O-0161-25

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3889338

BY LAURA SPRING

TO REGISTER

Studio Spring

AS A TRADE MARK

IN CLASSES 16, 18, 24, 25, 35, 40, 41, 42

AND OPPOSITION THERETO (UNDER NO. 441870)

BY

FRASERS GROUP FINANCIAL SERVICES LIMITED

Background and pleadings

1. Laura Spring ("the applicant") applied to register the trade mark **Studio Spring** on 15 March 2023. The mark was published for opposition purposes on 7 April 2023 in classes 16, 18, 24, 25, 35, 40, 41 and 42. Classes 35, 41 and 42 were subsequently amended by means of a form TM21B dated 28 November 2023. The specifications for the goods and services as they now stand will be set out later in this decision.

2. Frasers Group Financial Services Limited ("the opponent") opposed the application in full on 7 July 2023 under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act). Under sections 5(2)(b) and 5(3) the opponent relies on the following UK and comparable[1] trade mark registrations.

Earlier registration	**Goods and services relied on**
UK TM No. 3205744 ("the '744 registration") **STUDIO** Filing date: 10 January 2017 Registration date: 31 March 2017	Class 9: sunglasses; cases for mobile devices and laptop; screen protectors for mobile devices. Class 18: luggage; bags; belts; umbrellas; parasols. Class 25: footwear; clothing; headgear; scarves. Class 35: Retail and wholesale services in connection with the sale of stationery products, books, arts and crafts materials, games, toys and playthings, tricycles, bicycles and scooters, nursery and baby products, namely toiletries,

[1] Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all rights holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent's mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

	baby chairs, bouncers, high chairs, learning aids, musical instruments, cleaning materials and products, health and safety products, clothing, footwear and headgear, cosmetics, cleaning products, furniture, audio visual equipment, containers, catering and cooking equipment, bedding, textiles, soft furnishings, Christmas trees lights and decorations, fragrances, leather belts, bags and luggage, domestic appliances, fires, confectionery, bathroom accessories, namely bathroom household containers, bathroom furniture, soap dishes and shower cuddies, jewellery and watches, garden tools, garden furniture, planters, garden ornaments, lighting. Class 36: Insurance services; product service plan; warranty insurance services; extended warranty insurance services; warranty programme services; financial services; credit services.
UK TM No. 918096760 ("the '760 registration") studio We Do Wow Filing date: 18 July 2019 Registration date: 30 November 2019	Class 35: Retail and wholesale services in connection with the sale of stationery products, books, arts and crafts materials, games, toys and playthings, tricycles, bicycles and scooters; Retail and wholesale services in connection with the sale of nursery and baby products, namely toiletries, baby chairs, bouncers, high chairs, learning aids,

	musical instruments, cleaning materials and products, health and safety products, clothing, footwear and headgear, cosmetics, cleaning products, furniture, audio visual equipment, containers, catering and cooking equipment, bedding, textiles, soft furnishings; Retail and wholesale services in connection with the sale of Christmas trees lights and decorations, fragrances, leather belts, bags and luggage, domestic appliances, domestic electrical products, fires, confectionery, bathroom accessories, namely bathroom household containers, bathroom furniture, soap dishes and shower cuddies, jewellery and watches, garden tools, garden furniture, planters, garden ornaments, lighting.

3. Under section 5(4)(a) the opponent states that it has used the sign **STUDIO** for *retail and online retail services* since 2002 throughout the UK.

4. The applicant filed a defence and counterstatement denying all the grounds of opposition and putting the opponent to proof of use.

5. During these proceedings, only the opponent filed evidence and both sides filed written submissions in lieu of a hearing.

6. The applicant is represented by Cloch Solicitors and the opponent by Abion UK Limited.

7. I make this decision based on a consideration of all the material before me.

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts that predate the UK's withdrawal from the EU.

EVIDENCE

Relevant date and proof of use

9. The opponent's registrations have filing dates that are earlier than the filing date of the contested application and are therefore earlier marks, in accordance with section 6 of the Act. Earlier UK TM No. 918096760 has not been registered for five years or more before the filing date of the contested application so is not subject to the proof of use requirements, as per section 6A of the Act. The registration procedure for UK TM No. 3205744 was completed more than 5 years prior to the filing date of the contested application so it is subject to the use conditions, as per section 6A of the Act.

10. My first task is to establish whether, or to what extent, the opponent has shown genuine use of its earlier registration UK TM No. 3205744 within the 'relevant period'. The relevant period is defined as being the period of 5 years ending with the filing or priority date of the contested registration, i.e.16 March 2018 to 15 March 2023

11. The opponent submitted a witness statement in the name of Paul Kendrick, a Director and former CEO of the opponent. Mr Kendrick attaches 12 exhibits in support of his witness statement. I do not intend to summarise the evidence in full here, but I will set out the most pertinent points of the opponent's evidence below.

12. Mr Kendrick states that the opponent's predecessors in title begin trading in 1962 using the mark **STUDIO**, firstly as a mail order business and later as an online retailer via its website and via a mobile phone app. It retails its own branded goods, and third party branded goods.

13. Mr Kendrick gives the following sales figures for the period 2019-2023:

FY (Studio)	TOTAL STUDIO SALES	TOTAL STUDIO BRANDED SALES
2019	£335,348,331	£35,596,920
2020	£357,401,711	£77,513,706
2021	£513,176,678	£123,059,819
2022	£448,327,780	£123,532,198
2023 (not full year figures)	£385,167,783	£123,012,374
TOTAL	**£2,039,422,284**	**£482,715,018**

15. Mr Kendrick provides customer analytics data demonstrating a geographical spread of customers throughout the UK between 2019 and 2023.[2]

16. By means of the Wayback Machine internet archive services, Mr Kendrick exhibited screenshots dated between 2017 and 2023 of the opponent's website namely www.studio.co.uk.[3] The word mark **STUDIO** is used in text on the web pages and the following two marks are displayed on the mast heads:

17. The prices are displayed in pounds sterling. Within the screenshots provided and in addition to the third party products for sale, I note that there are **STUDIO** branded goods namely footwear, ponchos, hats, scarves, gloves, towels, face cloths, laundry bag, toilet roll holder, weighing scales, storage units, storage baskets and pillows.

18. Mr Kendrick also provides evidence of the opponent's credit services which is branded as **STUDIO PAY**. This take the form of a customer credit account which allows the spread of purchase costs over a prescribed period and attracting an interest payment if the balance is not cleared. Mr Kendrick states that the credit service has been provided since 2018 and generates approximately £100k per annum for the opponent.[4]

[2] Exhibit PK-2
[3] Exhibit PK-5
[4] Exhibit PK-12

19. In terms of advertising, Mr Kendrick provides evidence of TV advertisements for the opponent using the marks **STUDIO** and  dated between 2016 – 2022 and shown on the terrestrial channel broadcaster ITV and on YouTube.[5] Also exhibited are two articles from the online trade press.[6] Firstly an article from www.retailgazette.co.uk, dated September 2021, outlining the opponent's upcoming Christmas 2021 campaign to include TV, radio, online and social media advertising. Secondly an article from www.marketing-beat.co.uk, dated October 2022, which also focussed on the opponent's Christmas 2022 advertising campaign for that year and again confirmed a combination of TV, radio, online and social media advertising.

20. Mr Kendrick also provides evidence of a three-year sponsorship deal, namely to sponsor the family stand at the ground of Accrington Stanley FC. The deal started in 2018 and was then renewed in 2021 for a further three years.[7] There is also evidence of sponsorship of Accrington Cricket Club dated 2021.[8]

21. Mr Kendrick also provides evidence of the opponent attending a trade fair in Accrington town hall to promote its goods and services as a locally based business on 1 July 2019.[9]

22. This concludes my summary of the evidence.

Relevant statutory provision: Section 6A:

23. The relevant statutory provisions for section 6A are set out below:

> "(1) This section applies where
>
> (a) an application for registration of a trade mark has been published,

[5] Exhibit PK-8
[6] Exhibit PK-9
[7] Exhibit PK10
[8] Exhibit PK-10
[9] Exhibit PK-11

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) 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) [Repealed]

(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."

24. In *easyGroup Ltd v Nuclei Ltd & Ors*,[10] Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, 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 Bundervsvereinigung 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 Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles 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].

[10] [2023] EWCA Civ 1247

(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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(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]; *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]."

25. Section 100 of the Act states that:

"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."

Use in a differing form

26. I note from the evidence that in addition to the word mark **STUDIO**, the following stylised marks are used namely 

, 

and the word mark **STUDIO PAY**. Guidance on marks used in a differing form is set out in *Lactalis McLelland Limited v Arla Foods AMBA*[11] where Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

"13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is,

[11] BL O/265/22

the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

27. I find that the  mark is altered only to the extent that it is depicted in white lettering on a blue background which I consider to be alteration of a non-distinctive element. As such the distinctive character of the mark is not altered and I find this mark to be an acceptable variant.

28. Turning to the  mark, I note the contrast in colour between the letters depicted in purple and the single letter O depicted in red. There is a visual impact to this alteration, but I am of the view that the distinctiveness of the word STUDIO remains intact and as such I also consider this mark to be an acceptable variant.

29. Finally with regard to the mark **STUDIO PAY**, I consider the word **PAY** to be a material alteration of the earlier registered mark as an additional word has been added to the mark. However I find the word **PAY** to be non-distinctive for credit services in class 36 and as set out above the addition of a non-distinctive element even when it is a word rather than a stylistic alteration is unlikely to change the distinctive character of the mark as a whole. Therefore I also consider this mark to be an acceptable variant.

Sufficiency of use

30. The evidence shows the **STUDIO** mark and its acceptable variants being used on some goods and services which I will come to shortly. But the primary use has been for retail services during the relevant periods. The opponent has demonstrated a consistently high sales turnover up to 2023 for its own goods and retail sales of its own and third party goods. I find there is a UK wide customer base and there is evidence of national advertising campaigns. Overall I find that the evidence supports the statements made by the opponent that there has been genuine use of the earlier registration during the relevant periods.

Framing a fair specification

31. The next stage is to decide whether the opponent's use entitles it to rely on all of the goods and services for which it made a statement of use and based on my assessments given above. In framing a fair specification, I rely on guidance given in the following judgments. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK)*

Limited[12], 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."

32. Moreover in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*[13], Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

> "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].

[12] BL O/345/10
[13] [2016] EWHC 3103 (Ch)

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 Pl*c [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."

33. Based on my assessment of the evidence, I am not able to find that the opponent has used its earlier mark on the full range of goods and services for which the mark is registered. Therefore I will assess what I think will represent a fair specification for the classes as set out below.

34. For the goods in class 9, namely *sunglasses; cases for mobile devices and laptop; screen protectors for mobile devices* I found no evidence of use, therefore the opponent cannot rely on the goods in this class.

35. For the goods in class 18 namely *luggage; bags; belts; umbrellas; parasols*. I found no evidence of use of the **STUDIO** mark on the goods themselves, the use was only for retail of these goods. Therefore the opponent cannot rely on the goods in this class.

36. For the goods in class in 25, namely *footwear; clothing; headgear; scarves*, there was some evidenced use of the **STUDIO** mark on the goods themselves during the relevant period, therefore the opponent can rely on these goods.

37. For the services in class 35 there was evidence of retailing the following products namely *Retail and wholesale services in connection with the sale of stationery products, books, arts and crafts materials, games, toys and playthings, tricycles, bicycles, nursery products, cleaning products, clothing, footwear and headgear, cosmetics, containers, textiles, soft furnishings, bags and luggage, bathroom accessories, namely bathroom household containers, and bathroom furniture.* There was no evidenced use of the remaining goods related to the retail services.

38. For the services in class 36, I found there was evidenced use for *credit services* such that the opponent can rely on these services. However, there was no evidence of use for the following services namely *Insurance services; product service plan; warranty insurance services; extended warranty insurance services; warranty programme services; financial services* therefore the opponent cannot rely on these services.

Section 5(2)(b)

39. Section 5(2)(b) of the Act reads as follows:

> "5 (2) A trade mark shall not be registered if because -
>
> […]
>
> (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".

40. Section 5A is also relevant and reads:

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

41. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

> (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 will wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

42. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

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

43. Guidance on this issue has also come from Jacob J. (as he then was) *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

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

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

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

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

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

44. I also find the following case law to be useful in these proceedings. In *Gérard Meric v Office for Harmonisation in the Internal Market*[14], 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 fur 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."

45. In *Oakley, Inc v OHIM*[15], the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

46. In *Tony Van Gulck v Wasabi Frog Ltd*[16], Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

[14] Case T- 133/05
[15] Case T-116/06, at paragraphs 46-57
[16] Case BL O/391/14

"9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are *'similar'* to goods are not clear cut."

47. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM,* Case T-105/05*,* at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded that:

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

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

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

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

48. The goods and services to be compared are set out below:

Opponent's goods and services for UK TM No. 3205744	Opponent's services for UK TM No.9108096760	Applicant's goods and services
		16: Paper, cardboard; printed matter; printed publications; periodical publications; books; notepads; notebooks; booklets; magazines; newspapers; newsletters; printed reports; bookmarks; posters; prints; stationery; tickets and passes (not magnetically encoded); office requisites; writing sets; pens and pencils; writing paper; packaging and boxing materials; bags made of paper of cardboard; marketing stands made from cardboard; containers made from cardboard; calendars; paper ornaments; postcards; diaries; organisers; journals; reminder pads; albums; boxes made from paper or cardboard; greeting cards; instructional and teaching materials; information books;

		manuals; educational books; printed tutorials; printed seminars; printed lectures; printed forms; printed diagrams and illustrations; printed certificates; graphic art works; graphic illustrations; plans; charts; drawings; maps; promotional literature; printed programmes; flyers; leaflets; photographs; banners and wall hangings made of paper or cardboard; office requisites; labels; stickers; binders and folders; book markers; envelopes; paper napkins; coasters of paper or cardboard; scrap books; tokens, all made of paper or card; tour and sightseeing books; instructional and teaching materials (other than apparatus); address books; colouring books; manuscript books; pocket memorandum books; activity books; log books; guide books; account books; copy books; pocket books; signature books; note books; writing or drawing books; business cards; business card holders made of paper or cardboard; passport holders; advertising and promotional

		materials; marketing stands made from paper or cardboard; pop up stands made from paper or cardboard; boxes and materials for packaging (not included in other classes); plastic material for packaging (not included in other classes); wrapping paper; adhesives for stationery or household purposes; artwork made from paper or cardboard; pop up artwork made from paper or cardboard; unfitted furniture covers of paper; flash cards made from paper or cardboard; parts and fittings for all the aforesaid goods.
		18: Art portfolios; wall hangings made of leather, imitation leather, animal skins and hides; animal skins and hides; trunks (luggage); bags; drawstring bags; slouch bags; tote bags; duffle bags; back packs; shopping bags; travelling bags; carrying bags; holdalls; rucksacks; handbags; brief cases; luggage; suitcases; folio cases; umbrellas; parasols; walking sticks; key cases; credit card cases and holders; portfolios; purses; wallets; belts

		made of leather or imitation leather; whips, harness and saddlery; collars, leashes and clothing for animals; coverings (Furniture -) of leather, imitation leather, animal skins or hides; leather, imitation leather, animal skins and hides for furniture; parts and fittings for all the aforesaid goods.
		24: Fabrics; textiles; gift wrap of fabric; kitchenware made from fabrics and textiles, namely kitchen cloths, table covers; homeware made from fabrics and textiles, namely curtains, bed covers, mattress protectors; coverings for furniture; furniture throws; bed linen and blankets; quilts; tea towels; textile piece goods; textiles and substitutes for textiles; household linen; curtains of textile or plastic; knitted elastic fabrics for clothing; textile fabrics for use in the manufacture of clothing; towels of textile; towelling [textile]; children's towels; hand towels of textile; textile fabrics for use in the manufacture of towels; textile piece goods for making-up into towels; textile

		bunting; flags; wall hangings; tapestries; fabric and textile covering for furniture; coverings for furniture; coverings (Furniture -) of textile; coverings of plastic for furniture; fabrics for manufacturing garden furniture; fibre fabrics for the manufacture of the exterior coverings of furniture; loose covers made of textile materials for furniture; protective coverings for furniture; protective loose covers for mattresses and furniture; replacement seat covers [loose] for furniture; seat covers [loose] for furniture; silk fabrics for furniture; textile fabric piece goods for the manufacture of upholstered; textile fabrics for use in the manufacture of furniture; throws (furniture coverings); unfitted fabric furniture covers; unfitted fabric slipcovers for furniture; velours for furniture; woven fabrics for furniture; parts and fittings for all the aforesaid goods.
25: Footwear; clothing; headgear; scarves.		25: Clothing; footwear; headgear; athleisure; articles of clothing for artists namely, gowns, aprons, smocks, dungarees, head scarfs; jackets;

		jumpsuits; uniforms; neckerchiefs; capes; parts and fittings for all the aforesaid goods.
35: Retail and wholesale services in connection with the sale of stationery products, books, arts and crafts materials, games, toys and playthings, tricycles, bicycles, nursery products, cleaning products, clothing, footwear and headgear, cosmetics, containers, textiles, soft furnishings, bags and luggage, bathroom accessories, namely bathroom household containers, and bathroom furniture.	35: Retail and wholesale services in connection with the sale of stationery products, books, arts and crafts materials, games, toys and playthings, tricycles, bicycles and scooters; Retail and wholesale services in connection with the sale of nursery and baby products, namely toiletries, baby chairs, bouncers, high chairs, learning aids, musical instruments, cleaning materials and products, health and safety products, clothing, footwear and headgear, cosmetics, cleaning products, furniture,	35: Advertising; marketing; merchandising; compilation of statistical information; database management services; advice for consumers; dissemination of advertisements; sales promotion; retail services in relation to the sale of artwork and textile products; advertising matter (dissemination of -); distribution of samples; social media strategy and marketing consultancy; providing business advice in the field of art, textiles, homeware, furniture, fashion; advertisement and marketing of social media accounts, texts, blogs and video logs; advertisement and marketing provided by means of blogging; none of the aforesaid services in relation to branding agency services; retail services, mail order retail services, online retail services, wholesale services in relation to the sale of artwork and textile products, fabrics, paper, printed matter, books, notepads, notebooks,

	audio visual equipment, containers, catering and cooking equipment, bedding, textiles, soft furnishings; Retail and wholesale services in connection with the sale of Christmas trees lights and decorations, fragrances, leather belts, bags and luggage, domestic appliances, domestic electrical products, fires, confectionery, bathroom accessories, namely bathroom household containers, bathroom furniture, soap dishes and shower cuddies, jewellery and watches, garden tools, garden furniture, planters,	booklets; bookmarks, posters, prints, stationery, tickets and passes, office requisites, writing sets, pens and pencils, writing paper, packaging and boxing, bags, adhesives, wrapping paper, artwork, packaging, containers, calendars, paper ornaments, postcards, diaries, organisers, journals, reminder pads, albums, boxes, greeting cards, information books, manuals, educational books, printed tutorials, printed diagrams, illustrations, certificates, graphic artwork, graphic works, plans, charts, drawings, sketches, maps, photographs, banners, wall hangings, labels, stickers, binders and folders, envelopes, napkins, coasters, scrap books, tokens, tour and sightseeing books, playing cards, address books, colouring books, manuscript books, pocket memorandum books, activity books, log books, guide books, account books, copy books, pocket books, signature books, note books, writing or drawing books, business cards, business card holders, passport holders,

	garden ornaments, lighting.	art portfolios, personal accessories, brooches, kitchenware, furniture, homeware, stationary, artwork, decorative articles, animal skins and hides, luggage, bags, drawstring bags, slouch bags, tote bags, duffle bags, back packs, travelling bags, carrying bags, holdalls, rucksacks, handbags, brief cases, luggage, suitcases, folio cases, umbrellas, parasols, walking sticks, key cases, credit card cases and holders, portfolios, purses, wallets, belts, whips, harness, saddlery, collars, leashes and clothing for animals, coverings for furniture, furniture throws, bed linen and blankets, cushions, pillows, quilts, tea towels, oven gloves, teapot covers and cozies, plant pot covers, household linen, curtains, homeware towels, textile bunting, flags, wall hangings, tapestries, rugs, mats, floor coverings, covering for furniture, clothing, footwear, headgear, athleisure, articles of clothing for artists, jackets, jumpsuits, uniforms, brooches, neckerchiefs, knotwraps, capes,

		decorative articles, decorative articles made of rubber, decorative articles made of stone, decorative articles made of glass, decorative articles made of wax, decorative articles made of plaster, decorative articles made of plastic works of art, artworks of rubber, artworks of stone, artworks of glass, artworks of wax, artworks of plaster, artworks of plastic, artworks made of bone, artworks made of horn, artworks made of pearl, figurines, models, furniture, homeware, mirrors, picture frames, wall hangings, containers, shells, meerschaum, yellow amber, synthetic fibres, geotextile containers, yarns, threads, haberdashery, dressmakers' articles, lettering for marking fabric and textile articles, artificial garlands and wreaths, artificial plants, artificial foliage, artificial fruit, artificial flowers and vegetables, toys, games, playthings, festive decorations, mats, rugs, gymnasium mats; the bringing together, for the benefit of others, of a variety of art, textile and fabric design services,

		transportation services, conservation and preservation services, maintenance services, repair services, and restoration services, to enable purchasers to purchase those services by electronic means; rental of advertising space; import and export agency services; information, advisory and consultancy services relating to all the aforesaid services, including such services provided online from a computer network and/or via a computer database or the Internet and/or extranets.
36: Credit services.		
		40: Framing and mounting works of art; framing and mounting fabrics and textiles; stationary printing services; custom manufacture of artwork and textiles; reproduction of artwork and textiles; photographic etching of household articles, textiles and clothing; dyeing of fabrics and textiles; tailoring services; custom tailoring; tailoring services; alteration and decoration of fabrics and textile articles; custom tailoring services; custom millinery,

		tailoring or dressmaking; providing information relating to tailoring design; tailoring [custom manufacture]; millinery, tailoring or dressmaking; alteration of clothing and headgear; custom manufacture of clothing and headgear; dyeing of clothes and textiles; treatment of textiles, fabrics and clothing; information, advisory and consultancy services relating to all the aforesaid.
		41: Education; educational, training, teaching and instructional services; providing of training; education advisory services; courses (training-); entertainment; sporting and cultural activities; design education services; training of designers; art education; art classes; training of artists; art instruction; rental of artwork; art exhibitions; organising art competitions; publication services; publication of brochures and catalogues comprising designs relating to textiles, fabrics, bags, personal accessories, kitchenware, furniture, homeware, stationary, clothing, headgear and artwork;

		providing electronic publications; providing online electronic publications; publishing of papers; publishing of memorandums, leaflets, newsletters, journals, books and handbooks; providing of training; training services; lending of books; seminars, lectures, conferences, workshops; cultural services; entertainment services; educational and entertainment services, namely, providing on-line non-downloadable podcasts; educational services, namely, providing on-line non-downloadable podcasts; educational services, namely, arranging, conducting and providing workshops, classes, seminars, and conferences; providing online videos, not downloadable; publishing of memorandums, leaflets, newsletters, journals, books and handbooks; providing of training; training services; seminars, lectures, conferences, workshops; art exhibitions; design exhibitions; educational services in relation to heritage and cultural projects;

		information, advisory and consultancy services relating to all the aforesaid services; none of the aforesaid services in relation to creative marketing agency services.
		42: Design services; graphic design services; art and design services; commercial art design; technical research and design relating thereto; none of the aforesaid services in relation to creative marketing agency services; design services relating to textiles; design services relating to fabrics; design services relating to bags, personal accessories, kitchenware, furniture, homeware, stationary, clothing, headgear, artwork; graphic design services; art and design services; design services in relation to heritage projects; information, advisory and consultancy services relating to all the aforesaid.

Class 16

49. As per the case law cited above, it is permissible for me to consider the retail of specific goods as complementary to the goods themselves. As such as I find the opponent's terms *Retail and wholesale services in connection with the sale of*

stationery products, books, arts and crafts materials, to be complementary to a low degree to the following applicant's terms in class 16, namely *Paper, cardboard; printed matter; printed publications; periodical publications; books; notepads; notebooks; booklets; magazines; newspapers; newsletters; printed reports; bookmarks; posters; prints; stationery; office requisites; writing sets; pens and pencils; writing paper; paper ornaments; postcards; diaries; organisers; journals; reminder pads; albums; information books; manuals; educational books; printed tutorials; printed seminars; printed lectures; printed forms; printed diagrams and illustrations; printed certificates; graphic art works; graphic illustrations; drawings; promotional literature; printed programmes; flyers; leaflets; banners and wall hangings made of paper or cardboard; office requisites; labels; stickers; binders and folders; book markers; envelopes; scrap books; tour and sightseeing books; address books; colouring books; manuscript books; pocket memorandum books; activity books; log books; guide books; account books; copy books; pocket books; signature books; note books; writing or drawing books; wrapping paper; adhesives for stationery or household purposes; artwork made from paper or cardboard; pop up artwork made from paper or cardboard; parts and fittings for all the aforesaid goods.*

50. I do not find the remaining terms in the applicant's specification namely *tickets and passes (not magnetically encoded); packaging and boxing materials; bags made of paper of cardboard; marketing stands made from cardboard; containers made from cardboard; calendars; boxes made from paper or cardboard; greeting cards; instructional and teaching materials; plans; charts; maps; photographs; paper napkins; coasters of paper or cardboard; tokens, all made of paper or card; instructional and teaching materials (other than apparatus); business cards; business card holders made of paper or cardboard; passport holders; advertising and promotional materials; marketing stands made from paper or cardboard; pop up stands made from paper or cardboard; boxes and materials for packaging (not included in other classes); plastic material for packaging (not included in other classes); unfitted furniture covers of paper; flash cards made from paper or cardboard; parts and fittings for all the aforesaid goods* to be either similar or complementary.

Class 18

51. As set out above with regard to the complementarity of retail services and goods, I find that the opponent's terms *Retail and wholesale services in connection with the sale of leather belts, bags and luggage* to be complementary to a low degree to the applicant's terms *Art portfolios; trunks (luggage); bags; drawstring bags; slouch bags; tote bags; duffle bags; back packs; shopping bags; travelling bags; carrying bags; holdalls; rucksacks; handbags; brief cases; luggage; suitcases; folio cases; key cases; credit card cases and holders; portfolios; purses; wallets; belts made of leather or imitation leather* in class 18.

Class 24

52. As set out above with regard to the complementarity of retail services and goods, I find that the opponent's terms *Retail and wholesale services in connection with the sale of bedding, textiles, soft furnishings* to be complementary to a low degree to the applicant's terms *Fabrics; textiles; gift wrap of fabric; kitchenware made from fabrics and textiles, namely kitchen cloths, table covers; homeware made from fabrics and textiles, namely curtains, bed covers, mattress protectors; coverings for furniture; furniture throws; bed linen and blankets; quilts; tea towels; textile piece goods; textiles and substitutes for textiles; household linen; curtains of textile or plastic; knitted elastic fabrics for clothing; textile fabrics for use in the manufacture of clothing; towels of textile; towelling [textile]; children's towels; hand towels of textile; textile fabrics for use in the manufacture of towels; textile piece goods for making-up into towels; textile bunting; flags; wall hangings; tapestries; fabric and textile covering for furniture; coverings for furniture; coverings (Furniture -) of textile; loose covers made of textile materials for furniture; protective coverings for furniture; protective loose covers for mattresses and furniture; replacement seat covers [loose] for furniture; seat covers [loose] for furniture; silk fabrics for furniture; throws (furniture coverings); unfitted fabric furniture covers; unfitted fabric slipcovers for furniture; velours for furniture; woven fabrics for furniture; parts and fittings for all the aforesaid goods* in class 24.

53. I find that the opponent's terms *Retail and wholesale services in connection with the sale of bedding, textiles, soft furnishings* will not encompass the applicant's term *coverings of plastic for furniture* as it has a different nature and purpose. Nor are the opponent's terms complementary to the applicant's terms *fabrics for manufacturing*

garden furniture; fibre fabrics for the manufacture of the exterior coverings of furniture; textile fabric piece goods for the manufacture of upholstered; textile fabrics for use in the manufacture of furniture as these are goods or use in manufacture and therefore will have a different end user and channel of trade. As such there is neither similarity nor complementarity.

Class 25

54. I find that the opponent's terms *Footwear; clothing; headgear* is sufficiently broad to cover the applicant's goods in this class. The goods are therefore identical under the *Meric* principle.

Class 35

55. I note that the applicant's specification for class 35 broadly falls into three categories, namely retail services in relation to goods, the bringing together of services for others and a number of other class 35 services. I will begin with an assessment relating to the retail of goods.

56. Both sides have retail services which relate to a number of identical terms such as stationery products and textiles. But even where the retail services do not relate to exactly the same goods, they are still similar to some degree because of the similarity between the nature, purpose and methods of use for retail services for most goods. As such I find there is a low degree of similarity between the opponent's class 35 specification and the following services in the applicant's specification, namely: *retail services in relation to the sale of artwork and textile products; retail services, mail order retail services, online retail services, wholesale services in relation to the sale of artwork and textile products, fabrics, paper, printed matter, books, notepads, notebooks, booklets; bookmarks, posters, prints, stationery, tickets and passes, office requisites, writing sets, pens and pencils, writing paper, packaging and boxing, bags, adhesives, wrapping paper, artwork, packaging, containers, calendars, paper ornaments, postcards, diaries, organisers, journals, reminder pads, albums, boxes, greeting cards, information books, manuals, educational books, printed tutorials, printed diagrams, illustrations, certificates, graphic artwork, graphic works, plans, charts, drawings, sketches, maps, photographs, banners, wall hangings, labels,*

stickers, binders and folders, envelopes, napkins, coasters, scrap books, tokens, tour and sightseeing books, playing cards, address books, colouring books, manuscript books, pocket memorandum books, activity books, log books, guide books, account books, copy books, pocket books, signature books, note books, writing or drawing books, business cards, business card holders, passport holders, art portfolios, personal accessories, brooches, kitchenware, furniture, homeware, stationary, artwork, decorative articles, animal skins and hides, luggage, bags, drawstring bags, slouch bags, tote bags, duffle bags, back packs, travelling bags, carrying bags, holdalls, rucksacks, handbags, brief cases, luggage, suitcases, folio cases, umbrellas, parasols, walking sticks, key cases, credit card cases and holders, portfolios, purses, wallets, belts, whips, harness, saddlery, collars, leashes and clothing for animals, coverings for furniture, furniture throws, bed linen and blankets, cushions, pillows, quilts, tea towels, oven gloves, teapot covers and cozies, plant pot covers, household linen, curtains, homeware towels, textile bunting, flags, wall hangings, tapestries, rugs, mats, floor coverings, covering for furniture, clothing, footwear, headgear, athleisure, articles of clothing for artists, jackets, jumpsuits, uniforms, brooches, neckerchiefs, knotwraps, capes, decorative articles, decorative articles made of rubber, decorative articles made of stone, decorative articles made of glass, decorative articles made of wax, decorative articles made of plaster, decorative articles made of plastic works of art, artworks of rubber, artworks of stone, artworks of glass, artworks of wax, artworks of plaster, artworks of plastic, artworks made of bone, artworks made of horn, artworks made of pearl, figurines, models, furniture, homeware, mirrors, picture frames, wall hangings, containers, shells, meerschaum, yellow amber, synthetic fibres, geotextile containers, yarns, threads, haberdashery, dressmakers' articles, lettering for marking fabric and textile articles, artificial garlands and wreaths, artificial plants, artificial foliage, artificial fruit, artificial flowers and vegetables, toys, games, playthings, festive decorations, mats, rugs, gymnasium mats.

57. The applicant's terms *the bringing together, for the benefit of others, of a variety of art, textile and fabric design services, transportation services, conservation and preservation services, maintenance services, repair services, and restoration services, to enable purchasers to purchase those services by electronic means* has no equivalent in the opponent's specification. I understand the applicant's terms to

mean that a single point of contact/sale is offered for consumers to purchase these named services, namely design, repair, restoration etc. I do not find this service to be similar to the opponent's retail of goods as it is different in its nature, purpose and will attract different users. There is no competition or complementarity between the services.

58. Finally with regard to the remainder of the applicant's services in class 35 namely *advertising matter (dissemination of -); distribution of samples; social media strategy and marketing consultancy; providing business advice in the field of art, textiles, homeware, furniture, fashion; advertisement and marketing of social media accounts, texts, blogs and video logs; advertisement and marketing provided by means of blogging; none of the aforesaid services in relation to branding agency services; Advertising; marketing; merchandising; compilation of statistical information; database management services; advice for consumers; dissemination of advertisements; sales promotion; rental of advertising space; import and export agency services; information, advisory and consultancy services relating to all the aforesaid services, including such services provided online from a computer network and/or via a computer database or the Internet and/or extranets,* the opponent has not provided any reasoning as why these services are similar to its retail services. Absent any reasoning, I find that these services are different in nature, purpose and method of user. The users of the respective services are unlikely to overlap. I find these services to be dissimilar.

Class 40

59. The opponent has no direct equivalent class. The opponent has not provided any reasoning as why the applicant's services in this class are similar to its own goods or services. Absent any reasoning, I find that these services are different in nature, purpose and method of user. The users of the respective services are unlikely to overlap. I find these services to be dissimilar.

Class 41

60. The opponent has not provided any reasoning as why the applicant's services in this class are similar to its own goods or services. The opponent has no direct

equivalent class. I have considered the applicant's class 41 services and do not find a similarity with the opponent's goods or services.

Class 42

61. The opponent has not provided any reasoning as why the applicant's services in this class are similar to its own goods or services. Absent any reasoning, I find that these services are different in nature, purpose and method of user. The users of the respective services are unlikely to overlap. I find these services to be dissimilar.

62. Where I have found the goods and services to be dissimilar, it follows that there is no likelihood of confusion to be considered. I am guided on this matter in the case of *eSure Insurance v Direct Line Insurance*,[17] where Lady Justice Arden stated that:

> "49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

63. Accordingly the opposition under section 5(2)(b) fails for the goods and services I found to be dissimilar.

Average Consumer

64. I next consider who the average consumer is for the contested goods and services and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect[18]. For the purpose of assessing the likelihood of confusion, it must be borne in mind that

[17] [2008] ETMR 77 CA
[18] *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)

the average consumer's level of attention is likely to vary according to the category of goods or services in question[19].

65. The average consumer for the parties' goods is likely to be the general public whereas consumers for the parties' services is likely to include the general public and businesses. The goods are likely to have a wide price range, from the relatively inexpensive, e.g. stationery to expensive items like furniture. Similarly the contested service will also range in price. I find that consumers would be paying a medium level of attention as they will be purchasing an item on the basis of cost, aesthetics or suitability for purpose. The purchasing process will be predominantly visual as consumers are likely to browse in retail establishments, catalogues and their online equivalent website. There may also be an aural aspect to purchase either through word-of-mouth recommendations or advice sought from sales staff.

Mark comparisons

66. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*[20], 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."

[19] *Lloyd Schuhfabrik Meyer,* Case C-342/97.
[20] Case C-591/12P

67. 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.

68. The respective trade marks to be compared are:

Opponent's earlier registrations	**Applicant's mark**
STUDIO studio We Do Wow	Studio Spring

69. Both of the opponent's earlier registrations contain the word **STUDIO**. The '744 registration consists solely of **STUDIO** in block capitals with no other aspect to it. As such the overall impression is derived from this word. The '760 registration comprises the word **studio** positioned above the strapline **We Do Wow**. The letters in the word **studio** are set out in the same font but the letters S-T-U-D-I are depicted in black whereas the letter O, which ends the word, is depicted in greyscale. The positioning and scale of the word **studio** means it contributes more than the strapline to the overall impression of the registration.

70. The applicant's mark consists of two words **Studio Spring** in title case with no other aspect to it. I do not find that the combination of the words has a unitary meaning and as such both words contribute equally to the overall impression of the mark.

71. Taking first the visual comparison of the respective marks, they clearly all share the word **STUDIO**. It is the entirety of the '744 earlier registration and the dominant element of the '760 registration. The points of visual difference arise from the additional elements, namely the second word **Spring** in the applicant's mark and the strapline and the greyscale letter O, which has a noticeable visual impact, in the

opponent's '760 registration. It is settled case-law[21] that consumers are more likely to pay attention to the beginnings of marks rather than to the ends. Overall, when taking all these factors into account, I find there is a medium degree of visual similarity between the opponent's '744 registration and the applicant's mark. This is lowered slightly between the opponent's '760 registration and the applicant's mark.

72. In the aural comparison, the shared element **STUDIO** will be given its usual pronunciation which will be identical for the respective marks. Again the point of difference will arise from the additional element in the applicant's mark namely **Spring**. In my view the strapline in the opponent's '760 registration is unlikely to be articulated but if it is then it adds a further point of difference. Overall I find there is a medium degree of aural similarity between both the opponent's registrations and the applicant's mark if the strapline is not articulated. This is lowered slightly if the strapline is articulated.

73. Finally in relation to the conceptual comparison, the shared word **Studio** is a known dictionary word so will bring to mind its usual meaning. The opponent's strapline namely **We Do Wow**, whilst not being a grammatically correct phrase, will nonetheless likely be understood by consumers as meaning someone is doing something impressive. In my experience the word "wow" is a common if hyperbolic expression for something impressive.

74. With regard to the applicant's additional element namely **Spring**, the opponent, in its written submissions,[22] states the word will be seen as the season whereas the applicant has stated it is the applicant's surname.[23] I accept the word Spring is both the name of the season and can be a surname amongst its many other meanings. However in the structure of the mark **Studio Spring**, it is unclear what sort of concept a consumer would bring to mind as it is not a two word unit which produces a meaningful whole. In a conceptual comparison, it is settled case law that for a

[21] *El Corte Inglés, SA v OHIM*, Case T-39/10
[22] Opponent's written submissions, paragraph 16
[23] TM8 & counterstatement paragraph

conceptual message to be relevant it must be capable of immediate grasp by the average consumer.[24]

75. Overall I find that there is conceptual similarity to a low degree as the similarity lies only in the shared **STUDIO** element.

Distinctive character of the earlier registered trade mark

76. 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.

77. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,[25] 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 1-2779, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as

[24] This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM [2006]* e.c.r.-I-643; [2006] E.T.M.R. 29.
[25] Case C-342/97

originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

78. I will first consider the inherent distinctiveness of the opponent's earlier marks. The word **STUDIO** is an ordinary dictionary word and has no meaning in relation to the goods and services for which it is registered. Therefore I find that the earlier '744 registration is inherently distinctive to a medium degree. The '760 has the additional stylisation and strapline **We Do Wow** which slightly increases its distinctiveness, although it is the distinctiveness of the common element which is the key factor for my consideration.

79. As evidence has been provided for the '744 registration, I must consider whether use made of this mark has enhanced its distinctiveness (a finding which, given the identity of the marks, would be transferable to the other earlier registration). I remind myself of the *Windsurfing Chiemsee* factors set out above as to what I should consider.

80. The evidence demonstrated that there has been use of the mark on some goods, retail services and on credit services. There has been considerable turnover for both total sales and sales of branded Studio goods. I also note the extensive advertising expenditure, the TV and social media advertisements and the geographically wide customer base in the UK. Although no market share figure has been provided, the evidence is sufficient to find that the earlier marks' distinctive character has been enhanced though use to a somewhat higher degree.

Likelihood of confusion

81. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.[26] I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective

[26] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa.

82. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

83. In *L.A. Sugar Limited*[27]*,* Mr Iain Purvis Q.C., sitting as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark

84. Moreover in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors,* [28] Arnold LJ approved Mr Purvis's formulation but added:

> "13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood

[27] *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10
[28] [2021] EWCA Civ 1207

of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

85. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17. This is mere association not indirect confusion.

86. So far in this decision I have found that,

- Some goods and services are identical and similar to varying degrees, whilst some are dissimilar.
- The average consumer will pay a medium level of attention during the primarily visual purchasing process.
- There is a medium degree of visual and aural similarity between the opponent's '744 registration and the applicant's mark.
- There is a lower than medium degree of visual and aural similarity between the opponent's '760 registration and the applicant's mark if all elements with the '760 registration are verbalised.
- There is conceptual similarity to a low degree only for the shared word Studio
- The earlier marks are inherently distinctive to a medium degree but this has been enhanced because of use.

87. The respective marks clearly share the same word, namely **STUDIO**. However I find this similarity is outweighed by the differences, namely the additional word **Spring**, in the applicant's mark. This additional word is sufficient in my view for the average consumer not to directly confuse the marks, that is to mistake one mark for the other even where the goods and services are identical.

88. Having found that there is no likelihood of direct confusion, I now consider whether there is any indirect confusion. I remind myself of the guidance given in *L.A.Sugar* that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common

element to a shared undertaking, taking one mark to be a possible brand extension or sub brand of the other mark.

89. I cannot see a reason why the average consumer on seeing **Studio Spring** would assume that this is a brand extension from the opponent. The additional word **Spring** is an independently distinctive element of the applicant's mark and does not appear to be a likely brand extension. As such I do not find the average consumer is likely to be confused in to believing that respective goods and services come from the same or economically linked undertakings. I find there is no likelihood of indirect confusion.

90. I am guided in my conclusion by the case law in *Annco, Inc. V OHIM,*[29] where the General Court considered an appeal against OHIM's decision that there was no likelihood of confusion between ANN TAYLOR LOFT and LOFT (both for clothing and leather goods) and found that:

> "48. In the present case, in the light of the global impression created by the signs at issue, their similarity was considered to be weak. Notwithstanding the identity of the goods at issue, the Court finds that, having regard to the existence of a weak similarity between the signs at issue, the target public, accustomed to the same clothing company using sub-brands that derive from the principal mark, will not be able to establish a connection between the signs ANN TAYLOR LOFT and LOFT, since the earlier mark does not include the 'ann taylor' element, which is, as noted in paragraph 37 above (see also paragraph 43 above), the most distinctive element in the mark applied for.
>
> 49 Moreover, even if it were accepted that the 'loft' element retained an independent, distinctive role in the mark applied for, the existence of a likelihood of confusion between the signs at issue could not for that reason be automatically deduced from that independent, distinctive role in that mark.
>
> 50 Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case

[29] Case T-385/09

(*SABEL*, paragraph 18 above, paragraph 22; see, also, Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services at issue, marketing methods, whether the public's level of attention is higher or lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, prima facie, the existence of a likelihood of confusion between the signs at issue."

91. The opposition under section 5(2)(b) is unsuccessful.

Section 5(3)

92. I next turn to consider the claim made under section 5(3). The opponent opposed the application under this ground based on its two earlier registrations for which it claims to have a reputation.

93. 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 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."

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

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

92. The relevant case law can be found in the following judgments of the CJEU: Case C375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oréal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case

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

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

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

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

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

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

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

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

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

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

95. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its registrations and the application are similar. Secondly, the opponent must show that its registrations have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier registrations being brought to mind by the contested mark. Finally, assuming the first three 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 and services 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.

Reputation

96. I must consider whether the opponent's registrations have met the test for reputation. 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."

97. Having considered the factors set out above and weighing in the evidence that I assessed earlier in this decision, I find that the opponent has established the requisite reputation for its retail services in class 35 based on the evidence provided, for the mark **STUDIO.** I do not find that it has established a reputation for its goods classes nor the credit service in class 36. under this mark. Nor do I find that the opponent has established a reputation for its **STUDIO We Do Wow** registration.

Link

98. As noted above, the 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* underlined below are:

The degree of similarity between the conflicting marks

99. For the reasons given at paragraphs 68 to 72, I found there is a medium degree of visual and aural similarity between the opponent’s ‘744 registration and the applicant’s mark. There is conceptual similarity to a low degree for the shared word Studio.

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

100. The contested goods and services will be purchased by the general public and businesses, paying a medium degree of attention. I have already found that some of goods and services are identical and similar to varying degrees but some of the goods and services were dissimilar.

The strength of the earlier mark’s reputation

101. The earlier mark **STUDIO** has established a sufficient reputation for retail services.

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

102. For the reasons given at paragraphs 75 to 77, the registration for **STUDIO** is inherently distinctive to a medium degree. Given the use which has been made of the earlier mark, I find that the distinctiveness has been enhanced to a high degree.

Whether there is a likelihood of confusion

103. For the reasons given at paragraphs 83 to 87, I do not find that there was either direct or indirect likelihood of confusion between the respective marks.

104. In considering all the relevant factors set out above, I do not find that a significant proportion of UK consumers will make the link between **Studio Spring** when used in

relation to the goods and services covered by the application and **STUDIO** with its reputation for retail services.

105. If I am wrong about this, then I am satisfied that if a link is made between the respective marks, it would be fleeting and unlikely to give rise to the conditions covered by section 5(3) of the Act.

Section 5(4)(a)

106. I remind myself that under section 5(4)(a), the cancellation applicant relies on the following sign namely **STUDIO** for which it has claimed use since 2002 for retail and online retail services.

107. Section 5(4)(a) states:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > (aa) […]
> >
> > (b) […]
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

108. Subsection (4A) of Section 5 states:

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

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

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

110. In *Reckitt & Colman Products Limited v Borden Inc. & Ors*,[30] Lord Oliver of Aylmerton described the 'classical trinity' that must be proved in order to reach a finding of passing off:

> "First, [the plaintiff] must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

111. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

> "Establishing a likelihood of deception generally requires the presence of two factual elements:

[30] [1990] RPC 341, HL, page 406.

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon;
(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
(c) the similarity of the mark, name etc used by the defendant to that of the claimant;
(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action".

Relevant date

112. In terms of the relevant date for assessment of section 5(4)(a), in *Advanced Perimeter Systems Limited v Multisys Computers Limited,*[31] Mr Daniel Alexander QC (as he was then), sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in SWORDERS Trade Mark:[32]

> 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'"

113. The filing date of the contested application is 15 March 2023 and the applicant has not provided any evidence of use. As such, all factors will be considered as at this date.

Goodwill

114. The first hurdle for the opponents is to show that they had the required goodwill at the relevant date. The issue of what constitutes goodwill was discussed in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd*[33] viz,

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

[31] BL O-410-11
[32] BL O-212-06
[33] [1901] AC 217 (HOL)

115. In *Smart Planet Technologies, Inc. v Rajinda Sharm*[34]*,* Mr Thomas Mitcheson QC (as he was then), sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

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

116. The relevant market for assessing goodwill is the UK. Goodwill arises as a result of trading activities. Given my previous assessment of the evidence, I find that the opponent has provided very large retail sales figures. It has established a UK wide customer base and has provided sufficient evidence of its advertising expenditure. Taking all this into account, I find that the opponent has shown it has goodwill in **Studio** for retail services in relation to the goods for which it has shown evidence, namely *Retail and wholesale services in connection with the sale of stationery products, books, arts and crafts materials, games, toys and playthings, tricycles, bicycles, nursery products, cleaning products, clothing, footwear and headgear, cosmetics, containers, textiles, soft furnishings, bags and luggage, bathroom accessories, namely bathroom household containers, and bathroom furniture.*

Misrepresentation

117. Having cleared the first hurdle of goodwill, I will go on to consider the second hurdle that of misrepresentation. In *Neutrogena Corporation and Another v Golden Limited and Another*[35], Morritt L.J. stated that:

[34] BL O/304/20
[35] [1996] RPC 473

"There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

> "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]"

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

".... for my part, I think that references, in this context, to "more than *de minimis* " and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

118. On the subject of how many of the relevant public must be deceived or confused for the opponent to be successful in a claim under this ground, I bear in mind the decision in *Lumos Skincare Limited v Sweet Squared Limited and others*[36], where Lord Justice Lloyd commented on the paragraph above as follows:

"64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the "substantial number" of people who have been or would be misled by the Defendant's use of the mark, if the

[36] [2013] EWCA Civ 590

> Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small."

119. Accordingly, once it has been established that the party relying on the existence of an earlier right under section 5(4)(a) had sufficient goodwill at the relevant date to find a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

120. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation*,[37] Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

> "… if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement."

121. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd,* [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora,* [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that *"a substantial number"* of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal's later judgment in *Comic Enterprises,* it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests

[37] [2016] EWCA Civ 41

intended to exclude the particularly careless or careful, rather than quantitative assessments.

122. Under section 5(2)(b) I have already found that there would be no direct or indirect confusion based on the respective marks. I do not see why the same would not apply to misrepresentation under section 5(4)(a) even for similar retail services. I do not think consumers will be deceived but if some are then it would be in such insufficient quantities to represent a substantial number as per the case law cited above. As such I do not find any misrepresentation. The opposition based on section5(4)(a) fails at this hurdle.

Conclusion

123. The opposition has failed. Subject to any appeal of this decision the application can proceed to registration.

Costs

124. The applicant has been successful, so it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. Bearing in mind the guidance given in this TPN, I award costs as follows:

£400 Considering the Notice of Opposition and filing a counterstatement
£800 Considered the other's side's evidence
£350 Preparation of written submissions
£1550 Total

125. I order Frasers Group Financial Services Limited to pay Laura Spring the sum of £1550. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of February 2025

June Ralph
For the Registrar
The Comptroller-General