O/0874/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3978918
IN THE NAME OF TRADECRAFT BRANDS LTD T/A ALTORY
IN RESPECT OF THE TRADE MARK

IN CLASSES 18, 24, 25, 27 & 35

AND

THE OPPOSITION THERETO UNDER NO. 446677
BY GOLDEN GOOSE S.P.A.

Background and pleadings

1. TRADECRAFT BRANDS LTD T/A ALTORY ("the applicant") applied to register trade mark no. 3978918 in the UK on 13 November 2023, for the mark set out on the cover page of this decision. It was accepted and published in the Trade Marks Journal on 29 December 2023 in respect of the following goods and services:

> Class 18: *Trunks and travelling bags; gymbags; shopping bags; sports bags; tote bags; backpacks; beach bags; briefcases; card cases; handbags; pocket wallets; umbrellas; purses; rucksacks; leather and imitations of leather; goods made of leather and imitations of leather namely bags, belts, boxes, briefcases, card cases, luggage, purses and wallets.*
>
> Class 24: *Towels of textile; yoga towels.*
>
> Class 25: *Clothing; sports clothing; footwear; sports footwear; headgear; sports headgear.*
>
> Class 27: *Yoga mats.*
>
> Class 35: *Wholesale services, online and offline retail services, trading and export services, all in relation to the sale of trunks and travelling bags, gymbags, shopping bags, sports bags, tote bags, backpacks, beach bag, briefcases, card cases, handbags, pocket wallets, umbrellas, purses, rucksacks, leather and imitations of leather and, towels of textile, yoga towels, clothing, sports clothing, footwear, sports footwear, headgear, sports headgear, yoga mats, goods made of leather and imitations of leather namely bags, belts, boxes, briefcases, card cases, luggage, purses and wallets.*

2. GOLDEN GOOSE S.P.A. ("the opponent") partially opposed the trade mark in respect of all goods in classes 18 & 25 and all services in class 35,[1] relying on section

[1] As is discussed later in this decision, the opponent appears to slightly reduce the services opposed within its final written submissions.

5(2)(b) of the Trade Marks Act 1994 ("the Act"). This is on the basis of its earlier UK trade mark set out below:

UK registration no. 3819616

Filing date: 12 August 2022

Registration date: 4 November 2022

Trade mark:

Relying on all goods as registered, those being:

Class 18: *Leather and imitations of leather not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas and parasols; walking sticks; whips, harness and saddlery; briefcases; sport bags; bags for climbers; bags for campers; casual bags; beach bags; fanny packs; boston bags; clutch bags (hand bags); holdalls; gladstone bags; gym bags; hiking bags; key cases; chain mesh bags; overnight bags; cylinder bags; satchels; shoulder bags; baggage; multipurpose sports bags; bags for carrying pets; cloth shopping bags; carry-on bags; Make-up bags, not fitted; bags (Game -) [hunting accessories]; garment bags for travel; leather bags and wallets; net bags for shopping; travel bags for footwear; sling bags for carrying infants; shopping bags made of textile; leather bags, suitcases and wallets; bags (envelopes, pouches) of leather, for packaging; bags for jewellery of textile materials (empty); briefcases; card cases (notecases); credit card holders (wallets); handbag frames; hand bags; hat boxes of leather; haversacks; key cases [leatherware]; music cases; wallets; purses; rucksacks; suitcase handles; attaché cases; leather travelling suitcases; tool bags of leather, empty; travelling trunks; travelling sets (leatherware); vanity cases, not fitted; boxes, of leather or leatherboard; cases, of leather or leatherboard; chin straps, of leather; coverings of skins (furs); fur; straps*

(Leather -); leather cords; leather thongs; leather thread; leatherboard; moleskin (imitation of leather); leather shoulder straps; collars for animals.

Class 25: *Clothing, footwear, headgear; clothing of imitations of leather; leather clothing; clothing for gymnastics; dresses; bathrobes; bandanas [neckerchiefs]; bibs, not of paper; berets; underwear; smocks; boas (necklets); braces for clothing [suspenders]; corsets; stockings; socks; shirts; bodices [lingerie]; hats; coats; hoods (clothing); belts (clothing objects); money belts (clothing); tights; collars (clothing); detachable collars; ear muffs (clothing); layettes [clothing]; suits; beachwear; masquerade costumes; neckties; ascots; headbands (clothing); pocket squares; jackets [clothing]; garters; skirts; pinafore dresses; girdles; gloves(clothing); ski gloves; mackintoshes; knitwear [clothing]; jersey clothing; leg warmers; leggings (trousers); liveries; hosiery; sweaters; handwarmers [clothing]; skorts; boxer shorts; waistcoats; trousers; parkas; furs for clothing; pyjamas; wristlets [clothing]; ponchos; sweaters; stocking suspenders; sock suspenders; brassieres; sandals; bath sandals; shoes; bath slippers; gymnastic shoes; beach shoes; training shoes; shawls; sashes for wear; briefs; topcoats; outerclothing; petticoats; chemises; half-boots; boots; stoles (fur); T-shirts; combinations (clothing); peaks (Cap-); Wooden shoes (footwear); soles for shoes.*

3. By virtue of its earlier filing date, the above mark constitutes an earlier mark in accordance with section 6 of the Act. As the earlier mark had not been registered for a period of five years at the date on which the contested application was filed, it is not yet subject to the use provisions set out in section 6A of the Act. The opponent may therefore rely on all of its goods in these proceedings, without the requirement to prove use of the mark in respect of the same.

4. The opponent argues that the respective goods are identical, the services are similar, and the marks are highly similar. The opponent argues there is therefore a likelihood of confusion including a likelihood of association between the marks.

5. The applicant filed a counterstatement denying that the marks are similar enough to cause a likelihood of confusion.

6. Neither side filed evidence in these proceedings.

7. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

8. Both sides are represented in these proceedings. The applicant is represented by Amagufa Solutions Limited. The opponent is represented by Boult Wade Tennant LLP.

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

Decision

Section 5(2)(b)

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

> "5(2) A trade mark shall not be registered if because-
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

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

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

<u>The Principles</u>

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

The principles

(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

13. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

14. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

"… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP

> TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

16. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)****,*** Case T-325/06, the General Court ("GC") stated that there is complementarity where:

> "...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".

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

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

18. Before I proceed with the comparison of the goods and services in this instance, I note there appears to be a change in the opponent's position between its pleadings and its final written submissions. In the opponent's pleadings, it set out that it opposed all services in class 35 of the application. However, within its final written submissions, the opponent submitted as follows:

"As pleaded, the Opponent opposes the entirety of the Application for class 35. However, in preparing these submissions it has taken the pragmatic decision not to maintain its opposition in respect of the class 35 services insofar as they are for towels of textile, yoga towels and yoga mats."

19. I take from this that the services in class 35 relating to towels of textile, yoga towels and yoga mats are no longer opposed.

20. With this in mind, the goods and services for comparison are as follows:

Earlier goods	**Contested goods and services**
Class 18: *Leather and imitations of leather not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas and parasols; walking sticks; whips, harness and saddlery; briefcases; sport bags; bags for climbers; bags for campers; casual bags; beach bags; fanny packs; boston bags; clutch bags (hand bags); holdalls; gladstone bags; gym bags; hiking bags; key cases; chain mesh bags; overnight bags; cylinder bags; satchels; shoulder bags; baggage; multipurpose sports bags; bags for carrying pets; cloth shopping bags; carry-on bags; Make-up bags, not fitted; bags (Game -) [hunting accessories]; garment bags for travel; leather bags and wallets; net bags for shopping; travel bags for footwear; sling bags for carrying infants; shopping bags made of textile; leather bags, suitcases and wallets; bags (envelopes, pouches)*	Class 18: *Trunks and travelling bags; gymbags; shopping bags; sports bags; tote bags; backpacks; beach bags; briefcases; card cases; handbags; pocket wallets; umbrellas; purses; rucksacks; leather and imitations of leather; goods made of leather and imitations of leather namely bags, belts, boxes, briefcases, card cases, luggage, purses and wallets.*

of leather, for packaging; bags for jewellery of textile materials (empty); briefcases; card cases (notecases); credit card holders (wallets); handbag frames; hand bags; hat boxes of leather; haversacks; key cases [leatherware]; music cases; wallets; purses; rucksacks; suitcase handles; attaché cases; leather travelling suitcases; tool bags of leather, empty; travelling trunks; travelling sets (leatherware); vanity cases, not fitted; boxes, of leather or leatherboard; cases, of leather or leatherboard; chin straps, of leather; coverings of skins (furs); fur; straps (Leather -); leather cords; leather thongs; leather thread; leatherboard; moleskin (imitation of leather); leather shoulder straps; collars for animals.	
Class 25: *Clothing, footwear, headgear; clothing of imitations of leather; leather clothing; clothing for gymnastics; dresses; bathrobes; bandanas [neckerchiefs]; bibs, not of paper; berets; underwear; smocks; boas (necklets); braces for clothing [suspenders]; corsets; stockings; socks; shirts; bodices [lingerie]; hats; coats; hoods (clothing); belts (clothing objects); money belts (clothing); tights; collars (clothing); detachable collars; ear muffs (clothing); layettes [clothing]; suits; beachwear; masquerade costumes; neckties; ascots;*	Class 25: *Clothing; sports clothing; footwear; sports footwear; headgear; sports headgear.*

headbands (clothing); pocket squares; jackets [clothing]; garters; skirts; pinafore dresses; girdles; gloves(clothing); ski gloves; mackintoshes; knitwear [clothing]; jersey clothing; leg warmers; leggings (trousers); liveries; hosiery; sweaters; handwarmers [clothing]; skorts; boxer shorts; waistcoats; trousers; parkas; furs for clothing; pyjamas; wristlets [clothing]; ponchos; sweaters; stocking suspenders; sock suspenders; brassieres; sandals; bath sandals; shoes; bath slippers; gymnastic shoes; beach shoes; training shoes; shawls; sashes for wear; briefs; topcoats; outerclothing; petticoats; chemises; half-boots; boots; stoles (fur); T-shirts; combinations (clothing); peaks (Cap-); Wooden shoes (footwear); soles for shoes.	

	Class 35: *Wholesale services, online and offline retail services, trading and export services, all in relation to the sale of trunks and travelling bags, gymbags, shopping bags, sports bags, tote bags, backpacks, beach bag, briefcases, card cases, handbags, pocket wallets, umbrellas, purses, rucksacks, leather and imitations of leather, clothing, sports clothing, footwear, sports footwear, headgear, sports headgear, goods made of leather and imitations of leather namely bags, belts, boxes, briefcases, card cases, luggage, purses and wallets.*

21. The opponent has pleaded that the contested goods in classes 18 and 25 of specification are all identical, either self-evidently, or on the basis that they are encompassed by the broader terms included within the opponent's specification. The applicant has not denied this, and as such I do not consider this point to be in dispute. I accept that all of the applicant's goods in class 18 and 25 are identical to the opponent's earlier goods, either self-evidently, or in accordance with the principles set out in *Meric*.

22. The opponent has also pleaded that the contested services are similar to the earlier goods. Again, the applicant has not denied this similarity, however, I note the opponent did not set out the level of similarity the earlier goods and contested services share. This is therefore, for me to decide.

23. Firstly, I consider the following services covered by the applicant:

Class 35: *Wholesale services, online and offline retail services, trading […] services, all in relation to the sale of trunks and travelling bags, gymbags, shopping bags, sports bags, tote bags, backpacks, beach bag, briefcases, card cases, handbags, pocket wallets, umbrellas, purses, rucksacks, leather and imitations of leather, clothing, sports clothing, footwear, sports footwear, headgear, goods made of leather and imitations of leather namely bags, belts, boxes, briefcases, card cases, luggage, purses and wallets.*

24. The services above all comprise wholesale and retail services relating to goods which are included identically (either self-evidently or in accordance with the principles set out in *Meric)* to those for which the opponent holds protection under its earlier mark. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

25. In *Tony Van Gulck v Wasabi Frog Ltd,* Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

> "9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are *'similar'* to goods are not clear cut."

26. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v OHIM,* Case T-105/05, at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgewood Plc v Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded that:

> i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
>
> ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services <u>normally</u> associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
>
> iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
>
> iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

27. With consideration to the case law above, it is my view that the contested retail, wholesale and trading services will undoubtedly be different in nature, purpose and method of use to opponent's corresponding goods. However, I consider these to be complementary, on the basis that the goods will be essential for the retail services of those goods, and the consumer will likely believe that the goods and services derive from the same entity. Further, the trade channels and users will all overlap. Overall, I consider the contested retail services outlined similar to the earlier goods to a medium degree.

28. Next, I consider the applicant's services below:

> Class 35: *Wholesale services, online and offline retail services, trading […] services, all in relation to the sale of sports headgear.*

29. I note firstly, that it is my primary finding that some types of *sports headgear* may be encompassed within the opponent's class 25 goods *headgear*. If I am correct in this finding, I find the retail and wholesale services for those goods similar to the goods themselves to a medium degree, for the same reasons I have set out in paragraph 27 above. However, in case I am wrong, I will also consider the similarity should these goods cover protective headgear for sports only, such as would properly fall into class 9.

30. I note the earlier goods cover clothing generally in class 25, which will encompass various types of sports clothing, in addition to goods such as sport bags in class 18. These goods will obviously differ to the contested services in nature, method of use and purpose. Further, I do not consider these to be strictly complementary, on the basis that certain types of sports items will not necessarily be important or essential to the retail of other types of sporting goods. However, there is likely to be an overlap in trade channels, and the goods and services will likely often be offered by the same entities. Further, the users will often be shared. For example, a consumer looking to purchase sports headgear may also purchase their sports clothing and sports bag at the same time from the same store, engaging with both the goods and the retail services when doing so. This example is also true for a professional consumer engaging with the wholesale and trading services, with a view to stocking its own store. Finally, I remind myself that similarity between the goods and services is not in dispute in this instance. Overall, if they are not similar to a medium degree, I find there to be a low level of similarity between the services outlined above and the earlier goods in this instance.

31. Finally, I consider the following services filed by the applicant:

> *Export services, all in relation to the sale of trunks and travelling bags, gymbags, shopping bags, sports bags, tote bags, backpacks, beach bag,*

> *briefcases, card cases, handbags, pocket wallets, umbrellas, purses, rucksacks, leather and imitations of leather and clothing, sports clothing, footwear, sports footwear, headgear, sports headgear, goods made of leather and imitations of leather namely bags, belts, boxes, briefcases, card cases, luggage, purses and wallets.*

32. As above, I consider the nature, method of use and purpose of the earlier goods and these contested services differ. Further, I do not consider these to be in competition. I consider it possible there may be the occasional overlap in trade channels, with an entity offering the goods possibly also dealing with the trading and export services on behalf of interested purchasers of those goods in other territories, but without evidence on this point, I do not consider this pronounced enough for the consumer to assume the goods and services will likely be offered by the same economic undertaking on a regular basis, or for a finding of complementarity on that basis. I note there may also be an overlap in users, mainly intermediaries wishing to import and go on to sell the goods. Finally, I consider that the similarity between the goods and services is not in dispute in this instance. Overall, I find a low level of similarity between the goods and services.

Comparison of marks

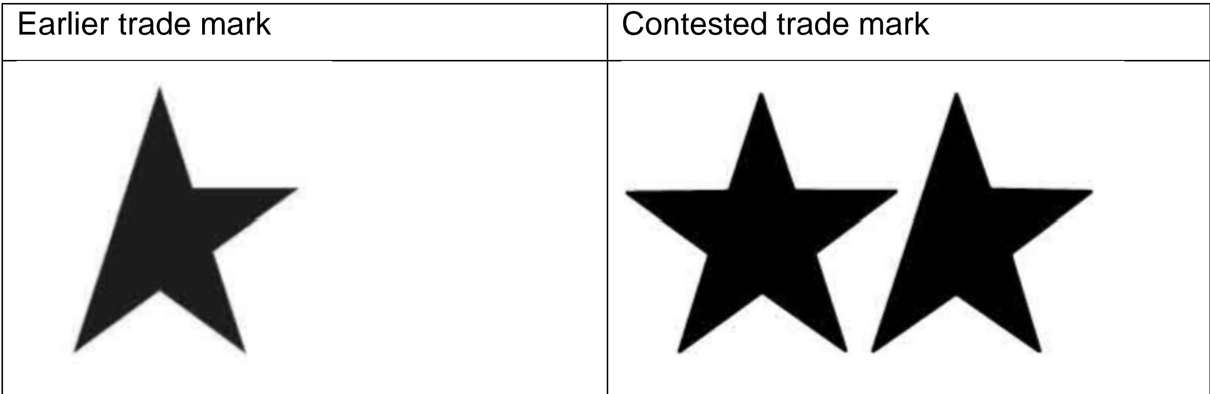
33. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

34. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

35. The respective trade marks are shown below:



Earlier trade mark	Contested trade mark

36. The earlier mark appears to be a device of a star missing its fifth point on the upper lefthand side, presented in a solid black colour. It is in this element that the overall impression of the mark resides.

37. In respect of the contested mark, I note the applicant has submitted the first star acts as the dominant element on the basis that “…the four pointed star serves as a shadow for the five pointed star; the Sign thereby obtaining an almost 3D like effect…”. I note at this point that I do not view the second star as a shadow in the contested mark, and I do not see the 3D effect referred to. I disagree with the applicant’s submissions on this point.

38. In my view, contested mark will be considered a combination of two stars. The first is an ordinary complete and solid black star. The second is a star missing its fifth point on the upper lefthand side, also presented in a solid black colour. It is my view that the star missing its fifth point is more distinctive than the ordinary solid star due to its

uniqueness. Whilst both elements contribute to the overall impression of the mark, I find that the second star plays a greater role in the same for these reasons.

Visual comparison

39. I note there are a number of submissions from the applicant with regards to the visual comparison of the marks. The applicant submits that the contested mark has two stars as opposed to the one star of the contested mark, that the second star is a shadow of the first creating a 3D effect, and that negative space between the two stars together in the contested mark form an upside down “A”. I have already dismissed the submissions regarding the shadow effect and 3D nature of the contested mark. Whilst I agree that the contested mark contains two stars, I do not agree that the space between the two stars will be considered as an upside down “A”. I struggle to see this letter even after this has been pointed out to me, and I do not accept it would be noticed by the consumer.

40. Visually, the marks coincide due to the second star in the contested mark being identical to the earlier mark. They differ as the second mark also contains a second star, although bar the missing fifth point, this is stylistically the same as the star in the earlier mark and the second star. Overall, I consider the marks visually similar to just above a medium degree.

Aural comparison

41. Neither mark contains any verbal element in this instance. The marks are therefore aurally neutral.

Conceptual comparison

42. The marks coincide conceptually on the basis that they both convey the concept of a star or stars. They are conceptually similar to at least a high degree.

Average consumer and the purchasing act

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

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

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

37. The average consumer for most of the goods in this instance will be members of the general public. I consider these are goods that will be purchased fairly frequently, although they are unlikely to be everyday purchases. The price point of the goods will vary considerably, and whilst in some instances the price of the goods will be high, I do not consider this will raise the level of attention paid towards the categories of goods as a whole. In respect of the class 18 and class 25 goods, the general public will consider factors such as the aesthetics, quality, practicality and materials used. Overall, I find the general public will pay a medium level of attention when purchasing the goods.

38. I consider there will also be a group of professional consumers of the goods in classes 18 and 25, who will purchase these in order to stock retail stores for example. These consumers are likely to pay a higher degree of attention to the goods than the general public, due to the responsibility of their position and the impact the purchases may have on their business. I consider these consumers will pay at least an above medium level of attention to the same.

39. In respect of the retail services, again the average consumer will primarily be a member of the general public, who will likely consider the practicality, reliability and reputation of the establishment. They will pay a medium level of attention to the same. However, the consumer of the wholesale services, in addition to the trade and export services, will likely primarily be a professional. These professionals are likely to also consider factors such as the reputation and reliability of the services, but will pay a higher level of attention overall, considering the impact using the correct services may have on their business. They will likely pay between at least an above medium level of attention to the same.

40. All of the goods and the retail services will primarily be engaged with visually. The bulk of the goods such as bags and clothing will likely be purchased via online or physical retail stores, although the professional consumer may purchase these from online or physical wholesale stores, or via brochures and catalogues. However, I note that there may also be a verbal element to the purchasing process. For example, verbal assistance may be sought from retail or wholesale staff. I therefore cannot completely discount the aural comparison. In respect of the wholesale and trade and export services, whilst these may also be sought visually, for example by way of visual advertisements and online, they may also be discussed over the phone, and as such both visual and aural considerations will play a role in the same.

Distinctive character of the earlier trade mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases

C108/97 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)."

46. No evidence has been filed in these proceedings, and so I only have the inherent position to consider.

47. The earlier mark comprises an image of a star which is missing its upper lefthand point. I note the applicant submits:

"9. Due to the universal character of four- and five-pointed stars as signs of relatively low distinctiveness; the demand for distinctiveness and differentiation from earlier marks must necessarily be judged accordingly, and it is submitted that the Sign is sufficiently different from the registration so as to distinguish itself graphically from the Registration."

48. I agree with the applicant that an ordinary five-point star will be of low distinctiveness due its relatively ordinary and somewhat decorative nature. However, I do not agree that a five-point star which is missing one of its five points, such as is the case with the earlier mark, can be put into the same category as an ordinary star to which no alteration has been made. The applicant has filed no evidence demonstrating that a four-point star such as the one in the earlier mark has "universal character", and it is my view this is not the case. The removal of the fifth point of the star in the earlier mark appears intentional and unusual, and whilst it will still not hold

the highest level of distinctive character inherently, it is my view the earlier mark will nonetheless be inherently distinctive to a medium degree.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

49. Prior to reaching a decision under section 5(2), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 12 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctiveness of the common elements is key.[2] I must keep in mind that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that how the goods and services are obtained may have a bearing on how likely the consumer is to be confused.

50. In respect of section 5(2)(b) of the Act, there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.[3]

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[2] See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

[3] *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

51. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

52. In this instance, I found the goods and services to range from identical to similar to a low degree. I found the marks to be visually similar to just above a medium degree, aurally neutral, and conceptually similar to at least a high degree. I found the element of the marks that is shared identically to be the more distinctive element in the contested mark and to therefore play a greater role in its overall impression. I found this element (that being the earlier mark) to hold a medium degree of distinctive character.

53. Considering all of the relevant factors in this case, it is my view that where the consumer is a member of the general public paying a medium degree of attention, and where the goods and services are similar to at least a low degree, there will be a likelihood of direct confusion between the marks. It is my view that the consumer is likely in those circumstances to focus on and remember the more distinctive partial star included identically in both marks, and pay less attention to the addition of an ordinary but similarly stylised star next to the same. Keeping in mind the consumers imperfect recollection, it is my view that the result of this will be that a significant portion of these consumers are likely to directly mistake one mark for the other. However, where the consumer is a professional paying an above-medium level of attention, it is my view that those consumers are more likely to notice and recall the differences between the marks, and not be directly confused. I therefore find a likelihood of direct confusion in respect of all opposed goods and services with the exception of those below:

> Class 35: *Wholesale services, […] trading and export services, all in relation to the sale of trunks and travelling bags, gymbags, shopping bags, sports bags, tote bags, backpacks, beach bag, briefcases, card cases, handbags, pocket wallets, umbrellas, purses, rucksacks, leather and imitations of leather and, clothing, sports clothing, footwear, sports footwear, headgear, sports headgear,*

goods made of leather and imitations of leather namely bags, belts, boxes, briefcases, card cases, luggage, purses and wallets.

54. I therefore move on to consider the likelihood of indirect confusion between the marks. In *L.A. Sugar* (cited above) Mr Iain Purvis Q.C. (as he then was), as the Appointed Person set out three examples of when indirect confusion may occur as below:

> 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)."

55. I note that the examples above were intended to be illustrative and are not exhaustive. I also keep in mind *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, in which Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

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

> "18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.
>
> 19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.
>
> 20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the 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."

57. I consider again all the factors of this case. I note particularly that the identical corresponding element, that being the four-point star, is the only element in the first mark and is the most distinctive element in the second mark. It is also my view that this element does not form a unit as such with the other star contained in the contested mark, and therefore plays an independent role within the same.

58. I note this is not a case that falls directly into any of the (non-exhaustive) *L.A. Sugar* categories, and being marks made up entirely of device elements, it is not a comparison that directly corresponds with the typical *Medion* case. However, considering the identical element is the most (or only) distinctive element in each mark, that this element holds a medium level of distinctive character inherently, and considering that the difference between the marks comprises only a single additional star (that is very similarly stylised to the identical elements), it is my view there is a proper basis for finding a likelihood of indirect confusion between the marks in this instance. I consider in the circumstances that it would be logical for the consumer to assume that the identical element represents a shared economic origin between the goods and services in this instance, and that the introduction (or omission) of a very simple and similar second star simply serves to indicate to the consumer a different range or type of goods and services, or an alternate brand from the same (or linked) economic entity. Whilst I have considered the possibility that the shared element might instead be put down to coincidence, it is my view that considering all of the relevant factors, this is the less likely scenario in this instance. I therefore find a likelihood of indirect confusion in respect of all of the opposed identical or similar goods and services in this instance.

Final Remarks

59. The opposition has succeeded in its entirety. Subject to any successful appeal, the application will be refused for all of the opposed goods and services. It will therefore proceed to registration in respect of the following unopposed goods and services only:

Class 24: *Towels of textile; yoga towels.*

Class 27: *Yoga mats.*

Class 35: *Wholesale services, online and offline retail services, trading and export services, all in relation to towels of textile, yoga towels*, *yoga mats.*

COSTS

60. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £700 as a contribution towards the cost of the proceedings, in accordance with Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Official fees:	£100
Preparing the TM7 and considering the TM8:	£250
Preparing and filing written submissions:	£350

61. I therefore order TRADECRAFT BRANDS LTD T/A ALTORY to pay GOLDEN GOOSE S.P.A. the sum of £700. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 23rd day of September 2025

R. Le Breton
For the Registrar