O/0776/24

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3594999

IN THE NAME OF STEPHEN WILLIAM CRAIG & BARNEY RODGERS

AND

OPPOSITION THERETO UNDER NO. 429349

BY DUNE BRAND LIMITED

Background and pleadings

1. On 12 February 2021, Stephen William Craig and Barney Rodgers ("the applicants") filed trade mark application number 3594999 for the word mark "DNE" ("the contested mark"). The application concerns the following goods and services:

> Class 18: Bags, handbags, tote bags, valises, shoulder bags, satchels, vanity cases, beach bags, bum bags, sports bags, rucksacks, trunks, travelling bags, suitcases, luggage; wallets, purses, credit card holders, key cases, belts, umbrellas; parts and fittings for all the aforesaid goods.
>
> Class 25: Articles of clothing, footwear and headgear, including caps, hats and belts; menswear, womenswear.
>
> Class 35: Retail and on-line retail and store services connected with the sale of bags, handbags, tote bags, valises, shoulder bags, satchels, vanity cases, beach bags, bum bags, sports bags, rucksacks, trunks, travelling bags, suitcases, luggage, wallets, purses, credit card holders, key cases, belts, umbrellas; retail and on-line retail and store services connected with the sale of articles of clothing, footwear and headgear, including caps, hats and belts, menswear and womenswear; provision of advertising space including in an on-line context; sales promotion for others; import and export services; business management and business consultancy services including in relation to the clothing and fashion sectors; provision of information and advisory services relating to the aforesaid services.

2. The application for registration is opposed by Dune Brand Limited ("the opponent"). The opposition is based on ss. 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). It is directed under each of these grounds against all of the goods in the contested mark's specification. The opponent relies on the following trade marks under ss. 5(2)(b) and 5(3):

Trade mark number	Trade mark	Relevant dates	Specification relied upon
UK905276175 "(UK175")	DUNE	Filing date: 4 August 2006 Registration date: 19 November 2007	Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas; handbags; purses; wallets; leather belts. Class 25: Clothing, footwear, headgear. Class 35: The bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a retail outlet store or from an Internet web site or via mail order or catalogues all specialising in clothing, footwear, headgear, fashion accessories and leather goods.
UK1431627 ("UK627")	DUNE	Filing date: 10 July 1990 Registration date: 10 April 1992	Class 25: Shoes, boots, slippers; footwear; all included in Class 25.

3. The opponent asserts that the marks at issue are highly similar and that the goods and services are identical or highly similar. It says that the earlier mark has enhanced distinctive character through use and submits that there is a likelihood of confusion, including the likelihood of association. Consequently, it asks that the application for the contested mark be refused under s. 5(2)(b).

4. The opponent also asserts that both of the above earlier marks have an "extremely strong" reputation. It says that this, combined with the similarity between the marks and the identity or similarity between the goods and services, will cause the average consumer to believe that the goods and services emanate from the opponent or that there is an economic connection between the users of the marks. It also claims that the use by the applicants is without due cause and would give the contested mark an unfair advantage. It asserts that the reputation of the earlier marks would be damaged where the contested mark is used for goods and services "not of the same high standard as those offered by the opponent" and says that there would be detriment to the distinctive character of the earlier marks by way of dilution. The opponent therefore asks that the application be refused under s. 5(3) of the Act.

5. Both of the earlier trade marks are subject to the use provisions at s. 6A of the Act. The opponent provided a statement that it has used the marks for the full range of goods and services relied upon.

6. In addition, the opponent says it has acquired a significant goodwill through use of both the word sign "DUNE" and the sign shown below:

Dune
LONDON

7. The opponent claims that it has used the signs throughout the UK since 1992 in relation to the following goods and services:

> Bags; luggage; umbrellas; handbags; purses; wallets; sports bags; make-up bags; card holders; key cases; keyrings; laptop cases; phone cases; belts; leather goods; fashion accessories; jewellery; candles; glasses; sunglasses; clothing; footwear; headgear; gloves; scarves; hats; slippers; face masks; eye

masks; pyjamas; womenswear; menswear; insoles; shoe care products; retail services; online retail services; mail order retail services.

8. It asserts that use of the contested mark would give rise to a misrepresentation and damage through both loss of sales and damage to the opponent's reputation. Accordingly, it asks that the application be refused under s. 5(4)(a).

9. The applicants filed a counterstatement denying all of the grounds. They put the opponent to proof that it has made genuine use of the earlier marks and of the asserted reputation. The applicants deny that the marks are similar and that there is a likelihood of confusion. They also deny each aspect of the claims under ss. 5(3) and 5(4)(a).

Hearing and representation

10. A hearing was held before me, by videoconference, on 8 November 2023. The opponent was represented by Eleanor Merrett of CMS Cameron McKenna Nabarro Olswang LLP. The applicants filed written submissions in lieu. They are represented by Cleveland Scott York.

Evidence

11. Only the opponent filed evidence. It consists of the witness statement, with exhibits, of Daniel Rubin, who is the founder and a director of the "Dune" business. His evidence is principally directed at supporting the opponent's claims of use, reputation and goodwill. Mr Rubin also gives some evidence about the "shortening" of brand names in the fashion industry.

12. Mr Rubin was not cross-examined. I have read all of his evidence and will refer to it as I consider appropriate in the course of this decision.

Relevance of EU law

13. 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, s. 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. This is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Approach

14. For reasons of procedural economy, I will proceed on the basis that use has been shown for all of the goods and services relied upon under the registered marks.

15. The specification of UK627 is identical to, or subsumed within, UK175's "footwear" in class 25. As the trade marks are identical, UK627 offers no better case for the opponent. It is therefore only necessary to consider the position in respect of UK175.

The s. 5(2)(b) grounds

16. The relevant parts of s. 5 read as follows:

> "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.
>
> […]
>
> 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."

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528; *Canon Kabushiki Kaisha v Metro-*

Goldwyn-Mayer Inc, Case C-39/97, EU:C:1998:442; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323; *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339; *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594; *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333; and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods and services

18. Some of goods and services at issue are clearly identical (e.g., wallets, footwear, retail of clothing). I will proceed on the footing that all of the goods and services are identical; if the opposition fails on that basis, it will also fail where there is a lower degree of similarity.

Average consumer and the nature of the purchasing act

19. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect: *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). 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 or services in question: *Lloyd Schuhfabrik Meyer*.

20. There does not appear to be any serious dispute about the average consumer or their level of attention. The opponent says that the goods are consumer products which, although varying in price point, will be selected usually visually, with a medium

degree of attention.[1] The applicant says that the average consumer is the general public and that they display a medium degree of attention.[2] I find that the average consumer of the goods in classes 18 and 25 and the vast majority of the services in class 35 is a member of the general public. The level of attention will be medium, due to some attention being paid to style and fit of the goods or factors such as the range of goods offered under the services.

21. The contested "provision of advertising space including in an on-line context; sales promotion for others; import and export services; business management and business consultancy services including in relation to the clothing and fashion sectors; provision of information and advisory services relating to the aforesaid services" in class 35 are business-to-business services and the user of such services will be a professional person. Their level of attention is likely to be above average, given that outlay will be higher, the services may involve lengthy contracts and therefore the provider's ability to deliver will be considered with some care.

22. I agree with the opponent that the purchasing process of all of the goods and services will be chiefly visual. The goods will be selected by eye from the shelves of retail premises or their online equivalents. The services are also likely to be selected from websites. Advertising material is likely to be visual for both goods and services, in the form of hoardings, print advertisements and potentially catalogues and brochures. For both the goods and services, there may be an aural element, arising from discussions with sales representatives and oral recommendations.

Distinctive character of the earlier trade mark

23. In *Lloyd Schuhfabrik Meyer,* 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

[1] Skeleton argument, §14.4.
[2] Submissions in lieu, §15.

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested 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)."

24. The word "DUNE" is an ordinary English word meaning a mound or drift of sand by the coast or in a desert.[3] It is not a meaning which has any connection to the goods or services of the earlier mark. The earlier mark is inherently distinctive to a medium degree.

25. As regards enhanced distinctiveness through use, the evidence shows that the "Dune" business was founded in 1992 with the opening of a concession. It appears that the first goods were women's footwear, as men's shoes were added to the range in 1999.[4] The first standalone store opened in 1993 and, by the relevant date, the opponent operated at least 36 "Dune" stores (including high street, outlet and airport stores but not including concessions) in various locations around the UK.[5] Photographs dated in the relevant period show storefronts which display "Dune" in the form below, as well as, in one instance, without the word "LONDON":[6]

[3] See https://www.collinsdictionary.com/dictionary/english/dune [accessed 31 July 2024]. This accords with my own understanding of the word's meaning.
[4] Rubin, §7; DRR-01; DRR-31.
[5] Rubin, §§8-9, 10, DDR-02.
[6] DRR-10.

26. For convenience, I will refer to the above presentation of the word “Dune” as the “stylised form”.

27. There were a number of “Dune” concessions in department stores such as House of Fraser and Debenhams throughout the UK between 2016 and 2021.[7] In 2016, for example, there were 230 total concessions, of which 28 were in handbag departments. The figure of 25-30 concessions specific to handbags remained constant; the shoe concession numbers declined as major department stores folded. “Dune” goods are also said to have been available through TK Maxx stores and their website between February 2016 and February 2021.[8]

28. Sales have been made online via the www.dunelondon.com website since 2005; prints dated between 2016 and 2021 show the stylised form of the word “Dune” both with and without the word “London” as well as plain text use.[9] Women’s scarves, hats, gloves, handbags, shoes, boots and men’s boots are specifically mentioned; there is also a heading “shop men’s”. Archive prints from the same period show “Dune”, “DUNE LONDON”, and the stylised form of “Dune LONDON” on websites such as Very and Selfridges in relation to offers for sale of women’s shoes and boots, gloves, handbags and men’s shoes.[10]

29. Footwear sales figures for the “Dune” brand are given as follows:[11]

2016/2017: £70,989,626

2017/2018; £80,584,053

2018/2019: £79,475,446

2018/2020: £77,500,913

2020/2021: £38,144,149

[7] Rubin, §§12-14, DDR-03.
[8] Rubin, §20.
[9] Rubin, §15, DRR-04.
[10] DRR-06.
[11] Rubin, §§28-29.

30. There are also sales figures said to be for "'accessories' [which] encompasses various fashion items, including bags, bumbags, card holders, laptop bags, leather belts, luggage, make up/wash bags, passport holders, pouches, purses, umbrellas, vanity cases and wallets".[12] These show sales in excess of £10 million each year between 2016 and 2020. This appears to be exclusive of any licensed sales.

31. In addition, sales figures are given for "'clothing' [which] also includes gloves, hats, hosiery, and non-leather belts", but not including licensed products, as exceeding £371,000 each year between 2016 and 2021.[13] A licence agreement was in place from 3 April 2019 to 11 October 2021 for "Dune" for loungewear, hosiery and underwear which generated sales of £297,348.91 in 2020.[14] Although the royalty statements are for socks, hosiery, underwear, nightwear and loungewear, there is no breakdown as between the goods and neither nightwear nor loungewear are specified among the items sold; there are entries for men's and women's "gifting" but it is unclear which goods this means.

32. A licence for luggage under the "Dune" brand has been in place since 21 October 2019 and generated sales worth £416,547.85 in 2020.[15] Images are provided of three of the products identified in the royalty statements, namely a holdall, a cabin-sized wheeled suitcase and a medium suitcase. "Dune London" in stylised form is displayed on the goods.

33. Copies of articles from national newspapers and magazines, such as *Vogue* and the *Times*, as well as the website of the ITV programme *This Morning*, are provided.[16] They are dated between 2016 and 2021. The articles are not provided full-size and the text is not visible on all of them, even when magnified, so it has not been possible for me to identify in all cases which of the products shown are "Dune" goods. However, shoes and boots (both men's and women's), handbags, gloves, scarves, hats, purses, a phone pouch, a holdall, wash bags, a suitcase, backpacks and belts can be seen. The vast majority of the articles concern shoes and handbags.

[12] Rubin, §33.
[13] Rubin, §§30-31.
[14] Rubin, §§21-22, DRR-07.
[15] Rubin, §23, DRR-08 – DRR-09.
[16] DRR-23 – DRR-25.

34. Advertising spend rose each year from over £2.3 million in 2016/2017 to over £6 million in 2020/2021. This included full-page print advertisements in weekly and monthly publications (e.g. *Sunday Times Style*, *Grazia*, *GQ*), out-of-home advertising such as on the London Underground and various types of digital advertising such as website skins (i.e., advertising surrounding the main content of a web page).[17] There is supporting evidence of advertising/marketing from 2016 to 2021 showing the "Dune LONDON" stylised mark.[18] Not all of the advertisements are particularly legible but they feature, or are said in unchallenged evidence to feature, shoes for men and women, bags and scarves.

35. In relation to retail services, there is one five-star review, based on product, presentation, value for money, customer service and shopping experience, for a Dune shop in Birmingham.[19] It describes the "strong product, value for money and good customer service" provided in store. The opponent is described as a "footwear retailer" in *Retail Week* magazine in June 2017, which talks about the use of user-generated content on its product pages.[20] Dune was named "multiple footwear retailer of the year" in the *Drapers* Footwear Awards in 2015, 2016 and 2019 and was shortlisted in 2021.[21] There is, additionally, an article about a "retail hub" from December 2020, though the opponent is described as a "footwear and accessories brand".[22]

36. I am satisfied on the evidence that UK175 was factually highly distinctive for footwear at the relevant date. In addition to the plain text use, the stylised form in which "Dune" has been used is an acceptable form, the stylisation being minimal and not detracting from the distinctiveness of the word "Dune" itself. The same applies to the addition of the word "LONDON", which will be perceived as descriptive of the location of the business.[23] There has been use of the marks for over twenty years in the UK, the sales figures for footwear are substantial and they are supported by a good amount

[17] Rubin, §46. See also DRR-19 and DRR-20.
[18] Rubin, §39, DRR-12 – DRR14, DRR-31. There is a brand video in DRR-31 which does not appear to be part of the marketing for the relevant period, since it references events in 2022.
[19] DRR-23, p. 44.
[20] DRR-26 p. 3.
[21] DRR-29.
[22] DRR-26, p.5.
[23] The proper approach to the test of use in a variant form is set out in *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12, EU:C:2013:253 and *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22 at [13]-[17]. See also the comments of the General Court in T-307/17 *adidas AG v EUIPO* EU:T:2019:427 at [50] to [63] and [70] to [73].

of press exposure, often in the nature of product highlights/ must-haves/ hottest buys-type lists for shoes, as well as handbags, which feature the opponent's goods.

37. The case for handbags is less clear-cut than for footwear, principally because there are no sales figures specifically for handbags. However, there is repeated reference to handbags sold under the "DUNE" marks in national press over several years. The opponent is also described in one article as a "shoe and bag maker".[24] This description is consistent with my own impression of the evidence. I am satisfied that UK175 had enhanced distinctiveness for "handbags" at the relevant date, at least to a reasonably high degree.

38. Although there is evidence that "DUNE" has been used for other goods, the most specific sales figures relate to "luggage". These figures are not negligible but they cover only one year and they are not likely to be significant in what is doubtless a large market. There are no sales figures specific to any other goods and the figures are not large enough to suggest a reputation for any specific goods, in the absence of a breakdown. The press evidence is also much weaker, showing the items just a few times or in some cases (e.g., suitcases) just once, nor is the advertising evidence compelling. Taken as a whole, I do not consider that the evidence establishes enhanced distinctiveness for any goods other than footwear and handbags.

39. As for retail services, whilst I accept that there has been a retail presence which is reasonably long-standing, there is little to demonstrate that the "DUNE" trade mark is well known for the provision of retail services. I recognise that there have been awards for retail services but these are industry awards. In the absence of any further detail, it is not apparent to me that recognition from one industry magazine, even on several occasions, or a glowing review for one shop, translates to a reputation for retail services among a significant part of the relevant public. I do not consider that the evidence establishes enhanced distinctive character for retail services of any kind.

Comparison of trade marks

40. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its

[24] DRR-23, p. 55.

various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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."

41. The trade marks to be compared are:

Earlier trade mark	Contested trade mark
DUNE	DNE

42. The opponent invites me to compare the marks in the same stylised typeface used by the opponent in much of its branding, viz.:

Notional use of:	
DBL's registered marks	**The Application**
DUNE	**DNE**
Dune	**Dne**

43. In *Herno S.p.A. v Miss Sparrow Ltd*, BL O/954/22, Iain Purvis KC, as the Appointed Person, considered an argument that a word mark should be considered in the same typeface as that in which an earlier device mark was used; alternatively that the typeface of the device mark should be disregarded in the comparison. Having reviewed *Calvin Klein Trademark Trust v OHIM*, T-185/07, EU:T:2009:147, *Faber Chimica Srl v OHIM*, T-211/03, EU:T:2005:135, *Ontex N.V. v OHIM*, T-353/04,

EU:T:2007:47, *Sadas v OHIM*, T-346/04, EU:T:2005:420, *Peek & Cloppenburg v EUIPO*, T-386/07, EU:T:2009:420 and *Wasabi Frog Ltd v BooBoo Products Ltd*, BL O/387/11, Mr Purvis concluded that the stylisation in a device mark is part of the overall impression and cannot be ignored, even where the stylisation is the presentation in a particular typeface. He added that:

> "42. Consistently with this, it is wrong to approach the required comparison by hypothesising a way of styling the word mark in a way which is extremely similar to the contested mark (whether by choice of font or the use of other forms of presentation), and asking whether confusion would be likely in such a case. This approach is contrary to *Calvin Klein* and *Faber* and *Ontex*. It is also contrary to the statutory test which is to ask whether confusion will arise '*because of the similarity between mark and sign*' because the stylisation is not part of the mark. Neither *Sadas* nor *Peek* provide a mandate for such an approach. The tribunal or examiner should simply consider the similarity of the word itself to the device, bearing in mind that the particular font in which the word mark happens to be presented on the Register is irrelevant".

44. In my view, it would be equally inappropriate in the present case to compare the marks in the typeface used by the opponent. The trade marks in issue are word-only marks. Stylisation, however slight, forms no part of their overall impression.

45. The applicant says that the marks are dissimilar overall. The opponent submits that the respective marks are highly similar both visually and aurally. It also says that to the extent that the average consumer might seek to replace the "missing" vowel in the application and construe the mark as "dune", there would be conceptual identity.

46. The opponent has filed some evidence relating to the shortening of marks in the fashion sector. Mr Rubin says that it is common "for businesses to abbreviate their house brands, either to indicate a sub-brand, a diffusion line, or to simply shorten the length".[25] He gives in his narrative evidence examples of D&G/Dolce & Gabbana, VV/Versace, CKOne/Calvin Klein, YSL/Yves Saint Laurent, McQ/Alexander McQueen and DKNY/Donna Karan (New York). There is documentary evidence showing a range

[25] Rubin, §70.

of brands using abbreviated versions of their name, such as “MNG” shown on shoes on the Mango website; t-shirts and trousers from Primark bearing a highly stylised “PRMRK” logo; “DP” on dorothyperkins.com and “FWM by Fenn Wright Manson” for Matalan.[26] There is also evidence of interlocking and stylised “D”s on goods on the Dune website.[27] Mr Rubin says that the brand also uses “DL”, though I cannot see this in the evidence said to support the statement.[28]

47. I do not find this evidence supportive of the opponent’s submissions. First, most of these examples are not instances of vowels being omitted at all. They are the use of initials rather than full words. Secondly, in none of these examples is only one of multiple vowels omitted, which is what the shortening of “DUNE” to “DNE” would entail: “MNG” and “PRMRK” omit all of the vowels. Thirdly, the evidence does not come close to establishing that the average consumer of fashion goods will routinely seek to replace missing vowels where there is a string of consonants. It may be the case, where “MNG” is used in proximity to “Mango” or “PRMRK” to “Primark”, that the consumer will do so. It may also be the case that, in certain instances, the omission of vowels will leave a string of letters which naturally lends itself to insertion of vowels to make a word or (probably reputed) brand name; the “PRMRK” example seems nearer to this than “MNG”. However, it is a very different proposition that the average consumer seeing any string of letters on goods in isolation will typically and immediately seek to add vowels to make a word. I can see no reason why they would do so in the present case. In my view, the contested mark will be seen as the letters “DNE” and no more. The overall impression lies in this combination of letters.

48. The overall impression of the earlier mark lies in the word “DUNE”.

49. The marks share the letters “D”, “N” and “E”. The latter two are juxtaposed and in that order. The marks all start with “D”. However, the omission of a letter when the marks are only three and four letters long, respectively, is a significant one. It is even more noticeable where it is closer to the start than the end of the mark. The marks have a fairly low degree of visual similarity.

[26] DRR-27.
[27] DRR-28.
[28] Rubin, §71.

50. Aurally, the contested mark will be verbalised as the three letters of the alphabet “D”, “N”, “E”. It bears no resemblance to the ordinary pronunciation of the word “DUNE” (whether articulated as “DYOON”, “DOON” or “JOON”). They are aurally different.

51. I have already indicated that the earlier mark means a mound or drift of sand. The contested mark will not be seen as having a clear conceptual meaning, though the average consumer will recognise that it is three letters of the alphabet. The marks are not conceptually similar.

Likelihood of confusion

52. Whether there is a likelihood of confusion is a global assessment, which must take into account all of the factors considered above. The likelihood of confusion must be determined from the perspective of the average consumer, who will rely on their imperfect recollection of the trade marks. The competing factors must be balanced against one another, meaning, for example, that a greater degree of similarity between the trade marks may be offset by less similarity between the goods.

53. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Iain Purvis QC (now KC), again as the Appointed Person, explained that:

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

54. I will consider the position in respect of identical goods where there is enhanced distinctive character first, that being the most favourable position to the opponent.

55. The opponent says that the present case falls within categories (a) and (c) of Mr Purvis's list. In respect of category (a), it says that the "DUNE" mark is "so distinctive […] that the average consumer would assume that no-one else but [the opponent] would be using a short mark comprising three of the same letters as a trade mark". I reject that submission. Mr Purvis's category (a) relates to situations where "the common element is so strikingly distinctive" that there would be confusion. The "common element" in this case, however, is the letters "D", "N" and "E". The opponent's use of the word "DUNE" is not, in my view, capable of conferring distinctive character on the letters "D", "N" and "E" either individually or as a series of three letters separately from the whole word "DUNE". I do not think that even the extensive use which has been shown of "DUNE" would cause the average consumer to think that there may be a connection with another trader using the letters "DNE".

56. It is also submitted that category (c) is engaged, on the basis that the truncated term "DNE" is an entirely logical brand extension of "DUNE" and is consistent with the types of brand extension seen across the fashion industry. I do not agree. I accept that some fashion brands may choose to omit certain letters of their full names for various reasons. However, I do not agree that it is likely that the average consumer would

construct “DUNE” from “DNE”, or vice versa, unless there were a good reason for them to undertake such an exercise. The evidence does not support that it is common to omit only some of the vowels, rather than all of them, from a brand name and there is nothing else in the letters “DNE” to prompt a consumer towards an association with “DUNE”. I dismiss the argument that “DNE” is a logical brand extension (or contraction) of “DUNE”, or vice versa. There is no likelihood of indirect confusion.

57. Ms Merrett added that the opponent’s view was that while indirect confusion was the more likely, there remained a likelihood of direct confusion. I do not consider that there is a likelihood of direct confusion. There is a clear conceptual meaning attached to the word “DUNE” which is not likely to be misremembered. Nor is the fact that the contested mark is three unconnected letters of the alphabet likely to go unnoticed or be forgotten by the reasonably observant and circumspect average consumer, even if there is uncertainty over the letters or their order. I have already rejected the submission that the average consumer will see “DNE” as a modified version of “DUNE”. Given the relatively limited visual similarity, the aural dissimilarity and the clear conceptual hook which attaches to “DUNE”, I do not think that there is a likelihood of direct confusion.

58. It follows that if there is no likelihood of either direct or indirect confusion in relation to identical goods where there is enhanced distinctive character, there will also be no confusion where there is no enhanced distinctiveness and/or where the goods and services are similar to a lesser degree. The opposition based on s. 5(2)(b) is dismissed.

The passing off grounds

59. Ms Merrett accepted before me that the passing off grounds under s. 5(4)(a) stand or fall with the s. 5(2)(b). There is, therefore, no need for me to consider this ground further.

The s. 5(3) grounds

60. This is the opponent’s primary case. S. 5(3) of the Act reads:

"5.—(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."

61. S. 5(3A) states:

"(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."

62. As UK175 is a comparable mark, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

"10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom include the European Union."

63. The relevant case law can be found in the following judgments of the CJEU: *General Motors*, Case C-375/97, EU:C:1999:408, [1999] ETMR 950; *Intel,* Case 252/07, EU:C:2008:655, [2009] ETMR 13; *Adidas-Salomon,* Case C-408/01, EU:C:2003:582, [2004] ETMR 10; and *L'Oréal v Bellure*, Case C-487/07, EU:C:2009:378, [2009] ETMR 55; *Marks and Spencer v Interflora*, Case C-323/09, EU:C:2011:604; and *Environmental Manufacturing LLP v OHIM*, Case C-383/12P, EU:C:2013:741. 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: G*eneral 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'Oréal 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'Oréal 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'Oréal 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'Oréal v Bellure).*

Reputation

64. In *General Motors,* the CJEU gave the following guidance for the assessment of a trade mark's reputation:

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

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

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

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

65. For the reasons given at paragraphs 27 to 39, above, I am satisfied that the earlier mark had a reputation for footwear and handbags at the relevant date but that no reputation subsisted in other goods and/or services.

Link

66. Whether the relevant public will make the required mental 'link' between the marks must take account of all relevant factors. The factors are identified in *Intel* (see paragraph 63(d), above). I have considered most of these points already and adopt my earlier reasons and findings. For convenience, I will set out my findings where appropriate below.

<u>The degree of similarity between the conflicting marks</u>

67. The marks are visually similar to a fairly low degree, aurally dissimilar and there is no conceptual overlap.

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

68. Starting with class 18, "handbags" are literally identical to the same goods for which the earlier mark is reputed. "Bags", "tote bags" and "shoulder bags" are identical on the principle outlined in *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T-133/05, EU:T:2006:247.

69. "Satchels, beach bags, bum bags, sports bags, rucksacks" are, like handbags, for carrying things but these goods are generally intended for carrying specific items that are not the same as the small personal items for which handbags are intended.[29] There are some differences in nature. They share trade channels and users and there may be a degree of interchangeability (e.g., a large casual handbag may be used as a beach bag, or a small rucksack in place of a handbag). These goods are similar to handbags to at least a medium degree.

70. "Valises, vanity cases, trunks, travelling bags, suitcases, luggage" only overlap in purpose at quite a high level of generality, in that the goods are all intended to contain and carry other items. Their nature is different. There may be some overlap in trade channels and it would not be unusual for these goods to be made by the same manufacturers. These goods are not complementary to handbags. These goods have a low degree of similarity to handbags.

71. "Wallets, purses, credit card holders, key cases" are intended to contain small items but their specific purpose is different from that of handbags. Users and channels of trade will overlap. Although the size and shape of the goods differs, they may be of the same material and style as handbags and may have the same manufacturer. There may be some complementarity if they are chosen to match a handbag or are sold as part of a set. They are similar to a lower than average degree.

[29] The factors relevant to the assessment of similarity between goods and services are set out in *Canon* at [23] and in *British Sugar Plc v James Robertson & Sons Ltd ("Treat")* [1996] RPC 281. "Complementarity" is explained in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),* Case T-325/06, EU:T:2008:338, among others.

72. “Belts” in class 18 includes belts for luggage. These are different in nature, purpose and method of use from handbags. It is true that these goods may be found in bag/luggage stores but they would usually be in different sections and/or on different shelves and displays. If there is any similarity at all, it is very low.

73. “Umbrellas” differ in all material respect from handbags and footwear, save that there is a superficial overlap in users and channels of trade. Neither is sufficient to make the goods similar.

74. As regards “parts and fittings” for the contested goods, I accept that handbag straps may be purchased separately in handbag shops by the general public, that they are often made by the same manufacturer as the handbags themselves and that, as a result of their close connection, are complementary to handbags. Parts and fittings for handbags are similar to handbags to a medium degree. However, there is nothing before me to suggest that parts and fittings for the other types of bags and luggage are routinely sold to the general handbag-buying public: these goods appear more likely to be made available to manufacturers or professional repairers. Consequently, they differ in channels of trade and users as well as nature and purpose. The goods are not in competition, nor is there any obvious reason why parts for these goods would be important for handbags. These goods are not similar.

75. Turning to class 25, “articles of footwear” is self-evidently identical to the earlier mark’s “footwear”. “Articles of clothing and headgear, including caps, hats and belts; menswear, womenswear” have a degree of overlap in purpose, because they are worn on the person, and have the same users. Their nature is different but there is some overlap in channels of trade and the goods are complementary, as they may be selected as part of an overall “look” and they may be produced by the same manufacturer. There is a medium degree of similarity.

76. In class 35, “retail and on-line retail and store services connected with the sale of bags, handbags, tote bags, shoulder bags, satchels, beach bags, bum bags, sports bags, rucksacks, wallets, purses, credit card holders, key cases” and “retail and on-line retail and store services connected with the sale of articles of clothing, footwear and headgear, including caps, hats and belts, menswear and womenswear” have a degree of similarity with handbags and footwear, respectively, which is either low or

medium. Where the retail services concern either handbags (including types of bag included within the term) or “footwear”, i.e. identical goods, there is a reasonably pronounced complementarity between the goods and services, which also share channels of trade and users. These goods and services are similar to a medium degree. The other retail services listed above concern goods which have at least a medium degree of similarity to the earlier goods, are found in the same outlets, are subject to the same retail services and are of interest to the same users. There is a low degree of similarity between the earlier mark’s goods and these retail services. For similar reasons, the “provision of information and advisory services relating to the aforesaid services” is similar to the earlier goods to a medium degree where the retail services at issue concern identical goods and a low degree where there is at least a medium degree of similarity.

77. There is no similarity between any of the remaining services in class 35 and the earlier mark’s goods. Although some of the remaining services are directed at the general public, this is too high a level of generality to be meaningful, as is the fact that the goods may be sold in the same stores but in different sections. The “provision of advertising space including in an on-line context; sales promotion for others; import and export services; business management and business consultancy services including in relation to the clothing and fashion sectors” are business services which are offered to a professional public and are in an entirely different sector. These services do not coincide with the earlier mark’s goods in any material respect.

78. As I found above, the average consumer is a member of the general public who will pay a medium degree of attention or a business user whose level of attention will be above average. The selection process will be predominantly visual, though there may be an aural aspect to the purchase.

The strength of the earlier mark’s reputation

79. The earlier mark had a strong reputation for footwear and a reasonably strong reputation for handbags at the relevant date.

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

80. At the relevant date the earlier mark was factually highly distinctive for footwear and distinctive to a reasonably high degree for handbags.

Whether there is a likelihood of confusion

81. I do not consider that there is a likelihood of confusion for any of the goods or services. For essentially the same reasons given at paragraphs 55 to 58, above, the differences between the marks are too significant for the consumer to mistake the marks for one another, or to believe that the users are economically connected. This is the case even for identical goods where the earlier mark has a strong reputation and is highly distinctive; confusion is even less likely for goods and services which have a lesser degree of similarity or are not similar.

Conclusion on link

82. Taking all of the above into account, I find that the relevant public would not have made the link between the respective marks at the relevant date. There would be no link for identical goods in the same sector as the earlier mark's reputation, nor can I see any good reason why the link would be made for goods or services which are less than identical and/or in a different sector and/or purchased by a business user rather than a member of the public.

83. Absent the requisite link, the opposition based upon s. 5(3) fails.

Unfair advantage/detriment to reputation or distinctive character

84. I would add that, even had I found that a section of the public would make a link, I would have rejected the opposition under s. 5(3) because:

(a) any link would have been weak;

(b) the use of the mark "DNE" in relation to the goods and services at issue would be seen by the public as a mere coincidence;

(c) In the light of the above, even if a section of the public were to make a mental link between the marks, it is unlikely that there would be any economic consequences, either increasing sales under the contested mark, damaging the earlier mark's reputation or reducing sales under the earlier mark.

Conclusion

85. The opposition has failed and the application will proceed to registration in full.

Costs

86. The applicants have been successful and are entitled to an award of costs. The applicable scale is in Tribunal Practice Notice 2/2016. I award costs to the applicants calculated as follows:

Considering the notice of opposition and filing the counterstatement:	£400
Considering the opponent's evidence:	£800
Written submissions in lieu:	£400
Total:	**£1,600**

87. I order Dune Brand Limited to pay Stephen William Craig and Barney Rodgers, jointly and severally, the sum of £1,600. This sum should 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 15th day of August 2024

Heather Harrison

For the Registrar