O/0413/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003835934

BY KAMALJIT HARRIS AND DARRAN HARRIS

TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 438602

BY BONPRIX HANDELSGESELLSCHAFT MBH

Background and Pleadings

1. On 4 October 2022, Kamaljit Harris and Darran Harris ('the Applicants') filed an application to register the following trade mark:

2. The application was published for opposition purposes in the Trade Marks Journal on 14 October 2022. Registration is sought in respect of the following single term *Clothing* in class 25.

3. On 16 January 2023, the application was opposed by bonprix Handelsgesellschaft mbH ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The Opposition is necessarily directed against the Applicants' entire specification. The Opponent relies upon the following earlier registration:

   UK00910500619

   RAINBOW

   This mark is a comparable mark pursuant to Article 54 of the Withdrawal Agreement, based on EUTM 010500619, which was registered prior to the withdrawal of the UK from the European Union.

   Filing date: 1 December 2011
   Date of entry in register: 11 April 2012

   Registered for the following goods, those relied upon shown in underline:

Class 14: *Jewellery; Horological and chronometric instruments.*
Class 18: *Leather and imitations of leather, not included in other classes; Trunks and travelling bags, travel bags, handbags, beach bags, shopping bags, cases for holding keys (leather items), rucksacks, pocket wallets, purses, umbrellas*
Class 25: *Clothing, footwear, headgear.*

4. The Opponent claims that the parties' marks are highly similar and their respective goods identical, leading to a likelihood of confusion.

5. Section 6A of the Act provides that where the date on which the registration procedure of the earlier mark was completed more than 5 years prior to the application date (or priority date) of the applied-for mark, the Opponent may be required to prove use of the earlier mark. The Opponent's mark was registered for more than five years prior to the filing date of the contested application. Section 6A of the Act is therefore engaged. The Opponent has made a statement of use for all of the goods sought to be relied upon.

6. The Applicants filed a Defence and Counterstatement in which they deny that the parties' marks are similar and, therefore, deny that there is a likelihood of confusion. The Applicants put the Opponent to proof in respect of its statement of use.

7. The Opponent is represented by AA Thornton IP LLP. The Applicants are represented by Trade Mark Direct.

8. Only the Opponent filed evidence. A hearing was granted at the request of the Applicants. A skeleton argument was filed by the Applicants in advance of the hearing. The Opponent indicated that it would not attend the hearing and filed written submissions in lieu thereof.

EVIDENCE

9. The Opponent's evidence comes from Carolin Klar, member of the Executive Board of the Opponent company. Ms Klar's Witness Statement is dated 23 June 2023, and is accompanied by nine exhibits: CK1 to CK9. The evidence focuses on the matter of genuine use of the earlier mark. I will refer to the evidence to the extent that it is relevant.

HEARING

10. A hearing took place before me, via video conference, on Wednesday 7 February 2024. Mr Mark Kingsley-Williams, of Trade Mark Direct, attended for the Applicants. I will not repeat Mr Kingsley-Williams' skeleton argument, or the parties' oral/written submissions here, but will refer to them, as appropriate, in my decision.

RELEVANCE OF EU LAW

11. 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.

12. The following decision has been made after careful consideration of the papers before me, and the Applicants' oral submissions.

DECISION

Earlier mark

13. In accordance with section 6 of the Act, the Opponent's mark is an earlier mark by virtue of its filing date, which fell before the filing date of the contested application.

Proof of use

14. I will begin by assessing whether there has been genuine use of the Opponent's mark.

Relevant legislation

15. Section 6A of the Act states:

'6A(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(b) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his

consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the 8 purposes of this section as if it were registered only in respect of those goods or services.'

16. Section 100 of the Act states:

'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.'

17. Given that the earlier mark is a comparable UK trade mark based on a EUTM, Paragraph 7 of Part 1, Schedule 2A of the Act is relevant:

'7. (1) Section 6A applies where an earlier trade mark is a comparable mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) 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 completion day –

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union'.

18. In the instant case, the relevant period for the purposes of considering the matter of genuine use is 5 October 2017 to 4 October 2022.[1] Use of the Opponent's earlier mark in the EU, but outside the UK, may therefore be taken into account for the period 5 October 2017 to 31 December 2020. For the portion of the relevant period post-dating IP Completion day, i.e. 1 January 2021 to 4 October 2022, only UK use is relevant.

Relevant case law

[1] I note that the Opponent has erroneously stated the relevant period to be 4 October 2017 to 3 October 2022: Opponent's written submissions in lieu of a hearing, [9]; Witness Statement of Carolin Klar, [2].

19. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

> '105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].
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> 106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:
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> (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
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> (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].
>
> (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer

or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed

to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

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

21. On the matter of use in relation to an EUTM, in the case of *Leno Merken BV v Hagelkruis Beheer BV,* Case C-149/11, the Court of Justice of the European Union ("CJEU") noted that:

'36.It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase 'in the Community' is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use."

And

'50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as 'genuine use', it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the

territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.'

And

'55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider* v *OHIM*, paragraphs 72 and 77).'

The court held that:

'Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.'

22. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited,* [2016] EWHC 52, Arnold J. (as he then was) reviewed the case law since the *Leno* case and concluded as follows:

> ‘228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.
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> 229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the Applicants' challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the Applicants' argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.
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> 230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the

territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.'

Opponent's evidence

23. By way of a preliminary observation, I note that Ms Klar has made several broad statements to the effect that where a particular exhibit contains documents related to a specific country, that material is to be deemed to relate to each country where the Opponent claims to have used its mark.[2] While this is noted, the expectation is that where use is claimed within a particular territory, it would not be particularly onerous for the Opponent to adduce evidence to substantiate such use.

24. I note the following from the Opponent's evidence:

(a) Ms Klar has given narrative evidence that the Opponent's mark has been used in the EU, particularly Germany, UK, France, Italy, Netherlands, Czech Republic and Poland.[3] Ms Klar states that where 'country specific' documents have been exhibited to her Witness Statement, these 'are representative of the documents produced in every country'.[4] Whilst this is noted, where UK use is required to be demonstrated (post IP Completion day), then concrete examples of documents having targeted the UK have much greater probative value than a statement to the effect that any document attributed to country/Member State X is to be deemed to have targeted 'every country'. Ms Klar states that the Opponent company, founded

[2] Witness Statement of C. Klar, [2], [5] and [10].
[3] Witness Statement of C. Klar, [2].
[4] As above.

in 1986, specialises in the 'distance-selling' of clothing and footwear 'for the whole family', via catalogues, having launched its 'e-commerce website in 1997'.[5] She explains that electronic versions of catalogues are emailed to millions of customers 'around the EU', those catalogues featuring products under the Opponent's various sub-brands, including 'RAINBOW', to which a section of the catalogue is dedicated.[6] Ms Klar states that the 'RAINBOW' mark has been used since the Spring/Summer of 2013, 'continuously throughout the EU with catalogues distributed in the UK, France, Italy, the Netherlands, Czech Republic, Poland, Sweden, Austria, Belgium, Slovakia, Hungary, Romania and Luxembourg'.[7]

(b) The Opponent has provided a document described as a 'presentation which has been produced to demonstrate how the Mark is applied to some of the goods sold by my Firm and the kinds of goods my Firm sells'.[8] Ms Klar states that the presentation has been 'created using goods which have appeared on my Firm's German and UK websites' and that she is able to 'confirm that the way the Mark is applied to these goods is representative of the way the mark has been applied to goods throughout the UK and the UK over the last five years'.[9] It is my understanding that this document has been compiled by cutting and pasting images from other sources and adding boxes of text by way of indicating dates of use. This document, therefore, does not constitute primary material. Contemporaneous material by way of excerpts from the original catalogues, or other sources, as the case may be, in the form in which they appeared at the time, would be of greater probative value. I hasten to add that this observation does not in any way call into question the integrity of the author of the document. I note that two of the pages feature photographs and product listings, said to be dated 27 February 2020 and 17 December 2020, respectively, for men's jeans and a women's nightdress. There are two screenshots, both dated 10 June 2021, featuring men's T-shirts with prices shown in £ Sterling. The 'RAINBOW' mark appears clearly and prominently on labelling affixed to the goods themselves, as well as in relation to the product description. Prices are expressed in £ Sterling. I

[5] Witness Statement of C. Klar, [3].
[6] As above, [4].
[7] As above, [6] – [7].
[8] As above, [5]; included in the first part of Exhibit CK1.
[9] As above.

also note that there are several images of clothing items/product listings with prices expressed in € Euros, said to relate to various dates in 2019/2020 (i.e. pre-dating IP Completion day). The clothing items shown are: women's T-shirts, shorts, sneakers, sandals, 'tankinis' (swimwear), and bikinis. The Opponent's mark features clearly on the clothing labels, as well as in the product descriptions. There are seven further screenshots featuring men's clothing items, all post-dating IP Completion Day. It is clear from the non-English text and/or prices expressed in € Euro that these show use of the mark in the EU, which cannot be taken into account.

(c) Included in Exhibit CK1 are six pages which have been annotated with the heading 'UK – Screenshots – Onlineshop – June 2023 – Rainbow-related products'.[10] This material post-dates the relevant period. The screenshots have been cropped in such a way that the URLs have been 'cut off', making it impossible to ascertain the name of the website and/or whether the web address is in the form 'co.uk'. The layout, tabs and drop-down menus indicate that the site is an online shop. The product listings are for the following women's clothing items: vests, a long-sleeved 'casual' top, a T-shirt, two cardigans, and a pair of wedge platform sandals. On all but two items (the vests and the T-shirt) the Opponent's mark is visible on the label affixed to the item. I note that prices are expressed in £ Sterling and that the size options are UK sizes (i.e. 6/8, 10/12 etc).

(d) Exhibit 2 is described by Ms Klar as 'images which show pages from my Firm's Spring/Summer 2010 German catalogue together with images from the Spring/Summer 2013 catalogue as issued in the UK, France, Italy, the Netherlands, Czech Republic and Poland'.[11] This material pre-dates the relevant period. The images, which have been cut and pasted into a 'Word' document, appear to be from catalogues from an overarching brand by the name of 'Bon Prix'. For all but the UK example, images of the cover pages show the year in the top right corner. The Opponent's mark appears prominently and clearly on double-

[10] Exhibit CK1, pages 47 – 52 of the evidence bundle.
[11] Witness Statement of C. Klar, [8].

page spreads of product listings for the following items of women's clothing: tops; jeans; trousers; T-shirts; cardigans; dresses; shorts; shoes; coats.

(e) I note that several of the Opponent's websites have been sign-posted by way of URLs.[12] However, the Opponent has not provided any pages from the websites cited. I do not propose to seek out the content to be found via the URLs. If a party wishes website material to be considered in evidence, then it is expected to provide a copy of that material.

(f) 'Wayback' prints[13] of pages from the Opponent's websites have been provided. It is convenient to summarise the salient details in the following table:[14]

Date:	Country/EU Member State:	Goods:	Use of earlier mark:
20 June 2019	Germany	Women's clothing items: tops; jackets; cardigans; jeans; trousers; leggings; skirts; shorts; jumpers.	The 'pathway' from the home page indicates that there is a dedicated section for goods under the Rainbow brand. The mark appears prominently at the beginning of the section of goods under the brand.
10 August 2020	Germany	Women's clothing items: dresses; trousers; tops; T-shirts; jumpers; skirts; leggings; jackets; blouses.	The mark appears prominently at the beginning of the section of goods under the brand.

[12] Witness Statement of C. Klar, [9].
[13] Copies of archived webpages from the web archiving service, The Wayback Machine.
[14] Exhibit CK3.

27 October 2019	Italy	Women's clothing items: dresses; shirts; cardigans; jumpers.	As above.
20 June 2020	Italy	Women's clothing items: dresses; T-shirts; trousers; tops.	As above.

(g) Circulation figures for the Opponent's catalogues featuring clothing under the 'Rainbow' mark have been provided by year and by country/EU member State.[15] It is convenient to summarise the pertinent details thus:[16]

Country/ Member State:	2018	2019	2020	2021	2022
Germany	66,476,166	62,099,000	26,679,903	-	-
UK	4,868,000	4,036,500	2,475,000	2,420,000	1,500,000 900,000 (Spring/ Summer); 600,000 (Autumn/ Winter)
France	17,228,754	16,655,004	1,499,066	-	-
Italy	11,767,934	9,844,967	3,908,720	-	-
Netherlands	8,769,168	9,733,181	5,810,280	-	-
Czech Republic	10,404,837	9,065,558	3,356,947	-	-
Poland	10,404,837	9,065,558	3,356,947	-	-

[15] Witness Statement of C. Klar, [12]; Exhibit CK4.
[16] This table is my own, based on the information in Exhibit CK4.

I note that the figures for the Czech Republic and Poland are identical, which is, to my mind, more likely an error than a coincidence. No figures have been provided for the initial portion of the relevant period, 5 October 2017 to 31 December 2017.

(h) Sales figures have been provided 'showing the net value of sales of Rainbow branded goods in various EU countries for the years up to 2020, and the UK from 2017 to 2022.[17] The values are shown in 'k€', which I take to be in the thousands of Euros. For example, the figure provided in respect of shoes sold in the UK in 2017 '134' is to be read as '€134,000' rather than '€134'. The Opponent has presented the figures thus:[18]

Net sales in k€

		2017	2018	2019	2020	2021	2022
UK	Clothing Women's outerwear, Men's outerwear, Women's swimwear, Women's nightwear	3,314	3,872	4,119	3,228	4,709	3,845
	Shoes	134	185	243	105	202	292
		3,448	4,057	4,362	3,333	4,911	4,137

		2017	2018	2019	2020
Germany	Clothing Women's outerwear, Men's outerwear, Women's swimwear, Women's nightwear	70,739	72,054	73,022	72,388
	Shoes	2,634	2,763	2,707	2,663
		73,373	74,817	75,729	75,051

[17] Witness Statement of C. Klar, [14]; Exhibit CK5

[18] Although the tables in the exhibit are in a different order, I have inserted the UK table first here, for convenience.

		2017	2018	2019	2020
France	Clothing Women's outerwear, Men's outerwear, Women's swimwear, Women's nightwear	14,410	14,221	14,560	15,188
	Shoes	734	798	826	784
		15,144	15,019	15,386	15,972

		2017	2018	2019	2020
Italy	Clothing Women's outerwear, Men's outerwear, Women's swimwear, Women's nightwear	8,250	8,523	8,573	9,819
	Shoes	502	542	547	718
		8,752	9,065	9,120	10,537

		2017	2018	2019	2020
Netherlands	Clothing Women's outerwear, Men's outerwear, Women's swimwear, Women's nightwear	9,827	11,030	12,994	13,510
	Shoes	387	442	517	471
		10,214	11,472	13,511	13,981

		2017	2018	2019	2020
Czech Republic	Clothing Women's outerwear, Men's outerwear, Women's swimwear, Women's nightwear	4,947	6,229	7,225	7,620
	Shoes	258	326	310	313
		5,205	6,555	7,535	7,933

		2017	2018	2019	2020
Poland	Clothing Women's outerwear, Men's outerwear, Women's swimwear, Women's nightwear	5,546	7,849	8,587	8,765
	Shoes	192	310	283	247
		5,738	8,159	8,870	9,012

I note that the Opponent has submitted that 'the sales figures in Exhibit CK5 […] show sales of over 100,000 Euros a year across the Relevant Territory'.[19] My view is that the drafter of the written submissions has overlooked the units 'k€' specified for the table and, as a consequence, neglected to read '3,314' as '3,314,000'. If the written submissions are to be relied upon, it would mean that the amount of revenue generated by the sale of shoes in, say, the UK in 2018, were merely '€185'. Whilst such a low sum is not impossible, it appears implausible in the light of the fairly impressive number of catalogues said to have been circulated in the UK for 2018 (4,868,000).

A breakdown of the figures by month, particularly for the years 2017 and 2022 (UK) would have been helpful given that only the portions 5 October to 31 December 2017 and 1 January to 4 October 2022 fall within the relevant period.

(i) Exhibit CK6 comprises a table of figures described as 'details of the market share for each year in a number of EU countries'. Ms Klar states that 'the sales figures given in the 'total market sales' column relate to the entire womenswear market for each country and do not relate to the RAINBOW brand exclusively'.[20] I reproduce the Opponent's table in full here:

[19] Opponent's written submissions in lieu of a hearing, [21].
[20] Witness Statement of C. Klar, [15]; Exhibit CK6.

Country	Year	Total sale of RAINBOW branded	Total Market sales for goods in women's	Market share for women's wear in M€ wear [sic] – sales in M.€ RAINBOW
UK	2017	26,091	3.23	0.01%
	2018	26,632	3.81	0.01%
	2019	27,537	4.01	0.01%
	2020	22,795	3.17	0.01%
	2021	26,123	4.55	0.02%
	2022	29,133	3.70	0.01%
France	2017	15,905	13.56	0.09%
	2018	15,917	13.43	0.08%
	2019	15,782	13.67	0.09%
	2020	12,669	14.27	0.11%
Italy	2017	14,672	7.41	0.05%
	2018	14,310	7.77	0.05%
	2019	14,082	7.68	0.05%
	2020	10,440	8.83	0.08%
Netherlands	2017	4,393	8.67	0.20%
	2018	4,422	9.95	0.23%
	2019	4,476	11.68	0.26%
	2020	3,893	12.17	0.31%
Czech Republic	2017	1,039	4.53	0.44%
	2018	1,116	5.73	0.51%
	2019	1,156	6.67	0.58%
	2020	949	7.05	0.74%

Poland	2017	3,177	5.18	0.16%
	2018	3,320	7.39	0.22%
	2019	3,435	8	0.23%
	2020	2,945	8.19	0.28%
Germany	2017		4,809	1.1%
	2018		4,831	1.0%
	2019		5,378	1.1%
	2020		5,544	1.1%

The footnote to the table reads: '*source of data: Euromonitor, Women's wear Rainbow Bonprix – data remark Women's wear = Women's outerwear, women's lingerie & nightwear, women's outerwear'.*

In my view, there are some problems/ambiguities with this table:

i. I note that the sales figures provided earlier at Exhibit CK5, above at [(h)] are net values expressed in k€, i.e. thousands of Euros. However, in this table, at Exhibit CK6, it is not clear whether the values are net or gross. Furthermore, no units have been given for the values in the column headed 'Total sale of RAINBOW branded'. Taking the figures simply as they are, the figure for the UK in 2017 would be 26,091, rather than 26,091,000 (presumably, Euro). However, earlier in Exhibit CK5, the figure of 3,448,000 (Euro) was presented for net sales of Rainbow-branded clothing and shoes. I am unable to see how a value of 3,448,000 representing net sales of Rainbow-branded shoes and clothing **(including men's outerwear)** for the UK in 2017[21] can be reconciled with a value of just 26,091 representing 'total sale of RAINBOW branded' **women's wear** for the UK in 2017.[22] If both figures are presumed to be correct, then (subtracting the figures) to deduce the value for men's outerwear alone would generate the improbable figure of 3,421,909. This would indicate that the

[21] Exhibit CK5
[22] Exhibit CK6.

vast majority of sales revenue had been generated by sales of men's outerwear. However, this is not borne out by the remainder of the evidence, which is, for the most part, focused on womenswear.

ii. No units have been provided for the figures in the column 'Total market sales for goods in women's [sic]', said to represent the total market size for women's wear in the UK. I note that the units 'M€', which I read as 'millions of Euro', appear above the adjacent column containing the values for the market share occupied by Rainbow-branded women's wear. However, given that these values are expressed in percentages, it seems likely that the insertion of 'M€' in that column was an error. Even if I assume that the figures for total market sales are to be read as 'M€', the percentages for market share appear to be incorrect. Taking the UK in 2017 as an example: 26,091 as a percentage of total market sales of 3.23 million (itself an improbably low figure in what must be a huge market) is not 0.01%, but 0.8%. Taking Czech Republic in 2019 as another example: 1,156 as a percentage of total market sales of 6.67 million is not 0.58%, but approximately 0.02%.
I find the information in Exhibit CK6 to be incoherent and, therefore, of little assistance.

(j) The Opponent has provided a table headed 'Advertising Costs 2018 – 2020', described by Ms Klar as showing 'details of the amount my Firm has spent promoting the Rainbow brand in the EU, [sic] values are shown in thousands of Euros'.[23] [my emphasis]. Taking a literal interpretation of Ms Klar's statement, taking Germany as an example, the figure '2111' for 'catalogue costs*' in 2018 is therefore to be read as '€2,111,000'. I note that there are no figures for the UK. I have reproduced the table as follows:

	Year	Catalogue costs*	E-Commerce Costs**	Sales Promotion Costs***
Germany	2018	2111	2161	1653

[23] Witness Statement of C. Klar, [16]; Exhibit CK7.

	2019	4253	3991	2829
	2020	4136	3852	2729
		10500	**10004**	**7211**
France	2018	561	662	420
	2019	1057	1225	852
	2020	1000	1144	861
		2618	**3031**	**2133**
Italy	2018	220	268	315
	2019	510	532	563
	2020	542	541	501
		1272	**1341**	**1379**
Netherlands	2018	167	770	127
	2019	370	1482	245
	2020	400	1472	250
		937	**3724**	**622**
Czech Republic	2018	116	281	201
	2019	223	537	434
	2020	195	531	525
		534	**1349**	**1160**
Poland	2018	174	431	195
	2019	342	811	420
	2020	342	776	500
		858	**2018**	**1115**

*Catalogue costs (mainly): production, postage costs

**E-Commerce costs (mainly): costs for online marketing, shop management platform

***Sales Promotion costs (mainly): vouchers, discounts, free shipping promotions

These figures relate to the EU only. Inclusion of UK figures, particularly for the portion of the relevant period post-dating IP Completion day (i.e. 1 January 2021 to 4 October 2022) would have been helpful.

(k) A selection of 19 invoices has been provided to demonstrate sales to customers based in Germany (7 invoices), France (4 invoices) and the Netherlands (5 invoices) for a range of dates between 24 October 2017 and 9 July 2020.[24] No invoices have been provided in respect of UK custom. Ms Klar has stated that 'a limited number of examples have [sic] been selected to keep within the UK IPO limit of 300 pages of evidence and further examples are available on request'.[25] While this is noted, my view is that it would have been more worthwhile to have included at least some invoices for the UK in the period post-dating IP Completion day (i.e. 1 January 2021 to 4 October 2022). As to the invoices provided, I note that the sums payable are fairly modest; ranging from around €42 to €225. Given that each invoice relates to a fairly small number of items purchased, it is clear that the customers in question are the general public purchasing items at retail prices. The invoices relate to a range of clothing items for women, including: trousers, tops, skirts, coats, dresses, T-shirts, blouses, sweatshirts, leggings.

(l) Exhibit CK9 comprises a large number of pages bearing 'images which demonstrate how the mark is applied to some of the goods' and 'includes sample pages' from catalogues distributed to EU countries.[26] The images include a selection of catalogue pages. In addition, there are images which appear to have been electronically 'cut' from the catalogue pages, cropped and enlarged to show the product more clearly. Both the images of the catalogue pages and individual products have been 'pasted' into a document, to which text has been added to indicate the catalogue number and year. Several images of the catalogue cover pages have been provided and, for the most part, I am able to make out the year and season shown in the top right-hand corner of the cover, e.g. 'Spring/Summer 2019'. The material appears to range from 'Autumn/Winter 2017' to 'Autumn/Winter

[24] Witness Statement of C Klar, [17]; Exhibit CK8.
[25] As above.
[26] Witness Statement of C Klar, [18]; Exhibit CK9.

2022'. The majority of the examples are in English. There are several other examples bearing text that I recognise as French, German and Italian. (Other examples included bear text in non-English languages with which I am less familiar). The 'English' examples span the entire relevant period. The German, French and Italian examples all pre-date IP Completion Day. The Opponent's mark is shown regularly, clearly and prominently on the catalogue pages. Several photographs of clothing items, particularly jeans, demonstrate that the mark appears on the goods themselves e.g. on the inside of the waistband. For each year within the relevant period, all products shown are clothing items for women. The range is fairly broad, including: boots; shoes (heeled and flat); sandals; trainers; tops (long/short-sleeved, and sleeveless); dresses; skirts; trousers; jeans; jackets; cardigans; T-shirts; shorts.

m) Aside from references to the mark in bodies of text (which are inevitably rendered in the standard typeface of that body of text), all other instances of the Opponent's mark visible in the evidence are presented in the form in which the mark is registered, i.e. with the mild stylisation by way of the horizontal 'post' of the 'A' character slanting down a little to the left:

Assessment of genuine use

25. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[27]

26. In assessing the body of evidence available to me, I bear in mind the case of *Awareness Limited v Plymouth City Council,* Case BL O/236/13, in which Mr Daniel Alexander Q.C. (as he then was) as the Appointed Person stated that:

[27] *New Yorker SHK Jeans GmbH & Co KG v OHIM,* T-415/09

‘22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.’

27. I also bear in mind the case of *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13*,* Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person stated that:

‘21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller-General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

> [24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or

her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *'show'* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.'

28. During the hearing, Mr Kingsley-Williams made no mention of the matter of genuine use; choosing to focus his submissions on the matter of the similarity, or otherwise, of the parties' marks (which will be addressed later in this decision). There is one brief mention of the Opponent's evidence in Mr Kingsley-Williams' skeleton argument: 'The evidence from the opponent does not support anything other than low awareness or reputation in the UK'.[28] With respect, there is no obligation on the Opponent to demonstrate that the earlier mark has a reputation in the UK. What needs to be demonstrated, is genuine use. The use shown must be: *within the EU* (which might include the UK) for the portion of the relevant period prior to IP Completion day; and *within the UK* for the part of the relevant period post-dating IP Completion day.

29. My view is that, whilst the body of evidence is not overly impressive, it succeeds in demonstrating that the earlier mark has been used within the relevant period. UK sales figures have been provided for each of the five years. The sums generated

[28] Skeleton Argument of the Applicants, [7th unnumbered paragraph of 2nd unpaginated page].

are significant, all being in the seven-figures, and have remained fairly steady. The sales figures in respect of EU Member States, Germany, France, Italy, Netherlands, the Czech Republic and Poland, are also impressive, all being seven or eight-figure sums.

30. A small number of invoices in respect of sales to Germany, France and the Netherlands has been provided. The small number of goods enumerated on each invoice likely indicates sales to consumers as opposed to retailers. The provision of invoices to demonstrate bulk purchases by retailers would have bolstered the Opponent's evidence further. The absence of invoices to demonstrate UK sales is disappointing; and adducing such material would not, in my view, have been particularly onerous. However, the significant number of catalogue excerpts, with English text, spanning the entirety of the relevant period, persuades me that the Opponent has made genuine efforts to target the UK market. The Opponent's mark is shown clearly and consistently, both on the catalogue pages and on some of the items of clothing (e.g. labels or waistbands). Catalogue excerpts have also been provided for France, Germany and Italy, for the portion of the relevant period pre-dating IP Completion Day.

31. The circulation figures in respect of catalogues, in which Rainbow-branded clothing is featured, distributed in EU Member States (including the UK) for the years preceding IP Completion Day are significant. The highest figure is 66,476,166 for Germany in 2018. Even at the lowest point (France, 2020), 1,499,066 catalogues were distributed. I acknowledge that circulation figures are, to a significant extent, determined by the population size of the Member State in question. After IP Completion Day, the circulation figures for the UK were: 2,420,000 for 2021; and 900,000 for the Spring/Summer season of 2022. Despite the distribution figures having declined since 2018, these figures for 2022 are not insignificant and, to my mind, demonstrate that the Opponent has continued to make real efforts to hold out its Rainbow-branded goods for sale, in the UK.

32. The information on advertising expenditure indicates significant marketing and promotional efforts for the following EU Member States: Germany, France, Italy,

Netherlands, Czech Republic and Poland. However, no explanation has been provided for the absence of figures for the UK.

33. A small number of 'Wayback' prints provides contemporaneous evidence of a variety of women's clothing items being available to purchase online, by consumers in Germany and Italy, in 2019 and 2020. Further 'Wayback' prints for the years 2017 and 2018 would have strengthened the Opponent's position. Furthermore, 'Wayback' prints to demonstrate goods being held out for sale to UK consumers for 2021 and the first half of 2022 would have been particularly helpful. The 'UK screenshots' from the Opponent's online shop are said to be dated June 2023, which is after the relevant period. It is therefore impossible to ascertain whether this material was published before the relevant period ended.

34. The material provided to illustrate the market share held by the rainbow mark over the relevant period is, in my view, of little assistance due to the difficulties identified above at [24](i) i and ii.

35. Despite the evidential shortcomings that I have identified, my view is that the totality of evidence demonstrates that the Opponent has made genuine use of its mark.

Fair specification

36. I now consider for which goods the earlier mark has been put to genuine use. The relevant part of the registered specification is:

Class 25: *Clothing, footwear, headgear.*

37. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

> 'In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of

the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.'

38. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

'245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those

which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.'

39. Almost all of the evidence relates to use of the mark in respect of clothing items for women. Use has been demonstrated for quite a wide range of Women's items: nightdresses; T-shirts; shorts; sneakers; sandals; 'tankinis' (a two-piece swim-set comprising a tank top and brief); bikinis; cardigans; short/long-sleeved tops; vest tops; platform wedge shoes; jeans; trousers; dresses; coats; jackets; leggings; skirts; jumpers; blouses; shirts; sweatshirts; boots; flat shoes; high heeled shoes; trainers. There does not appear to be any evidence of the mark being used in respect of the following categories of women's clothing items: underwear, headgear, lingerie, socks or hosiery. My view is that the number of sub-categories of women's clothing, in respect of which the mark has been shown to have been used, is sufficient to justify retention of the broad term 'Women's clothing'. In the spirit of *Merck*,[29] it is neither necessary nor practicable to use a mark in respect of 'every possible variation' of a product (or service).

40. I now consider use of the mark with respect to men's clothing. The sales figures at Exhibit CK5 are said to include revenue in respect of 'Men's outerwear'. However, the Opponent has not refined the figures to show what proportion of revenue is attributable to the sale of 'Men's outerwear'. The only concrete examples of men's clothing items being held out for sale, within the relevant period/territory, are three screenshots within exhibit CK1 showing: T-shirts (two screenshots dated 10 June 2021); and a pair of jeans (17 December 2020). The prices are in £ Sterling, indicating that these items were likely aimed at UK consumers. Although a large number of catalogue excerpts have been provided at Exhibit CK9, none feature clothing items for men. None of the invoices is in respect of men's clothing. If genuine use were to be found, it could only be in respect of the narrow terms *men's*

[29] *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834, [247]

T-shirts and *men's jeans.* My view is that, although the evidence is very scant, it is just about sufficient to support such a finding.

41. In the light of the foregoing, I consider a fair specification for the Opponent's Class 25 goods to be the following:

Clothing for women, excluding underwear, socks and hosiery; footwear for women; men's T-shirts; men's jeans.

Section 5(2)(b) opposition

Relevant legislation

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

> '5(2) A trade mark shall not be registered if because –
>
> (a)…
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.'

Relevant case law

43. The following principles are derived 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:

(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 they have kept in their 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.

The goods at stake

44. Mr Kingsley-Williams has set out the following concession at the beginning of his skeleton argument: 'The Owner has admitted that the services protected under the Registration are identical to those protected under the Applicants' Mark'.[30] The reference to 'services' is presumed to be an error because the terms at stake are class 25 *goods*, however nothing turns on this. No comment has been included in the skeleton argument on the matter of 'proof of use', and none was made during the hearing. None of the case papers reveal any concession on the matter of use. The concession as to the identity of the goods was, therefore, to the extent that the outcome of the assessment of genuine use had, at that point, not yet been determined, conditional.

45. The General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*[31] held to the effect that goods and services can be considered as identical when the goods and services designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

[30] Skeleton Argument of the Applicants, unnumbered paragraph on first unnumbered page.
[31] Case T-133/05

46. Following the finding of genuine use, the Applicants's goods *clothing* are identical to the Opponent's *clothing for women* excluding underwear, socks and hosiery because the former term encompasses the latter, per *Meric.*

Comparison of the marks

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

48. The marks to be compared are as follows:

Opponent's mark:	Applicants' mark:
RAINBOW	Rainbow colours

Overall impression of the marks

49. The earlier mark comprises the word ‘Rainbow’ rendered in a fairly plain typeface, with mild stylisation to the ‘A’ character by way of the central ‘bar’ of the ‘A’ sloping to the left. I consider that the stylisation is so subtle that many average consumers will overlook it. I find that the overall impression of the mark resides in the word ‘Rainbow’.

50. The Applicants’ mark comprises text and a figurative element. The words ‘Rainbow colours’ are presented in ‘Times New Roman’ typeface, coloured navy blue. The word ‘colours’ appears in a smaller font size, relative to ‘Rainbow’; the words presented on separate lines, in a centred alignment. A ‘bird’ device is positioned in the top right of the mark, hovering above the ‘o’ character of ‘Rainbow’. The outline of the bird is rendered in an ochre hue. The wing of the bird bears the colours of the rainbow, in a striped pattern, replicating the order in which the colours appear in nature: red, yellow, orange, green, blue, indigo, violet. The long forked shape of the tail suggests that the bird might be a swallow, although a proportion of average consumers may not appreciate this. My view is that, although the device is much smaller than the text elements of the mark, the ‘rainbow’ wing makes it noticeable; and the presence of the device will unlikely be overlooked by the average consumer. I consider that both the text and figurative elements will contribute to the overall impression of the mark. I find that the text elements ‘Rainbow colours’ will play a greater role. The words will likely be seen first, by virtue of their size and positioning, and the fact that words generally ‘speak louder’ than devices. The bird device will likely play a lesser role.

Visual comparison

51. The Opponent has submitted that the marks are ‘visually highly similar by virtue of the fact that they both include the identical word RAINBOW as their dominant and distinctive element’.[32] Mr Kingsley-Williams argued that the presence of the word ‘colours’, and the inclusion of the device, rendered the Applicants’ mark as having a low level of visual similarity to the earlier mark.[33]

[32] Opponent’s written submissions in lieu of a hearing, [36].
[33] Applicants’ skeleton argument, 2nd unnumbered paragraph on 2nd unpaginated page.

52. The word 'Rainbow' is present in both marks. I bear in mind that the general Court in *El Corte Inglés, SA v OHIM*, observed that 'the attention of the consumer is usually directed to the beginning of the word'.[34] However, this is a 'rule of thumb', not an absolute rule. The Applicants' mark contains the additional word, 'colours'; whereas the Opponent's mark comprises 'Rainbow', solus. Although 'colours' appears in a somewhat smaller font relative to 'Rainbow', the contrast in size is not so stark as to prevent the average consumer from seeing the two words more or less at once. The Applicants' mark also features a bird device, which is absent from the Opponent's mark. I consider the slight stylisation of the 'A' character in the Opponent's mark to be such that it would likely be overlooked by many average consumers. My view is that, although the device is relatively small, its positioning and rainbow-coloured wing accord it a measure of visibility that allows it to contribute to the overall impression of the mark. I find that it will unlikely be overlooked by the average consumer. In the light of the foregoing, I find the marks to be visually similar to no more than a medium degree.

Aural comparison

53. The Opponent has submitted that the marks are 'phonetically similar', arguing that 'the additional word ['colours'] reduces the level of similarity slightly but does not prevent the marks from being phonetically highly similar on the whole.[35] Mr Kingsley-Williams submitted that the level of aural similarity between the marks was low, owing to the Applicants' mark being 'several words'.

54. I respectfully disagree that the Applicants' mark is 'several words'; given that 'several' denotes 'more than two,' and the mark in question includes just two words. The word 'rainbow' will be articulated the same way in each mark i.e. 'RAYN-BOE'. The bird device will not be articulated. The point of aural difference between the marks lies in the presence of the word 'colours', likely articulated 'CUH-LUZZ', in the Applicants' mark, which is absent from the Opponent's mark. I agree that the 'colours' element will be articulated by the average consumer. Aurally speaking,

[34] Cases T-183/02 and T-184/02 at para [83].
[35] Opponent's written submissions in lieu of a hearing, [37].

the Applicants' mark is twice as long as that of the Opponent; four syllables versus two syllables. I consider that this difference will be readily perceived by the average consumer. I find the marks to have no more than a medium level of aural similarity.

Conceptual comparison

55. The Opponent has submitted that the marks are 'conceptually identical', going so far as to treat 'rainbow' and 'rainbow colours' as synonymous.[36] It argues that both marks include 'Rainbow' as the 'dominant and distinctive element' which will 'immediately conjure an image of a rainbow; and that the presence of colours in the Applicants' mark adds nothing beyond this concept.[37] Mr Kingsley-Williams submitted that the marks were 'conceptually different', the difference arising by virtue of the presence of the additional word 'colours' in the Applicants' mark which manifests as a difference in 'construction' of the marks.

56. I respectfully disagree with the Opponent's argument that 'Rainbow' is synonymous with 'Rainbow Colours'. I consider the word 'rainbow' to refer to the arch of colours which can appear after rain, due to the refraction of the sun's light by water droplets in the atmosphere. The resulting array of colours, often referred to as the 'colours of the spectrum', are said to show the sequence: red, orange, yellow, green, blue, indigo and violet. The average consumer will, in my view, perceive the Opponent's mark 'rainbow' to refer to the arched image that I have described.

57. My view is that the Applicants' mark 'Rainbow colours' will likely be perceived as a reference to the *colours that appear in a rainbow*, rather than *a rainbow*. I have found that the bird device, with the rainbow-coloured wing, will likely be noticed by the average consumer. I consider that the arrangement of the colours, in the sequence noted above at [56], reinforces the concept of the 'colours of the rainbow'.

[36] Opponent's written submissions in lieu of a hearing, [38].
[37] As above.

58. I also disagree with the Applicants' argument that the marks are 'conceptually different'. There is clearly an overlap in the ideas conveyed by the marks. All things considered, I find a fairly high level of conceptual similarity.

Distinctive character of the earlier marks

59. 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 *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)'.

60. Registered trade marks possess varying degrees of inherent distinctive character. Where a mark is suggestive or allusive of a characteristic of the goods or services, it tends to be low. Inherent distinctive character may range up to a high level for marks which consist of invented words with no allusive qualities.

61. The Opponent has submitted that 'Rainbow' is not descriptive for clothing.[38] It highlighted decision BL O-147-22, concerning the same earlier mark, in which Hearing Officer found that the term 'RAINBOW' had 'no meaning in relation to the goods for which it is registered' and considered the mark to be 'inherently distinctive to a medium degree'.[39]

62. Mr Kingsley-Williams submitted that the earlier mark had a low level of inherent distinctive character and that there were 'fifty-nine live marks on the UK register that contain the word RAINBOW in class 25 alone'.[40] The Applicants have argued that this indicated that the relevant public would be accustomed to seeing 'Rainbow' in a trade mark context where clothing was concerned.[41]

63. On the matter of the presence of marks on the register featuring the word 'rainbow', I bear in mind the case of *Zero Industry Srl v OHIM*[42] in which the General Court stated that:

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

[38] Opponent's written submissions in lieu of a hearing, [40]-[41].
[39] Decision BL O-147-22, [73].
[40] Applicants' skeleton argument, 1st unnumbered paragraph of second unpaginated-page.
[41] As above.
[42] Case T-400/06.

64. My view is that the presence of 59 marks, registered in respect of clothing, on the UK register, does not, without more, support a finding that the distinctive character of the Opponent's mark 'Rainbow' has been weakened. An assessment of the frequency of the use of registered marks containing 'rainbow' would entail, inter alia, consideration of the total number of such marks actually in use in the UK market place, as well as the intensity of their use. No evidence has been adduced upon which to make this assessment.

65. All things considered, I prefer the Opponent's submission; and I adopt the finding of the Hearing Officer, in respect of the same earlier registration, in case BL O-147-22 – I find the earlier mark to enjoy a medium level of inherent distinctive character. Like my colleague in that decision, I also consider that the mild stylisation of the 'A' character does not alter this finding.

66. I now consider whether the earlier mark enjoys a level of enhanced distinctiveness. Although I have found that the earlier mark has been put to genuine use, my view is that the totality of evidence available to me does not demonstrate that the mark enjoys an enhanced level of distinctive character in the UK. As explained earlier in this decision, the material adduced in an effort to demonstrate the market share held under the 'Rainbow' mark cannot be usefully interpreted. Although many catalogue excerpts have been provided to demonstrate promotional and marketing efforts targeted at UK consumers, no invoices have been provided in respect of UK custom. It is not possible to conclude that the level of distinctiveness can be raised above the finding that I have made for the mark's inherent distinctive character i.e. that of a medium degree.

Average consumer and the purchasing act

67. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word "average" denotes that the person is typical. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

68. The average consumer of the relevant goods will be the general public. The purchasing act will be primarily visual. The goods will be picked up or examined/tried on in physical shops, or, in the case of online purchases, product information will be read, before making a purchase. There may also be an aural aspect to the purchasing process; for example, by 'word of mouth' recommendation. The goods entail fairly frequent purchases, many at fairly low price-points. For example, a T-shirt might be purchased from a supermarket for just a few pounds. At the other end of the scale, an 'haute couture' dress might cost several hundreds of pounds. All things considered, I find that the average consumer would pay no more than a medium level of attention when making a purchase.

Likelihood of confusion

69. Confusion can be direct or indirect. Mr Iain Purvis Q. C., (as he then was) as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*[43]. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*[44], the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or an economically linked undertaking

70. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [43]. When

[43] Case BL O/375/10 at [16].
[44] *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

considering all relevant factors 'in the round', I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

71. The parties' goods are identical. I have found no more than medium levels of visual and aural similarity between the marks. Conceptually speaking, I have found the marks to be fairly highly similar. It is my view that, despite the identity between the goods, the net effect of the differences that I have identified, along the three 'planes' of comparison, is sufficient to prevent the average consumer from confusing one mark for the other. Given that the purchasing act will be primarily visual in nature, the presence/absence of the word 'colours', as well as that of the 'bird' device, would be noticed by the average consumer I remind myself of the possibility that a greater degree of similarity between goods *may* offset a lesser degree of similarity between marks. However, in the instant case, I do not consider the identicality of the goods capable of muting the differences between the marks. Aurally speaking, the Applicants mark is twice as long as that of the Opponent. Conceptually speaking, I find that the first element 'Rainbow' qualifies the second word 'Colours', conveying the idea of 'the colours of the rainbow'. To my mind, this 'unity' leads the average consumer to articulate the mark in full. Taking all relevant matters into consideration, I find that there is no likelihood of direct confusion. I find this to be the case even where only a medium level of attention is paid during the purchasing act.

72. I now consider whether there is a likelihood of indirect confusion.

73. The Opponent has submitted that the relevant public 'would believe [that] the contested mark is a sub-brand of the Opponent's mark used in relation to a range of clothing, or that the goods are in some other way authorised by or originate from the Opponent'.[45]

74. I note that in the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor

[45] Opponent's written submissions in lieu of a hearing, [48].

QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), 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.

75. In *L.A. Sugar Limited v By Back Beat Inc*[46] Mr Iain Purvis Q. C., (as he then was) as the Appointed Person, explained that [my words in parentheses]:

> (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)".

76. I remind myself that a finding of a likelihood of indirect confusion should not be made merely because the competing marks share a common element.[47] I also bear in mind that the above-mentioned categories are not intended to be exhaustive. I have found the earlier mark, comprising 'Rainbow' solus, to have a medium level of distinctiveness. The common element 'Rainbow', to my mind, cannot be said to be particularly striking. I do not consider the word element 'colours' to be a non-distinctive 'add-on' in the manner of Mr Purvis' second

[46] Case BL O/375/10
[47] Case BL O/547/17, [81.4].

category, either. My view is that the distinctive character of the Applicants' mark resides in the combination of 'Rainbow' and 'Colours', whereby the former word qualifies the latter, conveying the concept of the colours of the rainbow. I consider the prospect of an average consumer presuming the marks to be related by way of deriving from the same or economically-related undertaking (e.g. as sub-brands or variant marks for the same brand) to be unrealistic. To my mind, it is difficult to conceive of any commercial rationale for the marks 'Rainbow' and 'Rainbow colours' being perceived as related brands. The Opponent has not developed its argument beyond simply saying that the average consumer would presume the parties' marks to be related brands or originating from the same undertaking. I have considered the possibility of the contested mark 'Rainbow Colours' denoting, perhaps, a particularly colourful range of 'Rainbow' clothing. However, commercially speaking, this seems to me to be far-fetched given that the mark 'Rainbow' already has some connotation of colours by virtue of being understood as a reference to the coloured phenomenon that occurs in nature. I can, therefore, find no proper basis for a likelihood of indirect confusion.

Conclusion

77. The opposition has failed in its entirety. Subject to a successful appeal, application UK00003835934 may proceed to registration.

Costs

78. The Applicants are the successful party and is therefore entitled to a contribution to its costs based upon the scale published in Tribunal Practice Notice 2/2016, calculated as follows:

Preparing a statement and considering the other side's statement	£200
Preparing for and attending a hearing	£300
Total:	**£500**

79. A modest sum of £300 has been awarded in respect of preparation for, and attendance at, the hearing for the reason that the skeleton argument and oral submissions were exceptionally brief, and the hearing very short. I wish to make clear that my comment on such brevity is not a criticism, merely an observation on the state of affairs.

80. I therefore order bonprix Handelsgesellschaft mbH to pay to Kamaljit and Darran Harris the sum of £500. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of May 2025

N. R. Morris
For the Registrar,
the Comptroller-General