BL O/0784/24

TRADE MARKS ACT 1994

IN THE MATTER OF
THE UK DESIGNATION OF INTERNATIONAL REGISTRATION NO. 1608869
IN THE NAME OF FABRI CAMILLA
OF THE MARK:

CAMILLA SAAB

IN CLASSES 9, 16, 25, 41 AND 42

AND

THE COMBINED OPPOSITION NOs. 432749 AND 432754 THERETO
BY
CAMILLA IP PTY LTD
AND
CAMILLA AUSTRALIA PTY LTD

BACKGROUND AND PLEADINGS

1. International trade mark registration 1608869 ("**the Opposed IR**") consists of the plain words CAMILLA SAAB ("**the Contested Mark**"). The Opposed IR is in the name of Fabri Camilla ("**the Applicant**"). On 29 April 2021, the Applicant applied to designate the Opposed IR for protection in the United Kingdom in respect of goods and services in Classes 9, 16, 25, 41 and 42, as listed in full in the **Annex** at the end of this decision.

2. The Opposed IR is registered with effect from 29 April 2021, and claims priority from an earlier filing on 16 April 2021 of the same trade mark in Italy.[1] The request to designate the UK was published for opposition purposes on 21 January 2022.

3. Camilla IP Pty Ltd ("**CIP**") and Camilla Australia Pty Ltd ("**CAP**") (together "**the Opponents**") each filed a notice of opposition against the applied-for UK designation of the Opposed IR. The two Opponents are related corporate entities, but they rely on different earlier trade mark registrations, and CAP also claims an earlier unregistered right.

4. The oppositions were consolidated at the parties' suggestion and (together) make claims under **sections 5(2)(b)**, **5(3)** and **5(4)(a)** of the Trade Marks Act 1994 ("**the Act**"). The oppositions are only partial - each of the grounds of opposition being directed only at the following goods under the Opposed IR ("**the Contested Goods**"):

Class 9: *electronic publications (downloadable); downloadable software applications; electronic publications, namely, electronic books, magazines, newsletters, newspapers, brochures, manuals; electronic publications in the form of e-books*

Class 16: *Books; dictionaries; newspapers; periodicals; magazines; catalogs; brochures; newsletters, albums, note books, diaries; agendas; posters, calendars, maps, photo albums, photographs; office requisites (except furniture); folders for documents; office binders; instructional and teaching material (except apparatus); stationery, pencil sharpeners;*

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eraser; pen holder; ballpoint pens; pencils, fountain pens; markers; highlighters; adhesive labels and prints, envelopes, letter paper; business cards; greeting cards; paper bags; gift bags; gift cards; paper shopping bags. (The entire Class 16 registration.)

Class 25: *Clothing, footwear and headgear*. (The entire Class 25 registration.)

CIP's Opposition (432754)

5. For the purposes of its **sections 5(2)(b)** and **5(3)** grounds, CIP relies upon the following earlier-filed international trade mark which I shall refer to as "**the Villa Mark**":

VILLA CAMILLA XXC

IR No. 1584839
Designation date: 17 January 2021 – priority claimed from an earlier filing on 21 July 2020 of an Australian trade mark[2]
Date of protection of this IR in UK: 12 August 2021

6. For both its section 5(2)(b) and 5(3) grounds, CIP relies on all of the goods for which its earlier trade mark is registered.

Class 4: *Candles; scented candles; christmas lights (candles); lamp oils.*

Class 11: *Lamp shades; lamp bases; candle lanterns; oil burners; decorative electric lighting apparatus; light fittings; light shades; lanterns for lighting.*

Class 16: *Stationery; books; notebooks; book ends; book markers; book labels; adhesive paper films for stationery purposes; adhesive wall decorations of paper; photograph mounts; apparatus for displaying photographs; art prints; artwork; canvas for painting; fine art prints; posters; calendars; diaries; cards; writing implements [writing instruments]; drawing materials; drawing instruments; bags (envelopes, pouches) of paper or plastics; envelopes (stationery);*

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folders [stationery]; boxes of paper or cardboard; cases (covers) for passports; cases for writing implements; cases for stationery; coasters in card form; dinner mats of card; cut papers; decorative wrapping paper; display albums; document holders (stationery); document pouches (portfolio briefcases); files (stationery); gift boxes; gift stationery; gift wrap; hat boxes; inks; inkstands; ink wells; letter openers (knives); organisers (stationery); pads (stationery); paper kitchen towels; paper table linen; drawer liners of paper (perfumed or not).

Class 20: *Bedding (other than linen); bed heads; furniture for the home; chairs; ottomans; sofas; sofa beds; mirrors (looking glasses); picture frames; outdoor furniture; folding chairs; deck chairs; beach beds; window blinds (indoor); freestanding partitions (furniture); garment covers (storage); textile covers (fitted) for furniture; soft furnishings (cushions).*

Class 21: *Crockery for kitchen use; picnic crockery; cookware; tableware; kitchenware; glassware, porcelain; earthenware.*

Class 24: *Cushion covers; linens; bed linen; bathroom linen; household linen; table linen (not of paper); dish cloths of textile for drying; beach towels; curtains of textile or plastic; canvas; blanket throws; travellers rugs; covers (loose) for furniture; coverings for walls (wall hangings, of textile); bunting of textile or plastic; fabrics for furniture; fabrics for textile use; upholstery fabrics; household textiles; textile articles for household use.*

Class 27: *Wallpaper; floor coverings; floor rugs; carpets; mats; tiles (carpet, cork, linoleum, vinyl), being materials for covering existing floors; yoga mats; wallpaper in the nature of room-size decorative adhesive wall coverings.*

7. The Opponents' **section 5(2)(b)** claims are that the parties' trade marks are similar and that the goods and services are similar or identical, such that there is a likelihood of confusion. Their **section 5(3)** claim is that the earlier filed trade marks,

assessed at the priority date of the Opposed IR, had acquired a reputation in the United Kingdom because of their extensive use, and that use of the Opposed IR is without due cause and will take advantage of and be detrimental to the distinctive character and reputation of the Opponents' trade marks.

CAP's Opposition (432749)

8. For the purposes of its **sections 5(2)(b)** and **5(3)** grounds, CAP relies upon the following earlier-filed figurative trade mark, which I shall refer to as "**the Signature Mark**":

IR No. 1272920
Designation date: 7 April 2017
Date of protection of this IR in UK: 19 October 2017

9. For both its section 5(2)(b) and 5(3) grounds, CAP relies on all of the goods and services for which its earlier trade mark is registered, namely:

Class 3: *Soaps; perfumery; essential oils; cosmetics; hair lotions; hand and body lotions; hair care products*

Class 9: *Eyewear including sunglasses, frames, cases and accessories for sunglasses in this class.*

Class 14: *Jewellery; costume jewellery; non-precious jewellery all including pendants, necklaces, chains, bracelets, earrings, ear studs, jewellery pins, ornamental pins, watches, precious stones.*

Class 18: *Bags and baggage; trunks; beach bags; backpacks; suitcases; satchels, travelling bags; wallets; purses and handbags; briefcases; folio cases; attaché cases; key cases; credit card cases all of these goods made of leather and other materials not included in other classes.*

Class 24: *Textiles and textile goods namely linen, bedding, cushion covers and pillow covers, curtains, bed and table covers, napkins, towels, tea towels, kitchen towels, handkerchiefs, face towels, serviettes.*

Class 25: *Clothing, footwear and headgear including clothing accessories being scarves, shawls, sashes, clothing wraps, gloves, ties and belts.*

Class 35: *Retail services, wholesale services and online retail services connected with soaps, perfumery, essential oils, cosmetics, hair lotions, hand and body lotions, hair care products, eyewear including sunglasses, frames, cases and accessories for sunglasses, jewellery, costume jewellery, non-precious Jewellery all including pendants, necklaces, chains, bracelets, earrings, ear studs, jewellery pins, ornamental pins, watches and precious stones; retail services, wholesale services and online retail services connected with, bags and baggage, trunks, beach bags, backpacks, suitcases, satchels, travelling bags, wallets, purses and handbags, briefcases, folio cases, attaché cases, key cases, credit card cases all of the aforesaid made of leather and other materials, textiles, and textile goods namely linen, bedding, cushion covers and pillow covers, curtains, bed and table covers, napkins, towels, tea towels, kitchen towels, handkerchiefs, face towels, serviettes, clothing, footwear, headgear, clothing accessories namely scarves, shawls, sashes, clothing wraps, gloves, ties and belts.*

10. The **section 5(4)(a)** ground is based on the plain word “CAMlLLA”, claimed to have been used throughout the United Kingdom since 2011, generating sales and goodwill in respect of the following list of goods and services:

Soaps; perfumery; essential oils; cosmetics; hair lotions; hand and body lotions; hair care products. (i.e. Same as Class 3 of the Signature Mark)

Eyewear including sunglasses, frames, cases and accessories for sunglasses in this class. (i.e. Same as Class 9 of the Signature Mark)

Jewellery; costume jewellery; non-precious jewellery all including pendants, necklaces, chains, bracelets, earrings, ear studs, jewellery pins, ornamental pins, watches, precious stones. (i.e. Same as Class 14 of the Signature Mark)

Bags and baggage; trunks; beach bags; backpacks; suitcases; satchels, travelling bags; wallets; purses and handbags; briefcases; folio cases; attaché cases; key cases; credit card cases all of these goods made of leather and other materials not included in other classes. (This is the same as Class 18 of the Signature Mark but adds to the list "pet collars and leads".)

Textiles and textile goods namely linen, bedding, cushion covers and pillow covers, curtains, bed and table covers, napkins, towels, tea towels, kitchen towels, handkerchiefs, face towels, serviettes. (This is the same as Class 24 of the Signature Mark but adds to the list homeware; tableware; crockery; kitchenware; wallpaper.)

Clothing, footwear and headgear including clothing accessories being scarves, shawls, sashes, clothing wraps, gloves, ties and belts (This is essentially the same as Class 25 of the Signature Mark, specifying clothing items and accessories as well as "face masks".)

Retail services, wholesale services and online retail services connected with soaps, perfumery, essential oils, cosmetics, hair lotions, hand and body lotions, hair care products, eyewear including sunglasses, frames, cases and accessories for sunglasses, jewellery, costume jewellery, non-precious Jewellery all including pendants, necklaces, chains, bracelets, earrings, ear studs, jewellery pins, ornamental pins, watches and precious stones; retail services, wholesale services and online retail services connected with, bags and baggage, trunks, beach bags, backpacks, suitcases, satchels, travelling bags, wallets, purses and handbags, briefcases, folio cases, attaché cases, key cases, credit card cases all of the aforesaid made of leather and other materials, textiles, and textile goods namely linen, bedding, cushion covers and pillow covers, curtains, bed and table covers, napkins, towels, tea towels, kitchen towels, handkerchiefs, face towels, serviettes, clothing, footwear, headgear, clothing accessories namely scarves, shawls,

sashes, clothing wraps, gloves, ties and belts, homeware, tableware, crockery, kitchenware, face masks, pet collars and leads, wallpaper.

11. CAP claims that the similarity of the parties' signs and goods and services is such that use of the Opposed IR in the UK would be a misrepresentation leading to a real risk of damage to CAP's goodwill and that use of the Opposed IR would therefore be liable to being prevented by the law of passing off.

Applicant's defences

12. The Applicant filed a notice of defence for each of the oppositions, including a counterstatement. It admitted that some of the goods under the Opponents' earlier marks were identical or similar to the applied-for goods but denied the claims overall, including a likelihood of confusion, and put the Opponent to proof of its claimed reputation and goodwill. I return in this decision to points from the Applicant's counterstatements to the extent I consider warranted.

13. The Opponents are represented by Charles Russell Speechlys LLP; the Applicant by Withers & Rogers LLP. The Opponent filed evidence. The parties requested no oral hearing, but both parties filed written submissions in lieu. This decision is made 'from the papers', all of which I have read.

RELEVANCE OF EU LAW

14. 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, such as the General Court and the Court of Justice of the European Union ("**CJEU**").

STATUTORY PROVISIONS

15. The parts of section 5 of the Act relevant to the parties' claims are:

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

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

(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.

(3) A trade mark which—

(a) is identical with or similar to an earlier trade mark, and

(b) . . . . . .

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

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

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

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

[…]

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

(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.

16. Section 6 of the Act provides the meaning of "earlier trade mark" as referenced in section 5(2) and 5(3).

> *6. (1) In this Act an "earlier trade mark" means—*
>
> *(a) a registered trade mark .... which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,*

EVIDENCE OF USE OF THE EARLIER MARKS

17. The Opponents' trade marks had been registered for less than five years at the priority date of the Opposed IR (16 April 2021, "**the Relevant Date**"). The Opponents' marks are therefore not subject to the use provisions under section 6A of the Act.

18. While the Opponents may rely on all of their registered goods and services without having to prove use of the earlier marks, it is necessary for the Opponents to establish (i) the claimed reputation of the trade mark, and, by implication, any enhancement of the distinctive character of the earlier trade marks and (ii) goodwill acquired through use of the claimed sign.

19. During the evidence rounds, the Opponent filed evidence comprising a **witness statement** by **Colin Phipson**, dated 24 March 2023, introducing **Exhibits CP1 - CP16**. Following a case management conference, Exhibits CP8 and CP9 are subject to a confidentiality order.

20. Mr Phipson has been the Chief Operating Officer and Financial Director at CAP since 2017. I note the following from his evidence:

Company information

i. The Camilla brand was founded by Camilla Franks, an Australian fashion designer. The brand's first collection, a range of caftans, was launched in 2004 at Australian Fashion Week, and, until 2009, Ms Franks operated the brand as a sole trader under the business name "Camilla Caftans". In 2009, Ms Franks incorporated CAP to operate the business, manufacturing garments to her own print and garment designs. Ms Franks remains its creative director.

ii. CAP has grown into a global brand whose printed clothes, accessories and homeware are now sold in 55 countries globally, including the UK.

iii. Camilla IP Pty Ltd ("CIP") is a wholly owned subsidiary of CAP and was incorporated in February 2018 as an IP holding company for the business.

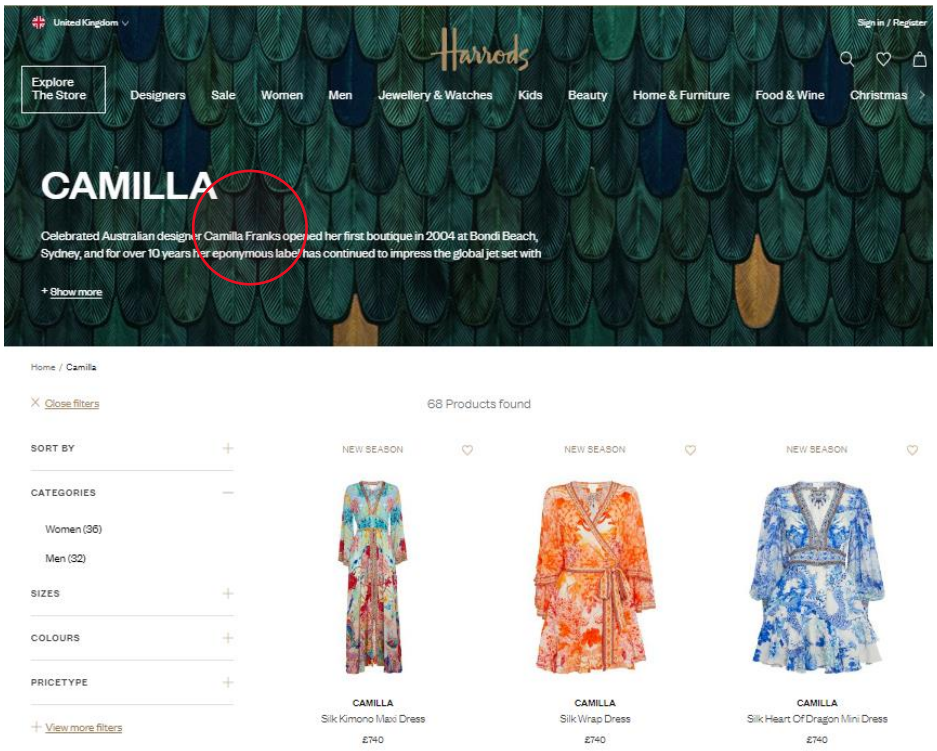
Reputation and goodwill in the Camilla brand in the UK

Sales avenues and figures

iv. **Exhibit CP1** shows two extracts from spreadsheets. Page 1 of the exhibit is said to show the products sold to Net A Porter in 2011. It lists 14 goods, which are kaftans, dresses, a cape, a playsuit and a coat. It does not show how many such goods were sold. Page 2 gives the name of the Opponents' "UK stockists and the relevant seasons that were promoted to them." It identifies 15 or so "UK clients and contacts", including Net A Porter, Flannels and Harrods. Those listed are located mostly in London, but the list includes a shop in Bournemouth, in Berkshire, in Essex, in Nottingham and another in the Vale of Glamorgan. The witness says that this exhibit shows the date of first promotion and sales in the UK and products sold. There are no dates in the exhibit, but I am prepared to infer that "SS11", "FW11", "SS12", under the column heading "season" refer to Fall / Winter and Spring / Summer of 2011 and 2012. The exhibit does not show sales of goods. The witness states that "by at least 2013 the offering had expanded to include homewares - namely cushions", though this is not a point shown by this exhibit.

v. The witness states that products sold under brand were initially available via high-end physical and online retail stockists such as Harrods and Harvey Nichols (London) and Net A Porter, Farfetch and Mytheresa. I note that the latter two stockists were not listed amongst the stockists in 2011/2012 under Exhibit CP1. **Exhibit CP2** shows extracts from five websites – including Farfetch and Mytheresa, along with Harrods, Harvey Nichols and Net A Porter – but those extracts are stated to be current as at the date of the witness statement. They therefore do not show the position as at the Relevant Date. I note that the Camilla information on the Harrods, Mytheresa and Farfetch

websites includes reference to its founder, Camilla Franks, as shown in the image below:



vi. Mr Phipson states that a dedicated UK website (https://uk.camilla.com) was launched in October 2018 complementing the Australian site. Mr Phipson states that **Exhibit CP3** includes a newsletter emailed to the customer database in October 2018 announcing the launch of the UK site; I could not find that content within the exhibit, but I accept the date of launch stated by Mr Phipson. **Exhibit CP3** contains screenshots from the UK website as it appeared as at the date of the witness statement. The words "United Kingdom £GBP" are shown at the top left of the screenshot; the Signature Mark appears at the top of the webpages and on certain of the goods. The goods are mainly dresses, but also jumpsuits. Also shown are a pair of slip-on beach sandals, a bum-bag, a handbag and a hair scarf. Exhibit CP3 also identifies Camilla Franks as the founder of Camilla.

vii. Mr Phipson states that "since at least 2019 the brand has expanded its product offering and in addition to its signature kaftans and dresses has sold a broad range of womenswear, childrenswear, menswear as well as jewellery, bags,

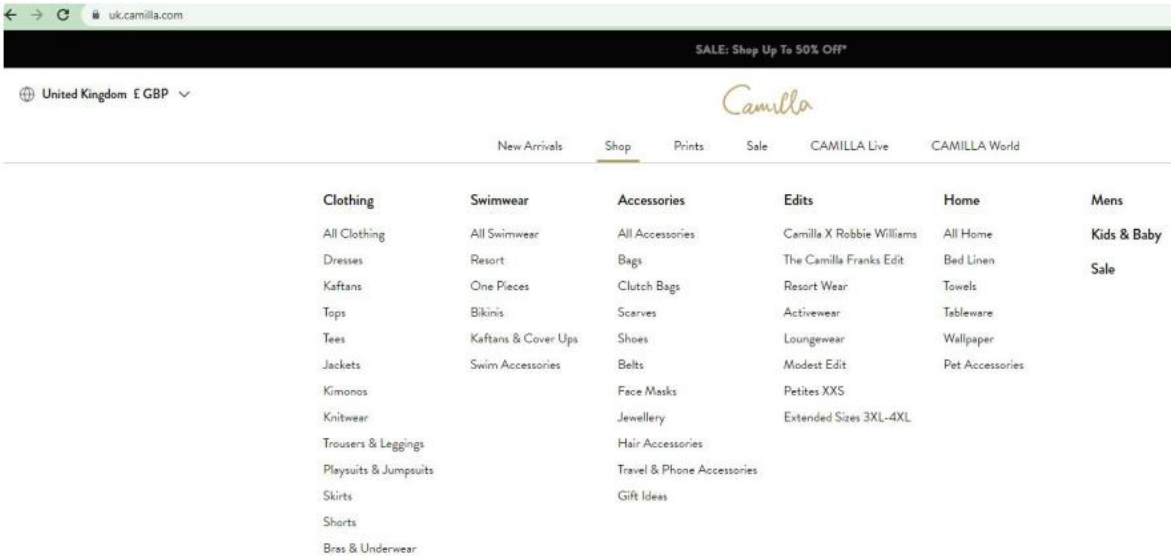
belts, scarves, decorative homeware and textile goods including soft furnishings, tableware, throws, linen and wallpaper." **Exhibit CP4** is stated to be a copy of an "electronic direct mailer" ("EDM") from 20 October 2020 to promote Camilla products, which was sent to nearly 2.5k UK customers. The exhibit also include one from 4 January 2021 (sent to nearly 2k UK customers), and another from 5 January 2022 (to around 5k UK subscribers who had engaged with the Opponent in the previous 180 days, which includes retail and online customers). The exhibit features the Signature Mark and shows a range of goods beyond dresses, including bedlinen, a bag and boots.

viii. Mr Phipson and explains the Opponent's practice of sending out on average between 2 -4 emails (EDMs) a week promoting the Camilla brand and products to its database of customers who have registered on its UK website. EDMs promoting homeware are sent periodically – four in Retail Year 2021 (from 1 July 2020 to 30 June 2021), seven in Retail Year 2022 (from 1 July 2021 to 30 June 2022) and five to date in Retail Year 2023 (though the latter two Retail Years are after the Relevant Date). **Exhibit CP5** shows screenshots from the current UK website showing examples of homeware goods such as cups and saucers, table runners, bed covers, towels – this again after the Relevant Date.

ix. Mr Phipson states that the sub-brand Villa Camilla XXC was launched in 2021 specifically to promote the homeware range which had previously been sold under the main Camilla brand.

x. The Signature Mark is said to be used on swing tags, garment labels and sometimes engraved or embossed on goods such as bags, and **Exhibit CP6** shows examples. The Villa Camilla XXC mark is shown on the underside of a china bowl:

xi. **Exhibit CP7** shows screenshots said to be taken in November 2022 (well after the Relevant Date of 16 April 2021) showing a range of products offered under the Signature Mark. The categories of offerings listed on the website are shown below:



xii. Mr Phipson states that **Exhibit CP7** shows goods including clothing, jewellery, key rings, hair accessories, bags, cosmetics bags, blankets, towels, bedding, napkins, swimwear, footwear, crockery and pet beds and accessories. It may well be, as Mr Phipson submits, that it evidences use of the marks across all classes of the earlier trade mark specifications. However, the test of the evidence is not simply one of use, but of whether the use had generated reputation or goodwill in the UK by the Relevant Date.

xiii. Following a case management conference to hear a confidentiality request, the Opponents chose to refile the witness statement, to include, for reference in any decision, a narrative account of the extent of sales in the UK in the relevant timeframe, including approximate sales figures and referencing the types of goods sold under the relevant marks/signs.

xiv. While the detailed content of Exhibit CP8 and CP9 is confidential, Mr Phipson's open evidence states that Exhibit CP8 and CP9 show the revenue generated by sales of products under the Camilla brand, in the UK, for the retail years ending 2019, 2020 and 2021, as being: around AU$2 million in 2019; and

around AU$1.5 million in both 2020 and 2021. I understand that the figures in Australian dollars would reduce by nearly half if given in pounds sterling. I also note that the sales in each of those years appear to have come from between 10 – 15 retailers. I could see no sales referable to the Opponents' UK-facing website.

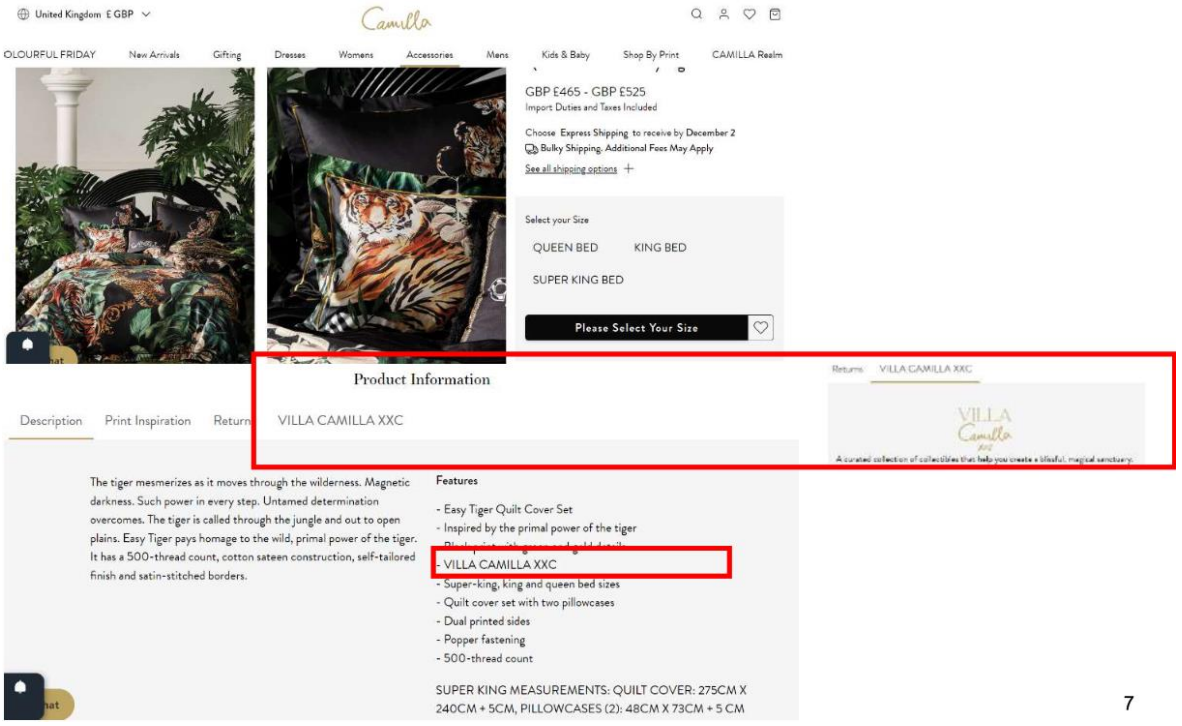
xv. Mr Phipson also points out that the figures in Exhibit CP9 include sales under marks that are not those relied on, namely MILLA BY CAMILLA and HOTEL FRANKS BY CAMILLA (the Opponents' childrenswear and menswear ranges). It is not fully clear whether those two marks are factored into the figures in Exhibit CP8 as part of the referenced "Camilla brand", but even if they are, I note that the great majority of the sales are under the Signature mark on its own. Mr Phipson states that UK sales of homeware goods 2019 - 2021, under both the Signature mark and the Villa Mark, totalled around AU$33k, of which less than AU$17k was under the Villa Mark.

Advertising - via social media / online platforms

xvi. The business has operated a Facebook and lnstagram page for the Camilla brand since 21 September 2009; a Pinterest account since the Spring/Summer 2010 collection; and a dedicated YouTube Channel since July 2014. Confirmatory screenshots of these platforms are at **Exhibit CP10**. The lnstagram account currently has 441,000 followers; the Facebook page currently has 256,866 likes, with 261,033 followers. The Pinterest account has 1.1 million monthly views; the YouTube channel has 12,154,938 views. These figures show a notable following, and reflect a global engagement, including Australia, USA and Mexico and 50 other countries. It is not shown what the social media profile is in the UK. What Mr Phipson says of the social media promotion in the UK is that "the business has engaged in paid social media advertising specifically targeting the UK market since 8 March 2020." **Exhibit CP11** contains screenshots of what is stated to be paid advertisements that appeared on Facebook and lnstagram used in the UK in May 2020. The three images show sponsored content by reference to the plain word Camilla and to the Opponents' uk.camilla.com website, announcing its "very first big International Sale". The dresses are shown for sale in pounds sterling. No information is given on how many 'likes' or 'follows' these shots received.

xvii. The “total brand keyword spend for Camilla” in 2018 was nearly AU$5k, rising to around AU$50k in 2020. It appears that this is a global spend. **Exhibit CP12** is stated to be an example of digital advertising spend for the UK, showing that approximately £299 was spent in May 2020. Mr Phipson states that the business has spent an additional AU$12,500, in each of 2021 and 2022, for Christmas gifting campaign promotional shoots, including: for homewares, used on the Camilla websites (including the UK website); in EDMs; paid advertising; and via its social media channels. (**Exhibit CP13** contains screenshots of the current Christmas campaign, but that content is after the Relevant Date.)

xviii. Mr Phipson describes **Exhibit CP14** as a representative sample of promotional material and activity specifically for the homeware products sold by reference to VILLA CAMILLA XXC. The witness acknowledges that this, again, is for the Opponents’ global promotion campaigns, but emphasises that it includes content for Instagram, Facebook and Pinterest, as well as for the UK Camilla website homepage. This does not seem to be from before the Relevant Date, but, anyway, the highpoint reference to VILLA CAMILLA XXC appears to be this image, which Mr Phipson submits educates the customer on Villa Camilla XXC production information:



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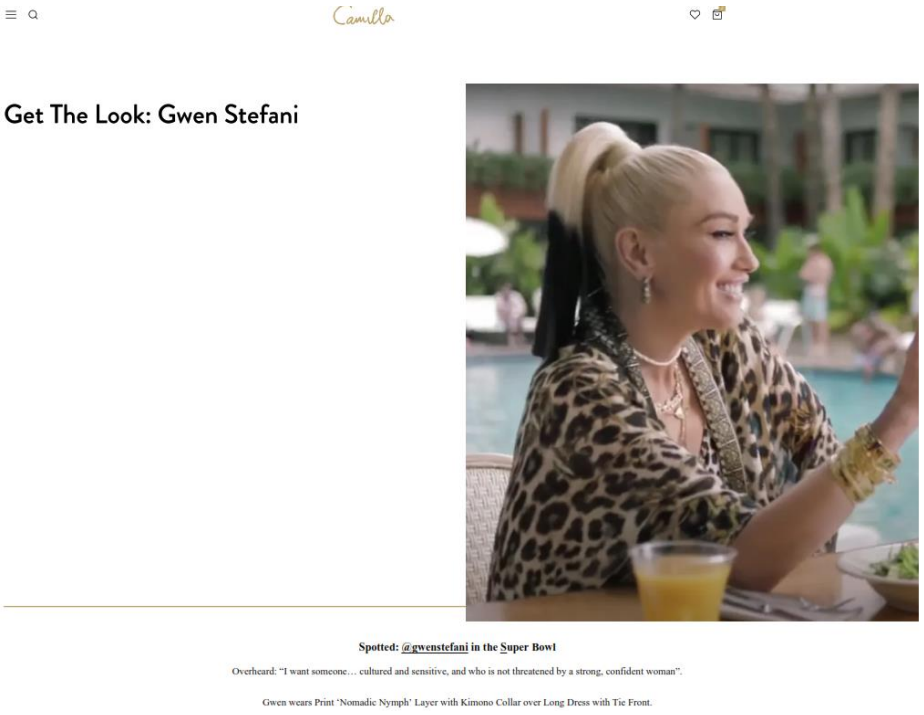
Press coverage

xix. Mr Phipson states that "*the Camilla brand received significant publicity as its products have been worn by international celebrities, including Oprah Winfrey, Beyoncé , Georgia Jagger and Jennifer Lopez amongst others*…", and that "*blog posts on the Camilla UK website at https://uk.camilla.com/blogs/camilla-world show high profile celebrities such as Heather Graham and Gwen Stefani wearing Camilla garments - evidencing that the Camilla brand has garnered high profile media attention globally, including in the UK*." **Exhibit CP15** includes this image, which appears to have been taken in the Super Bowl (presumably in the USA) and another image dates it as 12 February 2021 (two months before the Relevant Date).



xx. I do not agree with Mr Phipson's assertion that a snap taken of a celebrity, in America, wearing an item of the Opponent's clothing, then included by the Opponent in its blogpost, is evidence of the Camilla brand having garnered "high profile media attention in the UK". A similar photo, of the actress Heather Graham, is shown to have been taken after the Relevant Date.

xxi. More evidence is shown in **Exhibit CP16**, which comprises several extracts from articles from the Mail Online, which Mr Phipson states is "the website of the Daily Mail, the UK's highest circulated daily newspaper, and of its sister

paper The Mail on Sunday, with 22.4 million visitors a month." The first article is a reasonably lengthy article from 29 September 2015, including numerous photos of Beyoncé wearing several of the Opponent's garments. The article also refers to other celebrities who like the Opponent's brand, including Mariah Carey, Sofia Vergara, Jennifer Lopez, Georgia May Jagger, Goldie Hawn and Kate Hudson. What weakens this exhibit evidentially, is that it is shown to be an article for Daily Mail Australia. Even if the article, by virtue of being available online, were in fact accessible from the UK, it is entirely unknown how many in the UK, in fact, may have had sight of the article. I note that the 2015 article is shown to have just 11 shares and 6 comments. The article names three bloggers who are said to "love the Camilla style", but it describes them as "local stars", which, in context, is clearly Australia. The 2015 article states that "Camilla currently has 13 retail stores in Australia and is planning to open a Los Angeles shop in mid 2016 due to her rapidly growing international clientèle."

xxii. Another two Daily Mail articles are from May 2018 and focus on Camilla Franks's Australian Fashion Week. They have no UK focus. The fourth Daily Mail article is from June 2020, and is, largely, a personal profile of Camilla Franks, though it mentions that, in the UK, her signature kaftans and boho maxi dresses, and other "boho-luxe" designs, can be found in "the swankiest department stores: Harrods, Harvey Nichols and Selfridges."

xxiii. Two further articles in Exhibit CP16, from Hello! (UK) magazine and from AzureAzure.com, are from after the Relevant Date and, therefore, not relevant.

DECISION

21. In view of the detailed account of the evidence above, I find it convenient to deal first with the claims under section 5(3), giving my findings with regard to the claimed reputation, since the same evidence also bears on whether the Opponents' marks may benefit from any enhanced distinctive for the purposes of the section 5(2)(b) claim.

SECTION 5(3) CASE LAW PRINCIPLES

22. The relevant case law for section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel Corporation*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure*, Case C-487/07 and Case C-323/09, *Marks and Spencer v Interflora.* The legal principles are well establishes and are 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. Page 29 of 40

(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.

(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. Page 30 of 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*).

Findings for section 5(3)

23. A section 5(3) ground has certain potential advantages in that: (i) a mark with a reputation need only be brought to the mind of the relevant consumer, which is a threshold less onerous than a likelihood of confusion; and (ii) similarity of goods and services is not strictly required (though the closeness of the respective fields is a relevant factor). On the other hand, the initial challenge for a section 5(3) ground is to establish the requisite reputation in respect of the claimed trade mark and in respect of the claimed goods and services.

24. The Opponents claim a reputation in respect of all of the goods and services for which their earlier trade marks are registered.

25. The CJEU in *General Motors* gives guidance on assessing the existence of a reputation. Paragraph 27 of that judgment requires that I "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."

26. The bulk of the evidence in the present proceedings focuses on the sale of kaftans and dresses, but, for the reasons I give below, I do not find that the evidence, even in relation to those goods, is sufficiently compelling to establish the claimed reputation. The evidence in relation to homeware and any of the other registered goods is considerably less strong. The Villa Mark was launched at some point in 2021. Even if launched before the 16 April 2021 Relevant Date, it is most unlikely, in that time, to have secured a reputation, and the evidence of UK sales of homeware goods under the Villa Mark of under £10k, by some point in 2021, is not a sufficient basis for the claimed reputation.

27. In relation to the Opponents' kaftans and dresses sold under the Signature Mark, the evidence shows that they are finely made, with exotic prints, and are admired and worn by numerous famous women. However, while that may be the case, the evidence does not show that such popularity as may exist in Australia, the USA or elsewhere, extends to the UK.

28. There has been a UK version of the Camilla website since October 2018, several years before the 16 April 2021 Relevant Date, but no information has been provided about the numbers of visitors to that UK site, still less the numbers of sales achieved through that route.

29. Although there is evidence dating back to 2011 indicating promotion or sales of the goods in the UK, the number and geographical distribution of outlets or stockists are limited. Net a Porter is an online retailer and, therefore, has a potentially wider reach, but it is not entirely clear what value or number of goods were sold by / through Net a Porter to the UK public.

30. The scale and demonstrated penetration of the promotional activities are also insufficient. The number of promotional emails dispatched to a couple of thousand UK customers (the figure of five thousand UK subscribers not achieved until after

the Relevant Date) is not large, nor is it known how many of those recipients opened the emails or progressed to buy any goods. The Opponent started paying for UK-targeted social media just 13 months ahead of the Relevant Date, and the advertising expenditure seems very modest and the UK reach unclear.

31. The greatest level of sales revenue, in 2019, under the "Camilla brand" (which includes marks other than the Signature Mark) is around one million pounds. It is not clear whether that is the wholesale value or the retail value of the goods. The Opponents' goods appear aimed at the high end of the clothing market. As far as I can tell from the evidence, the dresses and kaftans are typically priced at over £700; consequently, although a million pounds is a significant sum, this could equate to annual sales in the region of 1500 units. I appreciate that some goods may be cheaper or more expensive, so the estimate is only approximate, but the volumes of sales constitute only a very tiny fraction of what is likely to be a multi-billion pound UK clothing market. On the other hand, I do not rule out that, in circumstances where the evidence content were stronger, a party selling garments at high prices, beyond the financial reach of most of the UK public, and which consequently sold in lower numbers, may well be able to demonstrate the requisite reputation.

32. For the above reasons, taking the evidence in the round, I find that the earlier marks in this case do not benefit from a reputation or enhanced distinctive character in the UK. In the absence of a reputation, **the claim under section 5(3) inevitably fails**.

THE SECTION 5(2)(B) CLAIM

33. Determination of a section 5(2)(b) claim must be made in light of the following principles, 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. The principles are:

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

(a) 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;

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

(c) 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;

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

(e) 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;

(f) 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;

(g) 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;

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

(i) 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;

(j) 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 the goods and services

34. Case law requires that:

"*In assessing the similarity of the goods … all the relevant factors relating to those goods .. themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary*".[3]

35. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)* the European Court ruled that goods can be considered as identical when the goods designated by the trade mark application the earlier mark are included in a more general category designated by the earlier mark or vice versa.[4]

36. It is settled case law that assessing whether goods and services at issue are similar must be on the basis of all relevant factors. These may include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary.[5] Goods and services are complementary when "… there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."[6]

37. Section 60A of the Act states that goods and services are not to be regarded as being similar to each other simply because they appear in the same class, nor are they to be regarded as being dissimilar from each other on the ground that they appear in different classes.

3 The essence of case law points on similarity made in relation to goods applies correspondingly to services.
4 See paragraph 29 of the judgment of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T- 133/05
5 See *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296].
6 *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

38. The Contested Goods are in Classes 9, 16 and 25. In this partial opposition against the Applicant's Contested Goods, the Opponents rely on all of the registered goods and services under each of the earlier trade marks. I shall consider each earlier registration in turn.

CIP's opposition based on the Villa Mark

The Contested Goods in Class 9

Class 9: *electronic publications (downloadable); downloadable software applications; electronic publications, namely, electronic books, magazines, newsletters, newspapers, brochures, manuals; electronic publications in the form of e-books*

39. CIP's statement of grounds explained its claim that the Contested Goods in Class 9 are similar to the goods under the Villa Registration, on the basis that they are "similar and complementary" … "*all being items that fashion houses regularly manufacture and sell and therefore fall under the lifestyle-type goods of the Opponent, including, by way of example only, the homeware goods found in Classes 20, 24 and 27*" of the Villa Registration (my underlining). The Opponents' submissions in lieu slightly varied the expression of the argument as the Class 9 goods being items that "*fashion houses regularly manufacture and utilise, for example via websites or apps, to promote their collections. They therefore fall into the category of lifestyle-type goods that the Opponents may be expected to sell including therefore the homeware goods of Class 24 of the Earlier Registrations*."

40. The Contested Goods in Class 9 - which are, essentially, software and electronic publications - differ in nature, purpose, method of use, uses, to any of the goods in the classes offered as examples by CIP, which, broadly, are bedding, soft furnishings and floor coverings. The goods are not in competition. It is not clear to me what the Opponent means by "lifestyle-type goods", and I do not consider the Contested Goods in Class 9 to fall naturally under that description.

41. I acknowledge that case law recognises that complementarity, even as a sole factor, is capable of being the basis for a finding of similarity. However, I have major misgivings over the claim that the Contested Class 9 goods (electronic publications) are complementary to bed linen and serviettes, or any of the Class 24 goods of the

Earlier Registrations. While electronic publications may have an important role in promoting the sale of any goods or services, a trade mark is not being used in that context to create a market for the electronic publications. Such promotional publications are not being offered for sale to the average consumer and they are secondary to the sale of the goods that their content may promote. There is no clear evidence to make out the Opponents' implied claim that the average consumer would assume that it is the sellers of, say, *cushion covers* or *curtains of textile or plastic* who also typically manufacture (themselves, in-house) electronic promotional publications such that customers may think that the responsibility for those different goods lies with the same undertaking. The Opponent's line of argument, when considered in respect of other of the Class 9 goods – software or e-books for instance – seems still less sustainable.

42. However, whatever my own doubts about the Opponents' claim that the Contested Goods in Class 9 are complementary in the way described above, I note that, in its counterstatement, the Applicant provides its own, different, basis for similarity. The Applicant admits that the Contested goods in Class 9 are similar and complementary to the Class 16 goods under CIP's Villa Mark. I set out the Class 16 goods under CIP's Villa Mark in the background and pleadings part of this decision. They are largely 'stationery' types of goods, but I note that the specification includes "books", and it is, perhaps, this inclusion that the Applicant had in mind in making its admission of similarity. I will, therefore, proceed on the basis that the Contested Goods in Class 9 are **similar** to CIP's "books" in Class 16, and that some such as *electronic publications, namely, electronic books* are, perhaps, even highly similar.

The Contested Goods in Class 16

Class 16: *Books; dictionaries; newspapers; periodicals; magazines; catalogs; brochures; newsletters, albums, note books, diaries; agendas; posters, calendars, maps, photo albums, photographs; office requisites (except furniture); folders for documents; office binders; instructional and teaching material (except apparatus); stationery, pencil sharpeners; eraser; pen holder; ballpoint pens; pencils, fountain pens; markers; highlighters; adhesive labels and prints, envelopes, letter paper;*

business cards; greeting cards; paper bags; gift bags; gift cards; paper shopping bags. (The entire Class 16 registration.)

43. In its counterstatement, the Applicant agrees that the Contested goods in Class 16 are **identical and similar** to the Class 16 goods under CIP's Villa Mark (but denies that this leads to a likelihood of confusion).

The Contested Goods in Class 25

Class 25: *Clothing, footwear and headgear*. (The entire Class 25 registration.)

44. CIP's statement of grounds had explained its claim that the Contested Goods in Class 25 are similar to the goods and services under the Villa Registration, on the same basis as it had for the Contested Class 9 goods, premised on a notion of "lifestyle-type goods*."* The Opponents' submissions in lieu argued that the Contested Goods in Class 25 are similar and complementary to the class 24 goods of the Villa Mark, in particular "household textiles". The Applicant denies that the Contested goods in Class 25 are similar and complementary to the Class 24 goods under CIP's Villa Mark.

45. I find that the Contested Goods in Class 25 differ in nature, purpose, method of use, uses, when compared to any of the goods under the Villa Mark, including the "household textiles" emphasised in the Opponents' submissions in lieu. Nor are the goods in competition, complementary or typically sold alongside one another. In my view, the Contested Goods in Class 25 are **not similar** to any of the goods or services under the Villa Mark.

46. Since some similarity of goods or services is a required component under section 5(2)(b), CIP's opposition on this ground, based on the Villa Registration, inevitably fails in respect of the Contested Goods in Class 25.

CAP's opposition based on the Signature Mark

The Contested Goods in Class 9 and Class 16

47. CAP's statement of grounds claimed that the Contested Goods in Class 9 and Class 16 are complementary to CAP's Class 35 retail services and, again, argues that they are "similar and complementary" to the goods and services under the Signature Registration… "*all being items that fashion houses, all being items that fashion*

houses regularly manufacture and sell and therefore fall under the lifestyle type goods that the opponent may be expected to sell including, by way of example only, the homeware goods found in class 24 of the Earlier Registration." The Applicant, in its counterstatement, denied that the Contested Goods in Class 9 and Class 16 are similar or complementary to the goods or services covered by the Signature Registration.

48. For the reasons I gave when considering the same sort of argument against these Contested Goods under CIP's opposition, I agree with the Applicant. The Contested Goods in Classes 9 and 16 differ in nature, purpose, method of use, uses, to any of the goods or services under the Signature Mark. Nor are the goods in competition, complementary or typically sold alongside one another. In my view, the Contested Goods in Class 9 and 16 are **not similar** to any of the goods or services under the Signature Mark.

49. Since some similarity of goods or services is a required component under section 5(2)(b), CAP's opposition on this ground, based on the Signature Registration, inevitably **fails in respect of the Contested Goods in Class 9 and 16**.

The Contested Goods in Class 25

Class 25: *Clothing, footwear and headgear*. (The entire Class 25 registration.)

50. In its counterstatement, the Applicant admits that the parties' goods in Class 25 are **identical** (but denies that this leads to a likelihood of confusion).

Comparison of the marks

51. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in Bimbo that: "... *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."[7]

52. It would, therefore, be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

CIP's earlier Villa mark	**The Applicant's contested mark**
VILLA CAMILLA XXC	CAMILLA SAAB
CAP's earlier Signature Mark	**The Applicant's contested mark**
	CAMILLA SAAB

53. The overall impression of the Applicant's CAP mark derives from the two words Camilla and Saab. CAP argues that, although the Applicant's Contested Mark incorporates the additional word SAAB, the word Camilla is the dominant element because it is the longer of the two elements and because consumers tend to focus on the beginning of a mark. I acknowledge that there is case law to support the latter contention, but it is only a rough guide. In my view, where there are just two words as here, the differential impact of one word preceding the other is marginal, but given it is clearly the longer word, I accept that it may, overall, have the slightly greater degree of dominance in the Contested Mark, though, in my view, the Contested Mark will be read as a unit (comprising a first and a last name, where the second word is more unusual as a name than the first word, and is thereby more distinctive).

7 *Bimbo SA v OHIM, Case C-591/12P (*at paragraph 34).

54. Dealing first with the **Signature Mark**: its overall impression is that it is the word CAMILLA rendered with a handwritten stylisation. I find the stylisation is not negligible and does contribute to the overall impression, but it is the word itself that dominates.

55. The Opponents' submissions in lieu contend that "the addition of SAAB at the end of the Contested Mark is less likely to be noticed by the average consumer who is deemed to pay more attention to the beginning rather than the end of a mark." This strikes me as stretching matters to breaking point, as there is no reason to suppose that the average consumer would be likely not to notice the second word. It is there; it is clear and distinctive, and is part of the name unit. The shared presence of the word Camilla gives rise in my view to a **medium degree of visual and aural similarity**.

56. The Opponents' submissions in lieu contend that "conceptually, neither mark has any meaning although both marks would be recognised as being a girl's name." I acknowledge that case law supports the view that names which do not convey a 'general and abstract idea' lack any "concept" thus making a **conceptual comparison impossible**.[8] In the present case, neither Camilla nor Saab has a clear and immediately recognisable semantic content, nor has either name become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname. I agree with Opponents' submission that both marks will be seen as referring to a female called Camilla, and would note that the average consumer would perceive the Applicant's Contested Mark as signifying a female whose surname is Saab. However, case law of the General Court has stated that the mere fact that the relevant public will associate the sign the registration of which is sought with a first name and a surname and, thus, with a specific, imaginary or real person, and that the earlier mark will be perceived as designating a person called by that name, is irrelevant for the purposes of a conceptual comparison of the signs at issue.[9]

8 *Luciano Sandrone v EUIPO* Case T-268/18, paragraphs 81 – 90.
9 *Luciano*, at paragraph 90.

57. Moving to consider the Villa Mark, I find that the overall impression of that mark derives from the words Villa, Camilla, followed by the three letters "XXC". The Opponents' submissions in lieu acknowledge that the CAMILLA element is not at the beginning of the Villa Mark, but submit that it is nonetheless the most dominant part of the Villa Mark. The basis of that submission is their contention that "*VILLA is a descriptive term such that the consumer, aware of the goods and services protected by the Earlier Registration, would understand the reference to 'villa' to mean 'house of Camilla', i.e. denoting the fashion house of the CAMILLA brand*." In my view, the average consumer will not perceive VILLA as "House of" in the fashion house sense; I find that used in relation to homeware goods (as the evidence shows) it would more likely be understood by its ordinary meaning of a house, typically in the countryside or near the sea, especially in southern Europe, and often one that people can rent for a holiday. The homeware goods designated would be understood as for furnishing and use in that house. I find that "Villa" in respect of homeware goods may be considered allusive, but, since it is not what the UK average consumer would typically call their own home or house, it does not lack distinctive character. I also particularly bear in mind that the only basis of my finding of similarity between the goods rests with CIP's registration for "books" in Class 16 under its Villa Mark, and I find that Villa is neither allusive nor descriptive in respect of books.[10] The Villa component also works to rhyme and pair with Camilla, and those two words together are more dominant than the three letters, which are reminiscent of roman numerals; though I accept that the word Camilla may be viewed as having the greater dominance, even if only as the longest element.

58. The shared presence of the word Camilla gives rise in my view to no more than a **medium degree of visual and aural similarity**. There is a conceptual difference in that the Villa Mark carries the concept I have described, albeit an allusive one. The Villa Mark also, of course, includes the first name of the Contested Mark (though not the distinctive second name).

The average consumer and the nature of the purchasing act

59. Trade mark questions must be approached from the point of view of the presumed expectations of the average consumer - a legal construct who is reasonably well

10 Even if it were said that "books do furnish a room".

informed and reasonably circumspect; "average" denotes that the person is typical.[11] It is necessary to determine who is the average consumer for the respective goods and services and how the consumer is likely to select them. 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.[8]

60. The average consumer of the goods that I have found to be identical or similar will be the general public: buying clothing etc. in Class 25; software applications and electronic publications in Class 9; books and stationery in Class 16. The average consumer is likely to take into consideration various factors when selecting the (various) goods at issue. The degree of attention will vary: for instance, it will typically be lower for buying an item of stationery or a magazine, or a tee-shirt; higher for other goods, perhaps such as downloadable software applications or an expensive dress. In buying the goods and services, the trade marks may likely be seen on websites or on labels, so visual considerations will be important. However, I bear in mind that the goods and services may sometimes be the subject of word-of-mouth recommendations and, therefore, aural considerations are also relevant.

Distinctive character of the earlier trade marks

61. Registered trade marks possess varying degrees of inherent distinctive character - ranging from low because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. A greater degree of distinctiveness of an earlier mark may tend to increase the likelihood of confusion. In *Lloyd Schuhfabrik* 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 …*

11 Per Birss J (as he then was) 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), paragraph 60.

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)."[12]

62. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services specified in the registration and, secondly, by reference to the way it is perceived by the relevant public.[13]

63. In *Harman International Industries, Inc v OHIM*, Case C-51/09P, the CJEU found that:

"*Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname 'Becker' which the Board of Appeal noted is common*."

In *El Corte Inglés, SA v OHIM*, Case T-39/10, the General Court found that:

55. Nevertheless, it is also clear from the case-law that that rule, drawn from experience, cannot be applied automatically without taking account of the specific features of each case …. Likewise, according to the case-law cited in the previous paragraph, the distinctive character of the first name is a fact that should play a role in the implementation of that rule based on experience."

12 *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97.
13 *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

64. The distinctive character of the Signature Mark, is, essentially, founded on the name Camilla, which is a name that, if not very common in the UK, is not especially unusual either, and the average consumer will instantly recognise it as a female name, having encountered it, for instance, as the name of the UK's current queen. It is neither suggestive nor allusive of a characteristic of the goods, and the average consumer is accustomed to encountering personal names as trade marks, especially in relation to fashion items, where the name may be that of the designer (as in the present case). On an inherent basis, that forename is of lowish distinctive character. Having reviewed the evidence in some detail, I conclude that the use that has been made of the Signature Mark is not sufficient to have enhanced its distinctive character for the average consumer in the UK (the general public at large). If I am wrong in that conclusion, and the sales of fine and costly kaftans and dresses, through a very limited number of outlets, since as early as 2011/12, has had a modest degree of enhancing influence, I would still find the Signature Mark to have no more than medium degree of distinctive character. My primary assessment is that the Signature Mark has a lower than a medium degree of distinctive character.

65. I find that it is only relevant to consider the distinctive character of the Villa Mark, insofar as it is registered for "books" in Class 16. This is because the other goods for which the Villa Mark is registered are not similar to the Contested Goods and are, therefore, not relevant for considering the factors contributing to an assessment of a likelihood of confusion, including the question of distinctive character. In my view, the words Villa Camilla XXC are neither suggestive nor allusive of a characteristic of the goods (books) and the Villa Mark may be considered to have a medium degree of distinctive character. Its distinctiveness has not been enhanced through use.

Conclusion as to likelihood of confusion

66. Taking into account the failure of the oppositions under section 5(2)(b) where I have found no similarity between the goods, my consideration of a likelihood of confusion is confined to the following:

(i) "Camilla Saab" compared with CIP's "Villa Camilla XXC" where the Contested Goods include some in Class 9 that are highly similar and some in Class 16 that are identical or similar; and

(ii) "Camilla Saab" compared with CAP's "Camilla" (Signature) mark where the Contested Goods in Class 25 are identical.

67. Deciding whether there is a likelihood of confusion is not based on simply applying a formula and seeing what comes out at the end; rather, it requires a global assessment of all relevant factors in accordance with case law principles, especially those outlined at my paragraph 33 above. The factors are interdependent and include the consideration that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. It is also necessary for me to keep in mind the distinctive character of the Opponents' trade marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be aware of the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

68. There are two types of confusion that may occur. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC (as he then was), sitting as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark,

but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.'"

69. I also recall another decision by Mr Purvis, namely *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which he pointed out that the level of distinctive character of a mark is only likely to increase the likelihood of confusion to the extent that it resides in the element or elements of the marks that are identical or similar. He said:

> "38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.
>
> 39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

70. I also note the guidance of Arnold J. (as he then was) in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), where he considered the impact of the CJEU's judgment in *Bimbo,* Case C-591/12P, on the court's earlier judgment in *Medion v Thomson* which concerns a particular form of indirect confusion. The judge said:

> "19. …[the] assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the

significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

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

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

71. I have found neither the Villa Mark, nor the Signature Mark to be similar to more than a medium degree, and even allowing that the UK general public may pay a lowish degree of attention when purchasing the identical goods at issue, I find that the differences between the parties' marks are significant enough for them not to be mistaken for each other in what I have found to be a largely visual purchasing process. The average consumer will notice and remember the distinctive second word "Saab" of the Contested Mark, and will note its absence from the Signature Mark; the Villa Mark, has additional notable points of difference, in the positioning of the shared word, the opening word "Villa" and the final three letters "XXC". Even allowing for the effect of imperfect recollection, there is no likelihood of direct confusion.

72. This brings me on to the likelihood of indirect confusion. In paragraph 17 of his decision in *L.A. Sugar*, Mr Purvis gave the following examples of when indirect confusion could occur:

"(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)."

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

"12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

74. I have considered whether the UK general public, noting that the parties' marks all contain the word "Camilla", will conclude that the Contested Mark is another brand of CAP or CIP, giving rise to a likelihood of indirect confusion.

75. The common element between the parties' marks is "Camilla", which the Opponents agree will be perceived as a girl's name. In my view, that name will be sufficiently familiar to the UK public that it may be considered to have a lowish distinctive character on an inherent basis (and even on a generous construction of the evidence of use of the Signature Mark to have no more than medium degree of distinctive character for clothing). The Contested Mark will be seen as a unit comprised of a forename and surname; the principle in *Medion* does not apply in that circumstance. In my view, the distinctive character of the shared element is too low to lead the average consumer to assume that no-one else but the Opponents would be using it in a trade mark at all. The word "Saab" in the Contested Mark is distinctive and will be seen as a surname qualifying the first name. I find there is no proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.

Outcome: The opposition under section 5(2)(b) ground fails.

THE SECTION 5(4)(A) CLAIM

76. I can deal with the section 5(4)(a) claim relatively briefly.

77. I note that in *Marks and Spencer PLC v Interflora,* [2012] EWCA (Civ) 1501, Lewinson L.J. had cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that *"a substantial number"* of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the later Court of Appeal decision in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. He concluded that "… if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement." Although *Comic*

Enterprises was an infringement case, the principles apply equally under section 5(2).[14]

78. The upshot of this is that although the test for likelihood of confusion under trade mark law may differ from the test for misrepresentation under the law of passing off, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

79. The oppositions have failed under the section 5(2)(b) claims, and in my view the position is no better under the section 5(4)(a) claim.

80. The Signature Mark features a handwriting stylisation; a perceptible advantage of the 5(4)(a) claim may therefore be that the sign relied on is simply the plain word "Camilla", which provides a greater degree of similarity to the applied-for mark. However, the stylisation present in the Signature Mark has been a consideration only of the most marginal significance in my conclusions under section 5(2)(b). While the Opponents' evidence may establish goodwill under the plain word sign in respect of, say, women's clothing, the Oppponents have anyway been able to rely on the full extent of the specifications of their earlier registrations, which largely align with the goods and services in respect of which goodwill is claimed under the section 5(4)(a) ground. The oppositions failed under section 5(2)(b) based on goods that are identical and similar, hence my conclusion that the Opponents are in no better position under its section 5(4)(a) claim.

81. The section 5(4)(a) claim fails for the reasons I give above, so my following comments have little or no consequence in the present proceedings. The Trade Marks (Relative Grounds) Order 2007 includes the following provision (with my underlining):

> **Refusing to register a mark on a ground mentioned in section 5 of the Trade Marks Act 1994**

14 See *Soulcycle Inc v Matalan Ltd,* [2017] EWHC 496 (Ch).

2. The registrar shall not refuse to register a trade mark on a ground mentioned in section 5 of the Trade Marks Act 1994 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right.

82. Mr Phipson states in his witness statement that "the goodwill in the Camilla brand in ultimately owned by [CIP] by virtue of a Deed of Assignment and an Intra-group Licence between [CAP] and [CIP] pending post-completion steps of a transaction that finalised on 9 December 2022.]"

83. I note that the section 5(4)(a) claim has been brought by CAP, not by CIP. While CIP is a wholly owned subsidiary of CAP, Mr Phipson's evidence statement at least raises a question over whether CAP technically had good standing to bring the section 5(4)(a) claim.

OVERALL OUTCOME

84. Both oppositions have failed and the UK designation of international registration No. 1608869 may proceed to registration for all of its goods and services as set out in the Annex to this decision.

COSTS

85. The Applicant is entitled to a fair contribution towards its costs, taking account of the scale published in the annex to Tribunal Practice Notice (2/2016).

- Considering the statement of grounds and preparing counterstatements in each of the oppositions £400
- Considering the Opponents' evidence £400
- Preparing written submissions in lieu of a hearing £400

Total: £1200

86. I order Camilla IP Pty Ltd and Camilla Australia Pty Ltd to pay Fabri Camilla the sum of £1200. This sum may be paid in full by either of the related parties or each may pay half of the £1200 total. The costs award is to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 15th day of August 2024

Matthew Williams

For the Registrar

ANNEX

Full list of the Applicant's goods and services

Class 9: *Software; game software; electronic publications (downloadable); downloadable software applications; electronic communications apparatus and instruments; televisions; radios; radio transmitters; radiotelephones; record players; CD, DVD, films, video tapes and video recorders; blank and recordable CD-ROMs and DVDs; portable and non-portable MP3 players; photographic and cinematographic apparatus, cameras; equipment for filming and broadcasting TV shows; electronic game software; electronic game software for playing games via televisions or computers; electronic book readers, telephones and mobile phones, tablets, desktop and laptop computers, mini-portable computers; electronic publications, namely, electronic books, magazines, newsletters, newspapers, brochures, manuals; electronic publications in the form of e-books, computer programs for use on the Internet and the global network; digital video and music (downloadable); software pre-installed on electronic boards or computers, on tablets, on desktop and laptop computers, on netbooks; downloadable MP3 files and MP3 recordings; audio books; computer hardware and software for creating, processing and integrating text, audio, graphics, photographs and moving images into multimedia applications and contents; computer software, for ebook-readers, for mobile phones, for tablets that provides web access to applications and services through systems connected to the internet; USB memory media and related accessories.*

Class 16: *Books; dictionaries; newspapers; periodicals; magazines; catalogs; brochures; newsletters, albums, note books, diaries; agendas; posters, calendars, maps, photo albums, photographs; office requisites (except furniture); folders for documents; office binders; instructional and teaching material (except apparatus); stationery, pencil sharpeners; eraser; pen holder; ballpoint pens; pencils, fountain pens; markers;*

highlighters; adhesive labels and prints, envelopes, letter paper; business cards; greeting cards; paper bags; gift bags; gift cards; paper shopping bags.

Class 25: *Clothing, footwear and headgear.*

Class 41: *Providing on-line electronic publications, not downloadable; production of radio and television programs; videotape editing; organization of exhibitions for cultural or educational purposes; organization of shows [impresario services]; film production, other than advertising films; videotape film production; production of music; production of shows; cinema presentations; publication of books; publication of texts, other than publicity texts; publication of electronic books and journals on-line; live performances (presentation of -); theater productions; scriptwriting services; writing of texts, other than publicity texts; videotaping; photographic reporting; news reporters services.*

Class 42: *Providing online non-downloadable computer software, entertainment, game, show, teaching and reading software programs and applications.*
