O/0573/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3769166
IN THE NAME OF PHILLIP BLAKE FOR

GODLESS

IN CLASS 25

AND

THE OPPOSITION THERETO
UNDER NO 434828 BY
EVEDEN INC

Background and pleadings

1. On 23 March 2022, Phillip Blake applied for the trade mark GODLESS (application 3769166), for *Clothing*, in class 25.[1] Following publication, the application was partially opposed by Eveden Inc ("the opponent") in respect of *lingerie, bras* and *sports bras*.

2. The grounds of opposition are that the application offends sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") in so far as it covers *lingerie, bras* and *sports bras*. Under sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following earlier mark, albeit it relies only upon a reputation in *lingerie, bras* and *sports bras* for the section 5(3) ground:

3172514

GODDESS

Class 25: *Articles of clothing; articles of outer clothing; sportswear and leisurewear; casual wear; headgear; none of the aforesaid being t-shirts, sweatshirts or baseball caps; articles of underclothing; footwear; swimwear; beachwear; corsetry; articles of lingerie; ladies' underwear; corsets; girdles; brassieres; ladies' foundation wear; hosiery; vests, knickers, petticoats; nightdresses; pyjamas and housecoats; articles of knitted outerclothing; bathing suits; stockings and pantihose; bath robes.*

Filing date: 1 July 2016; registration date: 7 April 2017

3. The pleadings are, in summary:

- section 5(2)(b): there is a likelihood of confusion because the goods are identical or similar and the marks differ by only one letter;

[1] The applicant's surname is spelled as 'blake' on the trade mark application form (TM3) and recorded on the trade mark register as 'blake', but the applicant has signed documents in these proceedings as 'Phillip Blake' (and signed the form TM3 as Phillip Blake). I will refer to the applicant as Phillip Blake/Mr Blake in this decision, except in the cost order.

- section 5(3): the opponent has a reputation in the UK for its GODDESS mark for lingerie, bras and sport bras. The relevant public will be confused into believing that the contested mark is commercially connected to the opponent's mark. There will also be unfair advantage because the contested mark will benefit from the opponent's significant investment in promoting its mark. If the contested mark is used in relation to inferior products, this could cause reputational and economic damage to the opponent;

- section 5(4)(a): relying on the use of the sign GODDESS in the UK from at least 2005 in relation to *lingerie, bras* and *sports bras* to oppose the same. The opponent claims significant goodwill in the business of which GODDESS is distinctive. Misrepresentation and damage will occur through use of the contested mark because consumers will think that the contested mark is a sub-brand or economically connected to the opponent's business.

4. I note that the opponent says this in its written submissions in lieu of a hearing:

> "As set out in the Opponent's Submissions [a reference to submissions filed with its evidence], the Applicant's Goods in Class 25 are identical, closely similar and/or complementary to the Opponent's Goods. Indeed, the Applicant is seeking protection for the broad category of goods 'clothing' which encompasses the Opponent's registered goods, as well as goods in respect of which its mark has been used to date, namely, "*lingerie, bras and sports bras*", and is therefore identical thereto."

5. As set out above, the statutory notice of opposition, the form TM7, pleaded that the opposition was only in respect of *lingerie, bras* and *sports bras*. Therefore, the opponent's submissions represent an unacceptable broadening of its claim, without having made an application to amend its pleadings. I will decide this opposition on the basis that it was pleaded; i.e. the goods which are opposed are *lingerie, bras* and *sports bras*.

6. Mr Blake filed a defence and counterstatement, denying the grounds and stating that the marks have completely different meanings. Mr Blake states that he intends to sell menswear and that he owns the domain name godlessclothing.co.uk. He has never heard of the opponent's mark and he states that the opponent and its mark do not appear in the first three pages of a search on Google for GODDESS. The opponent's mark does not appear in a search on Google for GODLESS.

7. The opponent filed evidence accompanied by written submissions. Neither party asked to be heard and only the opponent filed written submissions in lieu of a hearing. The opponent is represented by Mathys & Squire LLP and Mr Blake represents himself. I will refer to the evidence and submissions where relevant to the issues I have to decide and I confirm that I have carefully considered all the papers on file.

Evidence

8. The opponent's evidence comes from Vaughan Waylett, the opponent's Finance Director, in the form of two witness statements and exhibits.[2] The purpose of his evidence is to show the opponent's use of its mark, and the sign relied upon for the passing off ground, to establish reputation and goodwill.

Section 5(2)(b) of the Act

9. Section 5(2)(b) states:

> "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,

[2] Witness statements dated 24 March 2023 and 6 June 2023.

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

10. Section 5A states:

"Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."[3]

11. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are taken 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 C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.[4]

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

[3] This section also applies to the grounds raised under sections 5(3) and 5(4)(a) of the Act.
[4] 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.

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

12. Mr Blake is silent in his notice of defence and counterstatement about the opponent's claim that the parties' goods are identical, save for asserting that he plans to use the mark in relation to menswear. As an observation, since the opponent is only opposing *lingerie, bras* and *sports bras*, it is possible that the opposition could have been withdrawn if Mr Blake had filed a form TM21B to exclude those goods from his specification, or to have limited them to his stated area of interest, menswear. As that has not happened, I have to assess the similarity of the parties' goods according to the notional coverage of the parties' specifications. The contested mark covers the opposed goods, and the opponent relies upon all the goods covered by the earlier mark. The opposed goods, *lingerie, bras* and *sports bras*, are covered by the following terms in the earlier mark's specification, either because the terms are identical or effectively so, or because there is a term in the earlier specification which is broad enough to cover the opposed goods, making the parties' goods also identical on that basis:[5]

- *Articles of clothing; none of the aforesaid being t-shirts, sweatshirts or baseball caps;*
- *articles of underclothing;*
- *corsetry; articles of lingerie; ladies' underwear; corsets; girdles; brassieres; ladies' foundation wear; knickers, petticoats*.

Average consumer and the purchasing process

13. As the case law cited above indicates, it is necessary to decide who the average consumer is for the parties' goods and how they purchase them. "Average consumer"

[5] *Gérard Meric v OHIM*, Case T-33/05, General Court of the European Union.

in the context of trade mark law means the "typical consumer."[6] The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.

14. The average consumer for the parties' goods is the general public. By and large, consumers pay a medium degree of attention to quality, material, fit, suitability and aesthetics. The goods will be selected mainly from displays in shops, or from catalogues and websites. This means that the selection process is predominantly visual, which accords with case law. For example, in *Quelle AG v OHIM*, the General Court of the European Union ("GC") stated that:[7]

> "68..... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs (*NLSPORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 49).
>
> 69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland* v *OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55). That is the case with respect to the goods at issue here. Although the applicant states that it is a mail order company, it does not submit that its goods are sold outside normal distribution channels for clothing and shoes (shops) or without a visual assessment of them by the relevant consumer. Moreover, while oral communication in respect of the product and the

[6] *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch).
[7] Case T-88/05.

trade mark is not excluded, the choice of an item of clothing or a pair of shoes is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion (*NLSPORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 50). The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers."

15. Therefore, whilst I do not discount an aural dimension to the selection process, it is the visual perception of the marks which is the most important consideration.

Comparison of marks

16. *Sabel BV v. Puma AG* 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."

17. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

18. The comparison is:

Opponent's mark	Applicant's mark
GODDESS	GODLESS

19. Both marks consist of a single element in which the overall impression of each mark resides.

20. Each mark consists of seven letters. The first three and the last three letters are the same, in the same sequence. The only difference visually between the marks is that the middle letter in the earlier mark is D and in the later mark it is L. The marks are visually highly similar.

21. The first three and the last three letters will be pronounced the same. Both marks are two syllables long. The effect of the double D in the earlier mark is that the two syllables run into each other more than they do in the later mark, which will require more enunciation of the two syllables, God-Less. That said, the marks are aurally similar to between a medium to high degree.

22. The opponent provides extracts from *Collins English Dictionary* as to the definitions of goddess and godless, as follows:[8]

- goddess: "In many religions, a goddess is a female spirit or being that is believed to have power over a particular part of the world or nature.";

[8] Annex 1 to the opponent's written submissions dated 27 March 2023.

- godless: “If you say that a person or group of people is godless, you disapprove of them because they do not believe in God.” The American English definition is “1.. denying the existence of God or a god; irreligious; atheistic 2. Impious; wicked”.

23. I note that the definitions given for ‘goddess’ in American English are:

> “1. a female god
> 2. a woman greatly admired, as for her beauty
> 3. a feminine deity proposed by some as having been worshipped from ancient times and as variously present as a goddess in many of the world’s myths and religions.”

24. This accords with my own understanding of the meaning of goddess and how it is used and would be perceived in the UK.

25. The opponent submits that the marks are highly similar, conceptually:

> “22. … both ‘godless’ and ‘goddess’ are part of the same word-family based around the distinctive element and root word ‘god’…
>
> 23. Therefore, whilst the marks do not share identical meanings, they both evoke the idea of ‘god/divinity’, rendering them conceptually highly similar, particularly considering the average consumer’s imperfect recollection.
>
> 24. Indeed, it has been held that two marks are deemed to be conceptually similar when they evoke the same idea or the same concept, and it is the Opponent’s view that this is the case for the marks at issue.”

26. In my view, these submissions over-simplify the issue. Whilst both marks contain the concept ‘god’, overall they have different meanings. A goddess is a female deity, or the word is used as a reference to a woman who is greatly admired for her beauty; e.g. Marilyn Monroe was a ‘screen goddess’. ‘Godless’, on the other hand, means someone who is without God (as in irreligious or impious). Merely sharing the root

'god' does not make the marks highly conceptually similar, but I acknowledge that the deity concept is present in both words, although the words as a whole have different meanings. On that basis, the marks are conceptually similar to a low degree.

Distinctiveness of the earlier mark

27. The assessment as to whether there is a likelihood of confusion includes considering whether the distinctive character of the earlier mark has been enhanced (i.e. more distinctiveness has been acquired) through the use made of it. If a mark has an inherently high, or an enhanced, level of distinctiveness, the likelihood of confusion is increased. The earlier mark does not directly describe or strongly allude to the goods or their characteristics. As a common dictionary word, it has an average degree of inherent distinctiveness.

28. I turn to the opponent's evidence of use of its mark to decide whether the inherent distinctiveness of the earlier mark has been enhanced by the use made of it in the UK. Distinctive character is a measure of how strongly the earlier mark identifies the goods or services for which it is registered, determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identify the goods or services as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

> "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).

29. Mr Waylett states that between 2014 and 2021, the opponent's goddessbra.com website was accessed from the UK. The figures run into several thousand per year and I note that, in 2021, the number of sessions originating from the UK was 27,235. Exhibit VW03 shows prints from UK distributors' websites, such as boobydoo.co.uk, offering GODDESS sports bras on 23 March 2017 and 22 January 2021; amplebosom.com showing GODDESS bras and knickers priced in pounds sterling on 27 March 2015 and basques, bras and knickers on 4 April 2019; simplybe.co.uk showing GODDESS bras and knickers priced in pounds sterling on 5 November 2017.[9] A print from storminadcup.co.uk, as it was on 21 January 2022, says "Embrace the natural beauty of your curves with Goddess lingerie. Choose from flattering fuller figure bras from D to K cup size". Bras, basques, bustiers and knickers are shown for sale in pounds sterling.

30. Brochures are distributed every year (examples showing the earlier mark comprise Exhibit VW04). Mr Waylett states that the number distributed in the UK between 2014 and June 2022 was 839. I note from the cover pages of the brochures that they were 'trade workbooks'. The opponent spent approximately £39,000 producing the brochure for 2020 to 2021. Press releases are issued to customers twice-yearly (examples showing GODDESS comprise Exhibit VW06). Mr Waylett states that GODDESS has been featured in publications such as the Financial Times, TeenVogue, the Lingerie Addict blog, Bustle, Buzzfeed and Underlines, the latter being a lingerie business publication. Exhibit VW12 gives details of the reach of these publications. However, what is missing are any documents showing the published features themselves. Some of the articles contained in Exhibit VW07 are obviously directed at US readers because the prices are shown in US dollars.

31. Mr Waylett states that GODDESS goods are promoted amongst the UK public via trade shows and exhibitions. Exhibits VW07 and VW11 give details of some of these, such as the INDX Intimate Apparel show (in Solihull) exhibiting 130 brands and a roadshow in Harrogate, the latter showcasing over 50 brands in 2017. Exhibit VW11 shows that UK visitors attended the Salon Internationale de la Lingerie and the Interfillie shows in Paris. Mr Waylett states that the opponent spent £87,000 attending

[9] All from the internet archive, the Wayback machine.

these shows in 2021 to 22, although I note that the opponent also sells goods under other brands. Mr Waylett states that the associated costs are distributed equally between all the brands (five brands). I note that in 2019 GODDESS was shortlisted as one of the Lingerie of the Year finalists in the UK Drapers Independents Awards.

32. Mr Waylett states that the opponent's GODDESS sales in the UK are as follows:

Product	6 - Goddess								
Invoice Value GBP	Column Labels								
Row Labels	2014	2015	2016	2017	2018	2019	2020	2021	Grand Total
UK - All UK incl. N.I	399,900	366,274	307,998	425,302	432,940	335,267	297,003	294,179	1,932,414

33. Exhibit VW09 comprises examples of invoices to UK companies between 2014 and 2021, such as JD Williams & Co Ltd t/a Figleaves, Ample Bosom, Evans and Freemans. The invoices can be cross-referenced to Exhibit VW10 which shows product codes for specific GODDESS goods.

34. The opponent submits that its market is for plus sizes and that, therefore, it is niche. I note from, for example, the Ample Bosom website evidence that GODDESS bra sizes range from 34 to 56 (back measurements) and B to JJ cup. The report about the Drapers awards says that GODDESS bras are available in back sizes 34 to 56 and cup sizes C to K. I would not describe back measurements in the 30s, nor B, C or D cups as plus size. However, even if GODDESS bras are plus size, that is still a huge market. I appreciate that some of the evidence is likely to be directed at retailers, such as the trade workbooks, but, between the eight-year period 2014 and June 2022, only a total of 839 of these were distributed. Almost every female adult and teenager in the UK wears bras and will own several at any one time, buying new ones fairly regularly. In that context, neither the turnover figures, nor the evidence as a whole, are substantial enough to find that the inherent distinctive character of GODDESS had been enhanced above medium at the relevant date.

Likelihood of confusion

35. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. The parties' goods are identical, which is a factor in the opponent's favour.

36. Mr Blake states that he owns the domain name godlessclothing.co.uk. That is not relevant to the question as to whether there is a likelihood of confusion between the trade marks; not least because there is no evidence that the average consumer has been accustomed to differentiating between the parties' marks on the basis of use of the domain name (of which there is no evidence). Ownership of a domain name does not give rights in trade mark registration. Mr Blake also states that he has never heard of the opponent's mark and that the opponent and its mark do not appear in the first three pages of a search on Google. The opponent's mark does not appear in a search on Google for GODLESS. This is not relevant to whether the average consumer will confuse the marks because search engines use algorithms. For example, many businesses pay for services which enable their website to be listed higher in these search returns than they would be otherwise. In other words, the searches returned for Mr Blake will vary over time. The assessment as to a likelihood of confusion must take into account the reactions of average consumers, who are humans, not internet search engines.

37. There are two types of confusion, direct and indirect.[10] Direct confusion occurs where marks are mistaken for one another, flowing from the principle that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them which has been retained in the mind. As mentioned earlier, the visual similarities between the parties' marks are important because the consumer will see the marks during purchase, paying the normal degree of attention, even if there is also an aural element to selection.

[10] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 10.

38. I bear in mind that the parties' marks differ visually only in the middle letter. This could be a factor in imperfect recollection because the beginnings of marks are generally important in recollection, *El Corte Inglés, SA v OHIM*.[11] It is also easier to miss a difference which appears in the middle of a mark. Pulling against imperfect recollection is the low level of conceptual similarity. However, this may not be enough to avoid a mistake made by the eye seeing what it expects to see. I consider 'goddess' to be a word more commonly encountered in the UK in cultural contexts (a woman of beauty, or film, TV and gaming characters for instance), than 'godless'. In the context of lingerie, bras and sports bras which enhance a woman's shape, the potential for the eye seeing GODDESS rather than GODLESS is greater. That people have a tendency to see what they expect to see was explained by Lord Justice Arnold in several of his judgments, the first of these as the Appointed Person in *Muhammad Sarmad v Kentucky Fried Chicken (Great Britain) Ltd*.[12] In *Industria de Diseno Textil, S.A. (INDITEX, S.A.) v Hilary-Anne Christie*, Mr Daniel Alexander QC, having referred to another of Arnold LJ's judgments (then as Arnold J) *in Aveda Corporation v Dabur India Limited [2013] EWHC 589 (Ch)*, observed at paragraph 37:[13]

> "This is an explanation for why the CJEU case law (such as Canon) may be correct to treat marks with a highly distinctive character on the grounds of their acquired reputation as enjoying more extensive protection than those with a lower level of distinctiveness – the public has been sensitized to expect them."

39. If I am wrong about my conclusions as to enhanced distinctive character and that, instead, the earlier mark has a higher than medium degree of distinctiveness through the use made of it, then it makes it more likely that consumers will see what they expect to see: GODDESS. However, I consider that this mistake will still occur on the basis of the medium degree of distinctiveness of GODDESS *per se* (i.e. even if the earlier mark had not been used), because of the context of use in relation to goods being flattering to women's physical appearance and because of the relatively more common word 'goddess' compared to 'godless'. Although the marks are only conceptually similar to a low degree, I consider that the conceptual difference is not

[11] Cases T-183/02 and T-184/02, GC.
[12] BL O/227/04. The two marks were Kentucky Fried Chicken and Kennedy Fried Chicken.
[13] Case BL O/040/20.

strong enough to counteract the high degree of visual (and aural) similarities between the marks, when used in relation to *lingerie, bras* and *sports bras*, which are identical goods.[14] Putting all the factors together, I conclude that there is a likelihood of direct confusion.

40. Indirect confusion occurs when the consumer recognises that the marks are different, but puts the similarities between them down to the undertakings being the same or economically linked.[15] The opponent submits:[16]

> " … the average consumer may take the view that the Applicant's mark 'GODLESS' is a sub-brand of the Opponent's 'GODDESS' range (for instance, designating a different/unusual/limited-edition line of goods which would contrast with the 'GODDESS' previous collections), or with its own version (or take on) of the Opponent's range of products".

41. I think this is inherently unlikely. The marks have different meanings and it is not clear to me how one would be a logical brand evolution or extension of the other. The only type of confusion which is likely is that the difference between the marks will not be noticed, as already explained (i.e. direct confusion). If the difference is noticed, there is nothing else in play which will lead to indirect confusion in the manner in which the opponent submits. There must be a belief in an economic connection, which is "something more than mere idle wondering or speculation that there might be a connection"; *per Vault IP Limited v Mark Kingsley-Williams*, Mr Iain Purvis KC, sitting as the Appointed Person.[17] In *Dirtybird Restaurants Ltd v. Salima Vellani*, BL O/413/18, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

> "18. There is no rule or presumption to the effect that the concurrent use of a trade mark and one of its components for identical or similar goods or services will always or necessarily give rise to the perception that the goods or services

[14] *Victura, Inc v JYP Entertainment Corporation*, BL O/0504/24, Mr Geoffrey Hobbs KC, sitting as the Appointed Person.
[15] See *Back Beat Inc v L.A. Sugar (UK) Limited*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person.
[16] Paragraph 25, written submissions dated 25 March 2023.
[17] Case BL O/0353/24 at paragraph 15.

concerned come from the same or economically linked undertakings. That might or might not be the case. In order to determine whether it is, the decision taker must give as much or as little significance to the visual, aural and conceptual differences and similarities between the marks in issue as the relevant average consumer would have attached to them at the relevant point in time (which in this case was July/August 2015). It is axiomatic that the relevant average consumer is to be regarded as reasonably well-informed and reasonably observant and circumspect. However, (s)he is not to be regarded as a person who normally engages in extended thought processes for the purpose of pairing and matching trade marks or actively considering how they might be developed or appropriated for use as siblings of other marks. Indirect confusion of the kind described by Mr Iain Purvis QC in paras. [16] and [17] of his decision in L.A. Sugar is a matter of instinctive reaction to precipitating factors rather than the result of detailed analysis, as emphasised by Mr James Mellor QC sitting as the Appointed Person in Duebros Ltd v Heirler Cenovis GmbH (BL O/547/17; 27 October 2017) at para. 81."

42. For the average consumer to reach a conclusion that the undertakings responsible for the marks are linked, or that the marks are brand variants, they would need to analyse the marks more than a reasonably observant and circumspect person would normally do. I do not think that this is likely; it is stepping over the line of instinctive reaction to one of detailed analysis. There are no other reasons that I am able to identify which would lead to indirect confusion.

Section 5(2)(b) outcome

43. The section 5(2)(b) ground of opposition succeeds, subject to what I will say at the end of this decision about partial refusal.

Section 5(3) of the Act

44. Section 5(3) states:

"(3) A trade mark which-

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".

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

45. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12 P, *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 use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(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 of the earlier mark; *L'Oreal v Bellure NV,* paragraph 40*.* The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(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).*

46. For a successful claim under section 5(3), cumulative conditions must be satisfied by the opponent: similarity between the marks; a qualifying reputation in the earlier mark; a link between the marks (the earlier mark will be brought to mind on seeing the later mark); and one (or more) of the claimed types of damage. It is not necessary that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the relevant public will make a link between the marks. In this case, the goods are identical.

47. The first condition of some similarity between the marks is satisfied, as found earlier in this decision.

48. The next condition is reputation. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public, as stated in *General Motors*. I find that this condition is not satisfied for the same reasons as I gave earlier in relation to enhanced distinctive character. Even if I am wrong about that, there will only be a link based upon direct confusion. If there is no confusion, but the earlier mark is brought to mind (i.e. a link is still made), it is difficult to see how the pleaded damage would ensue. There is no particular image associated with the opponent's mark which comes through from the evidence, and the promotional expenditure is relatively modest so that it is unlikely that the later mark would take unfair advantage of the opponent's marketing efforts. The pleading that the goods of the later mark may

be inferior is speculative and therefore not soundly based.[18] Detriment to distinctive character was not pleaded (although I note that there is a reference to it in both sets of the opponent's written submissions). The section 5(3) ground would succeed to the same extent as the section 5(2)(b) ground, entirely based upon direct confusion. However, my primary finding is that the ground fails for want of a sufficient reputation.

Section 5(3) outcome

49. The section 5(3) ground of opposition fails.

Section 5(4)(a) of the Act

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

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

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

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

[18] See *Unite the Union* [2014] RPC 14, Ms Anna Carboni, sitting as the Appointed Person.

52. The three elements which the opponent must show are well known. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 (IPEC), Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

> "55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.
>
> 56 In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

53. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223:

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

54. As there is no evidence that the contested mark has been used, the *prima facie* relevant date is the date of the application for the contested mark: 23 March 2022. The opponent must show that it had sufficient goodwill at this date to bring the claim. I find that it has shown sufficient evidence of goodwill in relation to its pleaded case: *lingerie, bras* and *sports bras*.

55. Although the average consumer test is not strictly the same as the 'substantial number' test, in the light of the *Court of Appeal's judgment in Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt LJ stated that:

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]".

56. All other factors are equal. The same analysis applies with regard to the similarity of the marks and the goods and services as for the opponent's section 5(2)(b) ground. Section 5(4)(a) is concerned with misrepresentation causing the customers of the earlier signs to be deceived. I find that the opponent's section 5(4)(a) ground succeeds to the same extent as its section 5(2)(b) ground. Damage would follow; for example by diversion of trade caused by a mistaken belief that the later mark was the earlier mark.

57. The section 5(4)(a) ground succeeds, subject to what I say below about partial refusal.

Partial refusal

58. The effect of Section 5A of the Act is that the application is to be refused only in relation to the opposed goods (for which the opposition has been successful). Tribunal

Practice Notice (“TPN”) 1/2012 concerns partial refusal of applications. In particular, paragraph 3.2.2(b) indicates that I am able to add an exclusion to the specification of the contested mark, if appropriate:

> “3.2.2 **Defended Proceedings**
>
> In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings the Hearing Officer will, where appropriate, adopt one or a combination of the following approaches:
>
> a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;
>
> b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;
>
> c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular

descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer may indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services.

d) This third approach will be taken when a Hearing Officer considers that there is real practical scope to give effect to Article 13, having due regard to the factors in each individual case. For example, the original specification of the international trade mark registration which was the subject of Giorgio Armani SpA v Sunrich Clothing Ltd (cited above) was clothing, shoes, headgear. The successful opposition only opposed the registration to the extent that it covered "men's and boys' clothing", thereby leaving other goods covered by the specification as unobjectionable. Such an outcome could not be reflected in changes to the specification via either the 'blue pencilling' approach or the 'save for' type of exclusion. The specification was reworded and the international registration was eventually protected for a specification reading Clothing for women and girls, shoes and headgear. Generally speaking, the narrower the scope of the objection is to the broad term(s), compared to the range of goods/services covered by it, the more necessary it will be for the Hearing Officer to propose a revised specification of goods/services. Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner's business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal."

59. The opposition is directed only at *lingerie, bras* and *sports bras*. By adding an exclusion to the specification, the opposed goods are removed. Furthermore, the

counterstatement indicates that Mr Blake intends to use the mark in relation to menswear, which means that adopting this course of action is proportionate in relation to the goods remaining, which cover those which are of interest to him (see paragraph 3.2.2(d) of the TPN).

Overall outcome

60. The opposition succeeds in relation to the opposed goods. The application may proceed to registration for the unopposed goods, i.e. for the following specification:

> Clothing; but not including lingerie, bras or sports bras.

Costs

61. The opponent has been successful against the goods which it opposed and is entitled to a contribution towards its costs, based upon the scale of costs published in Tribunal Practice Notice 2/2016. I have not made an award for the opponent's written submissions in lieu of a hearing as they essentially repeat content from its submissions filed earlier in the proceedings. I assess costs as follows:

Official fee for filing the opposition	£200
Preparing and filing the notice of opposition and considering the counterstatement	£250
Filing evidence	£800
Total	£1250

62. I order Phillip blake to pay to Eveden Inc the sum of £1250. 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 20th day of June 2024

Judi Pike
For the Registrar,
the Comptroller-General