

O/0170/25

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 4029371
IN THE NAME OF HBTRADING LTD
TO REGISTER THE FOLLOWING TRADE MARK:**

NUUD

IN CLASSES 24, 25, 26, 35

AND

**IN THE MATTER OF FAST TRACK OPPOSITION THERETO
UNDER NO. 600003357
BY
GEORGES VICIDOMINI**

Background and pleadings

1. HBTRADING Ltd (“the applicant”) applied to register the trade mark NUUD in the UK on 21 March 2024 (“the contested mark”). It was accepted and published for opposition purposes on 5 April 2024 in respect of the following goods/services:

Class 24 - Knitted elastic fabrics for ladies underwear; Lingerie fabric; Lingerie fabrics.

Class 25 - Underwear; Jockstraps [underwear]; Briefs [underwear]; Sweat-absorbent underclothing [underwear]; Trunks [underwear]; Sweat-absorbent underwear; Underwear (Anti-sweat -); Anti-sweat underwear; Maternity underwear; Boy shorts [underwear]; Disposable underwear; Knitted underwear; Underwear for women; Undergarments; Underpants; Thermal underwear; Babies' pants [underwear]; Men's underwear; Functional underwear; Underclothes; Women's underwear; Long underwear; Gussets for underwear [parts of clothing]; Nappy pants [clothing]; Teddies [undergarments]; Panties; Shorts [clothing]; Ladies' underwear; Lingerie; Slips [undergarments]; Knickers; Clothes; Pants; Bottoms [clothing]; G-strings; Underpants for babies; Babies' pants [clothing]; Trousers shorts; Thongs; Jogging bottoms [clothing]; Underclothing; Maternity pants; Maternity lingerie; Trunks being clothing; Teddies [underclothing]; Thong sandals; Denim pants; Camouflage pants; Waterproof pants; Clothing; Dress pants; Pajamas; Leggings [trousers]; Gloves [clothing]; Gloves as clothing; Trouser socks; Undershirts; Underclothing (Anti-sweat -); Anti-sweat underclothing; Corsets [underclothing]; Silk clothing; Socks and stockings; Sweat-absorbent underclothing; Denims [clothing]; Bodices [lingerie]; Pyjamas; Braces for clothing [suspenders]; Latex clothing; Jogging pants; Corsets [clothing, foundation garments]; Chaps (clothing); Leather pants; Drawers [clothing]; Drawers as clothing; Baby pants; Anti-perspirant socks; Bra straps [parts of clothing]; Trousers; Maternity shorts; Braces [suspenders] for clothing / Suspenders [braces] for clothing; Tops [clothing]; Slips [underclothing]; Slips [clothing]; Hosiery; Gussets for tights [parts of clothing]; Beach clothes; Bandeaux [clothing]; Babies' undergarments; Waterproof clothing; Cycling pants; Sleep pants; Maillots [hosiery]; Sweat-absorbent socks; Nipple pasties being underclothing; Swimsuits; Muffs

[clothing]; Bed socks; Woolen clothing; Sweatpants; Aprons [clothing]; Bras; Pantyhose; Womens' undergarments; Mitts [clothing]; Linen clothing; Moisture-wicking sports pants; Garments for protecting clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Furs [clothing]; Layettees [clothing]; Clothing layettes; Headbands [clothing]; Headbands for clothing; Maternity clothing; Kerchiefs [clothing]; Jerseys [clothing]; Cashmere clothing; Capes (clothing); Oilskins [clothing]; Gabardines [clothing]; Leather clothing; Clothing of leather; Leather (Clothing of-); Parts of clothing, footwear and headgear; Collars [clothing]; Veils [clothing]; Knitted clothing; Embroidered clothing; Hoods [clothing]; Windproof clothing; Wristbands [clothing]; Belts [clothing]; Belts for clothing; Casual clothing; Rainproof clothing; Jackets being sports clothing; Visors [clothing]; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Clothing for leisure wear; Ready-made clothing; Playsuits [clothing]; Woven clothing; Infant clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Ties [clothing]; Clothing for children; Bodies [clothing]; Clothing for infants; Clothing for babies; Weatherproof clothing; Clothing for cycling; Water-resistant clothing; Fabric belts [clothing]; Pockets for clothing; Handwarmers [clothing]; Clothing for skiing; Beach clothing; Triathlon clothing; Thermal clothing; Cowls [clothing]; Men's clothing; Dance clothing; Braces for clothing; Plush clothing.

Class 26 - Lingerie tapes; Brooches for clothing; Whalebones for clothing; Bows for clothing; Fastenings for clothing; Clothing (Fastenings for -); Clothing buckles; Patches for clothing; Buckles [clothing accessories].

Class 35 - Retail services relating to clothing; Retail services connected with the sale of clothing and clothing accessories.

2. Georges Vicidomini (“the opponent”) opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon UK trade mark number 918257831: DnuD (“the earlier mark”). This trade mark was filed on 19 June 2020 and registered on 14 October 2020. Whilst registered for goods in a number of classes, for the purposes of this opposition it relies upon the following only:

Class 24 - Fabrics for the manufacture of apparel.

Class 25 - Bathing suits; Lingerie; Underwear; Underwear; Footwear; Leather shoes; Beach shoes; Underwear; Jerseys [clothing]; Clothing; Clothing for leisure wear; Nightwear; Beach clothes; Rainwear; Children's wear; Nightwear; Skull caps; Hats; Visors being headwear.

3. Under section 5(2)(b) of the Act, the opponent claims that there is a likelihood of confusion on the basis that the marks are similar, and the goods/services are either identical or highly similar leading to a likelihood of confusion, including a likelihood of association, and that the contested mark should be refused registration.

4. The applicant filed a defence and counterstatement denying the ground of opposition and submitting that the contested mark is dissimilar to, and distinguishable from, the earlier mark and therefore there cannot exist any likelihood of confusion on the part of the public between the marks. I note from its counterstatement, the applicant has accepted that the respective goods in classes 24 and 25 are identical, that there is similarity between the applicant's class 26 goods and the opponent's goods in the same classes (but not the extent of similarity) and that in certain circumstances the class 35 retail services could be similar to the opponent's clothing goods in class 25.

5. In accordance with section 6 of the Act, the mark relied upon by the opponent is considered an earlier mark. The mark has not been registered for five years at the date of application for the contested mark and so, in accordance with section 6A of the Act, it is not subject to proof of use; the opponent may rely upon all the goods as identified.

6. Rule 6 of the Trade Marks (Fast Track Opposition (Amendment) Rules 2013, S.I. 2013 2235 disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but it provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give live to either party to file evidence upon such terms as the registrar thinks fit.”

7. The effect of the above is to require parties to seek leave in order to file evidence in fast track oppositions. Further, Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it, or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

8. In this case, neither party sought leave to file evidence. A hearing was neither requested nor was it considered necessary. The parties did however elect to file written submissions in lieu, both dated 21 October 2024. Whilst I do not propose to summarise the parties' submissions, I shall refer to them as and where appropriate during this decision. This decision is taken following a careful consideration of all papers on file.

Representation

9. The opponent is represented by Lara Grant and the applicant is represented by Wilson Gunn.

Relevance of EU LAW

10. 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 which predate the UK's withdrawal from the EU.

Decision

Section 5(2)(b)

11. Section 5(2)(b) of the Act is 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”.

12. Section 5A of the Act states as follows:

“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.”

Relevant law

13. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

14. The competing goods/services are shown in the table below:

The earlier mark	The contested mark
Class 24 - Fabrics for the manufacture of apparel.	Class 24 - Knitted elastic fabrics for ladies underwear; Lingerie fabric; Lingerie fabrics.
Class 25 - Bathing suits; Lingerie; Underwear; Underwear; Footwear; Leather shoes; Beach shoes; Underwear; Jerseys [clothing]; Clothing; Clothing for leisure wear; Nightwear; Beach clothes; Rainwear; Children's wear; Nightwear; Skull caps; Hats; Visors being headwear.	Class 25 - Underwear; Jockstraps [underwear]; Briefs [underwear]; Sweat-absorbent underclothing [underwear]; Trunks [underwear]; Sweat-absorbent underwear; Underwear (Anti-sweat -); Anti-sweat underwear; Maternity underwear; Boy shorts [underwear]; Disposable underwear; Knitted underwear; Underwear for women; Undergarments; Underpants; Thermal underwear; Babies' pants [underwear]; Men's underwear; Functional underwear; Underclothes; Women's underwear; Long underwear; Gussets for underwear [parts of clothing]; Nappy pants [clothing]; Teddies [undergarments]; Panties; Shorts [clothing]; Ladies' underwear; Lingerie; Slips [undergarments]; Knickers; Clothes; Pants; Bottoms [clothing]; G-strings; Underpants for babies; Babies' pants [clothing]; Trousers shorts; Thongs; Jogging bottoms [clothing]; Underclothing; Maternity pants; Maternity lingerie; Trunks being clothing; Teddies [underclothing]; Thong sandals; Denim pants; Camouflage pants; Waterproof pants; Clothing; Dress pants;

	<p>Pajamas; Leggings [trousers]; Gloves [clothing]; Gloves as clothing; Trouser socks; Undershirts; Underclothing (Anti-sweat -); Anti-sweat underclothing; Corsets [underclothing]; Silk clothing; Socks and stockings; Sweat-absorbent underclothing; Denims [clothing]; Bodices [lingerie]; Pyjamas; Braces for clothing [suspenders]; Latex clothing; Jogging pants; Corsets [clothing, foundation garments]; Chaps (clothing); Leather pants; Drawers [clothing]; Drawers as clothing; Baby pants; Anti-perspirant socks; Bra straps [parts of clothing]; Trousers; Maternity shorts; Braces [suspenders] for clothing / Suspenders [braces] for clothing; Tops [clothing]; Slips [underclothing]; Slips [clothing]; Hosiery; Gussets for tights [parts of clothing]; Beach clothes; Bandeaux [clothing]; Babies' undergarments; Waterproof clothing; Cycling pants; Sleep pants; Maillots [hosiery]; Sweat-absorbent socks; Nipple pasties being underclothing; Swimsuits; Muffs [clothing]; Bed socks; Woolen clothing; Sweatpants; Aprons [clothing]; Bras; Pantyhose; Womens' undergarments; Mitts [clothing]; Linen clothing; Moisture-wicking sports pants; Garments for protecting clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Furs [clothing];</p>
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	<p>Layettes [clothing]; Clothing layettes; Headbands [clothing]; Headbands for clothing; Maternity clothing; Kerchiefs [clothing]; Jerseys [clothing]; Cashmere clothing; Capes (clothing); Oilskins [clothing]; Gabardines [clothing]; Leather clothing; Clothing of leather; Leather (Clothing of-); Parts of clothing, footwear and headgear; Collars [clothing]; Veils [clothing]; Knitted clothing; Embroidered clothing; Hoods [clothing]; Windproof clothing; Wristbands [clothing]; Belts [clothing]; Belts for clothing; Casual clothing; Rainproof clothing; Jackets being sports clothing; Visors [clothing]; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Clothing for leisure wear; Ready-made clothing; Playsuits [clothing]; Woven clothing; Infant clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Ties [clothing]; Clothing for children; Bodies [clothing]; Clothing for infants; Clothing for babies; Weatherproof clothing; Clothing for cycling; Water-resistant clothing; Fabric belts [clothing]; Pockets for clothing; Handwarmers [clothing]; Clothing for skiing; Beach clothing; Triathlon clothing; Thermal clothing; Cowls [clothing]; Men's clothing; Dance clothing; Braces for clothing; Plush clothing.</p>
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	Class 26 - Lingerie tapes; Brooches for clothing; Whalebones for clothing; Bows for clothing; Fastenings for clothing; Clothing (Fastenings for -); Clothing buckles; Patches for clothing; Buckles [clothing accessories].
	Class 35 - Retail services relating to clothing; Retail services connected with the sale of clothing and clothing accessories.

15. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account, as per *Canon*, where the CJEU stated at paragraph 23 of its judgement:

“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.”

16. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

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

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

18. I bear in mind that it is permissible to group goods together for the purposes of the assessment¹.

Class 24

Knitted elastic fabrics for ladies underwear; Lingerie fabric; Lingerie fabrics.

19. These are all types of fabric to be used in the manufacture of lingerie and ladies underwear. The applicant has admitted in written submissions that the goods listed in class 24 of the application are identical to those in the opponent’s specification. In my view, I agree that this is the case and I find the goods to be identical.

¹ Separode Trade Mark O/399/10

Class 25

20. It is worth noting at the outset of class 25 that the applicant has admitted in written submissions that the goods listed in this class of the application are identical to those in the opposition trade mark.

Underwear; Jockstraps [underwear]; Briefs [underwear]; Sweat-absorbent underclothing [underwear]; Trunks [underwear]; Sweat-absorbent underwear; Underwear (Anti-sweat -); Anti-sweat underwear; Maternity underwear; Boy shorts [underwear]; Disposable underwear; Knitted underwear; Underwear for women; Undergarments; Underpants; Thermal underwear; Babies' pants [underwear]; Men's underwear; Functional underwear; Underclothes; Women's underwear; Long underwear; Gussets for underwear [parts of clothing]; Nappy pants [clothing]; Teddies [undergarments]; Panties; Ladies' underwear; Lingerie; Slips [undergarments]; Knickers; G-strings; Underpants for babies; Babies' pants [clothing]; Thongs; Underclothing; Maternity pants; Maternity lingerie; Trunks being clothing; Teddies [underclothing]; Undershirts; Underclothing (Anti-sweat -); Anti-sweat underclothing; Corsets [underclothing]; Sweat-absorbent underclothing; Corsets [clothing, foundation garments]; Slips [underclothing]; Babies' undergarments; Bras; Pantyhose; Womens' undergarments; Bodices [lingerie]; Nipple pasties being underclothing; Trouser socks; Socks and stockings; Anti-perspirant socks; Hosiery; Maillots [hosiery]; Sweat-absorbent socks; Bed socks; Bra straps [parts of clothing]; Gussets for tights [parts of clothing]; Denim pants; Camouflage pants; Waterproof pants; Clothing; Dress pants; Pajamas; Leggings [trousers]; Silk clothing; Denims [clothing]; Pyjamas; Latex clothing; Jogging pants; Chaps (clothing); Leather pants; Drawers [clothing]; Drawers as clothing; Baby pants; Trousers; Maternity shorts; Tops [clothing]; Slips [clothing]; Beach clothes; Bandeaux [clothing]; Sleep pants; Woolen clothing; Sweatpants; Linen clothing; Garments for protecting clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Furs [clothing]; Layettees [clothing]; Clothing layettes; Maternity clothing; Jerseys [clothing]; Cashmere clothing; Gabardines [clothing]; Leather clothing; Clothing of leather; Leather (Clothing of-); Knitted clothing; Embroidered clothing; Wristbands [clothing]; Casual clothing; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Ready-made clothing; Playsuits [clothing]; Woven clothing; Infant clothing; Clothing for

children; Bodies [clothing]; Clothing for infants; Clothing for babies; Pockets for clothing; Men's clothing; Plush clothing; Trousers shorts; Shorts [clothing]; Clothes; Jogging bottoms [clothing]; Pants; Bottoms [clothing]; Parts of clothing, footwear and headgear; Gloves [clothing]; Gloves as clothing; Braces for clothing [suspenders]; Braces [suspenders] for clothing / Suspenders [braces] for clothing; Aprons [clothing]; Mitts [clothing]; Muffs [clothing]; Capes (clothing); Veils [clothing]; Belts [clothing]; Belts for clothing; Visors [clothing]; Handwarmers [clothing]; WeaFabric belts [clothing]; Braces for clothing; Ties [clothing]; Collars [clothing]; Cowls [clothing]; Kerchiefs [clothing]; Hoods [clothing]; Headbands [clothing]; Headbands for clothing; Waterproof clothing; Cycling pants; Swimsuits; Moisture-wicking sports pants; Windproof clothing; Rainproof clothing; Jackets being sports clothing; Clothing for leisure wear; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; therproof clothing; Clothing for cycling; Water-resistant clothing; Clothing for skiing; Beach clothing; Triathlon clothing; Thermal clothing; Dance clothing; Oilskins [clothing];

21. All the aforementioned goods in the applicant's specification are either items of clothing or underwear which are self-evidently identical or fall within the broader categories of 'clothing' and 'underwear' in the opponent's specification in class 25. The goods are, therefore, identical on the principle outlined in *Meric*.

Thong sandals;

22. These goods are worn as footwear and are encompassed within the opponent's broader category of 'footwear'. They are identical according to *Meric*.

Class 26

Lingerie tapes; Brooches for clothing; Whalebones for clothing; Bows for clothing; Fastenings for clothing; Clothing (Fastenings for -); Clothing buckles; Patches for clothing; Buckles [clothing accessories].

23. The applicant has admitted that there are similarities between the class 26 goods of the contested mark and the class 24 and 25 goods of the earlier mark to the extent that the class 26 goods can be accessories to the goods in classes 24 and 25.

24. In *Les Éditions Albert René v OHIM*², the General Court (“GC”) found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

25. As highlighted in *Les Éditions* above, the GC held that just because a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar. However, in this case, the opponent’s “*Lingerie tapes; Brooches for clothing; Whalebones for clothing; Bows for clothing; Fastenings for clothing; Clothing (Fastenings for -); Clothing buckles; Patches for clothing; Buckles [clothing accessories]*” relate to the fastening components of the applicant’s above clothing and accessories.

26. I consider that the nature of these items will likely be the same or similar to the opponent’s clothing, and for the same purpose. These items will likely be sold through the same trade channels to the same users as the opponent’s goods. It is also necessary for me to consider whether the goods are complementary, in that there is a close connection between them in the sense that one is essential or important for the use of the other.

27. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

² Case T-336/03

28. Given that the items in this class are fastenings for clothing, I do consider them complimentary. Overall, upon considering the levels of similarity between the nature, intended purpose and customer base, I do find the goods in class 26 to be similar to a medium degree to the opponent's clothing and underwear goods in class 25.

Class 35

Retail services relating to clothing; Retail services connected with the sale of clothing and clothing accessories.

29. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, 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.

30. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

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

31. 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 normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

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

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

32. The applicant admits that the class 35 services of the contested mark, being in relation to the retail of clothing, can be similar to the class 25 goods of the earlier mark, being in relation to the manufacture of clothing.

33. As highlighted in *Oakley* above, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. In this case, the opponent's "*Retail services relating to clothing; Retail services connected with the sale of clothing and clothing accessories*" relate to the sale of the applicant's above clothing and accessories. I consider it likely that the opponent's goods in class 25 will be sold

through the same trade channels as the applicant's retail services for the same goods, to the same users, and as such the goods and services are complementary. I, therefore, consider them to be similar to a medium degree.

The average consumer and the purchasing process

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

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

35. The average consumer for the goods and services is likely to be a member of the general public. The goods and services are unlikely to be particularly expensive purchases. They are not likely to be purchased every day, although will be purchased reasonably frequently. For the goods, factors such as materials, aesthetics and comfort are likely to be taken into consideration. For the services, factors such as location, range of products and customer services standards are likely to be taken into consideration. Consequently, I consider that the average consumer will pay a medium (or average) degree of attention during the purchasing process.

36. The goods are likely to be purchased by self-selection from the shelves of a retail outlet, or online equivalent. Similarly, the services are likely to be purchased following perusal of a website or signage on physical premises. Consequently, visual

considerations will dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants and word-of-mouth recommendations may play a part.

Comparison of marks

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

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

38. It would be wrong, therefore, to dissect the trade marks artificially, 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.

39. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
DnuD	NUUD

40. In its written submissions, the applicant denies the opponent’s statement that the marks are identical or similar. The applicant submits that the sale of clothing is predominantly a visual activity to which the average consumer would attribute more bearing on the first characters of the marks when comparing them. The applicant

accepts that both marks share the same suffix, being 'UD', but submits that this does not equate to a high similarity between the marks.

41. The applicant's mark is a word only mark consisting solely of the word 'NUUD'. There are no other elements to contribute to the overall impression of the mark, which lies in this word.

42. The opponent's mark is also a word only mark, consisting solely of the word 'DnuD'. There are no other elements to contribute to the overall impression of the mark, which lies in this word.

Visual comparison

43. It is necessary to consider that both marks are word only marks and are, therefore, capable of being presented in the same typeface. A word trade mark protects the notional use of the word itself, irrespective of font, capitalisation or otherwise and therefore the difference in casing will have little impact on my assessment.

44. Both marks are four letter words comprised of the same three letters, albeit in a different order and with repetition of a different letter in each. I note that both marks begin with a different letter, and that this does draw attention to the visual differences at the beginning of the mark, as per *El Corte Inglés, SA v OHIM*³, particularly given that both marks are short. However, what follows thereafter is similar, with 'NUD' in the contested mark being highly similar to the overall appearance of the earlier mark 'DnuD'.

45. I note that the applicant states that the contested mark is a mis-spelling of the word 'nude'. However, on first sight I do not consider that this is immediately obvious from a visual perspective.

46. Notwithstanding *El Corte Inglés*, given that both marks are four letter words comprising of the same three letters, presented in a similar way, I consider there to be a high degree of visual similarity between the marks.

³ Cases T-183/02 and T-184/02

Aural comparison

47. As both marks are not obvious dictionary words, it is not clear how they will be pronounced.

48. In respect of the earlier mark, I consider that 'DNUD' is likely to be pronounced by the average consumer as DUH-NUD or DEE-NUD. There is also the possibility that the mark will be pronounced letter by letter.

49. In respect of the contested mark, the applicant states in written submissions that 'NUUD' is a mis-spelling of the English word 'nude'⁴ and is pronounced "nju:d / nu:d". If it is the case that the consumer pronounces the contested mark in this way, I find there to be a low to medium degree of aural similarity. However, this is not a commonly used mis-spelling and therefore I find that whilst it is possible that the contested mark will be pronounced in a number of ways, in absence of evidence to the contrary, and following normal paradigms I consider it is likely to be pronounced as NUD by the average consumer. Consequently, I find that there is a high degree of similarity with the earlier mark.

Conceptual comparison

50. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM*⁵. The assessment must be made from the point of view of the average consumer.

51. Conceptually, the earlier mark is an invented word and has no meaning. It is, therefore, something of a guess on the part of the consumer as to how both words are perceived.

52. The contested mark must be considered from two different perspectives depending on pronunciation, as this will have a bearing on the conceptual aspect of the mark when considered by a consumer. In its written submissions, the applicant states that the pronunciation of its mark is as per the English word 'nude' (as per para

⁴ Meaning not wearing any clothes - Oxford dictionaries

⁵ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

49). If the average consumer recognises the contested mark as the misspelling of the word 'nude', the meaning of this is wearing no clothes or naked. Therefore, given that the contested mark has a meaning, but the earlier mark will be regarded as a word with no meaning, the two marks would be conceptually dissimilar.

53. However, as per para 49, given that the contested mark is not a commonly used mis-spelling of the word nude the average consumer is likely to primarily perceive it as an invented word with no meaning. In these instances, given that no conceptual comparison is possible the marks will be conceptually neutral.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

55. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it. The opponent has not pleaded that its mark has obtained an enhanced level of distinctiveness and being fast track proceedings, no evidence has been filed to that effect. Therefore, I only have the inherent position to consider.

56. The earlier mark is an invented word which does not allude to or describe the goods provided. Therefore, I am of the view that the earlier mark is inherently distinctive to a high degree.

Likelihood of Confusion

57. 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/services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods/services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

I remind myself that I made the following findings:

- I have found the contested mark and the earlier mark to be conceptually similar to a low degree if the consumer accepts that the contested mark is

perceived as 'nude'. However, as per my findings above, I consider it is likely to be perceived primarily as an invented word by the average consumer which makes the marks conceptually neutral;

- I have found the opponent's earlier mark to be inherently distinctive to a high degree;
- I have identified that the average consumer will be a member of the general public who will select the goods primarily by visual means, although I do not discount an aural component;
- I have concluded that a medium degree of attention will be paid during the purchasing of goods and services;
- I have found the parties' goods and services to be either identical or similar in varying degrees (no less than a medium degree).

58. Upon considering the above factors, and bearing in mind the principle of imperfect recollection, I consider the present case represents an example of direct confusion. I consider that the consumer upon seeing the later mark NUUD is unlikely to recall the exact spelling of the earlier mark DnuD. Given the overall similarity between the marks both visually and aurally, I consider that the consumer will overlook the difference created by the first letter and the spelling of either mark leading them to be misremembered. I consider that consumers are unlikely to recall the precise order or sequence of the letters and must instead rely upon the imperfect picture of them retained in its mind. This is particularly so because consumers rarely have the opportunity to compare marks side by side. Since the earlier mark will be viewed as invented with a high degree of distinctive character, I am satisfied that there is sufficient similarity for the marks to be mistaken for one another in relation to goods and services, that I found to be identical or similar to at least a medium degree.

59. I consider that the contested mark is unlikely to be pronounced or perceived as 'nude' by the average consumer and therefore being perceived as invented words, the differences between them are insufficient to enable consumers to distinguish between them. Ultimately, the words being the same length and comprising of the same three letters gives sufficient aural and visual similarity to lead to consumers

mistaking one mark for the other. As a result, taking all the above into account in the global assessment I consider that there exists a likelihood of direct confusion.

Conclusion

60. The opposition succeeds in full and, subject to any successful appeal, the applicant's mark is refused registration for all goods and services for which protection was sought.

Costs

61. As the opponent has been successful in opposing the applicant's mark, he is entitled to a contribution towards his costs, based upon the scale published in Tribunal Practice Notice 1/2023 which governs costs in Fast Track proceedings issued after 1 February 2023. In the circumstances, I award the opponent the sum of £450.00 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a notice of opposition and considering the Applicant's counterstatement:	£250.00
Written submissions:	£100.00
Official fee:	£100.00
Total:	£450.00

I therefore order HB Trading Ltd to pay Georges Vicidomini the sum of £450.00. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 25th day of February 2025

**L Bailey
For the Registrar**