

**BL O/556/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3471147**

**BY**

**N K D LONDON LTD**

**TO REGISTER THE FOLLOWING TRADE MARK:**



**NAKED  
LONDON**

**AND**

**OPPOSITION THERETO (NO. 60001414)**

**BY**

**Nakdcom One World AB**

## **Background and pleadings**

1. N K D LONDON LTD (hereafter “the applicant”) applied to register the trade mark:

NAKED  
LONDON

in the UK on 1 March 2020. It was accepted and published in the Trade Marks Journal on 20 March 2020, in respect of the following goods and services.

**Class 25:** Clothing, including underwear and outerclothing, other than special purpose protective clothing; socks; mufflers [clothing]; shawls; bandanas; scarves; belts [clothing]; Headgear; hats; caps with visors; berets; caps [headwear]; skull caps; Footwear; shoes; slippers; sandals.

**Class 35:** The bringing together, for the benefit of others of Clothing including underwear and outerclothing other than special purpose protective clothing, socks, mufflers [clothing], shawls, bandanas, scarves, belts [clothing], Headgear, hats, caps with visors, berets, caps [headwear], skull caps, Footwear, shoes, slippers, sandals for sales in retail stores, wholesale outlets, by means of electronic media or through mail order catalogues; provision of an online marketplace for buyers and sellers of goods and services; services of import-export agencies.

2. The application was opposed under the fast track opposition procedure by Nakdcom One World AB (hereafter “the opponent”) who opposes all of the goods and services of the contested trade mark, on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).
3. The opposition is based on three European trade marks (EUTMs), namely 13810205, 13912746 and 18177380.

EUTM 13810205 was filed on 10 March 2015 and registered on 17 July 2015 for the mark **na-kd** for goods and services in classes 14, 18, 25 and 35, including:

**Class 25:** Clothing; Ties [clothing]; Sweatpants; Oilskins [clothing]; Thermally insulated clothing; Tops [clothing]; Knitwear [clothing]; Muffs [clothing]; Ponchos; Knitwear [clothing]; Roll necks [clothing]; Headbands [clothing]; Furs [clothing]; Ear muffs [clothing]; Quilted jackets [clothing]; Chaps (clothing); Hats (Paper -) [clothing]; Kerchiefs [clothing]; Tights; Leather belts [clothing]; Pocket squares; Layettes [clothing]; Shorts; Bottoms [clothing]; Handwarmers [clothing]; Warm-up suits; Slips [undergarments]; Denims [clothing]; Veils [clothing]; Arm warmers [clothing]; Mufflers [clothing]; Boas [necklets]; Weatherproof clothing; Weatherproof clothing; Slipovers [clothing]; Clothing for children; Clothing made of fur; Garters; Corsets; Clothing of imitations of leather; Denims [clothing]; Garments for protecting clothing; Sportswear; Leather belts [clothing]; Shoes; High-heeled shoes; Casual footwear; Heelpieces for footwear; Footwear [excluding orthopedic footwear]; Insoles [for shoes and boots]; Shawls; Shawls and headscarves; Footwear; Headgear; Evening coats; Evening suits; Bathing drawers; Swimming costumes; Swim wear for gentlemen and ladies; Sleeveless jackets; Vest tops; Sleeveless jerseys; Belts made out of cloth; Belts made from imitation leather; Belts [clothing]; Boxer shorts; Bikinis; Blazers; Bermuda shorts; Brassieres; Denim jeans; Lingerie; Chemise tops; Women's suits; Trousers; Trousers of leather; Pantsuits; Button down shirts; Wedding dresses; Bridesmaids wear; Bridesmaid dresses; Evening wear; Women's ceremonial dresses; Capes; Bowties; Dress shirts; Gowns; Dress pants; Pockets for clothing; Christening robes; Costumes; Three piece suits [clothing]; Menswear; Gloves; Men's and women's jackets, coats, trousers, vests; Head scarves; Jackets [clothing]; Ready-to-wear clothing; Skirts; Long jackets; Shirts for suits; Men's suits; Suits; Tabards; Car coats; Corsets; Cuffs; Maternity clothing; Topcoats; Eye masks; Dressing gowns; Fur jackets; Silk ties; Scarves; Sarongs; Jackets; Ties; Loungewear; Socks and stockings; Neckerchiefs; Bandanas [neckerchiefs]; Dinner jackets; Tee-shirts; Tights; Heavy jackets; Thermal underwear; Casualwear; Knickers; Panties, shorts and briefs; Outerclothing.

**Class 35:** Wholesale services in relation to clothing; Retail store services in the field of clothing; Retail services connected with the sale of clothing and clothing accessories; Retail services in relation to cutlery; Retail services in relation to dietetic preparations; Retail services in relation to dietary supplements; Retail services in relation to clothing; Retail services in relation to fabrics; Retail services in relation to

printed matter; Retail services in relation to headgear; Retail services in relation to bags; Retail services in relation to sporting equipment; Retail services in relation to umbrellas; Retail services in relation to art materials; Retail services in relation to furniture; Retail services in relation to works of art; Retail services in relation to furnishings; Mail order retail services connected with clothing accessories; Department store retail services connected with the sale of beauty products, toiletries, machines for household use, hand tools, optical goods, domestic electrical and electronic equipment; Wholesale services in relation to footwear; Wholesale services in relation to clothing; Wholesale services in relation to bags; Retail services in relation to clothing; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Help in the management of business affairs or commercial functions of an industrial or commercial enterprise.

EUTM 13912746 was filed on 7 April 2015 and registered on 12 August 2015 for the mark:

**NA-KD**

for goods and services in classes 14, 18, 25 and 35, including:

**Class 25:** Clothing; Ties [clothing]; Sweatpants; Oilskins [clothing]; Thermally insulated clothing; Tops [clothing]; Knitwear [clothing]; Muffs [clothing]; Ponchos; Knitwear [clothing]; Roll necks [clothing]; Headbands [clothing]; Furs [clothing]; Ear muffs [clothing]; Quilted jackets [clothing]; Chaps (clothing); Hats (Paper -) [clothing]; Kerchiefs [clothing]; Tights; Leather belts [clothing]; Pocket squares; Layettes [clothing]; Shorts; Bottoms [clothing]; Handwarmers [clothing]; Warm-up suits; Slips [undergarments]; Denims [clothing]; Veils [clothing]; Arm warmers [clothing]; Mufflers [clothing]; Boas [necklets]; Weatherproof clothing; Weatherproof clothing; Slipovers [clothing]; Clothing for children; Clothing made of fur; Garters; Corsets; Clothing of imitations of leather; Denims [clothing]; Garments for protecting clothing; Sportswear; Leather belts [clothing]; Shoes; High-heeled shoes; Casual footwear; Heelpieces for

footwear; Footwear [excluding orthopedic footwear]; Insoles [for shoes and boots]; Shawls; Shawls and headscarves; Footwear; Headgear; Evening coats; Evening suits; Bathing drawers; Swimming costumes; Swim wear for gentlemen and ladies; Sleeveless jackets; Vest tops; Sleeveless jerseys; Belts made out of cloth; Belts made from imitation leather; Belts [clothing]; Boxer shorts; Bikinis; Blazers; Bermuda shorts; Brassieres; Denim jeans; Lingerie; Chemise tops; Women's suits; Trousers; Trousers of leather; Pantsuits; Button down shirts; Wedding dresses; Bridesmaids wear; Bridesmaid dresses; Evening wear; Women's ceremonial dresses; Capes; Bowties; Dress shirts; Gowns; Dress pants; Pockets for clothing; Christening robes; Costumes; Three piece suits [clothing]; Menswear; Gloves; Men's and women's jackets, coats, trousers, vests; Head scarves; Jackets [clothing]; Ready-to-wear clothing; Skirts; Long jackets; Shirts for suits; Men's suits; Suits; Tabards; Car coats; Corsets; Cuffs; Maternity clothing; Topcoats; Eye masks; Dressing gowns; Fur jackets; Silk ties; Scarves; Sarongs; Jackets; Ties; Loungewear; Socks and stockings; Neckerchiefs; Bandanas [neckerchiefs]; Dinner jackets; Tee-shirts; Tights; Heavy jackets; Thermal underwear; Casualwear; Knickers; Outerclotthing.

**Class 35:** Wholesale services in relation to clothing; Retail store services in the field of clothing; Retail services connected with the sale of clothing and clothing accessories; Retail services in relation to cutlery; Retail services in relation to dietetic preparations; Retail services in relation to dietary supplements; Retail services in relation to clothing; Retail services in relation to fabrics; Retail services in relation to printed matter; Retail services in relation to headgear; Retail services in relation to bags; Retail services in relation to sporting equipment; Retail services in relation to umbrellas; Retail services in relation to art materials; Retail services in relation to furniture; Retail services in relation to works of art; Retail services in relation to furnishings; Mail order retail services connected with clothing accessories; Department store retail services connected with the sale of beauty products, toiletries, machines for household use, hand tools, optical goods, domestic electrical and electronic equipment; Wholesale services in relation to footwear; Wholesale services in relation to clothing; Wholesale services in relation to bags; Retail services in relation to clothing; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes;

Help in the management of business affairs or commercial functions of an industrial or commercial enterprise.

EUTM 18177380 was filed on 8 January 2020 and registered on 22 May 2020 for the mark **NA-KD Circle** for goods and services in classes 03, 14, 18, 25 and 35, including:

**Class 25:** Clothing; Ties (for wear); Sweatpants; Oilskins [clothing]; Thermally insulated clothing; Tops [clothing]; Knitwear [clothing]; Muffs [clothing]; Ponchos; Knitwear [clothing]; Roll necks [clothing]; Headbands [clothing]; Furs [clothing]; Ear muffs [clothing]; Quilted jackets [clothing]; Chaps (clothing); Hats (Paper -) [clothing]; Kerchiefs [clothing]; Leotards; Leather belts [clothing]; Pocket squares; Layettes [clothing]; Short trousers; Culottes (clothing); Handwarmers [clothing]; Body warmers [clothing]; Slips [underclothing]; Denims [clothing]; Veils [clothing]; Arm warmers [clothing]; Mufflers [clothing]; Boas [necklets]; Weatherproof clothing; Weatherproof clothing; Slipovers [clothing]; Children's wear; Leather clothing; Suspenders; Corsets; Clothing of imitations of leather; Denims [clothing]; Garments for protecting clothing; Sportswear; Leather belts [clothing]; Shoes; High-heeled shoes; Leisure shoes; Heels; Footwear (except orthopaedic footwear); Insoles [for shoes and boots]; Shawls; Shawls and headscarves; Footwear; Hats; Evening coats; Evening suits; Swimming trunks; Swimming costumes; Swim wear for gentlemen and ladies; Sleeveless jackets; Vest tops; Sleeveless jerseys; Belts made out of cloth; Belts made from imitation leather; Belts [clothing]; Boxer shorts; Bikinis; Blazers; Bermuda shorts; Brassieres; Denim jeans; Ladies' underwear; Chemise tops; Women's suits; Briefs; Trousers of leather; Pantsuits; Button down shirts; Wedding dresses; Bridesmaids wear; Bridesmaid dresses; Evening wear; Women's ceremonial dresses; Capes; Bowties; Dress shirts; Gowns; Dress pants; Pockets for clothing; Christening robes; Costumes; Three piece suits [clothing]; Menswear; Gloves [clothing]; Men's and women's jackets, coats, trousers, vests; Head scarves; Jackets [clothing]; Ready-to-wear clothing; Skirts; Long jackets; Shirts for suits; Men's suits; Suits; Tabards; Car coats; Corsets; Cuffs; Maternity clothing; Topcoats; Eye masks; Lounging robes; Fur jackets; Silk ties; Scarves; Sarongs; Coats; Neckties; Loungewear; Socks and stockings; Neckerchiefs; Bandanas [neckerchiefs]; Dinner

suits; Tee-shirts; Tights; Heavy jackets; Thermal underwear; Casualwear; Knickers; panties, shorts and briefs; Outer clothing.

**Class 35:** Wholesale services in relation to clothing; Retail store services in the field of clothing; Retail services connected with the sale of clothing and clothing accessories; Retail services in relation to cutlery; Retail services in relation to dietetic preparations; Retail services in relation to dietary supplements; Retail services in relation to clothing; Retail services in relation to fabrics; Retail services in relation to printed matter; Retail services in relation to headgear; Retail services in relation to bags; Retail services in relation to sporting equipment; Retail services in relation to umbrellas; Retail services in relation to art materials; Retail services in relation to furniture; Retail services in relation to works of art; Retail services in relation to furnishings; Retailing via mail order relating to clothing accessories; Retailing provided in department stores relating to the sale of beauty products, toiletries, apparatus for household use, hand tools, optical goods, domestic electrical and electronic equipment; Wholesale services in relation to footwear; Wholesale services in relation to bags; Retail services in relation to clothing; E-commerce, namely providing product information via telecommunication networks for advertising and retail purposes; Help in the management of business affairs or commercial functions of an industrial or commercial enterprise.

4. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) a European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if

registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

5. The trade marks upon which the opponent relies qualify as earlier trade marks under the above provisions. As these earlier trade marks had been registered for less than five years at the date the application was filed, they are not subject to the proof of use provisions contained in section 6A of the Act. The opponent is, as a consequence, entitled to rely upon them in relation to all of the goods and services indicated without having to prove that genuine use has been made of them.
6. The opponent states that the marks at issue are highly similar visually, aurally and conceptually and that the goods and services are similar, all of which will lead to a likelihood of confusion, which includes the likelihood of association. The opponent also relies on the distinctive character and reputation of the earlier marks which it claims will lead to an increased likelihood of confusion.
7. In response, the applicant states that there is no likelihood of confusion between the marks at issue as they are visually, aurally and conceptually different and the overall impression they give to the target consumers are totally different. It added that there are many trade marks before the UK IPO and the EUIPO bearing the word ‘Naked’ in class 25 and “the strength of the word ‘naked’ is very weak, thus any slight changes can make a difference to make the other mark sufficiently distinctive”.
8. The applicant also claims that the word ‘LONDON’ is the main word in the contested mark as the word naked is an adjective. It suggests that the opponent’s trade marks would be perceived as a code rather than as the word naked, but claimed that even if the average consumer perceived the word naked in the earlier marks it would still not be possible to confuse the marks, due to the dissimilarities between them combined with the weak nature of the word naked on the goods and services at issue. Finally, regarding the opponent’s earlier EUTM 13912746, the applicant states that the stylisation of the letter ‘A’, with the removal of the central horizontal bar is a very common design and also very basic.
9. The opponent filed written submissions in lieu of a hearing which can be summarised as follows:

10. For procedural economy the opponent focuses on the goods and services in classes 25 and 35 and states that the goods and services in those classes of the earlier marks are identical to the goods and services in the contested application.
11. It states that the dominant and distinctive element within the applicant's mark is the word 'NAKED' and that the word 'LONDON' merely describes the location in which the goods and services will be provided. It claims that the word 'NAKED' in the applicant's mark dominates the overall impression of that mark.
12. The opponent argues that the element 'NA-KD' that comprises two of the earlier marks and forms a significant part of the third earlier mark will be perceived as a misspelling of the word 'NAKED' and as such these marks share visual, aural and conceptual similarities with the element 'NAKED' of the contested mark. It added that it may be said that earlier mark EUTM 13912746 is strikingly similar visually to the contested mark due to the practically identical stylised letter 'A' in both. The element 'NA-KD' of the earlier marks will be pronounced as 'NAKED' in the same way as the prominent element 'NAKED' in the contested mark. The average consumer would pronounce these elements identically. All of the marks at issue share the concept of 'NAKED' and the additional word 'LONDON' in the contested mark will be seen as a reference to a business operating in the city of London.
13. The opponent states that the average consumer of the goods and services, being clothing and the sale of clothing, will be the general public. The goods are unlikely to be expensive and will be purchased on a fairly frequent basis. As such the opponent suggests that a relatively low degree of attention will be undertaken in the purchasing process and that this will be primarily a visual process, although aural considerations should not be dismissed.
14. It added that the earlier marks have no meaning in relation to the goods or services for which they are registered and as such they have at least a normal level of distinctiveness.
15. The applicant also submitted written submissions in lieu which may be summarised as follows:

16. The applicant accepts that the opposed goods are identical/similar to the goods of the earlier marks. However, the applicant claims that the marks at issue are visually, aurally and conceptually dissimilar, and thus, the overall impression of the marks is totally different.
17. It adds that the consumer learns, uses and remembers trade marks as a whole. In Annex 1 of its submissions, it lists 67 marks that are filed or registered before the UK IPO or the EUIPO which contain the word 'naked' and cover class 25 goods.
18. The applicant states that the conceptual focus of its mark will be the city of London, describing the city as 'Naked'. It adds that the mark must be considered as a whole. It states that, as the opponent has claimed that the marks have no meaning, they cannot be conceptually similar.
19. Turning to the stylisation of the letter 'A' in earlier EUTM 13912746 and in the word 'NAKED' of the contested mark, the applicant states that this is a very common design and quite basic. The applicant provides information about more than 60 trade marks that it has found after searching the EUIPO database in class 25, which show a letter 'A' stylised in the same way.
20. The applicant agrees with the opponent that the purchase process will be primarily a visual one, but states that an aural component should not be ignored.
21. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”
22. The net effect of the above provisions is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.
23. Neither party requested a hearing and so this decision is taken following a careful perusal of the papers.

24. The applicant has been represented by Hatice Ahu Guneyli. The opponent has been represented by Bird & Bird LLP.

### **Preliminary issue**

25. The applicant has provided a certain amount of information in written submissions and in annex to those submissions, that I find takes the form of evidence.

26. As this opposition was filed under the fast track process, it was incumbent on both parties, if they so wished, to seek leave in order to file evidence. No leave was sought in respect of these proceedings. Therefore, the information provided by the applicant that I deem to be evidential in nature must be dismissed.

27. The information I consider to be evidential is that in which the applicant provides examples of existing marks before the UK IPO and the EUIPO which include the word 'NAKED' and where class 25 goods are included, and the information provided showing incorporation of the same stylisation in a letter 'A', i.e. the lack of a central horizontal bar, as seen in both marks at hand, based on a search of class 25 marks in the EUIPO database. All of this information can be considered to be 'state of the register' evidence.

28. However, for the sake of completeness, I refer to the findings in *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01, where the Court of Justice of the European Union (CJEU) found that:

"65... The fact that an identical trade mark has been registered in one Member State as a mark for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the

distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered.”

29. I also refer to the findings in *Zero Industry Srl v OHIM*, Case T-400/06, where the General Court stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71).”

30. Taking account of this case law, I find that the evidence relating to the state of the register cannot be said to be compelling. Each case must be considered on its own merits, taking into account all of the specifics of particular marks and circumstances.

## **Decision**

### **Section 5(2)(b) of the Act**

31. Section 5(2)(b) of the Act states:

“(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.”

32. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) 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**

33. In written submissions the applicant concedes that the contested goods are identical or similar to the goods of the opponent.<sup>1</sup> I note that in this section of its submissions the applicant refers only to 'goods', however the paragraph dealing with this issue is headed 'Comparison of the trademarks and the goods and services'. As no further mention is made of the services at issue, I initially took this to mean that the applicant was referring to both the goods in class 25 and the services in class 35 when conceding identity/similarity.

34. However, for completeness, I will briefly assess the goods and services at issue.

35. I will begin my comparison by considering the opponent's earlier EUTM 13912746. I do so as the opponent's goods and services are essentially the same across all three earlier rights, in classes 25 and 35 at least, and as the mark under 13912746

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<sup>1</sup> Section 2 on page 2 of written submissions received on 1 October 2020.

may be said to be stylistically the most similar to the applicant's contested mark. I will consider the opponent's other earlier marks later in my decision.

36. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

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

37. The applicant's contested goods and services are:

**Class 25:** Clothing, including underwear and outerclothing, other than special purpose protective clothing; socks; mufflers [clothing]; shawls; bandanas; scarves; belts [clothing]; Headgear; hats; caps with visors; berets; caps [headwear]; skull caps; Footwear; shoes; slippers; sandals.

**Class 35:** The bringing together, for the benefit of others of Clothing including underwear and outerclothing other than special purpose protective clothing, socks, mufflers [clothing], shawls, bandanas, scarves, belts [clothing], Headgear, hats, caps with visors, berets, caps [headwear], skull caps, Footwear, shoes, slippers, sandals for sales in retail stores, wholesale outlets, by means of electronic media or through mail order catalogues; provision of an online marketplace for buyers and sellers of goods and services; services of import-export agencies.

38. The opponent's earlier class 25 goods include 'Clothing, footwear and headgear'. Applying the principles in *Merich*, I find that the opponent's goods wholly encompass all of the contested goods of the applicant. As conceded by the applicant, these goods are indeed found to be identical.

39. The opponent's earlier class 35 services are 'Wholesale services in relation to clothing; Retail store services in the field of clothing; Retail services connected with the sale of clothing and clothing accessories; Retail services in relation to cutlery;

Retail services in relation to dietetic preparations; Retail services in relation to dietary supplements; Retail services in relation to clothing; Retail services in relation to fabrics; Retail services in relation to printed matter; Retail services in relation to headgear; Retail services in relation to bags; Retail services in relation to sporting equipment; Retail services in relation to umbrellas; Retail services in relation to art materials; Retail services in relation to furniture; Retail services in relation to works of art; Retail services in relation to furnishings; Mail order retail services connected with clothing accessories; Department store retail services connected with the sale of beauty products, toiletries, machines for household use, hand tools, optical goods, domestic electrical and electronic equipment; Wholesale services in relation to footwear; Wholesale services in relation to clothing; Wholesale services in relation to bags; Retail services in relation to clothing; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Help in the management of business affairs or commercial functions of an industrial or commercial enterprise’.

40. When applying the principles in *Meric* again, I conclude that the contested ‘The bringing together, for the benefit of others of Clothing including underwear and outerclothing other than special purpose protective clothing, socks, mufflers [clothing], shawls, bandanas, scarves, belts [clothing], Headgear, hats, caps with visors, berets, caps [headwear], skull caps, Footwear, shoes, slippers, sandals for sales in retail stores, wholesale outlets, by means of electronic media or through mail order catalogues’ are all wholly encompassed by the opponent’s earlier ‘Wholesale services in relation to clothing; Retail store services in the field of clothing; Retail services connected with the sale of clothing and clothing accessories; Retail services in relation to clothing; Retail services in relation to headgear’. These services are identical.

41. The remaining contested services in class 35 are: ‘provision of an online marketplace for buyers and sellers of goods and services’ and ‘services of import-export agencies’.

42. The opponent’s earlier mark is registered in respect of wholesale and retail services in the field of the relevant goods, and since those wholesale and retail services may be online, then applying the inclusion principle expressed in *Meric*, they can be said

to be identical to the contested 'provision of an online marketplace for buyers and sellers of goods and services'.

43. The services of an import-export agency are those engaged in the exportation of goods for sale overseas and the importation of goods for sale in the UK. Whilst these services will culminate with the sale or retail of goods in the UK, the nature of an import-export agency is quite different from that of a retailer or wholesaler of goods. The import-export agency will primarily be involved in the shipping or transportation of goods and the administrative side of that service, in respect of e.g. customs and excise, and legalities in crossing borders. The nature, purpose and channels of trade will differ from the goods and services of the opponent, and the user will not be the same. One may be the customer of the other, however I do not find that complementarity exists between these contested services and the opponent's earlier goods or services as they are not closely connected in the sense that one is indispensable or important for the use of the other so that consumers may think that the same undertaking is responsible.

44. The opponent's earlier class 35 services 'Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Help in the management of business affairs or commercial functions of an industrial or commercial enterprise' comprise fairly general business management, consultancy or advisory type services. They may provide advice in the running of an import-export agency, however this is not the same as the provision of import-export agency services. Whilst the opponent might claim that there is a link between these services, it is not clearly established. The nature, purpose, end-user and channels of trade are different.

45. Therefore, I conclude that 'services of import-export agencies' are dissimilar to the earlier goods and services of the opponent.

46. In conclusion I find the goods and services at issue to be identical and dissimilar.

#### **Average consumer and the purchasing act**

47. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion,

it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

48. 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.”

49. Both parties made submissions regarding the nature of the average consumer and the purchase process and appear to agree on this issue.

50. I find that the average consumer of clothing, footwear or headgear will predominantly be the general public but could also be a professional public or undertaking, buying on behalf of others. The average consumer of retail services bringing together such goods will also be the general public.

51. The selection of such goods and services is largely a visual process, as the average consumer (general public) will wish to physically handle the goods and try on articles of interest, to ensure a correct fit, whilst simultaneously appraising the overall aesthetic impact.

52. The professional consumer will also take significant care over the visual assessment of the goods, whether they be clothing, footwear or headgear as it will be essential that any items they select, precisely match the requirements of their clients.

53. I do not ignore the potential for the marks to be spoken, for example, by sales assistants in a retail establishment or when making a purchase from a catalogue, over the telephone. However, in those circumstances, the consumer will have had an

opportunity to view the goods, perhaps electronically via an online catalogue or website, or on paper in the traditional sense of catalogue shopping<sup>2</sup>. Therefore, when considering the aural impact of the marks, the visual impression of these goods will already have played a part in the consumer's mind.

54. As the goods at issue are generally day to day items of clothing, footwear and headgear, the average consumer will pay no more than a medium level of attention during the selection of those goods. The same may be said in the selection of the retail of such goods.

### **Comparison of marks**

55. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components.

56. 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.”

57. 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.

58. The respective trade marks are shown below:

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<sup>2</sup> *Quelle AG v OHIM*, Case T-88/05, paragraph 69

Earlier mark EU13912746	The applicant's trade mark
	

59. I note that both parties refer several times in submissions to the word 'NAKED' as forming a part of the marks at issue. The applicant refers to its mark as 'NAKED LONDON'. I take this to mean that both parties accept that the stylisation of the letter 'A' in both marks, is not sufficiently unusual or striking to suggest that the average consumer would interpret that element as anything other than a letter 'A'.

60. The opponent's earlier mark is comprised of a combination of the letters 'N' 'A' 'K' and 'D' presented in a fairly standard typeface, with a hyphen placed between the letter 'A' and the letter 'K'. There is a degree of stylisation in the letter 'A' which comprises the removal of the central horizontal bar. No single element can be said to dominate the mark, and nor can any element be said to be the more distinctive aspect of the mark. The overall impression of the earlier mark therefore lies in its totality.

61. The applicant's mark is comprised of the words 'NAKED' and 'LONDON' presented in two different, slightly stylised typefaces and in the colour orange. The word 'NAKED' is placed directly above the word 'LONDON' and may be said to be slightly larger in size. The letter 'A' in that word is stylised inasmuch as the central horizontal bar is missing. Neither of the words in the earlier mark can be said to dominate the other, however the word 'NAKED' can be said to be the more distinctive as the word 'LONDON' will likely be perceived as an indication of the geographical origin of the goods and services provided under the mark.

### **Visual similarity**

62. Visually, the marks are similar inasmuch as they share the letters 'N', 'A', 'K' and 'D', in that order. They are also similar in respect of the stylisation found in the letter 'A' in both marks. The marks differ visually in the letter 'E', the word 'LONDON' and the colour orange of the contested mark, none of which has a counterpart in the earlier mark; and in the small hyphen that appears in the earlier mark. These marks can be said to be visually similar to a medium degree.

### **Aural similarity**

63. The earlier mark may be pronounced in two syllables as *NAY/KED*. Alternatively, the individual letters 'N (*EN*), A (*AY*), K (*KAY*), D (*DEE*)' may be pronounced. In my opinion, the use of a hyphen to dissect the elements 'NA' and 'KD' will do nothing to alter the normal flow of the enunciation of the four letters. In other words, I do not anticipate that the average consumer would pause unnaturally when enunciating these sounds one after the other. A normal pattern of speech would likely be adopted. I also find that whilst the elements 'NA' and 'KD' in and of themselves, do not constitute a dictionary word, in modern language, where the removal of vowels in e.g. texting language is common, the average consumer will perceive the word 'naked' and presume to verbalise a letter 'E'. In that regard I believe that rather than pronouncing the earlier mark as '*EN/AY/KAY/DEE*', the average consumer will be far more likely to pronounce it as *NAY-KED*.

64. The applicant's mark will be pronounced as *NAY/KED/LUN/DUN*.

65. In both marks, the lack of a central horizontal bar in the letter 'A' will, I believe, have no impact on the pronunciation of that letter. The letter will be clearly and immediately perceived as such by the average consumer.

66. I conclude that the average consumer will immediately perceive the word 'NAKED' in both marks regardless of the various differences in those elements of the marks as I have described above. I find therefore that the aural impression of the earlier mark is wholly contained within the contested mark and that it is that element which will be

articulated first in the contested mark. I find therefore that the marks at issue are aurally similar to a medium degree.

### **Conceptual similarity**

67. The word 'NAKED' can be defined as '*having the body completely unclothed; undressed; having no covering; bare; exposed.*'<sup>3</sup>

68. The word 'LONDON' is well known and will be perceived as referring to the capital city of England.

69. Both marks have been found to contain elements which will be perceived as the word 'NAKED', which conveys the notion of some thing or someone uncovered or exposed and will generally be considered to relate to a person wearing no clothing. The additional word 'LONDON' in the contested mark will be understood as referring to the geographical location and will likely be perceived as the origin of the goods and services on offer.

70. The applicant stated in its counterstatement that the opponent had claimed that the marks have no meaning. As such, the applicant claims that the marks cannot be conceptually similar. In fact, I find that where the opponent refers to the conceptual analysis of the marks, it states that the earlier marks have no meaning in respect of the goods and services at issue, rather than that they have no meaning *per se*. I agree with this analysis with regard to the impact of the word 'NAKED'. As that word has no obvious link to the goods and services at issue it can be said to create a greater conceptual impression than the word 'LONDON'. As it is this element that is shared by the marks, they are conceptually similar to a high degree.

71. In conclusion, the marks have been found to be visually and aurally similar to a medium degree and conceptually highly similar.

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<sup>3</sup> <https://www.collinsdictionary.com/dictionary/english/naked>

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

72. 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-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

73. The opponent did not provide any evidence to support its initial claim of an enhanced degree of distinctive character or reputation.

74. Turning then to the consideration of inherent distinctiveness, I find the earlier mark to be a stylised version of the word naked. The word naked has no obvious link or association to the goods and services at issue. In fact, it can be argued that the use of the term naked on goods such as clothing is somewhat counterintuitive. Whilst it is a common dictionary word, ‘naked’ is used in this context in a fanciful and allusive manner. The addition of the stylised aspects of the mark supports a conclusion that

the earlier mark can be said to be inherently highly distinctive, or at least distinctive to a medium degree.

### **Likelihood of Confusion**

75. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17); a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

76. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertakings being the same or related).

77. I have already found that:

- the goods and services at issue are mostly identical but partly dissimilar;
- the marks are visually and aurally similar to a medium degree and conceptually highly similar;
- the average consumer will be both a member of the general public and a professional;
- the consumer will pay a medium level of attention when selecting the goods and services at issue;
- the purchasing process will be largely visual however I do not ignore the role that an aural assessment may play in the purchasing process;
- the earlier mark has at least a medium, if not a high degree of inherent distinctiveness.

78. In support of its claim that the marks at issue are visually different, the applicant has stated that the use of the colour orange in its mark serves to provide a distinction between the contested mark and the opponent's earlier marks, all of which are registered in black and white. However, the Court of Appeal has stated on two

occasions following the CJEU's judgment in *Specsavers*, (see paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47) that registration of a trade mark in black and white covers use of the mark in colour. This is because colour is an implicit component of a trade mark registered in black and white (as opposed to extraneous matter).<sup>4</sup> Thus a black and white version of a mark should normally be considered on the basis that it could be used in any colour.

79. In my opinion, these marks will be directly confused. The elements 'NA – KD' and 'NAKED' are quite similar, especially when taking account of the missing central horizontal bar in the letter 'A' of both marks. The word naked has been found to have no obvious link or association with the goods and services at issue. The word London in the contested mark will be perceived as the well-known geographical place and will be considered descriptive of the origin of the goods and services. I find that in respect of clothing, footwear and headgear particularly, it is not uncommon for undertakings to brand their products with both a trade mark and a place name, e.g. Milan, Paris or London. I know, from my own general knowledge, that the city of London is known for its fashion industry. Therefore, I believe that the average consumer will give little weight to the element 'LONDON' in the contested mark and perceive both marks as 'NAKED' marks, disregarding or overlooking the omitted letter 'E' of the earlier mark. I find that the average consumer may mistake one mark for the other and direct confusion is therefore likely to occur.

80. Although I have found a likelihood of direct confusion, in the event that I am found to be wrong in that conclusion, I now go on to consider the matter in respect of indirect confusion.

81. Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 noted that:

“16. ...Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It

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<sup>4</sup> See paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47

therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

82. These examples are not exhaustive but provide helpful focus.

83. In my opinion, the word ‘LONDON’ in the contested mark will be perceived as an indication of geographical origin of the goods and services at issue. The average consumer, when faced with the contested mark, having previously been exposed to the earlier mark (or vice-versa), will consider the later mark to be a brand extension or sub-brand applying the descriptive element ‘LONDON’ to the primary brand ‘NAKED’. Overall, I find that a likelihood of indirect conclusion will occur.

84. As I have found a likelihood of direct and indirect confusion between the opponent’s earlier EUTM 13912746 and the contested mark, I do not need to go further and

consider the opponent's other earlier marks. Those marks cover virtually identical goods and services as 13912746 and, in respect of those class 35 services that I have found to be dissimilar, are no closer to a finding of similarity. It can also be said that the marks under EUTM's 13810205, and 18177380 are less similar to the contested mark due, primarily to the inclusion of the central horizontal bar in the letter 'A' within those marks, something that is missing in the contested mark and the mark under 13912746.

### **Conclusion**

85. As I have found that there is a likelihood of confusion the opposition has been largely successful. Subject to appeal, the application is refused for all of the contested goods and services that have been found to be identical. The application may proceed to registration for those services which were found to be dissimilar, namely:

**Class 35:** services of import-export agencies.

### **Costs**

86. The opponent has been largely successful and is entitled to a contribution towards its costs based on the normal scale set out in Tribunal Practice Notice 2/2016

87. I therefore award costs to the opponent as follows:

Official notice of opposition	£100
Preparing the statement of grounds and considering the counterstatement	£200
Provision of written submissions and Considering the submissions of the Applicant	£200
<b><u>Total</u></b>	<b><u>£500</u></b>

88.I therefore order N K D LONDON LTD to pay Nakdcom One World AB the sum of £500. This sum is to be paid within 21 days of the expiry of the appeal period or within twenty-one days of the final determination of this case, if any appeal against this decision is unsuccessful.

**Dated this 9th day of November 2020**

**Andrew Feldon**

**For the Registrar**

**The Comptroller-General**