O/0617/25

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. 3698627 & 3906063

BY CLAUDIO LUIZ DE ALMEIDA HARRIS

AND

IN THE MATTER OF THE OPPOSITIONS THERETO

UNDER NOS. 431490 & 442503 BY

JOHN LEWIS PLC

BACKGROUND AND PLEADINGS

1. These proceedings concern two trade mark applications made by Claudio Luiz De Almeida Harris ("the applicant") and the oppositions to those applications by John Lewis PLC ("the opponent"). The applications are shown in the table below:

UKTM(A) No. 3698627 	Filing date: 22 September 2021 Registration is sought for goods in Classes 3, 14, 16, 18 and 25. A full list can be found in paragraph 83 of this decision.
UKTM(A) No. 3906063 **LEWIS MAGAZINE**	Filing date: 28 April 2023 Registration is sought for the following services in Class 35: *Online retail services relating to handbags; Online retail services relating to jewelry; Online retail services relating to clothing; Online retail services relating to luggage; Online retail services relating to cosmetics; Providing online marketplaces for sellers of goods and or services; Provision of an online marketplace for buyers and sellers of goods and services; Advertising services relating to the sale of goods; Promoting the goods and services of others through the distribution of discount cards; Online ordering services.*

2. In this decision, I shall refer to UKTM(A) No. 3698627 as "the Lewis logo" and to UKTM(A) No. 3906063 as "the Lewis Magazine mark".

Opposition No. 431490 to the Lewis logo

3. This opposition was filed on 2 March 2022. It is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act") and concerns all the goods in respect of which registration is sought.

4. The opponent is relying on the following marks:[1]

UKTM No. 2307716 (“the 716 mark”) **JOHN LEWIS** Filing date: 9 August 2002 Registration date: 24 January 2003 <u>*Class 35*</u> *The bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a department store or from an Internet web site; advertising; business management; business administration; office functions; provision of information to customers; provision of advice and assistance in the selection of goods; advertising for others.*
UKTM No. 903263936 (“the 936 mark”) **JOHN LEWIS** Filing date: 4 July 2003 Registration date: 17 September 2004 <u>*Class 14*</u> *Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; and all other goods in this class; cases for clock- and watchmaking; cases for watches [presentation]; chains (watch -); key rings [trinkets or fobs]; semi-precious stones; straps for wristwatches; watch bands; watch cases; watch chains; watch crystals; watch glasses; watch springs; watch straps.*

[1] The opponent originally also relied on goods in Class 3, but withdrew its reliance on those just before the hearing.

Class 18

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harnesses and saddlery; includes handbags, rucksacks, purses; clothing for animals; and all other goods in this class; attaché cases; backpacks; bags (net -) for shopping; beach bags; briefcases; card cases [note cases]; chain mesh purses, not of precious metal; clothing for pets; collars for animals; covers (umbrella -); covers for animals; dog collars; handbags; pets (clothing for -); pocket wallets; purses; purses, not of precious metal; rucksacks; satchels (school -); school bags; school satchels; shopping bags; umbrella covers; vanity cases, [not fitted]; wallets (pocket -); wheeled shopping bags.

Class 25

Clothing, footwear, headgear; and all other goods in this class; babies' diapers of textile; babies' napkins of textile; shoes (non-slippings devices for -).

UKTM No. 903263985 ("the 985 mark")

JOHN LEWIS

Filing date: 4 July 2003
Registration date: 24 September 2004

Relying on the following goods:

Class 16

Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; instructional and teaching material (except apparatus); printed publications.

5. The above marks qualify as earlier marks under section 6(1)(a) of the Act by virtue of their earlier filing dates. As they all completed their registration procedures more than five years before the filing date of the Lewis logo, the opponent is required to have

used the marks for the goods and services relied on, or to have proper reasons for not having used them. The opponent has stated that it has used the earlier marks for all the goods and services relied on.

6. Under section 5(2)(b), the opponent claims that the parties' marks are highly similar. It argues that they both share the word "Lewis" and that this word plays an independent distinctive role in its earlier marks. It further claims that the goods and services of both parties are either identical or highly similar. As a result, it asserts, there exists a likelihood of confusion on the part of the public, which includes a likelihood of association.

7. Under section 5(3), the opponent claims that the earlier marks have a reputation for all the goods and services relied on under section 5(2)(b). It argues that it is inevitable that, given this reputation and the similarity of the marks, the public will believe that the applicant's goods originate from the opponent or from an economically linked undertaking. It also claims that:

a) use of the Lewis logo would take unfair advantage of the opponent's reputation and the investment it has made in advertising and promoting the earlier marks;

b) there would be detriment to the reputation of the earlier marks, as the opponent would not be able to control the manner in which the applicant uses the Lewis logo or the quality of the goods provided under it; and/or

c) there would be detriment to the distinctive character of the earlier marks as the capacity of those marks to distinguish the opponent's goods and services would be reduced.

8. The applicant filed a defence and counterstatement denying the claims made and putting the opponent to proof of use of the 936 and the 985 marks. He did not request proof of use of the 716 mark for the Class 35 services. He admitted that the opponent had a reputation *"for similar goods and services to what we offer"*, but considered that the degree of similarity between the marks was not sufficiently high for there to be a likelihood of confusion or for the applicant to take unfair advantage of the opponent's reputation. He denied that there would be any detriment caused to the opponent from use of the Lewis logo. He also denied the opponent's claims that the goods and

services were similar. The applicant explained that the name "LEWIS" was an anglicised version of his own middle name (Luiz) and that the logo had already been used *"for many years"* in association with Lewis Magazine, which was the subject of UKTM No. 3035703.

Opposition No. 442503 to the Lewis Magazine mark

9. This opposition was filed on 14 August 2023. It is based on sections 5(2)(b) and 5(3) of the Act and concerns all the services in respect of which registration is sought. The opponent is relying on the 716 mark and the following mark:

UKTM No. 903281102 ("the 102 mark")

JOHN LEWIS

Filing date: 4 July 2003
Registration date: 13 October 2003

Relying on the following goods and services for the purposes of section 5(2)(b):

Class 14
Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; and all other goods in this class; cases for clock- and watchmaking; cases for watches [presentation]; chains (watch -); key rings [trinkets or fobs]; semi-precious stones; straps for wristwatches; watch bands; watch cases; watch chains; watch crystals; watch glasses; watch springs; watch straps.

Class 18
Travelling bags; backpacks; beach bags; briefcases; handbags; pocket wallets; purses; purses, not of precious metal; rucksacks.

Class 25 *Clothing, footwear, headgear; and all other goods in this class.* *Class 35* *Bringing together for the benefit of others a variety of goods, enabling customers to conveniently view and purchase those goods from a department store or an Internet website; advertising, business management, business administration, office functions, provision of information to customers, provision of advice and assistance in the selection of goods, advertising services for others, all of the aforesaid services provided over the Internet in a department store or over a computer network.*

10. The 102 mark also qualifies as an earlier mark under section 6(1)(a) of the Act by virtue of its earlier filing date. As both earlier marks completed their registration procedures more than five years before the filing date of the Lewis Magazine mark, the opponent has made statements saying that it has used them for all the goods and services relied upon.

11. Under section 5(2)(b), the opponent repeats its claim that "LEWIS" plays an independent distinctive role in the earlier marks. It adds that the word "MAGAZINE" plays only a minor role and so the marks are similar. It claims that the services applied for are identical to services covered by the earlier marks, and so there is a likelihood of confusion, which includes a likelihood of association.

12. Under section 5(3), the opponent claims that the earlier marks have a reputation for all the goods and services covered by them. In the case of the 102 mark, this is an extremely long list covering every class that was then in the Nice Classification. The pleadings made under this ground are the same as those made in the other opposition. At the hearing, I asked the opponent's Counsel whether the opponent was still claiming that this mark had a reputation for all the goods and services in the specification. She replied that the same goods and services were being relied on for both grounds of this opposition, and so I shall proceed on the basis that the opponent has claimed a reputation for the goods and services listed in the table in paragraph 9 above.

13. The applicant filed a defence and counterstatement denying the claims made and putting the opponent to proof of use of the earlier marks for all the goods and services relied on under section 5(2)(b). He argued that the word “MAGAZINE” played more than a minor role. In this counterstatement, the applicant did not specifically admit that the earlier marks had a reputation.

14. The two proceedings were consolidated on 19 January 2024.

RELEVANCE OF EU LAW

15. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

EVIDENCE AND SUBMISSIONS

16. The opponent’s evidence comes from Rosie Hanley, the Head of Brand Marketing at John Lewis PLC. Her witness statement is dated 15 August 2023 and is accompanied by 19 exhibits. It goes to the use and reputation of the earlier marks.

17. There is also a witness statement from Duncan Balloch, Chartered Trade Mark Attorney, at Lewis Silkin LLP, the opponent’s legal representative. It is dated 15 August 2023 and is a vehicle for exhibiting examples of fashion, cosmetic and perfumery brands that use a full personal name but that also have a sub-brand containing the surname only, and the results of a search of the IPO website for trade marks including the word “LEWIS” in Classes 3, 14, 16, 18 and 25.

18. The opponent filed written submissions dated 15 August 2023.

19. The applicant filed a witness statement dated 15 October 2023. It is accompanied by 14 exhibits. There are three further witness statements from:

a) Sofia Deus, Talent and Communication Consultant for LEWIS MAGAZINE LTD since January 2019. Her witness statement is dated 10 October 2023;

b) Sidney Gonçalves, Director of Singulab, who claims to have 20 years' professional experience in design and marketing and states that *"the brand 'Lewis Magazine' has always been identified by its consumer audience simply as 'Lewis'."* His witness statement is dated 7 October 2023; and

c) Richard Luis Santana, who describes himself as an experienced fashion and branding professional, responsible for the "LEWIS" logo for the magazine. His witness statement is dated 8 October 2023.

20. The applicant also filed written submissions dated 15 October 2023 and 2 April 2024.

THE HEARING AND PROCEDURAL ISSUES

21. I have already said that there was a hearing on this matter. It took place on 19 March 2025. The opponent was represented by Charlotte Blythe of Counsel, instructed by Lewis Silkin LLP. The applicant represented himself.

22. Both parties filed skeleton arguments two days before the hearing. Together with his skeleton argument, the applicant filed two witness statements, one from Ms Deus and another from Mr Stephen Meyer, founder and director of Meyer Model Management, both dated 17 March 2025.

23. Ms Deus's witness statement concerns the branding and marketing strategies adopted by both parties, and how they would be perceived by the consumer. She highlights the different markets that she considers that each party serves and provides some brief commentary on fashion publications moving into retail services and high-fashion brands expanding into other sectors. Finally, she concludes that *"Based on my expertise in advertising regulation, media strategy, and consumer perception, I can state with confidence that there is no reasonable basis for consumer confusion between Lewis Magazine and John Lewis & Partners."* In his skeleton argument, the applicant described Ms Deus's evidence as *"expert insight"*.[2]

24. Mr Meyer states that the name "LEWIS" is *"commonly used"* in the fashion and modelling industries to refer to Lewis Magazine and makes similar statements to those

[2] Paragraph 16.

of Ms Deus on brand expansion in the fashion sector and the respective markets of Lewis Magazine and the opponent. The examples that he gives are undated and not corroborated by documentary evidence. He also gives his opinion that refusing to register the applications would deny Lewis Magazine the right to use the LEWIS name and be anti-competitive.

25. The applicant also filed an extract from a contract between Lewis Magazine and Mesh Jewellery Lda dated 19 July 2022, along with an uncertified translation from the Portuguese, and an invoice dated 13 December 2022. Mr Harris had referred to this collaboration in his witness statement of 15 October 2023 and Exhibit OG10.

26. I notified the parties that I would consider whether to admit this evidence at the start of the hearing.

27. Section 4.8.5 of the Tribunal Manual sets out the practice relating to requests to file additional evidence. It states that:

> "A party may ask to file additional evidence. The Tribunal will consider the reasons for the request, the nature of the evidence and the views of the other party. In considering a request to file additional evidence the Tribunal will primarily consider the following (*Property Renaissance Ltd v Stanley Dock Hotel & Ors* (2016) EWHC 3103 (Ch)):
>
> - the materiality of the evidence in question to the issues that the Registrar has to determine;
>
> - the justice and fairness of subjecting the opposite party to the burden of evidence in question at the stage that the registry proceedings have reached, including the reasons why the evidence was not filed earlier;
>
> - whether the admission of the further evidence would prejudice the opposition party in ways that cannot be compensated for in costs (for example excessive delay); and

- the fairness to the applicant of excluding the evidence in question, including prejudice to the applicant if it is unable to rely on such evidence."

28. Mr Harris described the witness statement of Ms Deus as *"a refinement of existing material"* and said he sought to file more evidence relating to the Lewis Magazine and Mesh collaboration in order to *"clarify existing arguments"*. Turning to the witness statement of Mr Meyer, it was apparent that Mr Harris had expected that Mr Meyer, who was present at the hearing, would give evidence in person.[3] I clarified that witness statements were not given orally in Registry proceedings and noted that there had been no request for cross-examination. Consequently, only Mr Harris and Ms Blythe would speak at the hearing.

29. I asked Mr Harris why the additional material in Ms Deus's witness statement had not been included in her original evidence. Mr Harris replied that as the proceedings had gone on *"perhaps we had better light of the whole procedure"* and that he believed the applicant would be able to address different points because Ms Deus was already a witness.[4] I clarified that the additions related to Ms Deus's lack of awareness of any instances of actual confusion.

30. Ms Blythe submitted that the application to file additional evidence was made at a very late stage in the proceedings and that there was no reason why it had not been filed earlier. Besides, in her view, it was not relevant, as it largely consisted of submission and the opinions of a witness on whether there was a likelihood of confusion should not be taken into account. The documents relating to the Mesh contracts were dated after the relevant date for the Lewis logo. While they were dated before the relevant date for the Lewis Magazine mark, they did not show that mark. I agreed with these submissions, and for these reasons, as well as the lateness of the filing, I refused to admit the Mesh documents into the proceedings, but explained to Mr Harris that he would be able to refer to Exhibit OG10.

31. I also refused to admit Ms Deus's second witness statement. I considered that I would have expected to see evidence on the existence of confusion in the original

[3] Transcript, page 4.
[4] Transcript, page 5.

witness statement, but that in any case the absence of actual confusion is rarely determinative in trade mark opposition proceedings: see *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 at [291]. Ms Deus's opinion on whether there is a likelihood of confusion may well be based on her expertise in the sector. However, as Lady Justice Arden said in *eSure Insurance Ltd v Direct Line Insurance Plc* [2008] EWCA Civ 842,

> "62. Firstly, given that the critical issue of confusion of any kind is to be assessed from the viewpoint of the average consumer, it is difficult to see what is gained from the evidence of an expert as to his own opinion where the tribunal is in a position to form its own view. That is not to say that there may not be a role for an expert where the markets in question are ones with which judges are unfamiliar: see, for example, *Taittinger SA v Allbev Ltd* [1993] FSR 641."

32. The goods and services at issue in these proceedings are ones that are targeted towards the general public, and so there is no need for an expert opinion to guide my assessment of the likelihood of confusion.

33. Finally, I refused to admit Mr Meyer's evidence for the same reasons. At this point, it is worth noting that the arguments about the different sectors of the market served by the parties are not relevant in these proceedings. This is because I must base my assessment on the terms that are actually used in the specifications. In *O2 Holdings Limited & Anor v Hutchison 3G UK Limited*, Case C-533/06, the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that, when assessing the likelihood of confusion under section 5(2), it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

34. Furthermore, in *Devinlec Développement Innovation Leclerc SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-171/06 P, the CJEU stated that:

> "59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is

inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks."

35. Mr Harris referred to two decisions during the course of his oral submissions which, he claimed, were authority for the propositions that similar names could co-exist, where *"the branding and audience expectations are distinct"*[5] or where the parties were *"serving different markets and target consumers"*.[6] The first of these cases was a decision of this tribunal in *Jack Daniel's Properties, Inc v Jack & Victor Ltd*, BL O/0453/23.[7] Decisions of another hearing officer are not binding on me, and the decision in this case was in the nature of a multifactorial assessment, where a number of different factors were weighed against each other. I shall apply the same law as the hearing officer did in her decision on that case. However, I must apply it to the particular facts before me. The second case was *British Sugar Plc v James Robertson & Sons Ltd*, [1996] RPC 281. This judgment of Jacob J is invariably referred to in Tribunal decisions on section 5(2) of the Act, as he gave guidance on the factors to be taken into account when comparing goods and services. These factors include the user of the goods and services and the trade channels through which such goods and services reach the market. I shall say more about these in due course. Nevertheless, the requirement for me to consider the terms as they appear in the specifications, as established by the case law cited in the previous two paragraphs, remains.

PRELIMINARY POINTS

36. There are two other points that I wish to address before going any further. First, Mr Harris expressed surprise that John Lewis PLC had opposed the marks, given that the earlier marks relied on were not identified in the Examination Reports. This fact does not preclude the proprietor of an earlier mark from bringing an opposition, if it considers that there is a likelihood of confusion between the marks. When a mark is shown in the Examination Report, the proprietors of those marks are notified of the application, but the application is also published so anyone may become aware of it.

[5] Transcript, page 42.
[6] Transcript, page 46.
[7] In his skeleton argument, Mr Harris cited this case as *Jack & Victor Ltd v Whyte and Mackay Ltd* [2022], but during the hearing he referred to *Jack & Victor Ltd v Jack Daniel's.*

37. Secondly, Mr Harris characterised the opponent's actions as an attempt to stifle fair competition. The purpose of a trade mark is to enable the consumer to distinguish the goods and services of one undertaking from those of another. This function is impaired if the consumer is confused between two similar marks. For example, they may inadvertently purchase goods or services from a business other than the one they intended to buy from. Also, section 5(3) provides additional protection for trade marks with a reputation. This includes protection against a particular form of unfair competition, and I shall say more about this later in my decision. The proprietor of an earlier mark is entitled to oppose the registration of a mark it considers to be confusingly similar and/or that it believes will damage, or take unfair advantage of, the reputation or distinctive character of the earlier mark. The question I must decide is whether such claims are made out.

DECISION

Proof of Use

38. Section 6A of the Act is as follows:

> "(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 sections 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) 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.

…"

39. As the 936, 985 and 102 marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

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

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

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

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day-

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

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

40. The case law on genuine use was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247:

"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 *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 Bundersvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for*

Harmonisation in the Internal Market (Trade Marks and Designs) [EU:C:2014:2089], Case C-689/15 *W. F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

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

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in

accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [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]."

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The

General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

> '19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.
> …
>
> 22. … it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal … comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.'"

41. The relevant periods during which use must be shown are the following: 23 September 2016 to 22 September 2021 (for the contested Lewis mark) and 29 April 2018 to 28 April 2023 (for the contested Lewis Magazine mark).

42. For use to be genuine, it must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. For the 716 mark, that is the UK; for the remaining earlier marks, it is the EU up to IP completion day (31 December 2020) and the UK thereafter. With regard to assessing use within the EU, I also bear in mind that in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the CJEU held that while use of a Community trade mark in one Member State could suffice to establish genuine use in the Community, *"all facts and circumstances"* should be considered: see paragraph 55. These include the characteristics of the market concerned, the nature of the goods or services protected by the mark and the territorial extent and the scale of the use, as well as its frequency and regularity: see also *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor* [2016] EWHC 52, paragraphs 228-230, and *TVR Automotive Ltd v OHIM*, Case T-398/13.

The opponent's evidence of use

43. In 1864, John Lewis opened a draper's shop on Oxford Street in London. At the date of Ms Hanley's witness statement, the opponent owned 35 John Lewis & Partners department stores throughout the UK. It has operated a website at johnlewis.com since 2001, enabling customers to purchase goods online.[8]

44. The table below shows the number of unique visitors to the website. Ms Hanley states that the figures for 2019 are calculated from the 18th week in the year:[9]

[8] Witness statement of Ms Hanley, paragraphs 8-10.
[9] Paragraph 22.

Platform	2019	2020	2021	2022
Desktop/Mobile Site	107,647,452	157,294,966	184,338,642	171,549,217
iOS	1,776,572	2,633,877	3,106,474	3,686,308
Android	507,246	850,416	1,132,290	1,404,175
TOTAL	**109,931,270**	**160,779,259**	**188,577,406**	**176,639,700**

45. The opponent sells goods under its own name, as well as those produced by third parties. Ms Hanley provides the following table that shows revenue generated from sales of different types of goods.[10]

Product type	FY 2019	FY 2020	FY 2021	FY 2022
Jewellery	£4,141,347	£2,271,251	£2,658,901	£3,046,985
Bags	£9,643,880	£4,644,397	£6,811,209	£7,422,193
Clothing, footwear and headgear	£182,074,042	£124,342,684	£157,743,810	£176,052,795
TOTAL	**£195,859,269**	**£131,258,332**	**£167,213,920**	**£186,521,972**

46. Exhibit RH16 contains screenshots from the opponent's website showing jewellery sold under the "John Lewis" name. Some of these are undated, but a screenshot dated 4 June 2016 shows earrings, headbands, bangles, bracelets, hair vines, necklaces, hair pins, brooches, jewellery hair grips and combs. There is a further screenshot from 17 June 2016 showing a pack of three pairs of earrings.

47. The next exhibit contains two screenshots showing notebooks and journals. One of these is undated, but the second is dated 15 May 2021. The items shown are a mixture of own-branded products and goods sourced from other undertakings. The own-branded products are notebooks, scrapbooks and a recycled leather notebook cover. They account for 10 of the 36 products shown.[11]

[10] Paragraph 33.
[11] Exhibit RH18, pages 195-196.

48. Exhibit RH18 focuses on bags. Again, this contains two screenshots, one of which is undated. This shows handbags, tote bags and backpacks. The second screenshot is dated 21 April 2019. It shows backpacks, holdalls, reporter bags, messenger bags, briefcases and wheeled suitcases.[12]

49. Clothing and footwear are shown in Exhibit RH19. One screenshot is undated. Women's slippers, sandals, trainers and boots can be seen on a screenshot dated 26 September 2021, while two screenshots from 18 July 2019 and 15 July 2019 show, respectively, men's t-shirts and men's coats and jackets.

50. Ms Hanley states that the opponent has not been able to gather information relating to the total annual marketing spend for the goods and services relied on, but says that it spends several million pounds every year. Exhibit RH1 contains screenshots from adverts dated 30 August 2017, 13 September 2019 and 14 June 2020. There is also an article that appears to be from *The Standard* and is dated 6 September 2018 that discusses a new advert shown on television and the reaction that it gained on social media. The information about these adverts refers to the opponent as a retailer of clothing and homewares.

51. Exhibits RH2 to RH7 contain screenshots from, and press articles about, the opponent's Christmas adverts shown on television in the years 2015 to 2020. Ms Hanley states that:

> "Each Christmas advert is designed to encapsulate the Christmas spirit and encourage consumers to give generously to their loved ones and to those less fortunate. My Company uses its Christmas adverts as (a) a platform to donate substantial amounts of money to charity (and the proceeds of sales of its merchandise affiliated with the advert are donated to a single charity each year), (b) to advertise My Company's broad array of goods and services, including its goods in Classes 3, 14, 16, 18 and 25 and its services in Class 35 and, ultimately, (c) drive sales at one of the busiest times of the year for the retail sector."[13]

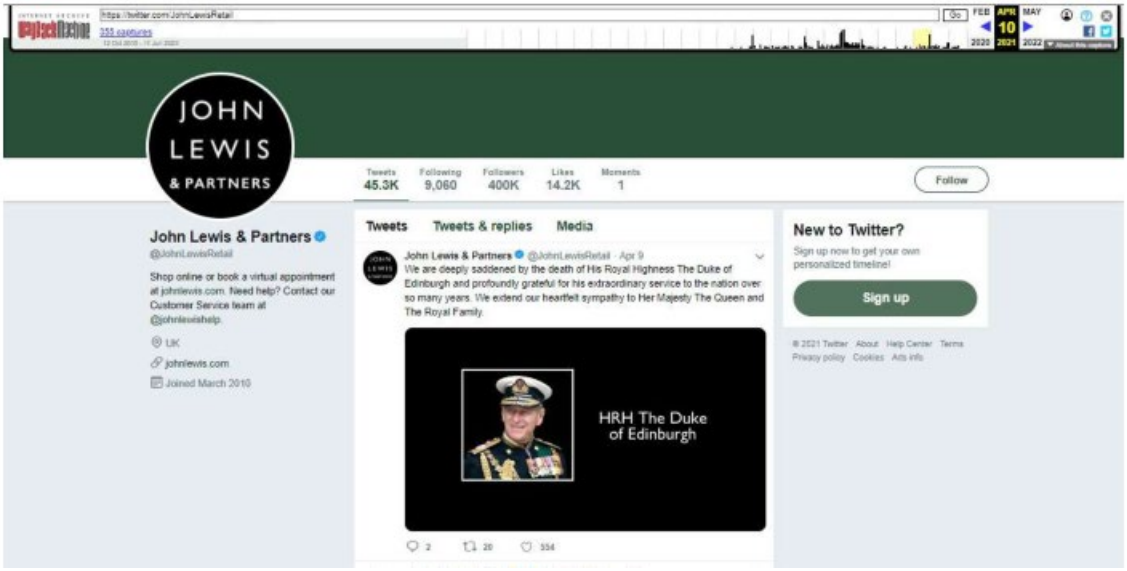
[12] Exhibit RH19, pages 203-204.
[13] Paragraph 20.

52. A *Guardian* article dated 10 November 2017 says that *"Over the past decade the department store chain has turned its festive adverts into an annual media moment"* and refers to the opponent as *"Middle England's favourite shop"*.[14]

53. Ms Hanley states that the opponent also runs what she terms Out of Home advertising campaigns and gives as an example a 2018 campaign promoting the opponent's own brand fashion, which included billboard and digital advertisements at London Underground stations, including Oxford Circus, and advertising on buses. The goods shown are women's clothing, footwear and bags. Two examples are reproduced below:[15]

[14] Exhibit RH4, page 32.
[15] Witness statement, paragraph 21; Exhibit RH8, pages 65 and 71.

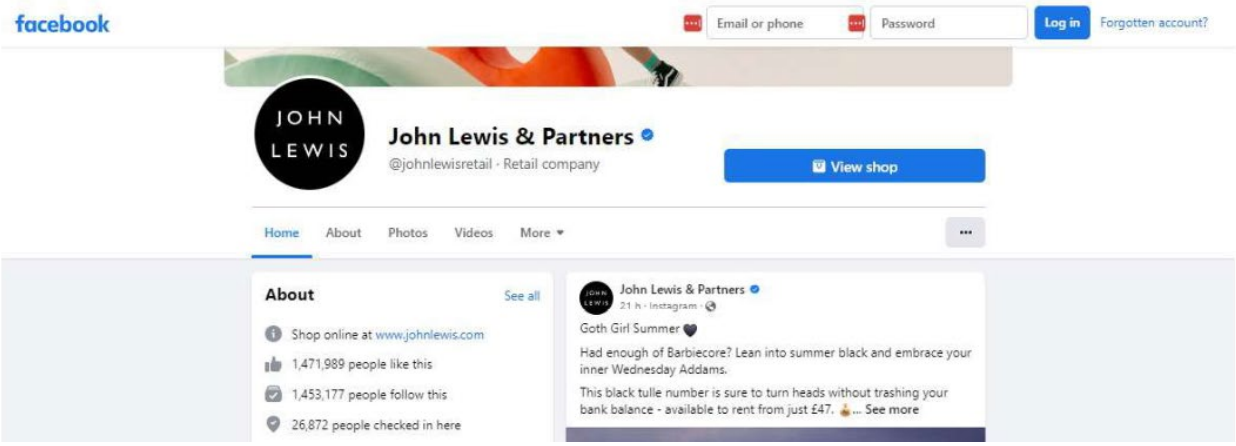
54. The opponent also uses various social media channels to promote the mark. Exhibit RH10 shows the opponent's X (formerly Twitter) account as at 10 April 2021. The number of followers was around 400,000 and the words "JOHN LEWIS & PARTNERS" are shown in the profile picture.



55. Exhibit RH11 shows the opponent's Instagram account. At the time of filing the witness statement, the account had over 1 million followers and the earlier mark is shown as the profile picture. Sample Instagram posts dated 23 October 2020, 3 December 2020, 11 May 2021 and 26 August 2021 highlight retail services, including

those relating to cosmetics and fashion. In addition, the penultimate post shows an own-brand bag.[16]

56. Exhibit RH12 shows posts from the opponent's Facebook account, which at the time of drafting the witness statement was liked by 1.47m people and followed by 1.45m people. There are two posts from within the relevant periods. The first is dated 20 September 2019 and focuses on the home collection, showing a sofa and a lamp. The second is dated 24 April 2020 and launches a children's competition to design a superhero-themed bear to be sold at Christmas, with all proceedings going to the NHS.



57. The last social media channel shown is YouTube. At the time of drafting the witness statement, the channel had 173K subscribers.[17] The exhibit contains a screenshot from a video posted on 13 November 2020 highlighting that year's Christmas charity campaign and another from a video posted on 24 September 2020 promoting the opponent's autumn home range. The first had 384,387 views and the second 106,636 views, but these figures reflect the position at 11 August 2023 and it is not possible to tell how many times the videos had been viewed at either of the relevant dates.

58. Exhibit RH14 contains a selection of press articles. These are as follows:

(i) "John Lewis unveils largest ever fashion investment drive", *Retail Gazette*, 13 July 2018. The article discusses a new collection of own-brand womenswear, handbags and accessories;

[16] Page 94.
[17] Exhibit RH13.

(ii) “John Lewis announces huge clothing sale – with up to 50 per cent off”, CheshireLive website, 29 May 2020 (updated 2 June 2020). The article mentions clothing from third-party brands and own-brand menswear;

(iii) “John Lewis and Mother of Pearl just launched the most beautiful, sustainable high street collection”, *GLAMOUR UK*, 22 April 2020. The article contains links to purchase the clothing, which is sold under both brands’ marks;

Tie-Waist Stripe Dress, £139, John Lewis X Mother of Pearl

Buy It Now

(iv) “Amazing John Lewis advert helps launch company rebrand”, source unclear but it appears to be a local Berkshire website, 5 September 2018. The article refers to the renaming of “John Lewis” as “John Lewis & Partners”;

(v) “School trousers or skirts for all: ‘Children should experience equality’”, *The Guardian*, 19 September 2017. This is an article on school uniform policy, following the opponent’s announcement that it was removing “girls” and “boys” labels from its children’s clothing;

(vi) “Uproar over John Lewis children’s range”, BBC News website, 4 September 2017. This article reports on the introduction of non-gender specific labels on the opponent’s own brand children’s clothing;

(vii) “John Lewis reveals major new fashion own-brand”, *Fashion Network*, undated, but refers to the first collection as being for Autumn/Winter 2018. The collection is said to include womenswear, handbags and accessories;

(viii) “The 13 best fashion buys from John Lewis’ stylish (and affordable) Anyday range”, *Stylist*, captured on 15 August 2023 and posted 2 years previously. It states:

> “… the brand has been purveying accessible wares since its inception in 1864, and fast forward a generation or two and it’s still going, most notably with the release of its Anyday range which debuted in April last year.
>
> Featuring a line-up of comfort-first coats that don’t compromise on style, insulating jumpers and on-trend padded bags, this is a purse-friendly line you’re not going to want to miss…”

The article features women’s clothing, footwear and a convertible tote-backpack;

(ix) “John Lewis launches affordable own brand range ANYDAY and prices start from £1.50”, *The Mirror*, 13 April 2021. The article states that the range includes *“over 2,400 stylish, thoughtfully designed quality products at competitive prices across homeware, technology, baby care and baby clothing”* and *“ANYDAY focuses on delivering great value products they know John Lewis customers love and need for daily life, while maintaining the brand’s promise of quality and trust”*. Products highlighted include a mug, fleece throw, kettle, lamp, rug and sofa;

(x) “John Lewis looks to LA for first lifestyle brand”, *British Vogue*, 15 March 2017. The article discusses the launch of the And/Or brand which includes jeans, other women’s clothing, footwear and accessories;

(xi) “John Lewis expands online fashion offering with 100 new brands”, *Retail Gazette*, 11 June 2021. The article refers to third-party brands sold by the opponent and that the opponent is planning to allow third parties to sell their goods directly on its website;

(xii) “John Lewis Christmas ad focuses on kindness theme”, BBC News website, 13 November 2020;

(xiii) “Money for old socks: John Lewis to buy back clothes to cut waste”, *The Guardian*, 18 June 2018.

Does the evidence show genuine use of the earlier marks?

59. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. He said:

> “244. As I described in *Maier v Asos*, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly 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 categories.
>
> 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 for 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."

60. The same approach is relevant when deciding what goods and services an opponent may rely on in an opposition. It was endorsed by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36:

> "261. … save that it must now be seen in light of the more recent guidance given by the CJEU in, for example: *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paras 36-53. There the CJEU explained, at para 40, that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use."

61. First, though, I shall address a point raised by the applicant. He submitted that the sign used by the opponent was actually "JOHN LEWIS & PARTNERS" and gave as an example the opponent's Facebook account, a screenshot from which can be seen in paragraph 56 above. In *Colloseum Holdings AG v Levi Strauss & Co*, Case C-12/12, the CJEU stated that use of a mark encompasses use of that mark with, or as part of, another mark, so long as it continues to be perceived as indicative of the origin of the goods or services at issue: see paragraphs 32-36. In my view, the average consumer, seeing the sign "JOHN LEWIS & PARTNERS" would understand the "& PARTNERS" element to be descriptive of the type of organisation, i.e. a partnership, and would perceive "JOHN LEWIS" to be the distinctive part of the sign. Consequently, I find that use of "JOHN LEWIS & PARTNERS" is use of the earlier marks.

62. The evidence is focused on activity in the UK. Although Ms Hanley does not say whether the sales figures and internet user figures relate to the UK or to a wider geographical area, the newspaper articles come from UK-based publications and the advertising was intended for the UK market. Furthermore, the opponent's physical shops are located in the UK. However, I remind myself of the case law referred to in paragraph 42 above. Where the EU is the relevant market, it is possible that the level

of use in the UK could be sufficient to be considered as genuine use in the EU, but I must take all relevant factors into account.

Class 14

63. Ms Hanley states that the opponent sold between £2.27 million and £4.15 million of jewellery under the mark in each of the financial years 2019 to 2022. There is no *de minimis* level of use and I consider that this is sufficient to show use in the EU up to the end of 2020 and in the UK thereafter. In paragraph 46 above, I list the items shown in the dated evidence. Ms Hanley has stated that Exhibit RH16 shows *"a representative collection"* of the goods in Class 14 sold under the JOHN LEWIS mark. This statement has not been challenged. I am therefore prepared to accept that the opponent has used the mark for earrings, headbands, bangles, bracelets, hair vines, necklaces, hair pins, brooches, jewellery hair grips and combs. I consider that these terms include a range of different subcategories of jewellery and so I find that the term *Jewellery* is one on which the opponent can rely. However, I consider that *Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes* would not be warranted on the basis of the evidence filed. This is because the term would include several categories such as watches, watch parts, trophies, key rings, figurines, and so on, that the average consumer would perceive to be distinct in terms of purpose, and that are not shown in the evidence. I also do not see any evidence of *precious stones* or *semi-precious stones*, which the average consumer would understand to mean the stones themselves, as opposed to jewellery containing such stones.

64. I consider that a fair specification for Class 14 is *Jewellery.*

Class 16

65. I have no sales information relating to the goods in Class 16. The only dated evidence is a screenshot from 15 May 2021, described in more detail in paragraph 47 above. Goods bearing the JOHN LEWIS mark represented a minority of the goods on offer. It should have been possible to provide sales figures, as the opponent has done for jewellery, bags and clothing, footwear and headgear. Reminding myself of the comments of the Appointed Person in *Awareness Ltd v Plymouth City Council*, cited

by Arnold LJ in *easyGroup*, I consider that the evidence is insufficiently solid and specific for me to find that the 985 mark has been used for goods in this class.

Class 18

66. Annual sales of JOHN LEWIS-branded bags in the financial years 2019 to 2022 were between £4.64 million and £9.65 million. Dated evidence shows advertising and offering for sale of backpacks, holdalls, reporter bags, messenger bags, briefcases, laptop bags, wheeled suitcases, handbags and shoulder bags. Some of these bags are described as being made of leather. As with the jewellery, I consider that the use shown is sufficient to be counted as genuine use in the EU for the period up to 2020 and in the UK thereafter.

67. The specification of the 936 mark includes *Backpacks; briefcases* and *handbags*. *Rucksacks* is an alternative term for *Backpacks* and so I would also include it in a fair specification. I consider that the term *Travelling bags* would include suitcases and holdalls, which the average consumer would assume were the main types of travelling bag (along with backpacks). Therefore, I consider that *Travelling bags* should be included in a fair specification. *Trunks* are a particular type of hard-sided long case and they are not shown in the evidence. I understand that *attaché cases* are a specific kind of hard-sided briefcase; again, these are not shown in the evidence. The remaining specific goods are not shown in the dated evidence. The final term I need to consider is *Leather and imitations of leather, and goods made of these materials and not included in other classes*. The opponent's evidence shows use of the mark in connection with a number of different leather bags, namely briefcases, backpacks, holdalls. The handbags shown in the advertisements in Exhibit RH8 appear to be made from leather or imitation leather. I come to this conclusion on account of the texture and firm appearance of the bags and reproduce an example below:[18]

[18] Page 71.

A broad range of different types of bags is covered and so I consider that it would be fair to allow the opponent to rely on *Bags made of leather and imitations of leather*.

68. I consider that a fair specification for Class 18 in Opposition No. 431490 is *Bags made of leather and imitations of leather; travelling bags; handbags, rucksacks; backpacks; briefcases.*

69. In Opposition No. 442503, a different mark is relied upon, with a smaller list of goods in this class. I consider that fair specification in this opposition would be *Travelling bags; backpacks; briefcases; handbags; rucksacks.*

Class 25

70. Annual sales of JOHN LEWIS-branded clothing, footwear and headgear in the financial years 2019 to 2022 were between £124.34 million and £182.08 million. Dated screenshots in Exhibit RH19 show women's slippers, sandals, trainers and boots and men's t-shirts, coats and jackets. Out of Home advertising campaigns show women's clothing and footwear, including coats, jumpers, skirts, trousers and boots.[19] Newspaper articles also refer to, or show, the following items of womenswear: shirts, jeans, dresses, blazers, trousers, shoes, jackets, t-shirts, tanks, skirts, slippers, tops, jumpers. Another article shows men's t-shirts. In addition, there are articles discussing

[19] Exhibit RH8.

JOHN LEWIS-branded children's clothing. I accept that the use shown is sufficient to be counted as genuine use in the EU for the period up to 2020 and in the UK thereafter for these goods.

71. A range of different clothing items is shown for both men and women. I also recall the articles about the range of children's clothing. Consequently, I find that it is fair to include *Clothing* in the specification on which the opponent may rely. The evidence on footwear is limited to footwear for women. I can see no examples of headwear, babies' diapers or napkins, or non-slipping devices for shoes in the evidence.

72. I consider that a fair specification for Class 25 is *Clothing; women's footwear.* This applies to both the 936 mark relied upon in Opposition No. 431490 and the 102 mark relied upon in Opposition No. 442503.

Class 35

73. I am satisfied that the evidence shows that the 716 mark has been used for *The bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a department store*. It is clear from the evidence that the opponent stocks a variety of goods in its shops. As well as the goods I have already discussed above, newspaper articles refer to furniture and homeware. The average consumer would, in my view, understand department stores to be large retail outlets selling clothing, fashion accessories, cosmetics and toiletries, home furnishings and other homewares, such as electrical goods and tableware. I consider that they would see the opponent's shops as department stores.

74. However, the remainder of that term is very broad. It is *The bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods … from an Internet web site*. The goods sold through such a website could consist of anything, from the types of goods I have already discussed, through to food, vehicles, construction materials, and so on. The opponent has not shown such widespread use and it would, in my view, be unfair to allow it to rely on such a broad specification for the opposition to the Lewis Magazine mark. I consider that a fair specification would be *The bringing together for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods … from the Internet web site of a department store*.

75. I consider that *Provision of information to customers* and *provision of advice and assistance in the selection of goods* are services that the average consumer would expect to be supplied in department stores. The remaining terms in this Class are *advertising; business management; business administration; office functions; advertising for others*. The evidence does not show that the opponent has traded in any of these services.

76. I note that the applicant did not request proof of use of the 716 mark for the purposes of Opposition No. 431490. The opponent may therefore rely on all the Class 35 services for which the mark is registered.

77. For the purposes of Opposition No. 442503, a fair specification of Class 35 is *The bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a department store or from the Internet web site of a department store; provision of information to customers, provision of advice and assistance in the selection of goods, all of the aforesaid services provided in a department store or the Internet website of a department store.*

78. In Opposition No. 442503, the opponent also relies on the Class 35 services of the 102 mark. These are as follows:

> *Bringing together for the benefit of others a variety of goods, enabling customers to conveniently view and purchase those goods from a department store or an Internet website; advertising, business management, business administration, office functions, provision of information to customers, provision of advice and assistance in the selection of goods, advertising services for others, all of the aforesaid services provided over the Internet in a department store or over a computer network.*

79. The words I have underlined are not entirely clear. In particular, it is possible that there should be a comma after the word “Internet”, as that would be more in keeping with the usual means of delivering the services. However, for reasons that shall become clear, nothing turns on this. A fair specification is *Bringing together for the benefit of others a variety of goods, enabling customers to conveniently view and purchase those goods from a department store or the Internet website of a department store; provision of information to customers, provision of advice and assistance in the*

selection of goods, all of the aforesaid services provided over the Internet in a department store or over a computer network.

Opposition to the Lewis logo

Section 5(2)(b)

80. Section 5(2)(b) of the Act is as follows:

> "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."

81. In considering the oppositions under this section, I am guided by the following principles, gleaned from the decisions of the CJEU in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

> 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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their

mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

g) a lesser degree of similarity between the goods or services may be offset by a 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; and

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 and services

82. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. As the General Court ("GC") said in *Boston Scientific Ltd v OHIM*, Case T-325/06, goods and services are complementary when

> "82. … there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

83. The goods and services to be compared are shown in the table below. It is important to be clear that, although the opponent withdrew its reliance on the Class 3 goods covered by one of its earlier marks, it did not withdraw its opposition to the Class 3 goods in the applicant's specification.

Contested goods	**Earlier goods and services**
Class 3 *Aftershave; Aftershaves; Perfumes; Perfume; Perfume oils; Perfumed soap; Amber [perfume]; Perfumed water; Perfumed creams; Perfume water; Perfumed soaps; Solid perfumes; Liquid perfumes; Perfumed powders; Extracts of perfumes; Aromatics for perfumes; Flower perfumes (Bases for -); Perfumed lotions [toilet preparations]; Sachets for perfuming linen; Linen (Sachets for perfuming -); Extracts of flowers*	

Contested goods	Earlier goods and services
[perfumes]; Bases for flower perfumes; Natural oils for perfumes; Perfumes in solid form; Room perfumes in spray form; Perfumed body lotions [toilet preparations]; Extracts of flowers being perfumes; Oils for perfumes and scents; Perfumed oils for skin care; Essential oils as perfume for laundry purposes; Perfume oils for the manufacture of cosmetic preparations.	
Class 14 *Jewellery; Jewellery, including imitation jewellery and plastic jewellery; Ornaments [jewellery]; Enamelled jewellery; Wristlets [jewellery]; Bracelets [jewellery]; Pearls [jewellery]; Imitation jewellery; Fashion jewellery; Costume jewellery; Necklaces [jewellery]; Precious jewellery; Artificial jewellery; Charms [jewellery]; Body jewellery; Lockets [jewellery]; Jewellery findings; Rings [jewellery]; Amulets [jewellery]; Jewellery brooches; Jewellery cases; Jewellery articles; Personal jewellery; Cloisonne jewellery; Gold jewellery; Hat jewellery; Ivory jewellery; Fake jewellery; Trinkets [jewellery]; Jewellery charms; Pins [jewellery]; Jewellery boxes; Jewellery products;*	*Class 14* *Jewellery.*

Contested goods	Earlier goods and services
Jewellery chain; Agate as jewellery; Amulets being jewellery; Articles of jewellery; Decorative brooches [jewellery]; Jewellery incorporating diamonds; Jewellery cases [fitted]; Wooden jewellery boxes; Rings being jewellery; Charms for jewellery; Items of jewellery; Plastic costume jewellery; Crucifixes as jewellery; Jewellery boxes [fitted]; Articles of imitation jewellery; Amberoid pendants being jewellery; Jewellery fashioned from bronze; Jewellery made from gold; Jewellery incorporating precious stones; Brooches [jewellery, jewelry (Am.)]; Gold plated brooches [jewellery]; Jewellery of yellow amber; Bracelets [jewellery, jewelry (Am.)]; Amulets [jewellery, jewelry (Am.)]; Trinkets [jewellery, jewelry (Am.)]; Charms [jewellery, jewelry (Am.)]; Jewellery for personal wear; Jewellery made from silver; Jewellery in precious metals; Necklaces [jewellery, jewelry (Am.)]; Medallions [jewellery, jewelry (Am.)]; Jewellery made of crystal; Pearls [jewellery, jewelry (Am.)]; Jewellery made of glass; Rings [jewellery, jewelry (Am.)]; Charms [jewellery, jewelry (Am.)]; Pins [jewellery, jewelry (Am.)]; Cabochons for making jewellery; Presentation	

Contested goods	Earlier goods and services
boxes for jewellery; Jewellery fashioned of precious metals; Jewellery in non-precious metals; Jewellery made of precious metals; Jewellery rope chain for anklets; Jewellery rope chain for bracelets; Jewellery fashioned of cultured pearls.	
Class 16 *Books; Song books; Book covers; Cookery books; Children's books; Story books; Book bindings; Flip books; Gift books; Wedding books; Educational books; Index books; Book wrappings; Log books; Appointment books; Recipe books; Cook books; Check books; Drawing books; Account books; Ledger books; Manuscript books; Score books; Birthday books; Autograph books; Copy books; Comic books; Sketch books; Commemorative books; Memorandum books; Fiction books; Dictation books; Book jackets; Signature books; Book markers; Sticker books; Agenda books; Coupon books; Book ends; Printed books; Painting books; Scrap books; Writing books; Guide books; Travel books; Bill books; Religious books; Data books; Information books; Fantasy books; Rule books; Poster books; Reference*	

Contested goods	Earlier goods and services
books; Resource books; Hymn books; Music books; Book marks; Ledgers [books]; Baby books; Score-books; Exercise books; Date books; Colouring books; Coloring books; Book binders; Address books; Telephone books; Guest books; Visitors books; Picture books; Hand books; Prayer books; Note books; Expense books; Composition books; Wirebound books; Wallpaper sample book; Pop-up books; Music note books; Cheque book holders; Logbooks [book-keeping]; Musical score books; Children's activity books; Exercise-book covers; Leather book covers; Baby books [storybooks]; Book binding material; Travel guide books; Cheque book covers; Coffee table books; Covers for books; Books for children; Pocket memorandum books; Stenographers' note books; Book-cover paper; Graphic art books.	
<u>Class 18</u> *Handbags; Evening bags; Leather handbags; Frames (Handbag -); Slouch handbags; Handbag straps; Gentlemen's handbags; Fashion handbags; Gent's handbags; Ladies' handbags; Ladies handbags; Pocketbooks [handbags]; Clutch handbags; Handbag frames;*	<u>Class 18</u> *Bags made of leather and imitations of leather; travelling bags; handbags, rucksacks; backpacks; briefcases.*

Contested goods	Earlier goods and services
Handbags for ladies; Purse frames [handbags]; Clutch purses [handbags]; Straps for handbags; Handbags for men; Handbags made of imitations leather; Handbags, purses and wallets; Handbags made of leather; Handbags, not of precious metal; Purses, not of precious metal [handbags]; Purses, not made of precious metal [handbags]; Handbags, not made of precious metal.	
Class 25 *Clothing, Footwear, Headgear.*	*Class 25* *Clothing; Women's footwear.*
	Class 35 *The bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase these goods from a department store or from an Internet web site; advertising; business management; business administration; office functions; provision of advice and assistance in the selection of goods; advertising for others.*

Class 3

84. Ms Blythe submitted that the contested Class 3 goods were all highly similar to the opponent's Class 35 retail services, as the services would include the retail of Class 3 goods. I agree that the retail services could include the retail of these particular goods,

even where the goods are ingredients for perfumes, such as *Bases for flower perfumes*, that would not be expected to be sold in department stores. This is because the opponent's term is broadly worded to cover retail and wholesale services provided on a website. I note that the mark was registered before the CJEU gave its judgment in *Pratiker Bau- und Heimwerkermärkte AG*, Case C-418/02, which provided guidance on how retail-type services should be represented in trade mark specifications, namely by specifying the goods or types of goods to which the services relate. I have therefore applied the general principles concerning the construction of terms, set out most recently by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36 at paragraph 365. It said that terms should be confined *"to the substance or core of their possible meanings"*. The core meaning of the term is retail or wholesale services delivered through a department store or a website.

85. In *Oakley, Inc v OHIM*, Case T-116/06, the GC held that, although retail services are different in nature, purpose and method of use from goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree: see paragraphs 46-57.

86. In *Tony Van Gulck v Wasabi Frog Ltd*, BL O/391/14, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, reviewed the law concerning the comparison of retail services and goods. He concluded that:

> a) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
>
> b) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services <u>normally</u> associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
>
> c) It is not permissible to treat a mark registered for "retail services for goods X" as though the mark were registered for goods X;

d) The GC's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered or proposed to be registered.

87. It is clear from this case law that where the opponent's retail services are to be compared to the applicant's goods, those retail services will be different in nature, purpose and method of use from the goods. Despite these differences, where there is some complementarity and shared trade channels, retail services may be similar to goods. It is equally clear that complementarity alone will not suffice for a finding of similarity, where from the consumer's point of view, the retail services of the applicant would not normally be offered by the same undertaking as the goods. Furthermore, I note that I must not treat the retail services as goods, although consideration of the retail services normally associated with the applicant's goods should be made.

88. The goods and services will be targeted towards the same users, and they will share the same trade channels. I consider that there will be a degree of complementarity with the goods as the average consumer would be accustomed to retailers selling own-branded Class 3 goods. Consequently, I find that the goods and services are similar to a medium degree.

Class 14

89. The term *Jewellery* appears identically in the applicant's specification and also in the fair specification of the opponent.

90. Terms may also be considered identical when the goods (or services) in the specification of one party are included in a broader term from the other party's specification: see *Gérard Meric v OHIM*, Case T-133/05, paragraph 29.

Jewellery including imitation jewellery and plastic jewellery; Ornaments [jewellery]; Enamelled jewellery; Wristlets [jewellery]; Bracelets [jewellery]; Pearls [jewellery]; Imitation jewellery; Fashion jewellery; Costume jewellery; Necklaces [jewellery]; Precious jewellery; Artificial jewellery; Charms [jewellery]; Body jewellery; Lockets [jewellery]; Rings [jewellery]; Amulets [jewellery]; Jewellery brooches; Jewellery articles; Personal jewellery; Cloisonne jewellery; Gold jewellery; Hat jewellery; Ivory

jewellery; Fake jewellery; Trinkets [jewellery]; Jewellery charms; Pins [jewellery]; Jewellery products; Jewellery chain; Agate as jewellery; Amulets being jewellery; Articles of jewellery; Decorative brooches [jewellery]; Jewellery incorporating diamonds; Rings being jewellery; Charms for jewellery; Items of jewellery; Plastic costume jewellery; Crucifixes as jewellery; Articles of imitation jewellery; Amberoid pendants being jewellery; Jewellery fashioned from bronze; Jewellery made from gold; Jewellery incorporating precious stones; Brooches [jewellery, jewelry (Am.)]; Gold plated brooches [jewellery]; Jewellery of yellow amber; Bracelets [jewellery, jewelry (Am.)]; Amulets [jewellery, jewelry (Am.)]; Trinkets [jewellery, jewelry (Am.)]; Jewellery for personal wear; Jewellery made from silver; Jewellery in precious metals; Necklaces [jewellery, jewelry (Am.)]; Medallions [jewellery, jewelry (Am.)]; Jewellery made of crystal; Pearls [jewellery, jewelry (Am.)]; Jewellery made of glass; Rings [jewellery, jewelry (Am.)]; Charms [jewellery, jewelry (Am.)]; Pins [jewellery, jewelry (Am.)]; Jewellery fashioned of precious metals; Jewellery in non-precious metals; Jewellery made of precious metals; Jewellery rope chain for anklets; Jewellery rope chain for bracelets; Jewellery fashioned of cultured pearls.

91. All these terms are included in the opponent's *Jewellery* and so I find them to be identical.

Jewellery findings

92. I understand that *Jewellery findings* are small items that are used in the manufacture and repair of jewellery. They would include earring backs, wires and clasps. The user of such goods would be a manufacturer, a repairer or retail jeweller. They may also be sold to the general public, who make jewellery as a hobby or who want to buy spare parts (such as earring backs) for items that they own. I find that there is some overlap in user with the opponent's *Jewellery*. There is some similarity in physical nature with at least some of the goods covered by the opponent's term, but they have different purposes. The opponent's goods are intended to adorn the body, while the applicant's goods will be used for the manufacture and repair of jewellery. There is likely to be some overlap in trade channels. The goods are not in competition. There is likely to be some complementarity, as the average consumer would expect that at least some of the goods covered by the parties' respective terms would come

from the same producer. Overall, I find that there is a medium degree of similarity between the goods.

Cabochons for making jewellery

93. *Cabochons* are stones that would be used in the making of such items as pendants or rings. In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC held that:

> "61. The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different."

94. The users of these goods will be jewellery designers and manufacturers and members of the public who make jewellery as a hobby. The purposes are different, in that the opponent's goods are worn as ornament while the applicant's are purchased in order to make a piece of jewellery. The cabochons need to be placed in a setting, likely to be of metal, in order to be worn. Therefore, the nature of the goods is different. The method of use is different. There are, however, likely to be some shared trade channels, as some jewellers are likely to sell stones as well as finished pieces, particularly where the customer is looking for a piece to be designed for them. The goods are not in competition, and I do not consider them to be complementary. In the light of the factors above, I find that the goods are similar to a low degree.

Jewellery cases; Jewellery boxes; Jewellery cases [fitted]; Wooden jewellery boxes; Jewellery boxes [fitted].

95. The applicant's goods are different in nature, method of use and purpose from the opponent's *Jewellery*, as they are intended to store single or multiple items. They do, however, have the same users and are likely to be sold through at least some of the same trade channels. The goods are not in competition.

96. I have considered whether there is any complementarity between them. The purpose of assessing whether there is a complementary relationship between goods is to assess whether the relevant public is liable to believe that responsibility for the

goods lies with the same undertaking. As Mr Daniel Alexander QC, sitting as the Appointed Person, noted in *Sandra Amalia Mary Elliot v LRC Holdings (LUV/LOVE Trade Marks)*, BL O-255-13:

> "18. … the concept of complementarity is itself not without difficulty. In a number of cases, reference to it does not make the assessment of similarity easier. If tribunals take the explanation of the concept in *Boston* as akin to a statutory definition, it can lead to unprofitable excursions into matters such as the frequency with which certain goods are used with other goods and whether it is possible for one to be used without the other. That analysis is sometimes of limited value because the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes."

97. Jewellery boxes and cases are almost always used with jewellery. However, the difference in physical nature leads me to doubt whether the average consumer would believe that the parties' respective goods are the responsibility of the same undertaking. I do not find them to be complementary. Taking all the above factors into account, I find that the parties' goods are similar to a low degree.

98. Because of the general wording of the opponent's Class 35 retail services, I will also consider whether there is any similarity between these services and the applicant's goods. In my view, all these goods are likely to be sold in a department store. The services and the goods are directed towards the same users and are accessed through the same outlets. There may be a degree of complementarity. I find that the goods and services are similar to a medium degree.

Presentation boxes for jewellery

99. I understand that a *Presentation box for jewellery* is the box in which a piece of jewellery is given to the customer after purchase. It may then be retained by the end user. Consequently, I find that the first user (and the purchaser of the applicant's goods) is a retail jeweller, while the end-user is likely to be a member of the public.

This end-user is the same as the user of the opponent's *jewellery*. It may in theory be possible for the buyer of an item of jewellery to buy a special presentation box separately, but I have no evidence to suggest that this is a common practice in the sector. I shall proceed on the basis that the users are different. The goods are different in nature, method of use and purpose. The distribution channels are likely to be different. The goods are not in competition, and I do not consider them to be complementary. I find that the goods are dissimilar. However, if I am wrong in this, and there is some overlap in user and trade channels, I find the goods to be similar to a low degree.

100. Because of the general wording of the opponent's Class 35 retail services, I will also consider whether there is any similarity between these services and the applicant's goods. *Presentation boxes for jewellery* may be some of the goods brought together on an Internet web site. The services and the goods are directed towards the same users and are accessed through the same outlets. There may be a degree of complementarity. I find that the goods and services are similar to a medium degree.

Class 16

101. Ms Blythe had submitted that the applicant's Class 16 goods were identical or similar to *Printed matter* and *Stationery* in Class 16 of the 985 mark. However, I recall that I found that the opponent was unable to rely on these goods following my assessment of the evidence of use. I therefore turn to Ms Blythe's alternative submission, that the applicant's goods are highly similar to the broad retail services covered by the earlier marks, as those would include the retail of Class 16 goods. I have already discussed the interpretation of the opponent's term *The bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a department store or from an Internet web site* in paragraph 73 above. The goods and services will be targeted towards the same users and share the same trade channels. The goods are essential for the supply of the retail services. In my view, all these items could be expected to be the responsibility of the undertaking providing the retail services. I find there to be complementarity. The goods and services will also be targeted towards the same users and share the same trade channels. I find that they are similar to a medium degree.

Class 18

102. The following term from the applicant's specification appears in the fair specification: *Handbags*.

Evening bags; Leather handbags; Slouch handbags; Gentlemen's handbags; Fashion handbags; Gents' handbags; Ladies' handbags; Ladies handbags; Pocketbooks [handbags]; Clutch handbags; Handbags for ladies; Clutch purses [handbags]; Handbags for men; Handbags made of imitations leather; Handbags made of leather; Handbags, not of precious metal; Purses, not of precious metal [handbags]; Purses, not made of precious metal [handbags]; Handbags, not made of precious metal.

103. In addition, the above terms are also included in the broad category of *Handbags* and so are identical per *Meric*.

Frames (Handbag -); Handbag frames; Purse frames [handbags]

104. The applicant's goods are components of the opponent's *Handbags*. I have already cited the judgment of the GC in *Les Éditions Albert René* in paragraph 93 above. The parties' goods are different in nature, method of use and purpose from the opponent's goods. In addition, the users are different, as the applicant's goods will be purchased by manufacturers of handbags. The trade channels are also likely to be different. They are neither in competition nor complementary, and so I find that the goods are dissimilar.

105. Because of the general wording of the opponent's Class 35 retail services, I will also consider whether there is any similarity between these services and the applicant's goods. The opponent's goods may be some of the goods brought together on an Internet web site. The services and the goods are directed towards the same users and are accessed through the same outlets. There may be a degree of complementarity. I find that the goods and services are similar to a medium degree.

Handbag straps; Straps for handbags

106. These are goods that are sold as accessories for use with handbags. They may be made of the same materials, so there is some similarity in nature, and they are likely to be sold to the same users, through the same trade channels. The goods are not in

competition, but I find that they are complementary. The opponent's goods are indispensable for the use of the straps, and, in my view, the average consumer is likely to believe that they are the responsibility of the same undertaking. Taking all these factors into account, I find that the goods are similar to at least a medium degree.

Purses and wallets

107. In paragraph 103 above, I found *Clutch purses [handbags]; Purses, not of precious metal [handbags]* and *Purses, nor made of precious metal [handbags]* to be identical per *Meric* to handbags. I made this finding because "purses" is a word used in American English for handbags and the words in square brackets indicate that this is the way in which these terms should be construed. Where that word is absent, as in the term I am considering at present, I shall give the word "purse" the usual meaning in British English. The average consumer would understand a purse or wallet to be a relatively small holder for coins and other personal effects, including paper money and credit cards. They are often made from the same materials as handbags, and so share the same physical nature, and there is a similarity in their purpose, as they are both intended to carry personal belongings. The difference in size means that there is unlikely to be competition between the goods. The users are the same and the goods are likely to be sold through the same distribution channels. In my experience, the parties' respective goods are sometimes made to match and may even be sold as sets. Overall, I find that the parties' goods are similar to a medium to high degree.

Class 25

108. The term *Clothing* appears identically in both parties' specifications.

Footwear

109. I found that a fair specification of the opponent's 936 mark included the term *Women's footwear*. The applicant's term is a broader category that would include the opponent's term. I find them to be identical per *Meric*.

Headgear

110. Headgear is sold through the same outlets as *Clothing* and worn on the body. The purpose of the parties' goods overlaps as they will both be worn in order to protect

or cover the body, and sometimes also as an adornment. In some instances, there may be a degree of similarity in the materials from which the goods are made, for example, both hats and jumpers may be knitted in wool. The goods are not in competition and they are not complementary. In my view, the goods are similar to a medium degree.

Average consumer and the purchasing process

111. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. This means that I must make *"an evaluation of what can reasonably be expected of a consumer, which may be informed by but is not determined by the responses of any given actual consumer"*: see *Industria De Diseño Textil, S.S. (Inditex S.A.) v Hilary-Anne Christie (ZOHARA Trade Mark)*, BL O-040-20, paragraph 21. I am not required to carry out a statistical analysis to identify a particular "average consumer". The test is intended to remove both the extremely careful and the extremely casual.

112. 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 and services in question: see *Lloyd Schuhfabrik*, paragraph 26. It is reasonable to expect a consumer to pay a greater deal of attention to goods or services that are infrequently purchased, complex or costly, than they would to goods or services they buy on a daily or weekly basis.

113. The goods in the applicant's Classes 3, 14, 18 and 25 vary significantly in price. However, the price of particular products is not relevant when considering who the average consumer is likely to be. This is because the goods in the applicant's specification are, for the most part, general terms, such as *Clothing* and *Perfume*. If the mark is registered for that specification, it could fairly be used for goods at all price points.

114. The average consumer of the goods and services at issue is a member of the general public, although I accept that some of the goods in Classes 3, 14, 16 and 18 will be purchased by businesses, such as manufacturers of perfumes, jewellery, books and handbags. I will deal with the member of the general public first. They are likely to

purchase these goods on a reasonably frequent basis, from bricks-and-mortar shops, catalogues or websites. They may have seen the goods advertised on television, online, in print or on billboards. They are likely to select the goods themselves from the shelves or racks (or printed or web pages), although they may also seek advice from sales staff. I consider that they will pay a medium degree of attention, and the purchasing process will largely be visual.

115. Where the average consumer is a business, the level of attention paid during the purchase of the goods would be slightly higher (although not at the highest level). This is because the quality of the materials they purchase will have an impact on the quality of the goods that they themselves sell. The goods are likely to be obtained through catalogues and other printed promotional material and websites, and some may also be purchased from physical wholesale outlets or ordered by telephone. While the visual aspect of the mark is most important, it will also be spoken and heard, so I shall take account of how the marks sound as well as how they look.

116. I consider that the level of attention paid during the selection of the Class 35 services would be at a medium level. The services may be selected after browsing the internet or seeing signage on physical premises. The average consumer may also have seen advertisements on television, in the printed media or on the internet. There may also be a role for word-of-mouth recommendations.

Comparison of marks

117. It is clear from the case law, particularly paragraph 23 of *SABEL*, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

> "34. … it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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."

118. Artificial dissection of the marks would therefore be wrong, although it is necessary for me 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 created by the marks.

119. The respective marks are shown below. As the earlier marks are identical, I shall refer to them in the singular for the rest of my decision on this opposition.

Contested mark	Earlier mark
	**JOHN LEWIS**

120. The earlier mark consists of two words, "JOHN" and "LEWIS", that will be perceived by the average consumer as a forename and a surname. Together, they will be seen as the name of an individual. Ms Blythe submitted that the surname "LEWIS" played a more important role, as the name "JOHN" is a very common one and that surnames are usually the main brand identifier in the retail and fashion world. She referred me to the evidence of Mr Balloch. Exhibit DB1 to his witness statement consists of website print-outs showing the use of full names with sub-brands containing the surname only:

- **Giorgio Armani**, with sub-brands including Armani Casa, Emporio Armani, Armani Exchange;
- **Chanel**, the surname of brand founder, Gabrielle "Coco" Chanel;
- **Christian Dior**, with sub-brand Dior;
- **Ralph Lauren**, with sub-brand Lauren;
- **Hugo Boss**, with sub-brand BOSS; and
- **Thierry Mugler**, with sub-brand MUGLER used for fragrances.

121. I shall return to this evidence later in my decision when I make my conclusions on the likelihood of confusion. For the moment, I note that these examples all come

from the world of high fashion, and do not support a contention that surnames are usually the main brand identifier in retail. Furthermore, the surname “LEWIS” is, in my view, fairly common. In my view, the overall impression of the earlier mark lies in “JOHN LEWIS” as a unit.

122. The Lewis logo consists of the word LEWIS in large capital letters. These letters contain a curved pattern of black lines on a white background. It is a pattern that covers the word in its entirety. The lines can be traced from one letter to another and create a sense of movement through the mark. The word “LEWIS” makes a large contribution to the overall impression of the mark. It may be perceived by the average consumer as a forename or a surname. I consider that the pattern does play a role within the overall impression of the mark, but it is a smaller one.

Visual comparison

123. The Lewis logo consists of five, patterned letters. The same five letters, albeit in plain form, appear as the whole of the second word of the earlier marks. I note here that the earlier mark is registered as a plain word mark. This type of mark protects the word or words contained within it, which may be used in any form, colour or typeface: see *LA Superquimica v European Union Intellectual Property Office (EUIPO)*, Case T-24/17, paragraph 39. Ms Blythe submitted that the stylisation seen in the Lewis logo was unimportant and that the marks were visually similar to *“a moderate to high degree”*.[20] I do not agree that the stylisation in the Lewis logo is unimportant. I found that it made a contribution to the overall impression of the earlier mark, even if that contribution is smaller than the one made by the word “LEWIS”. I find that the marks are visually similar to a medium degree.

Aural comparison

124. The two syllables of the Lewis logo will be pronounced in the same way as the second and third syllables of the earlier mark. The only difference is the first syllable of that earlier mark, which will be spoken in the usual way. I agree with Ms Blythe that the marks have a high degree of aural similarity.

[20] Skeleton argument, paragraph 14.

Conceptual comparison

125. I have already noted that I consider both marks would be perceived as names. Mr Harris submitted that the Lewis logo conveyed a further meaning. He described the pattern used as a *"digital print mark"* and explained its meaning in the following terms:

> "It is the mark that we are trying to make … anywhere you go, if you press your thumb the mark is going to be on it and that is the mark we want to make when it comes to gay equality. We want to be seen as we are and make a mark so people are not ashamed."[21]

126. It is possible that the pattern could be perceived to be that of a thumbprint, but, if so, it will only be a part of a thumbprint. Given that, I consider it more likely that the average consumer will see the pattern as abstract curved lines and will not be aware of the underlying meaning expressed by Mr Harris. I want to stress again that the average consumer here is a member of the general public, as the goods and services at issue are ones that are targeted towards the public as a whole, rather than a particular section of that public. In my view, they will understand the contested mark to refer to a person called Lewis. The earlier mark will be seen as denoting a specific person called John Lewis. I find that there is a medium degree of conceptual similarity between the marks for those consumers who see the contested mark as a surname. For those consumers who see it as a forename, the marks are conceptually dissimilar or, if I am wrong in this, conceptually similar to a low degree.

Distinctive character of the earlier mark

127. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*:

> "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,

[21] Transcript, page 45.

> 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)."

128. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of the mark can be enhanced by the use that has been made of it.

129. While both "John" and "Lewis" are fairly common names, the combination of the two indicates a specific individual, as I have already noted. The earlier mark is inherently distinctive to a medium degree.

130. Ms Blythe submitted that the distinctive character of the marks had been enhanced to the highest degree. I asked her to clarify whether this submission applied equally to all the goods and services covered by the mark. She replied:

> "Yes, absolutely. Of course we accept that the retail side, the class 35 services is the strongest case. That is where we would say undoubtedly we have the highest level of enhanced distinctiveness that you can have in that space but we do say, yes, we do have enhanced distinctiveness across the specific goods as well. There is good, strong evidence in our witness statement to show the scale of the sales of the own-branded goods across that space as well."[22]

131. I have already summarised the evidence of use. I can accept that it shows that the distinctive character of the 716 mark has been enhanced to a very high degree for the Class 35 retail services. Large sums have been spent on promoting the mark and the Christmas advertisements in particular have generated a huge amount of media attention. It is clear from this material that the opponent's primary business is in the

[22] Transcript, page 17.

supply of retail services. I am also prepared to accept that the distinctive character of the 936 mark has been enhanced for clothing and women's footwear, taking account of the sales figures and the examples of advertising and media coverage shown in the evidence. I do not think that the level of distinctive character is quite so high as it is for the retail services, but it is still, in my view, high. Class 18 goods in the form of handbags are also shown in the advertising, for instance on the bus advertisements shown in the photograph in paragraph 67 above. However, the sales figures do not distinguish between sales of different types of bags. Exhibit RH11 contains an Instagram post from 11 May 2021 showing a round jute shoulder bag and some of the media coverage in Exhibit RH14 refers to handbags. Consequently, I am unable to find that the evidence shows that the distinctive character of the earlier mark has been enhanced for goods in this class. I come to the same conclusion for jewellery. The sales are lower than for bags and there is little evidence showing advertisements and marketing or media coverage in relation to these goods.

Conclusions on likelihood of confusion

132. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the goods and services at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark. The courts have not said what weight should be attached to each of the factors or provided a formula that can be applied to any set of circumstances. However, I am required to take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services or vice versa.

133. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised 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)."

134. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

> "12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.
>
> 13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

135. Ms Blythe explained that the opponent was not arguing that there would be a likelihood of direct confusion. Rather, the average consumer would consider that the Lewis logo was a brand extension or another mark of the opponent:

> "For example, they may see the LEWIS mark and see that it is the surname of the John Lewis brand, it is the name Lewis, it is perhaps being used as a new sub-brand of the extremely well known JOHN LEWIS mark. So it could be, for example, a new men's fashion line, it could be a youth fashion, it could be anything within that sort of retail space. … We say the absence of that first name John in that circumstance is not sufficient to prevent confusion occurring."[23]

136. She invited me to consider the reaction of a consumer who had walked into a John Lewis store and noticed jewellery, bags or clothing sold under the Lewis logo. I find this an implausible scenario, given the opponent's position that there is a likelihood of confusion between the marks. It does not appear to me at all probable that a retail outlet would stock goods sold under a mark that the retailer believes to be so similar as to create a likelihood of confusion. In *ZOHARA Trade Mark*, Mr Daniel Alexander QC, sitting as the Appointed Person, said:

[23] Transcript, page 17.

> "24. … in order to evaluate whether confusion is likely, a tribunal may properly (and in many cases must) consider a range of situations in which the mark is likely to be encountered in use. Equally, a tribunal must consider the different ways in which the respective marks (and particularly the mark under challenge) may be perceived by consumers. In such case, there is often in part an exercise of imagination as much as anything else, since in proceedings before the Registrar evidence of actual consumer responses is often unavailable.
>
> 25. However, that cannot be taken too far: consideration of the range of responses does not require a microscopic analysis of the assumed characteristics of large numbers of possible individual consumers or possible kinds of situation in which the marks might be used. Moreover, it does [not] follow from the fact that it is possible to envisage situations in which confusion might arise in such imagined scenarios, that this suffices for a conclusion that confusion on the part of the average consumer is likely. Consideration must be given also to how realistic or likely such situations are as well as how typical of the normal manner in which the marks in question would be encountered. The more remote such scenarios are from a situation in which a mark would normally be perceived or presented, having regard to the nature of the goods and the nature of the trade in them, the greater the caution that must be exercised before taking such into account and concluding that the statutory test is satisfied."

137. A far more likely scenario is that the average consumer comes across the Lewis logo in an advertisement in a magazine or on a website. In such an instance, would the average consumer be confused so as to think that the contested mark belongs to the opponent or is economically connected to it?

138. I have already found that the earlier mark would be perceived by the average consumer as the name of an individual, with a forename and a surname. Given the opponent's claim of a likelihood of indirect confusion, I asked Ms Blythe for her comments on the point made by Arnold J (as he then was) in *Whyte and Mackay Ltd v Origin Wine UK Ltd & Anor* [2015] EWHC 1271 (Ch), where he considered the impact of the CJEU's judgment in *Bimbo* on the court's earlier judgment in *Medion*:

"18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks – visually, aurally and conceptually – as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

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

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

139. In paragraph 20, he said that, while the average consumer would in some situations recognise that a composite mark consisted of two (or more) signs, one (or more) of which had an independent distinctive character, this principle would not apply

where the average consumer would perceive the composite mark as being a unit with a different meaning to the meaning of the separate elements. As an example, he gave the examples of a surname and a surname qualified by a forename.

140. Ms Blythe explained that she was not relying on this case law and felt that the analysis was harder to apply when looking at a name. Instead, she submitted that:

> "It is clear from the evidence that within the retail space, within the fashion space in particular … while a first name and second name combination seems to be used as the main brand identifier a lot of the time, it seems to me extremely common … to have a sub-brand that is just the surname because once you are established you can branch out and a consumer does not expect to see any other brands using that name."[24]

141. I have already referred to the evidence of Mr Balloch in paragraph 120 above. I accept that it shows that some high-fashion brands that consist of a forename and surname, use the surname as a sub-brand. I have been given five examples. What is noticeable about these surnames (Armani, Dior, Lauren, Boss, Mugler) is that, with the exception perhaps of Lauren, they are unusual surnames in the United Kingdom. I can accept that the average consumer would not expect to see anyone else using "Armani", "Dior" or "Mugler".[25] However, as I have already found, "LEWIS" is a fairly common name in the UK.

142. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC (as he then was), sitting as the Appointed Person, stressed that *"a finding of indirect confusion should not be made merely because the two marks share a common element"*: see paragraph 81.4. If the later mark simply called to mind the earlier mark, that was mere association, not confusion. In my view, this is the most that may happen here in the mind of the average consumer, but I shall say more about this, and whether, if there is a calling to mind, it applies in the case of all the contested goods, when I come to deal with the section 5(3). For the present purposes, I find that the average consumer would not assume that only the opponent would be using the surname "LEWIS", even where the goods are identical. There is even less likelihood of

[24] Transcript, page 22.
[25] "Boss" is arguably different again, as it has a meaning in standard English.

confusion for those consumers who see “LEWIS” in the Lewis logo as a forename. I say this despite my finding that the earlier mark had a high level of distinctive character for some of the goods and services for which it is registered. This is because that distinctive character lies in “JOHN LEWIS” as a whole. Consequently, I find no likelihood of confusion under section 5(2)(b).

Section 5(3)

143. Section 5(3) of the Act is as follows:

> “A trade mark which–
>
> (a) is identical with or similar to an earlier trade mark,
>
> […]
>
> shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

144. The conditions of section 5(3) are cumulative. First, the marks at issue must be identical or similar. Secondly, the opponent must satisfy me that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the applications. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

145. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L’Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v*

Marks and Spencer plc & Anor (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29, and *Intel*, paragraph 63.

d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods and/or services, the extent of the overlap between the relevant consumers for those goods and/or services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or that there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68. Whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

f) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods and/or services for which the earlier mark is registered, or a serious risk that this will

happen in the future; *Intel*, paragraphs 76 and 77, and *Environmental Manufacturing*, paragraph 34.

h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oréal*, paragraph 40.

j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal.*

Reputation

146. In *General Motors Corp v Yplon SA*, Case C-375/97, the CJEU held that:

> "24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

147. The applicant admitted in his defence that the opponent has a reputation, but did not specify which particular goods and services it covered. Ms Blythe submitted that the scale of the reputation enjoyed by the opponent for retail services was *"mega"* and that it also extended to own brand goods: *"The relevant public know that John Lewis sells its own goods as well as selling those of third parties."*[26]

148. In his submissions on this ground, Mr Harris sought to draw a distinction between the target markets of the two parties, with the applicant's audience being the LGBTQ+ community, with a particular focus on gay men, and the opponent's being more female, middle-aged and traditional. I am required to consider the relevant public for the goods or services covered by the respective marks, and these goods or services are described in general terms. In my view, the relevant public is the general public.

149. On the basis of the evidence I have already summarised, I am satisfied that the 716 mark has an extremely strong reputation for *The bringing together, for the benefit*

[26] Transcript, page 26.

of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a department store or from an Internet website. I am conscious that *"from an Internet website"* is a broad term that could encompass any types of online retailer. However, I consider that the evidence shows that the reputation would relate to an internet version of the physical store. The goods sold in a department store are consumer goods aimed at members of the general public, rather than trade or professional customers. In terms of the nature of this reputation, I recall the description of the opponent in the *Guardian* article of 10 November 2017 as *"Middle England's favourite shop"*[27] and the comment in *The Mirror* on 13 April 2021 that the reputation of the opponent is one of *"quality and trust"*.[28] Other articles refer to the opponent stocking competitively-priced, good value products. Both parties agreed that the earlier mark had a family-friendly image.[29]

150. Under section 5(2)(b), I considered whether the distinctive character of the earlier marks had been enhanced through use. While distinctive character and reputation are not the same, the factors that must be taken into account are. I found that the distinctive character of the 936 mark had been enhanced to a high degree for clothing and women's footwear and had been slightly enhanced for bags. For the reasons I have given in paragraph 131 above, I find that the 936 mark has a fairly high reputation for clothing and women's footwear, but consider that the evidence falls short of what would be required to show reputation for goods in Classes 14 and 18. For the sake of completeness, I note here that I was unable to find that the opponent had shown that it had made genuine use of the mark for goods in Class 16.

Link

151. The next condition that must be met is that the public, when they see the applicant's mark, must make a link with the earlier mark. It is not necessary for the relevant public to be confused. The link may be a mere "calling to mind". The factors that I must take into account were identified by the CJEU in *Intel* at paragraph 42 of its judgment. I shall consider each of them in turn.

[27] Exhibit RH4, page 32.
[28] Exhibit RH14, page 135.
[29] See, for example, transcript pages 27 and 29.

The degree of similarity between the conflicting marks

152. I found the marks to be visually similar to a medium degree, aurally similar to a high degree and conceptually similar to a medium degree or dissimilar, depending on whether the average consumer sees “LEWIS” as a surname or as a forename.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

153. The following findings from section 5(2)(b) are relevant here:

a) The Class 3 goods in the application are similar to the Class 35 retail services to a medium degree;

b) *Jewellery cases, Jewellery boxes, Jewellery cases [fitted], Wooden jewellery boxes* and *Jewellery boxes [fitted]* are similar to the Class 35 retail services to a medium degree;

c) The Class 16 goods in the application are similar to the Class 35 retail services to a medium degree; and

d) *Clothing* and *Footwear* are identical to the opponent’s Class 25 goods and *Headgear* is similar to these goods to a medium degree.

154. The Class 14 goods discussed in paragraph 91 above are all items of jewellery that are likely to be sold in a department store. I find that they are similar to the opponent’s Class 35 retail services to a medium degree. The same applies for most of the applicant’s goods in Class 18, which are bags, straps for bags, purses and wallets. I also consider that this would be the case for *Jewellery findings* (discussed in paragraph 92 above) and the Class 25 goods covered in point (c) above.

155. I do not consider that *Cabochons for making jewellery* and *Presentation boxes for jewellery* (all in Class 14) and *Frames (Handbag -), Handbag frames* and *Purse frames [handbags]* (all three in Class 18) would be found in department stores, nor be available on such a store’s website.

156. As for the relevant public, I adopt the findings I made in paragraphs 113 to 116, namely, that the consumer, whether a member of the general public or a business, will pay a medium degree of attention in what is largely a visual purchasing process.

The strength of the earlier mark's reputation

157. The 716 mark has an extremely strong reputation for the Class 35 retail services. The 936 mark has a fairly high reputation for clothing and women's footwear.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

158. The distinctive character of the 716 mark has been enhanced to a very high degree for the Class 35 retail services, while the distinctive character of the 936 mark has a high degree of distinctive character for *Clothing* and *Women's footwear*. I remind myself that the distinctive character of these marks lies in the combination of "JOHN" and "LEWIS".

Whether there is a likelihood of confusion

159. I found there to be no likelihood of confusion under section 5(2)(b).

Conclusions on link

160. In *Intra-Presse SAS v OHIM*, Joined cases C-581/13 P and C-582/13 P, the CJEU stated that:

> "72. The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon finding a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the

earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHIM*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited)."

161. My finding of no likelihood of confusion does not, therefore, preclude a finding that there will be a link in the mind of the relevant public, who is a member of the general public.

162. I found the reputation of the 716 mark to be extremely strong. Given the strength of the reputation, I consider that there would be a link between the marks for all but the following goods:

Class 14
Cabochons for making jewellery; Presentation boxes for jewellery.

Class 18
Frames (Handbag -); Handbag frames; Purse frames [handbags].

163. The above goods in Classes 14 and 18 are primarily used in the manufacture of finished goods or, in the case of *Presentation boxes for jewellery*, sold to the trade who will use them when selling jewellery. I do not consider that they would be sold by department stores and it is my view that the earlier mark would not be brought to mind, if the average consumer were to see the contested mark being used for these particular goods. The section 5(3) claim fails for these goods.

Damage

164. My finding of a link in respect of some of the contested goods does not necessarily mean that damage will occur, as the CJEU said in *Intel*:

"71. … the existence of a link between the conflicting marks does not dispense the proprietor of the earlier trade mark from having to prove actual and present injury to its mark, for the purposes of Article 4(4)(a) of the Directive, or a serious likelihood that such an injury will occur in the future."

165. The opponent does not need to show actual instances of damage. In *Monster Energy Company v Red Bull GmbH*, [2022] EWHC 2155 (Ch), Mr Justice Adam Johnson said:

> "45. … the Court or tribunal can entirely permissibly draw inferences based on the inherent probabilities and by taking account of normal practice in the relevant sector and the circumstances of the case. The Court or tribunal cannot proceed on the basis of '*mere suppositions*', but an inference based on the inherent possibilities and the normal practice in the relevant sector will not be a mere supposition. It will be a rational and properly motivated conclusion."

Unfair advantage

166. Unfair advantage means that consumers are more likely to buy the goods of the contested mark than they would otherwise have been if they had not been reminded of the earlier marks. In *L'Oréal v Bellure*, the CJEU said:

> "50. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."

167. Earlier in the same case, the CJEU also said:

> "41. As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects

to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation."

168. It is not necessary to show that the applicant intended to take an unfair advantage. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch), Arnold J (as he then was) considered the earlier case law and concluded that:

> "80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

169. The purpose of this provision is therefore to provide a remedy against a type of unfair competition, where a party benefits from the reputation and/or the distinctive character of the earlier mark. In *Jack Wills*, the judge said that the conduct would be unfair where there was an intention to benefit in this way but that in some circumstances it could be concluded that, if the use of the later mark would result in this kind of benefit, then that use would be unfair, even if that had not been the applicant's intention. In *Argos Limited v Argos Systems Inc.* [2018] EWCA Civ 2211, the Court of Appeal held that a change in the economic behaviour of the customers for the goods and/or services offered under the later trade mark was required to establish unfair advantage.

170. The opponent claims that the applicant has chosen a mark with repute and that is distinctive for the goods and services covered by the application, and that he will therefore not need to invest the necessary time and money in developing his own mark. He would therefore take advantage of the effort that the opponent has made in advertising and promoting the earlier marks. In her skeleton argument, Ms Blythe submitted that *"It is clear from the evidence of Ms Hanley that the Opponent's efforts and investments have ensured that the John Lewis Marks project a positive and valuable image of reliability and quality. The Applicant will be able to benefit from the transfer of these qualities to his brand."*[30] The applicant would, it is argued, be able to attract more custom, without having to make the investment he would have had to have made if he had chosen another mark.

171. The applicant is the proprietor of a magazine, *LEWIS*. He has not given any evidence on the reach of the magazine or information on when it began. However, I can see that the ninth issue of the magazine was dated Spring/Summer 2020 and that there was a gap in publication, coinciding with the Covid pandemic, with the magazine returning in Autumn 2021.[31] The Lewis logo is visible on the covers and artwork. I am satisfied that the Lewis logo was already in use, albeit not for the contested goods, and it appears that the applicant wished to expand its use into other markets. He says that this is something that has been done by other fashion publications, such as *VOGUE*, which sells clothing and other goods under that mark.[32] I accept that it is probable that the mark was chosen in order to influence the economic behaviour of the readers of the applicant's magazine: to encourage them to buy the contested goods because of the association with the magazine. I do not consider that the evidence shows that there was a subjective intention to take advantage of the reputation of the earlier marks.

172. However, as I have already noted, it is not always necessary to show that the applicant intended to take unfair advantage of an earlier mark. From the objective facts of a case, it is possible in some circumstances to infer that an unfair advantage would be taken, regardless of the intention of the applicant. In *Jack Wills*, the judge found, on the facts of that particular case, that it could legitimately be inferred that there would

[30] Paragraph 43.
[31] Exhibit OG1, pages 14 and 5.
[32] Exhibit OG11.

be *"a subtle but insidious transfer of image"* which would make the goods sold under the later mark more attractive to the consumer: see paragraph 110 of that judgment.

173. I have found that there will be a link between the parties' marks. However, I do not consider that the applicant would benefit from any image transfer. In my view, the average consumer will conclude that these are two unconnected brands that happen to include the name "LEWIS", which, as I have already found, is a fairly common surname in the UK. For those consumers who see the Lewis logo as containing a forename, there is even less likelihood of any image transfer. I do not see that the applicant would gain an advantage through image transfer. Neither do I see that unfair advantage would be taken of the distinctive character of the earlier marks, notwithstanding my findings of an enhanced degree of distinctive character for the earlier marks, as this lies in "JOHN LEWIS" as a whole.

Detriment to reputation

174. I shall briefly cover the remaining claims of damage. The opponent argues that it would not be able to control the manner in which the Lewis logo is used or the quality of the goods provided under it, and so use would be detrimental to its reputation. No reason has been given to support such a claim and so this is a hypothetical argument. In *Unite The Union v The Unite Group Plc*, BL O/219/13, Ms Anna Carboni, sitting as the Appointed Person, considered that such arguments were unlikely to be successful in opposition proceedings. I dismiss this claim.

Detriment to distinctive character

175. The opponent's claim under this head of damage is brief: *"Detriment would be caused to the distinctive character of the Opponent's Trade Mark by reducing the Opponent's capacity to distinguish its goods or services from those of other undertakings"*. The CJEU stated in *Environmental Manufacturing LLP v OHIM*, Case C-383/12 P, that it was necessary to prove that there was a change in the economic behaviour of the average consumer of the goods or services of the earlier mark, or that there was a sufficiently serious likelihood that such a change would occur in the future: see paragraph 34. The opponent has not met this requirement, and so I dismiss the claim.

176. The opposition under section 5(3) is unsuccessful.

Opposition to the Lewis Magazine mark

Section 5(2)(b)

177. The legislation and general principles deriving from the case law can be found in paragraphs 80-81 of this decision.

Comparison of the goods and services

178. The goods and services to be compared are as follows:

Contested services	Earlier goods and services
	Class 14 *Jewellery*
	Class 18 *Travelling bags; backpacks; briefcases; handbags; rucksacks.*
	Class 25 *Clothing; women's footwear.*
Class 35 *Online retail services relating to handbags; Online retail services relating to jewelry; Online retail services relating to clothing; Online retail services relating to luggage; Online retail services relating to cosmetics; Providing online marketplaces for sellers of goods and or services; Provision of an online marketplace for buyers and sellers of goods and services; Advertising relating to the sale of goods; Promoting the goods and services of others through the distribution of*	*Class 35* *The bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a department store or from the Internet web site of a department store; provision of information to customers; provision of advice and assistance in the selection of goods.* *Bringing together for the benefit of others a variety of goods, enabling customers to conveniently view and purchase those goods from a*

Contested services	Earlier goods and services
discount cards; Online ordering services.	*department store or the Internet website of a department store; provision of information to customers, provision of advice and assistance in the selection of goods, all of the aforesaid services provided over the Internet in a department store or over a computer network.*

Online retail services relating to handbags; Online retail services relating to jewelry; Online retail services relating to clothing; Online retail services relating to luggage; Online retail services relating to cosmetics

179. These services are all included in the opponent's *The bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods … from the Internet web site of a department store.* They are identical per *Meric*.

Providing online marketplaces for sellers of goods and or services; Provision of an online marketplace for buyers and sellers of goods and services

180. I shall compare these services to *Bringing together for the benefit of others a variety of goods, enabling customers to conveniently view and purchase those goods from … the Internet website of a department store*. An online marketplace is a website or app that connects sellers and buyers. In essence, it acts as an intermediary. In other words, it does not keep the stock itself or fulfil orders. That is done by the sellers. There is an overlap in user, as people wishing to buy goods will use both parties' services. There is also an overlap in purpose, as both services enable potential customers to browse for, and purchase, goods. There is a degree of competition, as an individual wishing to buy a particular good may decide to use an online marketplace or the website of a department store. There may be some limited overlap in trade channels. One of the articles in Exhibit RH14 dated 11 June 2021 reports on the opponent's plans to allow third parties to sell their goods on its website, but there is no indication that these plans came to fruition. The nature of the respective services are different.

As I have noted, the applicant's services are those of an intermediary, while the opponent's services are retail services. From the perspective of the potential purchaser of goods, there is some similarity in the method of use, as both parties' services will be accessed on the internet. I do not consider that the services are complementary. Taking these factors into account, I find that the services are similar to a medium degree.

Advertising relating to the sale of goods

181. I shall compare these services to the opponent's *Provision of information to customers*. Earlier in my decision, I had found that there was genuine use of the earlier mark for these services, as they were services that the average consumer would expect to be supplied in the opponent's department stores.

182. I am mindful of the need not to interpret the terms used to describe services too broadly. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin said:

> "365. … The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 195; [2004] RPC 40 at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specification of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

183. The purpose of the opponent's services is to provide information to the customer, for example, when they are choosing between different products. The purpose of the applicant's service is to stimulate consumer desire for a particular product from a

particular undertaking. The user and purpose of the services will differ. I do not consider that it is likely that there is an overlap in trade channels; nor do I consider that there is any competition or complementarity between the services. I find that the applicant's services are dissimilar to the opponent's services. In addition, I cannot see that there is any similarity with the opponent's goods.

Promoting the goods and services of others through the distribution of discount cards

184. The purpose of these services is to encourage the bearer of the card to give their custom to the undertakings promoted through the cards. The purpose of the opponent's services, on the other hand, is to enable the customer to choose what they want to buy from a range of goods and complete that transaction. I therefore consider that the core purpose of the parties' services are different. They are not likely to be distributed through the same trade channels and their nature is, in my view, different. I do not consider there to be any competition or complementarity between them. I accept that the users are likely to be the same, but this is not sufficient for me to find the services to be similar. I do not see any reason why they are similar to any of the opponent's goods, and so I find these services to be dissimilar to the opponent's goods and services.

Online ordering services.

185. I consider that these services would be included in the opponent's broader internet retail services, such as *The bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods … from the Internet web site of a department store*. I find that they are identical per *Meric*.

Conclusions on the comparison of services

186. In *eSure Insurance Limited v Direct Line Insurance Plc*, [2008] EWCA Civ 842 CA, Lady Justice Arden stated that:

> "49. … I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has

to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

187. I therefore find that the opposition under section 5(2)(b) fails in respect of those services I found to be dissimilar, namely, *Advertising relating to the sale of goods; Promoting the goods and services of others through the distribution of discount cards.*

188. I shall continue with my assessment of this ground for the following services only:

Class 35

Online retail services relating to handbags; Online retail services relating to jewelry; Online retail services relating to clothing; Online retail services relating to luggage; Online retail services relating to cosmetics; Providing online marketplaces for sellers of goods and or services; Provision of an online marketplace for buyers and sellers of goods and services; Online ordering services.

Average consumer and the purchasing process

189. The average consumer of *Online retail services relating to handbags; Online retail services relating to jewelry: Online retail services relating to clothing; Online retail services relating to luggage; Online retail services relating to cosmetics; Online ordering services* is a member of the general public. I adopt the findings made at paragraph 116 above.

190. This leaves the following services: *Providing online marketplaces for sellers of goods and or services; Provision of an online marketplace for buyers and sellers of goods and services*. The average consumer may be a member of the general public or a business looking to sell its goods and services. Both types of consumer are likely to select the services after browsing the internet, and so the purchasing process will largely be visual. However, there may also be a role for word-of-mouth recommendations. The member of the general public that wants to purchase goods and/or services is likely to pay a medium degree of attention. They will be interested in the range of goods and services offered and may also give some attention to the

security of the site. A seller is likely to pay a slightly higher degree of attention, as they will be considering the terms and conditions of the marketplace, and trust is likely to be something they will take into account.

Comparison of the marks

191. The respective marks are shown below. As the earlier marks are identical, I shall refer to them in the singular for the rest of my decision on this opposition:

Contested mark	Earlier mark
LEWIS MAGAZINE	**JOHN LEWIS**

192. With regards to the overall impression of the earlier mark, I adopt the findings I made in paragraph 121 above. It lies in "JOHN LEWIS" as a unit.

193. Ms Blythe submitted that "LEWIS" is the dominant and distinctive element of the Lewis Magazine mark:

> "We say that because the word MAGAZINE is an everyday descriptive word and although it is not directly descriptive of the services applied for under that mark, which are class 35 retail services, we say it could be perceived as being allusive to the services underneath, so it could be descriptive of the way in which the class 35 retail services or the advertising services are being provided. It could be through a digital magazine or an online brochure, that type of connection."[33]

194. It is my view that the average consumer would understand the word "magazine" to refer to a printed publication that contains a number of different articles or illustrations. However, I accept that there are also likely to be digital versions of those publications, and I consider that a significant proportion of the relevant public would be aware of them. The contested services still at issue under this ground are all online services. I agree with Ms Blythe that the word "magazine" is allusive of the means of delivering the services. The word "LEWIS" therefore makes the greater contribution to

[33] Transcript, page 13.

the overall impression of the Lewis Magazine mark, with a lesser role played by "MAGAZINE".

Visual comparison

195. Both marks consist of two words, with the first word of the applicant's mark being identical to the second word of the opponent's mark. The number of letters in the Lewis Magazine mark is thirteen (five and eight), and the number of letters in the earlier mark is nine (four and five). Taking account of the overall impressions of the marks, I find that they are visually similar to a medium degree.

Aural comparison

196. The applicant's mark has five syllables and the opponent's has three. The start of the applicant's mark is identical to the end of the opponent's. The words would be pronounced in the usual way. Taking account of the overall impressions of the marks, I find that they are aurally similar to no more than a medium degree.

Conceptual comparison

197. I adopt my finding made in paragraph 126 above that "John Lewis" would be perceived as the name of a person. The conceptual message of the Lewis Magazine mark is of a magazine named after a person called Lewis. I have already noted that this may be perceived as a surname or as a forename. For those consumers who think "LEWIS" is a surname, there will be a low to medium degree of conceptual similarity between the marks; for those who think it is a forename, the marks are conceptually dissimilar or, if I am wrong in this, conceptually similar to a very low degree.

Distinctiveness of the earlier mark

198. I adopt the findings made at paragraph 129 and 131 above that the earlier mark has a medium degree of inherent distinctive character and that this has been enhanced to a very high degree for the Class 35 retail services.

Conclusions on likelihood of confusion

199. I have found that:

a) The services still in play are identical to the opponent's services or similar to them to a medium degree;

b) The average consumer of the retail services is a member of the public paying a medium degree of attention in a largely visual purchasing process;

c) The average consumer of the online marketplace services is either a member of the public or a trader. The former is likely to pay a medium degree of attention, with the latter being more careful. The purchasing process will largely be visual;

d) The marks are visually similar to a medium degree, aurally similar to no more than a medium degree, and conceptually similar to a low to medium degree or dissimilar; and

e) The earlier mark has a very high degree of distinctive character for Class 35 retail services.

200. For the same reasons I gave in the other opposition, I do not consider that there is a likelihood of indirect confusion. This is because the average consumer would perceive the earlier mark as a unit. Even where the services are identical, it is my view that the average consumer would not assume that any use of the word "LEWIS" means that the mark is economically connected to the opponent. I consider that the high degree of enhanced distinctive character enjoyed by the earlier mark would not make enough of a difference, given that the distinctive character lies in "JOHN LEWIS" as a whole.

201. The section 5(2)(b) claim fails.

Section 5(3)

Reputation

202. I remind myself that the opponent claims that the 716 mark has a reputation for the Class 35 services. I adopt the findings I made in paragraph 149 above that this mark has an extremely strong reputation for *The bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a department store or from an Internet website*.

203. The other mark relied on by the opponent is the 102 mark. The goods in Classes 14 and 25 are included in the goods relied on in the other opposition based on the 936 mark. I therefore adopt the findings I made as to reputation in paragraph 150 above: the evidence does not show a reputation for the Class 14 goods, but it does show a fairly high reputation for *Clothing* and *Women's footwear*. The Class 18 goods covered by the 102 mark are different from those covered by the 936 mark, but earlier in my decision at paragraphs 66-69, I found that the goods that would be included in a fair specification of the 102 mark were all included in the fair specification of the 936 mark. I therefore adopt my finding in paragraph 150 that the evidence does not show a reputation for the Class 18 goods. Earlier in my decision, I noted the slight lack of clarity in the specification for Class 35.[34] However, the fair specification I devised would not put the opponent in a better position than the 716 mark.

Link

204. I shall set out here my findings on the factors identified in *Intel*.

The degree of similarity between the conflicting marks

205. I found that the marks were visually similar to a medium degree, aurally similar to no more than a medium degree, and conceptually similar to a low to medium degree or dissimilar, depending on whether the average consumer perceives "LEWIS" as a surname or as a forename.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

206. I found the following services to be identical to the opponent's retail services: *Online retail services relating to handbags; Online retail services relating to jewelry; Online retail services relating to clothing; Online retail services relating to luggage; Online retail services relating to cosmetics; Online ordering services.* The relevant public for both parties' services is the general public.

[34] See paragraph 79.

207. I found the following services to be similar to a medium degree to the opponent's services: *Providing online marketplaces for sellers of goods and or services; Provision of an online marketplace for buyers and sellers of goods and services.* The relevant public for the applicant's services consists of members of the general public and traders. The overlap with the opponent's Class 35 services is with the general public.

208. I found the following services to be dissimilar to the opponent's goods and services: *Advertising relating to the sale of goods; Promoting the goods and services of others through the distribution of discount cards.* The relevant public for the applicant's services are businesses, although members of the general public may also avail themselves of the services for *ad hoc* sales of goods. In my view, the level of attention paid would vary but in general I consider that the average consumer would pay a relatively high degree of attention when selecting these services.

The strength of the earlier mark's reputation

209. The 716 mark has an extremely strong reputation for the Class 35 retail services. The 102 mark has a fairly high reputation for clothing and women's footwear.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

210. The distinctive character of the 716 mark has been enhanced to a very high degree for the Class 35 retail services, while the 102 mark has a high degree of distinctive character for *Clothing* and *Women's footwear*.

Whether there is a likelihood of confusion

211. I found there to be no likelihood of confusion under section 5(2)(b).

Conclusions on link

212. As I found that the 716 mark has an extremely strong reputation for the Class 35 services, I consider that a link would be made in the mind of the relevant public, were the Lewis Magazine mark to be used for *Online retail services relating to handbags; Online retail services relating to jewelry; Online retail services relating to clothing; Online retail services relating to luggage; Online retail services relating to cosmetics;*

Providing online marketplaces for sellers of goods and of services; Provision of an online marketplace for buyers and sellers of goods and services; Online ordering services.

213. Turning now to *Advertising services relating to the sale of goods*, I remind myself that the relevant public for these services is different from that of the opponent's retail services. It is, of course, the case that someone buying the applicant's services in a professional capacity is also a member of the general public. However, I found that the applicant's services would be selected with a fairly high degree of attention. There is no evidence that the opponent is known for offering advertising services, and it seems to me that it would be unlikely for a retail business to diversify into offering advertising services to third parties to promote other businesses' goods. The distance between the services leads me to find that there would not be a link. However, if I am wrong in this, it is my view that, as the average consumer of the applicant's services is paying a fairly high degree of attention and Lewis is a fairly common name, any link made would be momentary and not such as to result in any damage to the earlier marks.

214. The final services to consider are *Promoting the goods and services of others through the distribution of discount cards*. Under section 5(2)(b), I found that these services were dissimilar to the opponent's Class 35 services for which it had shown use. As with advertising, I consider that the distance between the services and the differences between the respective relevant publics lead me to find that, as with *Advertising relating to the sale of goods*, there would not be a link between the marks. However, if I am wrong in this, it is my view that, as the average consumer of the applicant's services is paying a fairly high degree of attention and Lewis is a fairly common name, any link made would be momentary and not such as to result in any damage to the earlier marks.

215. The opposition under section 5(3) fails in respect of *Advertising relating to the sale of goods* and *Promoting the goods and services of others through the distribution of discount cards*.

Damage

216. I shall begin by considering whether there is a serious likelihood that use of the Lewis Magazine mark will take unfair advantage of the reputation or distinctive

character of the earlier marks. The relevant case law has already been set out in paragraphs 166 to 169 above.

217. The majority of the services at issue are identical to the services for which the earlier mark has an extremely strong reputation. Nevertheless, I do not consider that the applicant would derive an unfair advantage through image transfer or take unfair advantage of the distinctive character of the earlier marks for the reasons I have explained in paragraph 173 above.

218. I adopt the findings on Detriment to reputation and detriment to distinctive character made in paragraphs 174 and 175 above.

219. The opposition under section 5(3) is unsuccessful.

OUTCOME

220. The opposition to the Lewis logo (Application No. 3698627) has failed. Subject to a successful appeal, the application may proceed to registration.

221. The opposition to the Lewis Magazine mark (Application No. 3906063) has failed. Subject to a successful appeal, the application may proceed to registration.

COSTS

222. The applicant has been successful and is entitled to a contribution towards his costs. Prior to the hearing, he had been sent a proforma to complete, indicating the number of hours that had been spent on various stages of these proceedings. The applicant did not return the proforma, but it was apparent that this was because he was uncertain how to deal with the consolidated proceedings. At the end of the hearing, I noted that, should the applicant be entitled to any costs, I would request the proforma at that point and then invite the opponent to make any submissions.

223. During the hearing, Mr Harris asked that *"I be awarded full compensation for the damages caused by this prolonged and unnecessary legal battle."* Section 68 of the Act and Rule 67 of the Trade Marks Rules 2008 give the Registrar the power to award costs, but not damages. Furthermore, it has long been the practice, set out in Tribunal Practice Notice 2/2000, that costs are not intended to amount to full compensation for

the costs incurred during the proceedings, but rather to be a contribution to those costs. The purpose of this practice is to maintain the Tribunal as a relatively low-cost tribunal for all litigants.

224. Section 5.2 of the Tribunal Manual sets out the position for unrepresented parties:

> "Unrepresented parties generally incur lower costs because they do not have to pay legal or other professional fees. … unless a Hearing Officer directs otherwise, unrepresented parties will be sent a proforma at the end of proceedings inviting them to set out the number of hours spent on the various steps of the proceedings.
>
> If an award is to be made in favour of an unrepresented party, Hearing Officers will consider the information provided when determining the sum to be awarded. The number of hours claimed will not, however, be binding on Hearing Officers, who will continue to assess whether the time spent was reasonable in the circumstances of the case and who will retain a residual discretion in any event.
>
> The sum to be awarded per hour will be analogous to that set out in the Civil Procedure Rules, Part 46, which is currently £19 per hour. The total amount awarded should, though, not exceed the maximum amount payable on the scale of costs (unless off scale costs are sought). If the unrepresented party does not complete and return the proforma, no costs award will be made save in relation to official fees (except fees for extensions of time)."

225. The proceedings were consolidated on 19 January 2024, after the Forms TM7 and TM8 in opposition No. 442503 had been filed. The applicant is therefore invited to complete two proformas. In the first of these, the applicant should record the time spent on the pleadings stage of Opposition No. 431490 against the Lewis logo; the time spent on the evidence round; and the time spent on preparing for and attending the hearing. In the second proforma, the applicant should only record the time spent on the pleadings stage of Opposition No. 442503. By "pleadings stage", I mean consideration of the opponent's Form TM7 and the completion of the applicant's Form TM8. A period of **14 days** from the date of this decision is allowed for the filing of the proformas, which should be copied to the opponent. The opponent will have a period

of **14 days** from the date of filing of the proformas in which to file any submissions. Should no proformas be filed, the applicant will not be awarded any costs, as it has incurred no official fees.

226. I shall issue a supplementary decision on costs, in which I shall set the appeal period for this decision.

Dated this 7th day of July 2025

Clare Boucher
For the Registrar,
The Comptroller-General