O-0589-25

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003953872

IN THE NAME OF TOPEAK LIMITED FOR THE FOLLOWING TRADE MARK:

STYLECLOSET

IN CLASS 25

AND

IN THE MATTER OF AN OPPOSITION THERETO UNDER NO. 444937

BY CLOSET CLOTHING CO. LTD

Background and Pleadings

1. On 7 September 2023, TOPEAK LIMITED ("the applicant") applied to register 'STYLECLOSET' as a trade mark in the United Kingdom. The trade mark was published for opposition purposes on 29 September 2023. Registration is sought for the following goods in class 25:

Clothes; clothing; shoes.

2. On 28 December 2023, Closet Clothing Co. Ltd ("the opponent") filed an opposition against the mark, in its entirety, under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). For the purpose of the opposition, the opponent relies upon the following trade marks and the goods laid out below for which they are registered:

United Kingdom Trade Mark ("UKTM") 3634489:

Closet.
LONDON

Filing date: 29 April 2021
Registration date: 17 September 2021

Clothing, footwear, headgear. (Class 25)

UKTM 3226667:

CLOSET

Filing date: 24 April 2017
Registration date: 14 July 2017

Clothing (Class 25)

3. In its Notice of Opposition, the opponent submits that the similarities between the respective trade marks, and particularly the parties' shared use of "CLOSET", coupled with the identity or high similarity between the respective goods, gives rise to a likelihood of confusion.

4. In its counterstatement, the applicant denies that there exists a likelihood of confusion, submitting instead that the respective marks are "distinguishable". It also highlights differences in the goods offered by each party and the way in which they are marketed. The applicant also puts the opponent to proof in respect of its earlier mark ending '667.

5. The opponent is represented by Maguire Boss whilst the applicant is represented by Axis Professionals Ltd. The opponent filed evidence and written submissions during the evidential rounds.[1] Neither party requested a hearing nor did either elect to file written submissions in lieu. This decision is taken following a careful perusal of the papers.

Relevance of EU law

6. 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

[1] On receipt of the opponent's evidence, the applicant was invited to file evidence and/or submissions by 22 July 2024. In reply to an enquiry from the applicant on 25 July 2024, the registry advised that, since the relevant deadline for filing evidence had expired, if the applicant intended to file evidence it must file an official form TM9R by 6 August 2024. As no form was received, on 6 September 2024 the registry wrote to both parties confirming that the evidence rounds were concluded. In a further enquiry on 20 September 2024, the applicant asked what could be done if it still wished to file evidence. On the same date, the registry directed the applicant to Form TM9R but advised that "the registry would need to be presented with especially compelling reasons not only why the applicant missed the deadline, but why it considers that it needs to file evidence in the present case". As no form was received, the case was progressed for a decision on the papers.

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.

Preliminary matter

7. In its counterstatement, the applicant submits as follows:

> "…Applicant's goods are sold virtually exclusively through authorized distributors in the UK. Applicant's goods generally are not advertised via radio or television and are not sold via telephone. Thus, the circumstances surrounding the sale of applicant's goods further diminish the alleged phonetic similarity as a factor.
>
> …
>
> Here, the clothes products are stylised and personalised, with different types of clothing for different age groups. So the products are purchased after careful consideration than where they are purchased casually."

8. I can address these points relatively briefly. As an assessment as to a likelihood of confusion is a prospective analysis, I must consider the potential for conflict between the respective trade marks in light of all relevant circumstances. In the context of registering or protecting a new mark, all of the circumstances in which the mark *may* be used if registered must be taken into account.[2] Differences between the nature of the parties' *current* offerings are therefore irrelevant to the assessment I am required to make, except to the extent that those differences are apparent from the lists of goods or services they have tendered for the purpose of registration. Furthermore, the assessment should not be restricted to the current marketing or trading patterns of the parties.[3] As parties' marketing strategies are transitional and can change with the passage of time, it would be inappropriate to take such factors into account when approaching the prospective analysis of a likelihood of confusion.[4]

[2] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66
[3] *Oakley v OHIM*, Case T-116/06
[4] *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P

Evidence

9. The opponent's evidence comprises a witness statement from Mr Mohammad Sajjad Baig dated 16 May 2024 and a witness statement from Sylvie Tate, of Maguire Boss, dated 20 May 2024. Mr Baig is the opponent's company director and his statement is supported by thirty exhibits (MSB1 – MSB30). Ms Tate's statement is accompanied by a single exhibit (ST1).

10. I take the following from the opponent's evidence:

The opponent's company was founded in 1996 and has consistently traded as "Closet" since its incorporation. Since 1996, CLOSET has been used continuously in the UK in relation to clothing.

The opponent's figurative mark was first used in the UK in 2015 and has been used continuously in relation to clothing.

The opponent's domain name https://www.closetlondon.com has been used for trading purposes since 2011.

The opponent uses representations of both its marks on the labels and tags attached to its goods.

The turnover the opponent has generated by the sales of its goods under both marks from 2017 to 2022 is as follows:

Year	UK Turnover (£)
2022	5,535,570.00
2021	5,005,499.43
2020	3,694,452.48
2019	5,512,338.64
2018	5,425,885.74
2017	4,989,234.46
Total	**30,162,980.75**

Between 2017 and 2022, the opponent invested nearly £4,000,000 into the advertisement and promotion of its marks in the UK, as shown in the table below. Its marketing methods have included the use of social media, flyers, brochures, campaigns and exhibitions including "Pure London" which the opponent describes as "the UK's leading trade fashion buying event". The opponent also publishes newsletters which are emailed to its UK customers on a daily basis.

Year	Annual Advertising Spend in the UK (£)
2022	431,651.63
2021	607,005.56
2020	357,791.08
2019	586,452.92
2018	840,464.96
2017	976,183.51
Total	**3,899,458.23**

The opponent uses social media platforms such as Facebook, Twitter, Instagram, YouTube and Tiktok.

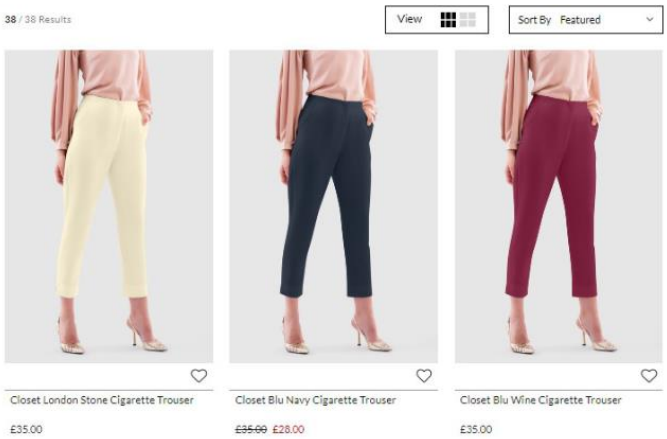
The opponent's goods are, and have been, sold via several high profile UK retailers, including Next, ASOS and John Lewis.

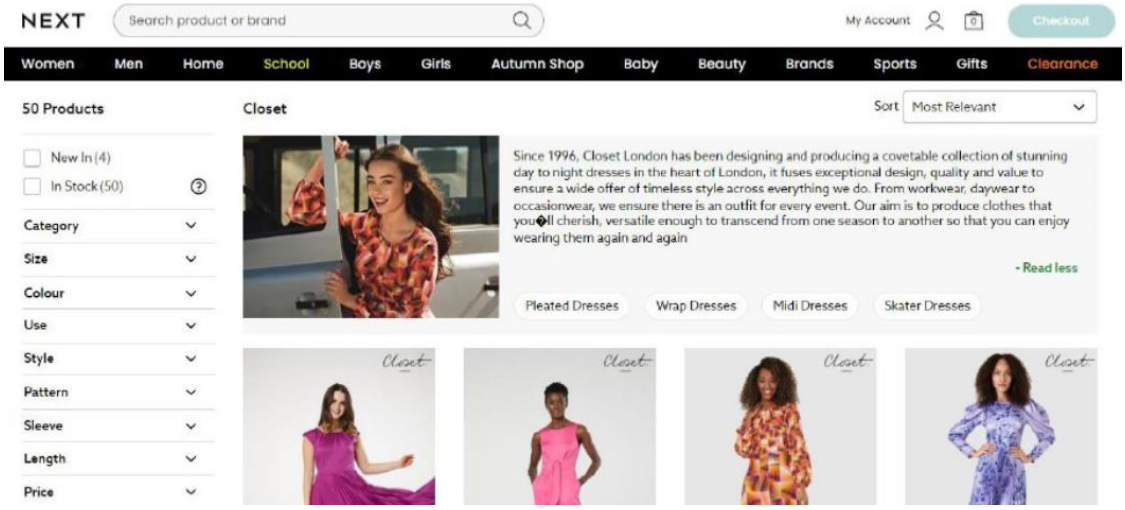
The opponent's goods regularly appear in "well-known" UK publications such as "Hello" and "OK". Its goods also feature in supplementary publications to UK newspapers The Sun, The Mirror and the Express.

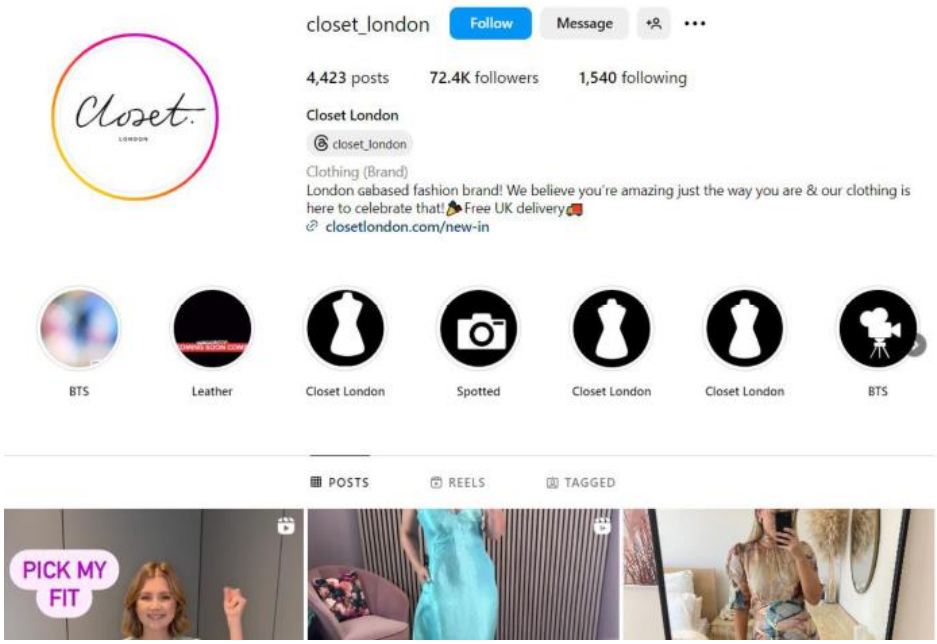
The opponent's goods have also featured on UK television on "numerous occasions" and have enjoyed independent celebrity endorsements from public figures including Holly Willoughby, Lorraine Kelly and Amanda Holden.

The opponent was awarded the Drapers "Young Fashion Brand of the Year Award". In 2015 and was a finalist in 2013, 2014, 2016 and 2017. In an article from The Guardian in February 2011, the publication was described as the "fashion industry bible".

11. I enclose a sample of the opponent's exhibits below:


38 / 38 Results
View
Sort By Featured
Closet London Stone Cigarette Trouser
£35.00
Closet Blu Navy Cigarette Trouser
£35.00 £28.00
Closet Blu Wine Cigarette Trouser
£35.00


NEXT
Search product or brand
My Account
Checkout
Women
Men
Home
School
Boys
Girls
Autumn Shop
Baby
Beauty
Brands
Sports
Gifts
Clearance
50 Products
Closet
Sort
Most Relevant
New In (4)
In Stock (50)
Category
Size
Colour
Use
Style
Pattern
Sleeve
Length
Price
Since 1996, Closet London has been designing and producing a covetable collection of stunning day to night dresses in the heart of London, it fuses exceptional design, quality and value to ensure a wide offer of timeless style across everything we do. From workwear, daywear to occasionwear, we ensure there is an outfit for every event. Our aim is to produce clothes that you'll cherish, versatile enough to transcend from one season to another so that you can enjoy wearing them again and again
- Read less
Pleated Dresses
Wrap Dresses
Midi Dresses
Skater Dresses


closet_london
Follow
Message
4,423 posts
72.4K followers
1,540 following
Closet London
closet_london
Clothing (Brand)
London gabased fashion brand! We believe you're amazing just the way you are & our clothing is here to celebrate that!Free UK delivery
closetlondon.com/new-in
BTS
Leather
Closet London
Spotted
Closet London
Closet London
BTS
POSTS
REELS
TAGGED
PICK MY FIT

17 Nov 2022

Best Quality Ever!

I'm an ardent closet fan for all my work dresses and jumpsuits. Amazing is understatement! Top quality! The fabrics are beautiful! You can never go wrong with these. Thank you guys!

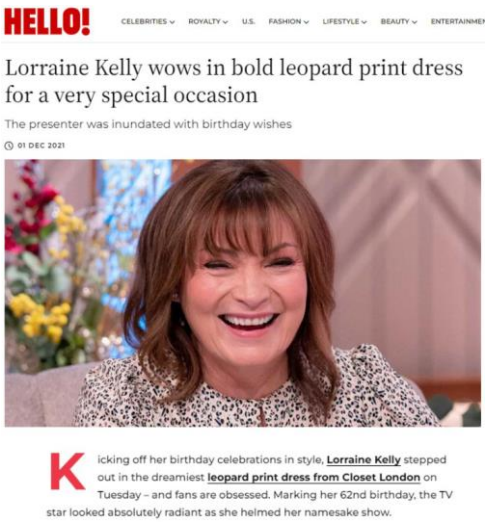
Date of experience: 17 November 2022

Verified 5 Feb 2019

Having loved closet dresses but only…

Having loved closet dresses but only bought from stores that stocked them, decided to buy direct.and so thrilled with my purchase. Perfect size and fast delivery, and of course a beautiful dress. Very happy.

Date of experience: 05 February 2019



Good Morning Britain: December 2022 Charlotte Hawkins's Purple Floral Midi Dress
GOOD MORNING BRITAIN •
12 DECEMBER 2022

Good Morning Britain: October 2022 Charlotte Hawkins's Pink Pencil Dress
GOOD MORNING BRITAIN •
14 OCTOBER 2022

Claim to Fame: Season 1 Episode 10 Brittany's Orange Puff Sleeve Dress
CLAIM TO FAME • 07 SEPTEMBER 2022
OUTFIT DETAILS →
♡ 19

Good Morning Britain: August 2022 Charlotte Hawkins's Pink and Yellow Floral Pleated Midi Dress
GOOD MORNING BRITAIN •
17 AUGUST 2022

Good Morning Britain: August 2022 Charlotte Hawkins's Blue and Pink Leopard Midi Dress
GOOD MORNING BRITAIN •
09 AUGUST 2022

Good Morning Britain: June 2022 Charlotte Hawkins's Blue Pleated Midi Dress
GOOD MORNING BRITAIN •
09 JUNE 2022

Good Morning Britain: April 2022 Laura Tobin's Purple Jumpsuit
GOOD MORNING BRITAIN •
22 APRIL 2022
OUTFIT DETAILS →
♡ 37

Good Morning Britain: April 2022 Ranvir Singh's Peach Floral Wrap Dress
GOOD MORNING BRITAIN • 11 APRIL 2022
OUTFIT DETAILS →
♡ 33

Proof of use

12. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "(6)(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[…]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

13. Section 6A is also relevant. It reads:

"(1) This section applies where

(a) an application for registration of a trade mark has been published,
(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
(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. Section 100 of the Act reads as follows:

"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."

15. Both of the opponent's trade marks clearly qualify as earlier marks under the above provisions. As the opponent's mark ending '667 completed its registration procedure more than five years prior to the filing date of the contested application, it is consequently subject to the proof of use provisions set out in section 6A of the Act. As the opponent's mark ending '489 is not subject to the same provisions, the opponent may rely upon this mark and all goods it has identified without providing evidence of use.

16. In *easyGroup Ltd v Nuclei Ltd & Ors*,[5] 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:

[5] [2023] EWCA Civ 1247

(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]."

17. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"[6] because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark" is, therefore, not genuine use.

18. The burden is on the opponent to show that the earlier mark (ending '667) has been used within the UK within the relevant time frame of 8 September 2018 – 7 September 2023. The opponent must show that the use made of its mark is genuine and that it has been made in respect of the goods relied upon (namely *clothing*).

19. I begin by acknowledging that the opponent has not disclosed the size of the relevant market, nor has it clarified its specific share. I must also acknowledge that

[6] *Jumpman* BL O/222/16

some of the exhibited evidence falls outside of the relevant period. However, there is much within the opponent's evidence that does pertain to the relevant period and it has provided a comprehensive selection of exhibits and supporting information. On review of those exhibits, it seems clear that the opponent's goods have been available for sale via its online website and the websites of other well-regarded UK retailers. Its goods have been promoted via a range of channels, including social media platforms, newsletters and exhibitions. The amount the opponent has invested into the promotion of its marks throughout the relevant period is significant; standing at over £600k in 2021 and over £430k in 2022, by way of example. The opponent's goods have featured in a number of high-profile publications and have been viewed on, and promoted by, UK public figures. Even absent of market share, I consider the turnover generated by the opponent's goods to be significant (exceeding £5million annually in 2021 and 2022, for example). Taking all of this into account, I am satisfied that the opponent has demonstrated genuine use of the earlier mark during the relevant period in respect of clothing.

20. For completeness, whilst the evidence shows use of both earlier marks, I acknowledge nonetheless that it is only the opponent's word-only mark which must satisfy the use provisions set out above. With that in mind, I am satisfied that there is sufficient evidence showing use of the opponent's word-only mark. The opponent's invoices and online listings, for example, use descriptions such as "Closet Kimono Wrap Dress" or "Closet Crop Wide Leg Jumpsuit". There are also a number of references made to "Closet London" (in articles, for example). I should make clear that I find this an acceptable variant of the opponent's '667 mark as the "LONDON" element will be perceived as descriptive of the place of origin and therefore has little bearing on the distinctive character of the mark which resides, at least predominantly, in its leading "CLOSET" element[7].

21. As for devising a fair specification, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*[8], Mr Geoffrey Hobbs Q.C., as the Appointed Person, summed up the law as being:

[7] See, for example, *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22
[8] BL O/345/10

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

22. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors,*[9] the Court of Appeal set out the proper approach to partial revocation, as follows:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.
>
> 248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

[9] [2017] EWCA Civ 1834

> 249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

23. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

24. In the present case, the opponent seeks to rely upon "clothing" at large. Whilst the *nature* of the clothing exhibited throughout the evidence does not appear to be restricted to any meaningful extent, there is nothing in the evidence to suggest that the opponent has made use of the mark in respect of menswear or childrenswear, for example. It appears instead to demonstrate a heavy interest or focus on womenswear in particular. Having careful consideration of the case law cited above, particularly *Merck*, I find it appropriate for the opponent to rely upon *women's clothing*.

Decision

25. Section 5(2)(b) of the Act states that:

> "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."

Section 5(2)(b) - Case law

26. The following principles are gleaned from the decisions of the courts of the *European Union 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

27. The goods to be compared are displayed in the table below:

Opponent's goods	Applicant's goods
Opponent's mark ending '489: *Clothing, footwear, headgear (class 25)* Opponent's mark ending '667*:* *Women's clothing (class 25)*	*Clothes; clothing; shoes (class 25)*

28. The term *clothing* is present in both the opponent's specification for its mark ending '489 and the applicant's specification. These terms are self-evidently identical. I also find the opponent's *clothing* is identical to the applicant's *clothes*.

29. In *Gérard Meric v Office for Harmonisation in the Internal Market*[10], the General Court (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".

30. On the above basis, I find the applicant's *shoes* is encompassed by the opponent's *footwear*. I also find the opponent's *women's clothing* is encompassed by the applicant's *clothing* and *clothes*. These goods are to be deemed identical.

31. For completeness, I find at least a medium degree of similarity between the opponent's *women's clothing* and the applicant's *shoes*. Whilst the goods differ in physical nature, they share a similar purpose, will be selected by the same consumers and are likely to utilise the same channels of trade. The goods may not be competitive

[10] Case T- 133/05

and are not necessarily complementary, though in my experience it is not unusual for footwear and clothing to be selected as part of a combined overall aesthetic.[11]

The average consumer and the nature of the purchasing act

32. 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. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*[12], Birss J. described the average consumer in these terms:

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

33. In *New Look Limited v OHIM*[13], the GC stated that:

> "49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (BUDMEN, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely

[11] See, for example, *Treat* [1996] R.P.C. 281, which set out various factors for assessing similarity; *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),* Case T-325/06
[12] [2014] EWHC 439 (Ch)
[13] Joined cases T-117/03 to T-119/03 and T-171/03

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 aural similarity between the signs."

And

"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 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."

34. The average consumer of the goods at issue here is likely to be a member of the general public. The goods are likely to be self-selected by the consumer from the rails of a traditional retail establishment or an online equivalent. As a consequence, and as the case law above indicates, the marks' visual impression is likely to carry the greatest weight throughout the selection process. That being said, given that retail assistants or peers may offer word-of-mouth recommendations, the relevance of the marks' aural position is not to be overlooked. The price of the goods can vary fairly widely, from budget brands to designer goods, and are, generally speaking, purchased fairly frequently. The consumer is likely to be alive to considerations such as quality and compatibility when approaching its purchase. Weighing all factors, I find the average consumer is likely to apply a medium degree of attention to its selection of the relevant goods.

Comparison of trade marks

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall

impressions created by them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated in *Bimbo SA v OHIM*[14], that:

> "34. ...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."

36. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create.

37. The trade marks to be compared are displayed in the table below:

Opponent's marks	Applicant's mark
Opponent's mark ending '489: Closet. LONDON Opponent's mark ending '667: **CLOSET**	**STYLECLOSET**

[14] Case C-591/12P

38. The opponent's mark ending '489 is figurative, with all of its comprising elements presented in black. The word 'Closet' is shown in an italic, hand-written script with a full stop positioned after the final letter. Written beneath, in a central position, is the word 'LONDON'. 'LONDON' is presented in a significantly smaller and unremarkable font. I find the mark's overall impression is likely to be dominated by the word 'Closet', with the punctuation and 'LONDON' elements, and the adopted stylisation, playing a lesser role.

39. The opponent's mark ending '667 comprises a single word; CLOSET. Its overall impression resides solely in the word itself.

40. The applicant's mark comprises a single word of eleven letters, though the average consumer may naturally be inclined to identify it as two distinct words which have been conjoined; STYLE/CLOSET.[15] Still, the mark's overall impression resides in the combination of these words, STYLECLOSET.

The opponent's '489 mark

41. Visually, the marks coincide in the sequence C-L-O-S-E-T. These are the first six digits in the opponent's mark and the final six in the applicant's mark, in which the letters are preceded by S-T-Y-L-E. The opponent's mark also incorporates the word 'LONDON' and a full stop, and its 'Closet' element is expressed in a font which is reminiscent of a hand-written script. In light of my findings concerning the marks' respective overall impressions, and having kept in mind that the beginnings of marks generally have more of an impact on the average consumer than their endings[16] and that registration of a word-only mark would generally allow for its presentation in various typefaces, I find the marks' visual similarity is between a low and medium degree.

42. From an aural perspective, whilst I accept that there may be some consumers who do not articulate the mark's LONDON element, the opponent's mark in its entirety is

[15] See, for example, *Usinor SA v OHIM,* Case T-189/05
[16] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

likely to be articulated in four syllables; CLOS-IT-LUN-DUN. The applicant's mark is likely to be articulated in three syllables, STYLE-CLOS-IT. The first two syllables in the opponent's mark are identical to the second and third syllables in the applicant's mark, though there is little similarity in the marks' remaining syllables. On that basis, and keeping in mind what I have said regarding the beginnings of marks, I find the marks aurally similar to between a low and medium degree.

43. The marks' conceptual position must be assessed from the perspective of the average consumer. Beginning with the opponent's mark, the mark's elements will be readily identified, with the consumer understanding "Closet" to mean a storage cupboard and LONDON as a geographical location, though this is likely to perceived as a nod toward the goods' origin. The mark's punctuation is unlikely to contribute any conceptual significance. As already indicated, I find it likely that the applicant's mark will naturally be perceived as a combination of dictionary words STYLE and CLOSET. 'STYLE', particularly alongside the word CLOSET, will be perceived as a word used to describe a certain aesthetic. In combination, those words are likely to create a conceptual impression of a storage cupboard used to house various stylish garments. With these findings in mind, and keeping in mind the weight attributed to the marks' respective elements, I find the marks' conceptual similarity is fairly high.

The opponent's '667 mark

44. Visually, the parties' marks share the six-letter sequence C-L-O-S-E-T. Whilst this is the only component in the opponent's mark, the sequence is preceded by S-T-Y-L-E in the applicant's mark. I find the marks' visual similarity is of a medium degree.

45. Aurally, the opponent's mark is likely to comprise two syllables; CLOS-IT. As before, the applicant's mark will likely comprise three; STYLE-CLOS-IT. The latter two syllables are clearly identical to the syllables in the opponent's mark. On balance, I find the aural similarity is of at least a medium degree.

46. "CLOSET" will likely be attributed the definition I have already set out and, as before, the applicant's mark will likely convey an impression of a cupboard storing

wearable stylish goods such as clothing. I find the marks' conceptual similarity to be fairly high.

Distinctive character of the earlier trade mark

47. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*[17], 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).

48. 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)."

49. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services for which they are registered, to those with high inherent distinctive

[17] Case C-342/97

character, such as invented words. Dictionary words which do not allude to the goods or services will typically fall somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; generally, the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

50. I begin with the inherent position of the earlier marks. When considered in respect of the relied upon goods, I find “CLOSET”, as a term, to have a fairly low degree of distinctiveness, being an item of furniture which could readily be utilised to store clothing (for example). In the opponent’s figurative mark, given the lesser degree of weight attributable to its punctuation and ‘LONDON’ elements, and that the script is not particularly elaborate, I do not consider these factors to have any material impact on the strength of the mark’s distinctive character. Generally speaking, I find both of the opponent’s marks inherently distinctive to a fairly low degree.

51. As for whether the distinctiveness of the earlier marks has been enhanced through use, I revisit my earlier considerations of the opponent’s evidence. In doing so, it seems clear that the opponent has made consistent use of various means of promotion and has invested a considerable amount in doing so. UK consumers are likely to have been exposed to the mark via social media platforms, online resources and articles and celebrity sightings, with the opponent’s customers also in receipt of regular newsletters. The opponent’s goods have been sold in a number of high-profile UK retailers and the turnover the opponent has enjoyed is indicative of a significant number of consumers. Weighing all considerations, I am satisfied that the distinctiveness of the earlier marks has been enhanced by virtue of their use to a fairly high degree.

Likelihood of confusion

52. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is

also necessary for me to keep in mind the distinctive character of the opponent's trade marks, as the more distinctive they are, the greater the likelihood of confusion.

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

54. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*[18], where he explained that:

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

[18] Case BL O/375/10

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)".

55. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*[19], Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria*[20], where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

56. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

57. In *Bristol Global Co Ltd v EUIPO*[21], the GC held that there was a likelihood of confusion between AEROSTONE (slightly stylised) and STONE if both marks were used by different undertakings in relation to identical goods (land vehicles and automobile tyres), despite the fact that the beginnings of the marks were different. The common element – STONE – was sufficient to create the necessary degree of similarity between the marks, as wholes, for the opposition before the EUIPO to succeed.

[19] [2021] EWCA Civ 1207
[20] BL O/219/16
[21] T-194/14

58. Throughout my assessment, I keep in mind that I have found the competing goods are mostly identical and that the distinctiveness of the earlier marks has been enhanced through use to a fairly high degree. The parties' marks are visually similar to either a low to medium or medium degree, aurally similar to a low to medium or at least medium degree and the marks are conceptually similar to a fairly high degree. As for the purchasing process, I have found the average consumer is likely to apply a medium degree of attention and that the marks' visual impression is likely to carry the greatest weight (though I do not discount the aural position).

59. I begin by considering a likelihood of direct confusion. As already set out, this is simply a matter of the average consumer mistaking one mark for the other. Even when I consider the matter in respect of identical goods, I find there is sufficient difference between the beginning of the parties' marks to overcome a likelihood of direct confusion. Notwithstanding the identical "Closet" element in the parties' marks, the word is preceded by five-letter word "STYLE" in the applicant's mark, such that the consumer will be able to readily distinguish between the respective marks, whether it approaches its purchase by visual or aural means.

60. I turn now to consider a likelihood of indirect confusion. What the parties' marks have in common is a reference to a "closet". The applicant's mark is likely to be viewed as a neologism of ordinary words STYLE and CLOSET and, whilst I have found the mark's impression to reside in the word as a whole ("STYLECLOSET"), I have found a fairly high degree of conceptual similarity between the parties' marks, with the STYLE element in the applicant's mark perceived as a nod toward of the *kind* of goods stored within the closet, suggesting that it houses particularly 'stylish' garments, for example. Whilst I keep in mind that "Closet", as a term, is not particularly inherently distinctive in this context, I have found that the earlier marks enjoy a fairly high degree of enhanced distinctiveness and their respective impressions are dominated either solely, or at least predominantly, by their "Closet" element. With this in mind, given that there is little deviation between the concepts evoked by the respective marks, particularly in regard to goods which are mostly identical, I find the average consumer is likely to erroneously conclude that the later mark is a sub-brand or brand extension of the earlier "Closet" marks (or vice versa). The "STYLE" prefix in the applicant's mark

may simply be viewed as indicative of a new line of “stylish” or “on-trend” goods, for example. In the interest of completeness, I find a likelihood of indirect confusion is likely to be engaged in respect of both earlier marks and in respect of goods which may be similar to only a medium degree.

Conclusion

61. The opposition under section 5(2)(b) of the Act has been successful. Subject to any successful appeal against this decision, registration of the applicant’s mark will be refused.

Costs

62. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of £1,000, which is calculated as follows:

Preparing a Notice of Opposition and considering the applicant’s counterstatement:	£300
Preparing evidence and submissions:	£600
Official fees:	£100
Total:	**£1,000**

63. I order TOPEAK LIMITED to pay Closet Clothing Co. Ltd the sum of £1,000. 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 unsuccessful.

Dated this 27th day of June 2025
Laura Stephens
For the Registrar