O/0579/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3941396
IN THE NAME OF HANGZHOU MUJIA NETWORK TECHNOLOGY CO., LTD
TO REGISTER THE FOLLOWING TRADE MARK:

DECONOVO

IN CLASSES 18, 20, 21, 22, 25 & 27

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 444181
BY WACOAL EMEA LTD

Background and pleadings

1. On 3 August 2023, HANGZHOU MUJIA NETWORK TECHNOLOGY CO., LTD ("the applicant") applied to register the trade mark **DECONOVO** in the UK, under number 3941396 ("the applicant's mark"). Registration is sought for goods in classes 18, 20, 21, 22 and 27, as well as the following goods in class 25:

> *Bathing suits; leggings [leg warmers]; scarves; trousers; caps being headwear; clothing; dressing gowns; hosiery; shoes; bathing trunks; headscarves; neck tube scarves; sweaters; underwear; bath slippers; clothing for gymnastics; coats; footwear; hats; rash guards; sandals; shawls; skirts; slippers; yoga tops; yoga pants; yoga shirts; yoga socks; yoga shoes; bath robes.*

2. Details of the application were published for opposition purposes on 18 August 2023. On 17 November 2023, Wacoal EMEA Ltd ("the opponent") opposed the registration of the applicant's mark in class 25 under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

3. Under section 5(2)(b), the opponent relies upon its UK trade mark registration number 910943066, **DECO** ("the opponent's mark").[1] The opponent's mark was filed on 6 June 2012 and became registered on 5 September 2014. It stands registered for *lingerie; hosiery; beachwear; swimwear* in class 25, all of which are relied upon under this ground.

4. The opponent's mark qualifies as an 'earlier mark' in accordance with section 6 of the Act. It had been registered for more than five years at the filing date of the applicant's mark and is, therefore, subject to the use requirements in section 6A of the Act.

[1] The opponent's mark is a comparable mark based upon its EU trade mark number 10943066. On 1 January 2021, in accordance with the Withdrawal Agreement between the UK and EU, a comparable UK trade mark was automatically created. It is now recorded on the UK register, has the same legal status as if it had been applied for and registered under UK law, and retails its original filing date.

5. In its statement of grounds, the opponent contends that the competing marks are similar and that the parties' goods are identical or similar. On this basis, the opponent submits that there is a likelihood of confusion.

6. Under section 5(4)(a), the opponent claims that it has significant goodwill in its business in relation to which it has used the sign **DECO** ("the opponent's sign") throughout the UK since 2012. The opponent's sign is said to have been used in respect of *lingerie; hosiery; beachwear; swimwear; sports bras*. The opponent argues that use of the applicant's mark in respect of the applied-for goods in class 25 would constitute passing off.

7. The applicant filed a counterstatement, denying the grounds of opposition. It also indicated that it would require the opponent to provide proof of use of its mark.

8. Both parties are professionally represented; the opponent by Mathys & Squire LLP and the applicant by Charlie, Liu. Only the opponent filed evidence. No hearing was requested and only the opponent filed written submissions in lieu. I also note that the opponent filed written submissions during the evidence rounds. This decision is taken following a careful consideration of all the papers before me.

Relevance of EU law

9. 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.

Evidence and submissions

10. The opponent's evidence is given in the witness statement of Vaughan Waylett, dated 26 April 2024, together with 14 exhibits (VW1-VW14). Mr Waylett is a director

of the opponent, a position he has held since 1 April 2016. He provides evidence of use of the opponent's mark/sign.

11. I have taken all the evidence into account in reaching my decision and will refer to it below where necessary.

Preliminary issue

12. Within both of its written submissions, the opponent claims that its mark has a reputation in the UK and that use of the applicant's mark, without due cause, would take unfair advantage of, and be detrimental to, the distinctive character and repute of its mark. These arguments are relevant to claims under section 5(3) of the Act, a ground which has not been pleaded by the opponent. As such, I say no more about them.

Proof of use

13. Section 6A of the Act reads as follows:

> "(1) This section applies where –
>
> (a) an application for registration of a trade mark has been published,
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> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
>
> (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
>
> (1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

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

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

14. Pursuant to the above provisions, the relevant period for assessing whether there has been genuine use of the opponent's mark is the five-year period ending with the filing date of the applicant's mark, i.e. 4 August 2018 to 3 August 2023.

15. 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].
>
> 106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:
>
> (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
>
> (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]."

16. Moreover, section 100 of the Act states that:

"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. As the opponent's mark is a comparable mark, it may rely upon use of the mark in the EU for any parts of the relevant period which fall prior to IP Completion Day, that being 31 December 2020.[2]

18. Mr Waylett says that the opponent manufactures lingerie, beachwear and swimwear, with a focus on women's lingerie and swimwear. He says that 'DECO' is a range under the 'FREYA' brand which has been used continuously in the UK since its launch in 2009. Printouts, obtained via the Wayback Machine, from the freyalingerie.com/uk website ("the Freya website") have been provided.[3] They are dated between 29 September 2020 and 23 January 2023, and show the word 'Deco' being used in relation to bras.

19. In addition to targeting UK consumers through the Freya website, Mr Waylett says that 'DECO' goods are offered through the websites of distributors/stockists. The

[2] Part 1, Schedule 2A of the Act, paragraph 7
[3] Exhibit VW2

following printouts, obtained via the Wayback Machine, from third-party websites have been provided:[4]

(i) Printouts from the House of Fraser website (UK) dated 16 January 2021 and 17 September 2021. These show the word ‘Deco’ being used in relation to bras and bikini tops. This evidence also shows that House of Fraser has multiple stores across England.

(ii) Printouts from the STORM in a D CUP website (UK) dated between 13 April 2021 and 17 August 2022. The word ‘Deco’ can be seen in connection with bras and underwear. The printouts show that this undertaking is based in Twickenham.

(iii) Printouts from Amazon (UK), showing listings for ‘Deco’ bras, bikini tops and a swimsuit. The date these goods were first available are given as 21 August 2013, 10 February 2016, 11 February 2016 and 6 June 2017. There are reviews from verified purchasers in the UK from within the relevant period in 2018, 2019, 2022 and 2023.

(iv) Printouts from the BRAVISSIMO website dated 27 February 2021, 26 October 2021 and 24 May 2022. The printouts show listings for ‘Deco’ bras. Although the printouts are from a global website, the prices are given in pound sterling and the website shows that BRAVISSIMO has multiple stores across the UK.

(v) Printouts from the LEIA website dated between 26 May 2022 and 10 June 2023. These show listings for ‘Deco’ bras and bikini tops. They are from a global website, but the prices are given in pound sterling; the website also states that this undertaking is based in York.

(vi) Printouts from the Belle Lingerie website (UK) dated 27 September 2021 and 16 August 2022. They show listings for ‘Deco’ briefs and bras.

[4] Exhibit VW3

20. Mr Waylett has also exhibited a list of the opponent's UK "e-tailers" (retailers selling goods online).[5] There are 38 undertakings listed, who cumulatively made sales of over £28 million between 2019 and 2023.[6] Mr Waylett does not confirm whether these sales relate solely to 'DECO' goods, or whether they include sales of goods from other ranges and brands. In the list itself, it states that the sales relate to all products. In light of this, as well as the turnover information relating to 'DECO' products set out below, I am unable to infer that the sales listed in the document relate solely to the opponent's mark; rather, they are likely to represent sales of all of the opponent's goods through these undertakings.

21. In addition, Mr Waylett has provided examples of product brochures (or 'trade workbooks') for the 'Freya' range of goods for each year between 2018 and 2023.[7] 'Deco' branded bras and underwear can be seen within the brochures, which include UK size guides. Mr Waylett says that these brochures – and other materials such as leaflets – have been distributed in the UK. In support, he provides a spreadsheet detailing the numbers of trade workbooks and 'lookbooks' that have been distributed in this territory between 2019 and 2023; I note that the opponent distributed 144,529 materials in this time period, though some are labelled as 'French', rather than 'English'.[8] Mr Waylett also exhibits a spreadsheet showing that the opponent spent £866,510.03 on these 'Freya' trade workbooks and lookbooks.[9]

22. Mr Waylett gives the following turnover figures relating to sales of 'DECO' products in the UK:[10]

[5] Exhibit VW3
[6] There may, in fact, be less than 38 undertakings, given that some appear to be duplicated (for example, "NEXT" and "NEXT RETAIL LTD"). I also bear in mind that some of the £4.2 million accrued in 2023 is likely to have been from sales made after the end of the relevant period.
[7] Exhibit VW4
[8] Exhibit VW5
[9] Exhibit VW6
[10] Exhibit VW9 I again bear in mind that some of the turnover accrued in 2023 is likely to have been from sales made after the end of the relevant period.

Year	Turnover (£)
2019	487,072.21
2020	256,442.11
2021	352,445.05
2022	373,898.76
2023	212,547.58
Total	1,682,405.71

23. The figures are not broken down by individual product, though I note that bras and underwear appear throughout the sales data. In support of the turnover figures, Mr Waylett has provided example invoices, which demonstrate the sale of 'DECO' branded bras to UK customers between 1 April 2019 and 27 April 2023.[11]

24. Mr Waylett says that the 'DECO' brand has featured in well-known UK publications. He provides extracts of the same, which comprise the following:[12]

(i) An article in *Cosmopolitan*, dated 15 January 2021. I note that a 'Deco' product is included in a 'best comfortable bras' feature.

(ii) An article in *Uplifted Lingerie*, dated 29 July 2021. In exploring the 'Freya' range of goods, the article discusses a 'Deco' strapless bra and its features.

(iii) Blog posts on *Investin Your Chest*, dated 13 November 2019, 4 January 2020 and 5 January 2020. These consist of reviews of 'Deco' bras, or reviews which refer to 'Deco' bras by comparison.

(iv) A blog post on *Ruth Crilly*, dated 17 August 2021. In a review piece about strapless bras, the author recommends a 'Deco' product, amongst others.

25. In addition to this, Mr Waylett says that 'DECO' goods are marketed under the 'Freya' brand, which has a longstanding and consistent presence on social media. He

[11] Exhibit VW10
[12] Exhibit VW7

provides a selection of printouts from the 'Freya' social media accounts.[13] From these, I note that the 'Freya' Facebook page was created in January 2010 and has 135,000 likes; on 22 November 2019, 29 August 2020 and 27 July 2021, the account posted about 'Deco' bras. I also note that the 'Freya' X (formerly Twitter) page was created in February 2010 and has 19,700 followers; the account posted about 'Deco' bras on 31 March 2020, 18 January 2021 and 27 July 2021. The 'Freya' Instagram page has 146,000 followers; I note that there were posts featuring 'Deco' bras on 9 November 2019 and 28 April 2020.

26. The evidence has its limitations. For instance, no details of the size of the relevant market have been provided or the share of that market held by 'DECO' branded goods. Moreover, as the workbooks and lookbooks relate to the 'Freya' brand at large, it cannot be said that all the sums spent in this regard are directly relevant to the opponent's mark. There are also no circulation or readership figures for the publications and blogs. As for the social media evidence, it is not possible to ascertain how many of the individuals who follow/like the Freya accounts are based in the UK. In addition, as the printouts are not dated, the follower/likes figures are likely to reflect the position at the date of Mr Waylett's statement, i.e. 26 April 2024; therefore, it is not possible to ascertain what the figures were at any time during the relevant period.

27. Nevertheless, an assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole.[14] The opponent has provided printouts from the Freya website which show 'DECO' branded goods offered for sale in the UK during the relevant period. Printouts from the websites of several third parties (some of which are extremely large undertakings) also show the same. Moreover, the opponent produced and distributed over 140,000 brochures containing 'DECO' branded goods in the UK during the relevant period. I also note that 'DECO' branded goods featured in a few publications during the relevant period, one of which I understand to be popular in the UK. Although the social media evidence is rather limited, it at least shows that the opponent has made an attempt to promote 'DECO' branded goods via those channels. Turnover figures have also been provided, which

[13] Exhibit VW8
[14] *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T-415/09

show that the opponent generated up to around £1.6 million from the sale of 'DECO' branded goods during the relevant period. The figures are supported by invoices demonstrating the sale of such goods to UK customers during the relevant period. Whilst the figures appear relatively small in the context of what is likely to be a very large market in the UK, the authorities stipulate that use does not need to be quantitatively significant for it to be deemed genuine. Taking all the evidence into account, it is clear that the opponent has attempted to create and maintain a market for its 'DECO' branded goods. Although the evidence mostly shows use of the opponent's mark as a secondary mark in conjunction with the word 'Freya', use of a mark encompasses both its independent use and its use as part of another mark or in conjunction with that other mark.[15] I am satisfied that the opponent has demonstrated genuine use of its mark.

28. In determining a fair specification for the opponent's mark, I acknowledge that fair protection is not to be achieved by identifying and defining particular examples of goods for which there has been genuine use but, rather, the particular categories of goods they should realistically be taken to exemplify.[16] I must consider how the average consumer would fairly describe the goods shown in evidence.[17] The evidence shows that the opponent has used its mark in connection with bras and underwear. This is clear from the printouts from the Freya and third-party websites, the product brochures, the sales data, the extracts from publications and the social media posts. To my mind, the average consumer would fairly describe these goods as *lingerie*. Although bikini tops and women's swimsuits can also be seen in the printouts from third-party websites, I do not consider use in relation to these goods to justify reliance upon the broad terms *beachwear* and *swimwear*. This is because these categories include a variety of other goods, which are different in essence from bikini tops and swimsuits, and of which there is no evidence of the opponent providing. In my view, the average consumer would fairly describe the goods shown in evidence as *women's swimwear*. Finally, there is no documentary evidence of the opponent's mark being used in connection with *hosiery* during the relevant period and Mr Waylett does not

[15] *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, paragraphs 32-35
[16] *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10
[17] *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

refer to these goods in his statement. As such, this term may not be relied upon by the opponent. Taking all of this into account, I find that the opponent may rely upon *lingerie* and *women's swimwear* for the purposes of the opposition.

Section 5(2)(b)

Legislation and case law

29. Sections 5(2)(b) and 5A of the Act read as follows:

> "5(2) A trade mark shall not be registered if because -
>
> […]
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."
>
> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

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

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

31. In *Canon*, the Court of Justice of the European Union ("CJEU") stated, at paragraph 23 of its judgment, that:

> "In assessing the similarity of the goods or services concerned, […] all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

32. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity were:

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

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

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

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

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

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

33. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM,* Case T-325/06, the General Court ("GC") stated that 'complementary' means:

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

34. In *Gérard Meric v OHIM,* Case T- 133/05, the GC stated that:

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

35. The goods to be compared can be found at paragraphs 1 and 28.

36. The opponent's *women's swimwear* incorporates all types of women's swimwear, including the applicant's *bathing suits*. These goods are to be regarded as identical in accordance with the principle outlined in *Meric*.

37. The applicant's *clothing* is a broad term which encompasses all kinds of clothing, including the opponent's *lingerie* and *women's swimwear*. These goods are also identical under the principle outlined in *Meric*.

38. The applicant's *underwear* falls within the scope of the opponent's *lingerie*. These goods are identical under the *Meric* principle.

39. *Hosiery* is defined as being a word used, especially in shops, for goods such as socks, tights and stockings.[18] It is my view that there is an overlap in nature, method of use and intended purpose with the opponent's *lingerie* insofar as they are both types of undergarments which are worn on the body. The goods reach the market through the same trade channels and are likely to be located within the same sections of retail outlets. They are also likely to be produced by the same undertakings. The respective goods share users. They are not in competition. However, there is a degree of complementarity between them in the sense that lingerie and hosiery may be purchased with the intention of creating a coordinated look or as part of a matching set. Taking all of this into account, I find that the respective goods are highly similar.

40. Although women may wish to wear shorts for swimming, *bathing trunks* are defined as a piece of men's clothing which are worn whilst swimming.[19] This is consistent with my own experience as an average consumer. Therefore, I do not consider the applicant's goods to be identical to the opponent's *women's swimwear*. However, the respective goods are both items of swimwear which are likely made from the same (or similar) materials and used for the same purpose, i.e. swimming. As such, they have the same nature, method of use and intended purpose, the only difference being that one is typically for women and the other for men. The respective goods reach the market through the same trade channels, such as clothing stores, albeit that they may be presented in different sections of those outlets. For instance, in some retail environments, women's swimwear will be located with other items of women's clothing, whereas bathing trunks will be located with other items of men's clothing. The respective goods may also be produced by the same undertakings. I do not consider

[18] https://dictionary.cambridge.org/dictionary/english/hosiery
[19] As per the definition at https://dictionary.cambridge.org/dictionary/english/swimming-trunks, a term which is treated as synonymous with bathing trunks.

there to be any material competition between the respective goods. Neither are they complementary, given that they are not important or indispensable to one another. In light of all this, I find that there is between a medium and high degree of similarity between the respective goods.

41. There is an overlap in nature, method of use and intended purpose between the opponent's *lingerie* and the applicant's *leggings [leg warmers]; scarves; trousers; dressing gowns; neck tube scarves; sweaters; clothing for gymnastics; coats; shawls; skirts; yoga tops; yoga pants; yoga shirts; yoga socks; bath robes; rash guards* in that they are all kinds of clothing which are worn on the body. However, I acknowledge that this overlap is somewhat limited, given the different forms and materials of the respective goods, as well as their uses. The respective goods reach the market through overlapping trade channels and may sometimes be produced by the same undertakings, although they may appear in different sections of retail outlets. The respective goods share users. There is no competition between the respective goods. Moreover, as they are neither important nor indispensable to one another, they are not complementary. Overall, I find that there is a medium degree of similarity between the respective goods.

42. As for *caps being headwear; hats; headscarves; shoes; bath slippers; footwear; sandals; slippers; yoga shoes*, the overlap in nature, method of use and intended purpose with the opponent's *lingerie* is even more limited, since these goods are not items of clothing per se or worn on the body. The respective goods share users and are likely to reach the market through overlapping trade channels. However, I acknowledge that these items of headwear and footwear will be found in different sections of retail outlets. The respective goods are not in competition. Furthermore, as they are not important or indispensable to one another, they are not complementary. Balancing all of these factors, I find that there is only a low degree of similarity between the respective goods.

The average consumer and the purchasing process

43. As the case law indicates, I must determine who the average consumer is for the parties' goods and the manner in which they are likely to select those goods. The average consumer has been described in the following terms:[20]

> "The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The […] relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

44. The average consumer of the goods at issue in these proceedings is a member of the general public. The goods are likely to be purchased relatively frequently. The associated cost will vary, with cheaper items at one end of the spectrum and more expensive fashion/luxury pieces at the other. Overall, they are relatively inexpensive and, as such, the purchasing process will not require an overly considered thought process. That being said, the average consumer will consider factors such as style, quality, size, fit and compatibility with other items when making a selection. In light of the foregoing, I agree with the opponent that the average consumer will demonstrate an average (medium) level of attention.

45. The goods are typically sold in physical retail establishments and their online equivalents, where the goods are self-selected from rails and shelves, or after viewing images and information on webpages. As the GC stated in *New Look Limited v OHIM*, Cases T-117/03 to T-119/03 and T-171/03:

> "50. […] Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral

[20] *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), paragraph 60

communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing 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."

46. In accordance with this, I find that visual considerations will dominate the purchasing process, but I do not discount aural considerations entirely.

Distinctive character of the earlier mark

47. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

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

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

48. Registered trade marks possess varying degrees of inherent distinctive character. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

49. The opponent's mark is in word-only format and consists of the word 'DECO'. As there are no other elements in the mark, its distinctiveness lies in the word itself. The word 'DECO' may be reminiscent of the 'art deco' style of decoration, as per the definition from Collins Dictionary provided by the opponent.[21] However, the opponent has not provided any evidence which establishes that the average consumer of the goods at issue would perceive the word in this way. In the absence of such evidence, it is my view that individuals who would are not likely to constitute a significant proportion of average consumers. Rather, it is considered that the average consumer would perceive the mark as an invented word with no meaning. As such, I find that the opponent's mark possesses a high level of inherent distinctive character.

50. Evidence has been filed and I am now required to consider whether the opponent has demonstrated that its mark had an enhanced level of distinctive character at the relevant date of 3 August 2023.

51. I have already assessed the evidence and found that it demonstrates genuine use of the opponent's mark in the five-year period preceding the relevant date. However, the burden for establishing enhanced distinctive character is a much heavier one, in that it requires a level of knowledge of the mark amongst average consumers leading to the mark having a greater capacity to identify the goods as coming from a particular undertaking, not simply that there has been an attempt to create or maintain a market for goods under the mark.

52. The opponent's evidence shows that its mark was displayed on the Freya website, as well as those of third parties, for around three years before the relevant date. The printouts from Amazon suggest a longer period of use through that channel. Moreover, the product brochures date back to 2018. Overall, however, the evidence is not

[21] Annex 2 to the opponent's written submissions of 26 April 2024

demonstrative of longstanding use of the opponent's mark. The turnover figures provided by the opponent show that over £1.6 million was accrued through sales of 'DECO' goods since 2019. Without market share information, it is difficult to ascertain how significant the sales of goods bearing the opponent's mark were before the relevant date. However, in the context of the relevant market(s), on the face of it the figures do not strike me as indicative of intensive use of the mark. This is particularly the case, given that the figures have not been broken down (by reference to, for example, what proportion of it relates to lingerie and what proportion of it relates to swimwear). The evidence also shows that the opponent spent over £800,000 in the production and distribution of around 140,000 advertising materials before the relevant date. However, these figures relate to the whole 'Freya' brand, not just the opponent's mark. In addition, there is no further evidence of any marketing activities or amounts spent on the same. I acknowledge that the opponent's mark featured in several publications, but no circulation or readership figures have been provided and I am personally only aware one of the publications (*Cosmopolitan*). It is, therefore, difficult to determine how many consumers would have been exposed to the opponent's mark through the articles and blogs. The opponent's mark may have featured on the 'Freya' social media pages. However, I am unable to determine how many of the follows/likes are from individuals in the UK or how many of these the pages had prior to the relevant date. On the balance of all the evidence, I am not satisfied that the distinctive character of the opponent's mark had been enhanced above its inherent characteristics at the relevant date. I should add that, even if it did, this would not be to such an extent that it would have any material effect on the outcome of these proceedings (the opponent's mark being highly distinctive inherently).

Comparison of trade marks

53. It is clear from *Sabel* 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 *Bimbo* 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."

54. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

55. The marks to be compared are as follows:

The opponent's mark	**The applicant's mark**
DECO	DECONOVO

56. The competing marks are both in word-only format and consist of the words 'DECO' and 'DECONOVO', respectively. The opponent submits that the applicant's mark comprises two words, and the emphasis will be on the first, i.e. 'DECO'. I disagree. As discussed in further detail below, there does not appear to be any reason which would lead the average consumer to dissect the word 'DECONOVO' into two words. Rather, it is my view that the average consumer would perceive the mark as one word. There being no other elements in the competing marks, I find that the overall impressions of the marks lie in the words 'DECO' and 'DECONOVO' themselves.

57. Visually, the marks are similar to the extent that they share the letters 'D', 'E', 'C' and 'O' in the same order. These letters comprise the entirety of the opponent's mark and appear at the beginning of the applicant's mark, a position which is generally considered to have more impact.[22] The competing marks are visually different in that

[22] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

the applicant's mark contains an additional four letters. These additional letters also render the applicant's mark twice as long as the opponent's mark. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of visual similarity between the competing marks.

58. Aurally, the opponent's mark consists of two syllables, i.e. "DE-CO", whereas the applicant's mark consists of four, i.e. "DE-CO-NO-VO". The first two syllables are identical, but the applicant's mark has two additional syllables, rendering it twice as long as the opponent's mark. Overall, I find that there is a medium degree of aural similarity between the competing marks.

59. Conceptually, the opponent's mark is likely to be perceived as an invented word with no semantic content. As for the applicant's mark, the opponent argues that 'NOVO' is descriptive and would be perceived as denoting something new. In support of this, it has provided a definition from Collins Dictionary, showing that the term "de novo" is a Latin adverb which means "from the beginning; anew".[23] Whilst I acknowledge that consumers may break a mark down into verbal elements which suggest a concrete meaning or resemble words known to them,[24] for a concept to be relevant, it must be capable of immediate grasp by the relevant consumer.[25] I am not convinced that the average consumer would dissect 'DECO' from 'NOVO' and perceive the latter as a descriptive reference to something new. The mark does not contain the dictionary defined term as a whole. Even if it did, it is unlikely that the average consumer would understand it. This is because Latin has ceased to be a commonly used language in the UK. Whilst I accept that some individuals might understand Latin or attribute some meaning to 'NOVO', I do not consider them to be numerous enough to constitute a significant proportion of average consumers. This is particularly the case, given that the opponent has provided no evidence pointing to the average consumer's understanding of the term/word. In my view, the applicant's mark is most likely to be seen as a single invented word with no obvious. As neither of the competing marks has any semantic content, the conceptual position is neutral.

[23] Annex 2 to the opponent's written submissions of 26 April 2024
[24] *Usinor SA v OHIM*, Case T-189/05
[25] *The Picasso Estate v OHIM*, Case C-361/04 P

Likelihood of confusion

60. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

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

62. Earlier in this decision, I concluded that:

- The parties' goods are identical or similar to at least a low degree;

- The average consumer is a member of the general public, who will demonstrate a medium level of attention during the purchasing process;

- The purchasing process is likely to be predominantly visual in nature, though aural considerations have not been excluded;

- The opponent's mark has a high level of distinctive character;

- The overall impressions of the competing marks lie in their respective words, i.e. DECO' and 'DECONOVO';

- There is a medium degree of visual and aural similarity between the competing marks, whilst the conceptual position is neutral.

63. I acknowledge that the opponent's mark is entirely reproduced at the beginning of the applicant's mark. Moreover, I accept that the opponent's mark possesses a high level of distinctive character. Nevertheless, taking all the above factors into account, it is my view that the differences between the competing marks are likely to be sufficient for the average consumer, paying a medium degree of attention, to distinguish between them and avoid mistaking one for the other. The applicant's mark contains four additional letters, i.e. 'NOVO'. Although the beginnings of trade marks tend to have more impact, that is a general rule which is not necessarily determinative.[26] In the present case, it is my view that the additional letters in the applicant's mark are unlikely to be overlooked; all the letters in the applicant's mark contribute to its overall impression, not just the first four. Moreover, as a result of the additional letters, the applicant's mark is twice as long as the opponent's mark. Although I accept that there is no special test for 'short' marks,[27] the opponent's mark consists of only four letters and, therefore, the four additional letters are more likely to be noticed. Accordingly, even taking into account the principles of imperfect recollection and interdependency, I find that there is no likelihood of direct confusion, even in relation to identical goods.

64. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later

[26] See, for example, *CureVac GmbH v OHIM*, Case T-80/08.
[27] *Robert Bosch GmbH v Bosco Brands UK Limited*, BL O/301/20, paragraph 43

mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

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

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

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

65. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.[28] However, indirect confusion has its limits; such a finding should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another

[28] As was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, paragraph 12.

mark.[29] It has also been emphasised that, where there is no direct confusion, there must be a proper basis for finding indirect confusion.[30]

66. Within its written submissions, I note that the opponent refers to a prior decision of this Tribunal (BL O/282/20) in which a likelihood of indirect confusion was found between the plain word 'CAMEL' and a figurative mark containing the words 'CAMEL ACTIVE'. This was on the following basis:

> "[the word 'ACTIVE' and the presentational differences] are likely to be seen as an extension of a brand (being a variant mark that identifies a range of active wear clothing). Taking all of the above factors into account, the presence of the word 'CAMEL' in each of the marks will lead the average consumer to view them as alternative marks used by the same or economically linked undertakings."

67. The opponent argues that the same reasoning applies in this case because it is said that the additional word 'NOVO' is descriptive. I disagree. Although, for what it's worth, I agree with the Hearing Officer's finding in that decision, it is well-established that previous decisions of the Tribunal are not binding. Moreover, the marks at issue in those proceedings are not sufficiently comparable to the competing marks in the present proceedings. This is particularly because i) the applicant's mark is not made up of two words but, rather, a single word and ii) the applicant's mark does not consist of the opponent's mark with an additional descriptive word and minor presentational differences. For these reasons, the decision does not assist the opponent.

68. Having regard to all the aforementioned factors and principles, I do not believe that the average consumer will assume that the opponent and the applicant are economically linked undertakings on the basis of the competing marks. I am not convinced that the average consumer will assume a commercial association, collaboration or licencing agreement between the parties, or sponsorship on the part of the opponent, merely because they share the letters 'DECO'. The opponent's mark

[29] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17
[30] See the Court of Appeal's comments in *Liverpool Gin Distillery*, paragraph 13.

may be highly distinctive, but the letters in the applicant's mark combine with the additional letters 'NOVO' to form one word; the average consumer would have no reason to dissect the mark and separate the first four letters from the whole. Therefore, there is no sharing of an independent distinctive element which would give rise to this type of indirect confusion. Furthermore, I do not consider the differences between the competing marks to be simple additions or removals of non-distinctive elements, and they are not consistent with any logical brand extensions that would be familiar to the average consumer. I can see no reason why an undertaking would take the invented word 'DECO' and add four (seemingly arbitrary) letters, resulting in a different invented word.

69. Whilst I acknowledge that the categories of indirect confusion identified in *L.A. Sugar* are not exhaustive, to my mind there is no other basis for concluding that the average consumer would assume an economic connection between the parties. In this regard, I do not agree with the opponent that this is a case in which the principle established in *Medion v Thomson* applies. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J (as he then was) considered the impact of the CJEU's judgment in *Bimbo* on the court's earlier judgment in *Medion v Thomson.* The judge said:

> "18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.
>
> 19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole,

and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

70. In the present proceedings, the applicant's mark does not consist of two elements but, rather, one single word; the average consumer will not perceive the mark as consisting of two signs. The 'DECO' string in the applicant's mark forms a word in combination with the other four letters which follow, and the average consumer will have no reason to dissect the mark in two. As such, although the first four letters of the applicant's mark are identical to the opponent's mark, they do not have a distinctive significance which is independent of the significance of the mark as a whole. Therefore, there is no basis upon which to find that this type of indirect confusion is likely to arise.

71. In light of all the above, I find that there is no likelihood of indirect confusion, even in respect of identical goods.

Conclusion

72. The opponent's claim under section 5(2)(b) is dismissed.

Section 5(4)(a)

Legislation and case law

73. 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."

74. 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."

75. 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)."

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

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

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

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

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

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

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

77. As no evidence has been filed by the applicant to show that its mark has been used, the relevant date for the purposes of the opponent's claim under this ground is the filing date of the applicant's mark, namely 3 August 2023.[31]

Goodwill

78. The first hurdle for the opponent is to show that it had the necessary goodwill in the sign relied upon at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

"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

[31] *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11

which distinguishes an old-established business from a new business at its first start."

79. I have already found that the evidence provided by the opponent is insufficient for the purposes of establishing that the distinctive character of a registered mark identical to the sign relied upon under this ground had been enhanced through use at the relevant date. Nevertheless, that does not preclude a finding of goodwill since a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small.[32] For the same reasons as given at paragraphs 27 and 28 above, I am satisfied that the opponent has demonstrated that its business in *lingerie* and *women's swimwear* enjoyed a moderate level of goodwill at the relevant date. I am also satisfied that the 'DECO' sign was distinctive of that goodwill.

Misrepresentation

80. 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]"
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville*

[32] See, for example, *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590.

Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

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

81. In *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501, Lewison LJ cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that "a substantial number*"* of the relevant public are deceived, which might not mean that the average consumer is confused. However, considering the Court of Appeal's later 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.[33] This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

82. I have already found that there is no likelihood of confusion between the applicant's mark and a registered mark identical to the opponent's 'DECO' sign. In light of the above and for the same reasons as given in my global assessment under section 5(2)(b), I do not consider that a substantial number of members of the public will be

[33] Although this was an infringement case, the principles are equally applicable to section 5(2) of the Act: *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch).

deceived into purchasing the applicant's goods in the mistaken belief that they are the goods of the opponent.

Conclusion

83. The opponent's claim under section 5(4)(a) is dismissed.

Overall outcome

84. The opposition under sections 5(2)(b) and 5(4)(a) of the Act has failed. Subject to any appeal against my decision, the applicant's mark will proceed to registration in the UK for all the applied-for goods.

Costs

85. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. The applicant did not engage with the proceedings following the filing of its counterstatement. In the circumstances, I award the applicant the sum of £300 towards the costs of considering the opponent's statement and preparing a counterstatement.

86. I order Wacoal EMEA Ltd to pay HANGZHOU MUJIA NETWORK TECHNOLOGY CO., LTD the sum of £300. This sum is to be paid within 21 days of the expiry of the appeal period, or within 21 days of the final determination of the proceedings if any appeal against this decision is not successful.

Dated this 27th day of 2025

James Hopkins
For the Registrar