

O/1181/25

TRADE MARKS ACT 1994

IN THE MATTER OF

UK TRADE MARK APPLICATION No. 3894547

CONDITION

IN CLASS 25

IN THE NAME OF

CONDITION (U.K.) LTD

- AND -

OPPOSITION No. 441926 THERETO BY DIANA IRANI

BACKGROUND AND PLEADINGS

1. On 29 March 2023 (“**the Relevant Date**”), Condition (UK) Ltd (“**the Applicant**”) applied to register the word “CONDITION” as a UK trade mark (“**the Application**”) in respect of the following goods in Class 25: *Clothing; Clothing for sports; Athletic clothing; Footwear; Headwear.*
2. On 13 July 2023, the Application was opposed by Diana Irani (“**the Opponent**”). The opposition is based on sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“**the Act**”). The Opponent is the proprietor of the following earlier filed trade mark (“**the Earlier Mark**”):

UKTM No. UK00906756035

Word mark: *CONDITIONS APPLY

Filing date: 14 March 2008

Registered on 17 February 2010 for goods and services in Classes 14, 18, 25 and 35.

3. The **section 5(2)(b)** claim is that the applied-for mark is similar to the Opponent’s Earlier Mark, and the Applicant’s goods are identical or similar to goods registered under the Earlier Mark, giving rise to a likelihood of confusion. The Opponent relies on the following goods under its registration in Class 25: *Articles of clothing; articles of outer clothing; articles of sports clothing; footwear; headgear.* The Earlier Mark had been registered for more than five years before the Relevant Date, and the Opponent duly stated that the Earlier Mark had been used in the period of 5 years ending on the Relevant Date, in respect of all of the goods relied on.
4. The **section 5(4)(a)** claim is that at the Relevant Date use of the applied-for trade mark would have been actionable under the law of passing off. The Opponent’s statement of grounds claims goodwill associated with the sign *CONDITIONS APPLY, based on use since 2010 throughout the UK in respect of the following goods: *articles of clothing; articles of outer clothing; articles of sports clothing; footwear; headgear.* The Opponent claims that use of the applied-for mark would be a misrepresentation,

deceiving consumers into believing that the Applicant's goods originate from the Opponent and that this misrepresentation would cause damage to the Opponent's goodwill.

5. The Applicant filed a defence notice and counterstatement denying the grounds of opposition. It put the Opponent to strict proof of use of the Earlier Mark as registered in respect of the goods relied on, in order to determine the reliable scope of the registration. The Applicant denied in any event that there is any confusing similarity between the parties' marks, taking account of their visual, aural and conceptual differences. The Applicant likewise put the Opponent to strict proof of the existence of the claimed goodwill, and in any event denied that the goods of the Applicant would be misrepresented as being associated with the Opponent.
6. Only the Opponent filed evidence. The Applicant requested an oral hearing, which took place on 10 February 2025. Seaghan Davey of Counsel attended for the Opponent, instructed by Briffa Legal Ltd; Andrew Marsden, of Wilson Gunn, attended as attorney for the Applicant. Both sides filed helpful skeleton arguments in advance of the oral hearing. I have read all the papers filed and refer to their contents and to points made at the hearing to the extent I consider it warranted to do so.

RELEVANCE OF EU LAW

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

DECISION

The Section 5(2)(b) Claim

8. Section 5(2)(b) of the Act provides as follows:

Section 5 Relative grounds for refusal of registration.

[...]

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

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Proof Of Use

9. Section 6 of the Act defines what is meant by an “earlier trade mark” for the purposes of section 5; by virtue of its earlier filing date, the Opponent’s trade mark qualifies as such. As it had been registered for more than five years at the filing date of the Application, it is subject to the use conditions pursuant to section 6A of the Act, and as it is a comparable trade mark (EU) it is additionally subject to the provisions set out in Schedule 2A, Part 1, paragraph 7 of the Act. Relevant provisions are set out below.

Section 6A

(1) This section applies where—

(a) an application for registration of a trade mark has been published,

(b) [...]

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) [...]

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

(3) The use conditions are met if—

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes—
- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

[...]

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

Schedule 2A, Part 1, paragraph 7

- (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.
- (2) Where the relevant period referred to in section 6A(3)(a) (the “five-year period”) has expired before IP completion day—
 - (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
 - (b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.
- (3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day—
 - (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and
 - (b) the references in section 6A to the United Kingdom include the European Union.

10. In line with section 6A(2), the Opponent can rely on her Earlier Mark only to the extent that the evidence filed establishes that it had been put to genuine use in respect of the registered goods relied on, within the five years up to the date on which the Application was filed. The relevant period in which the Opponent must establish use of the Earlier Mark is therefore 30 March 2018 to 29 March 2023 (“**the Relevant Period**”).
11. As the Earlier Mark is a comparable mark (EU), use in the EU remains relevant since a part of the relevant five-year period falls prior to IP Completion Day.¹ Therefore, the Opponent could rely on use of the corresponding EUTM in the EU, including the UK, prior to IP Completion Day. However, any use after IP Completion Day (i.e. from 1 January 2021) must relate solely to use in the UK.

Evidence of Use

12. Section 100 of the Act makes it clear that the onus is on the Opponent to provide evidence to support the claimed use. Genuine use of the Earlier Mark must be established during the Relevant Period and in the relevant territory. Given its nature as a comparable trade mark (EU), it was, as I have noted, open to the Opponent to rely on evidence of genuine use relating to the EU, including the UK, for the period from 30 March 2018 to 31 December 2020. However, although there are a few references to places in Europe, such as Paris and London, the evidence of genuine use overall, as I shall explain, falls short of the expectations set out in the applicable case law (as referenced below), and while the evidence in respect of the UK is thin, it is not fortified by considering the earlier position of the wider territory of the EU.²
13. This part of my decision examines the evidence filed of use of the earlier registered trade mark. That Earlier Mark is identical to the sign (unregistered trade mark) relied on by the Opponent for her section 5(4)(a) claim and the registered goods relied on are the same as those claimed in the context of the goodwill. Whereas genuine use of the Earlier Mark is framed by the dates of the five-year Relevant Period, evidence of goodwill is not so strictly defined by a timeframe (though goodwill is to be shown to

1 “IP” here refers to the end of the implementation period, up to 31 December 2020, when the changes arising from the UK’s departure from the EU took effect across the UK’s legal regime.

2 For this reason, I omit any account of case law that considers the required territorial extent of use for EU purposes, notably, *Walton International Ltd & Anor v Verweij Fashion BV*, [2018] EWHC 1608 (Ch).

have existed at the Relevant Date). Some of the evidence is from outside the Relevant Period, but I shall nonetheless mention it to the extent that there may be comment to be made on its potential contribution to the evidence of goodwill for the purposes of the section 5(4)(a) claim.

Proof of use case law

14. The applicable legal principles relating to genuine use of a registered trade mark, derived from a series of EU decisions were summarised in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247 by Arnold LJ as follows (where I have emphasised certain points in bold):

“106. [...]:

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

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

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

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

latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

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

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

107. [...] 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 the 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.”

15. In *Awareness Ltd*, the Appointed Person goes on to say that (my emphasis):

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind)

the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. **The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered [...].**”

16. I also note Mr Alexander’s comments in *Guccio Gucci SPA v Gerry Weber International AG*.³ He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round – or lose it”.”

17. The genuine use provision is not there to assess economic success or large-scale commercial use.⁴ An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁵

The Opponent’s Evidence

18. The evidence comprises a witness statement of Diana Irani dated 18 January 2024, with 11 exhibits in total, including confidential Exhibits DI5, DI8 and DI9. The witness is the Opponent and co-founder of I&G Limited (formerly Irani and Gressier Limited). I&G Limited is stated to be a clothing company producing ethical, luxurious, handcrafted women’s clothing at affordable rates.

3 Case BL O/424/14.

4 *MFE Marienfelde GmbH v OHIM*, Case T-334/01.

5 *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.

19. Ms Irani left her role as director of I&G Limited in 2021, but remains its lead designer. The other co-founder, Julien Gressier, is the current and only director of I&G Limited. Ms Irani is authorised by Mr Gressier and I&G Limited to make the witness statement. She states that I&G Limited is and has always been the only licensee of the Earlier Mark. The account of the relationship between the Opponent and I&G Limited is unchallenged, and I accordingly find that any use by I&G Limited is with the authority and consent of the Opponent.

Variant form use

20. The provision in section 6A(4)(a) of the Act - that genuine use of a registered trade mark may be satisfied by evidence of use in trade of an acceptable variant – “avoids imposing strict conformity between the used form of the trade mark and the form in which the mark was registered, is to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned.”⁶
21. Case law sets out the correct approach to consideration of whether evidenced use of a trade mark is in a form that is an acceptable “variant form” for the purposes of section 6A(4)(a) of the Act, i.e. whether it differs in elements that do not alter the distinctive character of the mark in the form in which it was registered.⁷ It requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences).
22. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, the Court of Justice of the European Union found that that “the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark”⁸ but that, nevertheless, “a registered trade mark that is used only as part of a composite mark or in conjunction with another

6 General Court in T-146/15 *Hyphen v EUIPO*, EU:T:2016:469 at [27].

7 See for instance *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Professor Phillip Johnson, sitting as the Appointed Person

8 [32]

mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' ..."⁹

23. In *Hyphen GmbH v EU IPO*, Case T-146/15, the General Court held that use of the mark shown on the left below constituted use of the registered mark shown on the right. The court held that the addition of a circle, being merely a banal surrounding for the registered mark, did not alter the distinctive character of the mark as registered.



24. The court set out the following approach to the assessment of whether the inclusion of additional components is likely to alter the form of the registered mark to a material extent.

“28. ...a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark ...

29 For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true ...

25. Where a mark contains words and a figurative element the word element will usually be more distinctive; this suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements. In

9 [35]

Hyphen, the addition of a circle around the registered mark was not sufficient to alter the distinctive character of the registered mark. In the present case, as Mr Marsden presented in his skeleton argument, the following marks appear in the evidence:

| | |
|-------|--|
| (i) | <p>CONDITIONS APPLY</p> |
| (ii) |  |
| (iii) |  |
| (iv) |  |
| (v) |  |
| (vi) |  |

26. Mr Marsden submitted that none of the above is the same as the registered mark and that none of the marks shown in the evidence constitute acceptable variants of the registered mark. He argued as follows:

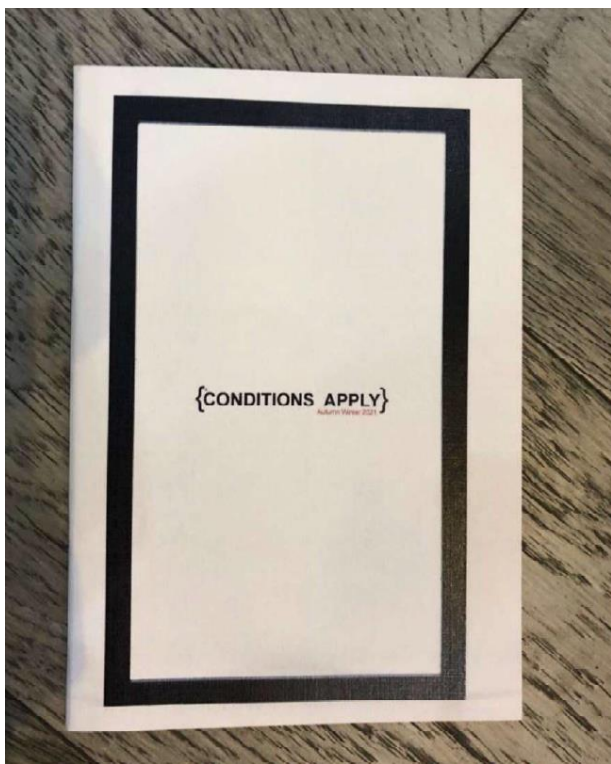
- i. The asterisk is a key distinctive part of the registered mark, its omission is fatal.
- ii. The brackets used with the Opponent’s mark in the evidence are part of the mark. The inclusion of the brackets is not merely incidental, there is no justification for the inclusion of the brackets other than as a distinctive element of the brand, thereby creating a new mark which, in his submission, is not the registered mark and cannot therefore support the registration. The evidence includes several uses

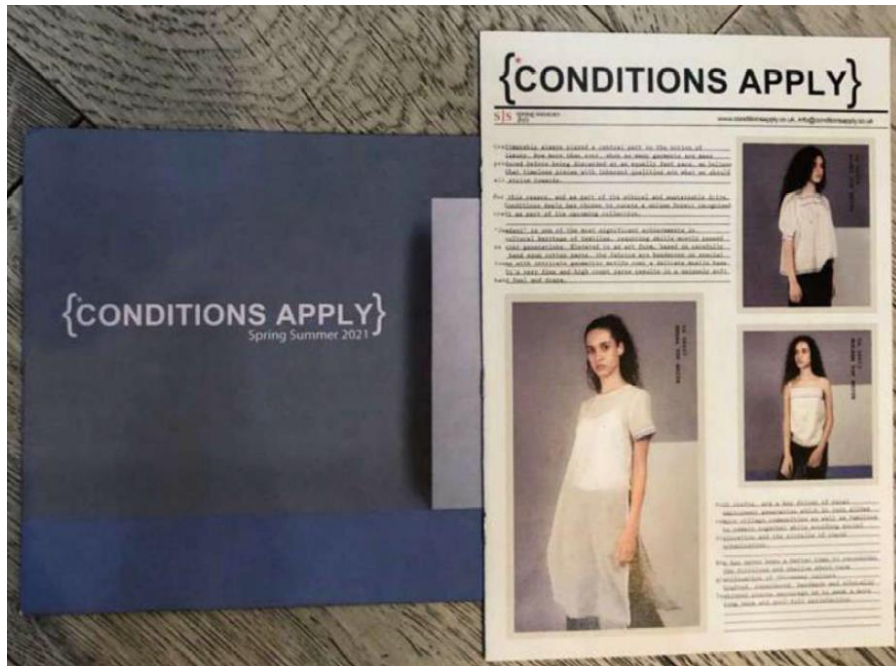
of the mark with the brackets, all brochures feature the brackets on the front covers, and there is a shop window representation showing the brackets.

- iii. The presentation of the asterisk in colour (once in red and once in yellow) is a further distinctive element which is not reflected in the registered mark. The asterisk shown in several places in the evidence is different from the asterisk in the registered mark, which has 5 points.
27. In my view, given the small size of the asterisk and the commonplace nature of the symbol in written text, I am not convinced that its omission should be cast as unacceptable variant use. Nor do I consider small variations in the form or colour of the asterisk to be significant enough to render the use an unacceptable variant. The addition of the curly brackets has more significance, but the whole of the word mark as registered (asterisk and word phrase) is centrally present. Parentheses are commonplace in written text, and I find the brackets are, at best, of very low intrinsic distinctive character, where the greater distinctiveness is clearly the two-word textual phrase; sitting on the outer sides, I do not consider the brackets to be dominant in the marks shown, rather the two-word textual phrase is dominant. I find that the extra words (such as “Autumn/Winter 2021”) are descriptive additions, separate from the Earlier Mark that do not change its distinctive character. I conclude that the marks shown in the evidence are acceptable variant uses and I move on to give my account of the evidence taken as whole is sufficient or adequate to satisfy the burden of establishing genuine use.
28. **Exhibit D11** shows pages from various magazines, where the Opponent’s brand is referenced, including Boutique Magazine in 2015 and 2016, Drapers Magazine (2013) and Women & Home (2010). These are all from outside the Relevant Period, so are not relevant in establishing genuine use. Moreover, the marks are merely mentioned in tiny text; this is not, for example, evidence of a profile piece that may be more likely to attract consumer attention. It is not clear where the magazines were published or in what numbers; I note that the items of clothing shown at page 14 of the exhibit appear to be priced in Japanese Yen, so the publication is unlikely to have been targeted towards UK consumers.

29. **Exhibit DI2** is to support Ms Irani's statement that the brand "has a presence on social media." It confirms that the "Conditions Apply" Facebook page was set up in 2010 and has (at the date of printing) 722 followers and 709 'likes'. No content is shown, so it is not clear where the followers and likers may be based or when they liked a post or became a follower. In any event the numbers are very modest and do not show use in respect of the goods claimed. The exhibit also confirms the setting up of a conditions_apply_official Instagram account as of January 2023. This is less than 3 months before the end of the Relevant Period. The account is shown to be based in India, and to have 1313 followers and 1106 posts, but no information is given as to what the posts are or where the followers may be based or when they became a follower. In any event the numbers are very modest and do not show use in respect of the goods claimed.
30. **Exhibit DI3** lists stockists in various countries, including Japan, UAE, Netherlands, Belgium, France, Spain, Ireland and USA. 26 stockists are listed for the UK. However, the list of stockists is not dated the witness does not state when these stockists have supplied goods or what the goods stocked may be. The exhibit does not show use in respect of the goods claimed.
31. **Exhibit DI4** is a single page from conditionsapply.co.uk website, which the witness states sells directly to consumers in the UK. The page shows a model wearing dungarees. The exhibit is undated and does not show use in respect of the goods claimed during the Relevant Period.
32. **Exhibit DI5** is confidential detail on the UK website activity, but the main evidential thrust is set out at paragraph 12 of the witness statement which states that the UK website had "a total of 8054 visitors across 9024 sessions in 2023 alone." It is not apparent how many of those visits were before the end of the Relevant Period (29 March 2023). Nor is it explained how those visits progressed to sales or exposure to the Earlier Mark in respect of the goods relied on. The exhibit does not show genuine use in respect of the goods claimed during the Relevant Period.

33. **Exhibit DI6** is stated to be examples of a lookbook (a catalogue) of the *Conditions Appy collections Autumn / Winter (AW) and Spring / Summer (SS). The exhibit comprises 11 pages. The date years and the Earlier Mark (or an accepted variant form) are included and visible in only some of those pages, but the majority either pre- or postdate the Relevant Period. Others indicate the years 2018 (PRE-SS18), 2019 (AW19), 2021 (Spring /Summer 20121 and Autumn/Winter 2021) 2021 (Spring /Summer 2023), so within the Relevant Period. Ms Irani states that the exhibit is just one example of the annual marketing on which “a considerable amount” is spent. The exhibited lookbooks reveal little, as is seen from the following extracts:





34. There is no evidence of how many of the catalogues were printed, what they contained, to what extent and to whom they were distributed and in which territory. The reference to annual marketing expenditure is very vague indeed. The evidence around **Exhibit D16** does not usefully contribute to the task of showing genuine use of the Earlier Mark in respect of the Opponent's goods in the Relevant Period in the UK.
35. The witness states at paragraph 14 that the Spring Summer 2024 collection was showcased in 2023 in London, Paris, New York and Texas. **Exhibit D17** shows that these events took place after the Relevant Period and are therefore of no relevance.

36. Paragraph 15 of Ms Irani's witness statement introduces the table below, which she states contains approximate net sales figures of *CONDITIONS APPLY branded products between 2019 – 2023.

| *CONDITIONS APPLY UK Net Sales Figures | | | | |
|---|-------------|----------|----------|------------|
| 2019 | 2020 | 2021 | 2022 | 2023 |
| £193,435.14 | £159,818.92 | £350,604 | £122,520 | £86,401.80 |

37. **Confidential Exhibit D18** is a small-print, 8-page printout of a spreadsheet, which Ms Irani states to be a breakdown from an internal database “of sales made by *CONDITIONS APPLY in the UK”. There is no reference in the exhibit to the Earlier Mark, nor any clarification of what are the “branded products” to which Ms Irani refers at paragraph 15. Although from elsewhere in the Opponent's evidence it is apparent that the trade mark is concerned with women's clothing, this exhibit does not identify or particularise any items of clothing. I also note that there is a good deal of mismatch between, on the one hand, the list of 26 UK stockists named in **Exhibit D13**, and, on the other hand, the “Customer Names” (shop names) listed in the 8 pages of sales breakdown in **Exhibit D18**, wherein by far the most predominantly listed names are not among the 26 stockists identified in **Exhibit D13**. The figures given do not strike me as obviously “approximate”, and I also note that although the witness statement refers to the figures in the table above as “Net Sales Figures”, it is clear from the spreadsheet at **Exhibit D18** that the figures in the table include VAT at 20%. For instance, the figure shown in the table for 2021 and mirrored in the Grand Total column of the spreadsheet is £350,604, but the total without VAT is £292,170 (as shown in the spreadsheet).

38. Ms Irani describes **Confidential Exhibit D19** as a “sample of sales invoices we have throughout our time in existence.” None of the invoices is in respect of clothing or other goods in class 25, but instead are payments (by the Opponent or her company) for shows/booths, often outside the UK and the EU.

39. The remaining exhibits are not directed to the question of use.
40. Taking account of all of the above and the principles from case law, I am not satisfied that the Opponent has discharged the burden of establishing genuine use. The table of sales figures may be significant, but it is not sufficiently corroborated by what the witness has chosen to exhibit. Indeed, in some respects it is undermined by the witness's misdescription of the yearly sales sums and of the invoices at **Exhibit D19**. Nowhere in the evidence is there a clear indication of the goods sold or offered for sale in the UK during the Relevant Period. It would presumably have been straightforward for the Opponent to list what articles of clothing, footwear and headgear are in the seasonal collections referenced and how many of each were sold in the UK or EU. It should have been easy to state which goods were supplied to the stockists or sold through its website to customers in the relevant territory. There is no compelling evidence of how the consumer had been exposed to the Earlier Mark in respect of those goods – such as on clothing labels or swing tags. There is no confirmation of actual sales of the goods, no relevant promotion and no reviews of any goods sold. The flaws and weaknesses referenced in my narrative account highlight that the majority of the evidence is either not relevant or of virtually no probatory value.
41. I of course bear in mind all of the case law principles I have reference above, including that use of the mark need not always be quantitatively significant for it to be deemed genuine, nor is it not strictly necessary to exhibit any particular kind of documentation.
42. However, case law also makes clear 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, and 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.
43. Taking account of the evidence in the round, I find it to be insufficiently clear, lacking in vital detail and not well-supported or solid. Since it is not possible to determine from the evidence in relation to what goods there has been genuine use of the mark during

the Relevant Period (if any), it is impossible to determine the reliable scope of the registration. Since the Opponent has failed to prove genuine use, it is unable to rely on its Earlier Mark and the section 5(2)(b) ground inevitably fails for lack of basis.

44. Though the matter of the section 5(2)(b) claim ends there, it is perhaps worth stating my view, albeit in the briefest of terms, that the differences between the marks, would not give rise to a likelihood of confusion. Not only are there significant visual and aural differences, but there is also a notable conceptual difference between the lone, singular word CONDITION and the two-word phrase of the Earlier Mark. Certainly, in the absence of evidence of enhanced distinctive character, I would anyway have concluded that even for identical goods (clothing), there is no real likelihood of direct or indirect confusion on the part of the general public (the average consumer) as to the origin of the goods, such that the claim would still have failed.

The Section 5(4)(a) Claim

45. The Act reads:

Section 5 Relative grounds for refusal of registration.

[...]

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

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

[...]

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

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

46. In *Jadebay*,¹⁰ Her Honour Judge Melissa Clarke, sitting as Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off

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

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

Goodwill

47. The first element described in *Reckitt & Colman* refers to “goodwill or reputation”, although case law has developed so as to distinguish between goodwill and “mere reputation” – the latter being insufficient alone to sustain a claim of passing off. To satisfy the first element of the tort, the Opponent is required to show that it has goodwill among UK consumers. It must have actual consumers in the UK, who buy its goods and have been exposed to its sign.

48. In *Hart v Relentless Records*, Jacob J. (as he then was) stated his view that “the law of passing off does not protect a goodwill of trivial extent. one is looking for more than a minimal reputation.”¹¹ This does not mean that a small business is incapable of establishing goodwill - even though its goodwill may be modest, a business can protect signs which are distinctive of that business under the law of passing off. Thus, in *Lumos Skincare Ltd v Sweet Squared Ltd*,¹² the Court of Appeal upheld a claim for

10 *Jadebay Limited, Noa and Nani Limited (trading as The Discount Outlet) v Clarke-Coles Limited (trading as Feel Good UK)* [2017] EWHC 1400 IPEC.

11 *Hart & Anor v Relentless Records* [2002] EWHC 1984 (Ch) [62]

12 [2013] EWCA Civ 590

passing off based on the claimant's use of the mark "LUMOS" for around three years before the defendant's use of the same mark, even though sales volumes and turnover were modest. In that case, the Claimant sold skincare products under the name LUMOS and alleged passing off by the Defendants' sale of nail care products under the same name. Both parties sold their products to beauty salons whose technicians used the products on their customers. The claimant's products sold for between £40 and £100 each and between early 2008 and September 2009, the claimant had achieved a turnover of around £2,000 for quarter. From the latter date up until the relevant date in October 2010, the claimant's turnover increased to around £10k per quarter and had repeat custom from over 25 retail clients. Even so, the claimant remained a very small business with a modest number of sales, yet the court was prepared to protect the goodwill in that business under the law of passing off. It is also the case that a relatively short period of time may sometimes be sufficient to build up goodwill.¹³ Each case turns on the individual facts found in the evidence.

49. To succeed in its section 5(4)(a) claim, the Opponent must first establish that, at the Relevant Date, it had the benefit of actionable goodwill among the relevant consumers in the UK. In light of my earlier consideration of the evidence, I find the claimed extent of use of the sign - throughout the UK, since at least 2010, in respect of articles of clothing, articles of outer clothing, articles of sports clothing, footwear and headgear - is not substantiated. Even if I were to regard the 5 years of sales figures given in the table in the witness statement as of sufficient scale and consistency on which to base a claim of goodwill, the evidence fails to show what goods are the source of the claimed sales income or how the sign was used in respect of those goods. The promotional evidence is extremely thin and I cannot conclude that UK consumers had been exposed to the sign to any reliable degree. I find that the Opponent has failed to establish the requisite goodwill and consequently the claim under section 5(4)(a) inevitably fails.
50. Though the matter of the section 5(4)(a) claim ends there, I again give my view that the differences between the marks, would not give rise to a misrepresentation. The test for misrepresentation for passing off purposes differs from the test for a likelihood

13 The notorious outlier example in this regard being *Stannard v Reay* [1967] F.S.R. 140, 144

of confusion under trade mark law.¹⁴ However, it seems doubtful whether the difference between the legal tests will - all other factors being equal - produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.¹⁵ Since the unregistered mark and claimed goods under section 5(4)(a) are in the present case precisely the same as the Earlier Mark relied on under section 5(2)(b), there is no factor that would lead to a different outcome between the two grounds.

OVERALL OUTCOME OF OPPOSITION

51. The Opposition fails in its entirety and subject to any successful appeal, trade mark application No. 3894547 may proceed to registration.

COSTS

52. The Applicant is entitled to a contribution towards its costs in these proceedings, in line with the scale set out in Tribunal Practice Notice 1/2023. I award the sum of **£2000**, which is calculated as follows:

Considering the statement of grounds and preparing a counterstatement: **£500**

Considering the Opponent's evidence: **£500**

Preparation for and attending a hearing: **£1000**

53. I order Diana Irani to pay Condition (UK) Ltd the sum of £2000. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of December 2025

Matthew Williams

For the Registrar

14 In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewison L.J. pointed out that it is sufficient for passing off purposes that "a *substantial number*" of the relevant public are deceived, which might not mean that the average consumer is confused.

15 The overlap or blurred distinction between the tests is supported by the terms in which Kitchen L J refers to the role of the average consumer in the assessment of a likelihood of confusion in the the Court of Appeal case *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, at paragraph 34(v).