O/0388/24

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION No. 3595321

IN THE NAME OF PAIGE AND PARTRIDGE

AND

APPLICATION No. 505473 BY PAIGE, LLC

FOR THE REGISTRATION TO BE INVALIDATED AND CANCELLED

BACKGROUND AND PLEADINGS

1. This is an application by Paige, LLC ("the applicant") under section 47(2) of the Trade Marks Act 1994 ("the Act") to invalidate trade mark registration 3595321. The contested trade mark is shown below:

2. The application to register the mark was filed on 14th February 2021 and the mark was registered on 25th June 2021. The registered proprietor is Paige and Partridge ("the proprietor"), which is a business based in Yorkshire.

3. The contested mark is registered in class 25 in relation to:

> Clothing; Tops [clothing]; Knitted clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Sports clothing; Girls' clothing; Knitwear [clothing]; Jerseys [clothing]; Casual clothing; Collars [clothing]; Women's clothing; Embroidered clothing; Jackets [clothing]; Muffs [clothing].

4. The applicant is the registered proprietor of trade mark 904023487. This consists of the word PAIGE. It is also registered in class 25 in relation to *clothing, footwear, headgear* (without restriction).[1] It is a 'comparable trade mark' created in accordance with withdrawal legislation enacted when the UK left the EU. It was applied for as an EU trade mark on 6th September 2004 and registered as such on 2nd December 2005. Save for the proof of use requirements, to which I return below, the comparable mark is treated as though it has been registered in the UK throughout. It is therefore an 'earlier trade mark' (compared to the contested mark) under section 6 of the Act.

[1] It is also registered in relation to a list of individual items falling within these broad descriptions

5. The applicant claims that:

(1) The respective marks are similar;

(2) The respective goods are identical or highly similar:

(3) There is a likelihood of confusion on the part of the public, including the likelihood of association.

6. Therefore, registration of the contested mark was contrary to section 5(2)(b) of the Act, which states:

"(2) A trade mark shall not be registered if because—

(a) –

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

7. Further, the applicant claims that the earlier mark has a reputation and that use of the contested mark, without due cause, would take unfair advantage of, and/or be detrimental to, the distinctive character and reputation of the earlier mark. Consequently, registration of the contested mark was also contrary to section 5(3) of the Act, which 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 the repute of the earlier trade mark."

8. The proprietor filed a counterstatement denying the grounds for invalidation and putting the applicant to proof of use of the earlier mark in accordance with section 47(2A) and (2B) of the Act, which state:

> *(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—*
>
> > *(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,*
> >
> > *(b) the registration procedure for the earlier trade mark was not completed before that date, or*
> >
> > *(c) the use conditions are met.*
>
> *(2B) The use conditions are met if—*
>
> > *(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-*
> >
> > > *(i) within the period of 5 years ending with the date of application for the declaration, and*
> > >
> > > *(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or*
> >
> > *(b) it has not been so used, but there are proper reasons for non-use.*

9. Additionally, paragraphs 9 of Schedule 2A to the Act applies. It provides:

> *"(1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.*
>
> *(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the "five-year period") has expired before IP completion day—*
>
> *(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and*
> *(b) the references in section 47 to the United Kingdom include the European Union.*
>
> *(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day—*
>
> *(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM…."*

10. This means that for the purposes of showing genuine use of the earlier mark, use anywhere in the EU prior to 31st December 2020 counts as qualifying use in the UK. The relevant periods in this case are (1) 15th February 2016 to 14th February 2021, and (2) 8th November 2017 to 7th November 2022.

REPRESENTATION

11. The applicant is represented by Sonder & Clay. The proprietor is represented by Meissner Bolte (UK) Limited. Neither side asked for a hearing. Consequently, this decision is based on the written submissions and evidence filed by the parties and, of course, the law.

THE EVIDENCE

12. The applicant's evidence consists of a witness statement by Walter Lacher with 10 exhibits. Mr Lacher is the applicant's Chief Financial Officer.

13. The proprietor's evidence consists of a witness statement by Alexander Pickles with 5 exhibits. Mr Pickles is a Chartered Trade Mark Attorney at Meissner Bolte (UK) Ltd.

PROOF OF USE

14. In *Walton International Ltd & Anor v Verweij Fashion BV*[2] Arnold J (as he then was) summarised the law relating to genuine use 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.
>
> (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.
>
> (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. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality.
>
> (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. Internal use by the proprietor does not suffice. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter.
>
> (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

[2] [2018] EWHC 1608 (Ch)

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.

(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.

(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.

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use.

15. 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."

16. According to Mr Lacher, the applicant takes its name from its founder, Paige Adams-Geller. He says the applicant sells a range of clothing, footwear and accessories and first started selling goods under the earlier mark in the United Kingdom in 2006. The first UK stores to sell PAIGE branded products were Selfridges

and Harrods. The applicant subsequently marketed its products through a small range of upmarket stores, including Harvey Nicholls, Liberty and John Lewis. Additionally, between 2019 and 2021 the goods were marketed through 48 (2019) to 80 (2021) of what the applicant calls 'UK independent stores'. Save for a store called Fenwicks, which is mentioned below, there is no further information as to the identity or location of these stores.

17. Mr Lacher says that between 2017 – 2019 the applicant sold its goods through a UK distributor. However, in 2019 a wholly owned subsidiary was set up (Paige Europe Ltd) to sell the applicant's goods into Europe and the UK. As to the volume of sales, Mr Lacher says:

> *"Paige consider sales turnover figures to be confidential so does not wish to disclose the exact amount of financial sales, however, I can confirm that sales turnover for the United Kingdom in each of the years 2017 - 2021 is in the millions of US dollars and has grown year on year."*

18. The witness provides samples of invoices from 2017 to 2021 bearing the name Paige.[3] The invoices from 2017 and 2018 are addressed to a distributor in London. The later ones, from 2019 to 2021, are from the applicant's subsidiary based in London to various UK retailers, including Selfridges, Harrods, John Lewis and Brown's Fashion. Some of the invoices from 2017 appear to relate to goods provided as samples. In every case the financial information has been redacted. Consequently, it is not possible to see how much any of the goods cost, or how much income they generated. In terms of sales volume, the invoices cover between around 1100 items (in 2018) and 3000 items (in 2019) per annum. The average annual sales volume shown in the invoices is a little under 2000 items.

19. The goods identified in the invoices are clothing items, specifically tops, T-shirts, blouses, sweaters, pants, trousers, jeans and bodysuits. There is also an entry for *"leather article for women, not coat or jacket."* I cannot tell from this description what the article is.

[3] See exhibits WL01 to WL05

20. There is also evidence from the WayBack internet archive showing Paige jeans on sale on the websites of Selfridges, Harvey Nichols and Fenwicks between 2017 and 2020.[4] I note the last named website indicated the goods were available at Bond Street, Brent Cross, Canterbury, Colchester, Kingston, Newcastle, Tunbridge Wells, Windsor and York. The goods were priced in pounds and marketed at £200 - £300 a pair.

21. The applicant also sells goods through its own website at paige.com. However, there is no evidence of any sales to the UK/EU via the website.

22. According to Mr Lacher, *"much of the advertising of Paige, LLC is done through social media and social influencers."* He exhibits pages from the applicant's Facebook and Instagram accounts, which show some advertising from 2019/2020, including for Paige boots.[5] As far as I can see, there is nothing to suggest this was aimed at UK/EU consumers, or that such goods were available in those territories. I note that the applicant has over 150k followers on Facebook, and over 370k on Instagram. However, these appear to be the figures at the date the pages were downloaded in 2023, and there is no information about the geographical location of the followers.

23. Mr Lacher exhibits published articles which he says show that the applicant and its products appear regularly in the UK press.[6] Some of them are from 2023 (i.e. well after the relevant date) and/or do not appear to be aimed at the UK. However, I note an article that appeared in Drapers online in November 2018 entitled "*The next chapter: Paige Adams-Geller's plans for her denim brand."* According to this article, wholesale prices for the brand range from £35 for a T-shirt up to £470 for outerwear. The brand was also mentioned in articles published:

(1) by the London Evening Standard in 2019 entitled "*The new jeans styles to know for 2019, according to the experts."*

(2) in July 2019 on the website whowhatwear.co.uk.

[4] See exhibit WL6
[5] See exhibits WL08 and WL09
[6] See exhibit WL10

(3) in February 2016 on the website of British Vogue.

(4) In February 2016 in the ‘style’ section of The Telegraph.

24. The applicant’s evidence is weak in a number of respects. In particular, it is difficult to identify the true volume of sales of goods marketed in the UK/EU under the earlier trade mark during the relevant periods, and it is difficult to identify the extent to which the mark was promoted in the UK/EU. However, it appears there was use of the mark in the UK during the relevant periods, and there is enough information to conclude that PAIGE goods were stocked by a significant number of UK retailers, including high-end retailers such as Selfridges and Harrods. Additionally, the goods appear to have been available at multiple physical locations in the UK. I am, therefore, satisfied that the evidence shows genuine use of the earlier mark during the relevant periods.

25. The use shown in the UK/EU appears to be in relation to tops, T-shirts, blouses, sweaters, pants, trousers, jeans and bodysuits. These are all items of clothing. For present purposes, I will proceed on the basis that the applicant has shown genuine use of the earlier mark in relation to ‘clothing’ at large. There is no evidence of use of the earlier mark in the UK/EU in relation to footwear or headgear. Consequently, the earlier mark is not entitled to protection in relation to such goods for the purposes of these proceedings.

STATUS OF EU LAW

26. 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.

THE GROUND FOR INVALIDATION BASED ON SECTION 5(2)(B) OF THE ACT

Global Assessment

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

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

28. The respective goods are shown below.

Goods covered by contested mark	*Goods for which earlier mark is entitled to protection*
Class 25: Clothing; Tops [clothing]; Knitted clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Sports clothing; Girls' clothing; Knitwear [clothing]; Jerseys [clothing]; Casual clothing; Collars [clothing]; Women's clothing; Embroidered clothing; Jackets [clothing]; Muffs [clothing].	Class 25: Clothing

29. I find the goods are identical.[7] Some of the goods (e.g. tops) would still be identical if I had limited the specification of the earlier mark to only the specific clothing items for which use of the earlier mark has been shown.

Average consumer and the selection process

30. Clothing sales are aimed at the general public. The average consumer is therefore a member of the general public.

31. The applicant submits that clothing items are often "*an impulse purchase meaning the degree of attention of the consumer is relatively low*." I do not accept this submission. The level of attention paid will clearly vary depending on the type and cost of the clothing. However, consumers generally care about their appearance and choose clothes to meet their particular needs, such as protection against rain or cold, and durability. Although the cost of clothing varies greatly, it is not usually an impulse purchase made without paying much attention, such as a chocolate bar. In my view,

[7] Applying the inclusion principle set out in *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05

average consumers of clothes pay a 'normal' or medium degree of attention during the selection process.

32. The goods will be selected mainly by eye from shelves or displays in shops, or internet sites. However, there will also be oral orders/enquiries in shops, and recommendations. Therefore, the way the marks look is most important, but the way they sound must also be factored into my assessment.

The distinctive character of the earlier mark

33. Mr Pickles' evidence shows that PAIGE was one of the top 50 female forenames given to children born in England and Wales between 1996 and 2001. The popularity of the name has since waned, but it was still one of the 200 most popular female names given to children born in 2020.[8] The position is broadly similar in Scotland and Northen Ireland.[9]

34. Paige is, therefore, a relatively popular given name, more so amongst those old enough to be trading. The public will be aware of this and will, therefore, be open to the possibility that there could be more than one trader using that name as part of their branding. This means the earlier mark has only a moderate degree of inherent distinctive character.[10]

35. The applicant submits the earlier mark has acquired an enhanced distinctive character as a result of the extensive use made of it. The relevant date for assessing the matter is 14th February 2021 (the application date of the contested mark). In *Lloyd Schuhfabrik Meyer,* 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*

[8] See exhibit AJP1
[9] See exhibits AJP2 and 3
[10] See, by analogy, the judgment of the CJEU in *Harman International Industries, Inc v OHIM*, Case C-51/09P, where the court said it was necessary to consider the commonness, or otherwise, of names in assessing their distinctive character as trade marks.

other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 WindsurfingChiemsee 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)."

36. I have already accepted the applicant's use of PAIGE in the UK appears to be established and that sales seem likely to have occurred in a reasonably widespread number of locations throughout the UK.

37. The applicant's witness states that sales of PAIGE clothing in the UK for each of the years 2017 - 2021 was *"…in the millions of US dollars and has grown year on year."* I not entirely sure what "*in the millions"* means, but I will take it to mean that the value of UK sales was at least $2 million per annum. It is not clear whether this is the wholesale value or the retail value of the goods. The applicant's goods appear to be aimed at the high end of the clothing market. As far as I can tell from the evidence, the goods are priced in the range £35 - £470 wholesale, and often fall in the retail range £200 - £300. Consequently, although $2m is a significant sum, this could equate to annual sales in the region of 6 to 12,000 units. It is not possible to be any more precise because the applicant has chosen not to provide the necessary information to enable me to make more specific findings.

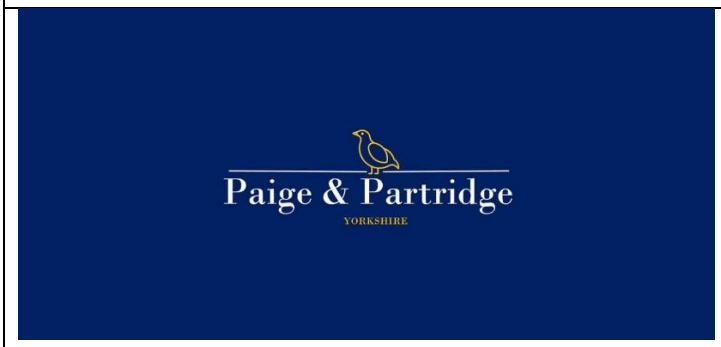
38. There is no evidence as to the size of the UK clothing market, or the applicant's share of it, but the volumes represented above seem likely to constitute only a tiny fraction of what is likely to be a multi-billion pound market.

39. As noted above, there is no evidence as to the amount spent promoting the earlier mark. Much of the applicant's advertising seems to be done through social media and social influencers. However, although information has been provided about the number of followers on various social media sites, none of this identifies the number of followers in the UK, or the number of UK visitors to these sites. Nor is there any information about the number of UK visitors to the applicant's paige.com website.

40. Consequently, whilst I accept that use of the earlier mark has probably resulted in some enhancement to its distinctiveness, I do not accept the evidence shows that PAIGE had become highly distinctive through use by the relevant date. The most that can be said on the evidence is that the mark had acquired a 'normal' degree of distinctive character as a result of the use made of it.

Comparison of marks

41. The marks at issue are:

Contested mark	Earlier mark
	PAIGE

42. In *Bimbo SA v OHIM*, the CJEU stated 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….. ."*

43. The earlier mark consists of a single element, namely the word PAIGE.

44. The contested mark is a composite mark with a number of elements. The blue rectangular background on which the other elements appear is just that - background. It will make little lasting impression on average consumers.

45. The distinctive and dominant element of the mark is plainly the words Paige & Partridge. The meaning of Partridge, being a type of bird, is reinforced by the use of a representation of a bird above the beginning of that word. The mark also includes the placename Yorkshire in relatively small script. In my view, that word will make little or no impact on average consumers.

46. Comparing the marks visually, the applicant submits that the marks are highly similar because the contested mark incorporates the earlier mark, and at the beginning of the mark where it will make most impact on consumers. On the other hand, the words in the contested mark are unmistakably longer than the word PAIGE alone, comprising 14 letters in total (and an ampersand) to just 5. Further, the device of a bird adds a further point of visual distinction between the marks. In my view, when compared as wholes (as average consumers usually do) the marks are visually similar to only a medium degree, at most.

47. The start of the marks sounds the same – PAYJE, but the contested mark has three additional syllables AND-PART-RIDG. The marks as wholes are, therefore, aurally similar to only a medium degree.

48. Conceptually, the proprietor submits that PARTRIDGE distinguishes the marks because it is the name of a bird (and emphasised as such by the device of a bird with the characteristics of a partridge), as well as being a rare surname, most notably that of the fictional TV character, Alan Partridge.

49. The applicant says the proprietor's submission that PARTRIDGE would be taken as a surname is fanciful. Rather, the applicant submits it would be taken as the name of the bird shown in the mark. Nevertheless, it argues that the shared meaning of the common element – PAIGE – creates a high degree of conceptual similarity between the marks. As to what that meaning is, the applicant says that PAIGE may be understood as a forename, or by its dictionary definition as a young servant.

50. I note that the Oxford English Dictionary includes a definition of PAIGE as a variant spelling of PAGE, meaning a boy or young man, usually in uniform, employed by a hotel, club or similar establishments. However, in my experience, the usual spelling of the word with this meaning is PAGE. I therefore consider it likely that average consumers will afford the word PAIGE (in both marks) the meaning of a given name.

51. If PAIGE is taken as a forename, it is possible that a section of average consumes will take PARTRIDGE as also being a name, in this case a surname (although not as part of the name of one individual called Paige Partridge). However, because Partridge is an unusual surname, and because the bird device reinforces the other meaning, most average consumers are likely to take PARTRIDGE as the name of a bird. I therefore accept the applicant's submission on this point. Combining a forename with the name of a bird gives the contested mark a whimsical character, which is absent from the word PAIGE alone. However, as the word PAIGE conveys the same meaning in both marks, and it is difficult to say that Paige & Partridge has a clear meaning, I accept that there is a low degree of conceptual similarity between the marks.

Likelihood of confusion

52. The applicant claims there is a likelihood of direct and indirect confusion. The proprietor disputes this.

53. I can deal with the first submission briefly. I am satisfied there is no likelihood of direct confusion. Despite the identity of the goods, and the possibility of imperfect recollection, the differences between the marks are too great for an average consumer paying a medium degree of attention, to mistake or mis-recall the contested mark as the earlier mark, or vice versa.

54. As to indirect confusion, the applicant's case is based on the proposition that PAIGE has an independent distinctive role in the contested mark because it does not *"form a unit"* with PARTRIDGE. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and*

Another,[11] Arnold J (as he then was) considered the impact of the CJEU's judgment in *Bimbo* on the court's earlier judgment in *Medion v Thomson.* The judge said:

> "*18 The judgment in Bimbo confirms that the principle established in Medion v Thomson is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.*
>
> *19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In Medion v Thomson and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.*
>
> *20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).*
>
> *21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of*

[11] [2015] EWHC 1271 (Ch)

confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

55. I have accepted that Paige & Partridge does not have a clear meaning. Therefore, it is difficult to say it has a clear meaning that is different to the meanings of PAIGE and PARTRIDGE, separately. However, I do not accept it automatically follows that PAIGE must have distinctive significance independently of the whole of the contested mark. PAIGE & PARTRIDGE as an unusual combination of words with a whimsical character (like 'James and Giraffe'). Standing back and looking at the mark like this, as most average consumer would, I find that PAIGE & PARTRIDGE would be seen as one, not two signs. Consequently, I do not think that this is a case to which the *Medion* principle applies. Further, even if I am wrong about that, it does not automatically follow that there is a likelihood of indirect confusion.

56. The same applies to the likelihood of indirect confusion amongst the minority of average consumers who may see PARTRIDGE as the name of a second person instead of (or as well as) the name of a bird. Admittedly, that would strengthen the case for finding that PAIGE will be perceived as having some independent distinctive significance to this section of the relevant public. However, this is not the applicant's case. Further, as the judge noted in *Whyte and Mackay,* a specific assessment of the likelihood of confusion is still required.

57. In the well-known case of *L.A. Sugar Limited v By Back Beat Inc*,[12] Mr Iain Purvis Q.C., 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,*

[12] Case BL O/375/10

is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

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

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

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

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

58. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,[13] Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria*,[14] where he said at [16] that *"a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion".* Arnold LJ agreed, pointing out that there must be a *"proper basis"* for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

59. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*.[15] This is mere association not indirect confusion.

[13] [2021] EWCA Civ 1207
[14] BL O/219/16
[15] BL O/547/17

60. The types of cases set out in paragraph 17 of Mr Purvis's decision are not exhaustive. However, they are the most usual circumstances where indirect confusion may arise. In my judgment, none of them apply here. The word PAIGE is not so distinctive that consumers would assume that no-one else but the brand owner would be using it in a trade mark at all. The second word, PARTRIDGE, is just as distinctive as PAIGE. The applicant submits that the contested mark would be taken as signifying a collaboration between the applicant and another party. This seems highly improbable if PARTRIDGE is taken as the name of type of bird rather than another human or business. Therefore, to the majority of average consumers who perceive PARTRIDGE as the name of a bird, there is no logical basis on which PAIGE & PARTRIDGE is liable to be seen as a brand extension of PAIGE.

61. I acknowledge that this argument might be a little stronger if PARTRIDGE is seen as the name of a second person. In some circumstances, the combination of the forename of one person with the surname of another could indicate a tie-up or joint venture. However, as I have already noted, this is not how the applicant puts its case. Further, PAIGE is a relatively common forename and it has not been shown to have become highly distinctive through use. It is, therefore, unlikely that average consumers will believe there could only be one possible (legitimate) user of marks including that name.

62. Additionally, the overall visual impression created by the contested mark does nothing to suggest that it is a variant mark used by the user of the PAIGE word mark. If anything, the presentation of the contested mark points in the opposite direction.

63. For these reasons, I find that no significant proportion of the relevant public is likely to be confused by use of the contested mark.[16] Therefore, I reject the case for invalidation based on section 5(2)(b) of the Act.

THE GROUND FOR INVALIDATION BASED ON SECTION 5(3) OF THE ACT

64. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case C-252/07, *Intel,* Case C-408/01, *Adidas-*

[16] See, by analogy, paragraph 34 of Kitchin LJ's judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41

Salomon, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *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 Saloman, paragraph 29* and *Intel, paragraph 63.*

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

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

(f) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that the current or future use of the later mark is taking unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier mark; *Intel, paragraph 67.*

(g) 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.*

(h) 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.*

(i) 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 on the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

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

Reputation

65. I have already explained the shortcomings in the applicant's evidence. I do not doubt that the applicant does business in the UK under the earlier mark, but the difficulties with the applicant's evidence make it difficult to assess whether the earlier mark was known to a significant part of the relevant UK public at the relevant date (i.e. 14th February 2021).

66. I note that in In *GNAT and Company Ltd & Anor v West Lake East Ltd & Anor*,[17] HHJ Hacon held that the claimants had not established a qualifying reputation for the purposes of section 10(3) of the Act. The claimants had operated a restaurant at the Dorchester Hotel in Park Lane for around four years prior to the relevant date. Turnover was between £5m and £6m each year, which equated to approximately 70,000 customers served per year; advertising spend had varied significantly, from around £5,000 at its lowest to over £47,000. The claimants had provided dining vouchers worth about £17,000 to charities and there had been some press coverage and awards but only 7 such articles appear to have been in evidence. The judge stated that although it was likely that a spread of individuals across the UK would have read the articles or been made aware of the awards, the claimants' market share was tiny relative to the UK restaurant business as a whole. The advertising sums were also very small in that context and the business was in relation to a single restaurant. The judge concluded that the evidence satisfied the 'geographic' aspect of the test but not the 'economic' one, and that the use was not sufficient to establish that the claimants' mark had a qualifying reputation.

67. The applicant in this case can rely on having used the earlier mark for a longer period. On the other hand, the judge in *GNAT and Company* at least had actual figures for sales, advertising spend and customers. So, in my view, the applicant's evidence of a qualifying reputation in this case is no stronger than in the cited case.

68. I find the applicant has failed to establish that the earlier mark had a qualifying reputation at the relevant date. The case for invalidation based on section 5(3) of the Act therefore falls at the first hurdle.

[17] [2022] EWHC 319

69. In case I am wrong about this, I will consider the section 5(3) case on the assumption that the applicant had a qualifying reputation at the relevant date.

The Link

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

The degree of similarity between the conflicting marks

71. I earlier found that the respective marks are:

(a) Visually similar to a medium degree, at most;

(b) Aurally similar to a medium degree; and

(c) Conceptually similar to a low degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

72. As discussed above, the respective goods are the same, the relevant public is the general public, and the goods are likely to be selected primarily by eye.

The strength of the earlier mark's reputation

73. If the earlier mark has a qualifying reputation, it is a relatively modest one. It is far from being a household name.

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

74. As discussed above, the earlier mark has a moderate degree of inherent distinctive character which has been enhanced through use. However, it is still not a highly distinctive mark to UK consumers.

Whether there is a likelihood of confusion

75. For the reasons already given, there is no likelihood of confusion.

Conclusion on link

76. Taking all relevant factors into account, I find average UK consumers will not make a link between the respective marks. However, in case I am wrong about this too, I will briefly consider whether any such link would take unfair advantage, or injure, the earlier mark.

Unfair advantage

77. The applicant submits that use of the conflicting mark would take unfair advantage of the reputation of the earlier mark by exploiting the applicant's investment in building its reputation. I do not accept this submission. As noted in paragraph 64(f) above, the likelihood that use of the contested mark will take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark, depends in part on how immediately and strongly the earlier mark is brought to mind. Given the differences between the marks, and the modest reputation of the earlier mark, any 'bringing to mind' is likely to be weak and fleeting. This mitigates against the likelihood of any advantage arising. Further, there is very limited evidence of the size or extent of the applicant's investment in promoting the earlier mark. This inevitably makes it harder to accept that use of the contested mark would take unfair advantage of that investment. Therefore, even if I had accepted that the earlier mark had a qualifying reputation at the relevant date, and that use of the contested mark would cause a significant section of the relevant public to call the earlier mark to mind, I would still have rejected the unfair advantage claim.

Detriment to reputation

78. The applicant submits the reputation of the earlier mark will suffer if the proprietor sells lower quality goods under the contested mark. This is purely speculative.[18] In the absence of any likelihood of confusion, this does not constitute a serious likelihood of damage to the reputation of the earlier mark.

Detriment to distinctive character

79. The applicant submits that the distinctiveness of the earlier mark will be eroded by use of the contested mark. I reject this submission too. A case under this heading requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future. I see no reason why use of the contested mark would make the earlier mark any less distinctive. Consequently, I would also have rejected this argument.

OVERALL OUTCOME

80. The application for invalidation fails and is rejected.

COSTS

81. The proprietor has been successful and is entitled to a contribution towards its costs. I assess this as follows:

> £300 for considering the application for invalidation and filing a counterstatement;
>
> £1000 for considering the applicant's evidence and filing evidence in response;
>
> £300 for filing written submissions.

[18] See the decision of Ms Anna Carboni as the Appointed Person *Unite The Union v The Unite Group Plc*, Case BL O/219/13

82. I therefore order Paige, LLC to pay Paige and Partridge the sum of £1600. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 29th day of April 2024

Allan James
For the Registrar