.

- Posts from the opponent's X platform can be summarised as follows: A video clip featuring the Tambour Watch with a campaign starring Bradley Cooper, 1 September 2023¹⁵; A clip showcasing the latest Tambour, 2 September 2023¹⁶; A photograph of Bradley Cooper at the Academy Awards wearing a rose gold Tambour watch, 11 March 2024¹⁷; A photograph of Mr Cooper at the 14th Governors Awards in Los Angeles wearing a steel Tambour watch, 11 January 2024¹⁸; A further clip featuring the new Tambour watch, "Celebrating the Maison's next chapter in watchmaking", 8 July 2023¹⁹; Images of Hiroshi Tamaki wearing different Tambour models to celebrate its 20th anniversary, 11 October 2022²⁰; A video clip featuring an "unboxing" is captioned "Tambour watch or fragrance set, #LVGifts are guaranteed to delight your loved ones", 25 December 2019²¹; An image featuring the Tambour Moon Dual Time watch, 10 March 2020²².

- The opponent encloses various articles concerning the opponent's partnership with Bradley Cooper. I set out details of these articles in the table below:

¹¹ 141, 993 views

¹² 718,509 views

¹³ 18,089 views

¹⁴ 51,682 views

¹⁵ 134.9K views

¹⁶ 51.7K views

¹⁷ 49.3K views

¹⁸ 49.6K views

¹⁹ 123.7K views

²⁰ Number of views not provided

²¹ Number of views not provided

²² Number of views not provided

“Hold Up and Freeze, Bradley Cooper is Now Officially A Louis Vuitton Tambour Man” The partnership is described in the article as “<i>a match of icons</i>”. It claims that the launch of the opponent’s Tambour watches “<i>disrupted all the conventions of watchmaking design</i>”.	<i>Thehourmarkers.com,</i> 8 September 2022
“Bradley Cooper fronts campaign for 20th anniversary Louis Vuitton Tambour” The article explains that the new release is “<i>on sale at select Louis Vuitton boutiques priced at \$17,800</i>”.	<i>www.watchpro.com,</i> 7 September 2022
“Bradley Cooper Lands Role as Louis Vuitton’s Newest Ambassador – See His Debut Campaign” <i>“To kick things off, he stars in the campaign celebrating the 20th anniversary of the Tambour watch. ...The campaign features two different images of the Limitless actor, one closeup of his face and, of course, one of his wrist. ...In the video, Cooper is seen making his way through the streets of New York City, while keeping time on his Tambour watch.”</i>	<i>www.people.com,</i> 7 September 2022
“Bradley Cooper stars in new campaign for Louis Vuitton Tambour”	<i>www.somethingaboutrocks.com,</i> 22 August 2023

"Bradley Cooper's new watch flex has shocked the watch world" <i>"Alongside a host of other starry actors like Michael Fassbender, Cooper was in town to celebrate the launch of Louis Vuitton's new Tambour 2.0 watch."</i> The article questions <i>"Why is this launch so significant?"</i> and, in reply, provides a quotation from Jean Arnault, the opponent's watch director, claiming <i>"This is going to be the first step for us in repositioning Louis Vuitton as a super high-end brand in the watch segment overall."</i> It also sets out a brief history of the Tambour, as reproduced in the extract below: <i>"For the past 20 years or so... Louis Vuitton... has steadily but surely been climbing up the horological ladder, and the Tambour has represented the pillar of stability in which to rest its chops in the watch world. The model has won LV GPHG awards (the watch equivalent to one of Bradley Cooper's Oscars), and has helped Louis Vuitton build its watchmaking credentials, to the point where LV watches are respected by watch lovers, and not just viewed as an (sic) fashion brand dabbling with wristwear."</i>	www.gq-magazine.co.uk, 7 July 2023
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- To give context to two of the above articles, Ms Chala provides data generated by Semrush concerning UK activity to the GQ and People websites. The respective figures, covering the month of June 2025, show that GQ enjoyed visits from over 640,000 UK consumers and that People's site was viewed by over 7million UK

consumers.

- A still from a YouTube video posted on 1 September 2023 is headed “Bradley Cooper for the Tambour Watch” and has attracted 141,993 views. A video offering a behind-the-scenes look at Mr Cooper’s campaign is dated 2 September 2023 and attracted 33,347 views. A further behind the scenes account was posted on 10 September 2022, earning 27,312 views. All were uploaded via the opponent’s Louis Vuitton account.

- Screenshots of YouTube videos from third parties featuring the opponent’s TAMBOUR goods are also provided. A post from the account “Hodinkee” dated 5 July 2023 promoting “The New Louis Vuitton Tambour” earned 35,342 views; A video posted by Time+Tide Watches on 5 July 2023 is titled “New Louis Vuitton Tambour: delete the past and start again” and was viewed 29,997 views; A video featuring the Tambour Horizon Light Up Connected Watch was posted by Faiz Aly and boasts 67,921 views.

- I set out below details of press articles promoting various TAMBOUR products:

In a “wishlist” of the “24 best new luxury watches for men and women” published in The Times on 4 May 2024, the Louis Vuitton Tambour Street Diver (£5,700) sits at number one of the men’s options.

An article from GQ UK published on 14 January 2022 celebrates the features of the opponent’s Tambour Horizon Light Up model. Amongst various praises, the article states: “Can a wristwatch made by a true luxury brand also be smart/connected? If the answer is yes, it finds its best form to date in the Tambour Horizon Light Up.” Prices are said to start from £2,400.

An article dated 11 March 2023 from *somethingaboutrocks.com* focuses on the opponent’s launch of three new “high horology masterpieces”; the Tambour Opera Automata, the Tambour Fiery Heart Automata and the Tambour Moon Flying Tourbillon Poinçon de Geneve.

An article from *www.watchpro.com* in March 2020 celebrates the advanced materials and skills used in the 2020 Tambour Curve Flying Tourbillon, though the article notes that “Louis Vuitton watches fly under the radar in comparison to their LVMH stablemates of Bulgari, TAG Heuer, Hublot and Zenith because they do not typically sell into wholesale so consumers only see them in the maison’s own boutiques.”

In January 2022, *somethingaboutrocks* reviewed the latest Tambour smart watch, the Tambour Horizon Light Up, which uses a new operating system – “the first from a luxury house that’s fully compatible with an apple phone”.

An article from GQ Magazine’s UK website published in November 2024 is titled “Taylor Swift enters a new watch-wearing era”, with the celebrity being pictured attending an NFL match wearing the updated 18kt gold version of the Louis Vuitton Tambour. The article states that “this timepiece is banging the drum for a new generation of fashion watches”, with a price tag “just north of £50,000”.

An online article from The Jewellery Editor published in September 2019 announces “A hip new generation” of the Tambours, marked by the launch of its Damier Cobalt for men and New Wave model for women.

In January 2023, RapportLondon.com invited readers to “Get a Glimpse at the Louis Vuitton Tambour Book”, a collection of 200 pieces celebrating 20 years of the Tambour. It reads “The design of the original Tambour remains as captivating now as it did two decades ago”.

A comprehensive article from *Monochrome* offers an in-depth look at the details and features of the new Tambour model, with prices said to be EUR 19,500.

The Tambour’s design is discussed in an article from L’Officiel UK in June of 2023. *Somethingaboutrocks* writes about the return of the opponent’s comic book house mascot, Vivienne, in April 2022.

In Watch Pro²³, the opponent’s new integrated Tambour is said to mark its entry into the “sports luxe market”, with the new model described as its most “symbolically important timepiece ever” and Tambour as a brand “one of the most successful watch designs of the 21st century”. Prices are said to stand at EUR19,500.

An article from November 2023 published in *tempusmagazine.co.uk* celebrates the launch of the opponent’s Tambour in Gold, described as “a glittering expression of the iconic Tambour”. Readers are invited to shop online at *uk.louisvuitton.com*.

In November 2022, an article from MyWatch discusses the publication of the book “Louis Vuitton Tambour”, which it claims “delves into the genesis of the iconic Tambour watch”. The book’s author, Fabinne Reybaud, is said to chart the opponent’s “watchmaking adventure”. The price is recorded as EUR125, available

²³ 11 July 2023

in Louis Vuitton stores.

An article from Esquire (UK) published in September 2022 is titled “On Its 20th Birthday, Louis Vuitton’s Tambour Watch Gets a Makeover (and a Bit of Bradley Cooper)”. Part of the article reads “...though the old school industry hasn’t always seen eye-to-eye with the elite of the fashion world, the Tambour stands toe-to-toe with the greats”.

Revolution Watch announces the launch of a new “epic” Tambour in July 2023, “redesigned as a lugless, bezel-less, integrated bracelet sports chic watch”. The article speaks very highly of the new model, and the Tambour brand in wider terms. Of the redesign, the article states:

“Is this a big roll of the dice? Did the move take cojones the size of Mount Augustus to mess with the Tambour, the brand’s bestselling model? You bet. Because such is Louis Vuitton’s leadership position in the luxury world that if the new Tambour was in any way subpar, horologically naïve, uncomfortable on the wrist, and perhaps most of all, derivative in any way, it would have been a disaster. The number of self-anointed interweb evangelists sitting in their greasy underpants in their mothers’ basements ready to savage the Tambour would have numbered greater than the army of Persia’s Cyrus the Great. But they can’t. And even if they try, their feeble lamentations will soon dissipate like the winds over Vesuvius. Because the new Tambour is good. I mean really good.”

A review of the opponent’s new Tambour Steel watch is provided by Hodinkee in July 2023, celebrating its various features and discussing the differences between this and previously-launched models. The cost is said to be EUR19,000 at launch. Finally, an article from *Time and Tide Watches* describes the opponent’s launch of the Tambour Convergence as “a major leap as a watchmaker”, signifying the “latest and most potent example of the Maison’s watchmaking maturity”.²⁴

- Finally, at Exhibit KC10, Ms Chala highlights the industry recognition enjoyed by the opponent’s TAMBOUR brand by providing articles “evidencing awards and accolades”. Specifically, in 2021, the opponent’s Tambour Street Diver won the GPHG Diver’s Watch Prize and its Tambour Carpe Diem won the GPHG Audacity Prize. Though it is not entirely clear when, a further article shows that the opponent’s Tambour Curve Flying Tourbillon received The Poinçon de Geneve, which it explains was awarded by

²⁴ Appears to have been published in January 2025

an independent bureau in Geneva and is considered “the most prestigious certification of origin, beautiful craftsmanship and reliability”.

The holder’s evidence

9. The holder filed evidence in the form of a witness statement from its CEO, Hankook Kim, dated 13 October 2025, alongside two accompanying exhibits. The first exhibit is a list of all worldwide TAMBURINS trade mark applications and registrations owned by the holder. Some are word-only marks whilst others are figurative representations. The second exhibit concerns the holder’s existing UK registrations for variations of the TAMBURINS mark. Details of seven registrations are enclosed, with the marks registered for various goods and services across classes 3, 4, 9, 18, 25, 26 and 35.

10. That concludes my summary of the parties’ evidence, insofar as I consider it necessary.

Proof of use

11. Section 6A of the Act reads as follows:

“(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.”

12. Section 100 of the Act reads as follows:

“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.”

13. As the opponent’s mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

“(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.”

14. In *easyGroup Ltd v Nuclei Ltd & Ors*,²⁵ Arnold LJ summarised the law relating to genuine use as follows:

²⁵ [2023] EWCA Civ 1247

“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].

15. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”²⁶ because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

16. Section 6A of the Act (cited above) makes clear that the relevant period for the present assessment is the five-year period ending on the priority date of the holder’s mark, being 18 July 2024. The relevant period is, therefore, 19 July 2019 to 18 July 2024 (“the relevant period”).

17. I have summarised the opponent’s evidence above and do not intend to reproduce it to any great extent here. Whilst admittedly not substantiated by way of invoices or receipts (for example) as acknowledged by the holder in its submissions, the sales figures pertaining to the opponent’s TAMBOUR mark are provided within the body of its witness statement, which has been filed and signed as per the usual requirements. I have no reason to doubt their legitimacy. The figures show that the opponent sold over 100 of its TAMBOUR products in the UK between July 2019 and July 2024, with goods available for sale via its website, examples of which from the present day have been provided. I am satisfied that the present-day examples of the goods sold on its website are reflective of how the goods were advertised during the relevant period, as Ms Chala has attested. I also note that, in an article published in November 2023, readers were directed to the opponent’s UK website which indicates that the site was

²⁶ *Jumpman* BL O/222/16

at least active at this time. A wide range of articles celebrating the opponent's TAMBOUR products and the opponent's partnership with Bradley Cooper are enclosed. It is not clear that all of these are engineered toward consumers in the relevant territory but there are, for example, some publications which are clearly UK-based (The Times or GQ UK for example). The evidence shows several examples of the opponent's TAMBOUR goods being promoted via various social media platforms, amongst which the opponent boasts a significant number of subscribers. Still, I keep in mind that I do not have before me the position during the relevant period, nor are the numbers broken down in geographical terms. The opponent's goods have received a number of high profile accolades within the horological industry, not to mention consistent celebration and praise across a number of renowned publications. Again, it is not entirely clear whether the awards were determined by representatives from a relevant territory. I am, however, required to look at the evidence as a whole. Whilst, in terms of volume, 100 watches sold over a five-year period may appear very low, I keep in mind that the evidence shows the price per unit is relatively quite high, with the TAMBOUR Automatic model starting from £18,300, for example, and other models still costing thousands of pounds (GBP). Taking all of the above into account, whilst some of the evidence could certainly have benefitted from a greater degree of context or specificity, I am satisfied that the evidence shows that the earlier mark was put to use during the relevant period.

18. It now falls to me to determine for which goods use has been shown. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*²⁷, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification. He said:

“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

²⁷ [2017] EWCA Civ 1834

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.”

19. This approach was endorsed by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors*²⁸, subject to the proviso that it must be seen in light of more recent guidance by the Court of Justice of the European Union (“CJEU”) that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods and

²⁸ (Rev1) [2024] UKSC 36

services capable of being viewed independently is their purpose and intended use (for example, *Ferrari SpA v DU*²⁹).

20. Whilst the opponent has indicated that it wishes to rely upon a wider set of goods, to my mind the use of its TAMBOUR mark shown in evidence is limited to use in respect of watches only. The opponent may therefore rely solely on this term for the purpose of the present proceedings.

DECISION

Section 5(2)(b)

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

22. 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*³⁰:

(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

²⁹ Joined Cases C-720/18 and C-721/18

³⁰ [2025] UKSC 25

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

23. The competing goods are laid out at paragraphs 1 and 2 of this decision.

24. As for when goods (or services) can be considered identical, in *Gérard Meric v Office for Harmonisation in the Internal Market*,³¹ the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

25. Throughout my comparison of the goods, I will consider factors including their nature, intended purpose, method of use, user, trade channels and whether they are in competition or are complementary.³²

26. In *Kurt Hesse v OHIM*,³³ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*³⁴, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable

³¹ Case T- 133/05

³² *Canon*, Case C-39/97; *Treat*, [1996] R.P.C. 281

³³ Case C-50/15 P

³⁴ Case T-325/06

or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

27. For the purpose of a comparison it is permissible to group goods together, where appropriate³⁵.

Watches incorporating MP3 players; watches incorporating cameras

28. In accordance with the principle outlined in *Meric*, I find the above goods identical to the opponent's broader term, *watches*.

Shoe jewellery; jewellery made of precious metals; paste jewellery; necklaces; earrings; rings [jewellery]; jewellery; women's jewelry; charms for jewellery; chains [jewellery]; cuff links; bracelets [jewellery]; pendants [jewellery]

29. The above terms can broadly be described as items of jewellery. Whilst I accept that the opponent's *watches* naturally have an additional function (i.e. as a means to tell the time), the goods are also used as accessories which can adorn the body of the wearer and may be selected in part for aesthetic purposes, creating some degree of similarity in the goods' use. The goods are likely to be selected by the same consumers and in some circumstances they may share some physical characteristics (where made from the same materials, for example). In my experience, the goods will often be sold from the same outlets (i.e. a jewellers) and positioned for sale in some proximity. The goods are not, in my view, competitive and they are not complementary given that they are not indispensable, though the consumer may be inclined to believe that the goods originate from a shared or related undertaking. I find the similarity between the goods is fairly high.

Jewellery boxes; boxes of precious metal

³⁵ *Separode Trade Mark* BL O-399-10 (AP)

30. The aforementioned goods are used to store jewellery (and could also be used to store watches). The core use of the parties' goods is therefore distinct, though the users are likely to be the same. Other than a vague compatibility in sizing (for example), the goods' physical nature is not similar. Generally speaking, I find any overlap in the goods' trade channels will be limited. Whilst not indispensable, the goods may be used alongside one another (and in some circumstances possibly supplied together), but for the most part the respective undertakings will differ. Finally, I do not consider the goods to be competitive. Weighing all conclusions, I find the goods similar to a low degree.

Metal key rings; key rings [split rings with trinket or decorative fob]; charms for key chains

31. The above goods differ in their use to those relied upon though the users are likely to be shared, at least to the extent that both sets of goods will be purchased predominantly by members of the public. There may also in some circumstances be an overlap in the respective trade channels, where the goods are sold (for example) from a jewellers or department store, though they are not likely to be sold in any real proximity to one another. The goods' physical characteristics are mostly dissimilar, though I accept that the same or similar materials may be used. The goods are not competitive nor are they indispensable, though there may be an expectation that the undertaking responsible is the same or related. I find a low degree of similarity.

Precious metals; semi-wrought precious metals; semi-wrought precious stones and their imitations; statues of precious metal and their alloys

32. The goods listed above do not share a use with the opponent's *watches* and any similarity between the goods' respective users is at a general level only. The goods are not similar in their physical makeup though, again, I accept that goods such as metal may be used in the construction of the opponent's goods. In this regard I keep in mind that one good being a component of another does not, in itself, support a

finding of similarity³⁶. There may be some overlap in the goods' trade channels, whereby both goods are sold from a jewellers, for example. That said, even where they occupy the same retail environment, they are likely to be positioned for sale in separate areas. The goods are not competitive nor are they likely to be perceived as complementary. All things considered, I take the view that the goods are similar to a low degree.

Clocks

33. Given that both parties' goods are designed to record the time of day, the above goods clearly share a use with those relied upon. The goods will be selected by the same consumers and will inevitably share some physical characteristics to enable a shared function, though watches are traditionally worn on the user's wrist whereas clocks are displayed in a stationary position. There may be some broad coincidence in the goods' trade channels but generally they will be sold in separate areas if available from the same outlet. The goods are not competitive and, whilst generally speaking I find undertakings are likely to specialise in one or the other, there may be some undertakings which offer both goods simultaneously. On balance, I find the goods are similar to at least a medium degree.

[Clocks] and parts therefor; clock cases

34. The above goods are components of a clock and therefore have a different use to the opponent's watches, at least in immediate terms, though I keep in mind that such components will likely be similar to those which are used to create watches as both provide the same function. Generally, the users of the respective goods are likely to be distinct, with components of clocks likely to be selected predominantly by manufacturers, for example, whereas watches will mostly be selected by members of the public. That said, I accept there may be circumstances in which a member of the general public may purchase the holder's goods for an at-home repair, for example.

³⁶ *Les Éditions Albert René v OHIM*, Case T-336/03

The goods are unlikely to reach the market via the same trade channels and any coincidence in physical nature will be limited. The goods are not competitive and, to my mind, are not indispensable. That said, there may be an expectation on the consumer's part that the responsible undertakings are shared or related. I find a very low degree of similarity.

Coins

35. Whilst I acknowledge that the above goods may be used in some circumstances for decorative purposes, the goods' respective uses are quite distinct. The users may be the same, in the main, but there is little similarity in the goods' physical nature. Generally speaking, I find it unlikely that the goods will reach the market through the same trade channels and, if the goods were available from the same stores, for example, it seems unlikely that they would be positioned for sale in any meaningful proximity. The goods are not competitive and, in my view, are not complementary. Weighing all factors, I find the goods are not similar.

36. As some degree of similarity between the respective terms is necessary for a finding of confusion³⁷, the opposition falls at this juncture in respect of *coins*.

Comparison of marks

37. 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 Court of Justice of the European Union stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*,³⁸ that:

³⁷ See, for example, *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

³⁸ Case C-591/12P

“...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.”

38. It would be wrong, therefore, to dissect the trade marks artificially, 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.

39. The competing trade marks are laid out for ease in the table below:

Opponent's mark	Holder's mark
TAMBOUR	TAMBURINS

40. The opponent's mark comprises a single seven-letter word (TAMBOUR). The marks' overall impression therefore resides solely in the word itself.

41. The holder's mark is composed of a single component, the word TAMBURINS. Absent any further elements, the mark's overall impression is dominated solely by its word element.

42. Visually, the marks clearly begin with the same four-letter sequence, T-A-M-B. The marks also share a sequence in U-R but this is situated differently in each of the marks. The opponent's mark is seven letters in length, whilst the holder's mark is nine letters long. Keeping in mind that the beginnings of marks typically have a greater impact on the consumer than their endings, I find the marks' visual similarity is of at least a medium

degree.

43. I find it likely that the average consumer will verbalise the opponent's mark in two syllables, loosely TAM-BOR. The holder's mark is likely to comprise three syllables, loosely TAM-BUH-RINS. The beginnings of the respective marks are aurally identical and there is some percussive similarity in their remaining syllables, particularly on account of the marks' shared letter 'R'. Weighing all considerations, I find the marks' aural similarity is of at least a medium degree.

44. I turn now to consider the marks' conceptual position. On this point, the opponent contends as follows:

"In relation to the relevant goods, conceptually there is no comparison. Both TAMBOUR and TAMBURINS have no meaning in relation to jewellery, watches or clocks, therefore no conceptual comparison can be made in the context of the relevant goods.

However, outside of the relevant goods the word TAMBOUR can refer to a handheld drum, while TAMBURINS is phonetically identical and visually highly similar to the word tambourine, the name of a handheld drum with metal jingles. Therefore, it is submitted that outside of the context of the relevant goods, the conceptual significance of the opponent's mark and the contested mark and the contested mark is identical, both referring to types of drums."

45. The holder, in turn, submits as follows:

"31. The opponent's mark means a kind of drum or a circular frame for holding fabric taut while it is being embroidered. For the Opponent's goods, the mark has no meaning.

32. The applicant's mark is a fanciful word that has no meaning.

33. In view of the above, the marks are conceptually neutral.”

46. It is well-established that the marks’ conceptual impression must be judged from the perspective of the average consumer. In *Chorkee Ltd v Cherokee Inc.*³⁹, Ms Anna Carboni, as the Appointed Person, described the limits to which judicial notice can be used in order to find that the average consumer is aware of particular facts. She said:

“While the Applicant contended in its Counterstatement that the earlier marks would be recognised to refer to the Cherokee tribe and that the tribe was well known to the general public, no evidence was submitted to support this. By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one’s own personal experience, knowledge and assumptions are more widespread than they are.”

47. To the opponent’s point concerning the significance of the relevant goods when considering the mark’s conceptual impression, whilst conceptual comparisons are usually done without reference to the goods at issue, the consumer nonetheless looks to the goods to inform the meaning of the mark, particularly where there is a link between the conceptual meaning of the mark and the goods to which it is affixed⁴⁰. In the present case, however, I am not sure this is applicable. To my mind, regardless of whether or not the matter is viewed with reference to the relevant goods, the average consumer will not be familiar with the word “TAMBOUR”, perceiving it rather as an invented or foreign word, and consequently will not derive any concept from the same. I reach much the same conclusion in regard to the holder’s mark. I do acknowledge, as the opponent identifies, that the word is to some extent similar to ordinary word “tambourine” (the concept of which the average consumer would be entirely familiar with), however, I find it likely that this will simply be a fleeting association, if identified. The consumer will not take any concept from TAMBURINS on account of this similarity, rather, it will simply be

³⁹ Case BL O/048/08

⁴⁰ See *EMILIANA*, BL O/052/22 and *LIGHT VITAMIN*, BL O/1174/25

viewed as an invented or foreign word without a clear concept. On this basis, I find there is no conceptual comparison to be undertaken.

48. In the alternative, if the average consumer were to derive any concept from the holder's mark on account of its similarities with dictionary word 'tambourine', I find it just as likely that the earlier mark will be perceived in the same way. Both parties' marks comprise words which are in some way (or to some extent) similar to the word *tambourine*. My primary finding (as above) is that the consumer will not derive any concept from either mark but, if in fact they were to take away the concept of a 'tambourine', I find both marks sufficiently similar to the word itself that each will evoke this concept, giving rise to an identical meaning amongst the parties' marks.

Average consumer and the nature of the purchasing act

49. *Iconix Luxembourg Holdings*, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor*,⁴¹ where he pointed out that:

"16. First, the average consumer is both a legal construct and a normative benchmark. They are a legal construct in that consumers who are ill-informed or careless and consumers with specialised knowledge or who are excessively careful are excluded from consideration. They are a normative benchmark in that they provide a standard which enables the courts to strike a balance between the various competing interests involved, including the interests of trade mark owners, their competitors and customers.

17. Secondly, the average consumer is neither a single hypothetical person nor some form of mathematical average, nor does assessment from the perspective of the average consumer involve a statistical test. They represent consumers who have a spectrum of attributes such as gender, age, ethnicity and social

⁴¹ (Rev1) [2024] EWCA Civ 262

group. ... It follows that assessment from the perspective of the average consumer does not involve the imposition of a single meaning rule akin to that applied in defamation law (but not malicious falsehood). ... 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, then a finding of infringement may properly be made.

18. Thirdly, assessing from the perspective of the average consumer is designed 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. ...

19. Fourthly, the average consumer's level of attention varies according to the category of goods or services in question.

20. Fifthly, 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."

50. The average consumer of the goods at issue in the present proceedings is a member of the general public. The goods are likely to be self-selected from the shelves of a traditional retail establishment or an online equivalent, suggesting that the goods' visual impression is likely to carry the greatest weight. That said, as advice may be sought from retail representatives or peers, for example, I do not overlook the significance of the marks' aural impression. The purchase of the goods is likely to be fairly frequent, and the cost of the goods can vary fairly significantly, with the consumer alive to considerations such as quality and aesthetic impact when approaching its purchase. All factors considered, generally speaking I find the average consumer is likely to apply a medium degree of attention to its purchase.

Distinctive character of the earlier trade mark

51. In *Lloyd Schuhfabrik Meyer*⁴², 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).”

52. 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 descriptive or allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

53. Earlier in my decision, my primary finding was that the earlier mark was likely to be

⁴² *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*, Case C 342/97, EU:C:1999:323

perceived as an invented word which is absent of any clear concept. I do not therefore consider that the mark can be deemed in any way descriptive nor allusive when it comes to the relevant goods. Still, I keep in mind that the mark is a single word and not particularly elaborate. All things considered, I find that the earlier mark enjoys a fairly high degree of inherent distinctiveness.

54. For completeness, were the consumer to derive the concept of a ‘tambourine’ from the earlier mark (on account of the words’ similarity), the average consumer is still unlikely to find the mark descriptive or allusive when considered in respect of the relevant goods. Whilst there may be some vague similarity between the shape of a tambourine and a part of a watch, I find it highly unlikely that the consumer will make this connection. Taken alongside the fact that the word will still nonetheless be perceived as an invented word with which the consumer is unfamiliar, I find the mark will enjoy a fairly high degree of inherent distinctiveness in either scenario.

54. I have already assessed the opponent’s evidence and found it sufficient to demonstrate genuine use of the opponent’s mark in the five years preceding the relevant date in respect of *watches*. However, the burden for establishing enhanced distinctive character is a much heavier one, in that 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. For the purposes of enhanced distinctiveness, it is the perception of the UK consumer at the relevant date, that being the priority date of the contested mark, that is key. The opponent’s mark has been used throughout the UK since 2002. Between July 2019 and July 2024, over 100 TAMBOUR watches were sold in the UK. Whilst this figure may at first appear low, given the unit prices shown in evidence, this is not necessarily determinative. Contextually, however, I expect the size of the luxury watch market is fairly considerable. The opponent’s evidence also faces some degree of limitation insofar as not all of the evidence appears to relate solely to UK use. Whilst there are before me some examples of UK-based publications featuring the opponent’s goods (I note, for example, that the opponent’s TAMBOUR Street Diver was ranked number one of The Times’ wishlist for

men's new luxury watches in May 2024), I do not have readership figures by which to gauge engagement of UK consumers. Ms Chala has provided UK readership for publications GQ and People Magazine in June 2025 which, whilst helpful, does not show with any certainty how many UK readers have been exposed to the earlier mark in articles including those shown in evidence, which were published some years earlier. Similarly, the significance of the high number of subscribers to the opponent's respective social media platforms is limited as I do not have access to the figures as they stood at the relevant date, nor do I have means to determine the proportion amongst these of UK consumers specifically. Still, I accept the brand's association with celebrities such as Bradley Cooper and Sophie Turner is likely to have granted the TAMBOUR brand at least a certain degree of exposure, with public figures such as these followed by consumers across multiple territories, including the UK. As for its promotional investment, the opponent has not provided an indication of how much was invested financially to promote the earlier mark in the UK (or elsewhere) during the relevant period. With all that said, I am not satisfied that there is sufficient evidence tailored specifically to the brand's UK profile to show that the distinctiveness of the opponent's mark has been enhanced to a degree beyond its inherent position. Given that I have found the earlier mark enjoys a fairly high degree of inherent distinctiveness above, this is unlikely to have any material impact on the opponent's position.

Likelihood of confusion

55. In determining whether there is a likelihood of confusion, 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/or services, and vice versa. It is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion. Conversely, the less distinctive it is, the lower the likelihood of confusion.

56. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average

consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and the parties' goods and/or services down to the responsible undertakings being the same or related.

57. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,⁴³ where he 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

⁴³ Case BL O/375/10

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)".

58. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,⁴⁴ Arnold LJ approved Mr Purvis's formulation but added:

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

59. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions including the degree of similarity between the marks and the respective specifications, the nature of the purchasing process and the level of distinctiveness attributable to the earlier mark. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

60. I will begin by considering a likelihood of direct confusion. I have found the parties' marks are visually and aurally similar to at least a medium degree and my primary finding concerning the marks' concept is that neither will offer the consumer a clear conceptual hook which they will be able to recall on, for example, a re-purchase of the

⁴⁴ [2021] EWCA Civ 1207

relevant goods. Alternatively, I have found that both marks will evoke the same concept (i.e. a tambourine). In either case, the consumer has no means to distinguish between the marks. As already acknowledged, it is the beginnings of marks which typically have a greater impact on the consumer and, in the case of the present marks, their first four letters are identical (T-A-M-B). Coupled with my finding concerning the marks' conceptual impressions, I take the view that the consumer will be susceptible to the effects of imperfect recollection and consequently mistake one mark for the other. In other words, there will be direct confusion. I make this finding in respect of all applied-for goods where I have found there to be similarity, even where this is at a very low degree. The similarities in the parties' marks, and particularly where the identical sequence of letters is situated within the respective words, alongside a lack of tangible concept in either mark (or a shared concept amongst the marks) will give rise to confusion.

Conclusion

61. The opposition under section 5(2)(b) succeeds in respect of the following goods:

Watches incorporating MP3 players; shoe jewellery; earrings; statues of precious metal and their alloys; precious metals; boxes of precious metal; jewellery made of precious metals; paste jewelry; necklaces; semi-wrought precious metals; semi-wrought precious stones and their imitations; metal key rings; key rings [split rings with trinket or decorative fob]; charms for key chains; rings [jewelry]; jewellery; jewellery boxes; clocks and parts therefor; clock cases; women's jewelry; charms for jewellery; chains [jewellery]; watches incorporating cameras; cuff links; bracelets [jewelry]; pendants [jewelry].

Section 5(3)

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

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

63. As the earlier mark is a comparable mark, paragraph 10 of Part 1, Schedule 2A of the Act is also relevant. It reads as follows:

“(1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to-

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom includes the European Union.”

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

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

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

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

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

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

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

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

(h) Detriment to the reputation of the earlier mark is caused when goods or

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder 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*).

65. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are 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.

Reputation

66. In *General Motors*,⁴⁵ the CJEU held that:

⁴⁵ Case C-375/97

“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.”

67. For the reasons set out in my consideration of enhanced distinctiveness, I am unable to conclude that the opponent’s mark had a qualifying reputation in the UK at the relevant date.

68. I have considered whether the evidence is stronger in respect of use in the EU prior to completion date. However, there seems to be even less evidence directed toward EU territories, at least with any greater degree of certainty. There are articles citing the prices of the opponent’s goods in Euros, for example, but I cannot be sure that it shows consumer engagement with a member state (or states) and, furthermore, such articles were published after 2021. I do not have an indication of sales, turnover, market share nor promotional investment amongst EU consumers. The evidence faces the same issues as those highlighted above; there is very little I can rely upon to establish with

any certainty that the opponent's mark had a reputation in the EU prior to IP Completion Day.

Conclusion

69. The opponent's claim under section 5(3) is dismissed.

Section 5(4)(a)

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

"5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

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

71. In *Discount Outlet v Feel Good UK*⁴⁶, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of

⁴⁶ [2017] EWHC 1400 IPEC

deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

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

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

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

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

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

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the

claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

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

73. For the purpose of the present assessment, the relevant date is the priority date of the holder’s mark: 18 July 2024.⁴⁷

74. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd*⁴⁸ in the following terms:

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

75. For the purpose of assessing goodwill, it is the opponent’s custom generated in the UK that is relevant. In this regard, the evidence faces the same limitations or ambiguity as that which was identified earlier in my decision, particularly that there is not a great deal of evidence engineered toward the opponent’s trading activities within the UK

⁴⁷ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11

⁴⁸ [1901] AC 217 (HOL)

specifically. That being said, notwithstanding my earlier criticisms, on reflection of the evidence as a whole I am satisfied that it is sufficient to establish that the opponent had a modest (but protectable) goodwill in relation to *watches*, and that the sign relied upon was distinctive of that goodwill at the relevant date.

76. Whilst I accept that the test for misrepresentation is different from that for a likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it has been acknowledged that they are unlikely to produce different outcomes in practice⁴⁹. To the extent that customers are deceived into erroneously believing that the holder’s goods are those of the opponent, to my mind, damage via a diversion of sales is entirely foreseeable.

77. As for the goods which I have found dissimilar, although it is not necessary under section 5(4)(a) for the parties to operate in a common field of activity, the burden of establishing misrepresentation where this is not the case is a heavy one⁵⁰. Notwithstanding any perceived closeness between the remaining goods and those relied upon, I do not consider any goodwill made out by the opponent’s evidence sufficient to overcome the burden highlighted above. Whilst the circumstances may give rise to a “mere wondering”, this does not constitute deception⁵¹, and I find this is all it would amount to. That being so, I do not consider there to be misrepresentation when it comes to the dissimilar goods set out earlier in my decision. The section 5(4)(a) ground therefore does not advance the opponent’s position.

CONCLUSION

78. The opposition has succeeded, in part, in respect of the following goods for which, subject to any successful appeal, the IR will not be protected in the UK:

Watches incorporating MP3 players; shoe jewellery; earrings; statues of precious metal

⁴⁹ *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41

⁵⁰ *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)

⁵¹ *Phones 4U Ltd v Phone4U.co.uk Internet Ltd* [2007] RPC 5 at 16-17

and their alloys; precious metals; boxes of precious metal; jewellery made of precious metals; paste jewelry; necklaces; semi-wrought precious metals; semi-wrought precious stones and their imitations; metal key rings; key rings [split rings with trinket or decorative fob]; charms for key chains; rings [jewelry]; jewellery; jewellery boxes; clocks and parts therefor; clock cases; women's jewelry; charms for jewellery; chains [jewellery]; watches incorporating cameras; cuff links; bracelets [jewelry]; pendants [jewelry]. (Class 14)

79. The opposition has failed in respect of the following goods for which, subject to any successful appeal, the IR will be protected in the UK:

Coins (Class 14)

COSTS

80. Both parties have achieved a measure of success, with a greater share going to the opponent. The opponent is therefore entitled to a contribution towards its costs in accordance with the guidance set out in Annex A of Tribunal Practice Notice (“TPN”) 2/2023. In accordance with that TPN, and having kept in mind that its success was partial, I award the opponent costs as follows:

Preparing a Notice of Opposition:	£250
Considering the counterstatement and preparing evidence:	£650
Preparing written submissions in lieu of a hearing:	£300
Official fee:	£200
Total:	£1400

81. I hereby order IICombined Co., Ltd. to pay Louis Vuitton Malletier the sum of £1400. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of September 2026

Laura Stephens
For the Registrar