BL O/1116/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003775735

BY GHAYAS TRADING LTD

TO REGISTER THE TRADE MARK:

FASHIONEGO

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 436276

BY NHN GLOBAL, INC.

BACKGROUND AND PLEADINGS

1. On 8 April 2022, Ghayas Trading Ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 24 June 2022. The applicant seeks registration for the following goods:

Class 25 Clothing, footwear, headwear; articles of clothing; clothing; clothes; men's clothing; men's socks; men's and women's jackets, coats, trousers, vests; swim wear for gentlemen and ladies; women's clothing; women's outerclothing; jeans; denim jeans; blue jeans; polo shirts; four pack of polo shirts; polo sweaters; polo knit tops; polo neck jumpers; t-shirts; jumpers; cardigans; vests; jackets; fleeces; fleece jackets; fleece tops; fleece pullovers; trousers; corduroy trousers; trousers of leather; casual trousers; golf trousers; chino pants; underwear and nightwear; men's underwear; women's underwear; women's underclothing; undershirts; underwear; men's underwear; women's underwear; trunks [underwear]; briefs [underwear]; knitted underwear; articles of underclothing; footwear; headgear; headwear; parts of clothing, footwear and headgear; parts and fittings for all the aforesaid goods.

2. The application was opposed by NHN GLOBAL, INC. ("the opponent") on 16 September 2022. The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

3. Under sections 5(2)(b) and 5(3), the opponent relies upon the following trade mark:

FASHIONGO

International registration no. WO0000001431226
International registration date 27 August 2018
Designation date 25 March 2022.
Date of protection granted in UK 17 November 2022.

Relying upon all of the services for which it is registered, namely:

Class 35 Advertising services, namely, dissemination of advertising for others via a global computer network; wholesale store services connected with the sale of clothing and fashion accessories; providing consumer product information via a global computer network; computerized on-line ordering services featuring a wide variety of clothing and fashion accessories; providing a searchable database in the field of business information available via a global computer network; providing a searchable on-line advertising guide featuring the goods of others, namely, clothing and fashion accessories; automated and computerized trading of goods of others featuring clothing and fashion accessories provided over a global communication information network.

4. The opponent's IR is represented on the UK register in the above format. However, it is represented in the Notice of Opposition (Form TM7) as a word-only mark. The international register records "The applicant declares that they wish the mark to be considered as a mark in standard characters (only if word mark)". It must, therefore, be a word-only mark.

5. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion as the IR and mark are highly similar, and the goods and services are highly similar.

6. Under section 5(3), the opponent claims to have acquired a reputation internationally for all of the services for which the IR is registered. It claims that use of the applicant's mark would therefore take unfair advantage of the opponent's reputation, and will cause detriment to the opponent's reputation and the distinctive character of its IR as consumers will believe that the goods provided under the applicant's mark emanate from the opponent, or that the applicant's goods are associated with, or endorsed by, the opponent.

7. Under section 5(4)(a), the opponent relies upon the sign **FASHIONGO** which it claims to have used throughout the UK since 7 February 2002 for the above class 35 services.

8. The applicant filed a counterstatement denying the claims made.

9. The opponent is represented by K&L Gates LLP and the applicant is represented by Stobbs. Neither party requested a hearing, however, the opponent filed evidence in chief and submissions in lieu of a hearing. I make this decision having taken full account of all the papers.

RELEVANCE OF EU LAW

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

EVIDENCE

11. The opponent's evidence consists of the witness statement of Christine Chung dated 22 February 2023. Ms Chung is General Counsel for the opponent, a position which she has held since 2 April 2018. Ms Chung's statement was accompanied by 6 exhibits (CC1-CC6).

12. Whilst I do not propose to summarise it here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

DECISION

Section 5(2)(b)

13. Section 5(2)(b) reads 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."

14. The IR had not completed its registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at section 6A of the Act do not apply. The opponent may rely on all of the services it has identified without demonstrating that it has used the IR.

15. In making this decision, I bear in mind the following principles 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 great degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods and services

16. The competing goods and services are as follows:

Opponent's services	**Applicant's goods**
Class 35 Advertising services, namely, dissemination of advertising for others via a global computer network; wholesale store services connected with the sale of clothing and fashion accessories; providing consumer product information via a global computer network; computerized on-line ordering services featuring a wide variety of clothing and fashion accessories; providing a searchable database in the field of business information available via a global computer network; providing a searchable on-line advertising guide featuring the goods of others, namely, clothing and fashion accessories; automated and computerized trading of goods of others featuring clothing and fashion accessories provided over a global communication information network.	Class 25 Clothing, footwear, headwear; articles of clothing; clothing; clothes; men's clothing; men's socks; men's and women's jackets, coats, trousers, vests; swim wear for gentlemen and ladies; women's clothing; women's outerclothing; jeans; denim jeans; blue jeans; polo shirts; four pack of polo shirts; polo sweaters; polo knit tops; polo neck jumpers; t-shirts; jumpers; cardigans; vests; jackets; fleeces; fleece jackets; fleece tops; fleece pullovers; trousers; corduroy trousers; trousers of leather; casual trousers; golf trousers; chino pants; underwear and nightwear; men's underwear; women's underwear; women's underclothing; undershirts; underwear; men's underwear; women's underwear; trunks [underwear]; briefs [underwear]; knitted underwear; articles of underclothing; footwear; headgear; headwear; parts of clothing, footwear and headgear; parts and fittings for all the aforesaid goods.

17. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the

Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

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

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

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

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

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

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

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

19. 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 the responsibility for those goods lies with the same undertaking."

20. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between 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 Amalia 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." 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."

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."

21. *In Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court ("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.

22. 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 v goods. He stated (at paragraph 9 of his judgment):

> "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 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.

23. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*[1], and *Assembled Investments (Proprietary) Ltd v. OHIM* Case T-105/05[2], upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd,* Case C-398/07P, Mr Hobbs concluded:

> (i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

[1] Case C-411/13P
[2] paragraphs [30] to [35] of the judgment

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court'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).

Clothing, […] headwear; articles of clothing; clothing; clothes; men's clothing; men's socks; men's and women's jackets, coats, trousers, vests; swim wear for gentlemen and ladies; women's clothing; women's outerclothing; jeans; denim jeans; blue jeans; polo shirts; four pack of polo shirts; polo sweaters; polo knit tops; polo neck jumpers; t-shirts; jumpers; cardigans; vests; jackets; fleeces; fleece jackets; fleece tops; fleece pullovers; trousers; corduroy trousers; trousers of leather; casual trousers; golf trousers; chino pants; underwear and nightwear; men's underwear; women's underwear; women's underclothing; undershirts; underwear; men's underwear; women's underwear; trunks [underwear]; briefs [underwear]; knitted underwear; articles of underclothing; headgear; headwear.

24. As highlighted in *Oakley* above, 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. In this case, the opponent's "wholesale store services connected with the sale of clothing and fashion accessories" relate to the sale of the applicant's above clothing and headwear. They overlap in trade channels and user, and are complementary. Applying the guidance from *Oakley,* I find that the goods and services are similar to a medium degree.

Footwear.

25. “Fashion accessories” is a broad category which I consider would encompass many terms, including footwear. On this basis the same comparison applies in paragraph 24 above, and the applicant’s “footwear” and the opponent’s “wholesale store services connected with the sale of clothing and fashion accessories” are similar to a medium degree. However, if the term footwear is not encompassed by the term “fashion accessories”, I still consider that wholesale stores which sell clothing would also sell footwear, and therefore the goods and services would still overlap in trade channels. I also consider that there would be an overlap in user. Therefore I consider that the goods and services are similar to at least between a low and medium degree.

Parts of clothing, footwear and headgear; parts and fittings for all the [applicant’s] aforesaid goods.

26. I consider that the opponent’s best case comparison to the applicant’s above goods are to its “wholesale store services connected with the sale of clothing and fashion accessories”. However, I still consider that the goods and services are dissimilar.

27. Firstly, and for the sake of completeness, I consider that clothing and fashion accessory goods would not include parts of clothing, footwear and headgear. Clearly, these are distinct goods.

28. On this basis, I do not consider that the applicant’s parts of clothing, footwear and headgear goods are similar to the opponent’s wholesale services for clothing and accessories. The goods and services clearly do not overlap in nature, method of use or purpose. The opponent’s services would be provided by a wholesale undertaking which provides clothing and accessories, which would then go straight onto being sold in retail outlets. I accept that the applicant’s goods may also be sold from a wholesaler, but I consider that they would be sold by specialist wholesalers selling parts of clothing, footwear and headgear which would be purchased by an undertaking which put the parts together to make the finished article. These goods would then be sold onto a retail store which would sell the goods to the general public. Consequently, I do not

consider that there is an overlap in trade channels or user. I also note that I have no evidence before me to indicate that such an overlap exists. The goods and services are clearly not in competition nor complementary. Taking all of the above into account, the goods and services are dissimilar.

29. It is a prerequisite of section 5(2)(b) that the goods and services be identical or at least similar. The opposition will, therefore, fail in respect of the goods that I have found to be dissimilar.[3]

30. The opposition under section 5(2)(b) fails for the following goods:

Class 25 Parts of clothing, footwear and headgear; parts and fittings for clothing, footwear, headwear, articles of clothing, clothing, clothes, men's clothing, men's socks, men's and women's jackets, coats, trousers, vests, swim wear for gentlemen and ladies, women's clothing, women's outerclothing, jeans, denim jeans, blue jeans, polo shirts, four pack of polo shirts, polo sweaters, polo knit tops, polo neck jumpers, t-shirts, jumpers, cardigans, vests, jackets, fleeces, fleece jackets, fleece tops, fleece pullovers, trousers, corduroy trousers, trousers of leather, casual trousers, golf trousers, chino pants, underwear and nightwear, men's underwear, women's underwear, women's underclothing, undershirts, underwear, men's underwear, women's underwear, trunks [underwear], briefs [underwear], knitted underwear, articles of underclothing, footwear, headgear and headwear.

The average consumer and the nature of the purchasing act

31. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc,*

[3] *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

32. The average consumer for the goods and services will be members of the general public and businesses. The cost of purchase is likely to vary, and the goods and services will be purchased relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process for the goods, such as materials used, cut, aesthetic appearance and durability. For the services, the average consumer is likely to take into consideration the location, ease of access and availability/the range of products on offer. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods and services.

33. The goods are likely to be obtained by self-selection from the shelves of a clothing retail outlet, online or catalogue equivalent. This means that visual considerations will be the most significant.[4] The services are most likely to be selected from websites and following sight of signs on a physical outlet. Alternatively, the goods and services may be purchased following the perusal of advertisements. Visual considerations are, therefore, likely to dominate the selection process.

34. However, I do not discount that there will also be an aural component to the purchase of the goods and services, as advice may be sought from a sales assistant or representative and word-of-mouth recommendations may play a part.

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

Comparison of the trade marks

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

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

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

37. The respective trade marks are shown below:

Opponent's IR	Applicant's trade mark
FASHIONGO	**FASHIONEGO**

38. The opponent's IR consists of the conjoined words "FASHION" and "GO" which creates the word "FASHIONGO", written in a capitalised typeface. There are no other elements to contribute to the overall impression which lies in the conjoined word itself.

39. The applicant's mark consists of the conjoined words "FASHION" and "EGO" which creates the word "FASHIONEGO", written in a capitalised typeface. There are no other elements to contribute to the overall impression which lies in the conjoined word itself.

40. Visually, the IR and mark overlap in the letters F, A, S, H, I, O and N at the beginning of the marks, which the average consumer tends to pay more attention to.[5] They also overlap in the letters G and O at the end of the marks. These act as visual points of similarity. However, the applicant's mark contains the letter E in the middle of the mark, which is absent from the opponent's IR. This acts as a visual point of difference. However, given that the additional letter appears in the middle of the mark, it will be less noticeable to the average consumer. Therefore, taking all of the above into account, I consider that the opponent's IR and applicant's mark is visually similar to a high degree.

41. Aurally, I consider that the opponent's IR is likely to be pronounced as FA-SHON-GO. I consider that the applicant's mark is likely to be pronounced as FA-SHON-EE-GO. Consequently, the beginning and the end of the IR and the applicant's mark aurally overlap, with the only difference in pronunciation being the "EE" syllable in the applicant's mark. I therefore consider that they are aurally similar to a high degree.

42. Conceptually, as highlighted above, the IR and applicant's mark are both presented as one word, but contain the ordinary dictionary word FASHION at the beginning of them. The word FASHION denotes the concept of styles of clothing, which is descriptive of the parties clothing goods and services. I note that the opponent's IR also ends with the word GO which is a recognisable ordinary dictionary word.

43. In its submissions in lieu, the opponent states that the addition of the "E" at the beginning of the word "GO" in the applicant's mark is a well-known abbreviation of something done over the internet, such as an "e-shop, e-mark and e-book". However, I disagree with this submission. I note that the examples provided by the opponent are all presented with a lower-case letter "e" followed by a dash and then a word. In the

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

applicant's mark, the letter E is capitalised, and there is no dash present to separate the letter E from GO, and therefore it is presented as one; EGO. I also note that EGO is an ordinary dictionary word which denotes the concept of someone's sense of worth.

44. Taking all of the above into account, I consider that the IR and applicant's mark are conceptually similar to at least a medium degree.

Distinctive character of the earlier trade mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, 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 promotion of 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)."

46. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic

of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

47. I will begin by assessing the inherent distinctive character of the opponent's IR. As highlighted above, the conjoined word FASHIONGO is composed of two ordinary dictionary words: FASHION and GO. The opponent submits that the terms FASHION and GO together "conceptualises the idea of fast moving fashion and the nature of fashion sales 'to go'".

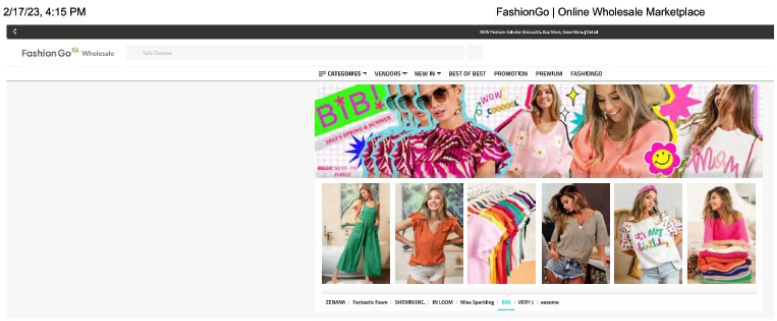
48. I consider that in the context of the opponent's "wholesale store services connected with the sale of clothing and fashion accessories" that the concept of FASHIONGO will be recognised as either "the place to go for fashion", or as the opponent submits, fashion "to go". It is therefore, at best, highly allusive of the opponent's services. However, I consider that as the words "fashion" and "go" are not usually used together by themselves, and as the words are presented conjoined (to create one word), this adds to the distinctiveness of the IR. However, I still consider that it is inherently distinctive to a low degree.

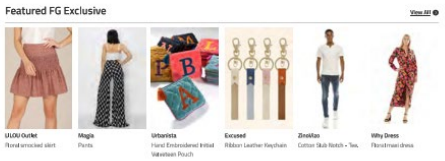
49. Although the opponent has not specifically pleaded enhanced distinctiveness, for the sake of completeness, I will make a finding as to whether I consider the evidence sufficient to demonstrate enhanced distinctiveness.

50. I note the following from the opponent's evidence:

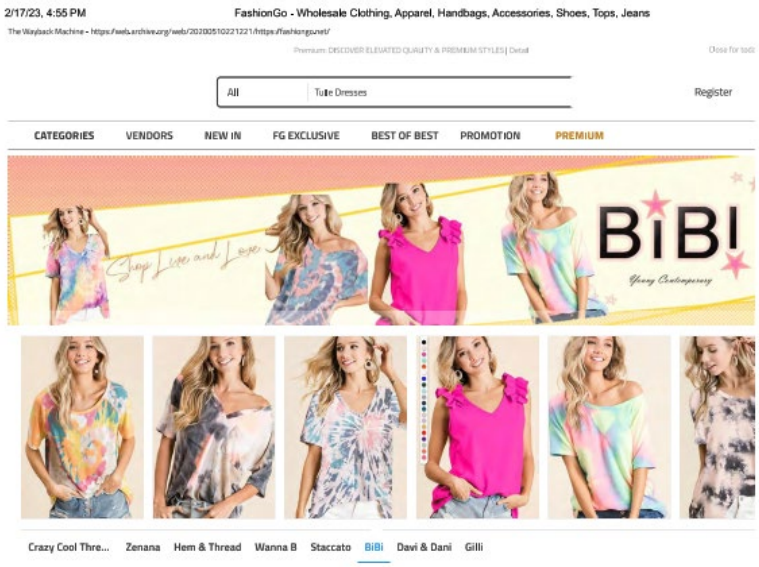
a) "FashionGo was established in 2002 and it is a leading business to business wholesale e-commerce marketplace that enables users to buy and sell" the latest fashion. The platform operates on a global basis and has 2,050 wholesalers and over 740,000 buyers.

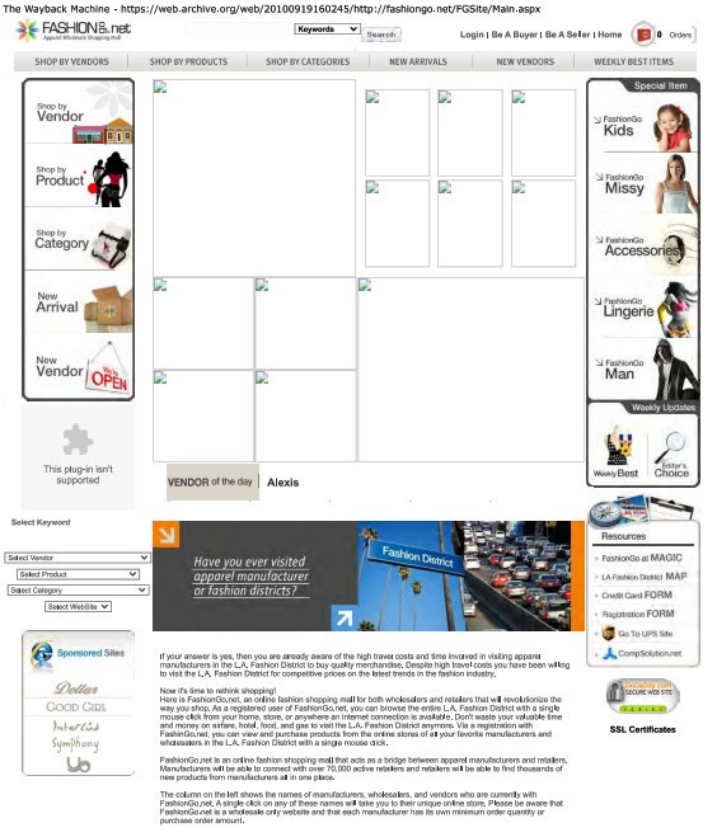
b) Its website www.fashiongo.net "operates on a global basis" including the UK. **Exhibits CC1** to **CC4** contain the following screenshots of the opponent's website dated 17 February 2023, 6 March 2003, 19 September 2010 and 10 May 2020 in Ms Chung's witness statement:


2/17/23, 4:15 PM
FashionGo | Online Wholesale Marketplace
Fashion Go Wholesale
BiBi

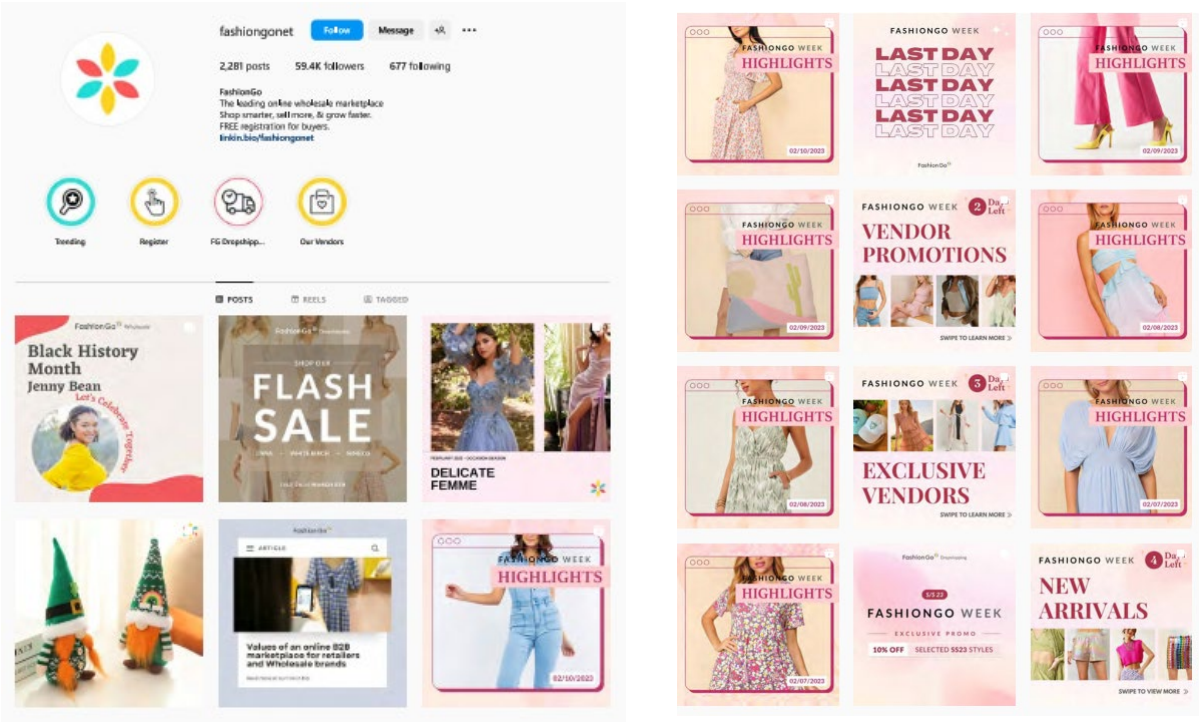

Featured FG Exclusive


2/17/23, 4:47 PM
Wayback Machine
The Wayback Machine - https://web.archive.org/web/20030306170805/http://www.fashiongo.net:80/
Home | Policy | Terms of Condition | Search | About Us | Contact Us | Sign Out
ESPAÑOL
MARKETS
CATEGORY
STYLE
BODYSIZE
Event Schedule
Admin Page
e-mail
Password
Log-In
Registration
Forgot Password?
This plug-in isn't supported
Welcome to fashiongo.net, a fashion marketplace and information center!
This site is exclusively designed for business and professionals that are involved with the fashion and fashion related industries.
MAGIC, Satellite Shows Weather East Coast Delays, Cautious Buying
William B. Contractors Seek Payment in Excess of $50,000
Holiday Online: Short Shopping Season Boosts We Sales…
Can Bebe Stores Fashion a Comeback?
This site is optimized for IE 5 or Flash Player
© 2003, FashionGo. All Rights Reserved. Designed by CompSolution.


2/17/23, 4:55 PM
FashionGo - Wholesale Clothing, Apparel, Handbags, Accessories, Shoes, Tops, Jeans
All
Tulle Dresses
Register
CATEGORIES
VENDORS
NEW IN
FG EXCLUSIVE
BEST OF BEST
PROMOTION
PREMIUM
BiBi
Crazy Cool Thre...
Zenana
Hem & Thread
Wanna B
Staccato
BiBi
Davi & Dani
Gilli



c) **Exhibit CC5** contains the following screenshots of the opponent's Instagram dated 17 February 2023 "which at the time had over 59,000 followers":



d) **Exhibit CC6** contains the following screenshot from the opponent's Facebook page dated 17 February 2023 "which at the time had over 16,000 followers":

e) Lastly, in her witness statement, Ms Chung states that "the UK presence of the FashionGo business and reputation of the brand in the UK market is evidenced by: the first UK buyer's account was registered on March 7, 2004 on FashionGo. As of November 2022, the total number of UK buyers registered on the FashionGo site is 6,176 and the total amount of orders shipped to UK buyers is about US$5,000,000."

51. The relevant market for assessing enhanced distinctiveness is the UK market only. In this instance, the only evidence I have which pertains to the UK is contained in paragraph (e) above. However, I also note that this evidence provides the number of buyers and orders "as of November 2022" which falls after the relevant date (8 April 2022). On this basis, I have no way of knowing what proportion of these figures fell prior to the relevant date. I also do not have any evidence of advertising figures pertaining to the UK or market share. Therefore, taking all of the above into account, I do not consider the evidence sufficient to establish enhanced distinctiveness.

Likelihood of confusion

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

53. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the IR and mark to be visually and aurally similar to a high degree.
- I have found the IR and mark to be conceptually similar to at least a medium degree.

- I have found the opponent's IR to be inherently distinctive to a low degree.
- I have identified the average consumer to be members of the general public and businesses who will select the goods and services primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods and services.
- I have the parties' goods and services to be similar to a medium degree, or to at least between a low and medium degree.

54. I bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion.

55. Taking all of the above into account, considering the principle of imperfect recollection, and bearing in mind that both the opponent's IR and the applicant's mark starts with letters F, A, S, H, I, O and N and end in the letters G and O, (resulting in the applicant's mark sharing 9 out of its 10 letters with the opponent's IR), I consider that there is a likelihood of direct confusion. The only differing element between the IR and mark is the letter E in the middle of the applicant's mark which would be easily overlooked by the average consumer. I therefore consider that the IR and applicant's mark will be mistakenly recalled or misremembered as each other given the high degree of visual similarity between the marks and the predominantly visual purchasing process. Even where aural considerations play a greater role, the high degree of aural similarity between the IR and the applicant's mark will have the same result. Consequently, I consider that there is a likelihood of direct confusion, even where there is only between a low and medium degree of similarity between the goods and services, due to the effect of the interdependency principle.

56. The opposition based upon section 5(2)(b) of the Act succeeds in relation to the following goods only:

Class 25 Clothing, footwear, headwear; articles of clothing; clothing; clothes; men's clothing; men's socks; men's and women's jackets, coats,

trousers, vests; swim wear for gentlemen and ladies; women's clothing; women's outerclothing; jeans; denim jeans; blue jeans; polo shirts; four pack of polo shirts; polo sweaters; polo knit tops; polo neck jumpers; t-shirts; jumpers; cardigans; vests; jackets; fleeces; fleece jackets; fleece tops; fleece pullovers; trousers; corduroy trousers; trousers of leather; casual trousers; golf trousers; chino pants; underwear and nightwear; men's underwear; women's underwear; women's underclothing; undershirts; underwear; men's underwear; women's underwear; trunks [underwear]; briefs [underwear]; knitted underwear; articles of underclothing; footwear; headgear; headwear.

Section 5(3)

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

> "5(3) 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 repute of the earlier trade mark."

58. Section 5(3A) of the Act states:

> "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."

59. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*

and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

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

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

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

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

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

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

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

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

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

60. I can deal with this ground relatively swiftly.

61. Earlier in my decision, I found that the distinctive character of the IR had not been enhanced through use. I recognise that reputation is not the same as enhanced distinctive character, but the same factors are to be taken into account in both assessments. Therefore, the evidence is, for the reasons set out above in relation to enhanced distinctiveness, insufficient to establish a reputation in the UK. Consequently, the opposition based upon section 5(3) falls at the first hurdle.

62. The opposition based upon section 5(3) of the Act is dismissed.

Section 5(4)(a)

63. 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".

64. 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."

65. Again, this ground can be dealt with relatively swiftly. 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 April 2022.

66. The burden of proving a protectable goodwill is on the opponent. I have summarised the opponent's evidence in paragraphs 50 and 51 above. I note that the only significant evidence of "trading activities" provided is the total number of buyers

registered on the FashionGo site amounting to it 6,176 and the total amount of orders shipped to UK buyers amounting to about US$5,000,000. However, these figures are dated "as of November 2022", and therefore falls after the relevant date. Consequently, I do not have any way of knowing what proportion of these sales figures, or user numbers, fell prior to the relevant date. I also bear in mind that I have no information regarding overall advertising and marketing expenditure, nor have I been provided with any market share figures.

67. I note that goodwill arises as a result of trading activities. Based on the evidence above, I do not have any figures to demonstrate that to what extent the opponent has been trading prior to the relevant date. The opponent's evidence of social media screenshots which are also dated after the relevant date do not assist. Whilst there are 4 screenshots of the opponent's FASHIONGO website which are dated before 8 April 2022, these also do not assist in demonstrating the extent of the opponent's trade in the UK.

68. I bear in mind that small businesses may still be protected by the law of passing off. However, the law of passing off does not protect a goodwill of trivial extent.[6] As Mr Thomas Mitcheson Q.C., sitting as the Appointed Person, concluded in *Smart Planet Technologies, Inc. v Rajinda Sharma*:[7]

> "…a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

69. This is all the more so in a case, such as this one, where the sign relied upon is of below average distinctiveness.

70. Bearing this in mind, as well as the deficiencies in the opponent's evidence, I am unable to find, on the balance of probabilities, that the opponent had established a

[6] *Hart v Relentless Records* [2002] EWHC 1984 (Ch)
[7] BL O/304/20

more-than-trivial level of goodwill under the FASHIONGO sign in the UK at the relevant date.

71. The opposition based upon section 5(4)(a) of the Act is dismissed.

CONCLUSION

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

Class 25 Clothing, footwear, headwear; articles of clothing; clothing; clothes; men's clothing; men's socks; men's and women's jackets, coats, trousers, vests; swim wear for gentlemen and ladies; women's clothing; women's outerclothing; jeans; denim jeans; blue jeans; polo shirts; four pack of polo shirts; polo sweaters; polo knit tops; polo neck jumpers; t-shirts; jumpers; cardigans; vests; jackets; fleeces; fleece jackets; fleece tops; fleece pullovers; trousers; corduroy trousers; trousers of leather; casual trousers; golf trousers; chino pants; underwear and nightwear; men's underwear; women's underwear; women's underclothing; undershirts; underwear; men's underwear; women's underwear; trunks [underwear]; briefs [underwear]; knitted underwear; articles of underclothing; footwear; headgear; headwear.

73. The application can proceed to registration in respect of the following goods, for which the opposition has been unsuccessful under section 5(2)(b):

Class 25 Parts of clothing, footwear and headgear; parts and fittings for clothing, footwear, headwear, articles of clothing, clothing, clothes, men's clothing, men's socks, men's and women's jackets, coats, trousers, vests, swim wear for gentlemen and ladies, women's clothing, women's outerclothing, jeans, denim jeans, blue jeans, polo shirts, four pack of polo shirts, polo sweaters, polo knit tops, polo neck jumpers, t-shirts, jumpers, cardigans, vests, jackets, fleeces, fleece jackets, fleece tops, fleece pullovers, trousers, corduroy trousers, trousers of leather, casual

trousers, golf trousers, chino pants, underwear and nightwear, men's underwear, women's underwear, women's underclothing, undershirts, underwear, men's underwear, women's underwear, trunks [underwear], briefs [underwear], knitted underwear, articles of underclothing, footwear, headgear and headwear.

COSTS

74. The opponent has enjoyed a greater degree of success in the opposition and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£850** as a contribution towards the costs of the proceedings.

75. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£200
Preparing and filing evidence	£100[8]
Preparing and filling written submissions and submissions in lieu of a hearing	£350
Official Fee	£200
Total	**£850**

76. I therefore order Ghayas Trading Ltd to pay NHN GLOBAL, INC. the sum of £850. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

[8] The pay award for evidence is lower on the scale due to the opposition firstly being partially successful, and secondly, the evidence provided was limited and unhelpful in terms of establishing enhanced distinctiveness, reputation and goodwill.

Dated this 24th day of November 2023

L FAYTER

For the Registrar