

O/0611/25

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**APPLICATION NO. 3915501**

**IN THE NAME OF RIVINGTONROIREBIS, LLC**

**TO REGISTER**

**123**

**AS A TRADE MARK IN CLASS 25**

**AND**

**THE OPPOSITION THERETO UNDER NO. 443327**

**BY**

**ETAM**

## **Background and pleadings**

1. On 25 May 2023, RIVINGTONROIREBIS, LLC (*“the Applicant”*) applied to register in the UK the trade mark shown on the cover page of this decision, under number UK00003915501 (*“the Contested Mark”*). Details of the application were published for opposition purposes on 30 June 2023. Registration is sought for the following goods:

Class 25      Hats; trousers; shirts; shoes; shorts; socks; hoodies; jackets; short-sleeved or long-sleeved t-shirts.

2. ETAM (*“the Opponent”*) opposes the application in full under section 5(2)(b) of the Trade Marks Act 1994 (*“the Act”*). The Opponent relies upon the following trade mark registrations (*“the Earlier Marks”*):

1) UK00003386266

First Earlier Mark:

The image shows a handwritten trade mark in black ink. The word 'Maison' is written in a cursive, flowing script, followed by the number '123' in a more upright, blocky font.

2) UK00918022398

Second Earlier Mark:

The image shows a second handwritten trade mark in black ink, identical to the first one. It consists of the word 'Maison' in a cursive script followed by the number '123' in a blocky font.

3. For the purposes of the opposition, the Opponent relies upon some of the goods for which the Earlier Marks are registered as indicated in the Annex to this decision.

4. The Second Earlier Mark is a comparable mark (EU).<sup>1</sup> By virtue of the Earlier Marks' respective earlier filing/priority dates, the registrations set out in the Annex

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<sup>1</sup> Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

constitute earlier marks within the meaning of section 6 of the Act. As the Earlier Marks had not completed their registration process more than five years before the filing date of the application in issue, they are not subject to proof of use pursuant to section 6A of the Act. The Opponent can, therefore, rely upon all of the goods it has identified without having to demonstrate use.

5. In its statement of grounds,<sup>2</sup> the Opponent contends that the competing goods are identical or highly similar and that the respective marks are visually, aurally and conceptually highly similar because they share the same distinctive component (i.e., the number '123') and the additional word 'maison' in the Opponent's marks lacks distinctive character in relation to class 25 goods since, in the context of the fashion industry, this term is commonly used to refer to a high-end or luxury fashion house. The Opponent submits that such similarity will give rise to a likelihood of confusion under section 5(2)(b) of the Act, including a likelihood of association, and asks for the application to be refused in its entirety and an award of costs be made in its favour.
6. On 8 March 2024, the Applicant filed its defence and counterstatement. The Applicant accepts that the goods under comparison are identical and/or similar and submits that the similarities between the signs are limited to the numeral '123' and that the signs can only be considered similar to a low degree. The Applicant also contends that the Earlier Marks' additional and different element 'maison' given its stylisation, position in the marks, and meaning is sufficient to exclude any likelihood of confusion also taking into consideration that the purchasing act of the goods in question is commonly visual. Thus, the Applicant requests the opposition to be dismissed, and a cost award be made in its favour.

### **Relevance of EU law**

7. 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

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<sup>2</sup> Dated 29 September 2023.

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**

8. During the evidence rounds the Opponent filed written submissions and evidence in chief, both dated 17 June 2024. The evidence consists of a witness statement from Caroline Paulet (legal manager of ETAM since June 2019) and Exhibits CP01 - CP04. The Applicant filed evidence in chief in the form of a witness statement of Szu-Yu Tao, a Chartered Trade Mark Attorney at Pinsent Masons LLP, dated 5 September 2024, accompanied by Exhibits ST01 - ST07. All the witnesses are duly authorised to provide evidence on behalf of their respective parties.
9. A hearing took place before me, by videoconference, on 2 April 2025. Prior to the hearing, the Applicant filed skeleton arguments. The Applicant was represented by Désirée Fields of Pinsent Masons LLP. The Opponent elected not to take part to the hearing but filed written submissions in lieu.<sup>3</sup>
10. The evidence and submissions (the latter both filed in paper and submitted at the hearing) will not be summarised here but will be referred to as and where appropriate during this decision. This decision is taken following a careful perusal of the papers as well as a careful consideration of the submissions presented at the hearing.
11. The Applicant is represented by Pinsent Masons LLP. The Opponent is represented by Wynne-Jones IP Limited.

### **Preliminary matters**

12. In its skeleton arguments the Applicant submitted that:

*“Taking into account the average customer’s higher degree of attention, they would be conscious of the differences between various clothing brands and the names Maison 123 on the one hand and 123 on the other. This is supported by the fact that there is no evidence to suggest the brands having encountered any direct consumer confusion in the marketplace”.*

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<sup>3</sup> Dated 31 March 2025.

13. I acknowledge the Applicant's submissions, however, I must clarify that the absence of actual confusion will not have any bearing on whether there exists a likelihood of confusion between the Applicant's mark and the Opponent's marks. Whilst evidence of actual confusion may be persuasive where it exists, the absence of confusion in the marketplace is rarely significant.<sup>4</sup> This is because the absence of confusion may be attributable to the Earlier Marks having only been used to a limited extent, in relation to only some of the goods for which they are registered, or in such a way that there has been no possibility for the competing marks to be mistaken one for the others. The provisions of the Act are not merely a reflection of what may be happening in the market. Even where there is no confusion in practice, it remains possible for there to be a finding of a likelihood of confusion.<sup>5</sup>

## **Decision**

### **The law**

14. The relevant parts of section 5 of the Act are 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.”

15. Section 5A reads:

“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.”

### **Case law**

16. The leading authorities which guide me are from the Court of Justice of the European Union (“CJEU”): *Sabel BV v Puma AG*, Case C-251/95, *Canon*

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<sup>4</sup> *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283.

<sup>5</sup> *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220.

*Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

## **The Principles**

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

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

### **Comparison of goods**

17. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, 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”.

18. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

a) The respective users of the respective goods or services;

b) The physical nature of the goods or acts of services;

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

d) 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;

e) 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.

19. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods (or services) are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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”.

20. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

21. The competing goods are as follows:

Applicant’s goods	Opponent’s goods
<b><u>Class 25</u></b>	<b><u>Class 25</u></b> (earlier mark UK3386266)
Hats; trousers; shirts; shoes; shorts; socks; hoodies; jackets; short-sleeved or long-sleeved t-shirts.	Clothing, footwear, headgear; clothing (garments) for women, men and children, dresses, skirts, petticoats, divided skirts, suits, pants, shorts, Bermuda shorts, briefs, shirts, ladies’ shirts, blouses, tee-shirts, sweatshirts, vests, coats, gabardines, raincoats, furs, stoles, sashes for wear, shawls, scarves, headbands (clothing), gloves (clothing),

	neckties, belts (clothing), socks, stockings, tights, underwear, pajamas, dressing gowns, bathing suits, bath robes; shoes, sandals, boots, ankle boots, booties, slippers; headgear, hats, berets, caps.
	(earlier mark UK918022398)
	Clothing, footwear, headgear; Clothing for ladies, men and children, dresses, skirts, petticoats, culottes, suits, trousers, shorts, Bermuda shorts, pants, shirts, blouses, bodices, T-shirts, sweatshirts, gilets, coats, gabardines, waterproof clothing, furs, stoles, scarves, shawls, headscarves, headbands (clothing), gloves (clothing), neckties, belts (clothing), socks, stockings, tights, underwear, pyjamas, dressing gowns, swimming costumes, bath robes; Shoes, Boots and sandals, Booties, Mules, slippers; Headgear, in particular hats and caps, Caps [headwear].

22. In its defence, the Applicant submitted that:

*“It is admitted that the goods under comparison in Class 25 are identical and/or similar”.*

23. Regardless of the Applicant’s concession, I find all the Applicant’s goods fall within the Opponent’s wider category “*Clothing, footwear, headgear*”. Therefore, the competing goods in class 25 are identical in line with the principle outlined in *Meric*.

**The average consumer and the nature of the purchasing act**

24. It is necessary to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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*, [2014] EWHC 439 (Ch), 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”.

25. The average consumer of the category of products concerned (i.e., clothing) is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96, *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31).

26. For the purposes 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 in question.<sup>6</sup>

27. The average consumer for the goods in class 25 (clothing) will be members of the general public (notwithstanding that clothing will also be sold wholesale and will, to that extent, include businesses). The cost of purchase for these goods is likely to vary (i.e., it can range from relatively low for fast-fashion garments to possibly fairly high for high-end garments), but generally clothes are not excessively high-cost items, and they will be purchased relatively frequently at least insofar as items of clothing wear out, cease to fit or as fashions and preferences change. In selecting and buying clothes, the average consumer will consider various factors such as the material of which the goods are made, size, fit, design, and make aesthetic considerations. Consequently, I consider that a medium degree of attention will be

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<sup>6</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, (Case C-342/97, [26]).

paid by the average consumer when selecting the goods. Businesses buying wholesale would pay a higher level of attention, however, the likelihood of confusion must be assessed from the perspective of the general public since they are the group who will pay the lower degree of attention.<sup>7</sup>

28. The purchasing process will entail the average consumer browsing the goods on shelves or rails in shops, or in images online or in a catalogue and where they will see the marks used as labelling or branding or in advertising. The purchase process is therefore a primarily visual one. Aural considerations may also play a part, such as word-of-mouth recommendations or as advice may be sought from a sales assistant or representative, so I also take into account the aural impact of the marks in the assessment. However, case law suggests that visual similarity (and difference) is most important in the case of goods that are self-selected or where the consumer sees the mark when purchasing the goods (such as clothing).<sup>8</sup>

### **Comparison of trade marks**

29. 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 the trade marks, bearing in mind their distinctive and dominant components.

30. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion”.


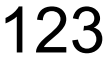
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<sup>7</sup> Case T-356/14, [25] – [26].

<sup>8</sup> See *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50.

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

32. The trade marks to be compared are as follows:

Earlier trade marks	Contested trade mark
<p data-bbox="204 674 767 712"><i>UK00003386266 and UK00918022398</i></p> 	

### Overall impression

33. The Earlier Marks are comprised of the word 'maison' followed by the number (or digit sequence) '123'. Both the marks' verbal and numeric components feature a stylised font resembling handwriting using an ink pen (e.g., fountain pen). The word 'maison' and the number (or digit sequence) '123' are not correlated to create a unitary meaning, but each retains an independent distinctive role being equally dominant in the marks and equally contributing to the overall impression.

34. The Contested Mark is composed of the number (or digit sequence) '123'. The overall impression of the Contested Mark resides in the number (or combination of three digits) that forms it.

### Visual similarity

35. The Earlier Marks consist of the lower-case word 'maison' followed by the number (or digit sequence) '123'. Both elements in the marks are stylised resembling handwriting using an ink pen with black ink. The Contested Mark is the plain

representation of the number (or digit sequence) '123'. The competing marks overlap in the number/digits '123'.

36. In its defence, the Applicant contended that the respective marks differ insofar as the Earlier Marks are longer marks containing the six-letter long word 'maison' placed at the beginning of the marks and since consumers read from left to right, such difference cannot be overlooked by the public.<sup>9</sup> The Applicant also argued that *"the signs are similar to the extent that they coincide in the numerals '123'. However, they differ in the verbal element, 'Maison', at the beginning of the sign under the Opponent's Registrations. A further noticeable difference lies in the heavy stylisation of the sign under the Opponent's Registrations which is usually distinctive and memorable"*.

37. The Opponent submitted that *"the only visual differences exist in non-distinctive elements. Therefore, the marks are visually similar to a high degree"*.<sup>10</sup>

38. I agree with the Applicant that the competing marks coincide in the element '123' and differ in the word 'maison' as well as in their overall length. I also note that the Contested Mark is quite short, and while there is no special test which applies to the comparison of 'short' marks,<sup>11</sup> and although the beginning of words tend to have more impact,<sup>12</sup> it is true that the shorter a sign, the more easily the public is able to perceive all its single elements also impacting the similarity (or lack thereof) of the marks. Accordingly, I find that the addition of the word 'maison' in the Earlier Marks creates a visual difference between it and the Applicant's mark. Additionally, albeit I do not find that the Earlier Marks have a 'heavy stylisation', the Earlier Marks' stylised font contributes to a further visual difference between the competing marks.

39. Overall, I find that the competing marks have a below-medium degree of visual similarity.

### **Aural similarity**

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<sup>9</sup> Applicant's counterstatement at paragraphs 11 a) and 11 b).

<sup>10</sup> Opponent's submissions in lieu dated 31 March 2025, [20].

<sup>11</sup> BL O/301/20, *BOSCO*, [44].

<sup>12</sup> Case T-183/02, *El Corte Ingles, SA v OHIM*.

40. The Earlier Marks are comprised of the two-syllable word pronounced “may – son” (that is not reproduced in the Contested Mark) and the number/digit sequence ‘123’. The Contested Mark consists of the number/digit sequence ‘123’. In the competing marks the consumers will voice ‘123’ either as the number “one hundred twenty-three” or as the three individual digits “one, two, three”. In both circumstances the consumers will read ‘123’ identically in all the competing marks. Therefore, I find the marks to be aurally similar to a medium degree.

### **Conceptual similarity**

41. The Opponent submitted that the word ‘maison’ is a commonly understood French word that translates to “house”, which is frequently used in the fashion industry to refer to, for example, high-end or luxury fashion houses.<sup>13</sup> To this end, Ms Paulet provided me with an extract from the Oxford English dictionary showing that ‘maison’ means “*a business (esp. a fashion house or firm)*”.<sup>14</sup> The Opponent also submitted that “*the term ‘Maison’ has a recognisable meaning for UK consumers of fashion items, such as clothing, footwear and headgear, amongst others. The term ‘Maison’ is synonymous with ‘fashion houses’, with it being used to merely indicate a brand in the fashion industry*”.<sup>15</sup>

42. In its defence, the Applicant contended that “*the verbal element of the sign under the Opponent’s Registrations, ‘Maison’ conveys no meaning in the English language and is fanciful*”. In Szu-Yu Tao’s witness statement evidence was provided to show that the word ‘maison’ is not frequent in modern written English and consumers are more likely to come across the word ‘house’ instead of ‘maison’. At the hearing Ms Fields also pointed out that the evidence the Opponent provided to show that ‘fashion house’ is commonly used in trade (**Exhibit CP02**) does, in fact, exclusively refer to the English word ‘fashion house’ rather than ‘maison’. Miss Tao, in her witness statement, also referred me to extracts from the Cambridge English dictionary and the Wiktionary database showing that ‘maison’ does not have any meaning in English.<sup>16</sup>

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<sup>13</sup> Opponent’s submissions in lieu dated 31 March 2025, [14].

<sup>14</sup> Exhibit CPO3.

<sup>15</sup> Opponent’s written submissions dated 17 June, [4].

<sup>16</sup> Exhibit ST02.

43. The Applicant provided a report from the ONS for the 2021 census showing that French was the 12<sup>th</sup> most popular language in the UK in 2021 and that only 0.2% of the population speaks French.<sup>17</sup> The Opponent contended that albeit French is not widely spoken as a language in the UK, English-speaking consumers will have a basic understanding of this language from their school studies.<sup>18</sup> I agree with the Opponent, and I find that a significant proportion of the relevant consumers, having at least a basic knowledge of French, is likely to understand ‘maison’ as the French word for “house”. However, I find it unlikely that a significant proportion of the English-speaking consumers will be familiar with the word ‘maison’ to also understand it as being used with the meaning of “fashion house” for the sector of luxury wear. Therefore, I find that a significant proportion of the relevant consumers will understand ‘maison’ as the French word for “house” and a, separate, significant proportion of the relevant consumers will perceive ‘maison’ as a foreign or invented word and attribute no meaning to it.

44. Furthermore, I note the Opponent submitted that “*all categories of average consumer will understand the meaning of the word MAISON in relation to clothing and other fashion items (but especially those consumers with an interest in fashion)*”.<sup>19</sup> To this regard, I must assess the marks’ meaning against the perception of the consumers of the goods that have been found identical. In this case I found clothing at large are everyday consumer items and the relevant public is composed of the general public. Therefore, a section of consumers with an interest in fashion is not representative of the general public in object and the fact that such high-end fashion consumers may understand ‘maison’ as indicating a “fashion house” is not determinative for the assessment of conceptual similarity and the overall likelihood of confusion.

45. Additionally, the Applicant submitted, in its defence, that the numeral ‘123’ will be perceived as indicating a line of business activities of the main brand ‘Maison’. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the

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<sup>17</sup> Exhibit ST04.

<sup>18</sup> Opponent’s submissions in lieu dated 31 March 2025, [17.c].

<sup>19</sup> Opponent’s submissions in lieu dated 31 March 2025, [16].

CJEU including *Ruiz Picasso v OHIM*.<sup>20</sup> I do not find, absent further evidence that '123' is commonly used with this meaning, that the relevant consumers are likely to immediately understand '123' as indicating a line of business or a (clothing) collection stemming from the brand 'maison' and I find the numerical element in all the competing marks to be devoid of a clear meaning apart from that of a number or digit sequence.

46. Therefore, for those consumers who perceive 'maison' as a foreign or invented word, they will focus on the number (or digit sequence) '123' and I find the competing marks will have a medium degree of conceptual similarity in that they share the same semantic reference to this number (or digit sequence). For the consumers who will understand 'maison' as the French word for "house" (meaning not reproduced in the Contested Mark), this conceptual dissimilarity is likely to further detract any conceptual similarity from the competing marks. Thus, in this second instance, I find the marks to have a low degree of conceptual similarity.

#### **Distinctive character of the Earlier Mark**

47. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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<sup>20</sup> [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

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. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the Opponent has filed no evidence of use of its marks. Accordingly, I have only the inherent position to consider.

49. The Earlier Marks comprise the word ‘maison’ and the number (or digit sequence) ‘123’ all in an inked-like handwritten stylisation. For the purposes of this opposition, in assessing the Earlier Marks’ distinctiveness, I will proceed to analyse the distinctive character of each of the elements composing the Earlier Marks, keeping in mind that although distinctiveness may, in part, be examined in relation to each of the terms or elements, considered separately, a mark’s distinctiveness refers to the combination of all of the mark’s elements, when considered as a whole.<sup>21</sup>

50. The Opponent provided written submissions and evidence contending that the term ‘maison’ has a descriptive and non-distinctive meaning because UK consumers will recognise it as the synonymous of ‘fashion house’ when used in relation to fashion items such as clothing, footwear, and headgear. First, Ms Paulet, in her witness statement, provided me with the Oxford English dictionary definition of ‘maison’ as meaning “*a business (esp. a fashion house or firm)*”. Second, Ms Paulet provided examples of fashion brands that use the term ‘maison’ for their businesses associated with an additional distinctive element (e.g., Maison 49, Maison Scotch, Maison Bent London, Boutique La Maison, La Maison, Maison Hotel, Maison Margiela, Maison M, Maison Close, Maison Labiche, and Maison de Fashion) to show that ‘maison’ by itself does not have enough distinctiveness to function as a trade mark. Regarding such arguments, first, as already found above in this decision, the relevant consumers are unlikely to understand ‘maison’ as meaning “fashion house” in French. Second, the fact that some businesses incorporate the term ‘maison’ in their commercial names, along with other

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<sup>21</sup> See Case C-329/02 P, *SAT.1 v OHIM*, [28].

elements, to market the goods at hand does not necessarily indicate that 'maison' lacks distinctive character when forming part of a trade mark in the UK.

51. Conversely, as mentioned above, the Applicant submitted that 'maison' conveys no meaning and, thus, the distinctive character of such word is normal. In Szu-Yu Tao's witness statement it is also submitted that 1) UK consumers are more likely to come across the word 'house' rather than 'maison' in modern written English, 2) that 'maison' is a French (or French-derived) word, 3) that only a small part of the public is familiar with the French language, and 4) that some of the fashion brands the Opponent identified using 'maison' in their names (i.e., Maison Margiela, Maison Close, Maison Lejaby, Maison Labiche, Maison Kitsune) originate from France. At the hearing Miss Fields also reported an instance where the Registry has admitted the word 'MAISON' for registration as a trade mark for class 25 goods (clothing)<sup>22</sup> arguing that this shows that 'maison' is distinctive to the extent that it can be accepted for registration as a trade mark. Regarding this latter point, firstly, I am not bound by previous decisions of trade mark examiners. Secondly, as correctly pointed out by the Opponent, this trade mark has been in fact cloned from the EUIPO and the Registry did not examine it for registration.<sup>23</sup>

52. Turning to the distinctive character of the numeral '123'. The Applicant argues that also the numeral '123' has normal distinctiveness but that consumers will not focus on it because they will understand it as denoting a line of business activities of the main brand 'Maison'.<sup>24</sup>

53. Following from the above considerations, in case the Earlier Marks are understood as a combination of a foreign/invented word and an arbitrary number (or digit sequence) that does not have any semantic correlation with the goods at hand, I find the Earlier Marks to have an above-medium degree of distinctive character. In case the Earlier Marks are perceived as the combination of an arbitrary French word (meaning 'house') and an arbitrary number (or digit sequence) that do not have any semantic correlation with the goods at hand, I find that the Earlier Marks have a medium degree of distinctive character.

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<sup>22</sup> UK00915486372.

<sup>23</sup> Submissions in lieu dated 2 April 2025, [17.e].

<sup>24</sup> Defence dated 17 June 2024, [11.a]

## **Likelihood of confusion**

54. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

55. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The concept of indirect confusion was explained by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10 as follows:

“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

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).”

56. I have found the respective goods to be identical. The consumer is likely to pay a medium level of attention in their selection. The distinctiveness of the Earlier Marks is either above medium or medium according to the consumers’ understanding of the word ‘maison’. The visual similarity is below medium, the aural similarity is medium, and the conceptual similarity is either medium or low according to how the consumers understand the word ‘maison’. The purchase of the contested goods is considered to be mainly visual but the potential for aural use is borne in mind.

57. The Applicant has submitted that the respective marks are similar to a low degree because they share the numerical element ‘123’. The Opponent addressed this point in its submissions in lieu stating that *“therefore the issues to be decide on this case are (i) whether the marks are similar to a high degree or low degree, and (ii) whether there exists a likelihood of confusion”*. At the hearing Miss Fields clarified that although it can be argued that the competing marks have a low degree of similarity due to their partial overlap in the ‘123’ element, such similarity does not lead to any likelihood of confusion.

58. The marks overlap in the number/digit sequence ‘123’ and differ in the word ‘maison’ placed at the beginning of the Earlier Marks and not reproduced in the Contested Mark. The Earlier Marks also have some level of stylisation that is absent in the Contested Mark. Weighing all of these factors, and especially taking into consideration the meaning and distinctiveness of the word ‘maison’ in the Earlier Marks, even bearing in mind the effects of imperfect recollection, I find that the marks are unlikely to be mistakenly recalled or misremembered as each other

by any of the relevant consumers. Thus, I do not consider there to be a likelihood of direct confusion.

59. It now falls to me to consider the likelihood of indirect confusion.

60. The three categories identified in *L.A. Sugar* are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.<sup>25</sup> I recognise that a finding of indirect confusion 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 mark: this is mere association not indirect confusion.<sup>26</sup> The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.<sup>27</sup>

61. Bearing all of the above in mind, I find unlikely that the average consumer would, upon being confronted with the parties’ marks, believe that they originate from the same or economically linked undertakings. I say this because I do not find the Applicant’s mark ‘123’ to be a logical brand extension of ‘maison 123’. The Opponent argued that the consumers will understand its marks are identifying the luxury version of the ‘123’ brand. However, as I found that a significant proportion of the English-speaking relevant consumers are unlikely to understand ‘maison’ as “fashion house”, I do not believe such association may occur. Furthermore, I point out that, according to the Opponent’s submissions, the word ‘maison’ is used, in the market of luxury wear, to refer to a business dealing in fashion, but this word does not convey the more general meaning of ‘luxury’ that the Opponent seems to suggest in this case (i.e., luxury goods coming from the ‘123’ brand). Thus, I do not see how the introduction of ‘maison’ to ‘123’ may be a logic addition to show that ‘maison 123’ is a sub-brand of the ‘123’ mark.

62. For this reason and taking into consideration the inherent distinctive character of the Earlier Marks and their overall impression, without evidence of enhancement through use, I do not believe the average consumer is likely to perceive the Contested Mark as a brand extension or sub-brand deriving from the Opponent.

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<sup>25</sup> *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

<sup>26</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

<sup>27</sup> *Liverpool Gin Distillery*.

Leaving aside the Opponent's submissions, I do not see other circumstances where the average consumer, having recognised that the marks are not the same, is nevertheless likely to believe that they come from the same or linked undertaking(s). Therefore, I find there is no likelihood of indirect confusion.

### **Conclusion**

63. The opposition fails under section 5(2)(b) of the Act.

64. The Applicant has been successful. Subject to any successful appeal, the application by RIVINGTONROIREBIS, LLC may proceed to registration.

### **Costs**

65. The Applicant is entitled to an award of costs. The relevant scale is contained in Annex A to the Tribunal Practice Notice ("TPN") 1/2023. Bearing that scale in mind, I award costs to the applicant as follows:

Considering the notice of opposition and preparing the counterstatement	£250
Preparing evidence and considering and commenting on the Opponent's evidence and submissions	£600
Preparing for and attending a hearing	£500
<b>Total:</b>	<b>£1,350</b>

66. I order ETAM to pay RIVINGTONROIREBIS, LLC the sum of **£1,350**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 4<sup>th</sup> day of July 2025**

**Andrea Rossi**

**For the Registrar**

## ANNEX

### The Opponent's Earlier Marks

#### 1) UK00003386266



**First Earlier Mark:**

#### Goods and services relied upon for the opposition:

Class 25 Clothing, footwear, headgear; clothing (garments) for women, men and children, dresses, skirts, petticoats, divided skirts, suits, pants, shorts, Bermuda shorts, briefs, shirts, ladies' shirts, blouses, tee-shirts, sweatshirts, vests, coats, gabardines, raincoats, furs, stoles, sashes for wear, shawls, scarves, headbands (clothing), gloves (clothing), neckties, belts (clothing), socks, stockings, tights, underwear, pajamas, dressing gowns, bathing suits, bath robes; shoes, sandals, boots, ankle boots, booties, slippers; headgear, hats, berets, caps.

**Filed:** 25/03/2019

**Date of entry in the register:** 12/07/2019

**Priority:** priority date of 13 February 2019 from France for trade mark number 4524882.

#### 2) UK00918022398



**Second Earlier Mark:**

#### Goods and services relied upon for the opposition:

Class 25: Clothing, footwear, headgear; Clothing for ladies, men and children, dresses, skirts, petticoats, culottes, suits, trousers, shorts, Bermuda shorts, pants, shirts, blouses, bodices, T-shirts, sweatshirts, gilets, coats, gabardines, waterproof clothing, furs, stoles, scarves, shawls,

headscarves, headbands (clothing), gloves (clothing), neckties, belts (clothing), socks, stockings, tights, underwear, pyjamas, dressing gowns, swimming costumes, bath robes; Shoes, Boots and sandals, Booties, Mules, slippers; Headgear, in particular hats and caps, Caps [headwear].

**Filed:** 14/02/2019

**Date of entry in the register:** 04/07/2019

**Priority:** priority date of 13 February 2019 from France for trade mark number 4524882.