

O/0741/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003907744

BY LAPA NETWORK TECHNOLOGY CO., LTD

TO REGISTER THE TRADE MARK:

OSOS

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 443716 BY

ASOS PLC

BACKGROUND AND PLEADINGS

1. On 4 May 2023, LAPA Network Technology Co., Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 21 July 2023 and registration is sought for the following goods:

Class 25 Nightwear; Maternity clothing; Knitted clothing; Evening dresses; Clothing for men, women and children; Clothing for babies; Swim wear for gentlemen and ladies; Men's and women's jackets, coats, trousers, vests; Swimsuits; Dresses; Pants; Outerwear; Skirts; Tops; T-shirts; Shirts; Tank tops; Bras; Pullovers; Ladies' suits.

2. On 20 October 2023, the application was opposed by ASOS plc (“the opponent”) based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Under both grounds of opposition, the opponent relies upon the following trade marks:

ASOS

UKTM no. 3197152

Filing date 16 November 2016; registration date 2 June 2017

(“the First Earlier Mark”)



UKTM no. 3207900

Filing date 20 January 2017; registration date 6 October 2017

(“the Second Earlier Mark”)

(together “the earlier marks”)

3. Under both grounds of opposition, the opponent relies upon only the goods and services in classes 14, 18, 25 and 35 of the earlier marks. This includes, *inter alia*, “clothing” in class 25.

4. Under section 5(2)(b) of the Act, the opponent claims that the marks are similar, and the goods and services are identical or similar, with the result that there is a likelihood of confusion.

5. Under section 5(3) of the Act, the opponent claims that its earlier marks have a reputation for all goods and services in classes 14, 18, 25 and 35 and that use of the applicant’s mark would, without due cause, take unfair advantage of, and/or be detrimental to, the reputation and/or distinctive character of the earlier marks. Again, the goods and services relied upon include, *inter alia*, “clothing” in class 25.

6. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use of the earlier marks in respect of, *inter alia*, “clothing”.

7. Neither party requested a hearing, and only the opponent filed written submission in lieu. This decision is taken following a careful consideration of all of the papers on file.

REPRESENTATION

8. The opponent is represented by Stobbs.

9. The applicant is represented by Marcin Ociepka.

EVIDENCE AND SUBMISSIONS

10. Only the opponent filed evidence. This took the form of the witness statement of Amy Elizabeth Toms, dated 26 April 2024. This evidence is accompanied by 13 exhibits (EXH1 to EXH13). Ms Toms is the Head of Trade Marks for ASOS.com Limited, which is a wholly owned subsidiary of the opponent. She has held this position

since September 2022, prior to which she was a Trade Mark Attorney (and subsequently a Senior Trade Mark Attorney) for the same company since September 2016.

11. The opponent filed written submissions in lieu dated 24 September 2024.

RELEVANCE OF EU LAW

12. 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.

DECISION

13. Given their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier marks pursuant to section 6 of the Act. As they had completed their registration process more than 5 years prior to the filing date of the application in issue, they are subject to the use provisions in section 6A of the Act. Consequently, I will begin by assessing whether the earlier marks have been put to genuine use.

Proof of Use

14. The relevant statutory provisions are as follows:

“6(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.”

15. Section 100 of the Act is also relevant, which reads:

“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.”

16. The relevant period for assessing genuine use is the five-year period ending with the filing date of the application in issue i.e. 5 May 2018 to 4 May 2023.

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

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

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

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

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

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

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

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

19. Ms Toms gives evidence that the brand, ASOS, was first used in 2002. The Second Earlier Mark has been used as registered during the relevant period, but also in black on different colour backgrounds, such as:¹



The Second Earlier Mark appeared on product packaging and on the opponent's website.² The First Earlier Mark has been used on the opponent's website.³

20. The first range of products launched by the opponent was women's clothing, which was launched between 2003 and 2004. It launched a range of clothing for men in 2007. In the evidence, there is reference to, *inter alia*, dresses, jeans, tops, skirts, trousers, occasion wear, jackets, jumpsuits, blazers, playsuits, bikinis, sweatshirts and rugby shirts.⁴ Whilst there are more examples of women's clothing, I note that both men and women's clothing has been offered for sale throughout the relevant period. I note that they also sell beauty products, footwear and a range of fashion accessories.⁵

21. In the years 2018 through 2022 respectively, the opponent had over 17million, 19million, 21million, 24million and 27million UK-based registered users. Of these, over 15million, 17million, 19million, 22million and 24million made purchases through ASOS.com.⁶ The opponent's financial years run from 1 September to 31 August. The following retail sales value figures for the UK have been provided:

2018/2019	Over £1.7billion
2019/2020	Over £1.9billion

¹ EXH 7

² EXH 6

³ EXH 6

⁴ EXH 6

⁵ See paragraphs 23 and 25 of Ms Tomas' statement.

⁶ See paragraph 19 of Ms Toms' statement.

2020/2021	Over £2.4billion
2021/2022	Over £2.8billion

22. ASOS was the number one fashion site for under 35s in the UK in financial year 2022.⁷ In terms of marketing spend, I have only been provided with worldwide figures (as opposed to UK-specific figures). However, these are in the 100s of billions of pounds for each year during the relevant period. Clearly, even if only a proportion of these figures relate to the UK market, this would represent a significant investment.⁸ I also note that ASOS promotes its brands via social media; in the UK alone, it had over 1.5million followers on Facebook and over 2.6million on Instagram.⁹

23. I bear in mind that the opponent's goods are not limited to clothing alone. However, given that the first product line launched by the opponent was women's clothing, and that men's clothing followed shortly after, it seems a reasonable inference to draw that a significant proportion of the above figures relate to the opponent's sales of women's and men's clothing. In my view, there can be little doubt given the evidence summarised above, that the opponent has put both earlier marks to genuine use during the relevant period in relation to clothing for both men and women.

24. I have considered whether the opponent should be entitled to rely upon the term "clothing" or whether this should be limited to clothing for men and women. However, in my view, it should be able to rely on the broader term given the breadth of the use shown across more than one category of clothing in the evidence. Consequently, I consider a fair specification to be:

Class 25 Clothing.

Section 5(2)(b)

25. Section 5(2)(b) of the Act reads as follows:

⁷ See paragraph 45 of Ms Toms' statement.

⁸ See paragraph 46 of Ms Toms' statement.

⁹ See paragraph 48 of Ms Toms' statement.

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

(a)...

(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.”

26. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, is not sufficient;

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

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

Comparison of goods

28. As noted above, the opponent has relied upon all of the goods and services for which the earlier marks are registered in classes 14, 18, 25 and 35. However, I have included only the term that I consider necessary for the purposes of my comparison in the table below. With that in mind, the competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 25</u> Clothing.	<u>Class 25</u> Nightwear; Maternity clothing; Knitted clothing; Evening dresses; Clothing for men, women and children; Clothing for babies; Swim wear for gentlemen and ladies; Men's and women's jackets, coats, trousers, vests; Swimsuits; Dresses; Pants; Outerwear; Skirts; Tops; T-shirts; Shirts; Tank tops; Bras; Pullovers; Ladies' suits.

29. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

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

30. In my view, all of the goods in the applicant's specification fall within the term "clothing" in the specifications of the earlier marks. As such, they are identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

31. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

32. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

33. The average consumer for the goods is a member of the general public. The goods are likely to vary in price and are likely to be reasonably frequent purchases (although not everyday purchases). Factors such as fit, aesthetics and comfort are likely to be taken into account when purchasing the goods. Consequently, I consider that a medium degree of attention will be paid during the purchasing process for the goods.

34. The goods are likely to be self-selected from the shelves of a retail outlet or online equivalents. Consequently, visual considerations will play the greater role in the purchasing process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants.


Comparison of trade marks

35. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impression created by the trade 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.”

36. It would be wrong, therefore, to dissect the trade marks artificially, although 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.

37. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p data-bbox="336 1626 655 1715">ASOS (the First Earlier Mark)</p>  <p data-bbox="312 1966 679 2002">(the Second Earlier Mark)</p>	<p data-bbox="1050 1626 1145 1662">OSOS</p>

Overall Impression

38. The applicant's mark and the First Earlier Mark are word only marks. The overall impression lies in each word/acronym respectively.

39. The Second Earlier Mark consists of the word ASOS presented in a lower case white font, on a black background. The word ASOS plays the greater role, with the stylisation playing a lesser role.

Visual Comparison

40. The applicant's mark and the First Earlier Mark overlap in the last three letters – SOS. However, they differ in that the first letter of the First Earlier Mark is the letter A, whereas the first letter of the applicant's mark is the letter O. I bear in mind that both marks are word only marks which could be used in any font. I also accept the applicant's submissions that the average consumer tends to pay more attention to the beginning of marks than the ends and that differences in shorter marks have more of an impact.¹⁰ In my view, the marks are visually highly similar.

41. The same is true of the Second Earlier Mark and the applicant's mark. I bear in mind that the applicant's mark is a word only mark which could be used in any font. I also note that the font used in the Second Earlier Mark, means that the letter A (in lower case) bears a resemblance to the letter O. In my view, the marks are visually highly similar.

Aural Comparison

42. Both earlier marks will be pronounced the same, either as an acronym with each letter being pronounced individually, or as a word (either with the first letter being pronounced AAA (as in 'hay') or AHH (as in 'apple')). The applicant's mark will also either be pronounced as an acronym, with each letter being pronounced individually,

¹⁰ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 and *MANDO* T-792/17

or as a word (with the first letter pronounced as OW as in 'bow' or OHH as in 'ordinary'). Either way, I consider the marks to be aurally similar to at least between a medium and high degree.

Conceptual Comparison

43. Whether the marks are perceived as invented words or as acronyms, I do not consider that any meaning will be attributed to them. Whilst I note Ms Toms' explanation that the brand ASOS began as "as seen on screen", I consider it unlikely that this meaning will be understood by the average consumer. Consequently, I consider the conceptual position to be neutral.

Distinctive character of the earlier marks

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

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

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

46. The First Earlier Mark consists of the letters ASOS. As noted above, this will either be viewed as an invented word or as an acronym. If it is viewed as an invented word, then it will be highly distinctive. If it is viewed as an acronym, then it will be inherently distinctive to a medium degree. The Second Earlier Mark is the same as the First Earlier Mark, but with additional stylisation. In my view, the same findings would apply in relation to this mark.

47. I will now consider whether the distinctiveness of the earlier marks has been enhanced through use. I have summarised the opponent’s evidence of use above. In my view, bearing in mind the longevity and intensity of the use that has been made of the earlier marks, the number of customers in the UK, the number of sales made and the investment in promoting the earlier marks, the distinctiveness of the earlier marks has been enhanced through use in relation to clothing. In my view, this will result in both of the earlier marks being distinctive to either a high or very high degree (depending on whether the starting position was medium or high) in relation to clothing.

Likelihood of confusion

48. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between them and the goods down to the responsible undertaking being the same or related. There is no scientific formula to apply in determining the likelihood of confusion, rather it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity

between the goods may be offset by a greater degree of similarity between the marks, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing act. In doing so, I must be alive to the fact that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

49. I have found as follows:

- a. The goods are identical.
- b. The average consumer for the goods is a member of the general public who will pay a medium degree of attention during the purchasing process.
- c. The purchasing process is predominantly visual, although I do not discount an aural component to the purchase.
- d. The marks are visually highly similar and aurally similar to (at least) between a medium and high degree. The conceptual position is neutral.
- e. The earlier marks are inherently distinctive to either a medium or high degree (depending on whether they are perceived as an acronym or invented word), which has been enhanced through use to either a high or very high degree in relation to clothing.

50. Bearing in mind the similarities between the marks, the distinctiveness of the earlier marks and the identity of the goods, I consider it likely that the marks will be mistakenly recalled or misremembered as each other. This is particularly the case given that the average consumer tends to see what he expects to see; consequently, when confronted with a similar mark for goods that are identical to those for which the distinctiveness of the earlier marks has been enhanced, the average consumer is likely

to misremember the ASOS and OSOS elements.¹¹ I find there to be a likelihood of direct confusion in respect of both the First and Second Earlier Marks.

51. To the extent that presentational differences are noted in the Second Earlier Mark (i.e. the stylisation in the Second Earlier Mark), this will simply be viewed as another mark being used by the same or economically linked undertaking. The elements ASOS v OSOS will still be misremembered, one for the other, particularly given that the font used in the Second Earlier Mark makes the A more similar to the letter O. I find there to be a likelihood of indirect confusion.

52. The opposition based upon section 5(2)(b) of the Act is successful.

Final remarks

53. For the avoidance of doubt, my findings would have been the same even if I had limited the opponent's specification to only clothing for women and/or clothing for men. This is because the goods in the parties' respective specification would still have been identical or highly similar and any limited distance between the goods would be offset by the similarity of the marks and the distinctiveness of the earlier marks. As a result, I would still have found a likelihood of direct and indirect confusion.

Section 5(3)

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

“5(3) A trade mark which -

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

¹¹ *Kennedy Fried Chicken*, Case BL O/227/04

55. Section 5(3A) of the Act states:

“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.”

56. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors, Case 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 C383/12P, 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) 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*.

(g) 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*.

(h) 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*.

(i) 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*).

57. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks and the applicant's mark are similar. Secondly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the earlier marks being brought to mind by the later mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Similarity of the marks

58. I have already found the marks to be similar for the reasons given above.

Reputation

59. I bear in mind the guidance of the CJEU in *General Motors*, Case C-375/97. Whilst enhanced distinctiveness and reputation are different, the factors relevant to both assessments are the same. For the same reasons given above, I consider that the opponent had a strong reputation in the UK for clothing at the relevant date.

Link

60. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

The marks are visually highly similar and aurally similar to (at least) between a medium and high degree. The conceptual position is neutral.

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

I have found the goods to be identical.

I apply the same findings in relation to the relevant public and purchasing process as set out above.

The strength of the earlier mark's reputation

The earlier marks have a strong reputation for clothing in the UK.

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

The earlier marks are inherently distinctive to either a medium degree or a high degree, depending upon how they are perceived. This has been enhanced through use in relation to clothing to either a high degree (where the starting point was medium) or very high degree (where the starting point was high).

Whether there is a likelihood of confusion

I have found there to be a likelihood of direct confusion (for both earlier marks) and indirect confusion (for the Second Earlier Mark).

61. Taking into account all of these factors, particularly the strength of the opponent's reputation, the identical goods and the similarity of the marks, I consider that a link will be made in the mind of the relevant public.

Damage

62. I must now consider whether any type of damage pleaded will arise.

Unfair advantage

63. In its Form TM7, the opponent states as follows:

“14. [...] Such use would constitute parasitism or free-riding, [...].

16. [...] use of the Application would give an unfair and undeserved boost to the Applicant’s business. The Applicant is seeking to take a ‘free ride’ on the investment of the Opponent in promoting and building up goodwill for its trade mark, in order to stimulate demand for the Applicant’s class 25 goods to an extent that is disproportionately high in comparison with the size of its promotion investment.”

64. To the extent that the relevant public believe that the goods of the applicant are the goods of the opponent, there will plainly be unfair advantage. Further, the evidence shows that the opponent had invested heavily in promoting the earlier marks and so it is clear that there is potential for the applicant to gain an unfair advantage, by benefitting from that investment, without having to invest in its own marketing activities. Ms Toms’ unchallenged narrative evidence is that the opponent focuses on “cutting edge fashion”, which is clearly an image that can be transferred.¹²

65. As I have found there to be unfair advantage, I do not need to consider the other pleaded heads of damage.

66. The opposition based upon section 5(3) of the Act succeeds.

CONCLUSION

67. The opposition is successful and, subject to any successful appeal, the application is refused.

¹² Paragraph 27 of Ms Toms’ statement.

COSTS

68. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of **£2,300**, calculated as follows:

Preparing a Notice of opposition and considering the applicant's counterstatement	£450
Preparing and filing evidence	£1,200
Written submissions in lieu	£450
Official fee	£200
Total	£2,300

69. I therefore order LAPA Network Technology Co., Ltd to pay ASOS plc the sum of **£2,300**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 7th day of August 2025

S WILSON

For the Registrar