

O/461/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003366151

BY ROHINI AKOSA

TO REGISTER THE FOLLOWING MARK:



IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 416153

BY A & H SPORTSWEAR CO., INC.

## BACKGROUND AND PLEADINGS

1. On 10 January 2019, Rohini Akosa (“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 1 February 2019 and registration is sought for the following goods:

Class 25      Clothing.

2. On 30 April 2019, A & H Sportswear Co., Inc. (“the opponent”) opposed the application based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). For the purposes of its opposition based upon section 5(2)(b), the opponent relies on the following trade marks:

MIRACLESUIT

*Miraclesuit*

(series of 2)

UK registration no. 2019409

Filing date 3 May 1995; registration date 23 August 1996

Relying upon all goods for which the earlier mark is registered, namely:

Class 25      Underwear; hosiery; swimwear.

(“the First Earlier Registration”)

MSP BY MIRACLESUIT

UK registration no. 3046478

Filing date 12 March 2014; registration date 19 September 2014

Relying upon all goods for which the earlier mark is registered, namely:

Class 25      Clothing; body suits; bottoms; capris; cycling shorts; jackets; leggings; pants; swimwear; t-shirts; tank tops; tops; unitards.

(“the Second Earlier Registration”)

MIRACLE TIGHTS

EUTM registration no. 12666954

Filing date 6 March 2014; registration date 11 November 2014

Relying upon all goods for which the earlier mark is registered, namely:

Class 25 Hosiery.

(“the Third Earlier Registration”)

3. The opponent claims that there is a likelihood of confusion because the parties’ respective marks are similar, the goods are identical or similar.

4. For the opposition based upon section 5(3) of the Act, the opponent relies upon the First Earlier Registration only. The opponent claims a reputation in relation to “swimwear; underwear”. The opponent claims that use of the applicant’s mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the First Earlier Registration.

5. For the opposition based upon section 5(4)(a), the opponent relies upon the sign **MIRACLESUIT**. The opponent claims to have used the sign throughout the UK since 31 October 2004 in relation to “underwear; swimwear”.

6. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of the First Earlier Registration.

7. The opponent is represented by Wildbore & Gibbons and the applicant is unrepresented. Only the opponent filed evidence. Neither party requested a hearing and only the opponent filed written submissions in lieu of attendance. This decision is taken following a careful perusal of the papers.

## **EVIDENCE**

8. The opponent filed evidence in the form of the witness statement of Mark Waldman dated 13 December 2019, which is accompanied by 12 exhibits. Mr Waldman is the President of the opponent, a position he has held since 1992. I have considered Mr

Waldman's evidence in its entirety and will summarise the relevant parts of it below, where appropriate.

## **DECISION**

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

9. Section 5(2)(b) of the Act 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.”

10. By virtue of their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the First Earlier Registration had completed its registration process more than 5 years before the application date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act. The Second and Third Earlier Registrations had not been registered for more than 5 years and are not, therefore, subject to proof of use. The opponent can, therefore, rely upon all of the goods identified in relation to those marks.

### **Proof of use**

11. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period .

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) [...]

(5A) [...]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

12. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

13. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the First Earlier Registration is the 5-year period ending with the date of the application in issue i.e. 11 January 2014 to 10 January 2019.

14. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009]

ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter:

*Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

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

16. There is evidence of the First Earlier Registration being used as registered. There is also evidence of the word MIRACLESUIT being used in slightly different fonts from those in which the First Earlier Registration is registered. However, I do not consider that the slight changes to the stylisation of the word prevent this from being use of the mark as registered. I also note that there is evidence of the mark “MIRACLESUIT BY SWIM SHAPER” being used. This is use of the First Earlier Registration, without the stylisation and with the addition of the words “BY SWIM SHAPER”. As already stated, I do not consider that the lack of stylisation prevents this from being acceptable use of the marks and I also consider that use in combination with the words “BY SWIM SHAPER” will not prevent the mark from continuing to indicate the origin of the goods.<sup>1</sup> This is use upon which the opponent can rely.

17. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>2</sup>

18. Mr Waldman explains that the First Earlier Registration has been used in the UK since October 2004 for a range of shapewear, including swimwear and underwear. Mr Waldman provides the following sales figures for MIRACLESUIT branded products from the opponent’s licensee to the opponent’s main UK distributor during the relevant period:

|      |          |      |                       |
|------|----------|------|-----------------------|
| 2014 | £274,000 | 2015 | £398,000              |
| 2016 | £809,070 | 2017 | £866,464              |
| 2018 | £914,628 | 2019 | £820,427 <sup>3</sup> |

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<sup>1</sup> *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

<sup>2</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

<sup>3</sup> Witness statement of Mark Waldman, para. 13

19. The fact that these represent repeat orders suggests that there have been sales from the distributor to the end users. A selection of invoices has been provided dated between April 2014 and July 2017, which confirm that during that period over 7,000 units have been sold.<sup>4</sup> All of the invoices confirm that the goods were shipped to a UK-based address and all invoices display the marks relied upon. Printouts dated August 2017 from various websites have been provided which show the opponent's goods available for sale under the First Earlier Registration.<sup>5</sup> Most of these are ".co.uk" websites so are clearly aimed at the UK market. However, even where this is not the case, prices are shown in GBP and are clearly therefore intended to be for the UK market. These show a range of women's swimwear and underwear products available for purchase. The opponent's swimwear and underwear products for women have also been advertised in various publications during the relevant period including *Woman and Home* (2016).<sup>6</sup> Taking the evidence as a whole into account, I am satisfied that the opponent has demonstrated genuine use of the First Earlier Mark during the relevant period.

20. I must now consider whether, or the extent to which, the evidence shows use of the First Earlier Registration in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

21. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

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<sup>4</sup> Exhibit MW12

<sup>5</sup> Exhibit MW2

<sup>6</sup> Exhibit MW3

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been

used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

22. The statement of use completed by the opponent in its Notice of opposition confirms that there has been use for “underwear” and “swimwear”. However, I note that the First Earlier Registration is also registered for “hosiery”. For the avoidance of doubt, I do not consider there to be sufficient evidence to demonstrate proof of use in relation to “hosiery” in any event. There is no evidence of the opponent selling swimwear or underwear for men or children under the First Earlier Registration. All of the evidence filed relates to goods aimed at the female market. Consequently, I consider a fair specification to be:

Class 25 Underwear for women; swimwear for women.

### **Section 5(2)(b) – case law**

23. 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.

## Comparison of goods

24. In light of my findings above, the competing goods are as follows:

| Opponent's goods   | Applicant's goods            |
|--|------------------------------|
| <b>First Earlier Registration</b><br><u>Class 25</u><br>Underwear for women; swimwear for women.   | <u>Class 25</u><br>Clothing. |
| <b>Second Earlier Registration</b><br><u>Class 25</u><br>Clothing; body suits; bottoms; capris; cycling shorts; jackets; leggings; pants; swimwear; t-shirts; tank tops; tops; unitards. |                              |
| <b>Third Earlier Registration</b><br><u>Class 25</u><br>Hosiery.   |                              |

25. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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 for Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

26. In its written submissions in lieu, the opponent states:

“20. The term “Clothing” in the application is the broad class heading encompassing all of the coverage of the Opponent’s earlier registrations. The competing goods are therefore to be regarded as identical.”

27. I agree with the opponent that all of the goods in the opponent’s specifications are types of clothing. They will, therefore, fall within the broader category of “clothing” in the applicant’s specification. These goods are, therefore, identical on the principle outlined in *Meric*. Even where the applicant’s specification would cover a broader range of clothing than that covered by the opponent’s specification, there will be overlap in trade channels, use, user, method of use and nature. The goods will, therefore, be highly similar.

### **The average consumer and the nature of the purchasing act**

28. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

29. The average consumer for the goods will be a member of the general public. The cost of the purchase is likely to be relatively low and the goods will be purchased reasonably frequently. However, various factors are still likely to be taken into account during the purchasing process, such as materials used, cut, aesthetic appearance and

durability. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

30. The goods are likely to be obtained by self-selection from the shelves of a retail outlet or online or catalogue equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.

### **Comparison of trade marks**

31. 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 Court of Justice of the European Union (“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.”

32. 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.

33. The respective trade marks are shown below:

| Opponent's trade marks   | Applicant's trade mark   |
|--|--|
| <p data-bbox="300 324 703 369">MIRACLESUIT</p> <p data-bbox="295 414 703 492"><i>Miraclesuit</i></p> <p data-bbox="408 519 580 555">(series of 2)</p> <p data-bbox="284 573 707 609">(the First Earlier Registration)</p><br><p data-bbox="320 685 671 719">MSP BY MIRACLESUIT</p> <p data-bbox="261 739 727 775">(the Second Earlier Registration)</p><br><p data-bbox="357 851 632 884">MIRACLE TIGHTS</p> <p data-bbox="279 904 710 940">(the Third Earlier Registration)</p> |  |

### Overall Impression

34. The First Earlier Registration consists of a series of two marks, being stylised versions of the word MIRACLESUIT. This will be identified as the conjoined words MIRACLE and SUIT. The word SUIT is likely to be seen as descriptive and the word MIRACLE is likely to be seen as laudatory. The stylisation is minimal and it is the word itself that plays the greater role in the overall impression, with the word MIRACLE being the more distinctive element.

35. The Second Earlier Registration consists of the words MSP BY MIRACLESUIT. Again, I note that the word MIRACLE will be seen as laudatory and the word SUIT will be seen as descriptive. In my view, the overall impression lies in the combination of all of these words as a whole.

36. The Third Earlier Registration consists of the words MIRACLE TIGHTS. The word TIGHTS will be seen as descriptive and the word MIRACLE is likely to be viewed as laudatory. I consider that the word MIRACLE plays the greater role in the overall impression, with the word TIGHTS playing a lesser role.

37. The applicant's mark consists of the letters M-RACLE in a cursive title case black font. The letters M and RACLE are divided by a leaf device. The word DRESS is presented in pale grey lower case font beneath the letters M-RACLE. A green outline is used as a border around these other elements. The word DRESS will clearly be seen as descriptive of the goods. In my view, the combination of the letters M-RACLE and the leaf device play the greater role in the overall impression, with the border, stylisation and the word DRESS all playing a lesser role.

### Visual Comparison

#### *The First Earlier Registration and the Applicant's Mark*

38. The First Earlier Registration and the Applicant's Mark coincide in the presence of the letters M-RACLE. They differ in that the letter I appears between these letters in the First Earlier Registration and a green leaf device appears between them in the applicant's mark. They also differ in the presence of the word SUIT in the First Earlier Registration and the word DRESS in the applicant's mark. I also note the border in the applicant's mark which is absent from the First Earlier Registration. Taking all of this into account, I consider the marks to be visually similar to between a low and medium degree.

#### *The Second Earlier Registration and the Applicant's Mark*

39. The same comparison applies in relation to the Second Earlier Registration, with the additional difference created by the presence of the words MSP BY in the Second Earlier Registration. I consider these marks to be visually similar to a low degree.

#### *The Third Earlier Registration and the Applicant's Mark*

40. The same comparison applies in relation to the Third Earlier Registration as outlined in paragraph **38** above, with the exception that the different second word in the earlier mark is TIGHTS rather than SUIT. I consider the marks to be visually similar to between a low and medium degree.

## Aural Comparison

### *The First Earlier Registration and the Applicant's Mark*

41. Although the applicant's mark does not actually contain the word "miracle", there is a tendency on the part of consumers to look for a word within trade marks. Consequently, I consider that the letters M-RACLE and the leaf device will be viewed as representing the word MIRACLE (or a misspelling of that word). Consequently, both marks will overlap in the pronunciation of the word MIRACLE which will be identical for both. However, they will differ in the pronunciation of the words DRESS and SUIT. Consequently, I consider the marks to be aurally similar to a medium degree. If, as the applicant suggests, the leaf device is viewed by some average consumers as the letter Y, the aural pronunciation of the words MIRACLE/MYRACLE will remain highly similar and, overall, there will be a slightly lower than medium degree of aural similarity between the marks.

### *The Second Earlier Registration and the Applicant's Mark*

42. The same comparison applies as set out above. However, there is the added difference of the pronunciation of the words MSP BY in the Second Earlier Registration, which have no counterpart in the applicant's mark. I consider the marks to be aurally similar to between a low and medium degree.

### *The Third Earlier Registration and the Applicant's Mark*

43. As noted above, the applicant's mark is likely to be seen as containing the word MIRACLE (or a misspelling of that word). The marks will overlap in the pronunciation of this word. However, they will differ in the pronunciation of the words DRESS and TIGHTS. Consequently, I consider the marks to be aurally similar to either a medium degree or a slightly lower than medium degree, depending upon whether the word MIRACLE or MYRACLE is identified in the applicant's mark.

## Conceptual Comparison

44. In her counterstatement, the applicant submits:

“1. We disagree that the leaf in our logo represents an “I”. It clearly represents the letter “Y” – namely from the word MYRACLE which is also reflected in the name of the company itself which is “Myracle dress Ltd”. The MY in Myracle is representative of the actual word “MY” which is used to demonstrate the personal/belonging attributes of the product and its characteristics for personalising one’s style or look using their choice of modular attachments i.e. The wearer can change the style of their dress/outfit by choosing which modular attachment they want for that or occasion. Our marketing approach supports and promotes the use of the word “MY”. The brand is a sustainable fashion brand (the green leaf in the logo) and it is based around a circular business model (the green circle around the wording). Our logo is markedly different from the opponents – we disagree that consumers will think our products are related as the image of our brand revolves around sustainability and eco-friendly fashion.”

45. As explained above, I consider that the letters M-RACLE and leaf device in the applicant’s mark will be viewed by the average consumer as representing the word MIRACLE (or a misspelling of that word). Consequently, the marks will overlap conceptually to this extent. I accept that there may be some average consumers who view the leaf device in the applicant’s mark as representing the letter Y. However, even where this is the case this will still be viewed as a play on the word MIRACLE. The marks clearly differ in that the applicant’s mark refers to a dress and the opponent’s marks refer to a suit or tights. Nonetheless, these will all be recognised as a reference to items of clothing. The words MSP BY in the Second Earlier Mark will be viewed as a secondary brand being offered by MIRACLESUIT. However, the meaning of the letters MSP is unclear. Any meaning that might be conveyed by the presence of the leaf device or circular border in the applicant’s mark is not, to my mind, immediately graspable. Taking all of this into account, I consider the marks to be conceptually similar to between a medium and high degree.

## **Distinctive character of the earlier trade marks**

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

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

47. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

48. I will begin by assessing the inherent distinctive character of the earlier marks. The First Earlier Registration consists of the word MIRACLESUIT presented in slightly

stylised fonts. The word MIRACLESUIT is clearly a conjoining of the words MIRACLE and SUIT and will be recognised as such by the average consumer. The word SUIT will be seen as descriptive of the goods and the word MIRACLE will be seen as laudatory. The stylisation is slight and contributes little to the distinctive character of the marks. Consequently, I consider the First Earlier Registration to be inherently distinctive to a low degree.

49. The same applies to the word MIRACLESUIT in the Second Earlier Registration. However, this has the addition of the words MSP BY. The letters MSP are likely to be seen as an acronym with no apparent meaning. Taking the mark as a whole into account, I consider the Second Earlier Registration to be inherently distinctive to a medium degree.

50. The Third Earlier Registration consists of the words MIRACLE TIGHTS. The word TIGHTS will be seen as descriptive and the word MIRACLE will be seen as laudatory. As a whole, I consider the mark to be inherently distinctive to a low degree.

51. I will now consider whether the earlier marks have acquired enhanced distinctive character through use. For the purposes of this assessment, the relevant date is the date of the application in issue i.e. 10 January 2019. Mr Waldman confirms that the mark MIRACLESUIT has been used in the UK since 2004. I have noted the sales figures outlined in the opponent's evidence above. However, I note that these represent sales to a UK distributor, rather than to the end user. Consequently, they do not represent the actual retail value of the goods sold. Mr Waldman calculates that retail sales between 2010 and 2015 would have amounted to more than £930,000. Presumably, this figure would be higher for more recent years, given that distributor sales for the period 2016 to 2019 amounted to over \$1million each year. Nonetheless, I consider this to be a relatively low market share given what must, undoubtedly, be a significant market in the UK. I note that the products sold under the mark are available from well-known national retailers such as Next and John Lewis.<sup>7</sup>

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<sup>7</sup> Exhibit MW2

52. No overall figures have been provided as to how much has been invested in promoting the MIRACLESUIT brand. However, I note in particular the following from the opponent's evidence:

- a) An article from *Global Intimate Wear* dated April 2011 states that "sales are up 49 percent year on year in the UK...".<sup>8</sup> It also states that "the current demand for Miraclesuit swimwear is truly overwhelming". We have worked very hard this past year on raising the brands profile in the UK, investing in PR and advertising campaigns..."
- b) A report entitled *Shapewear: Special Dossier* which is undated save for a print date of 2017, but refers to 2009/2010/2011 so presumably dates from sometime after that, states that "Miraclesuit holds onto its top slot as the most popular bestselling brand".<sup>9</sup>
- c) An article from *PR Genie* states "Two top sellers from Miraclesuit! The UK's favourite shape and swimwear brand (Underlines May 2010)".<sup>10</sup> Similarly, an article from *Underlines* dated September 2015 states "Miraclesuit remains in the lead as UK's fav shapewear brand" and goes on to state that "Miraclesuit was the nation's favourite for the 6<sup>th</sup> year in a row".
- d) Products sold under the MIRACLESUIT brand have featured in publications including *Good Housekeeping* (2010), *telegraph.co.uk* (2011), *dailymail.co.uk* (2014), *Now* (2015), *Woman & Home* (2016), *Health & Wellbeing* (May 2018), *Love It Mag* (May 2018), *Yorkshire Post Magazine* (May 2018) and *Woman's Weekly* (check).<sup>11</sup> I note that the reach for some of these publications is recorded as follows:

|                         |              |
|-------------------------|--------------|
| <i>Woman &amp; Home</i> | over 302,000 |
| <i>Woman's Weekly</i>   | over 267,000 |

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<sup>8</sup> Exhibit MW1

<sup>9</sup> Exhibit MW4

<sup>10</sup> Exhibit MW4

<sup>11</sup> Exhibit MW5

|                                |             |
|--------------------------------|-------------|
| <i>Health &amp; Wellbeing</i>  | 40,000      |
| <i>Yorkshire Post Magazine</i> | over 23,000 |
| <i>Love It Mag</i>             | over 80,000 |

- e) The opponent's MIRACLESUIT brand was featured in an article in the *Evening Standard* dated April 2018 in which it was listed amongst the "best swimwear brands of 2018" and described as "the leader in control swimwear".<sup>12</sup>

53. Mr Waldman notes that the opponent's MIRACLESUIT brand has also been promoted at fashion trade shows across the UK. This includes attendance at MODA (the UK's largest fashion trade exhibition) in 2010, 2011, 2012, 2013, 2014, 2016 and 2017 and The London Swimwear Show in 2013, 2014, 2017 and 2018.<sup>13</sup>

54. I note that the MIRACLESUIT brand was shortlisted as a finalist in the Shapewear Brand of the Year category in the 2015 UK Lingerie Awards.<sup>14</sup> Mr Waldman has also provided a number of reports which describe the bestselling beachwear brands in the UK and Ireland.<sup>15</sup> A report for 2014 listed MIRACLESUIT as one of the top selling brands in the UK market, as did the equivalent report for 2015. A report from 2018 confirmed that MIRACLESUIT was the top choice for retailers in the shaping swimwear category.

55. Taking all of this into account, I am satisfied that the opponent has demonstrated a degree of enhanced distinctive character through use. Whilst the market share demonstrated is relatively small given the size of the market, the amount of recognition and publicity that the MIRACLESUIT mark has obtained is significant. In my view, the fact that the MIRACLESUIT mark appears in standard text in much of the evidence, rather than in the stylised versions shown in the First Earlier Registration does not impact upon this finding. I consider that the distinctiveness of the First Earlier Registration has been enhanced through use to between a medium and high degree

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<sup>12</sup> Exhibit MW5

<sup>13</sup> Witness statement of Mark Waldman, para. 17 and Exhibit MW8

<sup>14</sup> Exhibit MW10

<sup>15</sup> Exhibit MW11

in relation to shaping swimwear and underwear for women. I note that no reference is made in the evidence to MSP or MIRACLE TIGHTS. Consequently, I do not consider that there is evidence to support a finding of enhanced distinctive character in relation to the Second and Third Earlier Registrations, other than to the extent that the Second Earlier Registration contains the word MIRACLESUIT.

### **Likelihood of confusion**

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

57. As the enhanced distinctive character of the First Earlier Registration represents the opponent's strongest case, I will begin by assessing the likelihood of confusion in relation to this mark and will return to the Second and Third Earlier Registrations if necessary. I have found the marks to be visually similar to between a low and medium degree, aurally similar to a medium degree and conceptually similar to between a medium and high degree. I have found the First Earlier Registration to have a low degree of inherent distinctive character, which has been enhanced to between a medium and high degree through use in relation to shaping swimwear and underwear for women. I have found the average consumer to be a member of the general public who will purchase the goods predominantly 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. I have found the goods to be identical or highly similar.

58. The differences between the marks, particularly the visual differences given that this is a predominantly visual purchasing process, will be enough to avoid the marks being mistakenly recalled or misremembered as each other. I do not consider that there is a likelihood of direct confusion.

59. In its Notice of opposition, the opponent states:

“3. It is submitted that the Opponent has a family of marks which contain the word MIRACLE in relation to various items of clothing in Class 25. The mark applied for is likely to be considered by consumers as an extension of the range of clothing items offered by the Opponent under its family of marks.”

60. In its written submissions in lieu, the opponent states:

“26. The opponent has declared in the Witness Statement of Mark Waldman dated 13 December 2019 that the marks MIRACLESUIT, MIRACLE TIGHTS and MSP BY MIRACLESUIT, covered by the grounds of opposition, have been used by the Opponent to sell items of clothing. Further, the opponent has declared that owing to the use of marks with a MIRACLE- prefix the public would expect any other mark with a MIRACLE- prefix and a descriptive suffix to be connected to the user of the opponent’s MIRACLE marks and that the goods covered by the application are directed at the same market to the opponent’s goods for which the earlier marks were present on the market at the relevant date.”

61. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the CJEU stated:

“62. Whilst it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation to use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as

they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a 'family' or 'series' of marks.

63. The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a 'family' or 'series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64. As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market."

62. The opponent has only filed evidence of the First Earlier Registration being present on the market. Whilst the opponent's evidence includes a statement that the Second and Third Registrations have been used, no detail has been provided in relation to this alleged use or, importantly, when it took place. It is impossible, therefore, for me to find that they were on the market at the relevant date. Consequently, its 'family of marks' line of argument must fail.

63. In any event, in my view, the fact that both marks will be perceived by a significant proportion of average consumers as sharing the common element MIRACLE combined with a descriptive term linked to clothing, will lead the average consumer to

conclude that the marks originate from the same or economically linked undertakings. Although the word MIRACLE is laudatory and, of itself, of low distinctiveness. However, I have found that the distinctive character of the First Earlier Registration has been enhanced to between a medium and high degree through use in relation to shaping swimwear and underwear for women. The fact that the marks will both be used on identical or highly similar goods is a further factor in the opponent's favour. For the significant proportion of average consumers who see the applicant's mark as the word MIRACLE, the additional stylisation and use of device in the mark will, in my view, just be viewed as an alternative mark being used for a different category of goods i.e. dresses. Even where the applicant's mark may be perceived as a misspelling of the word MIRACLE, I consider this is likely to be overlooked or mistakenly recalled. I consider there to be a likelihood of indirect confusion. As I have found there to be a likelihood of confusion in respect of the First Earlier Registration, I do not consider it necessary to return to consider the likelihood of confusion in respect of the Second and Third Earlier Registrations.

64. The opposition based upon section 5(2)(b) succeeds in its entirety.

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

65. 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.”

66. As noted above, by virtue of its earlier filing date the First Earlier Registration qualifies as an earlier mark pursuant to section 6 of the Act. I have found that the

opponent has satisfied the proof of use requirements pursuant to section 6A of the Act.

67. 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, *Adidas-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 First Earlier Registration has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, 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. Thirdly, assuming the first and second conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods 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.

68. The relevant date for the assessment under section 5(3) is the date of the application i.e. 10 January 2019.

## **Reputation**

69. 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."

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

71. The First Earlier Registration is a UK mark and the opponent must, therefore, establish a reputation in the UK. As noted above, the MIRACLESUIT mark has been used in the UK since 2004. For the reasons set out above, it appears that the opponent has a relatively low market share for what must, undoubtedly, be a significant market. I note that products sold under the mark are available from national retailers such as NEXT and John Lewis.<sup>16</sup>

72. Although no total figures have been provided for the opponent's marketing and advertising expenditure, I note that it had been referenced in a number of publications prior to the relevant date including *Good Housekeeping*, *Woman & Home* and *Woman's Weekly*.<sup>17</sup> Various references have been made to the popularity of the opponent's brand such as the demand being "truly overwhelming", it holding onto "its top slot as the most popular bestselling brand" and it remaining "in the lead as the UK's fav shapewear brand".<sup>18</sup> One of these articles refers to the opponent's brand being "the nation's favourite for the 6<sup>th</sup> year in a row". I also note that the reach of some

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<sup>16</sup> Exhibit MW2

<sup>17</sup> Exhibit MW5

<sup>18</sup> Exhibits MW1 and MW4

of the publications in which the opponent's brand has been referenced are fairly significant. I note that the opponent has attended the UK's largest fashion trade exhibition over a number of years, as well as The London Swimwear Show.<sup>19</sup> The opponent's brand was shortlisted as a finalist in the Shapewear Brand of the Year category in the 2015 Lingerie Awards and has also been described as one of the top selling beachwear brands in the UK market in 2014 and 2015.<sup>20</sup>

73. Clearly, the opponent's evidence could have been more comprehensive; market share and advertising figures could have been provided. However, taking the evidence as a whole into account, in particular the recognition of the opponent's brands in independent articles, it seems to me that there is clearly a reputation in the First Earlier Registration. Consequently, I find that the opponent's First Earlier Registration has a reasonable reputation in relation to shaping swimwear and underwear for women.

## **Link**

74. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

### The degree of similarity between the conflicting marks

I have found the marks to be visually similar to between a low and medium degree, aurally similar to a medium degree and conceptually similar to between a medium and high degree.

### 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>19</sup> Witness statement of Mark Waldman, para. 17 and Exhibit MW8

<sup>20</sup> Exhibit MW11

I have found the goods to be identical or highly similar.

The strength of the earlier mark's reputation

The First Earlier Registration has a reasonable reputation in the UK for shaping swimwear and underwear for women.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

The First Earlier Registration is inherently distinctive to a low degree, which has been enhanced to between a medium and high degree through use in relation to shaping swimwear and underwear for women.

Whether there is a likelihood of confusion

I have found there to be a likelihood of indirect confusion.

75. In my view, taking into account the similarities between the marks and the identical or highly similar goods, I consider that a significant part of the relevant public will make a link between the marks in use. In my view, it is likely that the applicant's mark will be seen as indicating an alternative category of goods being offered by the opponent. The relevant public are likely to make the link between them.

**Damage**

76. I must now assess whether any of the three pleaded types of damage will arise.

77. The opponent claims that use of the applicant's mark would, without due cause, give the applicant an unfair advantage because of an association with the opponent's well established range of underwear and swimwear.

78. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

79. It is clear from the way in which the First Earlier Registration has been described in the publications referred to above, that it is known for being a ‘sculpting’ product i.e. a type of shapewear that improves the appearance of the user’s figure. Taking into account the opponent’s reputation, the similarity of the marks, and the similarity of the goods, it is clear that there is potential for this image to be transferred to the applicant. It is clearly foreseeable that the same connotations of being flattering to the user’s figure, would transfer to the applicant’s clothing items. The applicant would secure a commercial advantage, benefitting from the opponent’s reputation without paying financial compensation and would, therefore, be likely to take unfair advantage of the First Earlier Registration.

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

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

81. As I have already found in favour of the opponent under its oppositions based upon sections 5(2)(b) and 5(3), I do not consider it necessary to go on to consider the opponent’s section 5(4)(a) ground.

## CONCLUSION

82. The opposition is successful and the application is refused.

## COSTS

83. The opponent has been successful 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 **£1,700** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

|  |               |
|--|---------------|
| Filing a Notice of opposition and considering the applicant's counterstatement | £400          |
| Filing evidence  | £800          |
| Submissions/Hearing  | £300          |
| Official fee   | £200          |
| <b>Total</b>   | <b>£1,700</b> |

84. I therefore order Rohini Akosa to pay A & H Sportswear Co., Inc. the sum of **£1,700**. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 21<sup>st</sup> day of September 2020**

**S WILSON**

**For the Registrar**