

O/0896/24

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3832142

BY ANNE LOUISE LIMITED

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 438493 BY

ANN LOUISE BRIDAL LIMITED

AND

IN THE MATTER OF UK REGISTRATION NO. 3233131

IN THE NAME OF ANN LOUISE BRIDAL LIMITED

AND

AN APPLICATION FOR THE REVOCATION THEREOF

UNDER NO. 505481 BY

ANNE LOUISE LIMITED

BACKGROUND AND PLEADINGS

The opposition

1. On 22 September 2022, Anne Louise Limited (“Party B”) applied to register the following sign (“the opposed mark”) as a trade mark in the United Kingdom:

ALB
ANNE LOUISE

2. Protection was sought in respect of the following goods and services:

Class 25

Clothing; Clothes; Tops [clothing]; Knitted clothing; Children’s clothing; Maternity clothing; Ladies’ clothing; Wedding dresses; Wedding gowns.

Class 35

Retail services relating to clothing.

3. On 9 January 2023, the application was opposed by Ann Louise Bridal Limited (“Party A”). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and concerns all the goods and services in the application.

4. Under section 5(2)(b), Party A relies on the following earlier UK trade marks (“UKTM”):

UKTM No. 3233131 (“the 131 mark”)

ANN LOUISE BRIDAL

Application date: 24 May 2017

Registration date: 6 October 2017

Class 14

Costume jewelry; tiara; wedding rings; wedding bands; silver earrings; gold earrings; earrings of precious metal; necklace charms; silver necklaces; gold necklaces; necklaces [jewelry]; necklaces of precious metal; jewelry for the head; bracelets; bracelet charms; silver bracelets; bracelets [jewelry]; gold bracelets; bracelets of precious metal; bracelets made of embroidered textile [jewelry].

Class 25

Wedding dresses; ladies' dresses; bridesmaid dresses and special occasion dresses for women and children; evening dresses; women's ceremonial dresses; evening gowns; bridal gowns; wedding gowns; cheongsams (Chinese gowns); formal evening wear; gloves; gloves without fingers; gloves as clothing; veils; headdresses [veils]; veil [clothing]; fabric belts; waist belts; belts for clothing; fabric belts [clothing]; belts made out of cloth; underclothes; underclothing; undergarments; under garments; ladies' underwear; women's undergarments; women's underclothing; corsets [underclothing]; underwear for women; women's underwear; underclothing for women; garters; girls' clothing; outer clothing for girls; boys' clothing; outer clothing for boys.

Class 35

Retail services in the field of bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, combs, articles of jewelry made of precious metals and non-precious metals, costume jewelry, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories; online retail store services relating to bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, combs, articles of jewelry made of precious metals and non-precious metals, costume jewelry, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories; advertising services relating to bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, combs, articles of jewelry made of precious metals and non-precious metals, costume jewelry, bangles, bracelets, brooches, necklaces, earrings, rings, hair

accessories; information, advisory and consultancy services relating to bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, combs, articles of jewelry made of precious metals and non-precious metals, costume jewelry, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories

UKTM No. 3708357 (“the 357 mark”)

Ann Louise London

Application date: 10 October 2021

Registration date: 21 January 2022

Class 3

Perfume; perfume extracts; cosmetics; facial cosmetics; lotions for cosmetics purposes; make up; candles for cosmetic purposes.

Class 4

Candles.

Class 14

Costume jewellery; tiara; wedding rings; wedding bands; silver earrings; gold earrings; earrings of precious metal; necklace charms; silver necklaces; gold necklaces; necklaces [jewellery]; necklaces of precious metal; jewellery for the head; bracelets; bracelet charms; silver bracelets; bracelets [jewellery]; gold bracelets; bracelets of precious metal; bracelets made of embroidered textile [jewellery].

Class 25

Wedding dresses; ladies' dresses; bridesmaid dresses and special occasion dresses for women and children; evening dresses; women's ceremonial dresses; evening gowns; bridal gowns; wedding gowns; cheongsams (Chinese gowns); formal evening wear; gloves; gloves without fingers; gloves as clothing; veils; headdresses [veils]; veils [clothing]; fabric belts; waist belts; belts for clothing; fabric belts [clothing]; belts made out of cloth; underclothes; underclothing; undergarments; under garments; ladies' underwear; women's undergarments; women's underclothing; corsets

[underclothing]; underwear for women; women's underwear; underclothing for women; garters; girls' clothing; outer clothing for girls; boys' clothing; outer clothing for boys.

Class 35

Retail services in the field of bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, combs, articles of jewellery made of precious metals and non-precious metals, costume jewellery, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories; online retail store services relating to bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, combs, articles of jewellery made of precious metals and non-precious metals, costume jewellery, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories; advertising services relating to bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, combs, articles of jewellery made of precious metals and non-precious metals, costume jewellery, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories; information, advisory and consultancy services relating to bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, combs, articles of jewellery made of precious metals and non-precious metals, costume jewellery, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories.

5. Both marks qualify as earlier marks under section 6(1) of the Act by virtue of their earlier filing dates.

6. Party A claims that the opposed mark is highly similar to its earlier marks and that the goods and services in Classes 25 and 35 are identical or at least highly similar. Consequently, there is a likelihood of confusion on the part of the public, including a likelihood of association, and Party A requests that the application be refused under this ground.

7. Under section 5(3), Party A claims that the earlier marks relied on under section 5(2)(b) have a reputation in relation to the goods and services covered by those marks. It claims that a link between the marks would be created in the minds of consumers who would believe that use of the opposed mark was by Party A, by an economically linked undertaking or was endorsed by Party A. Such a link would take unfair advantage of the distinctive character or repute of the earlier marks, or would result in detriment to the distinctive character of reputation of the marks. Party A claims that it is not aware of any due cause requiring Party B to use the opposed mark, Consequently, Party A requests that the application be refused under this ground.

8. Under section 5(4)(a), Party A submits that it has used the unregistered sign **ANN LOUISE BRIDAL** throughout the UK since 2015 in relation to *Clothing; bridal gowns, accessories and jewellery; retail services relating to the aforementioned goods* and has acquired goodwill through this use. Party A claims that use of the opposed mark would amount to a misrepresentation likely to lead the public to believe that the goods and services offered are those of Party A or that there is some association between the two undertakings. As a result, Party A is likely to suffer damage in the form of lost sales, damage to its reputation and loss of exclusivity in its sign **ANN LOUISE BRIDAL**. Party A requests that the application be refused under this ground.

9. On 14 April 2023, Party B filed a defence and counterstatement denying the claims made and putting Party A to proof of the claimed reputation and goodwill.

The application for revocation

10. On 21 October 2022, Party B made an application that the 131 mark should be revoked for non-use under sections 46(1)(a) and (b) of the Act. The periods in respect of which non-use is claimed are shown in the table below:

Period	Date of revocation
7 October 2017 – 6 October 2022	7 October 2022
21 October 2017 – 20 October 2022	21 October 2022

11. The applicant filed a defence and counterstatement denying the claims made.

12. The proceedings were consolidated on 9 May 2023.

EVIDENCE AND SUBMISSIONS

13. Only Party A filed evidence. This is in the form of a witness statement from Cheryll Butler, who is the founder and sole director of Ann Louise Bridal Limited. It is dated 10 July 2023 and is accompanied by 10 exhibits. The evidence goes to the use made of the 131 mark and the claims to reputation and goodwill.

14. Neither party requested a hearing and only Party A filed written submissions in lieu. These are dated 18 January 2024.

15. I have read all the evidence and submissions and will refer to them in my decision where appropriate.

REPRESENTATION

16. In these proceedings, Party A is represented by Stobbs. Party B was initially represented by Keystone Law but as of 28 September 2023 represented itself.

DECISION

17. I shall deal first with the application for revocation of the 131 mark.

Application for Revocation of the 131 Mark

18. The relevant provisions of section 46 of the Act are as follows:

“(1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

...

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation were existing at an earlier date, that date.”

19. 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.

20. The case law on genuine use was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247:

“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 Laboratoires Goemar SA* [2004] ECR I-1159, Case C-416/04 *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 Bundersvereinigung 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] and [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].”

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v*

Plymouth City Council [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

‘19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

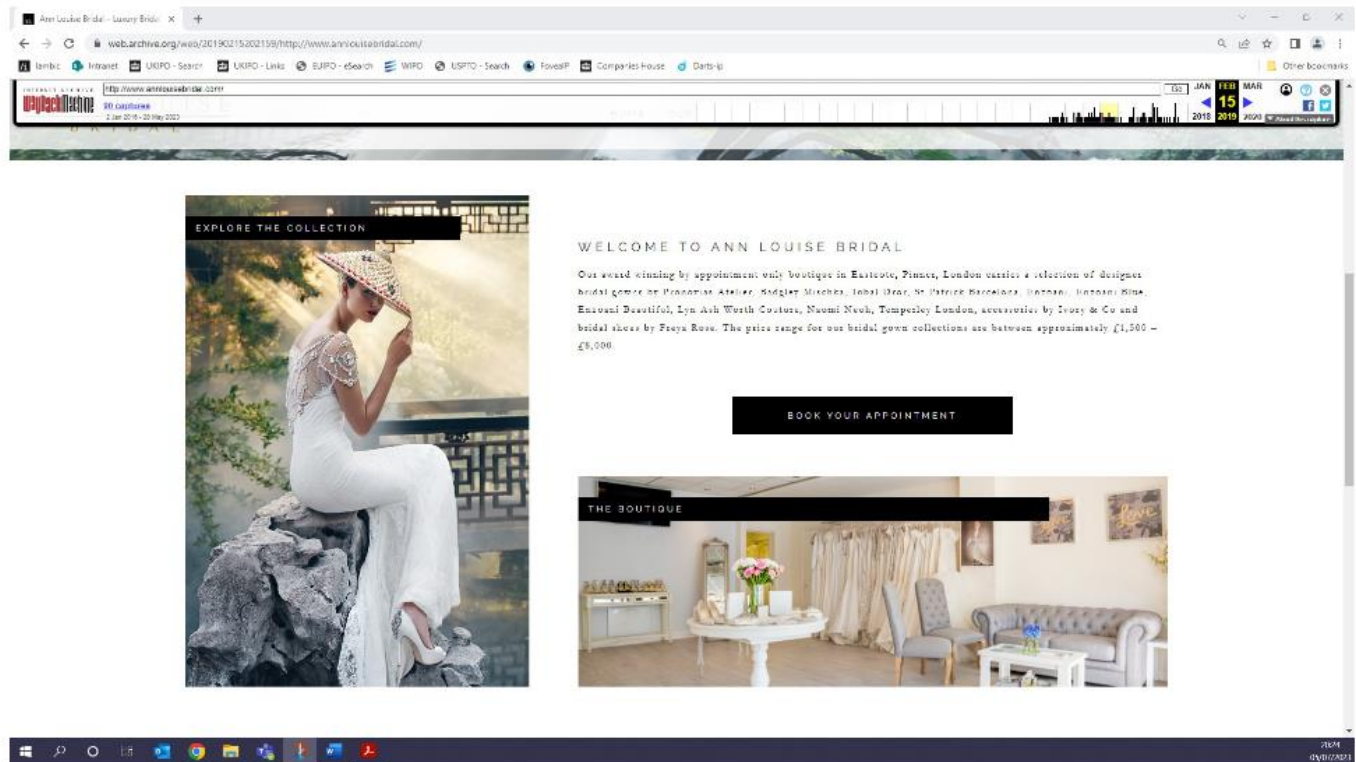
...

22. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.”

The evidence

21. Ms Butler states that the 131 mark has been used since 2015 for a London boutique selling designer bridal gowns, accessories, shoes and related wedding products. The website provides information on the goods sold and the services offered, and the mark can be seen in screenshots with dates from 2 October 2017 to 5 October 2022, with further screenshots captured in 2023. Over this period, the look of the

website, the images used and the goods described are consistent. An example dated 15 February 2019 is shown below:¹



There is no evidence to indicate that goods are available for purchase online.

22. Between 2017 and 2022, Party A had sales of £1.564 million. Ms Butler explains that, during this period, the Covid pandemic led to a number of wedding cancellations, which had an impact on turnover.² A selection of sample invoices is supplied in Exhibit CB3. The invoices show sales to customers with postcodes in London and the south-east of England. I have summarised below the details of those that fall after the registration date of the 131 mark:

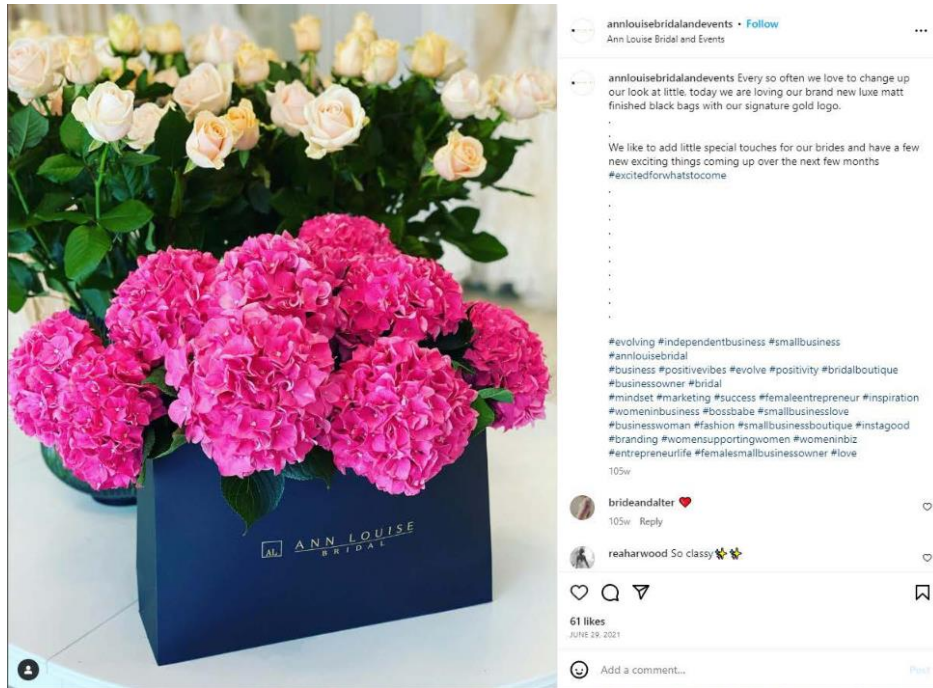
Date	Details	Value
22/02/2018	Ann Louise Veil; Ann Louise Diamante Belt	£500.00
20/03/2018	Bridal Travel Box; Ivory & Co Stockholm bridal jewellery set	£129.95
30/03/2018	3 Dessy Bridesmaid Gowns; 1 item described as "Dessy – Style 2988")	£1,160.00

¹ Exhibit CB1.
² Paragraph 5.

Date	Details	Value
27/10/2018	Atelier Pronovias Rani; So Sassi veil; Extra lace Atelier Pronovias	£4,700.00
18/01/2019	Badgley Mischka Alice; Jupou fur stole; Loves Promise veil; petticoat.	£2,175.00
20/04/2019	Badgley Mischka Callista; So Sassi veil; ALB crystal belt	£2,850.00
03/08/2019	Enzoani Jenny bridal gown; Ann Louise Camilla bridal belt; Amanda Wyatt veil.	£1,750.00
03/07/2020	Ann Louise Camilla bridal belt	£250.00
19/06/2021	Eliza Jane Howell Sibella	£2,329.00
13/08/2022	Enzoani Pearl bridal gown; Ann Louise veil	£2,630.00

I understand that Atelier Pronovias, Badgley Mischka, Enzoani and Eliza Jane Howell are all designers of wedding dresses.

23. Ms Butler states that between 2017 and 2022, Party A spent £35,000 on promoting the mark. Exhibit CB4 contains posts showing attendance at The National Wedding Show and coverage in magazines such as *British Vogue* and *Wedding Ideas*. All of these predate the relevant periods. Social media channels are also used and, as of 6 July 2023, Party A had 5.9k followers on Instagram; 5.7k likes and 5.7k followers on Facebook; 959 followers on Twitter. Exhibit CB5 contains examples of social media posts dated between 2017 and 2022. Most of these are taken from Instagram. They show wedding and bridesmaid dresses, veils, shoes, tiaras, necklaces, earrings, belts, jewellery to be worn in the hair, and the boutique's bags showing the mark in use and the signage on the boutique itself. I have reproduced the last two below. They are dated 29 June 2021 and 11 April 2021 respectively.



24. Exhibit CB6 contains reviews and recommendations posted on Google Reviews, Yell, Bridebook, Guides for Brides and Facebook. The reviews following the registration date of the 131 mark come from the period of 15 October 2017 to October 2022.³ They describe the goods sold in the shop as wedding dresses and bridal

³ As the reviews were retrieved in on 6 July 2023, reviews that were posted “10 months ago” are likely to have been posted within the relevant periods.

accessories. Veils are specifically mentioned and four reviewers say that their veils were custom-made by Ms Butler's mother.

25. Further reviews describe the services offered, and I have reproduced some examples below:

"I couldn't recommend Cheryll and Ann Louise Bridal more. I first visited with my mum and sister, to try on a specific designer but soon realised that the dresses didn't suit me. Cheryll showed me other options and let me try on numerous dresses and recommended one which I didn't initially want to try on, who knew it would be the one!" (10 months ago)⁴

"I can't thank Cheryll enough for helping me find my dream dress. Cheryll listened to what I wanted, my style and the type of venue we were getting married at." (10 months ago)⁵

"A wonderful experience from start to finish. Cheryll was so helpful, professional and very friendly and extremely accommodating (even when I changed my dress 6 weeks before the big day!) Cheryll and Donna understood exactly what I wanted and offered great advice to help me create my dream dress." (11 months ago).⁶

"Cheryll was absolutely brilliant! She found me the perfect dress, gave excellent advice on styling, and recommended a seamstress who altered the dress so it fitted like a glove." (A year ago).⁷

"I had the most wonderful, personalised experience choosing the dress of my dreams at Ann Louise Bridal. I spoke through what I liked and chose some dresses. Cheryll listened and then selected some that she felt fitted what I wanted." (2 years ago).⁸

"From the moment I entered the very spacious and beautiful boutique I felt completely comfortable. I was not rushed at all and there was no pressure

⁴ Page 12.

⁵ Page 16.

⁶ Page 20.

⁷ Page 28.

⁸ Page 34.

to make a decision there and then. Cheryll helped me to try on a couple of dresses, and knowing exactly what was going to work from what I had told her, helped me to find my perfect wedding dress.” (3 years ago).⁹

26. In Exhibit CB7, there is a selection of articles mentioning Party A. Some of these predate the registration of the 131 mark, but the rest are as follows:

- An article from *Brides Magazine*, January/February 2019, entitled “How they did it”, featuring a real wedding in which one of the brides’ dress and veil came from Party A. The article states that the dress was made by the designer Lyn Ashworth and does not give any information on the undertaking responsible for the veil;
- An article from *Bridal Buyer Magazine*, March 2021, entitled “Wise words” featuring short interviews with eight retailers, including Ms Butler, on their plans to reopen after the Covid lockdown; and
- An article from the same issue of *Bridal Buyer Magazine* focusing on Ann Louise Bridal.

27. Ms Butler states that Ann Louise Bridal has been nominated for the following awards since the registration date of the 131 mark:¹⁰

- UK Wedding Awards, 2018: Best Bridal Boutique, shortlisted.
- Global Wedding Awards, 2018: Best Bridal Boutique – North West London.
- Bridebook Wedding Awards, 2018: Best Wedding Dress Supplier, Silver Badge of Excellence.
- LTG Wedding Awards, 2019: Shortlist.
- London Prestige Awards, 2019: Bridal Service of the Year.
- Enzoani Platinum Partner, 2019.¹¹
- Enzoani Platinum Partner, 2021.
- Enzoani Platinum Partner, 2022.

⁹ Page 53.

¹⁰ Exhibit CB8.

¹¹ This award honours the top ten retailers of the brand in the UK: see page 3 of Exhibit CB8.

- Guides for Brides Awards, 2023: Customer Services Award, shortlisted.

Has genuine use been made of the mark?

28. For use to be genuine, it must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods or services at issue in the UK. In these proceedings, there are two relevant periods, the second of which ends on the day before the application for revocation was made (7 October 2017 to 6 October 2022, and 21 October 2017 to 20 October 2022).¹² It will be seen that the two periods almost entirely overlap. In making my assessment, I am required to consider all relevant factors, including (i) the scale and frequency of the use; (ii) the nature of the use; (iii) the goods and services for which use has been shown; (iv) the nature of those goods and services and the markets for them; and (v) the geographical extent of the use.

29. Party A submits that it has shown that the mark has been used for all the goods and services covered by the 131 mark. I remind myself that the essential function of a trade mark is to guarantee the identity of the origin of the goods or services to the end consumer or end user by enabling them to distinguish the goods or services of one undertaking from another: see point 3 of Arnold LJ's summary in *easyGroup*, cited above.

30. At this point, I wish to say a few words about bridesmaids' dresses. There is a single invoice dated 30 March 2018 showing sales of these goods of £1,160 and a single Instagram post from after the registration date of the 131 mark. However, the Instagram post is dated January 2018 which is only a short time after the registration date. I consider that it is not uncommon for bridal and bridesmaids' dresses to be purchased well in advance of the date of the wedding and so I cannot say for certain that the dresses were purchased after 7 October 2017. There are also two reviews, one from 7 November 2017 and the second from 18 March 2018, although in the latter case the reviewer states that she got married in the previous July, meaning the dresses would certainly have been purchased before either of the relevant periods. I also note that, while bridesmaids' dresses are specifically mentioned on the earliest of the website screenshots, dated 2 October 2017, by the next screenshot, dated

¹² This means that in these proceedings section 46(3) does not apply.

15 December 2018, this text had been removed. It was not reinstated. I infer from this evidence that the retail offering became wholly focused on brides at some point in 2018.

31. The evidence does not show that Party A makes the dresses or other goods itself or sells them under the 131 mark, but under the marks or signs of the third parties. The website screenshot I have reproduced in paragraph 20 above states that:

“Our award winning by appointment only boutique in Eastcote, Pinner, London carries a selection of designer bridal gowns by Rosa Clara, Marchesa for Pronovias, Badgley Mischka, Inbal Dror, Enzoani, Enzoani Blue, Enzoani Beautiful, Elysee, Elysee Atelier, Lyn Ash Worth Couture, Naomi Neoh, Temperley London, accessories by Ivory & Co and bridal shoes by Freya Rose.”

32. The exception to this may be veils and belts. Two of the ten invoices show sales of veils under the name “ANN LOUISE” and four of the reviews in Exhibit CB6 refer to bespoke veils being made by Ms Butler’s mother. The invoices are dated 22 February 2018 and 13 August 2022. Two of the reviews come from 3 years ago (likely to be around 2020), another from 5 years ago (around 2018), and the fourth is dated 5 August 2019. The invoices also show that Party A has sold veils from other manufacturers and therefore under other marks. I am not given further assistance by the turnover figures, as these have not been broken down by products sold. At this point, I need to refer back to the judgment of Arnold LJ in *easyGroup*, which I cited at [20] above. In particular, he said at [107] that genuine use “*must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned*”; it could not be proved by means of probabilities or suppositions. He also quoted with approval the decision of the Appointed Person in *Awareness Ltd v Plymouth City Council* [2013] RPC 24, who said that evidence should be “*clear, precise, detailed and well-supported*”. It appears to me that it would have been possible for Party A to provide information on how many bespoke veils had been created and sold. While I am satisfied that there has been commercial use of the mark for bridal veils, I recall that it is not the case that every proven commercial use of a mark can be deemed to be genuine. In my view, the evidence does not show that the 131 mark has been genuinely used for bridal veils.

33. With regard to belts, four of the ten invoices show sales of belts, under the mark “ANN LOUISE” or, in one case, “ALB”. These are dated 22 February 2018, 29 April 2019 (“ALB”), 3 August 2019 and 3 July 2020. There is no further evidence showing belts sold under either of these marks, and an Instagram post dated 30 April 2018 shows that Party A stocked bridal belts from Naomi Neoh.¹³ One of the reviews, from around a year before the date of printing (which was 6 July 2023), refers to the purchase of a belt, but it is not clear what mark this belt was sold under.¹⁴ I have the same difficulties with this evidence as I do with the evidence on bridal veils. I am satisfied that belts were sold, but I cannot say without resorting to probabilities or suppositions what use has been made of the mark for these goods. Consequently, I find that the evidence does not show genuine use for bridal belts.

34. I come now to the services in Class 35. I can see no evidence that Party A provides an online retail service. Neither, in my view, does it provide advertising services. Advertising only one’s own goods and services is not use that would be warranted in the advertising sector to maintain or create a share in the market for those services.

35. Turning to the remaining services in Class 35, I recall the comments of Mr Daniel Alexander QC, sitting as the Appointed Person, in *Intermar Simanto v Nike Innovate CV (JUMPMAN Trade Mark)*, BL O-222-16:

“71. ... in order to make the evaluation of the nature of the use in question and its significance it is necessary to have some regard to the context in which use takes place. There are some markets in which sales are so infrequent that an order for a product every few years might be regarded as significant. There are other kinds of goods which, in terms of the volume and value of sales naturally to be expected are so large, that much larger volumes would need to be sold for the use to be regarded as significant.”

36. At this point, I consider that it is helpful to clarify that, when I was assessing the use for goods, I was looking for evidence that Party A was responsible for the production of those goods. Retail services essentially involve the bringing together of a variety of goods, enabling customers to conveniently view and purchase them. These

¹³ Exhibit CB5, page 15.

¹⁴ Exhibit CB6, page 33.

goods may come from a wide range of different businesses, and so it is therefore possible for a mark to be genuinely used for retail services in instances where no genuine use has been found for the goods sold in the retail outlet.

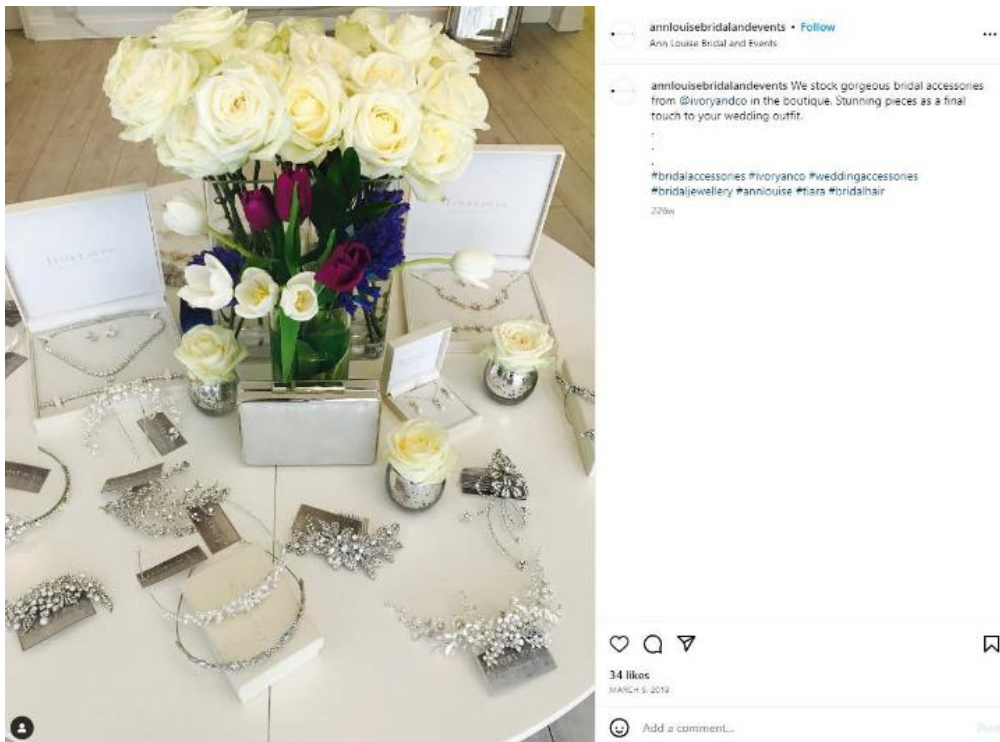
37. I also recall that in *Praktiker Bau- und Heimwerkermärkte AG*, Case C-418/02, the Court of Justice of the European Union (CJEU) said:

“34. In that regard, it should be noted that the objective of retail trade is the sale of goods to consumers. That trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. That activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor.”

38. In the context of retail services for clothing, turnover of £1.564 million over the period 2017-2022 strikes me as being fairly small. However, retail services relating to bridal clothing and accessories are services that a customer would use very infrequently. I also note that these services are provided from a single premises in northwest London, which imposes a certain geographical constraint on the potential market. Earlier in *JUMPMAN*, the Appointed Person noted at [23] that “... *it is no objection to the continued registration of a national trade mark that the mark has only been used in a limited location.*” The invoices show sales being made throughout the relevant periods and I accept that the Covid pandemic had an impact on the number of weddings that took place. I am therefore satisfied that Party A has made genuine use of the mark **ANN LOUISE BRIDAL** for retail services relating to wedding dresses and bridal accessories.

39. At this point, I need to say something about the specific accessories for which I consider use has been shown. Many of the reviews talk about “*bridal accessories*” in general terms, but this term does not appear in Party A’s specification. On the basis of the evidence that I have already discussed at [32] and [33] above, I am satisfied that the mark has been used for retail services in relation to bridal veils and belts.

40. Turning to jewellery, I note that there is a single invoice dated 20 March 2018 showing sale of the Stockholm bridal jewellery set from Ivory & Co. A print-out from the Ivory & Co website in Exhibit CB3 shows that the set consists of a pendant necklace and earrings.¹⁵ An Instagram post from 6 March 2019 shows a display of accessories comprising jewellery sets of necklaces, bracelets and earrings, and hair accessories, including decorative combs and hair bands. If the image is magnified, the small open box to the right of the large floral display can be seen to contain the Stockholm bridal jewellery set.



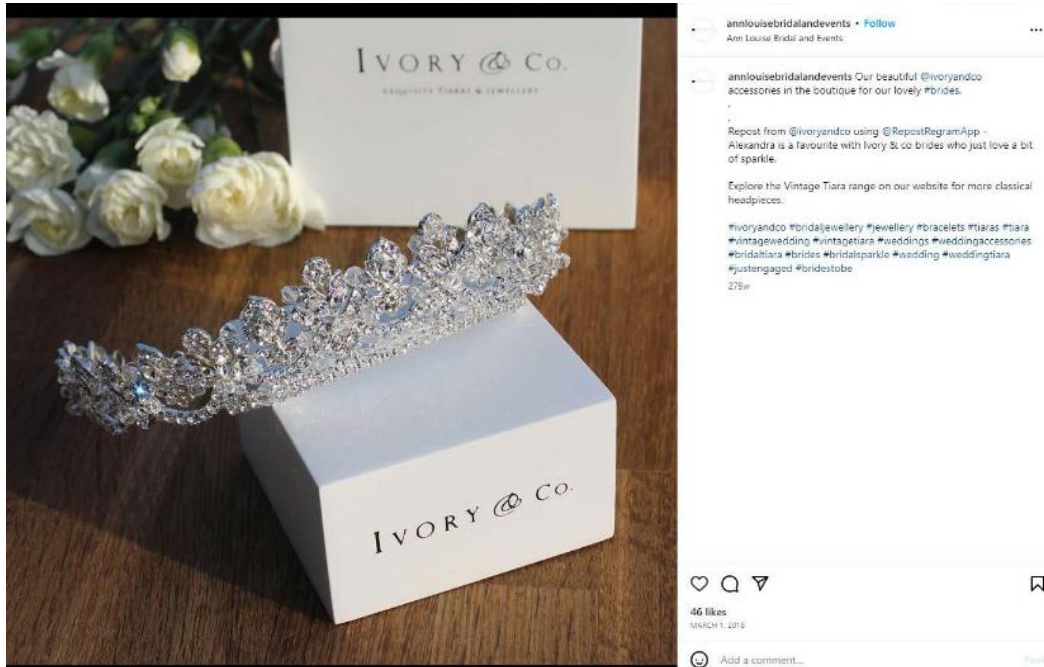
41. Further Instagram posts dated 18 June 2019 and 23 February 2018 show a headdress and hair ornament respectively.¹⁶ These posts refer to the boutique stocking accessories by Ivory & Co. This statement is also made on the website screenshots to which I have already referred.

42. The evidence for retail services in connection with tiaras consists of an Instagram post dated 1 March 2018 (shown below) and a reference to the sale of a tiara in a review dated 15 October 2017. I also consider that the Instagram post reproduced in [40] above shows a tiara to the left of the large floral display and below an open box

¹⁵ Page 21.

¹⁶ Exhibit CB5, pages 12 and 17.

containing a jewellery set. The invoice evidence relating to tiaras and headdresses predates the relevant periods. The Instagram post does not, however, explicitly state that this, or any other, tiara is stocked by Party A. It refers generally to accessories.



43. Advertising (and it seems to me that this would include social media posts) is capable in principle of providing evidence of trade mark use. Whether such evidence actually does prove genuine use, is a matter to be determined on the facts. On the basis of the evidence, and bearing in mind what the Appointed Person said in *Awareness Ltd*, I am satisfied that, although the evidence is not extensive, Party A has used the mark for retail services in relation to bridal jewellery, including jewellery to be worn in the hair and jewelled hairbands, and tiaras.

44. Finally, I come to retail services relating to shoes. The website consistently states that shoes are stocked and they can be seen in the following image of the boutique that appears on each iteration of the website:



45. There are also two Instagram posts. One of these predates the relevant periods, having been posted on 25 May 2017.¹⁷ The other is dated from 26 August 2020, and shows a pair of Jimmy Choo shoes. It is a repost from Jimmy Choo’s own account and contains the following text from Party A: *“A little Wednesday sparkle with the fabulous @jimmychoo see our beautiful collection in store during your private consultation”*.¹⁸ There is nothing elsewhere in the evidence to suggest that Party A stocked shoes from this particular designer and the post stops short of stating that the boutique stocks shoes at all. There is also no invoice evidence of shoe sales. There are also reviews that mention shoes, but these also predate the relevant periods, being posted on 24 April 2017 and 25 June 2017 respectively.¹⁹ I therefore only have the evidence on the website. In my view, this is not sufficient for me to find that genuine use has been made of the 131 mark for retail services related to shoes.

46. Having made these findings in relation to the retail services, I now need to consider whether genuine use has been shown for the information, advisory and consultancy services. I will say at the outset that these are very broad terms, but it appears to me that Party A has used the mark to provide services which involve the giving of advice and carrying out consultations on bridal style and in relation to the goods which are the subject of the retail services. This is evidence by the reviews, examples of which I

¹⁷ Exhibit CB5, page 20.

¹⁸ Exhibit CB5, page 10.

¹⁹ Exhibit CB6, pages 114 and 119.

have reproduced above at [25]. In addition, the articles in *Bridal Buyer Magazine* contain references to consultation appointments for brides.²⁰

Framing a fair specification

47. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. He said:

“244. As I described in *Maier v Asos*, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.

245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other categories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to

²⁰ Exhibit CB7, pages 16-19.

arrive at a fair specification of goods or services having regard to the use which has been made of the mark.”

48. The specification I need to consider is as follows:

Retail services in the field of bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, combs, articles of jewelry made of precious metals and non-precious metals, costume jewelry, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories; information, advisory and consultancy services relating to bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, combs, articles of jewelry made of precious metals and non-precious metals, costume jewelry, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories.

49. I shall deal first with the retail services. As the CJEU confirmed at [50] in *Pratiker Bau-*, retail services need to be linked to the supply of specified types of goods. I have already found that genuine use has been shown for retail services connected with wedding dresses. A fair specification would, in my view, include *Retail services in the field of bridal wear, bridal gowns, wedding dresses*. These are identifiable subcategories of *Wedding and special occasion wear*, which would also include subcategories such as morning dress for men and prom dresses, and there is no evidence that retail services were offered in relation to these last two types of goods. I have already said that the evidence does not show me that Party A was genuinely using the mark for retailing bridesmaid dresses during either of the relevant periods. It is not immediately obvious whether *outfits* in the second line of the above specification should be construed as “*wedding ... outfits*” or simply “*outfits*”. Even if it is the former, I think the term would include identifiable subcategories, such as the morning dress that I have already mentioned and bridesmaids’ dresses.

50. I also found that there was use for retail services in relation to bridal belts and veils. The specification does not specify bridal belts as being goods associated with the retail services, but I consider that they would be included under the term *Retail services in the field of bridal wear*. A fair specification would also include *Retail services in the field of ... bridal veils*.

51. Turning to the jewellery items, I note that *Tiaras, necklaces, bracelets and earrings* are all goods that are the subject of the retail services in the specification. I do not consider that there is any meaningful distinction that can be drawn between goods that are intended to be worn by brides and those that are not. A fair specification would include *Retail services in the field of ... tiaras, ... bracelets, ... necklaces, earrings*.

52. The specification also includes more general terms for the goods that are the subject of the retail services. These are *Articles of headwear, headgear, combs, articles of jewelry made of precious metals and non-precious metals, costume jewelry, hair accessories*. In my view, *Articles of headwear* and *headgear* would include a number of identifiable subcategories, including hats, and the average consumer would consider that *Tiaras* are a category of such goods that would be viewed independently. The term *Combs* could refer to accessories that are intended to be worn in the hair or tools for removing tangles and knots from the hair or dividing it into sections. In the interests of clarity, I consider that a fair specification would include *Retail services in the field of ... decorative hair combs*. *Hair accessories* would be a broader category that would include ribbons, bows, slides, hair bands, as well as the decorative combs. The image shown above indicates that hair bands were offered for sale and it is not clear how some of the others in the image might be worn in the hair. This suggests to me that it may be somewhat arbitrary to divide the category of *Hair accessories*, and I find that a fair specification would include *Retail services in the field of ... hair accessories*. Finally, I need to consider the broad categories of jewellery. In my view, there is use in sufficient subcategories for *Retail services in the field of ... articles of jewelry made of precious metals and non-precious metals, costume jewelry* to be included in a fair specification.

53. The nature of the services provided by Party A, whereby a customer arranges a consultation to discuss her requirements and options, leads me to find that a fair

specification would include *Information, advisory and consultancy services* related to the same goods included in a fair specification for the *Retail services*.

Outcome of the revocation

54. The application for revocation has been partially successful and the 131 mark is revoked with effect from 7 October 2022 for the following goods:

Class 14

Costume jewelry; tiara; wedding rings; wedding bands; silver earrings; gold earrings; earrings of precious metal; necklace charms; silver necklaces; gold necklaces; necklaces [jewelry]; necklaces of precious metal; jewelry for the head; bracelets; bracelet charms; silver bracelets; bracelets [jewelry]; gold bracelets; bracelets of precious metal; bracelets made of embroidered textile [jewelry].

Class 25

Wedding dresses; ladies' dresses; bridesmaid dresses and special occasion dresses for women and children; evening dresses; women's ceremonial dresses; evening gowns; bridal gowns; wedding gowns; cheongsams (Chinese gowns); formal evening wear; gloves; gloves without fingers; gloves as clothing; veils; headdresses [veils]; veil [clothing]; fabric belts; waist belts; belts for clothing; fabric belts [clothing]; belts made out of cloth; underclothes; underclothing; undergarments; under garments; ladies' underwear; women's undergarments; women's underclothing; corsets [underclothing]; underwear for women; women's underwear; underclothing for women; garters; girls' clothing; outer clothing for girls; boys' clothing; outer clothing for boys.

55. It remains registered for services in Class 35 and the specification is amended as follows with effect from 7 October 2022. The deleted terms are shown in strike through and additional words are underlined:

Class 35

Retail services in the field of ~~bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats,~~

~~decorative hair combs, articles of jewelry made of precious metals and non-precious metals, costume jewelry, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories; online retail store services relating to bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, combs, articles of jewelry made of precious metals and non-precious metals, costume jewelry, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories; advertising services relating to bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, combs, articles of jewelry made of precious metals and non-precious metals, costume jewelry, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories; information, advisory and consultancy services relating to bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, decorative hair combs, articles of jewelry made of precious metals and non-precious metals, costume jewelry, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories.~~

The Opposition to Application No. 3832142

Section 5(2)(b)

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

“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.”

57. The relevant date on which this claim must be assessed is the date of application for the opposed mark, i.e. 22 September 2022. This is before the effective date of the partial revocation of the 131 mark. This mark had not completed its registration procedures five years before the filing date of the earlier mark and so Party A can rely on all the goods and services for which it is registered. I shall consider the opposition under this section on the basis of this mark first and return to the 357 mark should that prove necessary.

58. I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation 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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone 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, and whose attention varies according to the category of goods or services in question;

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

- d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;
- h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- i) mere association, in the strict sense that the later mark brings 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; and
- 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

59. Where goods (or services) in the specification of one mark are included in a broader term from the other party's specification, those goods (or services) are considered to be identical: see *Gérard Meric v OHIM*, Case T-133/05 at [29].

60. In my view, all the goods and services covered by Party B’s application are either self-evidently identical or *Meric* identical to goods and services covered by Party A’s application. The table below provides the details:

Party B’s goods and services	Party A’s earlier goods and services	
<i>Clothing</i>	<i>Ladies’ dresses</i>	<i>Meric identical</i>
<i>Clothes</i>	<i>Ladies’ dresses</i>	<i>Meric identical</i>
<i>Tops [clothing]</i>	<i>Girls’ clothing; Boys’ clothing</i>	<i>Meric identical</i>
<i>Knitted clothing</i>	<i>Girls’ clothing; Boys’ clothing</i>	<i>Meric identical</i>
<i>Children’s clothing</i>	<i>Girls’ clothing; Boys’ clothing</i>	<i>Meric identical</i>
<i>Maternity clothing</i>	<i>Ladies’ dresses</i>	<i>Meric identical</i>
<i>Ladies’ clothing</i>	<i>Ladies’ dresses</i>	<i>Meric identical</i>
<i>Wedding dresses</i>	<i>Wedding dresses</i>	<i>Identical</i>
<i>Wedding gowns</i>	<i>Wedding gowns</i>	<i>Identical</i>
<i>Retail services relating to clothing</i>	<i>Retail services in the field of bridal, wedding and special occasion wear</i>	<i>Meric identical</i>

Average consumer and the purchasing process

61. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch) at [60]. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods and services in question: see *Lloyd Schuhfabrik* at [26].

62. The average consumer of the goods and services at issue is a member of the general public. Where the goods and services relate to wedding dresses, the average consumer will be a member of the public planning her wedding. The consumer will buy the goods from a clothing retailer or a department store, either visiting a physical shop

or ordering from the internet or a printed catalogue. In the case of bridal wear, they may visit a specialist boutique. This means that the mark will be seen and so the visual element will be the most significant: see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, at [50]. However, I do not discount the aural element, as the consumer may in some cases be assisted by a member of staff. The price varies, but in many cases these goods will be frequent purchases. The consumer will pay attention to the size, the materials, the style and colours to ensure they buy a garment that fits them and achieves the effect they desire. In my view, the average consumer of these goods will be paying a medium degree of attention. However, I consider that the level of attention will be higher when the average consumer is purchasing wedding dresses.

63. When choosing a supplier of retail or information services, the average consumer will pay attention to the variety of goods available in the shops and other facilities, such as convenience of location. Again, I consider that the choice will largely be visual but I accept that there will be a role for word-of-mouth recommendations. The level of attention paid will be medium, although for retail services associated with wedding dresses I would expect a higher degree of attention.


Comparison of the marks

64. It is clear from *SABEL* (particularly at [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 CJEU stated in *Bimbo* that:

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

65. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

66. The respective marks are shown below:

Opposed mark	Earlier marks
	<p>131 mark:</p> <p>ANN LOUISE BRIDAL</p>

67. The opposed mark consists of the words “ANNE LOUISE”, which would be perceived as the name of a woman or girl, presented in capital letters in a standard typeface below the letters “ALB”. These are also in upper case and the same typeface but are larger. In my view the letters will be seen as an abbreviation with “A” standing for “ANNE” and “L” for “LOUISE”. There is nothing in the mark to inform the consumer of the meaning of the letter “B”. Because of the size of the three-letter abbreviation, I consider that this will play the greater role in the overall impression of the opposed mark, although the contribution made by “ANNE LOUISE” is also significant.

68. The 131 mark is a plain word mark. In *LA Superquimica v European Union Intellectual Property Office (EUIPO)*, Case T-24/17, the GC held at [39] that such marks protected the word or words contained in the mark in whatever case, colour or typeface. The words “ANN LOUISE” will be perceived as the name of a woman or girl, with “BRIDAL” alluding to the goods and services provided under the mark. Consequently, “ANN LOUISE” will be the dominant and distinctive element.

69. Party A submits that the marks are visually highly similar as the words “ANN LOUISE” appear in the opposed mark and the letters “ALB” in that mark are the initials of “ANN LOUISE BRIDAL”. I note that the name “ANN/ANNE” has a different spelling in the respective marks, so this is a point of difference, albeit one that occurs at the end of the word. Another difference can be found in the large initials in the opposed

mark. While I accept that these are the first letters of each word in the 131 mark, the visual impact of those initials cannot be ignored. I find that the marks are visually similar to a medium degree.

70. All the words in the 131 mark will be pronounced in their usual way. Both “ANN/ANNE” and “LOUISE” are common names in the UK and the average consumer will know how to say them. The same applies to the word “BRIDAL”. The 131 mark has five syllables. Turning to the opposed mark, I remind myself that it would be wrong to indulge in an artificial dissection of the mark. Given its size, I consider that the average consumer would pronounce the three letters “AY-ELL-BEE” before going on to “ANNE” and “LOUISE”, which will be pronounced identically to “ANN LOUISE” in the 131 mark. The opposed mark has six syllables, with a different beginning. Taking the marks as wholes, I consider that they are aurally similar to a medium degree.

71. Conceptually, “ANN” and “ANNE” would be perceived by the average consumer as different spellings of the same name. A point of conceptual difference comes from the word “BRIDAL” at the end of the 131 mark, and this informs the consumer of the nature of the services supplied under the mark. Party A submits that “ALB” is an acronym of “ANN LOUISE BRIDAL”. It cannot be denied that “A”, “L” and “B” are the initials of the words in the 131 mark. However, when looking purely at the opposed mark, there is nothing in it to help the consumer understand what the letter “B” might stand for. Of course, that may be clearer in the context of the goods or services offered, but this is a point to which I shall return when conducting the global comparison. For the present, I find that the marks are conceptually similar to a high degree.

Distinctive character of the earlier mark

72. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*.

“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).”

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

74. I have already found that both “ANN/ANNE” and “LOUISE” are fairly common names in the UK and that “BRIDAL” is allusive or descriptive. Consequently, I find that the 131 mark has a medium degree of inherent distinctive character.

75. Party A has claimed that the 131 mark enjoys an enhanced distinctive character on account of the use that has been made of it. I have already considered the evidence of use when assessing the application for revocation and found that no use had been shown for the goods. I shall therefore only consider whether the distinctiveness of the mark has been enhanced with respect to *Retail services in the field of bridal ... wear*. The mark has been in use since 2015 in London, although I acknowledge that the client base extends more widely than this, with customers elsewhere in the south-east of England. I also note that Party A has won awards and elicited positive reviews from satisfied customers. As of the date of printing (6 July 2023), there were 126 reviews on Google, 5 on Yell, 48 on Bridebook, 5 on Guides for Brides and 138 on Facebook. The earliest of these date from before the relevant period, in 2016 and 2017. It has also been featured in magazines devoted to weddings. However, I have no information on the reach of these publications, how well-used the review sites are, or how widely known the awards might be. Over the five years 2017 to 2022, Party A spent £35,000 on promoting the mark, but Ms Butler does not say how this was spent. Party A exhibited at the National Wedding Show in 2016, but there is no evidence that it has

done so since then.²¹ Turnover for the period 2017 to 2022 was £1.564 million. I accept that the Covid pandemic had an impact on the wedding industry as a whole. I have nothing to tell me the size of the market for the services at issue. Even so, the turnover figures strike me as relatively small given the cost of the wedding dresses shown on the invoices. Taking the evidence as a whole, I consider that the evidence does not show that the inherent distinctive character of the earlier mark has been enhanced through use.

Conclusions on likelihood of confusion

76. Party A submits that confusion is not just likely, but that it has actually occurred. Ms Butler states that her business has received voicemails from customers of Party B with queries about orders and returns on 14 October 2021, 18 May 2022, 19 May 2022 and 25 May 2022.²² She also states that she has received returns of Party B's products. These appear to have been returned from an online retailer that deals with independent fashion boutiques and offers their goods to its customers. A variant of the opposed mark can be seen on the bag in the image below, with the words "Anne-Louise" in a handwritten script under the initials "ALB".²³



²¹ Exhibit CB4, pages 1-6.

²² Paragraph 14.

²³ Paragraph 15 and Exhibit CB9.

77. Party A further submits that the likelihood of confusion is exacerbated by the fact that Party B also sells bridal and bridesmaid dresses.²⁴

78. In *Maier & Anor v ASOS & Anor*, [2015] EWCA Civ 220, Kitchin LJ (as he then was) said that:

“80. ... the likelihood of confusion must be assessed globally taking into account all relevant factors and having regards to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion.”

79. I shall therefore carry out the usual global assessment, but will bear the above evidence in mind.

80. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the goods and services at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. There is no law setting out precisely what weight should be attached to each of the factors or providing a formula that can be applied to any set of circumstances. However, I am required to take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services or vice versa.

81. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

²⁴ See Exhibit CB10.

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

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).”

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

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

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

83. I found the goods and services to be identical and the marks to be visually and aurally similar to a medium degree and conceptually similar to a high degree. The conceptual content of the opposed mark is “ANNE LOUISE” and “ANN LOUISE” is the dominant and distinctive element of the 131 mark. The difference between “ANN” and “ANNE” will easily be misremembered by the average consumer, even when they are paying a high degree of attention, as both are common spellings of the name. Bearing in mind the imperfect recollection of the average consumer, I consider that there is a likelihood of direct confusion.

84. In case I am wrong in this, and the average consumer recalls that the marks are different, it is my view that they will consider that the opposed mark is another mark of Party A, given that the initials “ALB” could stand for “ANNE LOUISE BRIDAL”, particularly if the opposed mark were to be used for bridal wear or bridesmaids’ dresses. I find a likelihood of indirect confusion.

85. These findings are supported by the evidence of actual confusion, although they do not rely on them.

86. The opposition is wholly successful under section 5(2)(b). I do not therefore need to assess the likelihood of confusion with the 357 mark. I shall, however, briefly consider the remaining grounds for the sake of completeness.

Section 5(3)

87. Section 5(3) of the Act is as follows:

“A trade mark which–

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

[...]

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

88. The conditions of section 5(3) are cumulative. First, the marks at issue must be identical or similar. Secondly, Party A must satisfy me that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/services 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.

89. Party A claimed that both its marks enjoyed a reputation. However, its final written submissions focus on the 131 mark. As no use has been filed of the 357 mark, there is no evidence that it has a reputation and so I shall therefore base my assessment of this ground on the 131 mark alone. I note that I have already found that this mark is similar to the opposed mark.

Reputation

90. In *General Motors Corp v Yplon SA*, Case C-375/97, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

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

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

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

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

91. I do not intend to repeat the summary of the evidence that I made earlier when considering the revocation application. Where this evidence was not sufficient to show genuine use, it will not be sufficient to show reputation. I shall therefore continue this analysis on the basis of those services for which I found that there had been genuine use.

92. The relevant public for Party A’s services consists of women who are planning their wedding. I have already found that the sales figures are relatively low, when the cost of the goods retailed is taken into account, and it is not clear how the £35,000 promotional spend was incurred. A lot of the advertising and media coverage comes from 2016 and 2017, with a single article from 2019 and two from 2021. It is not clear

how widely known the awards are among the relevant public. In my view, the evidence does not establish that the 131 mark had a reputation at the relevant date.

93. The opposition fails under section 5(3).

Section 5(4)(a)

94. Section 5(4)(a) of the Act states that:

“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 or 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 4(A) is met

...”

95. Subsection 4(A) is as follows:

“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.”

96. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off at [406]:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods

or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

Relevant Date

97. In *Maier v ASOS*, Kitchin LJ (as he then was) said:

"165. ... Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the [contested] trade mark would have amounted to passing off. But if the [contested] trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began."

98. The date on which the opposed mark was applied for is 22 September 2022, and so this is the relevant date. However, the goods wrongly returned to Party A show use of a variant form of the mark on the bag containing the clothing. The return slips indicate that goods were ordered on 23 August 2022 and 25 August 2022, so I shall also consider the position on the earlier of these two dates.

Goodwill

99. Party A must show that it had goodwill in a business at the relevant date and that the sign relied upon, **ANN LOUISE BRIDAL**, is associated with, or distinctive of, that business. Party A has claimed that it has used this sign in relation to *Clothing, bridal gowns, accessories and jewellery; retail services relating to the aforementioned goods.*

100. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at [224]:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages 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. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

101. Under section 5(2)(b), I found that Party A had made genuine use of the mark **ANN LOUISE BRIDAL** for the services listed in [56] above. An assessment of genuine use is, of course, not the same thing as an assessment of goodwill. In *Mercis BV v Bunnyjuice Inc*, BL O/0064/24, Dr Brian Whitehead, sitting as the Appointed Person, said:

“57. ... In trade mark law, the analysis of proof of use, reputation and enhanced distinctive character needs to be performed on a granular basis, looking at each of the individual goods and services in turn. ... In passing off law, however, goodwill attaches to a business, rather than to isolated individual goods and services. Of course, when assessing goodwill, it is necessary to ask, ‘What is the nature of the business?’, but it is not appropriate to break the business down at the same level of granularity as is done for assessing trade mark use etc.”

102. I am satisfied that Party A had acquired at least in the South East of England a protectable goodwill by 23 August 2022 for *Retail services relating to bridal gowns, bridal accessories and bridal jewellery*, and that this goodwill had not diminished by 22 September 2022.

Misrepresentation

103. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473 at [493]:

“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] RPC 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 RPC 147 at page 175; and *Re Smith Hayden’s Application* (1945) 63 RPC 97 at page 101.”

104. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millett LJ explained at [714]-[715] that it was not necessary for the parties to be in competition with each other. He said:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression ‘common field of activity’ was coined by Wynn-Parry J in *McCulloch v May* (1948) 65 RPC 58, when he dismissed the plaintiff’s claim for want of this factor. This was contrary to the numerous previous authorities (see, for

example, *Eastman Photographic Materials Co Ltd v John Griffiths Cycle Corporation Ltd* (1898) 15 RPC 105 (cameras and bicycles); *Walter v Ashton* [1902] 2 Ch. 2 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although ‘the plaintiff and the defendant were not competing traders in the same line of business’. In the *Lego* case Falconer J acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal, but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘... whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel’s (Berkeley Square) Ltd v G Schock (t/a Annabel’s Escort Agency) [1972] RPC 838 at page 844 per Russell LJ

In the *Lego* case, Falconer J likewise held that the proximity of the defendant’s field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant’s conduct would cause the necessary confusion.

Where the plaintiff’s business name is a household name the degree of overlap between the fields of activity of the parties’ respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v McCain Foods (G.B.) Ltd* [1984] RPC 501 Slade LJ said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson LJ said at page 547:

'... in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden, how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged 'passer off seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.'

105. The services in the specification of the opposed mark (*Retail services relating to clothing*) clearly overlap with the activities of Party A. The sign relied on is the same as the 131 mark that I found to be visually and aurally similar to the opposed mark to a medium degree and conceptually similar to the opposed mark to a high degree. I find

that there is misrepresentation. Even if the goodwill is only local, I would make the same finding, as registration of a trade mark entitles the proprietor to use it throughout the UK.

106. I consider that the same applies with respect to *Clothing; clothes; Children's clothing; Ladies' clothing; Wedding dresses; Wedding gowns*, as these are all items of clothing that would be sold by Party A, or broader terms that include such items of clothing. I have put *Children's clothing* in this group as this term would include clothes for page boys and flower girls within a bridal party.

107. The distance between the activities of Party A and *Tops [clothing]; Knitted clothing; Maternity clothing* is greater. These are not items of clothing that the public associate with a retailer of bridal gowns, accessories and jewellery. In my view, the size of Party A's goodwill is not sufficient to bridge the gap. In *W.S. Foster & Son Limited v Brooks Brothers UK Limited* [2013] EWPC 18 (PCC), Mr Iain Purvis QC, sitting as a Recorder of the Court, said:

“54. Mr Aikens stressed in his argument the difference between ‘mere wondering’ on the part of a consumer as to a trade connection and an actual assumption of such a connection. In *Phones 4U Ltd v Phone4U.co.uk Internet Ltd* [2007] RPC 5 at 16-17 Jacob LJ stressed that the former was not sufficient for passing off. He concluded at 17:

‘This of course is a question of degree – there will be some mere wonderers and some assumers – there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former’.”

108. In the case of these goods, it is my view that at most the public would wonder where there was a connection, rather than assume that one exists. Consequently, I find no misrepresentation for these goods and the section 5(4)(a) ground fails with regard to *Tops [clothing]; Knitted clothing; Maternity clothing*.

Damage

109. In *Harrods*, Millett LJ described the requirements for damage in passing off cases at [715]:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff’s business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff’s goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff’s reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant’s plastic irrigation equipment might be dissuaded from buying one of the plaintiff’s plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”

110. The parties will be in competition over retail services relating to bridal wear. There is a risk that Party A will lose potential customers to Party B. In respect of the goods, I consider that there is a risk of injurious association. Damage is made out.

111. The opposition succeeds under section 5(4)(a) for the following goods and services:

Class 25

Clothing; Clothes; Children’s clothing; Ladies’ clothing; Wedding dresses; Wedding gowns.

Class 35

Retail services relating to clothing.

OUTCOME

112. The application for revocation has been partially successful and the 131 mark is revoked with effect from 7 October 2022 for the following goods:

Class 14

Costume jewelry; tiara; wedding rings; wedding bands; silver earrings; gold earrings; earrings of precious metal; necklace charms; silver necklaces; gold necklaces; necklaces [jewelry]; necklaces of precious metal; jewelry for the head; bracelets; bracelet charms; silver bracelets; bracelets [jewelry]; gold bracelets; bracelets of precious metal; bracelets made of embroidered textile [jewelry].

Class 25

Wedding dresses; ladies' dresses; bridesmaid dresses and special occasion dresses for women and children; evening dresses; women's ceremonial dresses; evening gowns; bridal gowns; wedding gowns; cheongsams (Chinese gowns); formal evening wear; gloves; gloves without fingers; gloves as clothing; veils; headdresses [veils]; veil [clothing]; fabric belts; waist belts; belts for clothing; fabric belts [clothing]; belts made out of cloth; underclothes; underclothing; undergarments; under garments; ladies' underwear; women's undergarments; women's underclothing; corsets [underclothing]; underwear for women; women's underwear; underclothing for women; garters; girls' clothing; outer clothing for girls; boys' clothing; outer clothing for boys.

113. It remains registered for services in Class 35 and the specification is amended as follows with effect from 7 October 2022. The terms to be deleted are shown in strike-through and the words to be added are underlined:

Class 35

Retail services in the field of ~~bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, decorative hair combs, articles of jewelry made of precious metals and non-precious metals, costume jewelry, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories; online retail store services relating to bridal,~~

~~wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, combs, articles of jewelry made of precious metals and non-precious metals, costume jewelry, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories; advertising services relating to bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, combs, articles of jewelry made of precious metals and non-precious metals, costume jewelry, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories; information, advisory and consultancy services relating to bridal, wedding and special occasion wear, bridal gowns, wedding dresses, outfits and dresses, bridesmaids dresses, underwear, hosiery, stockings, suspenders, petticoats, bridal veils, cufflinks, handbags, purses, shoes, articles of headwear, headgear, tiaras, fascinators, hats, decorative hair combs, articles of jewelry made of precious metals and non-precious metals, costume jewelry, bangles, bracelets, brooches, necklaces, earrings, rings, hair accessories.~~

114. The opposition has been successful and Application No. 3832142 is refused registration.

COSTS

115. Both parties have enjoyed some success in these proceedings, with the greater part going to Party A, which is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice No. 2/2016. I have calculated this award as follows, taking into account Party A's partial success in the revocation and total success in the opposition:

£200 for preparing a statement and considering the other side's statement;
£700 for preparing evidence;
£300 for preparing written submissions in lieu of a hearing;
£200 for official fees.

£1400 in total.

116. I therefore order Anne Louise Limited to pay Ann Louise Bridal Limited the sum of £1400. This 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 16th day of September 2024

**Clare Boucher
For the Registrar,
Comptroller-General**