

O/0671/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 4073404
IN THE NAME OF ABDULWAHED BIN SHABIB DISTRIBUTION
FOR THE TRADE MARK**



IN CLASSES 3, 9 & 25

AND

**THE OPPOSITION THERETO UNDER NUMBER 450339
BY TUMI, INC.**

Background and pleadings

1. Abdulwahed Bin Shabib Distribution (“the applicant”) filed an application for the trade mark shown on the cover page of this decision (number 4073404) on 9 July 2024 (“the relevant date”) for goods in classes 3, 9 and 25.

2. Tumi, Inc. (“the opponent”) opposes the application under sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”).¹ The opponent relies upon some of the goods and services of the following four earlier trade mark registrations for its section 5(2)(b) ground:

(i) International Registration 1422244



“The mark consists of the word TUMI” in stylized lettering.”

International registration date: 19 June 2018; UK protection date: 9 March 2022

Class 3: All-purpose cleaners; cleaning preparations; scented fabric refresher spray; polishing preparations; fabric softeners; shoe polish, creams and cleaning preparations; fragrances; perfumes.

Class 20: Clothes hangers; pillows

(ii) 811422244



“The mark consists of the word TUMI” in stylized lettering.”

¹ The claims were narrowed at the hearing from those originally pleaded

Filing date: 27 November 2019; registration date: 19 June 2020

Class 9: *Cases, covers, sleeves, and pouches made in whole or substantial part of leather, imitation leather, nylon, fabric, plastic, silicone specially adapted for portable electronic devices, namely, mp3 players, mobile telephones, smart telephones, laptops, tablet computers, digital cameras, global positioning systems and personal digital assistants; scales; earphones; speakerphones; headphones; battery chargers; mobile power packs, namely, battery charge devices; electrical adapters; battery cases; usb cables; usb hubs; luggage and bag tracking devices using radio frequency, global positioning systems, cellular communication networks and sensors; eyewear; electronic locks.*

(iii) 902306728



Filing date: 18 July 2001; registration date: 15 October 2002

Class 18: Luggage, suitcases, trunks, cases; briefcases, attache cases; handbags, purses, wallets, billfolds; portfolios; carryalls, tote bags; sports bags, gym bags; toiletry cases, vanity cases; leather goods.

Class 25: Coats.

Class 35: Retail services, mail order services, Internet and on-line shopping services, wholesale services, all in relation to bags, cases, luggage, leather goods and clothing.

(iv) 903578143



Filing date: 10 December 2003; registration date: 17 August 2005

Class 9: *Carrying cases for computers, computer accessories and electronic equipment; computer briefcases; computer backpacks.*

Class 18: *Leather and imitations of leather and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas; luggage, handbags, toiletry cases sold empty, all purpose sports bags, tote bags, attaché cases, briefcase-type portfolios and briefcases; purses, women handbags, clutches, shoulder bags, make-up bags sold empty, suitcases, carry on luggage, travel kits sold empty, shoulder bags, back packs, book bags, waist packs, pocket wallets, school bags; passport wallets.*

Class 35: *The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a retail store; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from an Internet web site.*

3. The section 5(2)(b) ground is directed at all of the class 3 and 25 goods and some of the class 9 goods of the application. The opponent claims that the parties' marks and goods are closely similar or identical, leading to a likelihood of confusion.

4. Earlier marks (iii) and (iv) are relied upon for the section 5(3) ground in relation to the underlined goods and services. The section 5(3) claim is directed at all of the goods of the application. Earlier marks (iii) and (iv) are subject to the provisions of section 6A of the Act because they had been registered for more than five years at the date on which the application was filed. The opponent has made a statement that the earlier marks have been put to genuine use.

5. Section 5(4)(a) of the Act is directed against the entirety of the application. The opponent claims that it has used the sign which corresponds to its earlier marks throughout the UK since at least 2008 in relation to *carrying cases for computers; travelling bags; luggage; the bringing together, for the benefit of others, of a variety of*

goods, enabling customers to conveniently view and purchase those goods from an Internet web site.

6. The opponent claims that its business, distinguished by its sign, has goodwill and that the use of the application would cause misrepresentation and damage to its goodwill. On this basis, the opponent claims that use of the application is contrary to the law of passing off.

7. The section 3(6) ground is directed against the entirety of the application, as follows:

“It is submitted that the Contested Application and numerous others filed for by the Applicant incorporate elements taken from other third party brands. These include, but are not limited to the following:

Applicant's Mark	Application No.	Class No.	Owner	Third Party Brand	Brand Owner	Example UK Trade Mark No. owned by Brand Owner
	UK00004062562	18	ABDULWAHED BIN SHABIB DISTRIBUTION	TOM CRUISE	Mr Tom Cruise	N/A – Unregistered Right
	UK00004073404	03, 09, 25	ABDULWAHED BIN SHABIB DISTRIBUTION		The Chapel Hair & Spa Limited	UK00002635458
	UK00004062584	18	ABDULWAHED BIN SHABIB DISTRIBUTION	Calvin Klein	Calvin Klein Trademark Trust	UK00002130032
	UK00004073523	18	ABDULWAHED BIN SHABIB DISTRIBUTION		C. & J. CLARK INTERNATIONAL LIMITED	UK00900167916

	UK00004086885	03, 18, 25	ABDULWAHED BIN SHABIB DISTRIBUTION		The North Face Apparel Corp.	UK00917919022
	UK00004073464	18, 25	ABDULWAHED BIN SHABIB DISTRIBUTION		Under Armour, Inc.	UK00906469266 and UK00904703799
	UK00004073362	03, 18, 25	ABDULWAHED BIN SHABIB DISTRIBUTION		Tommy Hilfiger Licensing, LLC	UK00801225683
	UK00004014271	18	ABDULWAHED BIN SHABIB DISTRIBUTION	AMERICAN TOURISTER	Samsonite IP Holdings S.a r.l.	UK00912463576
	UK00004014275	18	ABDULWAHED BIN SHABIB DISTRIBUTION	AMERICAN TOURISTER	Samsonite IP Holdings S.a r.l.	UK00912463576
	UK00004062583	18	ABDULWAHED BIN SHABIB DISTRIBUTION	AMERICAN TOURISTER	Samsonite IP Holdings S.a r.l.	UK00912463576

	UK00004073465	18, 25	ABDULWAHED BIN SHABIB DISTRIBUTION	AMERICAN TOURISTER	Samsonite IP Holdings S.a r.l.	UK00912463576
	UK00004086887	03, 18, 25	ABDULWAHED BIN SHABIB DISTRIBUTION	ARMANI	GIORGIO ARMANI S.P.A.	UK00900504282
	UK00004101886	18	ABDULWAHED BIN SHABIB DISTRIBUTION		Samsonite IP Holdings S.a r.l.	UK00001006589 and UK00913610233

The above sets out a clear pattern of behaviour regarding other marks and signs. Considered in the round, they build a picture that the Contested Application was filed in bad faith as the Applicant's conduct is dishonest or otherwise falls short of the standards of acceptable commercial behaviour as judged by the ordinary standards of honest people."

8. The applicant filed a defence and counterstatement, denying the grounds of opposition and putting the opponent to proof that it has used earlier marks (iii) and (iv)

and that it has reputation and goodwill. The applicant's denial of the section 3(6) ground is as follows:

"48. The applicant denies the application was filed in bad faith. An allegation of bad faith is a serious allegation which must be distinctly proved. The opponent has not advanced any explanation on why it considers the application to be in bad faith other than pointing to other applications filed by the applicant. The opponent's claim of bad faith is not adequately pleaded as it does not explain why it considers the Applicant's behaviour in filing the current application to be dishonest.

49. The mere fact that a trade mark bears some similarity to another trade mark is not in itself a marker of bad faith. Indeed, many of the marks listed in Section D of the opposition could be construed as parodies. The right to publish parodies is an important aspect of free speech (Human Rights Act s12) and is not sufficient to amount to bad faith. It is not an inherently dishonest business practice to use a sign which brings another trader to the mind of some consumers in an amusing but inoffensive way (*Swatch AG v Apple Inc* [2021] EWHC 719 (Ch)).

50. It is denied that the applicant's conduct in filing the application was dishonest as the mark applied for is not confusingly similar to the opponent's earlier marks. Registration of the mark applied for would not in any way block or hinder the opponent's use of its marks. As advised in paragraphs 47 above [sic], many of the marks listed in Section D could be construed as parodies. Nonetheless, and irrespective of any co-pending marks that the applicant has filed, there is nothing intrinsically wrong with the applicant filing the current application as it would not be confused with the opponent's marks. The applicant has a bone fide intention to use the mark on the goods in question.

51. The Section 3(6) grounds [sic] must fail."

9. Only the opponent filed evidence. The applicant filed written submissions during the evidence rounds. A hearing was held on 21 May 2026 by video conference at

which Ms Ashton Chantrielle, of counsel, appeared for the opponent, instructed by HGF Limited, and Ms Gail Nicol, of Lincoln IP, appeared for the applicant. I make this decision after careful consideration of all the admissible papers on file and the submissions made, referring to them as necessary.

Evidence

10. The opponent's evidence comes from Richard Lamb, its Assistant Secretary.² His evidence is aimed at proving genuine use, reputation and goodwill in relation to the earlier marks and signs and also providing information about other trade mark applications and proceedings involving the applicant. Mr Lamb's second witness statement replied to the applicant's written submissions. His third witness statement was the subject of a request for permission to file it to correct errors made in his first witness statement. The request was made two days prior to the hearing.

11. I dealt with the request as a preliminary issue at the hearing. Also filed was a witness statement dated 19 May 2026 from the opponent's legal representative, Tanya Waller, a partner at HGF Limited. She explains that, in preparing for the hearing, she had become aware that the invoices filed as Exhibit RAL14 were the wrong invoices. She could not explain the error, but adduced Exhibit TEW1 containing the correct invoices. The error in Mr Lamb's first witness statement, corrected in his third, was that the turnover figures only related to goods in classes 3, 9 and 25 rather than all the goods sold by the opponent. Ms Chantrielle submitted that she would not be able to make submissions about the opponent's evidence, knowing that it was incorrect, without being able to rely instead upon the corrected evidence. The evidence was also material. I agreed with both of those submissions. Ms Nicol submitted that all due care should have been taken at the original time of filing. She did not think that the corrected evidence would make any difference to the concessions the applicant had already made with regards to use and reputation for the opponent's class 18 goods. I directed that the evidence be admitted under rule 20(4) of the Trade Mark Rules 2008 (as amended) and that the applicant should be allowed 14 days to file

² Witness statements dated 27 June 2025, 20 November 2025 and 19 May 2026 and exhibits

evidence or submissions in response (and, if it did, the opponent was to have the same amount of time to reply). No submissions or evidence were filed by the applicant.

Proof of use

12. Section 6A of the Act states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

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

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

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

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

(5)-(5A) [Repealed]

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

13. As the earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant.³ It reads:

“7.— (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 On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM or International Registration designating the EU (“IR(EU)”). The earlier marks subject to proof of use were originally protected in the UK as EUTMs. They are now comparable marks which are recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing and registration dates.

(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.”

14. The relevant period for proof of use is the five years ending on the filing date of the contested application: 10 July 2019 to 9 July 2024. This means that the opponent can rely upon EU use (including in the UK) for the period of 10 July 2019 to 31 December 2020. From 1 January 2021 to 9 July 2024, any use shown must have been UK use. The burden of proof lies with the opponent, as the proprietor of the earlier marks, to show genuine use of earlier marks (iii) and (iv) because Section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

15. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:⁴

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v*

⁴ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky' [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

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

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

at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

16. At paragraph 9 of its written submissions, the applicant concedes that the opponent has used its earlier marks in relation to “luggage, bags, purses, wallets etc which all fall within the scope of class 18”. The applicant’s skeleton argument said, at paragraph 27, that:

“It is admitted that the Opponent has filed evidence that proves it has acquired a reputation in the UK in relation to luggage, bags and related accessories”.

17. At the hearing, Ms Nicol said that the applicant admitted that there was “use across Class 18” and also accepted that there was genuine use for retail of such goods. Consequently, I do not need to decide whether the opponent has established genuine use for the class 18 goods and retail thereof. Given the concessions, genuine use needs to be established for:

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Class 25: *Coats.*

Class 35: *Retail services, mail order services, Internet and on-line shopping services, wholesale services, all in relation to clothing.*

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Class 9: *Carrying cases for computers, computer accessories and electronic equipment; computer briefcases; computer backpacks.*

Class 35 (other than in relation to the conceded class 18 goods): *The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a retail store; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from an Internet web site.*

18. All the earlier marks are, essentially, the same mark (earlier mark (iv) looks a little grainier, but is to all intents and purposes the same as the others). Earlier mark (ii),

which is not subject to proof of use, covers essentially the same goods in class 9 as mark (iv). For economy, therefore, I do not need to assess whether earlier mark (iv) has been put to genuine use for the class 9 goods because it takes the opponent no further than earlier mark (ii). In relation to the class 35 services of earlier mark (iv), these are undefined in terms of what the subject goods are, which is not compliant with the judgment of the Court of Justice of the European Union (“CJEU”) in *Praktiker Bau- und Heimwerkermärkte AG*, Case C-418/02.⁵ The judgment was handed down on 7 July 2005, after the date on which earlier mark (iv) was filed but ten days before it was registered. The judgment applies to marks which were applications on or after 7 July 2005, but not to marks registered before that date.⁶ Consequently, the judgment applies to earlier mark (iv). However, Ms Chantrielle submitted that, in practical terms, the opponent relied upon this mark in respect of services relating to clothing and luggage, as for earlier mark (iii).

19. Mr Lamb states that the opponent’s goods are available to buy directly through its Tumi branded stores or websites (the UK version is uk.tumi.com) and indirectly via retailers and wholesalers, such as Selfridges, John Lewis and Amazon. Exhibit RAL07 comprises examples of the opponent’s goods on the UK website during the relevant five-year period, from the Internet Archive, the Wayback Machine. Page 3 shows rain ponchos and coats (11 April 2020) and I note that the page is headed “Jackets & High Tech Outerwear”, with “38 items”, although only three (two ponchos and a puffer jacket) are shown. Mr Lamb provides the following turnover figures for the UK:⁷

⁵ The court stated: “1. The concept of ‘services’ referred to by First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, in particular in Article 2, covers services provided in connection with retail trade in goods. 2. For the purpose of registration of a trade mark for such services, it is not necessary to specify in detail the service(s) in question. However, details must be provided in connection with regard to the goods or types of goods to which those services relate.”

⁶ See the CJEU’s judgment in *Tulliallan Burlington Ltd v EUIPO*, Joined cases C-155/18 P to C-158/18 P: “133 However, first, the Court has made clear that the line of authority derived from the judgment in *Praktiker* concerns only applications for registration as trade marks and does not concern the protection of trade marks registered at the date of that judgment’s delivery (judgment of 11 October 2017, *EUIPO v Cactus*, C-501/15 P, EU:C:2017:750, paragraph 45).”

⁷ Witness statement dated 19 May 2026

Product Type	UK Turnover Per Year (in excess of \$(USD))				
	2020	2021	2022	2023	2024
Luggage	2,000,000	2,400,000	4,800,000	5,900,000	6,600,000
Backpacks	1,100,000	1,000,000	2,100,000	2,500,000	2,900,000
Bags	610,000	620,000	1,300,000	1,400,000	1,600,000
Briefcases	420,000	320,000	580,000	690,000	780,000
Accessories	190,000	160,000	290,000	520,000	610,000
Small Leather Goods	150,000	77,000	160,000	130,000	170,000
Umbrellas	20,000	22,000	66,000	29,000	39,000
ICT Cases	13,000	14,000	31,000	30,000	45,000
Business Cases	9,500	8,500			
Apparel	42,000	56,000	15,000	2,800	2,200
Phone Bags	10,000	3,500	5,500	7,500	15,000
Other			3,100	7,700	19,000
Sports Bags		1,800	2,700	6,400	24,000
Undefined	1,900	2,800	6,500	9,100	12,000
Attachés			2,700		14,000
Handbags	2,400	900	3,500	4,400	3,400
Belts	2,300	3,300	2,200		700

20. I note that, in the corrected invoices to UK customers (Exhibit TEW1), an invoice dated 1 January 2020 (page 29) shows items listed as “OUTERWEAR MENS TUMIPAX PATROL JKT BLACK [and] NAVY” in L and XL sizes. However, this invoice was both sent from and to addresses in Switzerland, which is (and was) not in the EU.

21. There is a paucity of documentary evidence relating to ‘coats’ or to retail of clothing. There is a single screenshot of the website page from 11 April 2020 showing three coats. The invoice does not assist because it is outside of the UK and the EU. The turnover table refers to “apparel”, a term which covers a wide variety of clothing types; it is not possible to say that “apparel” relates only to coats. I bear in mind that the single screenshot is headed “Jackets & High Tech Outerwear”, which could mean that this is the only clothing that has been sold, in which case the turnover could all relate to only these types of goods. However, “outerwear” is a wide term and could cover more than simply coats. It is the opponent’s responsibility to make its evidence clear as to what has been sold and to what the turnover relates. In *W Sternoff LLC v Peter Kertels*, Case BL O/0984/25, Mr Phillip Johnson, sitting as the Appointed Person, stated:

“15. [...] in relation to proof of use (and distinctiveness or reputation) the assessment of the evidence is by its nature forensic and stringent. As Daniel Alexander QC, both sitting as a deputy High Court judge and as an Appointed Person, has emphasised, it is important to ensure that when proving use the registered proprietor has dotted all the i’s and crossed all of the t’s in its evidence: *Abanka DD v Abanca Corporacion Bancaria SA* [2017] EWHC 2428 (Ch), [88]; *Gerry Weber International Ag V Guccio Gucci Spa* [2015] RPC 9, [1]. Any evidence not meeting this high standard can properly be disregarded by the tribunal.

16. Mr Alexander further stated in *Awareness Limited v Plymouth City Council* (O/236/13), [22]:

The burden lies on the registered proprietor to prove use...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 (which in many cases will be the Hearing Officer in the first instance) 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.

17. Indeed, as the requirement to prove use is to establish and maintain an exclusive right it is appropriate that any evidence of use is proved strictly. But as Mr Alexander says if a mark has been used it should be easy to prove use even if the test is strict.”

22. Mr Johnson went on to state:

“27. Evidence of sales is only useful for establishing genuine use where it sets out the sales revenue for a particular and identified good (or service) and it is clear that that good or service is sold under the trade mark. Only where there is only one good being sold and it is sold under only one trade mark can global figures be sufficient.”

23. There is no statement that the sales figures for “apparel” are, in fact, only for coats. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each piece of evidence shows use by itself.⁸ However, I do not think I can put together the single webpage and the figure which is described as apparel and find that the figure relates only to coats. Without particularisation of the figure enabling me to do that, I cannot decide if a sufficient amount of use has been made in relation to coats. There are no invoices to help (the sole invoice being from and to Switzerland). There are no other pictures in the evidence showing use in relation to any clothing.

24. Further, the figures for “apparel” are not large and diminished significantly to a vanishingly small amount in 2023 (US\$2,800 in 2023 and less still in 2024). In assessing whether genuine use has been made in relation to coats or retail of clothing, I am not making a judgment about the commercial success of the earlier marks. It depends upon a variety of factors, including the nature of the goods and services and the characteristic of the market; the consistency of sales over time and whether the use is warranted to create or maintain a share in that market. This is a very large market. I bear in mind *Industria de Diseño Textil, SA (Inditex) v EUIPO*, T-467/20, EU:T:2021:842, where the General Court (“GC”) held that representative invoices showing sales of pasta in Italy totalling something over €40,000 were sufficient to show genuine use in the EU when taken together with marketing material and evidence of regular use over the relevant period. However, in the present case, there are no relevant invoices, no particularisation of turnover for “apparel” and there is no marketing material in relation to coats. I find that no genuine use was made in

⁸ *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, General Court of the European Union, Case T 415/09

the relevant period in relation to coats and retail services, mail order services, Internet and on-line shopping services, wholesale services, all in relation to clothing (earlier mark (iii)) and, other than in relation to the conceded services for class 18 goods, there was no genuine use in relation to *the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a retail store; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from an Internet web site* (earlier mark (iv)).

25. There is use of the marks as registered and, clearly, given the concessions as to use, there is no dispute about the form of use of the marks. Taking the concessions into account, for the section 5(2)(b) ground the opponent can rely upon all of its goods as pleaded for earlier marks (i) and (ii); the class 18 goods of earlier marks (iii) and (iv); and the class 35 services of earlier marks (iii) and (iv) in so far as they relate to *bags, cases, luggage, leather goods*.

Section 5(2)(b) of the Act

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

“5. (2) A trade mark shall not be registered if because –

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

27. Section 5A states:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”⁹

28. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

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

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

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that

⁹ This section also applies to the grounds raised under sections 5(3) and 5(4)(a) of the Act

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

29. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

30. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

31. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, the GC stated that complementary means:¹⁰

“82 ... there is a close connection between [the goods], 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...”.¹¹

32. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

33. The parties' goods and services are:¹²

¹⁰ Case T-325/06, the General Court

¹¹ In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods and services

¹² The section 5(2)(b) ground was withdrawn prior to the hearing in respect of Alcoholmeters; audio mixers; computer game software, downloadable; computer game software, recorded; computer

Opponent	Applicant
Class 3: <i>All-purpose cleaners; cleaning preparations; scented fabric refresher spray; polishing preparations; fabric softeners; shoe polish, creams and cleaning preparations; fragrances; perfumes.</i> Class 9: <i>Cases, covers, sleeves, and pouches made in whole or substantial part of leather, imitation leather, nylon, fabric, plastic, silicone specially adapted for portable electronic devices, namely, mp3 players, mobile telephones, smart telephones, laptops, tablet computers, digital cameras, global positioning systems and personal digital assistants; scales; earphones; speakerphones; headphones; battery chargers; mobile power packs, namely, battery charge devices; electrical adapters; battery cases; usb cables; usb hubs; luggage and bag tracking devices using radio frequency, global positioning systems, cellular communication networks and sensors; eyewear; electronic locks.</i> Class 18: <i>Luggage, suitcases, trunks, cases; briefcases, attache cases; handbags, purses, wallets, billfolds;</i>	Class 3: <i>Air fragrance reed diffusers; amber [perfume]; beard dyes; deodorant soap; deodorants for human beings or for animals; eau de cologne; essential oils/ethereal oils; extracts of flowers [perfumes]; fumigation preparations [perfumes]; hair dyes/hair colorants; hair lotions; hair spray; hair straightening preparations; hair waving preparations/waving preparations for the hair; incense; ionone [perfumery]; micellar water; mint for perfumery; musk [perfumery]; oils for perfumes and scents; perfumery; perfumes; potpourris [fragrances]; shampoos; shaving soap.</i> Class 9: <i>Bathroom scales; cinematographic cameras; ear pads for headphones; eyewear; goggles for sports; headphones; headsets; loudspeakers; microphones; navigational instruments; portable speakers; scanners [data processing equipment].</i> Class 25: <i>Boxer shorts; clothing containing slimming substances; clothing for gymnastics; clothing of imitations of leather; clothing; coats;</i>

software, recorded; electronic sheet music, downloadable; hydrometers; juke boxes, musical/coin-operated musical automata [juke boxes]; mouse pads. At the hearing, Ms Chantrielle said that scanners [apparatus] for performing automotive diagnostics was also not similar.

<i>portfolios; carryalls, tote bags; sports bags, gym bags; toiletry cases, vanity cases; leather goods.</i> <i>Class 18: Leather and imitations of leather and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas; luggage, handbags, toiletry cases sold empty, all purpose sports bags, tote bags, attaché cases, briefcase-type portfolios and briefcases; purses, women handbags, clutches, shoulder bags, make-up bags sold empty, suitcases, carry on luggage, travel kits sold empty, shoulder bags, back packs, book bags, waist packs, pocket wallets, school bags; passport wallets.</i> <i>Class 20: Clothes hangers; pillows.</i> <i>Class 35: Retail services, mail order services, Internet and on-line shopping services, wholesale services, all in relation to bags, cases, luggage, leather goods.</i> <i>Class 35: The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a retail store; the bringing together, for the</i>	<i>dresses; embroidered clothing; gloves [clothing]; headwear; jackets [clothing]; jerseys [clothing]; knitwear [clothing]; layettes [clothing]; ready-made clothing; shirt fronts; shirt yokes; shirts; short-sleeves shirts; skirts; sports jerseys; tee-shirts; underpants; underwear/underclothing; waistcoats/vests.</i>
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<i>benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from an Internet web site; all in relation to bags, cases, luggage, leather goods.</i>	
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34. In its counterstatement, the applicant admits that its *eyewear* is identical to the same term in the specification of earlier mark (ii). At the hearing, the applicant also admitted that its *eau de cologne; perfumery; perfumes* are identical to the opponent's *fragrances; perfumes* of earlier mark (i). In addition to *eyewear*, it also admitted at the hearing that *goggles for sports* are identical to *eyewear* and that its *bathroom scales and headphones* are identical to the opponent's *scales; headphones*.

Class 3

35. At the hearing, Ms Nicol said "We agree that fragrances and perfumes are similar to the reed diffusers etc outlined at Paragraph 64, we aren't going to disagree with that." Paragraph 64 of the opponent's skeleton argument is actually a summary of the *Treat* criteria; but paragraph 65 lists the following goods:

Air fragrance reed diffusers; amber [perfume]; eau de cologne; essential oils/ethereal oils; extracts of flowers [perfumes]; fumigation preparations [perfumes]; incense; ionone [perfumery]; mint for perfumery; musk [perfumery]; oils for perfumes and scents; perfumery; perfumes; potpourris [fragrances].

36. This is, therefore, a concession from the applicant that the above goods are identical or similar to the opponent's *fragrances; perfumes*. I still need to determine how similar the goods are (other than those which the applicant accepts are identical.)

37. The law requires that goods and services be considered identical where one party's description of its goods and services encompasses the specific goods and services covered by the other party's description (and vice versa): *Gérard Meric v OHIM*.¹³ On this basis, I find that the applicant's *air fragrance reed diffusers; incense;*

¹³ Case T-33/05, GC

potpourris [fragrances] are identical to the opponent's *fragrances*, which covers fragrances for rooms as well as for people. The applicant's *essential oils/ethereal oils; extracts of flowers [perfumes]; mint for perfumery; musk [perfumery]; oils for perfumes and scents* also appear to be identical to the opponent's *fragrances* because such goods can be used in burners and with diffusers to fragrance rooms. Essential oils can also be mixed with carrier oils to use as perfumery on the person, making these goods highly similar to *perfumes* for use on the person, by virtue of nature, purpose, users, methods of use, channels of trade and competition. *Fumigation preparations [perfume]* are used to scent a room or area (such as toilets in hotels or offices) and are identical or at least highly similar to the opponent's *fragrances*. *Collins* online dictionary gives the following definition for ionone:

“1. a yellowish liquid mixture of two isomers with an odour of violets, extracted from certain plants and used in perfumery.”

38. There are no dictionary definitions for amber which relate to perfumery. Ionone and amber are listed in the applicant's specification as being perfumery or perfume. It seems to me that they are perfumery ingredients rather than pure essential oils, the latter of which may be used as standalone products in burners or diffusers. In *Les Éditions Albert René v OHIM*, case T-336/03, the GC found 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.”

39. The user of the opponent's goods will be a manufacturer of perfume or scented goods, rather than the end user. The nature is the same (liquid) and the purposes of the goods are to fragrance. The channels of trade will not coincide because the applicant's goods will be sold to manufacturers rather than to the general public. They are not in competition because they are not a finished article, and they are unlikely to be complementary because the end user will not be exposed to the ingredient and will therefore not expect the same undertaking to be responsible for both the ingredient

and the finished perfume or fragrance. However, the applicant has conceded some degree of similarity. It is not for me to make a better case for the applicant than it makes for itself. I therefore find that the applicant's *amber [perfume]* and *ionone [perfumery]* are similar to the opponent's *fragrances; perfumes* to a low degree.

40. The applicant's *deodorant soap; deodorants for human beings* are for enhancing the smell of the body, sharing the same purpose as perfumes. The nature of the opponent's goods will be the same as deodorants if they are in the form of sprays. *Shaving soap*, deodorant soap and deodorants for human beings could also form part of a range of goods (such as body lotion, bath gel and after shave) sold with the same scent, sharing channels of trade and a degree of complementarity. I find that the applicant's *shaving soap, deodorant soap and deodorants for human beings* are similar to a high degree to the opponent's *perfumes*.

41. Additionally, *shaving soap*, whilst being specifically to help achieve an effective shave, is also for cleaning the skin. *Micellar water* is a skin cleanser. The opponent has the standalone term *cleaning preparations* in its class 3 specification; it is standalone because it has semi-colons before and after the term. In *Aveda Corporation v Dabur India Limited*, [2013] EWHC 589 (Ch), Arnold J (as he then was) agreed at paragraph 60 with the registrar's hearing officer that 'cleaning, polishing, scouring and abrasive preparations' were not for use on the body and that the natural meaning of the unqualified term is that of household or industrial preparations since all four adjectives appear in the same term. In that case, 'cleaning preparations' was construed in the context of the other words which formed part of the same term: polishing, scouring and abrasive preparations. In the present case, cleaning preparations is a standalone term. Given its ordinary meaning, cleaning preparations plainly covers goods for e.g. the household and personal use. On this basis, the opponent's *cleaning preparations* covers (*per Meric*) the applicant's *deodorant soap; shaving soap, micellar water and shampoos*, making these goods identical. The opponent's cleaning preparations includes goods for animals, such as pet shampoo. A dog groomer, for example, may choose to use a shampoo and a deodorant with the same scent, purchased from the same outlet. Consequently, I find that the opponent's *cleaning preparations* are similar to a medium degree to the applicant's *deodorants for animals*.

50. This leaves *beard dyes; hair dyes/hair colorants; hair lotions; hair spray; hair straightening preparations; hair waving preparations/waving preparations for the hair*. Although they are not cleaning preparations, they have a similar purpose to shampoo (covered by cleaning preparations) for improving the appearance of hair. They are not in competition but they will be sold side-by-side and may form part of a range of items for use together. There is a medium degree of similarity with the opponent's *cleaning preparations*.

Class 9

51. At the hearing, Ms Nicol conceded that the applicant's *headsets* are similar to the opponent's *headphones*. In my view, the terms are interchangeable, which makes the applicant's goods identical. If I am wrong about that and headsets are not strictly the same as headphones because the former includes microphones, they are clearly highly similar. The applicant's *ear pads for headphones* are similar to a medium degree to the opponent's *headphones* because the applicant's goods are parts for headphones. There is a strong degree of complementarity and they will be bought via the same trade channels.

52. Earlier mark (ii) covers luggage and bag tracking devices using global positioning systems. This appears to be covered, on the *Meric* principle, by the applicant's *navigational instruments*. If that is wrong, I note that earlier mark (ii) includes coverage for cases, covers, sleeves and pouches for specified portable electronic equipment. The opponent has limited the type of goods for which its cases and covers are adapted because the word 'namely' precedes the list of types of equipment. The list includes cases for global positioning systems. Such goods would be complementary to the applicant's *navigational instruments*, being a specifically adapted case or cover, and sold via the same trade channels. They are, if not identical, similar to a medium degree to the aforementioned goods of the opponent.

53. A cinematographic camera could be portable and digital. Consequently, I find a medium degree of similarity between the applicant's *cinematographic cameras* and the opponent's *cases, covers, sleeves and pouches...specially adapted for portable digital cameras* because they will be complementary and sold via the same trade

channels. The remainder of the applicant's class 9 goods are not covered by any of the listed (and limited) terms applicable to the opponent's cases and covers, the applicant's goods being *loudspeakers; microphones; portable speakers; scanners [data processing equipment]*. However, the opponent also has cover for *battery chargers and electrical adapters*. These could be a part or a fitting of the applicant's goods, sold as a complementary item via the same trade channels. They are similar to a medium degree.

54. Even if I had assessed the class 9 goods relied upon under earlier mark (iii) for proof of use, at most, any use was made in relation to laptop bags, which does not put the opponent in a stronger position than for earlier mark (ii) which also covers laptop bags.

Class 25

55. I found earlier that the opponent has not used its earlier marks in relation to coats or retail services in relation to clothing. There is no similarity between the opponent's goods in classes 3, 9 and 20 and the applicant's class 25 goods. I will assess the applicant's class 25 goods against the opponent's class 18 goods and class 35 services (for retail of class 18 goods).

56. In *El Corte Inglés SA v OHIM (PiraÑam)*, Case T-443/05, the GC considered whether "Leather and imitations of leather goods not included in other classes" was similar to "Clothing, footwear and headgear". The court acknowledged that the goods in classes 18 and 25 could be made of leather or imitation leather but, while it could be taken into account, this factor was not enough on its own to find similarity owing to the wide variety of goods which could be made of those materials. The court also said that it was apparent that the distribution channels of some of the goods were identical, so this was a factor to be taken into account. The court confirmed that there was a slight similarity between the goods. It also stated that:

"49 Goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image ('look') of the consumer concerned.

50 The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in class 25 and the various clothing accessories which complement them such as handbags in class 18. Any such coordination depends on the consumer concerned, the type of activity for which that look is put together (work, sport or leisure in particular), or the marketing strategies of the businesses in the sector. Furthermore, the fact that the goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and strengthen the perception that the same undertaking is responsible for the production of those goods.

51 It is clear that some consumers may perceive a close connection between clothing, footwear and headgear in class 25 and certain 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which are clothing accessories, and that they may therefore be led to believe that the same undertaking is responsible for the production of those goods. Therefore, the goods designated by the mark applied for in class 25 show a degree of similarity with the clothing accessories included in 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which cannot be classified as slight."

57. In *Gitana SA v Office for Harmonization in the Internal Market v OHIM*, Case T-569/11, the GC stated:

"45 Moreover, in respect of the relationship between the 'goods in leather and imitations of leather' in Class 18 covered by the trade mark sought and the goods in Class 25 covered by the earlier mark, it is apparent also from settled case-law that the 'goods in leather and imitations of leather' include clothing accessories such as 'bags or wallets' made from that raw material and which, as such, contribute, with clothing and other clothing goods, to the external image ('look') of the consumer concerned, that is to say coordination of its

various components at the design stage or when they are purchased. Furthermore, the fact that those goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and support the impression that the same undertaking is responsible for the production of those goods. It follows that some consumers may perceive a close connection between clothing, footwear and headgear in Class 25 and certain ‘goods made of these materials [leather and imitations of leather] and not included in other classes’ in Class 18 which are clothing accessories. Consequently, clothing, shoes and headgear in Class 25 bear more than a slight degree of similarity to a category of ‘goods made of these materials [leather and imitations of leather] and not included in other classes’ in Class 18 consisting of clothing accessories made of those materials (see, to that effect, *PiraÑAM diseño original Juan Bolaños*, paragraph 42 above, paragraphs 49 to 51; *exē*, paragraph 42 above, paragraph 32; and *GIORDANO*, paragraph 42 above, paragraphs 25 to 27).”

58. In *Asos Plc v OHIM*, Case T-647/11, the GC upheld a decision by OHIM’s (now the EUIPO) Fourth Board of Appeal that there was no similarity between clothing, footwear and headgear and “bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses”. The court stated:

“45 It is apparent from the case-law that goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image (‘look’) of the consumer concerned. The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say, coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in Class 25 and the various clothing accessories which complement them, such as handbags in Class 18 (*PiraÑAM diseño original Juan Bolaños*, cited in paragraph 15 above, paragraphs 49 and 50).

46 In the present case, in the contested decision, the Board of Appeal held that the ‘bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses’ in Class 18 — contrary to the ‘clothing, footwear, headgear’ in Class 25, which had an aesthetic function — essentially had a practical function, namely that of containing sports equipment, documents, banknotes and coins, are not perceived as part of the external image, have no aesthetic function and are not included in the marketing strategy for fashion accessories. The Board of Appeal consequently held that the abovementioned goods, coming within Class 18, were not complementary to ‘clothing, footwear, headgear’ in Class 25. It added that it was unlikely that, when buying a briefcase or a wallet, the purchaser would be asked about the colour of the suits or shoes normally worn or, when buying a sports bag, the colour of his tracksuit.

47 That appraisal by the Board of Appeal must be upheld.

48 Firstly, the ‘bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses’ in Class 18, unlike the ‘clothing, footwear, headgear’ in Class 25, have an essentially utilitarian function and not an essentially aesthetic function. There is therefore no reason for the consumer to coordinate them with the ‘clothing, footwear, headgear’ in Class 25. In contrast to handbags, coming within Class 18, the goods at issue in Class 18 do not contribute to the external image of consumers.

49 Secondly, the purchase of the goods at issue in Class 18 is viewed independently from the purchase of ‘clothing, footwear, headgear’ in Class 25. The average consumer will purchase ‘bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses’ without worrying about the concomitant possession or purchase of ‘clothing, footwear, headgear’ in Class 25. Conversely, for the average consumer, the decision to buy ‘clothing, footwear, headgear’ in Class 25 is generally not influenced by, or subject to, the purchase or possession of the goods at issue in Class 18.

50 It follows that the ‘bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses’ in Class 18 cannot be considered to be clothing accessories.

51 In addition, even if the goods at issue in Class 18 were to share with the goods at issue in Class 25 the same distribution channels and have the same end users, that would not suffice for the conclusion that there is a similarity between those goods. Lastly, the intervener’s argument that those goods in Class 18 and the ‘clothing, footwear, headgear’ in Class 25 are generally produced by the same manufacturer has not been substantiated.

52 It follows that the Board of Appeal acted correctly in holding that the ‘bumbags; sports bags; casual bags; briefcases; attaché cases; satchels; beauty cases; credit card cases and holders; wallets; purses’ in Class 18 and referred to in the application for the mark sought and the goods in Class 25, covered by the earlier mark, were not similar.”

59. The main point for me to consider which has emerged from these cases is that, depending upon the goods in class 18, they may be complementary to goods in class 25 as being part of the effort to achieve a co-ordinated look, such that the goods will be regarded as being the responsibility of the same undertaking. The last of the judgments which I have set out above was handed down on 29 April 2014. This was some ten years prior to the relevant date in these proceedings. In that time, fashions have changed. It seems to me that the wearing of sportswear as general fashionable casual wear, as opposed to mainly for participating in sport, is now more prevalent than it was in 2014. It may be that the image-conscious wearer of sportswear, perhaps attending a gym, will want a co-ordinated sports bag to complete the overall look, rather than a sports bag to fulfil a simply utilitarian function. A certain look will also be important, for example, for a wedding or a school prom. Hats, outfits and bags may all be chosen with a coordinated look in mind.

60. With that in mind, and noting that the applicant has conceded use across the opponent’s class 18 goods, I find that the following of the applicant’s class 25 goods

are similar either to the opponent's *handbags* or to its *all purpose sports bags* to a low to medium degree, sharing end users and trade channels:

Clothing for gymnastics; clothing of imitations of leather; clothing; coats; dresses; embroidered clothing; gloves [clothing]; headwear; jackets [clothing]; jerseys [clothing]; knitwear [clothing]; ready-made clothing; shirts; short-sleeves shirts; skirts; sports jerseys; tee-shirts; waistcoats/vests.

61. There is no similarity between the opponent's class 18 goods and the applicant's *boxer shorts; underpants; underwear/underclothing* because these are underwear and would not be part of a coordinated look. There is no similarity with the applicant's *shirt fronts; shirt yokes* because these are parts of clothing. There is no similarity with the applicant's *layettes [clothing]* because layettes are clothes for newborn babies, which would not be co-ordinated with bags (as opposed to perhaps a pram being coordinated with a bag). Lastly, I have no information about *clothing containing slimming substances*, but this term does not strike me as the type of clothing for which the wearer would seek a coordinated look with a bag. There is no similarity between these goods and retail of class 18 goods, which is a step further away.

62. As I have found no similarity in respect of some of the applicant's goods, the opposition under section 5(2)(b) fails in respect of the following goods:

*Boxer shorts; underpants; underwear/underclothing; shirt fronts; shirt yokes; layettes [clothing]; clothing containing slimming substances.*¹⁴

Average consumer and the purchasing process

63. As the caselaw cited above indicates, it is necessary to decide who the average consumer is for the goods at issue and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."¹⁵ The average consumer is deemed to be reasonably well informed and reasonably observant and

¹⁴ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77

¹⁵ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch)

circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*. In *Lidl Great Britain Limited & anor v Tesco Stores Limited & anor* [2024] EWCA Civ 262, Lord Justice Arnold explained:

“16. First, the average consumer is both a legal construct and a normative benchmark. They are a legal construct in that consumers who are ill-informed or careless and consumers with specialised knowledge or who are excessively careful are excluded from consideration. They are a normative benchmark in that they provide a standard which enables the courts to strike a balance between the various competing interests involved, including the interests of trade mark owners, their competitors and consumers.

17. Secondly, the average consumer is neither a single hypothetical person nor some form of mathematical average, nor does assessment from the perspective of the average consumer involve a statistical test. They represent consumers who have a spectrum of attributes such as age, gender, ethnicity and social group.

18. Thirdly, assessment from the perspective of the average consumer is designed to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence.

19. Fourthly, the average consumer's level of attention varies according to the category of goods or services in question.

20. Fifthly, the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and

must instead rely upon the imperfect picture of the trade mark they have kept in their mind.”¹⁶

64. The average consumer of the goods (the opponent’s services are not similar to the applicant’s goods) is a member of the general public. The level of attention paid will clearly vary depending on the type and cost of the goods. Some will entail a relatively careful purchase, such as global positioning systems, whilst others, such as shampoo, will be selected with a lower level of attention. Overall, average consumers of the goods pay a ‘normal’ or medium degree of attention during the selection process. The goods are likely to be selected from shelves and displays in stores, from printed catalogues or from websites. Therefore, the selection process is likely to be primarily visual. However, sales assistance and word of mouth orders/recommendations may also play a part in the selection process, so the way the marks sound is also a consideration.

Comparison of marks

65. *Sabel BV v Puma AG* explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

¹⁶ Approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc and anor* [2025] UKSC 25, at paragraph 30

67. As stated earlier in this decision, the opponent's marks are all essentially the same. Earlier mark (iv) is a little grainier, but makes no difference to the outcome of the mark comparison. I will use the representation of earlier mark (i) to compare all of the earlier marks with the applicant's mark. The marks to be compared are:

Opponent's mark(s)	Applicant's mark
	

68. The earlier mark consists of the highly stylised word TUMI. The stylisation carries significant weight in the overall impression of the mark. The applicant's mark is comprised of three main elements. There is a device or logo at the top, which looks like the letters T and C, intersected. Below that, on the same line are the words TOM and CRUISER. The TOM element is heavily stylised and appears white on a black background. Although all three elements contribute to the overall impression, the eye is drawn more to the words, and to the TOM element in particular, on account of the heavy stylisation and because the words will be read from left to right.

69. The main visual difference between the marks is the additional device and CRUISER in the applicant's mark which have no counterparts in the earlier mark. However, the TOM element is visually highly similar to the earlier mark, whether or not the letters are black or white. The way the letters are arranged is the same; in particular, the double-lined T, the top bar of which extends across the top of the remaining letters; the way the T is elided with the top of the U and O, respectively; and the square-ish letters, which makes the U and O look almost the same. Although the TOM element in the applicant's mark ends with M and TUMI ends in I, the I in TUMI is the least noticeable part of the element, which further increases the visual similarity between the earlier mark and the TOM element of the later mark. Bearing in mind that the same stylisation is present in the dominant element of both marks, and

notwithstanding the other visual differences, I find that the marks are visually similar overall to at least a medium degree.

70. The earlier mark will be pronounced TEW-MEE or TOO-MEE. The logo in the later mark is unlikely to be articulated: the mark will be referred to as TOM CRUISER, the pronunciation of which is obvious. Aural similarity only arises from the common T beginning and the fact that there is an M sound in TUMI and in TOM. The marks are aurally similar to a very low degree.

71. In its counterstatement, the applicant submits that TUMI is derived from the Quechua language, meaning knife (without any evidence of the same). I note that in the opponent's evidence, Mr Lamb states that the opponent was named after a Peruvian god-like figure, the symbol of a Peruvian state. Neither of these meanings is likely to be known to the average UK consumer. The earlier mark will be seen in the UK as an invented word. The logo in the later mark does not have a concept (other than it is the letters T and C, which is not really a concept). TOM is a forename. *Collins Online Dictionary* gives the following definitions for British English for *cruiser*:¹⁷

- “1. a high-speed, long-range warship of medium displacement, armed with medium calibre weapons or missiles
2. Also called: cabin cruiser
a pleasure boat, esp one that is power-driven and has a cabin
3. any person or thing that cruises”

72. The marks have nothing in common, conceptually. Ms Nicol referred to the applicant's mark bringing to mind the Hollywood actor, Tom Cruise. In *The Picasso Estate v OHIM*, the CJEU found that the EU's Court of First Instance should have taken account of the conceptual meaning of PICASSO (as the name of the famous artist) when assessing the degree of similarity (and therefore the likelihood of confusion) between that mark and the later-filed trade mark PICARO when used in relation to vehicles.¹⁸ In *Lionel Andrés Messi Cuccittini v EUIPO*, the CJEU dealt with

¹⁷ Accessed on 15 July 2026

¹⁸ Case C-361/04 P

an appeal concerning a mark corresponding to one of the given names of Mr Cuccittini, a well-known footballer usually called just 'Messi'.¹⁹ Mr Cuccittini had applied to register a mark containing MESSI as an EU trade mark for 'rescue devices' in class 9, clothing in class 25, and sporting articles in class 28. The appellant argued the EU's General Court had been wrong to regard the reputation of Messi as a footballer as a relevant factor in the assessment of the likelihood of confusion between the mark shown below and an earlier EU trade mark, MASSI:



73. Relying on *Aceites del Sur-Coosur*, the appellant submitted that only the reputation of the earlier mark could be taken into account when assessing whether there was a likelihood of confusion.²⁰ The CJEU rejected this submission stating that:

“44. In so far as JM-EV criticizes the General Court for disregarding Article 8(1)(b) of Regulation No 207/2009 by considering, in paragraph 62 of the judgment under appeal, that there was account of the notoriety of Mr Messi Cuccittini in the context of the assessment of the likelihood of confusion, within the meaning of that provision, it should be recalled that, according to settled case-law of the Court, the existence of a likelihood of confusion in the mind of the public must be assessed globally taking into account all the relevant factors of the case.

45. According to equally settled case-law, the overall assessment of the likelihood of confusion must, as regards the visual, phonetic or conceptual similarity of the signs at issue, be based on the overall impression produced by them, taking into account, in particular, of their distinctive and dominant elements.

¹⁹ Joined cases C-449/18P & C-474/18P

²⁰ Case C-498/07 P

46. In the context of that overall assessment, the reputation of the earlier mark is, admittedly, a relevant factor for the purposes of assessing the likelihood of confusion.

47. However, as the Court has held, account must also be taken of the possible notoriety of the person applying for his name to be registered as a trade mark, since that reputation may obviously, have an influence on the perception of the mark by the relevant public (see, to that effect, judgment of 24 June 2010, *Becker v Harman International Industries*, C-51/09 P, paragraph 37).

48. It follows that the General Court was right to consider, in paragraph 62 of the judgment under appeal, that the notoriety of Mr Messi Cuccittini constituted a relevant factor in order to establish a difference at the conceptual level between the term ‘messi’ and the term ‘massi’.”

74. Accordingly, if there is another concept present in the applicant’s mark, i.e. that of the Hollywood actor, Tom Cruise, that is still a concept which is absent from the earlier mark. Conceptually, the marks are not similar.

Distinctiveness of the earlier mark

75. The assessment as to whether there is a likelihood of confusion includes considering whether the distinctive character of the earlier marks has been enhanced (i.e. more distinctiveness has been acquired) through the use made of them. If a mark has an inherently high, or an enhanced, level of distinctiveness, the likelihood of confusion is increased.²¹

76. I will firstly consider the inherent distinctive character of the earlier marks. TUMI will be perceived as an invented word by the average UK consumer. It does not allude to the goods or services, or to their characteristics. The stylisation of the letters is

²¹ *Sabel BV v Puma AG*, Case C-251/95.

unusual and contributes to the distinctiveness. The earlier marks have a high degree of inherent distinctive character.

77. Distinctive character is a measure of how strongly an earlier mark identifies the goods or services for which it is registered, determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identifies the goods or services as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

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

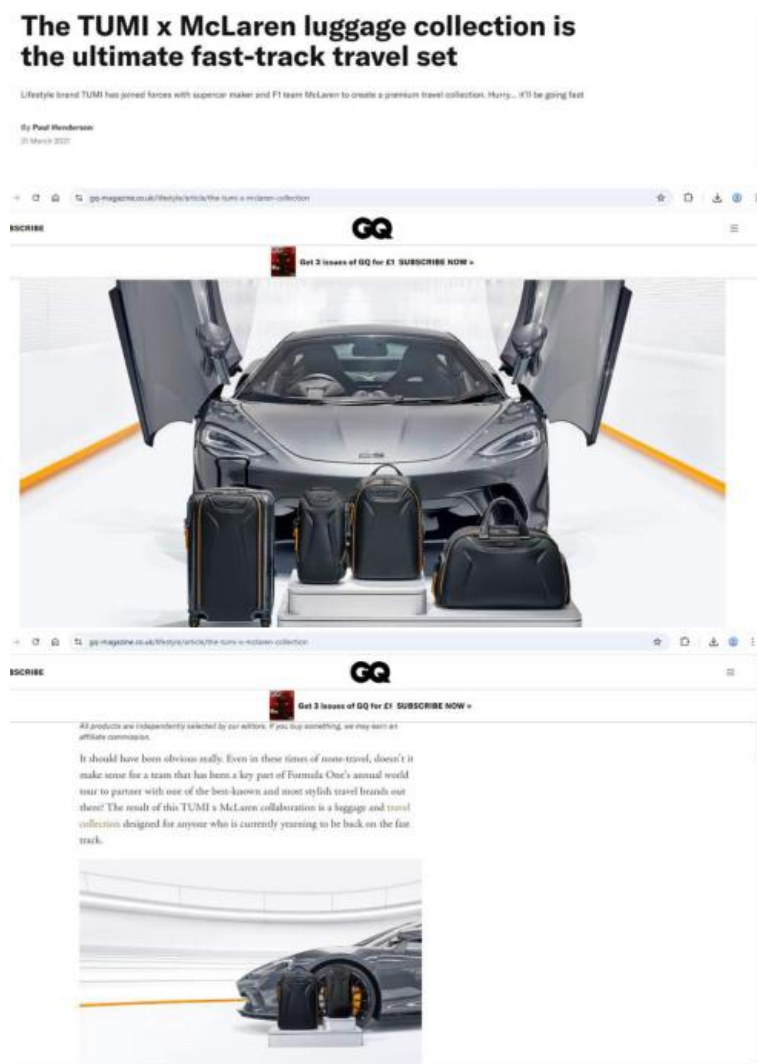
78. In its skeleton argument, the applicant said:

“It is admitted that the Opponent has filed evidence that proves it has acquired a reputation in the UK in relation to luggage, bags and related accessories.”

79. At the hearing, Ms Nicol said the opponent's reputation in its marks for luggage was “strong” and that the applicant accepts “reputation for Class 18, 35 in relation to the sale of luggage etc.”²² Looking at the turnover figures supplied by Mr Lamb in his third witness statement, the figures are insufficient to support enhanced distinctive character for any goods or services other than those for which reputation has been conceded. Although enhanced distinctive character and reputation are not the same thing, similar considerations apply. In the present case, the UK sales figures for class

²² Page 9 of the hearing transcript

18 goods are substantial. Close to US\$1million was spent on advertising TUMI goods in the UK between 2022 and 2024 in high profile locations, such as motorways, bus shelters, airports, shopping centres, London Underground stations, on the internet, on social media and in bricks and mortar stores. In 2023, the opponent launched a limited edition of TUMI luggage in collaboration with McLaren supercars, with publicity featuring the Formula 1 driver, Lando Norris.²³ It had already had a line of products in collaboration with McLaren in 2021:



80. In 2022, TUMI partnered with Tottenham Hotspur Football Club. In July 2023, the opponent opened its Knightbridge store, near to Harrods and Harvey Nichols. I find that the already high degree of inherent distinctive character has been enhanced

²³ Exhibit RAL20

further through the use made of the earlier marks in relation to the class 18 goods and retail thereof.

Likelihood of confusion

81. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. In this case, for the goods which I have found to be similar, the degree of similarity ranges from identical to similar to a low degree.

82. There are two types of confusion, direct and indirect.²⁴ Direct confusion occurs where marks are mistaken for one another, flowing from the principle that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them which has been retained in the mind. The earlier marks are distinctive to a high level inherently, and to a level higher still for luggage and retail thereof. Overall, there will be a medium level of attention paid to the purchase, which is primarily visual. Whilst the marks are only aurally similar to a very low degree and they are not conceptually similar, they are visually similar to at least a medium degree and the purchase is primarily visual. A key consideration is that the overall impressions of the parties' marks are dominated by word elements which look highly similar and have a very particular and distinctive shared stylisation. I consider that the visual differences between the marks, in what is primarily a visual purchase, will be sufficient to avoid direct confusion, but the factors I have outlined will lead, instead, to indirect confusion.

83. Indirect confusion was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *Back Beat Inc v L.A. Sugar (UK) Limited*, BL O/375/10:

²⁴ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: *“The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”*.”

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

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

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

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

84. That the three categories in that case are non-exhaustive was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and*

others.²⁵ Even where the goods are similar to a low degree I consider it likely that the average consumer will consider the presence of such a similar and highly stylised dominant element as alternative versions of the parties' marks, or a branding upgrade. The elements do not have to be the same to conclude that there is a likelihood of confusion. The TUMI and TOM elements of the marks could easily be mis-read. The way the letters flow into each other not only masks the differences between them but will be the feature which sticks most in the mind. The opponent has provided evidence from the applicant's website about how the applicant uses its mark (applied to luggage).²⁶



85. Use by the applicant of its own mark is paradigm use. In *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 at page 779, Neuberger J (as he then was) said:

“In my judgment, in the absence of argument or evidence to the contrary, the way in which the proprietor actually uses the mark can be said, at the very least *prima facie*, to be the paradigm case of its use in a normal and fair manner.”

86. Paragraph 11-086 of *Kerly's Law of Trade Marks and Trade Names* 17th Edition, says (footnote omitted):

²⁵ Ibid

²⁶ Mr Lamb's first witness statement, paragraph 48

“If in fact it is known what use an applicant intends to make of their mark, then consideration of that use cannot be excluded. Evidence that an intended use is particularly likely to be confusing is helpful to an opponent, to prevent such use being dismissed as unfair or fanciful.”

87. However, I do not need to see this to reach the conclusion that the first element of the applicant’s mark is easily mistaken for the earlier marks. If TOM in the later mark is perceived as the TUMI marks, any concept of Tom Cruise will be irrelevant because the average consumer will think that the words are TUMI CRUISER, and that CRUISER denotes a brand extension of travel goods, not least in relation to voyaging on cruises. Even if CRUISER does not trigger such a conceptual hook, the belief would be that nobody else other than the opponent or a linked undertaking would be using an element so very similar visually and distinctive (point (a) in *LA Sugar*). The similarities are so pronounced that the perception will be that they are not coincidental: there is an economic connection.

88. At the hearing, Ms Chantrielle submitted that the application plays on the name of the actor, Tom Cruise. The opponent did not raise the connection with Tom Cruise in its relative grounds pleadings (although it forms part of its section 3(6) pleadings). At the hearing, Ms Nicol submitted that the application will bring to mind the Hollywood actor, rather than the opponent, and that most consumers will see the application as an amusing play on words. I therefore consider this to be in issue between the parties. Although the previous paragraph is my primary finding, i.e. without reference to Tom Cruise, I also find that average consumers who read the application as TOM CRUISER, rather than TUMI CRUISER, will assume a collaboration with the Hollywood actor, whose fame I consider to be a notorious fact. The opponent’s evidence shows that the opponent has collaborated with McLaren supercars and Lando Norris, the Formula 1 driver, and with the English Premier League football club, Tottenham Hotspur. Collaborating with a Hollywood film star would fit with the opponent’s other choices of partners associated with famous and glamorous images. This is a further reason for finding indirect confusion, although the ground succeeds without it, for the reasons already given.

89. The section 5(2)(b) ground succeeds in relation to all goods which were opposed under this ground except for *boxer shorts; underpants; underwear/underclothing; shirt fronts; shirt yokes; layettes [clothing]; clothing containing slimming substances.*

Section 5(3)

90. Section 5(3) of the Act states:

“(3) A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

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

91. Section 5A states:

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

92. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12 P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

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

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *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 Saloman*, paragraph 29 and *Intel*, paragraph 63.

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

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

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

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

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

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

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

93. The goods and services relied upon for this ground for earlier marks (iii) and (iv) are underlined at paragraph 2 of this decision:

- earlier mark (iii): *Luggage, suitcases* (class 18); *Retail services, mail order services, Internet and on-line shopping services, wholesale services, all in relation to bags, cases, luggage, leather goods* (class 35)

- earlier mark (iv): *travelling bags; luggage*.

94. As detailed earlier in this decision, the applicant concedes a reputation for all these goods and services and, at the hearing, characterised the reputation in relation to the class 18 goods as strong.

95. This ground of opposition is directed at all the goods of the application. The opponent was able to rely upon the notional use of goods in classes 3 and 9 for section 5(2)(b), whereas under the present ground the goods and services for which it has a reputation are much narrower. Subsection (3A) states that section 5(3) applies “irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.” It is therefore not a bar to success under this ground that some of the goods of the application are not similar to the goods and services relied upon, although the relative distance between the parties’ goods and services are one of the factors which must be assessed in deciding whether the relevant public will make a link between the marks. Dissimilarity is a relative concept. The applicant’s goods (including scanners [apparatus] for performing automotive diagnostics), and the opponent’s goods are all consumer goods. The parties’ goods are not strikingly dissimilar; as opposed to, for example, luggage compared to chemicals for use in industry. The relevant public will be the general public.

96. The level of visual similarity and the strikingly distinctive nature of the earlier marks’ stylisation which is the same stylisation (albeit slightly different letters) as the dominant element of the applicant’s mark leads me to find that the relevant public, which is the general public, will make a link between the parties’ marks. The earlier marks have a, conceded, strong reputation for the class 18 goods and a reputation has also been conceded for the retail services relied upon. The earlier marks are strongly distinctive and appear to be unique. The earlier marks will be brought to mind on seeing the later mark in relation to any of the goods of the application. Even for dissimilar goods, the relevant public will believe that the strongly similar stylisation of the common elements, when the earlier marks have a strong reputation, is non-

coincidental and is a result of the parties being economically linked.²⁷ The previous comments about a collaboration with Tom Cruise, the actor, also apply here. Unfair advantage will follow because that confusion will give rise to more sales for the applicant than would otherwise have been the case.

97. In case I am wrong that there will be confusion, I nevertheless find that the use of the application will take unfair advantage of the reputation of the earlier marks. Ms Nicol, at the hearing, referred to the strong reputation of the earlier marks for luggage and “the high price point”. The image which comes through in the opponent’s evidence is that the opponent’s luggage is at the premium end of the market. I have already referred to the Knightsbridge store location and the collaboration with McLaren supercars and the F1 driver, Lando Norris. The goods are priced commensurately with the upscale or premium market position. Exhibit RAL07 shows a tote bag for sale for £595, a cosmetic bag for £230 and a backpack for £975. *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) is authority for the proposition that it is unnecessary to show that the applicant intends to cause confusion or to take unfair advantage: such a finding can be made on the basis of the objective effect of use of the later mark. In my view, the objective effect of the use of the applicant’s mark will be that it will benefit from the exclusive or luxury image of the opponent’s marks without having to make the marketing efforts which would otherwise have been necessary to gain sales which it will achieve as a result of the piggy-backing on the image of the earlier marks. This is unfair advantage, even if there is no confusion.

98. As earlier in this decision, the above is my primary finding; but there is also unfair advantage if there is a link made between the opponent’s marks and the application, even if no confusion, because of the so-called amusing play on words (as described by Ms Nicol at the hearing) with the name of the actor, Tom Cruise.²⁸ If sales are

²⁷ In *Intel*, the CJEU said at paragraph 57 that “... a link between the conflicting marks is necessarily established when there is a likelihood of confusion, that is to say, when the relevant public believes or might believe that the goods or services marketed under the earlier mark and those marketed under the later mark come from the same undertaking or from economically-linked undertakings (see to that effect, inter alia, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17, and Case C-533/06 *O2 Holdings and O2 (UK)* [2008] ECR I-0000, paragraph 59).

²⁸ In *Champagne Louis Roederer v J Garcia Carrion S.A. and others* [2015] EWHC 2760 (Ch), Mrs Justice Rose said, in finding unfair advantage, that: “97. It is clear to me from these examples that the use of the name has resulted in Cristalino drawing attention to itself, differentiating itself from other cavas by being associated with a premier champagne when it has done nothing to contribute to the

made because the later mark is seen as an amusing combination of the reputed earlier marks and the actor's name, that will be an unfair advantage. Those sales would not have been made without the marketing efforts of the opponent in promoting its marks.

99. As I have found unfair advantage (with and without confusion), I do not need to look at the other two types of damage.

100. The section 5(3) ground succeeds.

Section 5(4)(a)

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

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

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

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of

premier image of CRISTAL. The people on Flickr seem to have bought Cristalino rather than any other brand of cava so that they could post their photos and make the joke which, at base, is 'Look I'm pretending to be the kind of rich person who can drink Cristal champagne and I am using this bottle of Cristalino as a prop to make the joke'.

application for registration of the trade mark or date of the priority claimed for that application.”

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

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

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

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

105. The relevant date is the date on which the application was filed: 9 July 2024.²⁹ The evidence shows that the opponent, at the relevant date, had a strong and substantial level of goodwill in its business associated with the sign relied upon (which is the same as its earlier marks) in relation to the goods and services in class 18 and 35 for which the applicant has conceded use, and at least in relation to the goods and services for which a reputation has been conceded.

106. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

²⁹ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, case BL O/410/11, Mr Daniel Alexander QC, sitting as the Appointed Person

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to

show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.’

In the same case Stephenson L.J. said at page 547:

‘...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged “passer off” seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.’ ”

107. The opponent succeeded under its section 5(2)(b) ground against all but a few goods in class 25. It was able to rely upon the notional use of goods in classes 3 and 9, which is not the case for the passing off claim. The opponent's reputation which is conceded under section 5(3) is for the same goods and services upon which it may rely under the present ground. The applicant concedes that the reputation in the class 18 goods is strong, and I consider that this also applies to the opponent's level of goodwill, at least for the class 18 goods. The sign relied upon is strongly distinctive of the opponent's luggage business and appears to be unique. Even for strictly dissimilar goods, the opponent's customers and potential customers will believe that the strongly similar stylisation of the common elements, when the sign has such a strong level of goodwill, can only be as a result of the parties being economically linked.³⁰ The goods are all consumer goods. Shirt fronts, for example, are used in formal dress, and the evidence shows that the opponent's goods are sold in Knightsbridge, an area where formal dress is likely to be sold. The previous comments about a collaboration with Tom Cruise, the actor, also apply here, but there will be misrepresentation even without a belief in a collaboration with Tom Cruise if the first word element of the

³⁰ *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473

application is mis-read as the opponent's sign. Damage would follow; for example, damage to reputation if the goods were of inferior quality, high quality being a characteristic which is a key element of the opponent's goodwill. Furthermore, in the extract from *Harrods v Harrodian*, quoted above, the court referred to the judgment in *Stringfellow v McCain* regarding damage to the plaintiffs as against an innocent defendant in a completely different line of business. I am of the view that the application was not innocently made, as I shall go on to explain. It is not necessary for a finding of passing off that there was an intention to deceive. However, the stylisation of the applicant's mark appears to me to point strongly to an intention to benefit from the opponent's very substantial amount of goodwill. The House of Lords stated in *Office Cleaning Services v Westminster Office Cleaning* (1964) 63 RPC 39 that:

“Confusion innocently caused will yet be restrained. But if the intention to deceive is found, it will be readily inferred that deception will result. Who knows better than the trader the mysteries of his trade?” (at p. 42 per Lord Simonds).”

108. The section 5(4)(a) ground succeeds.

Section 3(6)³¹

109. Section 3(6) of the Act states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

110. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240], as follows:

“(i) [...]

³¹ This case was the subject of the second of two hearings held on the same day in relation to two applications by the same applicant for the same contested mark, albeit filed as separate applications in different classes. The other application (4062562) in class 18 was opposed by Samsonite IP Holding S.a.r.l. (opposition number 449897) solely under section 3(6) and was heard first. Both parties relied in the present case upon their submissions made in the first hearing as regards the section 3(6) ground.

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevenet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 (“*Malaysia Dairy*”), para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 (“*Sky CJEU*”), para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 (“*Koton*”), para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case ([*Hasbro*

Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening) (Case T-663/19) EU:T:2021:211 (“*Hasbro*”)], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant

had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

111. An allegation of bad faith is a serious one which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

112. I have set out at the beginning of this decision the opponent's table of marks belonging to third parties next to marks owned by the applicant which the opponent claims shows a pattern of filing trade mark applications incorporating elements from

third-party brands, in bad faith. Mr Lamb provides further examples in his witness statements. It suffices to show the table from his first witness statement:

Applicant's Trade Mark Application No.	Third Party Brand	Brand Owner	Example UK Trade Mark No. owned by Brand Owner
 (No. UK00004062562 and UK00004073404)	TOM CRUISE	Mr Tom Cruise	Unregistered Right
		The Chapel Hair & Spa Limited	UK00002635458
	 Calvin Klein	Tumi, Inc.	UK00903578143
Calvin Bags (No. UK00004062584)		Calvin Klein Trademark Trust	UK00002130032
 (No. UK00004073523)		C. & J. CLARK INTERNATIONAL LIMITED	UK00900167916
 (No. UK00004086885)		The North Face Apparel Corp.	UK00917919022
		Under Armour, Inc.	UK00906469266 and

(No. UK00004073464)			UK00904703799
 (No. UK00004073362)	TOMMY HILFINGER	Tommy Hilfiger Licensing, LLC	UK00801225683
 (No. UK00004062583)	AMERICAN TOURISTER	Samsonite IP Holdings S.a r.l.	UK00912463576
 (No. UK00004073465)	AMERICAN TOURISTER	Samsonite IP Holdings S.a r.l.	UK00912463576
 (No. UK00004086887)	ARMANI	GIORGIO ARMANI S.P.A.	UK00900504282
 (No. UK00004101886)	 and 	Samsonite IP Holdings S.a r.l.	UK00001006589 and UK00913610233
 (No. UK00004014271)	 and AMERICAN TOURISTER	Samsonite IP Holdings S.a r.l.	UK00912463535 and UK00912463576
 (No. UK00004014275)	AMERICAN TOURISTER and the Swiss National flag (protected under Article 6ter of the Paris Convention) and British Red Cross symbol	Samsonite IP Holdings S.a r.l. The Swiss Confederation The British Red Cross	UK00912463576 Unregistered Right Unregistered Right

	(protected under the Geneva Conventions Act of 1957)		
 (No. UK00004014566)		General Tools & Instruments Company LLC	Unregistered Right
 (No. UK00004014558)		McLane Company, Inc.	Unregistered Right
 (No. UK00004073407)		JNTL Consumer Health I (Switzerland) GmbH	UK00912152617 UK00004034144
 (No. UK00004073513)	Carla Fracci	Carla Fracci	Unregistered Right
 (No. UK00004073510)	Carla Fracci	Carla Fracci	Unregistered Right
 (No. UK00004091318)	 and CLARA CLARK	J&E Brothers Holdings, LLC	UK00003363683 and UK00918005089
 (No. UK00004101889)	EMIRATES and 	Emirates	UK00912333209 and UK00914230163
 (No. UK00004101892)	EMIRATES And 	Emirates	UK00912333209 and UK00914230163

 (No. UK00004129025)		Panasonic Holdings Corporation	UK00917789504
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113. A similar table appears in Mr Lamb's second witness statement, where he explains that, of the 24 examples in that table, 16 are the subject of opposition proceedings (one of them had not reached publication for opposition at that stage).

114. The applicant filed no evidence. For convenience, I repeat its denial of the ground in its defence and counterstatement here:

“48. The applicant denies the application was filed in bad faith. An allegation of bad faith is a serious allegation which must be distinctly proved. The opponent has not advanced any explanation on why it considers the application to be in bad faith other than pointing to other applications filed by the applicant. The opponent's claim of bad faith is not adequately pleaded as it does not explain why it considers the Applicant's behaviour in filing the current application to be dishonest.

49. The mere fact that a trade mark bears some similarity to another trade mark is not in itself a marker of bad faith. Indeed, many of the marks listed in Section D of the opposition could be construed as parodies. The right to publish parodies is an important aspect of free speech (Human Rights Act s12) and is not sufficient to amount to bad faith. It is not an inherently dishonest business practice to use a sign which brings another trader to the mind of some consumers in an amusing but inoffensive way (*Swatch AG v Apple Inc* [2021] EWHC 719 (Ch)).

50. It is denied that the applicant's conduct in filing the application was dishonest as the mark applied for is not confusingly similar to the opponent's earlier marks. Registration of the mark applied for would not in any way block or hinder the opponent's use of its marks. As advised in paragraphs 47 above [sic], many of the marks listed in Section D could be construed as parodies. Nonetheless, and irrespective of any co-pending marks that the applicant has filed, there is nothing intrinsically wrong with the applicant filing the current application as it would not be confused with the opponent's marks. The applicant has a bone fide intention to use the mark on the goods in question.

51. The Section 3(6) grounds [sic] must fail.”

115. Of course, I have found that the marks are “confusingly similar”: partially under section 5(2)(b) and against the entire application under sections 5(3) and 5(4)(a).

116. The applicant is correct in submitting that the fact that a trade mark bears some similarity to another trade mark is not, per se, a marker of bad faith. However, the opponent's statement of grounds and evidence about the applicant's other applications show that the contested mark is not the first or only of the applicant's marks to bear more than a passing resemblance to third parties' trade marks. It is a notorious fact that at least some of the marks highlighted by the opponent have a reputation in the UK, such as Armani, The North Face and Under Armour (for clothing). The Calvin Bags mark has the same font as Calvin Klein, as does the 'Clark' element of the applicant's Clark & Mark application compared to the well-known mark Clarks, for shoes. Such evidence can show a pattern of behaviour which may lead to a conclusion that a mark has been applied for in bad faith. The opponent's evidence that 16 out of 24 applications have been opposed is, in this context, not irrelevant (contrary to the applicant's submissions).

117. In its written submissions, the applicant says that the contested application "At best, amounts to nothing more than a play on words or gentle and affectionate teasing". This seems to me to be an admission that there is some similarity with a third-party mark or brand. The applicant states in its defence that many of the marks listed in the opponent's table "could be construed as parodies". It relies upon *Swatch AG v Apple Inc* [2021] EWHC 719 (Ch) for its proposition that it is not bad faith to apply for parodies as trade marks. In that case, Apple had objected to Swatch's application for ONE MORE THING, which was a phrase associated with Apple's CEOs when making announcements at industry events, to the point that compilations of ONE MORE THING moments had been made by Apple 'fans' on YouTube. Parody was one of the legs to Apple's bad faith ground. The present case can be distinguished from the *Swatch AG v Apple Inc* case. Two of the considerations of Mr Iain Purvis QC, sitting as a Deputy judge of the High Court, were that there was "no evidence that Swatch had made a practice of parodic advertising in the past, against any party, let alone Apple" and that it was "not clear how the suggested parodic use of the mark would be effective when, on the Hearing Officer's findings, it was only associated with Apple by only a small number of people."³² In the present case, there is a pattern of

³² Paragraph 44, points (iii) and (iv)

previous filings of marks which are similar to those of third parties, and those third-party marks have a reputation amongst the general public in the UK.

118. The applicant characterises parodical marks as signs which bring another trader to the mind of some consumers in an amusing and inoffensive way, which is taken from *Swatch AG v Apple Inc*:

“52. 'Poking fun' and 'parody' cover a multitude of possibilities from gentle and affectionate teasing to full-frontal attacks. I do not consider that it is an inherently dishonest business practice to use a sign which brings another trader to the mind of some consumers in an amusing but inoffensive way. Such an activity would not necessarily undermine the interests of the third party in any material way. The point at which parodic or humorous activity of that kind would transgress the boundaries of honest business practices must depend on the nature of the humour, the intensity of its use and its consequent impact on the business interests of the recipient.

[...]

54. (i) [...]

(ii) He [the Hearing Officer] then makes the point that using a mark as part of a parody of another trader is difficult to reconcile with the use of the marks in accordance with their essential function, of indicating the commercial source of the goods. But, again, this must depend on the actual use in question. Using a phrase in a humorous parodic skit may well not be trade mark use. However, I do not see why a mark may not have parodic character whilst at the same time being perfectly capable of functioning as a trade mark. For example DUNK DIFFERENT could be a perfectly good trade mark for biscuits, whilst no doubt conjuring up for some people a wry or even amusing allusion to Apple's famous slogan.”

119. It is undeniable that the table reveals the applicant has filed other applications which are similar to or strongly reminiscent of famous third-party brands. The applicant does not deny it: in fact, it states that “many of the marks listed in Section D of the opposition could be construed as parodies.” Similar fact evidence was considered in *Trump International Ltd v DTTM Operations LLC* [2019] EWHC 769 (Ch). The controlling mind behind the applicant in that case was shown to have a history of applying for trade marks without any intention to use them, including famous third-party marks, and of being involved in numerous trade mark proceedings in the UK and elsewhere. The application for the trade mark TRUMP TV was found to have been made in bad faith. Carr J said:

“In relation to allegations of copyright infringement, it is necessary to decide, as a matter of fact, whether copying has occurred. As with claims of bad faith, direct evidence of copying is rarely available. In this context, it is well established that similar fact evidence may be admissible.” The case law is considered in *Copinger and Skone James on Copyright*, Vol 1, 17th Edition at [21-393]:³³

“...where the issue in a copyright case is whether the similarity between the claimant's work and the defendant's work is due to copying or is a coincidence, it is relevant to know that the defendant has produced works which bear a close resemblance to works other than the work in question which are the subject of copyright. Whereas similarity between two works might be mere coincidence in one case, it is unlikely that there could be coincidental similarity in, say, four cases. The probative force of several resemblances together is much better than one alone

This reasoning may well apply, depending on the facts, to an allegation that a third-party trade mark has been applied for in bad faith. The probative force of several instances of such applications, by the same or a connected party who has applied to register a third-party trade mark, is obvious. Such instances, if

³³ At [42].

based on solid grounds, are likely to require evidence from the applicant to refute the inference of bad faith that may otherwise be drawn from them.”

120. Turning back to the submission that the applicant’s mark is, at best, a play on words or gentle and affectionate teasing, as an isolated instance, there may be no bad faith. However, there is a pattern of behaviour, as in the *TRUMP TV* case, and I consider that the wording of the counterstatement implicitly acknowledges that there has been a pattern of behaviour of applying for marks which are similar to those of third parties. If they were not similar to the marks of third parties, the applicant’s other applications could not be parodies. There must be similarities for the parody to work. So, this must be an acceptance by the applicant that it has made several applications for marks which are similar to those of third parties (whether or not they actually are parodies). The present case not only includes a dominant element which is highly similar to the earlier marks but also includes a ‘TC’ logo which is highly similar to another party’s trade mark (as set out in the opponent’s tables).³⁴ This cannot be a coincidence.

121. *Paper Stacked Ltd v CK Holdings NV* (“*Alexander Trade Mark*”) was a case involving the same controlling mind as in the *Trump TV* case. Mr Geoffrey Hobbs QC, sitting as the Appointed Person, upheld the Hearing Officer’s finding of bad faith.³⁵ At paragraph 35 of his decision (quoted at paragraph 25 of Mr Hobbs’ decision), the Hearing Officer said:

“Taken together with the opponent’s evidence that (1) none of the marks applied for in the UK (or US) appear to have been used, (2) the absence of any apparent commercial logic for the filing pattern of the applicant and/or Mr Gleissner’s other companies, and (3) the evidence that companies controlled by Mr Gleissner have been found to have abused legal systems, I find that opponent has also made out a prima facie case that, at the time of filing the

³⁴ *Paper Stacked Ltd v CK Holdings NV* (“*Alexander Trade Mark*”), Case BL O/036/18, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, regarding the absolute nature of section 3(6), at [19]: “Since there is no requirement for the objector to be personally aggrieved by the filing of the application in question, it is possible for an objection to be upheld upon the basis of improper behaviour by the applicant towards persons who are not parties to the proceedings provided that their position is established with enough clarity to show that the objection is well-founded.”

³⁵ *Ibid*

application, the applicant had no intention of using the mark in accordance with its essential function. That is to say using the mark to distinguish the goods/services of the applicant from those of other traders.”

122. In the present case, the applicant has implicitly admitted that it has applied for several trade marks which are similar to those of third parties for the reasons I have given above. It is the nature of those applications which is key: they mimic the marks of third parties. It cannot be a coincidence that the mark contains the TC logo (of a third party) and a dominant element which is extremely similar to the opponent’s earlier marks when viewed alongside its other applications which ape the trade marks of third parties. The applicant has given no indication that any of them have been used because it has not filed evidence. A submission from its legal representatives that it has a bona fide to use its mark is not evidence and has no weight. In the *Alexander* case, Mr Hobbs said this:

“7. CKL’s [the applicant’s] case as presented in these submissions was that the evidence tendered by the opponent established no basis sufficient in point of fact or in point of law to justify rejection of the contested application for registration on the ground of bad faith. Having chosen to file no evidence directed to the specifics of the facts and matters relied on by the opponent, CKL was, in essence, asking the Registrar to say that it had no case to answer.”

123. The applicant in the present case has chosen the same course of action. In *Accessible Labs Ltd v Rui Qu (Shanghai) Enterprise Management Consulting Company Limited*, Mr Daniel Alexander KC, sitting as the Appointed Person, said:³⁶

“43. Third, *SkyKick* notes that the application of the law presents evidential difficulties. It is rare that an opponent to a trade mark application mark will have direct evidence that the applicant intended to do so for reasons which do not accord with the proper objects of securing trade mark registration. Lord Kitchin said in *SkyKick* at [154]:

³⁶ Case BL O/0534/25.

“It may be very difficult for a claimant seeking a declaration of invalidity of a registered trade mark to prove the subjective intention or motive of the applicant in filing the application to register that mark in respect of particular goods and services. Accordingly, from the earliest consideration of this issue by the CJEU, it has been recognised that this subjective aspect of the objection will generally have to be established by reference to what have been described as relevant, consistent and objective criteria.””

124. In *Skykick*, the Supreme Court stated at paragraph 240 that:

“(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).”

125. I consider that there is a *prima facie* case to answer. The opponent has pointed out the applicant’s pattern of filing marks which ape those of third parties and, in the light of that pattern, the non-coincidental inclusion of an element so similar to its own marks. This combination of factors is sufficient to raise a *prima facie* case. In *Maya Appliances Pvt. Ltd v Prapaharan Sivaratnam*, Mr Iain Purvis KC, sitting as the Appointed Person, said:³⁷

“27. It is obviously wrong to expect a party to Cancellation proceedings to be able to give direct evidence of the motivation of someone who has adopted their mark. All they can reasonably be expected to do in the vast majority of cases is to make inferences from the objective facts and invite the other party to respond to this. If they establish a *prima facie* case consistent with bad faith, then in the absence of a response from the other party the Cancellation should succeed.

³⁷ Case BL O/0052/25: the decision concerned cancellation proceedings, but the law is no different in relation to an opposition under section 3(6)

126. In the present case, the opponent has done all that it was able to do, in the circumstances of the case. As the opponent has met the burden of raising a prima facie case, it has rebutted the presumption of good faith. It is incumbent on the applicant to explain and provide a plausible explanation for the contested application. It has made no attempt to do so in evidence. In *Accessible Labs Ltd*, Mr Alexander said:

“45. ... as Lord Kitchin said in *SkyKick* at [235] and [252]:

“235. I recognise that an inference that an application to register a trade mark was made in bad faith may be displaced by an explanation of an appropriate commercial rationale for making it. In my opinion, however, a failure to provide any satisfactory explanation may reinforce the inference and provide further support for a finding of bad faith.

...

252. I recognise that such an applicant, when given an appropriate opportunity, may provide a reasonable explanation and justification for its actions and in that way answer and dispel any inference that it made the application in bad faith. If, however, it fails to do so, it is in my view open to the tribunal to find that the application was indeed made in bad faith in respect of those goods and services.”

46. *SkyKick* therefore reinforced the importance of a satisfactory explanation for making a UK trade mark application in circumstances where an inference that the mark was applied for in bad faith appeared justified, prima facie. Key questions are therefore (a) whether an explanation was provided at all and (b) whether the hearing officer had sufficient basis to find that the explanation provided was unconvincing with respect to motivation in applying for the mark and in particular intention to use it in the UK, taking the evidential picture as a whole.

47. As to that, the case law from the Court of Appeal prior to *SkyKick* suggests that where, in principle, evidence from those with knowledge of intention is available, it is reasonable to expect it to be adduced to rebut a prima facie case of bad faith. That proposition is supported by *Lidl Great Britain Ltd & Anor v*

Tesco Stores Ltd & Anor (Rev1) [2024] EWCA Civ 262, where Arnold LJ said at [180] of one of the grounds of appeal (namely that it was not realistic for the judge to expect that either witness testimony or documentary evidence would be available to explain Lidl's intentions) that despite the passage of time, the applicants for registration were best placed to explain their intentions. The court expected a proper explanation.

48. In the light of these authorities, where there is evidence from which it is proper to infer that an application for registration has been made in bad faith (on the basis that it was not applied for to protect one or more of the legitimate functions of a trade mark) an applicant can reasonably be expected to provide a sufficiently coherent explanation for the application specifically in the UK including as to its scope. An applicant may be able to justify the application (including its scope) on the basis of credible evidence as to its purposes in making it, for example by reference to the width of the underlying business, actual or reasonably contemplated, which the trade mark is intended to protect. If no adequate or sufficiently credible explanation is provided or one which justifies the UK application, there may be a proper basis for a finding of bad faith in whole or in part.”

127. The objective, relevant and consistent indicia point towards a conclusion that the application was made in bad faith and the applicant has not rebutted that conclusion. There is no evidence from the applicant as to how it arrived at a mark which includes elements so similar to those of third parties, especially in the context of its other applications, and no evidence of its commercial plans for the mark. In paragraph 240 of its *Skykick* judgment, the Supreme Court said:

“(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).”

128. The applicant has failed to rebut the prima facie case. The application constitutes an intention to take advantage of the trade mark registration system. The application was filed with the intention of undermining, in a manner inconsistent with honest practices, the interests of the opponent by causing conflict, as shown by the number of other applications which have caused oppositions, without countering that conclusion with evidence of a bona fide intention to use the mark. This behaviour is an abuse of the trade mark system. It is contrary to the objective of a trade mark registration, as set out in *Skykick* at paragraph 240 (iv):

“... the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin ...”.

129. I have not taken into account Ms Chantrielle's submission at the hearing that the application is an attempt by the applicant to register a mark which is similar or close enough to allow it to ride on the coat tails of the opponent's reputation because that was not pleaded.

130. Even if the contested mark has been filed as a parody, it is not a one-off like the *Swatch* case. The number of trade mark applications which ape marks of third parties and have caused conflict means that the applicant cannot avail itself of a defence of parody when it is abusing the trade mark registration system. I do not, therefore, need to consider the applicant's references to freedom of speech.

131. The section 3(6) ground succeeds.

Overall outcome

132. The opposition succeeds. The application is refused.

Costs

133. The opponent has been successful and is entitled to an award of costs, based on the scale published in Tribunal Practice Notice 1/2023. I have reduced the award to take into account that the opponent was unsuccessful at a case management conference (“CMC”) at which it sought suspension of these proceedings pending the outcome of another case. The applicant successfully resisted suspension. I award costs in favour of the opponent as follows:

Fee for Form TM7	£200
Preparing the notice of opposition and considering the counterstatement	£400
Preparing evidence	£1000
Attendance at the hearing	£800
Minus the CMC	-£200
Total	£2200

134. I order Abdulwahed Bin Shabib Distribution to pay to Tumi, Inc. the sum of £2200. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of July 2026

Judi Pike
For the Registrar