

O/0975/23

TRADE MARKS ACT 1994

**CONSOLIDATED PROCEEDINGS**

IN THE MATTER OF APPLICATION NO. UK 3691736

BY THE LUXURY CLOSET INC.

IN CLASS 35

AND OPPOSITION THERETO UNDER NO. 429489

BY CLOSET CLOTHING CO. LTD.

AND

IN THE MATTER OF REGISTRATION NO. UK 3226667

IN THE NAME OF CLOSET CLOTHING CO. LTD.

IN CLASSES 3, 18, 25, 35 AND 42

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO. 504812 BY THE LUXURY CLOSET INC.

## Background and Pleadings

### Opposition

1. On 8 September 2021, The Luxury Closet Inc. (“the Applicant”) applied to register the UK trade mark no. 3691736 for services in class 35 as set out below. It was accepted and published in the Trade Marks Journal on 1 October 2021.

UKTM 3691736

(“the ‘736 mark”)

The logo consists of the words "THE", "LUXURY", and "CLOSET" stacked vertically in a bold, black, serif font. The text is centered within a light gray rectangular background.

Class 35: Business intermediary and advisory services in the field of selling products and rendering services; Provision of an online marketplace for buyers and sellers of goods and services; Advertising, marketing and promotional services; Product demonstrations and product display services; Business information; Promoting the goods and services of others via computer and communication networks; Procuring of contracts for the purchase and sale of goods; Online retail services relating to handbags; Online retail services relating to jewelry; Online retail services relating to clothing; Wholesale ordering services; Wholesale services relating to clothing; Wholesale services relating to jewelry; Wholesale services in relation to footwear Wholesale services in relation to bags; Wholesale services in relation to clothing; Wholesale services in relation to jewellery; Wholesale services in relation to headgear; Retail services relating to clothing; Retail services relating to jewelry; Retail services in relation to bags; Retail services in relation to footwear; Retail services in relation to headgear; Retail services in relation to clothing; Retail services in relation to jewellery; Retail services in relation to confectionery; Mail order retail services for clothing; Retail services in relation to fashion accessories; Retail services in relation to time instruments; Retail services in relation to clothing

accessories; Online retail store services relating to clothing; Online retail store services in relation to clothing; Mail order retail services connected with clothing accessories; Retail store services in the field of clothing; Mail order retail services for clothing accessories; Retail services connected with the sale of clothing and clothing accessories.

2. On 21 December 2021, Closet Clothing Co. Ltd. (“the Opponent/Proprietor”) opposed the ‘736 mark under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. For its opposition based upon section 5(2)(b) the Opponent relies upon the marks as set out below:

(i) UKTM 3226667

(“first earlier mark”)

CLOSET

Filed on 24 April 2017 and registered on 14 July 2017 for all the goods and services in classes 3, 18, 25, 35 and 42 as set out in full in the annex attached to this decision.

(ii) UKTM 3634489

(“second earlier mark”)



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Filed on 29 April 2021 and registered on 17 September 2021 for all the goods and services in classes 3, 9, 18, 25, 35 and 42 as set out in full in the annex attached to this decision.

4. Under section 5(2)(b) the Opponent claims that there is a likelihood of confusion because the marks are similar and the goods/services are identical or similar.

5. Under section 5(3), the Opponent relies upon the same marks as set out above claiming a reputation for those goods and services in classes 25 and 35 (as set out

below) for which the earlier marks are registered. It claims that use of the '736 mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier marks.

6. In so far as its first earlier mark it claims a reputation for the following goods and services:

First earlier mark

Class 25: Clothing

Class 35: The bringing together, for the benefit of others, of a variety of goods, namely, clothing enabling customers to conveniently view and purchase those goods in retail stores, department stores, retail clothing stores, fashion boutiques, pop-up shops, by mail order retail services, by wholesale retail services, by means of telecommunications or through an internet website; the bringing together, for the benefit of others, of a variety of goods, namely, clothing; retail services, mail order retail services, wholesale retail services, and online retail services connected with clothing.

7. In relation to the second earlier mark its reputation is claimed for the following goods and services:

Second earlier mark

Class 25: Clothing

Class 35: The bringing together, for the benefit of others, of clothing enabling customers to conveniently view and purchase those goods in retail stores, department stores, retail clothing stores, fashion boutiques, pop-up shops, by mail order retail services, wholesale retail services, by means of telecommunications or through an internet website; retail services, mail order retail services, wholesale retail services, and online retail services connected with clothing, enabling customers to conveniently view and purchase those goods in retail stores, department stores, retail clothing stores, fashion boutiques, pop-up shops, by mail order retail services, wholesale retail services, by means of telecommunications or through an internet website; retail services provided via retail stores, department stores, retail clothing stores,

fashion boutiques and pop-up shops connected with clothing, enabling customers to conveniently view and purchase those goods in retail stores, department stores, retail clothing stores, fashion boutiques, pop-up shops, by mail order retail services, wholesale retail services, by means of telecommunications or through an internet website.

*Claset.*  
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9. The Applicant filed a defence and counterstatement denying each of the claims made and putting the Opponent to strict proof.

#### **Invalidation action**

10. On 25 April 2022, the Applicant filed an application for invalidation against the first earlier mark, pursuant to sections 3(1)(b) and 3(1)(c) of the Act.

In relation to the section 3(1) grounds the Applicant states that the mark CLOSET:

“..is devoid of distinctive character because it is descriptive of characteristics of the goods or services; and

In the context of the claimed goods and services, the sign ‘CLOSET’ immediately informs consumers without the need for further reflection that the goods at issue all are items usually stored in a closet, such as, clothes, bags, or cosmetics and that the services all relate to these goods usually being stored in a closet. Therefore, the expression ‘CLOSET’ conveys obvious and direct information regarding the intended location and, given its meaning, also about the kind of the goods and services in question.”

11. Consequently the Applicant claims that the registration should be invalidated because it is devoid of distinctive character and/or is descriptive.

12. The Proprietor filed a defence and counterstatement denying the claim.

13. Both parties are represented; the Opponent/Proprietor by Maguire Boss and the Applicant by Law & Tech s.r.o.. Both parties filed evidence accompanied by submissions (although the Applicant did not file formal evidence in support of its

invalidation action). Neither party requested a hearing but both parties filed written submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

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

## **Evidence and submissions**

### The Opponent/Proprietor's evidence

15. The Opponent/Proprietor filed evidence in the form of a witness statement of Mohammed Sajjad Baig dated 20 September 2022, accompanied by 22 exhibits marked MSB1-MSB22. Mr Baig is the Director of the Opponent, a position he has held since the company was first incorporated. Mr Baig's evidence was accompanied by written submissions dated 20 September 2022.

16. Mr Baig's statement serves to introduce evidence in relation to the Opponent's reputation, goodwill and its claim to an enhanced distinctive character. Mr Baig's evidence will be summarised to the extent that it is considered necessary when dealing with the particular claims as they arise.

17. Three further witness statements were filed by Ms Sylvie Tate dated 21 September 2022 and 9 February 2023 accompanied by fourteen exhibits marked ST1-ST14. Ms Tate is a chartered trade mark attorney and a partner in the employ of the Opponent's professional representatives. The purpose of Ms Tate's statements is to produce various documents and extracts from the Opponent's and various third parties' websites, as well as letters from various individuals who are associated with the Opponent, such as its suppliers and distributors. These letters were not filed in the correct format to be taken as evidence i.e. they were not filed by way of a witness statement and were not accompanied by a statement of truth. Other than as a medium to produce these documents there is little narrative within Ms Tate's statement to explain the contents of the exhibits and on the whole her evidence appears to consist

of opinion evidence from the Opponent's associates and from Ms Tate herself, regarding the claimed reputation of the Opponent. On this basis the materiality of Ms Tate's evidence is limited and for the most part shall be disregarded.

### The Applicant's evidence

18. The Applicant filed evidence in the form of the witness statements of Adrianna Zatonska and Gemma Felicity Cullis both dated 9 December 2022. Ms Zatonska is an independent contractor for the Applicant's representatives whilst Ms Cullis is a solicitor engaged in the employ of the same representatives. Their evidence is simply to relay a telephone conversation with an unnamed individual purporting to be from the Opponent who answered a telephone call with the words 'CLOSET LONDON'. It appears that this evidence was produced in an attempt to counter Mr Baig's statement that the company is referred to as CLOSET. I am not entirely clear as to the purpose of this evidence in relation to the grounds at issue but for reasons that will become apparent later in my decision, this evidence is irrelevant.

19. The Applicant's evidence was accompanied by submissions dated 9 December 2022.

20. Both parties filed written submissions in lieu of hearing; the Opponent's were dated 27 March 2023 and the Applicant's were dated 27 March 2023. Whilst I have read and taken account of all the submissions filed throughout the proceedings, I do not propose to summarise them, but I shall refer to them as and where appropriate during this decision.

### **Preliminary issue**

21. Following consolidation of the proceedings, the evidence filed by the parties as outlined above was filed only in relation to the opposition proceedings. The Applicant did not file evidence to support its invalidation action. Consequently the Registry wrote to the Applicant on 28 September 2022 stating that in accordance Rule 42 of the Trade Mark Rules 2008 given that no evidence was filed, consideration would be made as to whether the invalidation action should be deemed withdrawn. A Case Management Conference ("CMC) was requested to consider the matter. The Applicant's representatives attended that CMC, the Proprietor chose not to attend but filed written submissions in lieu of attendance.

22. Following consideration of the matter, I came to the view that given that the TM26I was personally signed by an individual and included a statement of truth together with dictionary definitions of the word 'closet' that it could be accepted as prima facie evidence of the Applicant's claim, such that I would not deem the invalidation action as having been withdrawn due to the non-filing of a separate formal witness statement. I provided my reasons for that decision in my letter dated 24 November 2022 and I adopt those reasons here.

### **Decision**

23. Given the potential impact of the Invalidation action on the remainder of the proceedings, I will begin by assessing this claim first.

### **The invalidation action against the first earlier mark**

24. In invalidation proceedings, section 3 of the Act has application because of the provisions of section 47(1) which reads:

"47(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed."

25. The relevant parts of section 3(1) of the Act read as follows:

“3(1) The following shall not be registered -

[...]

(b) trade marks which are devoid of any distinctive character.

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

[...]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) ...above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

26. The relevant date under section 3(1)(b) and (c) is the filing date of the first earlier mark which in this case is 24 April 2017.

27. I bear in mind that the grounds under section 3(1)(b) and (c) are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b) of the Act: *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, at paragraph 25. In reality however, since the Applicant’s case under section 3(1)(b) is that the Proprietor’s mark is descriptive then, if its section 3(1)(c) claim succeeds or fails then the same outcome will apply to its claim under section 3(1)(b).

### **Average Consumer**

28. The above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect: *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. The average consumer will vary depending on the particular goods and services concerned. In this case, however, the average consumer for the majority of the Proprietor’s goods/services will primarily be members of the general public, although I accept that some of the services such as

wholesale retail services may be directed at a business user, for example someone running a business who wishes to buy goods in bulk. I recognise that the cost of the goods are likely to vary in price and are neither particularly frequent nor infrequent purchases. On balance, I consider that at least a medium degree of attention is likely to be paid during the purchasing process for the goods, given that factors such as style, fit, aesthetics and cost are all likely to be relevant factors. For those services directed at the members of the public, such as retail services, I do not consider that more than a medium degree of attention will be paid, with considerations such as ease of use, price and availability being factors taken into account. Even for those services directed at the business user the level of attention would not vary from that of the member of the public, as the same or similar considerations would apply.

### **Section 3(1)(c)**

29. I begin with the Applicant's claim under section 3(1)(c) which prevents the registration of marks which are descriptive of the goods or a characteristic of them. The case law under section 3(1)(c) (corresponding to Article 7(1)(c) of the EUTM Regulation, formerly Article 7(1)(c) of the CTM Regulation ) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. zo.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728

[2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether

there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be

regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

31. More recently, Zacaroli J summarised the key question in *Puma SE v Nike Innovate C.V.*, [2021] EWHC 1438 (Ch):

"Ultimately, as Ms Himsworth Q.C. submitted, the question is whether the mark applied for, when notionally and fairly used, is descriptive of the goods and services in question within the meaning of section 3(1)(c). A sign can be refused registration 'only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of [the characteristics in section 3(1)(c)]': *Technopol* (above), at [50]. Moreover, a sign will be descriptive 'if there is a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of one of the

characteristics of the goods and services in question': Case T-234/06 *Giampetro Torresan* (above) at [25]."<sup>1</sup>

32. I bear in mind when undertaking the assessment that the objective of this section is to ensure signs designating a characteristic of the goods/services, remain free for use by traders.

33. I note that the Applicant did not file evidence to support its invalidation action but submitted the following in its pleadings in support of its claim:

7. **Descriptiveness of trademarks depends on the perception of the sign by the relevant consumer in relation to the goods and services for which protection is sought. In this case, the relevant consumer is the British consumer. The English-speaking public would understand the sign as having the following meaning: enclosed space, with a door, used for storage, particularly that of clothes.**
8. **The meaning of the word 'CLOSET' is supported by the following dictionary references.**
  - **'a cupboard or a small room with a door, used for storing things, especially clothes'**  
(information extracted from *Cambridge Dictionary* on 15/4/2022 at <https://dictionary.cambridge.org/us/dictionary/english/closet>)
  - **'A tall cupboard or wardrobe with a door, used for storage'**  
(information extracted from *Oxford Dictionaries* on 15/4/2022 at <https://www.lexico.com/definition/closet>)
9. **The registered sign consists, exclusively, of the word "CLOSET" which is customary in the English language and throughout the English speaking community. The relevant consumer will readily associate the sign 'CLOSET' with the place or location for storing clothes, bags, cosmetics and related items. As a common, purely descriptive generic term presenting a direct link to the goods and services concerned, the word 'CLOSET' is therefore incapable of giving a consumer ideas about identifying the origin of said goods and services.**

34. In response the Proprietor submitted that the word CLOSET is not customary in the English language and throughout the English speaking community to describe places or locations or that it is a purely descriptive generic term presenting a direct link to the goods/services. Furthermore, it is submitted that the word CLOSET does not convey obvious and direct information regarding the kind, place or location of the goods and services in question.

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<sup>1</sup> Para 21

35. I accept the definition provided by the Applicant as to the meaning of 'closet' as extracted from the Cambridge online dictionary, however the definition also includes a citation that it is 'mainly US' and it is a "bedroom linen/storage closet". It is defined as a noun and a piece of furniture.

36. The Collins online dictionary defines the noun 'closet' thus<sup>2</sup>:

"A closet is a piece of furniture with doors at the front and shelves inside, which is used for storing things. [US]

Regional Note: in BRIT, use cupboard"

and

" A closet is a very small room for storing things, especially one without windows. [US, also British, old-fashioned]"

37. In so far as the meaning of the word, as suggested by the Proprietor I accept that the word closet is commonly used in America to refer to a 'built in cupboard to store things' however, whilst commonly used in the USA, UK consumers would still understand the meaning of the word and attribute the same meaning to it. I do not accept, however, as submitted by the Applicant, that the term closet would be exclusively limited to storing "clothes, bags, cosmetics or related items".<sup>3</sup> To my mind the term closet will be seen as a piece of furniture, a storage facility used to store a whole range of items to include clothing but also such things as bedding, linen and household supplies.<sup>4</sup>

38. In so far as the ground pleaded, to say that this understanding is indicative of a characteristic of the Proprietor's goods in so far as it describes the location in which the Proprietor's goods may be kept, is tenuous to say the least, this is not what the act intended when it refers to 'geographical location'. The word closet does not describe an intrinsic characteristic of the Opponent's goods or services, rather it is merely incidental to the properties of the goods/services.<sup>5</sup> At best the mark CLOSET is loosely allusive of the space in which an individual's belongings are stored, but it cannot be said to describe a characteristic of the goods themselves. In so far as the Proprietor's

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<sup>2</sup> <https://www.collinsdictionary.com/dictionary/english/closet>

<sup>3</sup> Para 9 Counterstatement

<sup>4</sup> <https://www.oed.com/dictionary/closet>

<sup>5</sup> *Fissler GmbH v EUIPO*, case T-423/18

services it has no descriptive or allusive meaning at all. The connection between the word CLOSET and its suggestive/allusive meaning is not sufficiently direct to the goods and services at issue. I do not consider that consumers will immediately perceive that the word CLOSET describes a characteristic of any of the Proprietor's goods or services; to do so would require a degree of mental effort on their part which is not consistent with an immediate perception. Furthermore, a mark derived from an English dictionary word, even if allusive, does not of itself prevent it from being used as a trade mark to denote trade origin or that it is incapable of achieving distinctiveness and I find this to be the case here.

39. Other than producing dictionary definitions the Applicant has not filed any evidence that as at the relevant date those in the trade or consumers would understand that the term CLOSET would be non-distinctive or needs to be kept free to be used descriptively for clothing etc and retail services related to the same. For an objection to succeed under section 3(1)(c) the mark must be descriptive of the goods and services for which the mark is applied for or a characteristic of them. In this case it is neither. The Proprietor's mark is, at its height, allusive as to the type of storage space in which the goods are kept but it is not descriptive of a characteristic or geographical origin of the goods or services themselves. It neither describes the intended purpose, kind, nature or quality of the goods and services on offer. The objection under section 3(1)(c) fails.

40. I now turn to the section 3(1)(b) objection. Section 3(1)(b) prevents the registration of a mark which is devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now Article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

41. I have already found that the Proprietor's mark is not descriptive and I accept that this does not of itself mean that its mark cannot be objectionable under section 3(1)(b).

However, descriptiveness is the only claim that the Applicant has made under this ground as to why the mark is devoid of distinctive character.

42. It is clear from the caselaw that for a mark to possess distinctive character it must serve to identify the goods/services in issue as originating from a particular undertaking. I can see no reason why the mark not being descriptive of the goods and services at issue could be said to be incapable of identifying those goods/services as originating from a particular undertaking. The invalidation based upon section 3(1)(b) also fails.

43. The application for invalidation fails in its entirety based on the inherent characteristics of the first earlier mark in respect of sections 3(1)(b) and 3(1)(c), on this basis there is no need for the Proprietor to show it has acquired distinctive character through use of its mark.

44. In light of these findings the Proprietor may rely upon the first earlier mark for the purposes of its opposition under sections 5(2)(b), 5(3) and 5(4)(a). I shall deal with each ground in turn.

## **Opposition**

### **Section 5(2)(b)**

45. Section 5(2)(b) of the Act states as follows:

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

(a) ....

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

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

46. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98,

*Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P:*

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

47. The trade marks upon which the Opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks completed their registration process no more than 5 years before the application, they are not subject to the proof of use requirements under section 6A of the Act and therefore the Opponent may rely upon all the goods/services of its registrations without having to demonstrate the use it has made of them.

#### **Comparison of the goods and services**

48. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where 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.”

49. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (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.

50. 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 Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

51. In *Kurt Hesse v OHIM*, Case C-50/15 P, 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)*, Case T-325/06, the GC stated that “complementary” means:

“...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”.

52. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services

are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

53. 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.”

54. Furthermore, terms used in specifications of goods/services should not be interpreted widely but confined to the core of the possible meanings attributable to the terms.<sup>6</sup>

55. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC 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.

56. Furthermore, in *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person, reviewed the law concerning retail services versus goods. He said that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of

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<sup>6</sup> *Sky v Skykick* [2020] EWHC 990 (Ch) as per Arnold J.

determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

57. In *Sanco SA v OHIM*,<sup>7</sup> Mr Hobbs concluded that amongst other matters the GC's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered or proposed to be registered.

58. However, in *Frag Comercio Internacional, SL v OHIM* T-162/08, the GC held that a registration for retail services which did not identify the kinds of goods covered by the services, was too vague to permit a proper comparison to be made. It appears clear, therefore, that a comparison can only be properly made if the goods to which the retail services are connected are specified, but it is also necessary to look at the goods for which the Applicant's services are normally associated and ascertain as to whether those correspond to the Opponent's goods.

59. The respective goods and services at issue are as follows:

<b>Applicant's services</b>
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Class 35: Business intermediary and advisory services in the field of selling products and rendering services; Provision of an online marketplace for buyers and sellers of goods and services; Advertising, marketing and promotional services; Product demonstrations and product display services; Business information; Promoting the goods and services of others via computer and communication networks; Procuring of contracts for the purchase and sale of goods; Online retail services relating to handbags; Online retail services relating to jewelry; Online retail services relating to clothing; Wholesale ordering services; Wholesale services relating to clothing; Wholesale services relating to jewelry; Wholesale services in relation to footwear
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<sup>7</sup> T-249/11

Wholesale services in relation to bags; Wholesale services in relation to clothing; Wholesale services in relation to jewellery; Wholesale services in relation to headgear; Retail services relating to clothing; Retail services relating to jewelry; Retail services in relation to bags; Retail services in relation to footwear; Retail services in relation to headgear; Retail services in relation to clothing; Retail services in relation to jewellery; Retail services in relation to confectionery; Mail order retail services for clothing; Retail services in relation to fashion accessories; Retail services in relation to time instruments; Retail services in relation to clothing accessories; Online retail store services relating to clothing; Online retail store services in relation to clothing; Mail order retail services connected with clothing accessories; Retail store services in the field of clothing; Mail order retail services for clothing accessories; Retail services connected with the sale of clothing and clothing accessories.

**First earlier mark's goods and services**

Class 3: Cosmetics, perfumery, essential oils, hair lotions; soaps; make-up; make-up remover; fragrances; toiletries and body care preparations; body cleaning and beauty care preparations; hair preparations and treatments; dentifrices; nail care preparations; skin care preparations; anti-perspirants; sunscreen cream; after-sun creams; tanning creams.

Class 18: Bags; hand bags; shoulder bags; trunks and travelling bags; purses; wallets; tote bags, canvas shopping bags, leather and imitation leather bags, backpacks, book bags, sports bags, bum bags, wallets, purses, cosmetic bags sold empty, make-up bags sold empty, evening bags, weekend bags, athletics bags, travelling bags, clutch bags, beach bags.

Class 25: Clothing, footwear, headgear.

Class 35: The bringing together, for the benefit of others, of a variety of goods, namely, cosmetics, perfumery, essential oils, hair lotions, soaps, make-up, make-up remover, fragrances, toiletries and body care preparations, body cleaning preparations and beauty care preparations, hair preparations and hair treatments, dentifrices, nail care preparations, skin care preparations, anti-perspirants,

sunscreen cream, after-sun creams, tanning creams, clothing, footwear, headgear, clothing accessories, belts, bags, tote bags, hand bags, shoulder bags, jewellery, costume jewellery, necklaces, bracelets, earrings and brooches, enabling customers to conveniently view and purchase those goods in retail stores, department stores, retail clothing stores, fashion boutiques, pop-up shops, by mail order retail services, by wholesale retail services, by means of telecommunications or through an internet website; the bringing together, for the benefit of others, of a variety of goods, namely, cosmetics, perfumery, essential oils, hair lotions, soaps, make-up, make-up remover, fragrances, toiletries and body care preparations, body cleaning preparations and beauty care preparations, hair preparations and hair treatments, dentifrices, nail care preparations, skin care preparations, anti-perspirants, sunscreen cream, after-sun creams, tanning creams, clothing, footwear, headgear, clothing accessories, belts, bags, tote bags, hand bags, shoulder bags, jewellery, costume jewellery, necklaces, bracelets, earrings and brooches; retail services, mail order retail services, wholesale retail services, and online retail services connected with cosmetics, perfumery, essential oils, hair lotions, soaps, make-up, make-up remover, fragrances, toiletries and body care preparations, body cleaning preparations and beauty care preparations, hair preparations and hair treatments, dentifrices, nail care preparations, skin care preparations, anti-perspirants, sunscreen cream, after-sun creams, tanning creams, clothing, footwear, headgear, clothing accessories, belts, bags, tote bags, hand bags, shoulder bags, jewellery, costume jewellery, necklaces, bracelets, earrings and brooches.

Class 42: Fashion design; design of clothing, footwear and headgear; design of bags.

**Second earlier mark's goods and services**

Class 3: Cosmetics, perfumery, essential oils, hair lotions; lipstick; lipstick cases; sun blocking lipsticks [cosmetics]; lip balm [non-medicated]; lip cosmetics; nail cosmetics; nail paint [cosmetics]; nail varnish; nail varnish remover; soaps; make-up; make-up remover; fragrances; toiletries and body care preparations; body cleaning and beauty care preparations; hair preparations and treatments;

dentifrices; nail care preparations; skin care preparations; anti-perspirants; sunscreen cream; after-sun creams; tanning creams.

Class 9: Sunglasses; boxes [cases] for sunglasses; cases for spectacles and sunglasses; chains for spectacles and sunglasses; clip-on sunglasses; cords for sunglasses; covers for sunglasses; fashion sunglasses; frames for spectacles and sunglasses.

Class 18: Bags; hand bags; shoulder bags; trunks and travelling bags; tote bags; leather and imitation leather bags; backpacks, book bags, sports bags, bum bags; evening bags, weekend bags, athletics bags, travelling bags, clutch bags, beach bags; purses; wallets; credit-card holders; canvas shopping bags; garment carriers; labels for luggage; umbrellas; belts; cosmetic bags sold empty, make-up bags sold empty; make-up cases; make-up bags; beauty cases

Class 25: Clothing, footwear, headgear; face masks.

Class 35: The bringing together, for the benefit of others, of clothing, footwear, headgear, clothing accessories, cosmetics, perfumery, essential oils, hair lotions, lipstick, lipstick cases, sun blocking lipsticks [cosmetics], lip balm [non-medicated], lip cosmetics, nail cosmetics, nail paint [cosmetics], nail varnish, nail varnish remover, soaps, make-up, make-up remover, fragrances, toiletries and body care preparations, body cleaning and beauty care preparations, hair preparations and treatments, dentifrices, nail care preparations, skin care preparations, anti-perspirants, sunscreen cream, after-sun creams, tanning creams, sunglasses, boxes [cases] for sunglasses, cases for spectacles and sunglasses, chains for spectacles and sunglasses, clip-on sunglasses, cords for sunglasses, covers for sunglasses, fashion sunglasses, frames for spectacles and sunglasses, jewellery, costume jewellery, necklaces, bracelets, earrings and brooches, lip brushes, applicators for cosmetics, containers for cosmetics, holders for cosmetics, make-up brushes, bags, hand bags, shoulder bags, trunks and travelling bags, tote bags, leather and imitation leather bags, backpacks, book bags, sports bags, bum bags, evening bags, weekend bags, athletics bags, travelling bags, clutch bags, beach

bags, purses, wallets, credit-card holders, canvas shopping bags, garment carriers, labels for luggage, umbrellas, belts, cosmetic bags sold empty, make-up bags sold empty, make-up cases, make-up bags, beauty cases, enabling customers to conveniently view and purchase those goods in retail stores, department stores, retail clothing stores, fashion boutiques, pop-up shops, by mail order retail services, wholesale retail services, by means of telecommunications or through an internet website; retail services, mail order retail services, wholesale retail services, and online retail services connected with clothing, footwear, headgear, clothing accessories, cosmetics, perfumery, essential oils, hair lotions, lipstick, lipstick cases, sun blocking lipsticks [cosmetics], lip balm [non-medicated], lip cosmetics, nail cosmetics, nail paint [cosmetics], nail varnish, nail varnish remover, soaps, make-up, make-up remover, fragrances, toiletries and body care preparations, body cleaning and beauty care preparations, hair preparations and treatments, dentifrices, nail care preparations, skin care preparations, anti-perspirants, sunscreen cream, after-sun creams, tanning creams, sunglasses, boxes [cases] for sunglasses, cases for spectacles and sunglasses, chains for spectacles and sunglasses, clip-on sunglasses, cords for sunglasses, covers for sunglasses, fashion sunglasses, frames for spectacles and sunglasses, jewellery, costume jewellery, necklaces, bracelets, earrings and brooches, lip brushes, applicators for cosmetics, containers for cosmetics, holders for cosmetics, make-up brushes, bags, hand bags, shoulder bags, trunks and travelling bags, tote bags, leather and imitation leather bags, backpacks, book bags, sports bags, bum bags, evening bags, weekend bags, athletics bags, travelling bags, clutch bags, beach bags, purses, wallets, credit-card holders, canvas shopping bags, garment carriers, labels for luggage, umbrellas, belts, cosmetic bags sold empty, make-up bags sold empty, make-up cases, make-up bags, beauty cases, enabling customers to conveniently view and purchase those goods in retail stores, department stores, retail clothing stores, fashion boutiques, pop-up shops, by mail order retail services, wholesale retail services, by means of telecommunications or through an internet website; retail services provided via retail stores, department stores, retail clothing stores, fashion boutiques and pop-up shops connected with clothing, footwear, headgear, clothing accessories, cosmetics, perfumery, essential oils, hair lotions, lipstick, lipstick cases, sun blocking lipsticks [cosmetics], lip balm [non-medicated], lip

cosmetics, nail cosmetics, nail paint [cosmetics], nail varnish, nail varnish remover, soaps, make-up, make-up remover, fragrances, toiletries and body care preparations, body cleaning and beauty care preparations, hair preparations and treatments, dentifrices, nail care preparations, skin care preparations, anti-perspirants, sunscreen cream, after-sun creams, tanning creams, sunglasses, boxes [cases] for sunglasses, cases for spectacles and sunglasses, chains for spectacles and sunglasses, clip-on sunglasses, cords for sunglasses, covers for sunglasses, fashion sunglasses, frames for spectacles and sunglasses, jewellery, costume jewellery, necklaces, bracelets, earrings and brooches, lip brushes, applicators for cosmetics, containers for cosmetics, holders for cosmetics, make-up brushes, bags, hand bags, shoulder bags, trunks and travelling bags, tote bags, leather and imitation leather bags, backpacks, book bags, sports bags, bum bags, evening bags, weekend bags, athletics bags, travelling bags, clutch bags, beach bags, purses, wallets, credit-card holders, canvas shopping bags, garment carriers, labels for luggage, umbrellas, belts, cosmetic bags sold empty, make-up bags sold empty, make-up cases, make-up bags, beauty cases, enabling customers to conveniently view and purchase those goods in retail stores, department stores, retail clothing stores, fashion boutiques, pop-up shops, by mail order retail services, wholesale retail services, by means of telecommunications or through an internet website; loyalty scheme services.

Class 42: Fashion design; design of sunglasses; design of clothing, footwear and headgear; design of fashion accessories; design of jewellery; design of cosmetic products; design of bags, boxes and cases.

60. In so far as identity/similarity as between the respective goods and services the Opponent filed an Annex<sup>8</sup> to its original submissions, arguing in essence that all the goods and services were identical or alternatively similar.

61. The Applicant submitted in its counterstatement that:

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<sup>8</sup> Attached to the Opponent's submissions dated 20 September 2022

26. Despite some similarity of claimed services in class 35, the nature of the goods to which these services relate are different and reach different groups of consumers. As already pointed out the Applicant is primarily focusing on reselling of top luxury brands, while the Opponent is a fashion designer, producer and seller of his own high-fashion clothing. The consumer looking for original pieces of clothes would be different to consumers looking for pieces of luxury brands in the fashion industry.

27. Furthermore, the goods are not marketed through the same distribution channels and sold in the same shops. The goods and services are not characterized by identical sales at identical or similar markets, and thus the average consumer would not be confused that the goods and/or services labeled this way come from one and the same manufacturer or give the average consumer the wrong impression. Based on the above-mentioned facts the Applicant is not in direct competition with the Opponent.

28. In this context we would like to point out that the Applicant is providing completely different services as the primary focus of Applicant's business activities shall be a sale of third parties' luxury items. On the other hand, the Opponent's primary focus is to design their own fashion clothing. It follows that the Applicant is not competing with the Opponent as the goods and/or services offered by both the Applicant and the Opponent substantially differ.

62. When considering the similarity of the goods/services it is permissible to group terms together.<sup>9</sup> I also bear in mind that the assessment I must make is based on a notional and fair use of the terms as registered against all the potential or intended uses of the goods/services and not necessarily the ones in which a party actually trades. Given that there is considerable overlap between the Opponent's specifications I shall deal with them collectively.

### **Retail Services**

63. Both parties specifications include the retail sale, either wholesale, online, in store or via mail order, of a whole list of specified goods which are identical in each party's specifications. Therefore, the applied for services namely *retail services relating to clothing; Retail services relating to jewelry; Retail services in relation to bags; Retail services in relation to footwear; Retail services in relation to headgear; Retail services in relation to clothing; Retail services in relation to jewellery; Retail services in relation to fashion accessories; Retail services in relation to clothing accessories; Retail store services in the field of clothing; Retail services connected with the sale of clothing and clothing accessories. Online retail services relating to handbags; Online retail services relating to jewelry; Online retail services relating to clothing; Online retail store services*

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<sup>9</sup> *Separode Trade Mark* BL O-399-10

*relating to clothing; Online retail store services in relation to clothing; Mail order retail services for clothing; Mail order retail services for clothing accessories; Mail order retail services connected with clothing accessories; Wholesale ordering services; Wholesale services relating to clothing; Wholesale services relating to jewelry; Wholesale services in relation to footwear; Wholesale services in relation to bags; Wholesale services in relation to clothing; Wholesale services in relation to jewellery; Wholesale services in relation to headgear* are either self-evidently identical or identical in accordance with *Meric*, being encompassed by the broader term, to the Opponent's *'retail services, mail order retail services, wholesale retail services, and online retail services connected with clothing, footwear, headgear, clothing accessories, belts, bags, hand bags, jewellery'* in both earlier marks' specifications.

64. Furthermore, given that the Opponent's specifications for goods in classes 18 and 25 relate to clothing, headgear, footwear, jewellery, bags and handbags which cover the identical goods for which the Applicant's retail services relate, then the Opponent's goods are also similar to the Applicant's aforementioned services to a medium degree. The goods and the services are indispensable to each other being complementary and overlap in trade channels and end consumers. It is recognised that consumers would consider that those entities responsible for producing the goods would be the same entity that brings the goods to market, whether physically in store, online, via mail order or wholesale.

65. In so far as the applied for *retail services in relation to time instruments* I consider that these are similar to between a medium and high degree to the Opponent's *retail services in relation to jewellery*. The goods which are the subject of the retail services are similar to between a medium and high degree, overlapping in nature, provider, producer, distribution channel and relevant public. It follows, therefore, that those providing retail services for these goods would be equivalently similar. The specific goods concerned are commonly retailed together in the same outlets and therefore I find that the retail services related to the respective goods are similar to between a medium and high degree.

66. This leaves *retail services in relation to confectionery*. The Opponent submits that its retail services are sufficiently broad that they would cover services for similar goods. Whilst not addressing the retail of confectionary specifically, it submitted that

consumers are accustomed to the practice in fashion retail/wholesale that a variety of similar or highly similar goods are brought together and offered for sale in the same shops or in the same sections of department stores or online stores. The Applicant did not advance any specific argument to the contrary beyond those as outlined above.

67. I accept that the respective parties' goods the subject of the retail services are not similar, there is no obvious similarity between confectionery and any of the Opponent's goods in classes 3, 9, 18 and 25. They have different natures and purposes. However, the retail and wholesale services relating to these goods may overlap in trade channels and be directed at the same end user. Confectionery goods are not specialised ones requiring them to be provided through specialised retailers. Consequently, a retail outlet such as a supermarket or wholesaler for example, provides all sorts of goods for retail and whilst not generally displayed in the same aisles they may well sell confectionery alongside clothing, particularly during seasonal periods. Whilst I accept that the goods themselves are not the same, consumers would nevertheless believe that the entity responsible for bringing these differing goods to market are the same or are at least related entities. I consider that the respective retail services are similar to a low degree.

68. The applied for *provision of an online marketplace for buyers and sellers of goods and services* is a sufficiently broad term that it would encompass the Opponent's '*bringing together, for the benefit of others, of clothing, footwear, headgear, clothing accessories...[.] enabling customers to conveniently view and purchase those goods....by means of telecommunications or through an internet website*'. Both services relate to the provision of an e-commerce platform where the seller can display and offer its goods and those of a third party for sale to the buyer on one platform or from one location. These services are identical in according to *Meric*.

69. The Applicant's *procuring of contracts for the purchase and sale of goods* services is the arranging of contracts for the purchase and sale of goods for others or the acquiring of goods for third parties and are in my view similar to the Opponent's *online retail services [..]*. I consider that the Applicant's procurement services would be offered by the same undertaking as those offering retail services provided online or via a communications network, to the same relevant public, through the same

distribution channels and may have the same purpose if they related to the same goods. These services are similar to a medium degree.

### **Business, Promotion and advertising**

70. The remaining applied for *Business intermediary and advisory services in the field of selling products and rendering services; Business information; Advertising, marketing and promotional services; Product demonstrations and product display services; Promoting the goods and services of others via computer and communication networks* encompass mainly services involving business advisory, management and administration of a commercial enterprise, as well as advertising, marketing and promotional services.

71. Advertising and promotional services is the provision of assistance to others in the launch, sale and promotion of their products or services. These services are normally provided by advertising companies and not generally regarded as encapsulating services to promote one's own products. Any advertising and promotion undertaken by the Opponent in the provision of its retail services is as a by-product to its own goods, rather than the provision of a separate advertising/promotional service for others. The respective services are directed at different publics, they do not share the same providers, they are neither complementary nor in competition and they differ in nature and purpose.

72. The same reasoning would apply to the aforementioned applied for business management and advisory/information services which again is the provision of support, advice and assistance in the management and operation of a company to manage its business. They are usually rendered by specialist companies such as business consultants. A company undertaking its own business management strategy or advice in the retail of its own goods is not providing this service to others.


73. I see no obvious similarity between the aforementioned applied for services and any of the Opponent's goods/services which are in essence the provision of goods and the related retail services thereof. They are dissimilar.

### **Average consumer and the purchasing process**

74. I have already considered the average consumer and the purchasing process of the goods and services at issue when dealing with the invalidation claim to which I

found them to be predominantly a member of the general public but for some services would include a business user. I consider that the same findings would apply to the Applicant's services.

**Comparison of the marks**

The '736 mark	First earlier mark	Second earlier mark
<p><b>THE LUXURY CLOSET</b></p>	<p><b>CLOSET</b></p>	

**Overall impression**

75. The first earlier mark is for the word CLOSET. There are no other elements to contribute to the mark and therefore the overall impression resides in the word itself.

76. The second earlier mark consists of two words, the word Closet presented in an embellished script followed by a punctuation mark and underneath in considerably smaller letters the word LONDON presented in capital letters in an unremarkable font. Neither the stylisation nor the punctuation mark play significant distinctive roles in the mark as a whole and certainly in so far as the punctuation mark it may well be overlooked in its entirety. The word Closet due to its size and position relative to the word LONDON, naturally draws the eye and in my view plays the greater role in the overall impression of the mark particularly since the word London will be perceived as a geographical indicator.

77. The '736 mark is for the three words THE LUXURY CLOSET presented in capital letters in a black non-descript font. The words are presented one above the other, but the presentation has little impact on the mark as a whole. The overall impression of the mark lies in the combination of the three words, weighted in favour of the word CLOSET, given the non-distinctive character of the word THE and the word LUXURY being laudatory, qualifying the word CLOSET.

78. I shall bear these conclusions in mind when comparing the competing marks.

### **Visual and aural comparison**

79. The first earlier mark and the '736 mark coincide visually and aurally with the word CLOSET. They differ to the extent that the '736 mark also includes the words LUXURY and THE there being no counterpart in the first earlier mark. Aurally, the '736 mark will be pronounced as THE LUXURY CLOSET or LUXURY CLOSET whereas the earlier mark will be pronounced as CLOSET. I bear in mind that usually greater visual and aural emphasis is placed on the beginning of marks, however, given the weak distinctive character of the words LUXURY and THE, the emphasis will nevertheless be on the word CLOSET in the '736 mark, making the marks aurally and visually similar overall to between a medium and high degree.

80. In so far as the '736 mark against the second earlier mark the stylisation and the word LONDON act as additional points of visual difference such that the visual similarity between these marks will be reduced to a medium degree. As stated the punctuation mark will have little impact. In so far as the aural similarity, no pronunciation will be given to the punctuation mark or the stylisation resulting in the aural similarity between the marks being reduced to a medium degree, if all the words of each mark are pronounced. Otherwise if the word LONDON is not pronounced then the same finding will apply as with the first earlier mark.

### **Conceptual comparison**

81. All three marks give rise to the identical concept of a CLOSET, understood to mean a piece of furniture/cupboard to store items. This concept is common to all marks. In the '736 mark the addition of the word LUXURY is a laudatory concept of opulence, giving rise to the meaning of a deluxe version, whereas, the presence of the word THE has little conceptual significance. The word London in the second earlier mark adds a point of difference indicating that the business is located in or the goods/services are made from London. Given that the subject matter of all three marks is the word CLOSET and this is the meaning that dominates, then, overall, the respective marks are conceptually highly similar.

## **Distinctive character**

82. The case of *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 sets out the legal position to determine the distinctive character of a mark. In this case 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).”

83. Registered trade marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer, to those with high inherent distinctive character such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion.

84. I have already found that the word CLOSET is not descriptive of the Opponent’s goods /services, but is a dictionary word understood to mean a piece of furniture or cupboard where goods may be stored. Being a dictionary word and at its height suggestive/allusive of where some of the Opponent’s goods may be stored, I consider

the mark is inherently distinctive to an average degree. In so far as the second earlier mark, in light of my findings in relation to the overall impression of this mark I do not consider that the stylisation, punctuation mark or the word LONDON impacts on the inherent distinctiveness of the mark beyond an average degree, which still lies in the word CLOSET.

### **Enhanced distinctive character**

85. The Opponent claims that by the use it has made of its marks that it has achieved an enhanced level of distinctive character. Distinctive character is a measure of how strongly the earlier marks identify the goods/services of a single undertaking. The assessment will depend on the nature, intensity, extent (including geographical extent) and length of the use claimed and as to how well known the marks are with the UK public.<sup>10</sup>

86. The Applicant submits that the Opponent's rebranding of CLOSET to CLOSET LONDON in 2015 means that any evidence of use in the word only mark prior to this date is use of a descriptive mark which ceased before the Opponent sought registration for it.<sup>11</sup> Any use of the logo mark and the word mark should therefore be treated separately and it is insufficient taking into account the market to establish enhanced distinctive character of the individual marks. Furthermore the evidence only demonstrates use as a company name rather than as a trade mark.

87. In assessing the evidence, it is clear that both the figurative mark and the word only mark have been used on invoices, websites, labels and swing tags of the clothing, promotional publications both online and in print as well as in the text of various magazines and newspapers.<sup>12</sup> The turnover and sales figures produced amount to millions of pounds (over £19 million between 2017 and 2021).<sup>13</sup> Whilst these turnover figures are not broken down specifically by category it is clear from the invoices,<sup>14</sup> promotional activity and the screenshots taken from the Opponent's website<sup>15</sup>, that I can reasonably infer that the figures relate to sales of women's clothing particularly

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<sup>10</sup> *Lloyd Schuhfabrik Meyer & Co.*

<sup>11</sup> Para 14 submissions dated 9 December 2022

<sup>12</sup> Exhibits MSB3 and MSB4

<sup>13</sup> See table at para 11 of Mr Baig's statement

<sup>14</sup> MSB4

<sup>15</sup> MSB5

tops/blouses, trousers, skirts, dresses, jumpsuits, jackets, coats and shorts and the retail services thereof.

88. Extensive promotion and advertising of the Opponent's brand has been shown to be undertaken, with expenditure running into almost £4 million pounds since 2017.<sup>16</sup> The promotional activities include references to the mark as CLOSET, CLOSET LONDON and its figurative form in "get the look" sections of popular magazines and newspapers to include Closer magazine dated 5 July 2014 with a circulation of 337,190, Hello! Magazine dated 22 July 2014 with a circulation of 288,331 and the Metro newspaper 26 January 2015 with a circulation of 1,340,143 as well as in supplements of daily newspapers such as the Sun, Daily Express, Daily Mail and the Mirror in 2018 and 2019.<sup>17</sup>

89. The Opponent has also promoted its brand via social media campaigns and endorsements by well-known UK celebrities. Its social media presence is active on platforms such as Instagram, Facebook, Tik Tok, Linked In, Twitter and YouTube. The followers it has for each platform is shown to be not an insubstantial number. Its Twitter account for example, under the handle '@closet\_London', has 3,404 followers whilst its Instagram account under the handle 'closet\_london' shows that it has 64,700 followers. The evidence shows that "Closet\_London" clothing (mainly dresses) have been endorsed by high profile daytime TV celebrities such as Lorraine Kelly, Kate Garraway, Charlotte Hawkins and Suzanna Reid on various platforms. A selection of posts/articles are produced dated 3 June 2019, 8 October 2019, 1 November 2019, 30 March 2021, and 13 August 2021

90. The evidence shows that the Opponent sells and promotes women's clothing by reference to predominantly its figurative mark, but also as CLOSET and CLOSET LONDON (word only), directly from its own website and via third party websites including high profile retail outlets such as Next and Asos.<sup>18</sup> Promotional literature said to be from 2021 shows that its website attracts 160,000 visits per month.<sup>19</sup> It is confirmed that both ASOS and Next are ranked as the second and fourth largest fashion companies in the UK, with both companies generating billions of pounds of

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<sup>16</sup> Para 14

<sup>17</sup> MSB13

<sup>18</sup> MSB6

<sup>19</sup> Page 61 of exhibit MSB11

revenue annually.<sup>20</sup> Mr Baig states that the Opponent's brand is the second biggest selling brand for ASOS in the UK, taking £13.6 million between January 2022 and August 2022. Whilst I accept that these figures are outside the relevant date I take on board that this level of sales would not have been achieved overnight and therefore it is reasonable for me to infer that the position would not be significantly different as at September 2021.

91. The evidence also shows reviews across various platforms from customers throughout the UK, where reference is made to mark as follows:



92. The word only Closet is also referred to by customers in the text of the reviews themselves as follows; "I would recommend closet to anyone", "I have several Closet dresses ..."<sup>21</sup> and "Absolutely Love Closet".<sup>22</sup>

93. The review platform 'Trustpilot', for example, shows that of 6,179 reviews, 74% of customers rated 'Closet LONDON' as excellent and of the sample of reviews produced, dated between 30 March 2015 and 28 July 2022, at least 20 had locations recorded as 'GB'.<sup>23</sup> The invoices<sup>24</sup> and customer reviews<sup>25</sup> produced confirm the geographical extent of the Opponent's presence in the UK with posts from and invoices sent to various UK addresses to include Manchester, London, Liverpool, Watford, Lemington Spa, Devon and Leicester. The invoices are dated between 2017 and 2022.

94. The Opponent is also said to have promoted its goods under the Closet brand to those in the trade, at events and trade fairs throughout the UK. It was an exhibitor at

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<sup>20</sup> Exhibit MSB9 page 99

<sup>21</sup> July 2018

<sup>22</sup> 3 March 2021

<sup>23</sup> MSB19

<sup>24</sup> MSB19

<sup>25</sup> MSB4

one such an event, namely Pure London in July 2017. I note that Pure London<sup>26</sup> is described as a trade only event, attracting over ‘12,000 fashion buyers and retailer from independent and department stores, multiples and e-tailers throughout the UK and worldwide’. Pure London’s ‘Look Book’ and promotional literature refers to the brand as ‘Closet London’.<sup>27</sup>

95. The evidence also shows that the Opponent has won several awards, to include The 25<sup>th</sup> Drapers Awards winner and Young fashion brand of the year 2015. Drapers is said to be a trade fashion publication with a print readership and circulation of 43,500 and 8,671 respectively and online readership and circulation of 91,931 and 298,076.<sup>28</sup> These examples illustrate that the brand is recognised not only amongst end consumers but also those in the trade.

96. In so far as the argument that the evidence only demonstrates use as a company name rather than use as a trade mark, I note Mr Daniel Alexander Q.C., as the Appointed Person’s, comments in *Aegon UK Property Fund Limited v The Light Aparthotel LLP*.<sup>29</sup> He affirmed the position of the Court of Justice in *Céline SARL v. Céline SA*, Case C-17/06 (*Céline*), namely that:

“[23]...where the sign is not affixed, there is use “in relation to goods or services” within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party.”

97. The question to be determined is whether the earlier marks have been used in accordance with their essential function namely to guarantee the identity of the origin of the goods or services for which they are registered, in order to create or preserve an outlet for those goods or services. In this regard I determine that they do, and reject the Applicant’s argument to the contrary.

98. In so far as the use of the word CLOSET solus or CLOSET LONDON, as opposed to use of the figurative mark, in *Société des Produits Nestlé SA v Mars UK Ltd*,<sup>30</sup> the

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<sup>26</sup> Wikipedia entry 13/1/2020

<sup>27</sup> MSB12

<sup>28</sup> MSB16

<sup>29</sup> BL O/472/11

<sup>30</sup> Case C-353/03

CJEU held that a mark may acquire a distinctive character as a result of it being used as part of, or in conjunction with, another mark. The CJEU stated in *Specsavers v Asda Case C-252/12*, at paragraph 23, that it is necessary that “the relevant class of persons actually perceive the product or service at issue as originating from a given undertaking.”

99. In *Adidas AG v Shoe branding Europe BVBA*,<sup>31</sup> it was found that the assessment of enhanced distinctiveness is to be interpreted the same as that for genuine use. This means that contrary to the Applicant’s submissions, the use of CLOSET LONDON or CLOSET solus may still be permissible variations of the figurative mark, provided they do not alter the distinctiveness of the mark as registered. The figurative mark is for the stylised word Closet, followed by a punctuation mark, in combination with the word LONDON. As set out earlier the word LONDON acts as a geographical indicator, which in my view does not detract from the word CLOSET itself acting as an indicator of trade origin (the punctuation mark adds very little to the distinctiveness of the mark). The word CLOSET is clearly identifiable within the figurative mark and retains an independent distinctive role, despite the stylisation or its use in combination with the word LONDON. It is my view, therefore, that use of the figurative mark will include use of CLOSET solus and CLOSET LONDON, both of which are permissible variations.

## **Conclusion**

100. The evidence is extensive and shows long standing and consistent use and promotion of both its marks in the UK by way of sales, advertisements, brochures, reviews, look books, celebrity endorsements, in printed publications, online platforms and via social media.

101. The figurative mark is used on labels and swing tags and the Opponent’s website and those of third parties, whereas the word Closet is used solus or in combination with the word LONDON in various text throughout the evidence to include invoices.

102. I have no hesitation in finding that the Opponent has demonstrated that it has enhanced the level of distinctive character for both its marks beyond their inherent positions to between a medium and high degree for women’s clothing and the retail

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<sup>31</sup> T-307/17.

services thereof, by the filing date of the contested application, namely 8 September 2021.

103. In so far as the remaining goods and services relied upon, whilst the Opponent's clothing is sold in various other retail outlets no evidence has been produced that the Opponent sells clothing for third parties either online or otherwise. Furthermore, no evidence has been produced in relation to either mark being used for any goods in classes 3 and 18, nor footwear and headgear in class 25 such that I am able to find an enhanced level of distinctive character for these goods. I have seen no evidence that relates to accessories either. Whilst I note that some evidence has been shown in relation to the design and development of its own goods there is no evidence that it provides these services for others.

### **Likelihood of confusion**

104. In determining whether there is a likelihood of confusion between the marks I must consider whether there is direct or indirect confusion. Direct confusion is where one mark is mistaken for the other, whereas indirect confusion is where the average consumer recognises that the marks are not the same but nevertheless due to the similarities between the marks lead them to believe that the respective goods or services originate from the same or related source.

104. There are a number of factors in the global assessment to bear 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 or services and vice versa. It is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the goods/services and the nature of the purchasing process. In doing so, I must consider 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.

106. Dealing with the first earlier mark first. Earlier in my decision I found that the marks were visually and aurally similar to between a medium and high degree. I found the conceptual similarity between the marks to be high. The '736 services are mostly identical, but with a few being similar to the Opponent's goods/services in varying degrees ranging from a low to between a medium to high degree. I found that the first

earlier mark was inherently distinctive to an average degree and by virtue of the use that had been made of it that it had enhanced that level of distinctiveness to between a medium to high degree for women's clothing and the related retail services. I identified that for most of the goods/services, the average consumer is a member of the general public, primarily selecting the goods/services via visual means but with aural considerations not being discounted. I concluded that a medium degree of attention will be paid in the purchasing/selection process. Some of the services were directed at a business user but I did not consider that this would give rise to a different level of attention being undertaken as the same considerations would apply. For the second earlier mark by the additional elements present the aural and visual similarities were reduced somewhat to a medium degree, otherwise the same findings apply.

107. In so far as direct confusion, I consider that consumers are unlikely to ignore the additional elements present in the respective marks. In my view the visual and aural differences between the marks will be sufficient to prevent them from being mistakenly recalled or misremembered for each other. I recognise that the marks all contain the common word CLOSET but I consider that the additional words, the presentational differences and the stylisation will not be overlooked. I do not find that there would be direct confusion.

108. Moving on to indirect confusion, for this to arise the average consumer must consider that as a result of the common element, there is an economic connection between the respective marks, such that the goods/services provided under one is regarded as a brand extension or sub brand of the other. Indirect confusion was explained by Mr Iain Purvis Q.C., as the Appointed Person, in *LA Sugar Limited v Back Beat Inc.*, BL O/375/10 as follows:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms,

is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example).”

109. I bear in mind that the examples as set out in in *L.A.Sugar* (above) are not exhaustive and that they are only intended to be illustrative of the general approach.<sup>32</sup> Furthermore in *Liverpool Gin*, Arnold L.J. pointed out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion. I bear in mind that a finding of indirect confusion should not be made merely because two marks share a common element; it is not enough that one mark merely calls to mind another, this is mere association, not indirect confusion.<sup>33</sup>

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<sup>32</sup> *Liverpool Gin Distillery Limited v Sazerac brands LLC* [2021] EWCA Civ 1207

<sup>33</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

### **First earlier mark and the '736 mark**

110. It is my view that as a result of the identical use of the word CLOSET, which is common to both marks, it is this element that will be retained in the minds of the average consumer as the name of the entity responsible for the goods/services and it is this element which will act as the badge of trade origin. The words THE and LUXURY create a point of conceptual difference, but this is insufficient to counteract the visual and aural similarities between the marks, particularly given the laudatory role that the word LUXURY plays in the '736 mark. The addition of the words THE and LUXURY will simply be perceived by consumers as adding a non-distinctive element to the '736 mark, which falls squarely into category (b) of the examples set out by Mr Purvis. Consumers will perceive the '736 mark as merely denoting a deluxe version of the Opponent's collection and one which they might expect to find as a sub brand or brand extension.

111. It is the word CLOSET that is the subject matter of the consumer's attention and which will stick in the mind as the entity responsible for the products/services on offer. It is my view that consumers will view the '736 mark as an alternative brand used by the same or economically linked undertaking describing their high end or luxurious collection/service.

### **Second earlier mark and the '736 mark**

112. The same findings would apply when comparing the second earlier mark and the '736 mark. Even though the aural and visual similarities are reduced to a medium degree, the differences arising from the stylisation and the word LONDON are insufficient to differentiate between them, even for services that are only similar to a low degree, given that the word CLOSET retains independent distinctive character in the second earlier mark. When factoring in the Opponent's enhanced degree of distinctive character for women's clothing and retail services thereof, confusion is even more likely.

113. I find a likelihood of indirect confusion to both the first and second earlier mark for those applied for services that I found to be identical or similar.

114. In so far as the services that I found to be dissimilar as set out earlier in my decision, without a finding of similarity, there can be no likelihood of confusion.<sup>34</sup> The opposition based on section 5(2)(b) of the Act succeeds in its entirety against all the Applicant's services, save for *Business intermediary and advisory services in the field of selling products and rendering services; Business information; Advertising, marketing and promotional services; Product demonstrations and product display services; Promoting the goods and services of others via computer and communication networks.*

115. I shall now go on to consider the other grounds of opposition.

### **Section 5(3)**

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

“A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (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 the repute of the earlier trade mark.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

117. I bear in mind the relevant case law set out in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The conditions of section 5(3) are cumulative. Firstly, the Opponent must show that the earlier marks are similar to the Applicant's mark. Secondly, the Opponent must show that the earlier marks have achieved a level of

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<sup>34</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Fourthly, assuming that the first three conditions are 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) for the goods to 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. For the purposes of section 5(3) the relevant date for the assessment is 8 September 2021.

### **Similarity between the marks**

118. In light of my earlier findings this first condition is satisfied. I found the marks to be similar overall visually, aurally and conceptually.

### **Reputation**

119. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

120. In assessing whether the earlier marks have a reputation to a significant number of consumers, I must assess the evidence in terms of the extent it demonstrates “the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it.”<sup>35</sup>

121. I note that the assessment of whether the Opponent has a reputation for the goods/services claimed is a different test to the one undertaken for an enhanced level of distinctive character and that to establish a reputation is not a particularly onerous requirement.<sup>36</sup> I have summarised the Opponent’s evidence at paragraphs 85-103 in relation to its claim to enhanced distinctiveness, which in light of my findings will apply equally to the assessment of whether it holds a reputation. I have no hesitation in finding that the evidence supports the Opponent’s claim to a reasonably strong reputation in the UK for both its first and second earlier marks, but only for women’s clothing and the retail services relating thereof, including online, wholesale, mail order and in store retail services. Given that the term clothing is a very broad term, I do not find that the Opponent has demonstrated a reputation for *clothing or retail of clothing* at large.

## **Link**

122. Having found a reputation I must now go on to consider whether this reputation would give rise to the necessary mental link being made between the respective trade marks. The factors to be taken into account to establish as to whether a link would be made, are those as set out in *Intel*.<sup>37</sup> Taking each of the factors in turn.

### The degree of similarity between the conflicting marks

I have already found that the marks are similar for the reasons already outlined. I adopt those reasons here.

### The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services and the relevant section of the public.

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<sup>35</sup> *General Motors* para 27

<sup>36</sup> *Enterprise Holdings Inc. v Europcar Group UK Ltd* [2015] EWHC 17 (Ch), Arnold J.

<sup>37</sup> *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU).

I have already found that the majority of the Applicant's retail services as outlined previously are identical to the Opponent's retail services, with others being similar to the registered goods/services ranging from a low to between a medium to high degree. In so far as the Applicant's services relating to advertising and business management as set out in paragraph 70 I found that these were dissimilar to the Opponent's goods/services. These findings would apply equally to the goods/services for which the Opponent holds a reputation.

The relevant public for the goods/services at issue, is both the general member of the public and the business user, who are deemed to be reasonably informed and reasonably observant and circumspect.

#### The strength of the earlier marks' reputation

I have found that based upon the evidence filed, the Opponent has a reasonably strong reputation for women's clothing and retail services thereof.

#### The degree of the earlier marks' distinctive character, whether inherent or acquired through use

I found that the earlier marks are inherently distinctive to an average degree and by virtue of the evidence filed, I found that the Opponent has enhanced the degree of distinctiveness further to a medium to high degree for women's clothing and the retail services of the same.

#### Whether there is a likelihood of confusion

I found a likelihood of confusion under section 5(2)(b) as a result of the similarity between the services/goods and overall similarity between the marks.

123. A link means that the earlier marks will be brought to mind by the later mark. One of the considerations in deciding whether a link will be made between the marks is whether there is a likelihood of confusion. If there is a likelihood of confusion, there must be a link, because confusion means that there must be more than a bringing to mind. I concluded, under section 5(2)(b) that there was a likelihood of confusion for those goods/services I found to be identical/similar. I find that this would equally apply to the goods/services for which the marks have a reputation namely women's clothing

and the retail services thereof. I have no hesitation in finding that due to the similarity of the marks and the identity/similarity between the goods/services, the relevant public will believe that the marks are used by the same undertaking or will believe that there is an economic connection between the undertakings leading to a link being made.

124. In so far as those of the Applicant's services that I found to be dissimilar, namely *'business intermediary and advisory services in the field of selling products and rendering services; Business information; Advertising, marketing and promotional services; Product demonstrations and product display services; Promoting the goods and services of others via computer and communication networks'*, the provisions of section 5(3) offer additional protection. The provisions take into account the repute and distinctiveness of earlier trade marks and that there is no requirement for the parties' respective goods or services to be similar. It is my view that even in respect of these services, such is the level of reputation and enhanced distinctiveness held in the marks CLOSET/Closet London (figurative mark) for women's clothing and retail services thereof, that a significant part of the relevant public is still highly likely to make a link between the competing marks for these services. The Applicant's advertising and business management services are not so remote or distinct from the Opponent's goods/services in which it holds a reputation, that consumers would not bring to mind the other, and wonder whether the goods and services are provided by the same entity. A commercial enterprise engaged in services that relate to the retail and promotion of women's clothing and the management of its own business is not so distant from an entity that provides advertising or business management services for others, particularly if those services relate to the same or similar goods. I consider that the degree of closeness between these services will still be sufficient in the minds of the relevant consumer for them to make a link.

## **Damage**

125. I must now consider whether any of the types of damage pleaded will arise. It is not necessary for the proprietor of an earlier mark to demonstrate or file evidence of actual damage being suffered, in order to succeed under section 5(3).<sup>38</sup> It is sufficient

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<sup>38</sup> *Intel* para 38.

to conclude that there is a serious risk of such damage occurring even if this was not intentional.

### **Unfair advantage**

126. Taking advantage of the distinctive character or reputation of an earlier mark creates a familiarity with consumers such that when confronted with the later mark there is an increased chance of consumers buying the later mark's products or choosing its services because of their perceived link to the Opponent. In my view this would take unfair advantage of the earlier marks' reputation and gain a foothold in the industry quickly, without having to make an equivalent investment or marketing effort themselves. The economic behaviour of customers would change, leading to a commercial advantage being gained by the Applicant. I find this to be the case here. I have already found that there would be a likelihood of confusion and a link between the respective marks as a result of the similarities between them. These similarities would lead the '736 mark to free ride on the reputation of both the figurative and word only CLOSET marks and gain an unfair commercial advantage.

127. Since I have found damage resulting from an unfair advantage being gained by the Applicant, this is sufficient for the opposition based upon section 5(3) to succeed and I need not therefore consider whether any of the other heads of damage have arisen.

128. The opposition based upon section 5(3) succeeds in its entirety.

### **Section 5(4)(a)**

129. 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, where the condition in subsection (4A) is met,

aa)...

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”.

130. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

131. Whilst the Opponent also relies on a claim under section 5(4)(a), on a question of proportionality, and given my earlier findings its position is not improved beyond that which I have already found under sections 5(2)(b) and 5(3).

132. However, dealing with the claim briefly, in order for the Opponent to succeed under this ground it must demonstrate goodwill, misrepresentation and damage. Since goodwill is territorial, and no evidence of prior use has been filed by the Applicant, the Opponent must establish that it had the requisite goodwill with UK consumers as at the relevant date namely 8 September 2021. Goodwill arises out of trading activities which must be considered in the context of its revenue figures, promotional activity and customers in the UK. In light of the evidence filed as outlined earlier and the nature of the goods/services in question I am satisfied that the Opponent has a reasonably strong degree of goodwill in relation to women’s clothing and the retail services thereof as at the relevant date and that the Opponent’s signs are distinctive of that goodwill.

133. I note that the test for misrepresentation requires a substantial number of members of the public to be deceived and that this test differs to the one undertaken for a likelihood of confusion where it necessitates that the average consumer is confused. However, in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether in reality the difference between the two legal tests would produce different outcomes. In light of my assessment regarding the similarity between the marks overall of at least a medium degree and the similarity of the goods/services, I believe this to be the case here. The Opponent’s goods and retail services thereof and the Applicant’s retail services are all within the same field of activity such that I am satisfied that a substantial number of the Opponent’s customers or potential customers would be misled into selecting the

Applicant's services in the mistaken belief that they are the services of the Opponent or those of an undertaking economically linked to the Opponent.<sup>39</sup>

134. In so far as those applied for services related to advertising and business management I find the same to be true. There is sufficient nexus between these services for the same reasons as outlined previously in my assessment under section 5(3) that it is highly likely that consumers would believe that the undertakings are economically linked. Having found goodwill and misrepresentation it follows that damage would arise, leading to a reasonably foreseeable diversion of sales from the Opponent to the Applicant, resulting in the Opponent suffering financial loss.<sup>40</sup>

135. The opposition based upon section 5(4)(a) succeeds in its entirety.

### **Overall conclusion**

136. The invalidation action has failed and the Opponent may retain all the goods and services of its registration.

137. The opposition has succeeded in part under section 5(2)(b), and in its entirety under sections 5(3) and 5(4)(a). Subject to any successful appeal the application shall be refused.

### **Costs**

138. The Opponent/Proprietor has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I note that the Opponent/Proprietor was required to defend an invalidation action which did not succeed and I have taken these costs into account in the overall assessment. I award costs on the following basis:

Preparing an opposition and defence/counterstatement and considering the other side's pleadings:	£500
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Preparing evidence and considering

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<sup>39</sup> *Harrods Limited v Harrodian School Limited* [1996] RPC 697.

<sup>40</sup> *Bocacina Limited v Boca Cafés Limited, Dercio De Souza Junior, Malgorzata De Souza* [2013] EWHC 8090 (IPEC)

the Applicant's limited evidence:<sup>41</sup>  
£800

Drafting submissions in lieu of hearing: £500

Official fee: £200

**Total £2,000**

139. I order The Luxury Closet Inc. to pay Closet Clothing Co. Ltd. the sum of £2,000 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 16<sup>th</sup> day of October 2023

Leisa Davies

For the Registrar

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<sup>41</sup> I have taken into account that the additional evidence filed by Ms Tate did not assist me in coming to this decision which has been reflected in the award of costs given.

## **Annex of Opponent/Proprietor's goods and services**

### **First earlier mark's goods and services**

Class 3: Cosmetics, perfumery, essential oils, hair lotions; soaps; make-up; make-up remover; fragrances; toiletries and body care preparations; body cleaning and beauty care preparations; hair preparations and treatments; dentifrices; nail care preparations; skin care preparations; anti-perspirants; sunscreen cream; after-sun creams; tanning creams.

Class 18: Bags; hand bags; shoulder bags; trunks and travelling bags; purses; wallets; tote bags, canvas shopping bags, leather and imitation leather bags, backpacks, book bags, sports bags, bum bags, wallets, purses, cosmetic bags sold empty, make-up bags sold empty, evening bags, weekend bags, athletics bags, travelling bags, clutch bags, beach bags.

Class 25: Clothing, footwear, headgear.

Class 35: The bringing together, for the benefit of others, of a variety of goods, namely, cosmetics, perfumery, essential oils, hair lotions, soaps, make-up, make-up remover, fragrances, toiletries and body care preparations, body cleaning preparations and beauty care preparations, hair preparations and hair treatments, dentifrices, nail care preparations, skin care preparations, anti-perspirants, sunscreen cream, after-sun creams, tanning creams, clothing, footwear, headgear, clothing accessories, belts, bags, tote bags, hand bags, shoulder bags, jewellery, costume jewellery, necklaces, bracelets, earrings and brooches, enabling customers to conveniently view and purchase those goods in retail stores, department stores, retail clothing stores, fashion boutiques, pop-up shops, by mail order retail services, by wholesale retail services, by means of telecommunications or through an internet website; the bringing together, for the benefit of others, of a variety of goods, namely, cosmetics, perfumery, essential oils, hair lotions, soaps, make-up, make-up remover, fragrances, toiletries and body care preparations, body cleaning preparations and beauty care preparations, hair preparations and hair

treatments, dentifrices, nail care preparations, skin care preparations, anti-perspirants, sunscreen cream, after-sun creams, tanning creams, clothing, footwear, headgear, clothing accessories, belts, bags, tote bags, hand bags, shoulder bags, jewellery, costume jewellery, necklaces, bracelets, earrings and brooches; retail services, mail order retail services, wholesale retail services, and online retail services connected with cosmetics, perfumery, essential oils, hair lotions, soaps, make-up, make-up remover, fragrances, toiletries and body care preparations, body cleaning preparations and beauty care preparations, hair preparations and hair treatments, dentifrices, nail care preparations, skin care preparations, anti-perspirants, sunscreen cream, after-sun creams, tanning creams, clothing, footwear, headgear, clothing accessories, belts, bags, tote bags, hand bags, shoulder bags, jewellery, costume jewellery, necklaces, bracelets, earrings and brooches.

Class 42: Fashion design; design of clothing, footwear and headgear; design of bags.

### **Second earlier mark's goods and services**

Class 3: Cosmetics, perfumery, essential oils, hair lotions; lipstick; lipstick cases; sun blocking lipsticks [cosmetics]; lip balm [non-medicated]; lip cosmetics; nail cosmetics; nail paint [cosmetics]; nail varnish; nail varnish remover; soaps; make-up; make-up remover; fragrances; toiletries and body care preparations; body cleaning and beauty care preparations; hair preparations and treatments; dentifrices; nail care preparations; skin care preparations; anti-perspirants; sunscreen cream; after-sun creams; tanning creams.

Class 9: Sunglasses; boxes [cases] for sunglasses; cases for spectacles and sunglasses; chains for spectacles and sunglasses; clip-on sunglasses; cords for sunglasses; covers for sunglasses; fashion sunglasses; frames for spectacles and sunglasses.

Class 18: Bags; hand bags; shoulder bags; trunks and travelling bags; tote bags; leather and imitation leather bags; backpacks, book bags, sports bags, bum bags; evening bags, weekend bags, athletics bags, travelling bags, clutch bags, beach

bags; purses; wallets; credit-card holders; canvas shopping bags; garment carriers; labels for luggage; umbrellas; belts; cosmetic bags sold empty, make-up bags sold empty; make-up cases; make-up bags; beauty cases

Class 25: Clothing, footwear, headgear; face masks.

Class 35: The bringing together, for the benefit of others, of clothing, footwear, headgear, clothing accessories, cosmetics, perfumery, essential oils, hair lotions, lipstick, lipstick cases, sun blocking lipsticks [cosmetics], lip balm [non-medicated], lip cosmetics, nail cosmetics, nail paint [cosmetics], nail varnish, nail varnish remover, soaps, make-up, make-up remover, fragrances, toiletries and body care preparations, body cleaning and beauty care preparations, hair preparations and treatments, dentifrices, nail care preparations, skin care preparations, anti-perspirants, sunscreen cream, after-sun creams, tanning creams, sunglasses, boxes [cases] for sunglasses, cases for spectacles and sunglasses, chains for spectacles and sunglasses, clip-on sunglasses, cords for sunglasses, covers for sunglasses, fashion sunglasses, frames for spectacles and sunglasses, jewellery, costume jewellery, necklaces, bracelets, earrings and brooches, lip brushes, applicators for cosmetics, containers for cosmetics, holders for cosmetics, make-up brushes, bags, hand bags, shoulder bags, trunks and travelling bags, tote bags, leather and imitation leather bags, backpacks, book bags, sports bags, bum bags, evening bags, weekend bags, athletics bags, travelling bags, clutch bags, beach bags, purses, wallets, credit-card holders, canvas shopping bags, garment carriers, labels for luggage, umbrellas, belts, cosmetic bags sold empty, make-up bags sold empty, make-up cases, make-up bags, beauty cases, enabling customers to conveniently view and purchase those goods in retail stores, department stores, retail clothing stores, fashion boutiques, pop-up shops, by mail order retail services, wholesale retail services, by means of telecommunications or through an internet website; retail services, mail order retail services, wholesale retail services, and online retail services connected with clothing, footwear, headgear, clothing accessories, cosmetics, perfumery, essential oils, hair lotions, lipstick, lipstick cases, sun blocking lipsticks [cosmetics], lip balm [non-medicated], lip cosmetics, nail cosmetics, nail paint [cosmetics], nail varnish, nail varnish remover, soaps, make-

up, make-up remover, fragrances, toiletries and body care preparations, body cleaning and beauty care preparations, hair preparations and treatments, dentifrices, nail care preparations, skin care preparations, anti-perspirants, sunscreen cream, after-sun creams, tanning creams, sunglasses, boxes [cases] for sunglasses, cases for spectacles and sunglasses, chains for spectacles and sunglasses, clip-on sunglasses, cords for sunglasses, covers for sunglasses, fashion sunglasses, frames for spectacles and sunglasses, jewellery, costume jewellery, necklaces, bracelets, earrings and brooches, lip brushes, applicators for cosmetics, containers for cosmetics, holders for cosmetics, make-up brushes, bags, hand bags, shoulder bags, trunks and travelling bags, tote bags, leather and imitation leather bags, backpacks, book bags, sports bags, bum bags, evening bags, weekend bags, athletics bags, travelling bags, clutch bags, beach bags, purses, wallets, credit-card holders, canvas shopping bags, garment carriers, labels for luggage, umbrellas, belts, cosmetic bags sold empty, make-up bags sold empty, make-up cases, make-up bags, beauty cases, enabling customers to conveniently view and purchase those goods in retail stores, department stores, retail clothing stores, fashion boutiques, pop-up shops, by mail order retail services, wholesale retail services, by means of telecommunications or through an internet website; retail services provided via retail stores, department stores, retail clothing stores, fashion boutiques and pop-up shops connected with clothing, footwear, headgear, clothing accessories, cosmetics, perfumery, essential oils, hair lotions, lipstick, lipstick cases, sun blocking lipsticks [cosmetics], lip balm [non-medicated], lip cosmetics, nail cosmetics, nail paint [cosmetics], nail varnish, nail varnish remover, soaps, make-up, make-up remover, fragrances, toiletries and body care preparations, body cleaning and beauty care preparations, hair preparations and treatments, dentifrices, nail care preparations, skin care preparations, anti-perspirants, sunscreen cream, after-sun creams, tanning creams, sunglasses, boxes [cases] for sunglasses, cases for spectacles and sunglasses, chains for spectacles and sunglasses, clip-on sunglasses, cords for sunglasses, covers for sunglasses, fashion sunglasses, frames for spectacles and sunglasses, jewellery, costume jewellery, necklaces, bracelets, earrings and brooches, lip brushes, applicators for cosmetics, containers for cosmetics, holders for cosmetics, make-up brushes, bags, hand bags, shoulder bags, trunks and travelling bags, tote bags,

leather and imitation leather bags, backpacks, book bags, sports bags, bum bags, evening bags, weekend bags, athletics bags, travelling bags, clutch bags, beach bags, purses, wallets, credit-card holders, canvas shopping bags, garment carriers, labels for luggage, umbrellas, belts, cosmetic bags sold empty, make-up bags sold empty, make-up cases, make-up bags, beauty cases, enabling customers to conveniently view and purchase those goods in retail stores, department stores, retail clothing stores, fashion boutiques, pop-up shops, by mail order retail services, wholesale retail services, by means of telecommunications or through an internet website; loyalty scheme services.

Class 42: Fashion design; design of sunglasses; design of clothing, footwear and headgear; design of fashion accessories; design of jewellery; design of cosmetic products; design of bags, boxes and cases.