

**O/0895/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003796753  
BY KAJA LEKSANDER TO REGISTER:**

**TU SOLUS**

**Tu Solus**

**(SERIES OF TWO)**

**AS TRADE MARKS IN CLASS 25**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 436370 BY  
J SAINSBURY PLC**

## BACKGROUND AND PLEADINGS

1. On 8 June 2022, Kaja Leksander (“the applicant”) applied to register the series of trade marks shown on the cover of this decision (“the application”) in the UK for the following goods:

Class 25: Articles of clothing, underwear and footwear for men, women, children and infants and all parts thereof.

2. The application was published for opposition purposes on 1 July 2022 and, on 21 September 2022, it was opposed by J Sainsbury PLC (“the opponent”).
3. The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In respect of the sections 5(2)(b) and 5(3) grounds, the opponent relies on the following series of marks:

A solid black logo consisting of the letters 'T' and 'u' in a stylized, bold, sans-serif font. The 'T' is tall and narrow, and the 'u' is shorter and wider, positioned to the right of the 'T'.

An outline version of the 'Tu' logo, where the letters 'T' and 'u' are defined by a thin black border. The shape and proportions are identical to the solid black version above.

(series of two)

UK registration no. 2643457

Filing date 26 November 2012; registration date 7 June 2013

Relying on some goods, namely:

Class 25: Articles of clothing, footwear and headgear; hosiery; socks; underwear; nightwear; swimwear.

(“the opponent’s registration”)

4. Under the section 5(2)(b) ground, the opponent claims that the marks in its registration are highly similar to the marks in the application and that the goods at

issue are identical. Further, the opponent argues that it has made extensive use of the marks in its registration and, therefore, they enjoy an enhanced degree of distinctive character. As a result, the opponent claims that there exists a likelihood of confusion between the parties' marks, which includes a likelihood of association.

5. Under the section 5(3) ground, the opponent claims that the marks in its registration are reputed throughout the UK. In light of the similarity of the marks at issue and the identity of the services, the opponent claims that consumers would believe that there exists a link between the marks and that consumers would believe them to be marks used by the same undertaking or that they share an economic connection. As a result, the opponent claims that the applicant's use of her marks would take unfair advantage of the opponent's registration and that it would be detrimental to the reputation and/or repute of the marks within it.

6. Under the section 5(4)(a) ground, the opponent relies on the unregistered sign 'TU' that it claims to have used throughout the UK since 2004 on the following goods:

Class 25: Articles of clothing, footwear and headgear; hosiery; socks; underwear; nightwear; swimwear.

7. The opponent claims that it has built a substantial goodwill in its sign in the UK and that the use of the marks in the application will constitute a misrepresentation that will deceive customers into thinking that the goods provided under those marks are the goods of the opponent or are somehow endorsed by the opponent. The opponent argues that this would result in damage to its business.

8. The applicant filed a counterstatement denying the claims made and requesting that the opponent provide proof of use of its marks in respect of all goods relied upon.

9. Both parties filed evidence in chief and the opponent elected to file evidence in reply. A hearing took place before me on 24 June 2024, by video conference. The opponent was represented by Ms Eleanor Merrett of CMC Cameron McKenna

Nabarro Olswang LLP, being the firm that has represented the opponent throughout these proceedings. The applicant was not present at the hearing but did file written submissions in lieu of her attendance. The applicant has not been professionally represented throughout these proceedings. The opponent filed a skeleton argument in advance of the hearing.

10. 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.

## **EVIDENCE**

11. The opponent's evidence came in the form of the witness statements of Tania Smith dated 20 March and 19 July 2023. The latter most dated statement is that which was filed in reply. Ms Smith is a Commercial Lawyer in the Corporate Services department of the opponent. While it is not clear how long she has held this role, she confirms that she has been in the continuous employ of the opponent since 1 October 2000, with a previous tenure with the opponent between 30 July 1984 and 11 March 1995. Ms Smith's first statement is accompanied by 16 exhibits, being those labelled TS01 to TS16. The purpose of her first statement was to demonstrate the extent of use of the opponent's registration, to prove the reputation of the same and the level of goodwill enjoyed by the business. Ms Smith's second statement is accompanied by no further exhibits and was adduced to provide clarity to paragraph 10 of her initial statement.<sup>1</sup>

12. The applicant's evidence came in the form of the witness statement of the applicant herself. The statement is dated 22 May 2023 and is accompanied by seven exhibits, being those labelled KL1 to KL7. The purpose of the applicant's statement

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<sup>1</sup> Which made an incorrect reference to the fact that turnover figures (which I will discuss below) covered third party brands as well as 'TU' clothing goods.

was to demonstrate use of her mark since 2022, what the current logo looks like, her brand's current rating, the public opinion of her brand and, lastly, the lack of connection with the opponent's brand by customers.

13. I do not intend to summarise the evidence filed by the parties in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

## **PRELIMINARY ISSUE**

14. There are a number of points that I wish to discuss as preliminary issues in respect of certain points that the applicant has raised in her defence, in the evidence filed and in her written submissions.

### Evidence of use

15. Throughout these proceedings, the applicant has filed evidence of her own use of the marks in the application. This evidence covers use from 2022 to 2023. If this evidence is provided to support a claim that there has been honest concurrent use of the marks, then it is insufficient. I say this because the case law that governs the issue of honest concurrent use sets out that such use must be for a prolonged period of time.<sup>2</sup> I note that the applicant's evidence seems to suggest that her use began in January 2022, being just six months prior to the filing date of her application (being the relevant date in these proceedings). Clearly, this is not a prolonged period of time and can, in no way, support a claim that there exists honest concurrent use.

### Lack of evidence of confusion

16. The applicant claims that her evidence, namely the evidence as to reviews of her own goods by consumers, makes it clear that her customers have not made any

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<sup>2</sup> See the case of *Budejovický Budvar NP v Anheuser-Busch Inc*, Case C-482/09 wherein the concurrent use took place over a period of almost 30 years.

connection between her marks and the opponent's marks.<sup>3</sup> The reviews shown to me in evidence are undated. I appreciate that they are listed as being within 'the past 6 months' or within 'the past year', however, the printout showing the reviews is undated and it is not clear as to what period is covered by 'the past year'. Even if the reviews were dated, the lack of comment on other brands in an online review is not necessarily indicative of a lack of confusion. In making her argument on this point, the applicant also sets out that the opponent has failed to prove the existence of actual confusion. While evidence of actual confusion may be of assistance, the lack of such evidence is not fatal to an opponent's claim. I say this because a likelihood of confusion is a notional assessment based on a number of different factors (that I will consider throughout this decision).

17. Lastly in respect of this point, I will say that while I appreciate that there are instances where a lack of evidence of confusion can be a factor in Tribunal proceedings,<sup>4</sup> the case law is very clear that the length of time that the parties have been using their marks alongside each other is a relevant factor. In the present case, six months of use by the applicant is not particularly longstanding. Further, and perhaps more importantly, the applicant's evidence in respect of its use is limited in scale (showing £27,958.04 between January and March 2022 and £103,030.66 from April 2022 to March 2023)<sup>5</sup> so it is not clear how many consumers are likely to have come into contact with both parties' marks. As a result, I do not consider that the applicant's argument on this point is of any real assistance and I will say no more about it.

#### The applicant's submissions in lieu

18. In her written submissions, the applicant raised a number of points that are of no relevance to the present decision. I do not intend to discuss all of these points as they are numerous but, as an example, I refer to the applicant's reference to the 'strength and protection' of her trade mark and the distinctiveness of the same (with

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<sup>3</sup> KL6

<sup>4</sup> See paragraphs 34 and 35 of *INCOGNITO*, Case BL O/078/22

<sup>5</sup> In respect of the April 2022 to March 2023 figures, it is likely that the majority of these fall after the relevant date, being 8 June 2022, which is just two months after this period began.

reference to section 3 of the Act). Firstly, section 3 of the Act is not relevant to the present decision as it relates to absolute grounds for opposition or invalidity, neither of which are at issue here. Secondly, the applicant is not required to show that her mark has been used or that it enjoys any ‘strength or protection’. While an applicant to opposition proceedings can file evidence of use to demonstrate honest concurrent use, I have already discussed whether this applies to the present case above (it does not). While there are points in the submissions that require further discussion during the relevant assessments below, I am of the view that the majority of the submissions are misguided in their relevance to opposition proceedings before the Tribunal<sup>6</sup> and are of no assistance.

## **DECISION**

### **Proof of use**

19. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) 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,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

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<sup>6</sup> I note that the submissions also make reference to section 10 of the Act, which is reserved for claims of trade mark infringement, again being something that is not relevant here.

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

20. Section 6A is also relevant. It reads:

“(1) This section applies where:

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

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

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

(3) The use conditions are met if –

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

(4) For these purposes –

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

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

21. Section 100 of the Act is also relevant. It reads:

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

22. Given the filing date for the opponent’s registration, the marks within it qualify as earlier trade marks under the above provisions. The opponent’s registration completed its registration process over five years prior to the filing date of the application. As set out above, the applicant requested that the opponent provide proof of use in respect of its marks. Therefore, the marks in the opponent’s registration are subject to the use provisions.

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

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

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

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

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

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

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

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

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

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

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

24. As per section 6A of the Act (cited above), the relevant period for the present assessment is the five-year period prior to the filing date of the application, being 8 June 2022. The relevant period is, therefore, 9 June 2017 to 8 June 2022 (“the relevant period”).

25. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”<sup>7</sup> because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

26. I believe that I can deal with the issue of use relatively briefly. In doing so, I will begin with the sales figures that the opponent has provided. The figures are provided via a table that covers the years 2018/19 to 2022/23. In the table itself, the figures are categorised as womenswear, menswear and childrenswear, however, the narrative evidence of Ms Smith confirms that the figures provided cover the sale of clothing, footwear, headgear, hosiery, socks and underwear. Further, Ms Smith sets out that the figures are approximate and that the annual sales figures have actually exceeded the amounts provided in the table.

27. The sales figures are as follows:

<b>Financial Year:</b>	<b>Sales Revenue (£)</b>
2018/19:	900,000,000
2019/20:	900,000,000
2020/21:	800,000,000
2021/22:	900,000,000
2022/23:	900,000,000
Total:	4,400,000,000

28. In considering the figures provided, I wish to briefly point out that I have nothing to suggest what is the opponent’s financial year. Therefore, I am unable to determine with any accuracy the actual level of use for 2022, being when the relevant period came to an end. For example, the majority of the figures for 2022/23 are likely to include sales that accrued after 8 June 2022 meaning that it is not possible for me to determine what proportion of those figures are relevant to the present assessment. Having said that, the figures are so substantial that this has very little impact on the

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<sup>7</sup> *Jumpman* BL O/222/16

assessment I must make. I note that the opponent's first witness statement explains that, due to the manner in which the opponent categorises its sales, the figures include those of third-party brands (such as FatFace) which are sold within TU sections of Sainsbury's stores or on its website. However, this was corrected in the evidence reply wherein it was confirmed by Ms Smith that upon further review of the sales figures provided, it was found that the figures given in her first statement (being those reproduced above) did in fact only cover 'TU' branded goods.

29. In addition to the above, the opponent has provided additional evidence as to its market position directly in relation to the TU brand. This comes in the form of a report generated by a data analytics and brand consulting company, KANTAR.<sup>8</sup> The report shows a number of graphs, the first two are dated 8 January 2023 and show that, at that time, Tu was the 10<sup>th</sup> largest retailer in the clothing market by market value and that it was the 6<sup>th</sup> largest by market volume. While dated after the relevant date, this evidence is capable of shedding light backwards to the fact that the opponent enjoyed a high level of success in the market as a result of longstanding use at a high volume.<sup>9</sup> In addition, a third graph is provided that shows Tu's brand health as tracked by YouGov. This sets out that between 1 March 2016 and 1 December 2022, Tu's brand health score ranged from 10.9 to 19.6. The chart confirms that Tu's ranking rose from sixth to fourth during this time. For comparison, these charts include rankings and scores for other large UK-based clothing retailers such as Next, F&F Clothing, Marks & Spencer and George.

30. While I have no cause for concern when considering Ms Smith's statement in her narrative evidence, particularly given that it is unchallenged and accompanied by a sworn statement of truth, I note that the opponent has provided a number of printouts of the opponent's Tu website that show the types of goods offered.<sup>10</sup> These are taken from the internet archive facility, The Wayback Machine, and are from within the relevant period. I note that these include categories such as

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<sup>8</sup> TS02

<sup>9</sup> I say this because such rankings in competitive markets such as clothing do not come over night and neither do they come after a short period of time.

<sup>10</sup> TS04

women's clothing, men's clothing and kid's clothing. The images also include a range of different types of clothes such as jumpers, shirts, jackets, dresses, suits, 'layering clothing', baby clothing, beanies (a form of headwear), children's hats, underwear and swimwear. In addition, the categories of the website show goods under the banners of 'lingerie' and 'shoes'.

31. The evidence also discusses the opponent's advertising spend in respect of its Tu branding. Ms Smith confirms that the brand has been advertised and promoted continually since its launch in 2004. Figures have been provided for 2017 onwards. As was the case with the sales figures, these figures are to be treated as those 'in excess of'. In addition, I note that the costs cover those associated with different types of advertising such as affiliate, display, poster, press, search and social, video on demand, radio, cinema and partnership advertising. The figures are as follows:

<b>Year:</b>	<b>Advertising spend (£):</b>
2017:	3,515,000
2018:	3,480,000
2019:	7,800,000
2020:	4,330,000
2021:	5,775,000
2022:	1,345,000
Total:	26,245,000

32. Examples of the opponent's advertising efforts are provided in evidence.<sup>11</sup> I do not intend to repeat these here but note that all of the adverts provided include use of the TU branding in the same form as the marks in the opponent's registration.

33. There are approximately 60 pages provided that speak to the press coverage of the opponent's Tu brand.<sup>12</sup> I do not intend to discuss this evidence in any great detail save to say that it covers articles of various regional and UK-wide

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<sup>11</sup> See TS06 and TS07

<sup>12</sup> See TS13 and TS14, though I note that some of the evidence is from outside of the relevant period.

publications that discuss the Tu brand. The publications provided include the likes of The Sun, the Daily Record, Manchester Evening News and Hello! Magazine. I note that the articles provided show images of the opponent's clothing goods and these include a range of clothing such as children's clothing and women's clothing.

34. While I appreciate that there is additional evidence that speaks to celebrity partnerships/collaborations, social media and the opponent's strategy of working with social media influencers, I am of the view that the evidence discussed above is more than sufficient to prove that the opponent has genuinely used its mark during the relevant period. Clearly, the opponent has obtained significant success in respect of its Tu brand and this is reflected in the sales figures provided (which total approximately £4 billion)<sup>13</sup>. The level of success of the opponents' brand is compounded by the evidence that speaks to Tu's presence in the relevant market. In addition, the opponent has incurred a significant advertising spend during the relevant period. Lastly, I am satisfied that the opponent's narrative evidence sufficiently demonstrates that it has used its mark on a wide range of goods. I have described the range of use shown to me at paragraph 30 above and such use is, in my view, sufficient to warrant a finding that genuine use applies to all of the goods relied upon.<sup>14</sup>

### **Section 5(2)(b): legislation and case law**

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

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

(a) [...]

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<sup>13</sup> Even taking into account that some of the figures provided are likely to come from after the relevant period, the level of turnover is still, in my view, likely to be in this region.

<sup>14</sup> On this point, I note that there are no goods expressly in relation to 'hosiery' or 'nightwear'. However, such goods are sub-categories of clothing, generally. Further, hosiery may also fall within lingerie, which is shown as being a sub-category of goods on the opponent's website during the relevant period. Given the significant level of use, I consider it reasonable to infer use in respect of such goods. In any event, I do not consider that anything turns on the use in relation to these goods given the presence of the broad term "article of clothing".

(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 or association with the earlier trade mark.”

36. Section 5A of the Act states as follows:

“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.”

37. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a 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

38. The parties' goods are as follows:

<b>The opponent's goods</b>	<b>The applicant's goods</b>
<u>Class 25</u> Articles of clothing, footwear and headgear; hosiery; socks; underwear; nightwear; swimwear.	<u>Class 25</u> Articles of clothing, underwear and footwear for men, women, children and infants and all parts thereof.

39. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. 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 that:

"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".

40. 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.

41. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“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.”

42. The opponent’s specification includes the broad term “articles of clothing, footwear and headgear”. This term is sufficiently broad enough to cover any type of clothing, footwear or headgear. Given that the applicant’s goods are “articles of clothing, underwear and footwear for men, women, children and infants”, they can be said to either be self-evidently identical to the opponent’s goods (“articles of clothing” appears identically in both specifications, for example) or are those that are identical under the principle outlined in *Meric* because they fall within the broader terms of the opponent (“underwear” is a type of clothing and, therefore, falls within “articles of clothing”, for example).

43. In addition to providing the goods themselves, the applicant’s specification includes the term “all parts thereof”. This term is not the same as the actual clothing goods of the opponent themselves. This is because the opponent’s goods are finished articles selected by consumers for their ‘ready-to-wear’ attributes, whereas the

applicant's term is primarily selected to fulfil a role in the manufacturing or creation of clothing. As far as I understand it, the average consumer for clothing is the general public whereas the average consumer for clothing components is likely to be a smaller demographic made up of those with the intention of making clothes, either for personal use or on a professional level. When it comes to the goods' physical nature, whilst the finished articles are likely to differ, there is likely to be a degree of similarity both in materials and to necessitate compatibility between the components and the finished article. Similarly, it seems likely that there could be an overlap in the trade channels through which the goods reach the market, though they may not always be sold alongside one another, or indeed in the same retail establishment. Given their different states, the goods are unlikely to be competitive, though there is certainly an opportunity for complementarity.<sup>15</sup> Whilst I keep in mind that one good being a component of another is not sufficient for a finding of similarity,<sup>16</sup> on balance I find the goods are similar to a medium degree.

### **The average consumer and the nature of the purchasing act**

44. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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

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<sup>15</sup> On the basis that, as per the case of *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the components are important to the clothing goods themselves and consumers are likely to believe the relationship between the goods is such that they originate from the same undertaking.

<sup>16</sup> *Les Editions Albert René v OHIM*, Case T-336/03

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.”

45. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

46. The applicant’s submissions discuss the way in which her goods reach the market. I note that she refers to this as being a shrewd strategy wherein she set up online storefronts on prominent platforms such as eBay and Etsy. While I appreciate that clothing goods often reach the market place via online stores, the assessment I must make here is a notional one and takes into account all ways in which the goods reach the market. So while the applicant may not currently sell her goods in physical stores, her terms are still capable of being sold that way and this is the relevant factor I must take into account.<sup>17</sup>

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<sup>17</sup> On this point, I remind myself that, as per the case of *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, marketing considerations are not relevant when considering the likelihood of confusion.

47. The average consumer for the goods at issue will, for the most part, be members of the general public at large. However, some goods (such as parts of clothing) are also likely to be selected by business users. The goods will be available via general retailers and their online equivalents though I appreciate that parts of clothing may also be available from the producer directly, be that at their premises or online. Regardless of the type of retailer, the goods will be available on shelves or racks where they will be self-selected by the consumer after a visual inspection. For online selections, the goods will be selected after consideration of images on webpages. As a result, I find that visual considerations will dominate the selection process, though I do not discount an aural component playing a role by way of advice from sales assistants or word of mouth recommendations. The goods at issue will be selected relatively frequently. In terms of cost, this will vary from cheap goods such as socks to more expensive clothing items such as designer leather jackets, for example. Regardless of the price paid or the identity of the consumer, the selection process will involve consideration to ordinary factors such as fit, style and materials used. In my view, the level of attention paid will be mostly medium although I do appreciate that this may be lower for more casual purchases such as socks, for example.

### **Comparison of the marks**

48. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

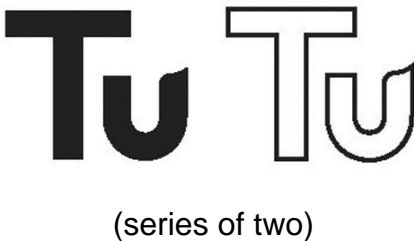
49. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is

sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

51. The respective trade marks are shown below:

The opponent’s registration	The application
 <p>(series of two)</p>	<p>TU SOLUS            Tu Solus            (series of two)</p>

52. The marks in the application are word only marks and can, therefore, be used in any standard typeface. I note that the applicant has provided evidence of how she uses her mark on her product packaging.<sup>18</sup> This appears in a highly stylised typeface. While I make no comment as to whether that is an acceptable variant of her marks, the way in which she actually uses the marks is not relevant to the comparison I must make here. This is because I am required to consider the mark in all of the ways in which it can be used, not how it is actually used. For example, the nature of the applicant’s word only marks is such that it is possible for them to be presented in an identical (or at least very highly similar) typeface to that used by the opponent in its registration. As a result, the applicant’s evidence as to her actual use of the mark is not relevant and I will say no more about it.

<sup>18</sup> KL7

53. The marks in the application are both word only marks for the same words with the only difference between them coming in their use of case. The first mark is presented in upper case whereas the second is presented in title case. These differences make no impact on the marks. I say this because, as word only marks, they are capable of being used in either upper case, lower case or any customary combination of the two (such as title case). As a result, I will consider the marks in the application as one and will simply refer to them as 'the applicant's mark' for the purposes of this comparison. I will take a similar approach with the marks in the opponent's registration. I do so because those marks only differ in their use of colour, with the first mark being solid black with the second being white with a black border. I do not consider that these differences are sufficient to warrant a separate comparison and I will, therefore, treat them as one which I will refer to as, simply, 'the opponent's mark'.

#### Overall Impression

54. The applicant's mark is a word only mark made up of the two words, 'TU SOLUS'. The applicant has made arguments in respect of the meaning of the mark but I will address these when considering the conceptual comparison below. For now, I will simply state that the overall impression of the mark is dominated by the two words equally. As for the opponent's mark, this is a figurative word mark which consists of the word 'Tu' presented in a very slightly stylised typeface. The word will dominate the overall impression of the mark and, given the nature of the stylisation, I consider it likely that this will be overlooked entirely.

#### Visual Comparison

55. Visually, the marks share use of the word 'Tu'. This is the first element of the applicant's mark and the sole element of the opponent's mark. While the opponent's mark does have some stylisation, it is so slight that I am of the view that the applicant's mark can be used in a very similar, if not the same, typeface. As a result, I do not consider the stylisation is a point of actual difference. The marks differ in the presence of the word 'SOLUS' which sits at the end of the

applicant's mark and has no counterpart in the opponent's mark. Taking all of this into account and bearing in mind the overall impression of the marks, I find that the marks are visually similar to a medium degree.

### Aural Comparison

56. Aurally, the applicant's mark consists of three syllables that will be pronounced as 'TOO-SOLL-US'. The opponent's mark will be pronounced as just one syllable, being 'TOO'. The first syllables of the marks are identical but the second and third syllables in the applicant's mark have no counterpart in the opponent's. These are, clearly, points of aural difference. Given the identical beginnings of the marks, I am of the view that they are aurally similar to a medium degree.

### Conceptual Comparison

57. The applicant's case is that these words form a unitary meaning 'Only You' in Latin. While I appreciate that this may be the case, I am not convinced that consumers in the UK would be aware of such a meaning. On this point, I have nothing by way of evidence that demonstrates any such awareness amongst the consumer base. Instead, I find that when viewed as a whole, the applicant's mark will form no unitary meaning and will be viewed as a combination of two made-up or foreign language words with no obvious meaning. The word 'Tu' in the opponent's mark will, like the same word in the applicant's mark, be viewed as a made-up or foreign language word with no meaning. As a result, I am of the view that the marks are not capable of being conceptually similar.

### **Distinctive character of the opponent's registration**

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

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an

overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-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).”

59. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods or services for which it is registered, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. As set out above, the opponent has claimed to enjoy an enhanced degree of distinctive character and has filed evidence to that effect. However before considering the position with regard to enhanced distinctiveness, I will consider the inherent position.

60. The opponent’s registration consists of two marks, both being the word ‘Tu’ presented in a very slightly stylised typeface. The first mark in the registration is in black whereas the second is in white with a black border. Given that the stylisation and use of colour is likely to be overlooked, I find that the distinctiveness of the mark lies in the word ‘Tu’. I have set out above this will be viewed as a made-up or

foreign language word with no obvious meaning. As a result, the mark has no descriptive or allusive qualities. In my view, the inherent distinctiveness of the marks in the opponent's registration is high.

61. While the inherent position is already high, I remind myself that the opponent's evidence (being that summarised at paragraphs 26 to 34 above) demonstrates that the opponent has used its mark throughout the UK to a very significant degree. I remind myself that the turnover provided stood at approximately £4 billion over five years with an advertising spend of over £26 million over six years. In addition, the opponent has provided evidence that demonstrates that, on 8 January 2023, its clothing brand was the 10<sup>th</sup> ranked clothing company by market value and sixth by market volume. In addition, its brand health score increased from the sixth best in March 2016 to the fourth best by December 2022. While some of this evidence is from after the relevant date for the present assessment (being the filing date of the application), I am satisfied that the position prior to the relevant date was not too far removed that the position as of December 2022 and 8 January 2023, especially when you consider the level of use and advertising during that time. Taking all of the evidence into account, I am of the view that the significant level of use by the opponent is such to enhance the already high degree of inherent distinctive character to a very high degree.

### **Likelihood of confusion**

62. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind

the distinctive character of the opponent's marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to 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 he or she has retained in his or her mind.

63. I have found the parties' goods are identical or similar to a medium degree. I have found the average consumer for the majority of the goods to be members of the general public at large, however, I found that some goods will be selected by business users. Regardless of the identity of the consumer, they will select the goods with primarily visual considerations (though I do not discount the aural component) after having paid, generally, a medium degree of attention. I have, however, found that some goods would attract a lower degree of attention. In respect of the similarity of the marks at issue, I have found the marks to be visually and aurally similar to a medium degree. As for the conceptual similarity, I have found that the marks are not capable of being conceptually similar due to their unknown meanings. The marks in the opponent's registration are inherently distinctive to a high degree and this has been enhanced to a very high degree thanks to the use made of them.

64. In considering direct confusion, I am of the view that the opponent's best case lies in a reliance upon the *Medion*<sup>19</sup> principle. At the hearing, the opponent argued that regardless of whether 'Solus' is considered significant (as above, I consider that it is), the word 'Tu' in the applicant's marks plays an independent role from 'Solus'. On this point, I remind myself that the correct approach to the *Medion* principle was set out by Arnold LJ (as he then was) in the case of *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch). In this case, 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

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<sup>19</sup> *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04.

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.”

65. Applying the approach set out above to the present case, I find that consumers would, when considering the applicant’s marks as wholes, view them as composite marks made up of two signs with the word ‘Tu’ having a distinctive significant role independent of the marks as whole. In such circumstances, consumers will, upon

being confronted by both marks, be directly confused with the opponent's marks, being made up solely of the identical word 'Tu' (with any difference in stylisation being overlooked). Consequently, I consider that there exists a likelihood of direct confusion, regardless of the level of similarity of the goods at issue.

66. For the sake of completeness, I now turn to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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

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

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

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

67. As above, I have found 'SOLUS' in the applicant's mark will be perceived as a made-up or foreign language word with no obvious meaning. As a result, I fail to see how categories (b) or (c) of *L.A. Sugar* (cited above) can apply to the present case.<sup>20</sup> That being said, I remind myself that I have found that the opponent's marks enjoy a very high degree of distinctive character thanks to the use made of them. Therefore, it follows that the opponent's marks, consisting solely of the word 'Tu' (again, with the stylisation being overlooked), which appears identically at the beginning of the applicant's marks (being where consumers tend to focus)<sup>21</sup>, can be said to be so strikingly distinctive that consumers would believe that only one undertaking would use it. As a result, I consider that category (a) of *L.A. Sugar* applies to the present case and, therefore, I find that there exists a likelihood of indirect confusion between the marks, regardless of the level of similarity of the goods at issue.

68. As a result of the above, the opposition reliant upon section 5(2)(b) has succeeded in its entirety. For the sake of completeness, however, I will proceed to consider the remaining grounds of this opposition.

### **Section 5(3)**

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

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<sup>20</sup> On this point, I wish to point out for clarity that the categories set out in *L.A. Sugar* are not exhaustive examples of the only instances where confusion would occur.

<sup>21</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

“5(3) A trade mark which –

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

70. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

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

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29 and *Intel*, paragraph 63.

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder 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*).

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

## **Reputation**

72. I have summarised the opponent's evidence at paragraphs 26 to 34 above. While that summary related to an assessment of proof of use, I have found it to be equally relevant to the issue of enhanced distinctiveness. This same evidence is also equally relevant to the issue of reputation. Given what I have said about the evidence of the opponent throughout this decision, it should come as no surprise that I am satisfied that it is sufficient to give rise to a finding that the opponent enjoys a very strong reputation in its marks for the goods at issue.

## **Link**

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

The degree of similarity between the conflicting marks.

74. The parties' marks are visually and aurally similar to a medium degree. Conceptually, they are not capable of a comparison due to their unknown meanings.

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

75. The goods at issue are either identical or similar to a medium degree.

The strength of the earlier mark's reputation.

76. I have found that the opponent's registration enjoys a very strong reputation.

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

77. Inherently, I have found the opponent's registration to be distinctive to a high degree. I consider that, as a result of the evidence before me, this has been enhanced to a very high degree.

Whether there is a likelihood of confusion

78. I have found that there exists a likelihood of both direct and indirect confusion between the marks.

Conclusions on link

79. Given the level of reputation and distinctiveness enjoyed by the marks in the opponent's registration and the fact that there exists a likelihood of confusion between the marks, it follows that there would also be a link. Even if no confusion

were to exist, I am of the view that shared use of the word 'Tu' and the strength of reputation and high level of distinctiveness of the opponent's marks is such that consumers would believe that the marks are economically linked or at least be caused to wonder if they were.

## **Damage**

80. The opponent has pleaded that use of the application would, without due cause, lead to an unfair advantage in favour of the applicant and cause a detriment to both the reputation of the opponent and to the distinctive character of the opponent's registration.

## Unfair Advantage

81. I bear in mind that unfair advantage has no effect on the consumers of the opponent's goods. Instead, the taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to select the goods of the later mark than they would otherwise have been if they had not been reminded of the earlier mark.

82. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

"80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate

case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

83. Given that I have found there to be a likelihood of confusion between the marks at issue under the 5(2)(b) ground above, it follows that unfair advantage is automatically made out on the basis that the consumer would erroneously purchase the goods of the applicant on the mistaken belief that they are the goods of the opponent. In such circumstances, it is implicit that there would be an unfair advantage.

84. Even if I had found no likelihood of confusion, I am of the view that unfair advantage would be made out in any event. I say this on the basis that the strength of the reputation of the opponent’s registration, its level of distinctiveness and the presence of the common element of ‘Tu’ across all marks are such that it is quite clear that there is potential for the applicant to gain an unfair advantage by using her similar marks. The applicant, by using the identical element of ‘Tu’, would achieve instant familiarity in the eyes of the average consumers, thereby securing a commercial advantage and benefitting from the opponent’s reputation without paying financial compensation. Such commercial advantage would not exist were it not for the very strong reputation of the opponent’s registration. Therefore, I find it likely that use of the marks in the application would take unfair advantage of the reputation of the opponent’s registration.

85. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the opponent’s other heads of damage. The section 5(3) ground of the present opposition, therefore, succeeds.

#### **Section 5(4)(a)**

86. Section 5(4)(a) of the Act reads as follows:

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

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

(aa) .....

(b) .....

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

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

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

88. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

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

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

89. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation<sup>1</sup> among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source<sup>2</sup> or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

#### Relevant Date

90. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

91. The applicant's mark does not have a priority date. While there is evidence of the applicant using the application, there is nothing sufficiently solid that allows me to determine when precisely she began using it. I say this because the evidence as to the turnover revenue and advertising spend provided is simply referred to as covering January 2022 to March 2022 with nothing to demonstrate exactly when the behaviour complained about began. Further, the earliest evidence that shows her eBay storefront is dated June 2022.<sup>22</sup> Lastly, there are printouts showing her business' visibility from 22 April 2022 onwards, a 'sponsoring chart' which covers January 2022 to May 2023.<sup>23</sup> In short, while the applicant may have been using her mark prior to the date on which she applied for the application, I am unable to determine when. Therefore, I have no alternative but to proceed on the basis that the relevant date for the assessment of the present ground is the earliest priority date of the applicant's mark, being 8 June 2022.

## Goodwill

92. The first hurdle for the opponent is that it needs to show that it had the necessary goodwill in the sign relied upon, being 'TU', at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

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

93. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

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<sup>22</sup> KL2

<sup>23</sup> KL1

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

94. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

95. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

96. Goodwill arises as a result of trading activities. I do not intend to repeat the evidence of the opponent in full here but remind myself that the opponent's turnover demonstrates sales of approximately £4 billion with over £26 million spent on advertising between 2017 and 2022. It is clear that such evidence is sufficient to prove that there exists a very strong level of protectable goodwill in the opponent's business in respect of the goods relied upon (being identical to those relied upon under the section 5(2)(b) and 5(3) grounds) and that the opponent's sign is distinctive of and/or associated with that goodwill. For the avoidance of doubt, the position would have been the same even if the applicant was able to accurately demonstrate that she began using her mark at an earlier date than 8 June 2022, the evidence is so overwhelmingly strong that the same level of

goodwill would have vested in the opponent regardless of when the behaviour complained about began in 2022.<sup>24</sup>

## **Misrepresentation and damage**

97. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

98. And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and

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<sup>24</sup> There is nothing prior to 2022 so, at best, the relevant date would have been 1 January 2022 at the earliest.

concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

99. While the sign relied upon under the present ground is not the same as the marks that formed the basis of my finding of a likelihood of confusion under the section 5(2)(b) ground above, I consider that a similar outcome to the section 5(2)(b) ground above can be said to apply here. I make this finding because (1) the sign relied upon here is, like the marks in the registration that were relied upon under the section 5(2)(b) ground, dominated by the word ‘TU’ with the only differences coming in the stylistic elements (which I have found likely to be overlooked entirely) and (2) the goods to which the opponent’s goodwill is attached are the same as those relied upon above and are equally identical and/or similar to the applicant’s goods. As a result, I am of the view that everything I said under my confusion assessment applies here. The reason that this is relevant to the present ground is because of the findings of Lewison L.J in the case of *Marks and Spencer PLC v Interflora*.<sup>25</sup> In that case, Lewison LJ set out that although the test for misrepresentation is different from that for a likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it is unlikely that the difference between the legal tests will produce different outcomes. Therefore, because I found confusion above (albeit in respect of different earlier marks), I consider that a similar finding of misrepresentation can be said to apply here for similar reasons as those given above.

100. Given that I have found that there is a misrepresentation in respect of all of the applicant’s goods, I consider that damage through diversion of sales is easily foreseeable. The opposition based upon section 5(4)(a) is, therefore, successful in full.

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<sup>25</sup> [2012] EWCA (Civ) 1501

## CONCLUSION

101. The opposition succeeds in its entirety and, subject to any successful appeal of my decision, the application is refused registration for all goods.

## COSTS

102. As the opponent has succeeded, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £1,900 as a contribution towards its costs. The sum is calculated as follows:

Filing a notice of opposition and considering the applicant's counterstatement:	£300
Filing evidence, considering the applicant's evidence and filing evidence in reply:	£700
Preparation for and attendance at a hearing:	£700
Official fees:	£200
<b>Total:</b>	<b>£1,900</b>

103. I hereby order Kaja Leksander to pay J Sainsbury PLC the sum of £1,900. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 13th day of September 2024**

**A COOPER**  
**For the Registrar**