

O/0900/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3233043
BY DASAN LIMITED**

TO REGISTER:

Capri
Clothing

AS A TRADE MARK IN CLASSES 14, 25 AND 35

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 410390
BY IN.PRO.DI-INGHIRAMI PRODUZIONE DISTRIBUZIONE S.P.A.**

BACKGROUND AND PLEADINGS

1. On 23 May 2017, Dasan Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision (“the contested mark”) in the UK. The application was published for opposition purposes on 30 June 2017, and registration is sought for goods and services in Classes 14, 25, and 35.¹

2. On 29 September 2017, the application was opposed by IN.PRO.DI-Inghirami Produzione Distribuzione S.p.A. (“the opponent”), based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed at all the goods and services in the application. The opponent relies upon the following European Union Trade Marks (“EUTM”):

CAPRI

EUTM no. 013768197

Filing date: 24 February 2015; registration date: 31 May 2023

Relying upon all goods for which the mark is registered.²

(“the First Earlier Mark”)

CAPRI

EUTM no. 002689891

Filing date: 6 May 2002; registration date: 10 February 2004

Relying upon all goods for which the mark is registered, as set out in the Annex to this decision.

(“the Second Earlier Mark”)

3. The opponent claims that the marks are highly similar and that the goods and services covered by the marks are either identical or similar, resulting in a likelihood of confusion.

4. The trade marks upon which the opponent relies qualify as earlier trade marks under Section 6 of the Act by virtue of their earlier filing dates. However, only the Second

¹ See goods and services comparison.

² See goods and services comparison.

Earlier Mark had completed its registration process more than 5 years before the filing date of the contested application and is therefore subject to the proof of use conditions, as per Section 6A of the Act. As the First Earlier Mark had not completed its registration process more than 5 years before the application date of the mark in issue, it is not subject to proof of use pursuant to Section 6A of the Act. The opponent can therefore rely upon all of the goods identified.

5. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use of the Second Earlier Mark.

6. On 25 July 2018, following a case management conference (CMC), the opposition proceedings were suspended pending the outcome of opposition proceedings at the EUIPO against the First Earlier mark. On 6 March 2023, following a conclusion of proceedings at the EUIPO, opposition proceedings in the present case were resumed.

7. The applicant is represented by Stephens Scown LLP and the opponent is represented by J A Kemp LLP. Neither party requested a hearing. Only the opponent filed evidence. Neither party chose to file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers.

EVIDENCE

8. The opponent filed evidence in the form of the witness statement of Giovanni Inghirami, dated 16 April 2018, which is accompanied by 7 exhibits. Mr Inghirami is Chairman of the Board of Directors for the opponent. The evidence has been adduced to prove the use that has been made of the Second Earlier Mark. I shall refer to the evidence to the extent that I consider necessary.

RELEVANCE OF EU LAW

9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon

in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

10. EUTMs are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SI 2019 No. 269, Schedule 5. This is because the opposition proceedings were commenced before IP completion day.

DECISION

My Approach

11. Whilst the First and Second Earlier Marks both comprise the word 'CAPRI', the Second Earlier Mark is presented in a stylised format, whereas the First Earlier Mark is presented in word only format. In addition, the specification of the First Earlier Mark is much broader than that of the Second Earlier Mark. Further, the First Earlier Mark is not subject to proof of use, whereas the Second Earlier Mark is. Consequently, as the First Earlier Mark is a word only mark and has a broader specification, I will conduct my assessment on the basis of this mark in the first instance, returning to the Second Earlier Mark only if it is necessary to do so.

Section 5(2)(b)

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

“A trade mark shall not be registered if because—

(a)...

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

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

13. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b) the matter must be judged through the eyes of the average consumer of the goods or services in question. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;
- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing

in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

i) mere association, in the strict sense that the later mark brings 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

15. The competing goods and services are as follows:

Applicant's goods and services

Class 14 Ankle bracelets; articles of jewellery; bands for watches; bangles; bracelets; brooches [jewellery]; chains [jewellery]; charms [jewellery]; choker necklaces; costume jewellery; cuff links; dress watches; drop earrings; ear studs; earrings; enamelled jewellery; fashion jewellery; finger rings; hoop earrings; imitation jewellery; jewel cases; jewellery boxes; lockets; necklaces; pendants; rings [jewellery]; synthetic stones [jewellery]; watches.

Class 25 Clothing; jerseys; sleeveless jerseys; tunics; tops; chemise tops; turtleneck tops; vest tops; hooded tops; halter tops; coats; coats for women; coats made of cotton; dinner jackets; evening coats; frock coats; jackets [clothing]; long jackets; anoraks; beach clothing; beachwear; blouses; caftans; cagoules; camisoles; capes; cardigans; casual shirts; casualwear; bobble hats; berets; beanies; beach footwear; beach clothes; beach shoes; belts [clothing]; bed socks; body warmers; boleros; boots; casual footwear; dresses; dresses for evening wear; dressing gowns; dungarees; ear muffs [clothing]; earbands; espadrilles; evening wear; flat shoes; flip-flops; footwear; footwear for women; formalwear; gilets; gloves; head bands; head scarves; heels; high-heeled shoes; hooded pullovers; hooded sweatshirts; hooded tops; hosiery; jump suits; jumper dresses; jumpers; jumpsuits; knitted clothing; lace boots; ladies' boots; ladies' clothing; ladies' dresses; ladies' footwear; ladies' outerclothing; leg warmers; leisure clothing; leisure footwear; leisure shoes; linen clothing; lingerie; long sleeve pullovers; long-sleeved shirts; loungewear; mittens; night gowns; nightdresses; nightshirts; nightwear; outerclothing; parkas; pinafore dresses; pinafores; plimsolls; pyjamas; rain coats; rain ponchos; rain wear; roll necks [clothing]; sandals and beach shoes; scarves; shift dresses; shirts; shoes; shoes for casual wear; short-sleeve shirts; short-sleeved or long-sleeved t-shirts; sleepwear; sleeved jackets; sleeveless jackets; slippers; sneakers; socks; stockings; suits; sundresses; sun hats; sun visors; swimming costumes; swimming suits; swimsuits; swimwear; t-shirts; under garments; underclothes; underclothing for women; underwear for women; vest tops; v-neck sweaters; vests; waistcoats; wellington boots; women's shoes; woolen clothing; wraps [clothing]; not including capri pants or trousers, or sets containing the same.

Class 35 Wholesale services in relation to ankle bracelets, articles of jewellery, bands for watches, bangles, bracelets, brooches [jewellery], chains [jewellery], charms [jewellery], choker necklaces, costume jewellery, cuff links, dress watches, drop earrings, ear studs, earrings, enamelled jewellery, fashion jewellery, finger rings, hoop earrings, imitation jewellery, jewel cases, jewellery boxes, lockets, necklaces, pendants, rings [jewellery], synthetic stones [jewellery], watches, clothing, jerseys, sleeveless jerseys, tunics, tops, chemise tops, turtleneck tops, vest tops, hooded tops, halter tops, coats, coats for women, coats made of cotton, dinner jackets, evening coats, frock coats, jackets [clothing], long jackets, anoraks, beach clothing, beachwear, blouses, caftans, cagoules, camisoles, capes, cardigans, casual shirts, casualwear, bobble hats, berets, beanies, beach footwear, beach clothes, beach shoes, belts [clothing], bed socks, body warmers, boleros, boots, casual footwear, dresses, dresses for evening wear, dressing gowns, dungarees, ear muffs [clothing], earbands, espadrilles, evening wear, flat shoes, flip-flops, footwear, footwear for women, formalwear, gilets, gloves, head bands, head scarves, heels, high-heeled shoes, hooded pullovers, hooded sweatshirts, hooded tops, hosiery, jump suits, jumper dresses, jumpers, jumpsuits, knitted clothing, lace boots, ladies' boots, ladies' clothing, ladies' dresses, ladies' footwear, ladies' outerclothing, leg warmers, leisure clothing, leisure footwear, leisure shoes, linen clothing, lingerie, long sleeve pullovers, long-sleeved shirts, loungewear, mittens, night gowns, nightdresses, nightshirts, nightwear, outerclothing, parkas, pinafore dresses, pinafores, plimsolls, pyjamas, rain coats, rain ponchos, rain wear, roll necks [clothing], sandals and beach shoes, scarves, shift dresses, shirts, shoes, shoes for casual wear, short-sleeve shirts, short-sleeved or long-sleeved t-shirts, sleepwear, sleeved jackets, sleeveless jackets, slippers, sneakers, socks, stockings, suits, sundresses, sun hats, sun visors, swimming costumes, swimming suits, swimsuits, swimwear, t-shirts, under garments, underclothes, underclothing for women, underwear for women, vest tops, v-neck sweaters, vests, waistcoats, wellington boots, women's shoes, woolen clothing, wraps [clothing], not including capri pants or trousers, or sets containing the same; retail services in relation to ankle bracelets, articles of jewellery, bands for watches, bangles, bracelets, brooches [jewellery], chains [jewellery], charms [jewellery], choker necklaces, costume jewellery, cuff links, dress watches, drop earrings, ear studs, earrings, enamelled jewellery, fashion jewellery, finger rings, hoop earrings, imitation jewellery, jewel cases, jewellery boxes, lockets, necklaces, pendants, rings [jewellery],

synthetic stones [jewellery], watches, clothing, jerseys, sleeveless jerseys, tunics, tops, chemise tops, turtleneck tops, vest tops, hooded tops, halter tops, coats, coats for women, coats made of cotton, dinner jackets, evening coats, frock coats, jackets [clothing], long jackets, anoraks, beach clothing, beachwear, blouses, caftans, cagoules, camisoles, capes, cardigans, casual shirts, casualwear, bobble hats, berets, beanies, beach footwear, beach clothes, beach shoes, belts [clothing], bed socks, body warmers, boleros, boots, casual footwear, dresses, dresses for evening wear, dressing gowns, dungarees, ear muffs [clothing], earbands, espadrilles, evening wear, flat shoes, flip-flops, footwear, footwear for women, formalwear, gilets, gloves, head bands, head scarves, heels, high-heeled shoes, hooded pullovers, hooded sweatshirts, hooded tops, hosiery, jump suits, jumper dresses, jumpers, jumpsuits, knitted clothing, lace boots, ladies' boots, ladies' clothing, ladies' dresses, ladies' footwear, ladies' outerclothing, leg warmers, leisure clothing, leisure footwear, leisure shoes, linen clothing, lingerie, long sleeve pullovers, long-sleeved shirts, loungewear, mittens, night gowns, nightdresses, nightshirts, nightwear, outerclothing, parkas, pinafore dresses, pinafores, plimsolls, pyjamas, rain coats, rain ponchos, rain wear, roll necks [clothing], sandals and beach shoes, scarves, shift dresses, shirts, shoes, shoes for casual wear, short-sleeve shirts, short-sleeved or long-sleeved t-shirts, sleepwear, sleeved jackets, sleeveless jackets, slippers, sneakers, socks, stockings, suits, sundresses, sun hats, sun visors, swimming costumes, swimming suits, swimsuits, swimwear, t-shirts, under garments, underclothes, underclothing for women, underwear for women, vest tops, v-neck sweaters, vests, waistcoats, wellington boots, women's shoes, woolen clothing, wraps [clothing], not including capri pants or trousers, or sets containing the same; advertising; advertising and publicity; advertising services relating to clothing; online retail store services in relation to clothing, not including capri pants or trousers, or sets containing the same; online advertisements; business organisation; business promotion; business management; business administration; marketing; fashion show exhibitions for commercial purposes.

Opponent's goods

Class 3 Perfumery; Cosmetics; Aftershave; Soaps; Hand soaps; Perfumed soaps; Bath foam; Cosmetic masks; Depilatories; Creams (Cosmetic -); Shampoo;

Hair lotions; Make-up; Eyebrow pencils; Eyebrow pencils; Mascara; Lip liners; Lipstick; Nail polish; Make-up removing preparations; Face powder; Rouges; Make up foundations; Perfumery; Essential oils; Hair dyes; Hair spray; Dentifrices; Deodorant for personal use; Moisturizers.

Class 9 Eyeglasses; Sunglasses; Optical glasses; Aesthetic spectacles; Goggles; Masks and Glasses for sporting activities; Spectacle supports; Spectacle chains; Sunglasses; Aesthetic spectacles; Contact lenses; Magnifying glasses [optics]; Telescopes; Protective helmets for sporting activities; Suits and gloves for protection against accidents during sporting activities; Lenses and frames for spectacles and masks; Cases and holders for spectacles and masks.

Class 18 Leather and imitations of leather; Curried skins; Animal skins, hides; Trunks and travelling bags; Umbrellas and parasols; Walking sticks; Umbrella rings; Key bags; Alpenstocks; Umbrella sticks; Vanity cases, not fitted; Trunks [luggage]; Baggage; Casual bags; Sling bags for carrying infants; Gym bags; Chain mesh purses; Tool bags of leather, empty; Baggage; Hand bags; Travelling sets [leatherware]; Briefcases; Satchels; Leatherboard; Cases, of leather or leatherboard; Collars for animals; Coverings of skins [furs]; Laces (Leather -); Leather, unworked or semi-worked; Leather thread; Moleskin [imitation of leather]; Umbrella covers; Casings, of leather, for springs; Saddle cloths for horses; Trimmings of leather for furniture; Leather leashes; Imitation leather; Walking stick handles; Umbrella handles; Suitcase handles; Sling bags for carrying infants; Sling bags for carrying infants; Cat o' nine tails; Chin straps, of leather; Muzzles; Parasols; Umbrellas; Hides; Curried skins; Skins of chamois, other than for cleaning purposes; Hides; Rubber parts for stirrups; Card cases [notecases]; Music cases; Baggage; Net bags for shopping; Furniture coverings of leather; Haversacks; Envelopes, of leather, for packaging; Bags for campers; Beach bags; Baggage; Bags for climbers; Shopping bags; Wheeled shopping bags; Cases, of leather or leatherboard; Boxes of vulcanised fibre; Hat boxes of leather; Butts [parts of hides]; Walking stick seats; Umbrella or parasol ribs; Frames for umbrellas or parasols; Handbag frames; Baggage; Baggage; Briefcases; Garment bags for travel; Rucksacks.

Class 25 Headgear; Motorists' clothing; Cyclists' clothing; Clothing for gymnastics; Non-slipping devices for footwear; Bandanas [neckerchiefs]; Bibs, not of paper; Caps [headwear]; Berets; Underwear; Sweat-absorbent underwear; Smocks; Boas [necklets]; Garters; Corsets; Skull caps Jodhpurs; Short-sleeve shirts; Shirts; Jackets (Stuff -) [clothing]; Bodices [lingerie]; Headgear; Top hats; Hats (Paper -) [clothing]; Jackets; Frames (Hat -) [skeletons]; Belts [clothing]; Belts (Money -) [clothing]; Shoulder wraps; Detachable collars; Camisoles; Headgear; Neck scarfs [mufflers]; Ear muffs (clothing); Layettes [clothing]; Corsets; Suits; Beachwear; Masquerade costumes; Ties; Ascots; Swimming caps; Shower caps; Headbands [clothing]; Pocket squares; Scarves; Fittings of metal for footwear; Linings (Ready-made -) [parts of clothing]; Gabardines [clothing]; Gaiters; Jackets [clothing]; Fishing vests; Garters; Skirts; Pinafore dresses; Girdles; Gloves; Mittens; Ski gloves; Welts for footwear; Mackintoshes; Ready-to-wear clothing; Paper clothing; Liveries; Singlets; Hosiery; Swimsuits; Pullovers; Muffs [clothing]; Maniples; Pelerines; Mantillas; Skorts; Miters [hats]; Boxer shorts; Bathing drawers; Waistcoats; Babies' pants [clothing]; Pants (Am); Parkas; Pelisses; Short yokes; Chasubles; Cuffs; Ponchos; Pullovers; Tips for footwear; Garters; Sock suspenders; Brassieres; Heelpieces for footwear; Heelpieces for stockings; Saris; Sarongs; Shawls; Sashes for wear; Pants (Am); Wimples; Topcoats; Outerclotthing; Dress shields; Trouser straps; Petticoats; Slips [undergarments]; Shirt fronts; Fur stoles; Soles for footwear; Soles for footwear; Heelpieces for footwear; Pockets for clothing; Tee-shirts; Togas; Footwear uppers; Footwear uppers; Turbans; Wetsuits for water-skiing; Combinations [clothing]; Uniforms; Veils [clothing]; Visors [headwear].

16. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

other or are complementary.”

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

18. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

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

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

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

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

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

21. Whilst on the other hand:

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

Class 14 of the contested application

Ankle bracelets; articles of jewellery; bands for watches; bangles; bracelets; brooches [jewellery]; chains [jewellery]; charms [jewellery]; choker necklaces; costume jewellery; cuff links; dress watches; drop earrings; ear studs; earrings; enamelled jewellery; fashion jewellery; finger rings; hoop earrings; imitation jewellery; jewel cases; jewellery

boxes; lockets; necklaces; pendants; rings [jewellery]; synthetic stones [jewellery]; watches.

22. The above contested goods can broadly be grouped into three categories, namely, (i) jewellery and cufflinks; (ii) watches and bands for watches; (iii) jewellery cases and boxes. I find that these goods and the goods contained in Classes 3, 9, 18 and 25 of the First Earlier Mark differ in their nature, intended purpose, methods of use and distribution channels. Moreover, there is nothing that enables them to be regarded as in competition with each other or functionally complementary. Whilst the goods may overlap on a superficial level in user because they will all be used by members of the general public, this is not sufficient on its own for a finding of similarity. Though I accept that there are some well-known brands that sell, for example, jewellery as well as perfume, sunglasses, bags and clothing, etc., these goods are likely to be sold in different shops, or in different parts of larger shops, such as department stores.³ Accordingly, I find the above contested goods are dissimilar to all of the opponent's goods contained in the specification of the First Earlier Mark.

Class 25 of the contested application

Clothing; jerseys; sleeveless jerseys; tunics; tops; chemise tops; turtleneck tops; vest tops; hooded tops; halter tops; coats; coats for women; coats made of cotton; dinner jackets; evening coats; frock coats; jackets [clothing]; long jackets; anoraks; beach clothing; beachwear; blouses; caftans; cagoules; camisoles; capes; cardigans; casual shirts; casualwear; bobble hats; berets; beanies; beach clothes; belts [clothing]; bed socks; body warmers; boleros; dresses; dresses for evening wear; dressing gowns; dungarees; ear muffs [clothing]; earbands; evening wear; formalwear; gilets; gloves; head bands; head scarves; hooded pullovers; hooded sweatshirts; hooded tops; hosiery; jump suits; jumper dresses; jumpers; jumpsuits; knitted clothing; ladies' clothing; ladies' dresses; ladies' outerclothing; leg warmers; leisure clothing; linen clothing; lingerie; long sleeve pullovers; long-sleeved shirts; loungewear; mittens; night gowns; nightdresses; nightshirts; nightwear; outerclothing; parkas; pinafore dresses; pinafores; pyjamas; rain coats; rain ponchos; rain wear; roll necks [clothing]; scarves;

³ *Compagnie des montres Longines, Francillon SA v OHIM*, Case T-505/12

shift dresses; shirts; short-sleeve shirts; short-sleeved or long-sleeved t-shirts; sleepwear; sleeved jackets; sleeveless jackets; socks; stockings; suits; sundresses; sun hats; sun visors; swimming costumes; swimming suits; swimsuits; swimwear; t-shirts; under garments; underclothes; underclothing for women; underwear for women; vest tops; v-neck sweaters; vests; waistcoats; woolen clothing; wraps [clothing]; not including capri pants or trousers, or sets containing the same

23. The majority of the above contested goods are either directly replicated in the opponent's Class 25 goods contained in the specification of the First Earlier Mark, or they fall within the wide terms *ready-to-wear clothing / outerclothing / headgear / underwear* contained therein. Therefore, the competing goods are identical, either because they are identically, or near-identically worded, or are identical, in accordance with the *Meric* principle.

24. For the avoidance of doubt, I do not consider the limitation to the applicant's specification (*not including capri pants or trousers, or sets containing the same*) to be relevant to my comparison of the parties' goods.

Beach footwear; beach shoes; boots; casual footwear; espadrilles; flat shoes; flip-flops; footwear; footwear for women; heels; high-heeled shoes; lace boots; ladies' boots; ladies' footwear; leisure footwear; leisure shoes; plimsolls sandals and beach shoes; shoes; shoes for casual wear; slippers; sneakers; wellington boots; women's shoes

25. In respect of the above contested *footwear* goods, it is noted that the opponent's Class 25 goods contained in the specification of the First Earlier Mark does not contain *footwear*, however it does contain *ready-to-wear clothing*. *Clothing* has some similarity of purpose to *footwear*, given that they are worn to cover parts of the body, though *footwear* is specifically for the feet as opposed to the rest of the body. These goods strike me as liable to be sold in the same shops, likely reasonably close to each other in retail premises and there may be a complementary relationship, as they may be worn together and produced by the same undertaking. Accordingly, I find a medium degree of similarity between these goods.

Class 35 of the contested application

26. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

Wholesale services in relation to clothing, jerseys, sleeveless jerseys, tunics, tops, chemise tops, turtleneck tops, vest tops, hooded tops, halter tops, coats, coats for women, coats made of cotton, dinner jackets, evening coats, frock coats, jackets [clothing], long jackets, anoraks, beach clothing, beachwear, blouses, caftans, cagoules, camisoles, capes, cardigans, casual shirts, casualwear, bobble hats, berets, beanies, beach clothes, belts [clothing], bed socks, body warmers, boleros, dresses, dresses for evening wear, dressing gowns, dungarees, ear muffs [clothing], earbands, evening wear, formalwear, gilets, gloves, head bands, head scarves, hooded pullovers, hooded sweatshirts, hooded tops, hosiery, jump suits, jumper dresses, jumpers, jumpsuits, knitted clothing, ladies' clothing, ladies' dresses, ladies' outerclothing, leg warmers, leisure clothing, linen clothing, lingerie, long sleeve pullovers, long-sleeved shirts, loungewear, mittens, night gowns, nightdresses, nightshirts, nightwear, outerclothing, parkas, pinafore dresses, pinafores, pyjamas, rain coats, rain ponchos, rain wear, roll necks [clothing], scarves, shift dresses, shirts, short-sleeve shirts, short-sleeved or long-sleeved t-shirts, sleepwear, sleeved jackets, sleeveless jackets, sneakers, socks, stockings, suits, sundresses, sun hats, sun visors, swimming costumes, swimming suits, swimsuits, swimwear, t-shirts, under garments, underclothes, underclothing for women, underwear for women, vest tops, v-neck sweaters, vests, waistcoats, woolen clothing, wraps [clothing], not including capri pants or trousers, or sets containing the same; retail services in relation to clothing, jerseys, sleeveless jerseys, tunics, tops, chemise tops, turtleneck tops, vest tops, hooded tops, halter tops, coats, coats for women, coats made of cotton, dinner jackets, evening coats, frock coats, jackets [clothing], long jackets, anoraks, beach clothing, beachwear, blouses, caftans, cagoules, camisoles, capes, cardigans, casual shirts, casualwear, bobble hats, berets, beanies, beach clothes, belts [clothing], bed socks, body warmers, boleros, dresses, dresses for evening wear, dressing gowns, dungarees, ear muffs [clothing], earbands, evening wear, formalwear, gilets, gloves,

head bands, head scarves, hooded pullovers, hooded sweatshirts, hooded tops, hosiery, jump suits, jumper dresses, jumpers, jumpsuits, knitted clothing, ladies' clothing, ladies' dresses, ladies' outerclothing, leg warmers, leisure clothing, linen clothing, lingerie, long sleeve pullovers, long-sleeved shirts, loungewear, mittens, night gowns, nightdresses, nightshirts, nightwear, outerclothing, parkas, pinafore dresses, pinafores, pyjamas, rain coats, rain ponchos, rain wear, roll necks [clothing], scarves, shift dresses, shirts, short-sleeve shirts, short-sleeved or long-sleeved t-shirts, sleepwear, sleeved jackets, sleeveless jackets, sneakers, socks, stockings, suits, sundresses, sun hats, sun visors, swimming costumes, swimming suits, swimsuits, swimwear, t-shirts, under garments, underclothes, underclothing for women, underwear for women, vest tops, v-neck sweaters, vests, waistcoats, woolen clothing, wraps [clothing], not including capri pants or trousers, or sets containing the same; online retail store services in relation to clothing, not including capri pants or trousers, or sets containing the same.

27. The contested services are those that enable consumers to view and purchase goods, namely various *clothing and headgear* products. As such, these services concern goods that are either directly replicated in Class 25 of the First Earlier Mark, or they fall within the wide terms *ready-to-wear clothing / outerclothing / headgear / underwear*, contained therein. Taking into account the guidance outlined above in *Oakley*, whilst the nature, purpose and method of use of these goods and services are not the same, I find that they are similar to a degree, because they are complementary, and the services are generally offered in the same places where the goods are offered for sale. Furthermore, they target the same public. Accordingly, I find that the contested services are similar to at least a low degree to the opponent's Class 25 services contained in the First Earlier Mark.

28. For the avoidance of doubt, I do not consider the limitation to the applicant's specification (*not including capri pants or trousers, or sets containing the same*) to be relevant to my comparison of the parties' goods.

Wholesale services in relation to beach footwear, beach shoes, boots, casual footwear, espadrilles, flat shoes, flip-flops, footwear, footwear for women, heels, high-heeled shoes, lace boots, ladies' boots, ladies' footwear, leisure footwear, leisure

shoes, plimsolls, sandals and beach shoes, shoes, shoes for casual wear, slippers, sneakers, wellington boots, women's shoes; retail services in relation to beach footwear, beach shoes, boots, casual footwear, espadrilles, flat shoes, flip-flops, footwear, footwear for women, high-heeled shoes, lace boots, ladies' boots ladies' footwear, leisure footwear, leisure shoes, plimsolls, sandals and beach shoes, shoes, shoes for casual wear, slippers, sneakers, wellington boots, women's shoes

29. The contested services directly relate to the wholesale and retail of *footwear*. Therefore, these services relate to goods not replicated in Class 25 of the First Earlier Mark, nor do I find that *footwear* is included in the broad term *ready-to-wear clothing* present in the First Earlier Mark. Whilst I acknowledge that there may be some overlap in channels of trade, this is not sufficient on the basis that there must be some similarity between the goods and services to find a likelihood of confusion. Furthermore, I bear in mind that Class 25 of the First Earlier Mark includes various footwear components, such as *welts for footwear* and *tips for footwear*, etc., however, the nature, purpose and method of use of these goods and the contested services are not the same, nor do I find them complementary. As such, as the specification of goods contained in the First Earlier Mark does not contain *footwear*, I cannot see how the opponent's registration should extend to retail and wholesale services connected with *footwear*. Accordingly, I find the above contested services dissimilar to all of the opponent's goods contained in the First Earlier Mark.

Wholesale services in relation to ankle bracelets, articles of jewellery, bands for watches, bangles, bracelets, brooches [jewellery], chains [jewellery], charms [jewellery], choker necklaces, costume jewellery, cuff links, dress watches, drop earrings, ear studs, earrings, enamelled jewellery, fashion jewellery, finger rings, hoop earrings, imitation jewellery, jewel cases, jewellery boxes, locket, necklaces, pendants, rings [jewellery], synthetic stones [jewellery], watches; retail services in relation to ankle bracelets, articles of jewellery, bands for watches, bangles, bracelets, brooches [jewellery], chains [jewellery], charms [jewellery], choker necklaces, costume jewellery, cuff links, dress watches, drop earrings, ear studs, earrings, enamelled jewellery, fashion jewellery, finger rings, hoop earrings, imitation jewellery, jewel

cases, jewellery boxes, lockets, necklaces, pendants, rings [jewellery], synthetic stones [jewellery], watches

30. I have considered all of the goods contained in the specification of the First Earlier Mark in relation to the above contested services and find no similarity. The uses, users and purpose are not the same and whilst there may be some overlap in the channels of trade this is not sufficient on the basis that there must be some similarity between the goods and services to find a likelihood of confusion. Accordingly, I find the above contested services dissimilar to all of the opponent's goods contained in the First Earlier Mark.

Advertising; advertising and publicity; advertising services relating to clothing; online advertisements; marketing; fashion show exhibitions for commercial purposes; business organisation; business promotion; business management; business administration

31. I find that the respective nature, methods of use and intended purpose of the competing goods and services at issue are different. It is not obvious to me that there would be any convergence of trade channels. The goods and services at issue are not in competition with each other, nor are they complementary. Moreover, they do not coincide in producers or distribution channels. Therefore, the contested services are dissimilar to all the goods contained in the First Earlier Mark.

Summary

32. Where there is no similarity between the goods and services, there can be no likelihood of confusion under section 5(2)(b) of the Act: see *eSure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA at paragraph [49]. The opposition therefore fails in respect of the following goods and services:

Class 14 Ankle bracelets; articles of jewellery; bands for watches; bangles; bracelets; brooches [jewellery]; chains [jewellery]; charms [jewellery]; choker necklaces; costume jewellery; cuff links; dress watches; drop earrings; ear studs; earrings; enamelled jewellery; fashion jewellery; finger rings; hoop earrings; imitation

jewellery; jewel cases; jewellery boxes; lockets; necklaces; pendants; rings [jewellery]; synthetic stones [jewellery]; watches.

Class 35 Wholesale services in relation to ankle bracelets, articles of jewellery, bands for watches, bangles, bracelets, brooches [jewellery], chains [jewellery], charms [jewellery], choker necklaces, costume jewellery, cuff links, dress watches, drop earrings, ear studs, earrings, enamelled jewellery, fashion jewellery, finger rings, hoop earrings, imitation jewellery, jewel cases, jewellery boxes, lockets, necklaces, pendants, rings [jewellery], synthetic stones [jewellery], watches; retail services in relation to ankle bracelets, articles of jewellery, bands for watches, bangles, bracelets, brooches [jewellery], chains [jewellery], charms [jewellery], choker necklaces, costume jewellery, cuff links, dress watches, drop earrings, ear studs, earrings, enamelled jewellery, fashion jewellery, finger rings, hoop earrings, imitation jewellery, jewel cases, jewellery boxes, lockets, necklaces, pendants, rings [jewellery], synthetic stones [jewellery], watches; Wholesale services in relation to beach footwear, beach shoes, boots, casual footwear, espadrilles, flat shoes, flip-flops, footwear, footwear for women, heels, high-heeled shoes, lace boots, ladies' boots, ladies' footwear, leisure footwear, leisure shoes, plimsolls, sandals and beach shoes, shoes, shoes for casual wear, slippers, sneakers, wellington boots, women's shoes; retail services in relation to beach footwear, beach shoes, boots, casual footwear, espadrilles, flat shoes, flip-flops, footwear, footwear for women, heels, high-heeled shoes, lace boots, ladies' boots ladies' footwear, leisure footwear, leisure shoes, plimsolls, sandals and beach shoes, shoes, shoes for casual wear, slippers, sneakers, wellington boots, women's shoes; advertising; advertising and publicity; advertising services relating to clothing; online advertisements; marketing; fashion show exhibitions for commercial purposes; business organisation; business promotion; business management; business administration.

The average consumer and the nature of the purchasing act

33. 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 (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

34. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

35. The average consumer of the goods and services at issue is the general public. The average consumer is likely to take into consideration various factors when selecting the goods and services at issue, but I would not expect the degree of attention to be particularly high. The goods and services are all likely to be sought out primarily by eye, including via websites, for example, and so I would expect the purchase to be mainly visual. However, I bear in mind that the goods and services may sometimes be the subject of word-of-mouth recommendations and therefore aural considerations are also borne in mind. Overall, I find that a medium degree of attention is likely to be paid during the purchase of the goods and services.


Comparison of the marks

36. It is clear from *Sabel BV v. Puma AG* 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 them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] 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.”

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

38. The trade marks to be compared are as follows:

Opponent's mark (First Earlier Mark)	Applicant's mark
CAPRI	

39. The opponent's mark comprises the word 'CAPRI' presented in standard upper-case letters without any stylisation. The overall impression resides in this single element.

40. The applicant's mark consists of the word 'Capri' presented in large, grey standard upper and lowercase letters. The word 'Clothing' is positioned underneath in small font. Positioned behind the words 'Capri' and 'Clothing' are the underlined words 'With love'. These words are presented in a very light grey signature style font. However, these words are barely visible within the mark. I find that the word 'Capri' plays the greater

role in the overall impression due to its size. The word 'Clothing', which is descriptive in nature, and the barely visible non distinctive words 'With love' play a much lesser role.

41. Visually the marks coincide insofar as they identically share the same word 'CAPRI / Capri'. This similarity appears at the beginning of the respective marks, being where consumers tend to focus⁴ as this position is generally considered to have more impact due to consumers in the UK reading from left to right. Accordingly, this is the element that will be read first in the applicant's mark and is the only element of the opponent's mark. In making my visual comparison of the marks, I bear in mind that notional and fair use of the marks would include use in both upper and lower case,⁵ so letter case is irrelevant to the comparison, as is colour. The marks differ in the words 'Clothing' and 'With Love' in the applicant's mark. However, I note that it is the word 'Capri' in the applicant's mark which plays the greater role in the overall impression and which appears identically in the opponent's mark. Overall, I find the marks visually similar to a high degree.

42. Aurally, the opponent's mark is likely to be pronounced as CAP-REE. With regards to the applicant's mark, given the descriptive nature and size of the word 'Clothing', and the barely noticeable words 'With Love', I consider it unlikely that these words will be articulated. Therefore, the applicant's mark is also likely to be pronounced as 'CAP-REE'. Consequently, I find the marks are aurally identical. If I am wrong, and the words 'Clothing' and 'With love' are pronounced, the marks will be aurally similar to a medium degree.

43. Conceptually, the word 'CAPRI / Capri', identically present in both marks, will likely be perceived as reference to a geographical location, on the basis that 'Capri' is an island found off the coast of Italy. However, I bear in mind that as the goods at issue include articles of clothing, there will be a proportion of consumers who will perceive the word 'CAPRI / Capri' as the name of a type of cropped trousers, namely *Capri pants*. In both instances, the words 'Clothing' and 'With love' in the applicant's mark are points of conceptual difference, although not distinctive ones. It follows that,

⁴ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

⁵ *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17

whichever way the respective marks are perceived, they are conceptually highly similar.

Distinctive character of the earlier mark

44. In *Lloyd Schuhfabrik Meyer*, 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 Alternberger* [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).”

45. Registered trade marks possess varying degree 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 distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

46. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the Opponent has not filed any evidence of use in relation to the First Earlier Mark. Consequently, I have only the inherent position to consider.

47. The First Earlier Mark comprises the word 'CAPRI'. Whilst this word will likely be understood as reference to a geographical location, namely 'Capri', being an island found off the coast of Italy, it has no obvious connection with the goods for which the opponent's mark is registered. On this basis, I find that the mark is inherently distinctive to a medium degree.

48. However, as previously discussed, bearing in mind the clothing goods at issue, for a proportion of consumers, the word 'CAPRI' is likely to be perceived as alluding to a type of cropped trousers, namely *capri pants*. Accordingly, for those kinds of goods, I find that the mark is inherently distinctive to a low degree.

Likelihood of confusion

49. 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 goods may be offset by a greater degree of similarity between the marks 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 act. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

50. Earlier in the decision I found that similarity between the goods and services range from dissimilar to identical. I have found that the average consumer of the goods and

services to be members of the general public, who will pay a medium degree of attention during the purchasing process. The purchasing process will be predominantly visual, although I do not discount an aural component. I have found the marks to be visually similar to a high degree, aurally similar to a high or medium degree (depending on how the marks are pronounced), and conceptually highly similar. The words 'Clothing' and 'With love' in the applicant's mark act as points of conceptual difference, although not distinctive ones. I have found that the earlier mark has either a medium or low degree of inherent distinctiveness depending on how the word 'Capri' is perceived.

51. I bear in mind that the applicant's mark contains the entirety of the First Earlier Mark, namely 'CAPRI / Capri' and that I have found that this shared element, will play a greater role in the applicant's mark. Accordingly, although the average consumer views marks as a whole, case law also directs me to bear in mind the dominant and distinctive elements of the marks. It is settled case-law that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind. With regard to the additional elements present in the applicant's mark, namely the non-distinctive words 'Clothing' and the barely visible 'With love', I am of the view that these will likely go unnoticed, be overlooked, or be forgotten. Accordingly, with all things considered, given the similarity of the marks and the similarity or identity between some of the goods and services, I find that the average consumer is unlikely to recall the differences between the marks resulting in the consumer confusing the marks for one another and therefore, there is a likelihood of direct confusion.

52. If the average consumer identifies the minor differences between the marks, given the common presence of the word 'CAPRI / Capri', I consider that they will put these differences down to brand extension rather than concluding that the marks originate from different undertakings. I consider there to be a likelihood of indirect confusion.

53. With regards to the Second Earlier Mark, even if there is proof of use, this mark does not assist the opponent any further as this is registered solely for *outer clothing* in Class 25.

Conclusion

54. The opposition under section 5(2)(b) is partially successful in respect of the following goods and services, for which the application is refused:

Class 25 Clothing; jerseys; sleeveless jerseys; tunics; tops; chemise tops; turtleneck tops; vest tops; hooded tops; halter tops; coats; coats for women; coats made of cotton; dinner jackets; evening coats; frock coats; jackets [clothing]; long jackets; anoraks; beach clothing; beachwear; blouses; caftans; cagoules; camisoles; capes; cardigans; casual shirts; casualwear; bobble hats; berets; beanies; beach footwear; beach clothes; beach shoes; belts [clothing]; bed socks; body warmers; boleros; boots; casual footwear; dresses; dresses for evening wear; dressing gowns; dungarees; ear muffs [clothing]; earbands; espadrilles; evening wear; flat shoes; flip-flops; footwear; footwear for women; formalwear; gilets; gloves; head bands; head scarves; heels; high-heeled shoes; hooded pullovers; hooded sweatshirts; hooded tops; hosiery; jump suits; jumper dresses; jumpers; jumpsuits; knitted clothing; lace boots; ladies' boots; ladies' clothing; ladies' dresses; ladies' footwear; ladies' outerclothing; leg warmers; leisure clothing; leisure footwear; leisure shoes; linen clothing; lingerie; long sleeve pullovers; long-sleeved shirts; loungewear; mittens; night gowns; nightdresses; nightshirts; nightwear; outerclothing; parkas; pinafore dresses; pinafores; plimsolls; pyjamas; rain coats; rain ponchos; rain wear; roll necks [clothing]; sandals and beach shoes; scarves; shift dresses; shirts; shoes; shoes for casual wear; short-sleeve shirts; short-sleeved or long-sleeved t-shirts; sleepwear; sleeved jackets; sleeveless jackets; slippers; sneakers; socks; stockings; suits; sundresses; sun hats; sun visors; swimming costumes; swimming suits; swimsuits; swimwear; t-shirts; under garments; underclothes; underclothing for women; underwear for women; vest tops; v-neck sweaters; vests; waistcoats; wellington boots; women's shoes; woolen clothing; wraps [clothing]; not including capri pants or trousers, or sets containing the same.

Class 35 Wholesale services in relation to clothing, jerseys, sleeveless jerseys, tunics, tops, chemise tops, turtleneck tops, vest tops, hooded tops, halter tops, coats, coats for women, coats made of cotton, dinner jackets, evening coats, frock coats, jackets [clothing], long jackets, anoraks, beach clothing, beachwear, blouses, caftans, cagoules, camisoles, capes, cardigans, casual shirts, casualwear, bobble hats, berets,

beanies, beach clothes, belts [clothing], bed socks, body warmers, boleros, dresses, dresses for evening wear, dressing gowns, dungarees, ear muffs [clothing], earbands, evening wear, formalwear, gilets, gloves, head bands, head scarves, hooded pullovers, hooded sweatshirts, hooded tops, hosiery, jump suits, jumper dresses, jumpers, jumpsuits, knitted clothing, ladies' clothing, ladies' dresses, ladies' outerclothing, leg warmers, leisure clothing, linen clothing, lingerie, long sleeve pullovers, long-sleeved shirts, loungewear, mittens, night gowns, nightdresses, nightshirts, nightwear, outerclothing, parkas, pinafore dresses, pinafores, pyjamas, rain coats, rain ponchos, rain wear, roll necks [clothing], scarves, shift dresses, shirts, short-sleeve shirts, short-sleeved or long-sleeved t-shirts, sleepwear, sleeved jackets, sleeveless jackets, socks, stockings, suits, sundresses, sun hats, sun visors, swimming costumes, swimming suits, swimsuits, swimwear, t-shirts, under garments, underclothes, underclothing for women, underwear for women, vest tops, v-neck sweaters, vests, waistcoats, woolen clothing, wraps [clothing], not including capri pants or trousers, or sets containing the same; retail services in relation to clothing, jerseys, sleeveless jerseys, tunics, tops, chemise tops, turtleneck tops, vest tops, hooded tops, halter tops, coats, coats for women, coats made of cotton, dinner jackets, evening coats, frock coats, jackets [clothing], long jackets, anoraks, beach clothing, beachwear, blouses, caftans, cagoules, camisoles, capes, cardigans, casual shirts, casualwear, bobble hats, berets, beanies, beach clothes, belts [clothing], bed socks, body warmers, boleros, dresses, dresses for evening wear, dressing gowns, dungarees, ear muffs [clothing], earbands, evening wear, formalwear, gilets, gloves, head bands, head scarves, hooded pullovers, hooded sweatshirts, hooded tops, hosiery, jump suits, jumper dresses, jumpers, jumpsuits, knitted clothing, ladies' clothing, ladies' dresses, ladies' outerclothing, leg warmers, leisure clothing, linen clothing, lingerie, long sleeve pullovers, long-sleeved shirts, loungewear, mittens, night gowns, nightdresses, nightshirts, nightwear, outerclothing, parkas, pinafore dresses, pinafores, pyjamas, rain coats, rain ponchos, rain wear, roll necks [clothing], scarves, shift dresses, shirts, short-sleeve shirts, short-sleeved or long-sleeved t-shirts, sleepwear, sleeved jackets, sleeveless jackets, socks, stockings, suits, sundresses, sun hats, sun visors, swimming costumes, swimming suits, swimsuits, swimwear, t-shirts, under garments, underclothes, underclothing for women, underwear for women, vest tops, v-neck sweaters, vests, waistcoats, woolen clothing, wraps [clothing], not including capri pants or trousers, or sets containing the same; online retail store

services in relation to clothing, not including capri pants or trousers, or sets containing the same.

55. The application can proceed to registration in respect of the following goods and services for which the opposition has been unsuccessful:

Class 14 Ankle bracelets; articles of jewellery; bands for watches; bangles; bracelets; brooches [jewellery]; chains [jewellery]; charms [jewellery]; choker necklaces; costume jewellery; cuff links; dress watches; drop earrings; ear studs; earrings; enamelled jewellery; fashion jewellery; finger rings; hoop earrings; imitation jewellery; jewel cases; jewellery boxes; lockets; necklaces; pendants; rings [jewellery]; synthetic stones [jewellery]; watches.

Class 35 Wholesale services in relation to ankle bracelets, articles of jewellery, bands for watches, bangles, bracelets, brooches [jewellery], chains [jewellery], charms [jewellery], choker necklaces, costume jewellery, cuff links, dress watches, drop earrings, ear studs, earrings, enamelled jewellery, fashion jewellery, finger rings, hoop earrings, imitation jewellery, jewel cases, jewellery boxes, lockets, necklaces, pendants, rings [jewellery], synthetic stones [jewellery], watches; retail services in relation to ankle bracelets, articles of jewellery, bands for watches, bangles, bracelets, brooches [jewellery], chains [jewellery], charms [jewellery], choker necklaces, costume jewellery, cuff links, dress watches, drop earrings, ear studs, earrings, enamelled jewellery, fashion jewellery, finger rings, hoop earrings, imitation jewellery, jewel cases, jewellery boxes, lockets, necklaces, pendants, rings [jewellery], synthetic stones [jewellery], watches; Wholesale services in relation to beach footwear, beach shoes, boots, casual footwear, espadrilles, flat shoes, flip-flops, footwear, footwear for women, heels, high-heeled shoes, lace boots, ladies' boots, ladies' footwear, leisure footwear, leisure shoes, plimsolls, sandals and beach shoes, shoes, shoes for casual wear, slippers, sneakers, wellington boots, women's shoes; retail services in relation to beach footwear, beach shoes, boots, casual footwear, espadrilles, flat shoes, flip-flops, footwear, footwear for women, heels, high-heeled shoes, lace boots, ladies' boots ladies' footwear, leisure footwear, leisure shoes, plimsolls, sandals and beach shoes, shoes, shoes for casual wear, slippers, sneakers, wellington boots, women's shoes; advertising; advertising and publicity; advertising services relating to clothing;

online advertisements; marketing; fashion show exhibitions for commercial purposes; business organisation; business promotion; business management; business administration.

Costs

56. As the parties have both been partially successful, I do not consider that it would be appropriate to make an award of costs in either of their favour.

Dated this 20th day of September 2023

**Sam Congreve
For the Registrar**

ANNEX

The Second Earlier Mark

CAPRI

EUTM no. 002689891

Class 25 Outer clothing.