

O/1187/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 4063294

BY JOSEPH JOHNSON

TO REGISTER THE TRADE MARK:



IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 449850

BY FLICK FASHIONS LIMITED

BACKGROUND AND PLEADINGS

1. On 13th June 2024, Mr Joseph Johnson (“the applicant”) applied to register the trade mark shown on the cover of this decision in the United Kingdom. The application was accepted and published in the Trade Marks Journal on 28th June 2024, in respect of the following goods:

Class 25: *Clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Woolen clothing; Layettes [clothing]; Clothing layettes; Garments for protecting clothing; Linen clothing; Headbands for clothing; Clothes; Gloves [clothing]; Gloves as clothing; Aprons [clothing]; Jerseys [clothing]; Shorts [clothing]; Denims [clothing]; Cashmere clothing; Capes (clothing); Silk clothing; Leather clothing; Clothing of leather; Leather (Clothing of -); Parts of clothing, footwear and headgear; Collars [clothing]; Veils [clothing]; Knitted clothing; Corsets [clothing, foundation garments]; Embroidered clothing; Hoods [clothing]; Windproof clothing; Wristbands [clothing]; Belts [clothing]; Belts for clothing; Casual clothing; Rainproof clothing; Bandeaux [clothing]; Waterproof clothing; Jackets being sports clothing; Visors [clothing]; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Latex clothing; Trunks being clothing; Playsuits [clothing]; Woven clothing; Infant clothing; Drawers [clothing]; Drawers as clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Ties [clothing]; Clothing for children; Muffs [clothing]; Bodies [clothing]; Clothing for infants; Clothing for babies; Tops [clothing]; Weatherproof clothing; Clothing for cycling; Water-resistant clothing; Fabric belts [clothing]; Pockets for clothing; Handwarmers [clothing]; Clothing for skiing; Beach clothing; Triathlon clothing; Chaps (clothing); Thermal clothing; Cowls [clothing]; Fishing clothing; Men's clothing; Dance clothing; Mitts [clothing]; Braces for clothing; Plush clothing.*

2. On 27th September 2024, Flick Fashions Limited (“the opponent”) opposed the application based on Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in the application.

3. The opponent relies upon the earlier marks shown below:

DREAMS

UK00002060937

Filing date: 13th March 1996, Registration date: 25th October 1996

Relying upon the following goods:

Class 25: *Articles of clothing; swimwear, footwear and headgear.*

DREAM

UK00002216417

Filing date: 7th December 1999, Registration date: 27th April 2001

Relying upon the following goods:

Class 25: *Clothing; swimwear; footwear; headgear.*

DREAMS LONDON

UK00003904128

Filing date: 24th April 2023, Registration date: 21st July 2023

Relying upon the following goods:

Class 25: *Clothing; footwear; headgear.*

4. By virtue of their earlier filing dates, the above registrations constitute earlier marks within the meaning of section 6 of the Act. Two of the marks ('DREAMS' and 'DREAM') had completed their registration processes more than five years before the filing date of the contested mark and are therefore subject to the proof of use provisions contained in section 6A of the Act. This does not apply to the third mark 'DREAMS LONDON' which was registered in 2023.

5. The opponent indicates on its TM7 form that it relies on all the goods for which the 'DREAM' and 'DREAMS' marks are registered. However, on the same form, it only provides a statement of use for some of the goods ("*Clothing*").¹ Since the statement of use has only been made in respect of "*clothing*", this is all that the opponent may rely upon – subject to satisfying the proof of use requirements.
6. Under Section 5(2)(b), the opponent claims that the contested application is visually, aurally and conceptually highly similar to its earlier marks and that the goods are identical or similar to its registrations. Therefore, that there exists a likelihood of confusion between the marks, including a likelihood of association.²
7. The applicant filed a counterstatement denying the claims made and requesting proof of use for the 'DREAM' and 'DREAMS' marks. It admitted that the marks are for identical goods and share the 'DREAMS' element, but that the marks must be considered as a whole and are "stylistically very different".³ The applicant asserts that the average consumer would be able to "readily identify and interpret the marks as originating from different undertakings".⁴
8. In these proceedings, the opponent is represented by Stratagem Intellectual Property Management Limited and the applicant by HGF Limited.⁵
9. Both sides filed evidence which will be summarised only to the extent that is considered necessary. Only the applicant filed written submissions in lieu of a hearing which will not be summarised, but will be referred to as and where appropriate during this decision. As no hearing was requested, this decision is taken following a careful perusal of the papers.
10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a)

¹ I note that the specification for the 'DREAMS' mark (UK00002060937) reads "Articles of clothing" rather than "Clothing", but this is immaterial.

² TM7 dated 27th September 2024.

³ Section 6 of counterstatement dated 29th November 2024.

⁴ Section 10 of counterstatement dated 29th November 2024.

⁵ HGF Limited was appointed by via TM33 on 8th October 2024.

of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence

11. The opponent's evidence is in the form of a witness statement dated 4th February 2025 from Tahir Sharif, Executive Director of the opponent, a position he has held since 1983. The witness statement includes 14 accompanying exhibits. The purpose of the evidence is to speak to the use of the opponent's marks. The applicant's evidence includes a witness statement from Rachel Platts, Trade Mark Director of the opponent's representative, HGF Limited. This, and the three accompanying exhibits, provides information on dictionary definitions for 'DREAMS', and three opposition cases by KTS Group Limited (with corresponding information from Companies House) which the applicant deems relevant to the present case.

Proof of use

12. The applicant has requested proof of use in these proceedings in respect of the opponent's earlier 'DREAM' and 'DREAMS' marks. I will begin by assessing whether and to what extent the evidence supports the opponent's statement that it has made genuine use of the earlier marks in relation to the goods relied upon. In accordance with section 6A(1A) of the Act, the relevant period for this purpose is the five years ending on the filing date of the contested application: 14th June 2019 to 13th June 2024.

13. I note that the opponent's witness statement and evidence deal exclusively with use of the 'DREAMS' mark, with no reference to use of the 'DREAM' registration. I will similarly focus my assessment on the 'DREAMS' mark due to this being the opponent's best case when compared to the contested mark, which also uses 'DREAMS' in the plural form. I will revisit the other two marks during my

conclusions on likelihood of confusion.

14. Section 6A of the Act states:

“(1) This section applies where

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

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

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

(3) The use conditions are met if –

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

(4) For these purposes -

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

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

15. Section 100 is also relevant, which reads:

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

16. Consequently, the onus is upon the opponent to prove that genuine use of the registered trade mark was made within the relevant territory in the relevant period, and in respect of the goods as registered.

Relevant case law

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009]

ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

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

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

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

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

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

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

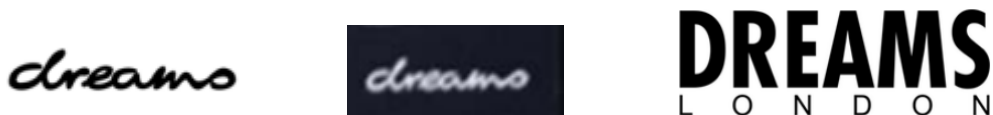
Form of the mark

18. For the sake of completeness, before I move on to assess if the opponent has shown genuine use, I must first consider if I find the use of the marks as shown in

the evidence to be use of the marks as registered. As outlined in *Lactalis McLelland Limited v Arla Foods AMBA*, Case O/265/22, the use of the mark in a different form may also constitute use of the mark as registered.

19. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, the Court of Justice of the European Union (“CJEU”) found 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” but that “a registered trade mark that is used only as part of a composite mark or in conjunction with another 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’ within the meaning of Article 15(1).”

20. Where the opponent has used its marks in their word only form this is clearly use upon which it may rely. However, I note that the evidence shows use of ‘DREAMS’ with ‘LONDON’ underneath, or with stylisation, e.g. in bold cursive typeface:



In these cases, I consider the marks shown above amount to use of the ‘DREAMS’ mark as registered, because this use does not alter the dominant element and distinctive character of the mark, both of which resides in the word ‘DREAMS’. The use of ‘DREAMS’ with ‘LONDON’ underneath is acceptable in accordance with *Colloseum*, as ‘DREAMS’ remains the indicator for the origin of the goods. Consequently, these are all use upon which the opponent can rely.

Use of the mark

21. The opponent (and its business predecessor, KTS Group Limited) have been selling clothing bearing the ‘DREAMS’ mark since 1982. This is primarily as a wholesale supplier to retailers across the UK and certain EU countries, though

the opponent offers 'DREAMS' clothing via its UK outlet in Brentwood, Essex and online via www.flick.co.uk.

22. Annual UK sales figures for clothing bearing the 'DREAMS' mark during the relevant period have been provided as follows⁶:

Year	Figure in GBP
2024 (January-June only)	795,998.00
2023	1,403,110.90
2022	1,889,003.70
2021	1,178,363.59
2020	916,335.34
2019 (June-December only)	546,120.64
Total	6,728,932.17

23. I have also been provided with examples of promotional activities in the UK. This includes information on trade exhibitions such as the "Spring Fair Moda" at the NEC in Birmingham, attended annually within the relevant period (save for 2021 which was cancelled due to the COVID-19 pandemic), the 2023 Spring "Pure" in London Olympia and various events in Harrogate. I have very limited information on the audience and reach of these, though Mr Sharif asserts that they provide "significant exposure...to customers throughout the UK and beyond".⁷ Exhibit FF12 shows trade stands at "various trade fairs". Some are ambiguous regarding specific dates but those from 2022 and 2023 clearly fall within the relevant period.

24. In support of the figures summarised at paragraph 22 above, a selection of invoices at Exhibits FF6-FF11 have been provided demonstrating sales made in the UK. Mr Sharif advises that a change was made to the invoicing software in

⁶ The relevant period begins 14th June 2019, therefore I have used the monthly breakdown for 2019 within Exhibit FF1 to provide a total figure for June to December only. I note that by including June in its entirety, this is a slightly generous estimate, though this is not significant in the context of the assessment as a whole. The same principle applies for the 2024 figure, where a total for January to June has been provided by the opponent.

⁷ Paragraph 7 of witness statement

2024 for invoices going forward to display the 'DREAMS' mark.⁸ Invoices prior to this would have been originally issued with the opponent's 'Flick logo' but link the opponent's goods to the 'DREAMS' mark via style codes (this is explained in more detail in the paragraph below). I note that some invoices fall outside of the relevant period, though those that fall within demonstrate a geographical spread across the UK including Essex, Cornwall, Mid Glamorgan, Isle of Wight, East Lothian, Country Down and South Yorkshire. The goods itemised include jumpers, dresses, trousers, tee shirts, jumpsuits, jackets, coats and gilets.

25. Mr Sharif (at paragraph 6 of his witness statement) provides details on the numbering system used for every 'DREAMS' garment sold by the opponent, comprising of style codes to identify items. He explains that the opponent does not retain photographs of every variation of the clothing sold due to the fast-paced turnaround of new styles and colours. However, Exhibit FF2 features photographs of examples of clothing sold by the opponent and with their corresponding style code. The clothes cover the same breadth of items as the invoices, i.e. jumpers, dresses, jumpsuits, coats etc., but are all womenswear.

26. Mr Sharif explains that, as is typical for the industry, they do not "emblazon" their mark across their clothes but instead utilise their 'DREAMS' mark on neck or waist labels on the goods and on hangtags for retail sale.⁹ Exhibit FF3 provides examples of these labels and hangtags on items. Exhibits FF4 and FF5 goes on to show images of the opponent's goods with a corresponding style codes and invoice numbers dated within the relevant period. Many of the goods shown in Exhibit FF4 have the labels or hangtags visible. Mr Sharif clarifies these are a selection of representative examples to link the labels, with the photographs of the goods, to dated invoices and therefore demonstrating use of the mark on the goods, within the relevant period. Mr Sharif goes on to explain that, despite the labels not being visible in every photograph (I note this is the case for all those provided in Exhibit FF5), each garment would certainly have had these.¹⁰

⁸ Paragraph 6 of witness statement.

⁹ Ibid.

¹⁰ Ibid.

27. In response to this evidence, the applicant contends (at paragraph 11 of its written submissions) that only two of the style codes matching up to a clothing photograph within Exhibit FF2 contain a visible image of the 'DREAMS' mark, therefore the rest are irrelevant.¹¹ It then goes on to rule out further items and uses this as the basis for considering only the invoices (and sales within) relating to item "LJ140169" which has a hangtag clearly visible, disregarding the rest.¹² Despite the applicant's protests, I am of the view that the 'DREAMS' mark is discernible on more items within Exhibit FF2, such as "FJ180166" (page 7). However, this is a moot point. The applicant's assertions here omit the evidence provided at Exhibit FF3 (featuring representative examples of hangtags and labels) and the clear confirmation provided by Mr Sharif that these would have been used on every item and that (since 2015) the opponent has only sold 'DREAMS' branded goods.¹³

28. The applicant's arguments focus on analysis based on invoices for style code "LJ140169". It claims that this (when cross referenced with the invoices supplied in Exhibits FF6 to FF11) demonstrates only "token use" of the opponent's mark as it relates to:

"only 30 items sold over a 5 year period, with sales of £118.50. When considering the size of the clothing market and the fact that the Opponent purports to have been well established, these are low sales numbers".¹⁴

As described above, I do not agree with the rationale used by the applicant to whittle down the items of clothing, style codes and corresponding invoices provided within the evidence. Additionally, the applicant fails to recognise Mr Sharif's explanation that these are representative examples. I also remind myself that my assessment here is a global assessment, which includes looking at the evidential picture as a whole (for example, also including the sales figures

¹¹ The opponent has not explained why they have bundled together items with the style codes "FD200002", "FD200003" and "FD200004" together in this assessment.

¹² I do not agree with the applicant's assertions that these images of clothing (found on pages 2 to 4 of Exhibit FF2) are "digital work ups or concept images, rather than the products themselves". To me, the images clearly show real products (pairs of jeans) with the image subsequently digitally altered insofar as to provide a black background.

¹³ Paragraph 6 of witness statement.

¹⁴ Paragraphs 13 and 14 of written submissions.

provided at Exhibit FF1) and not whether each piece of evidence shows use by itself.¹⁵

29. I note that the clothing market is extremely large. I have not been provided with any advertising expenditure figures or any indication of the market share enjoyed by the opponent. However, looking at the evidence as a whole, I consider that the sales figures and supporting information provided represent a reasonable level of sales and commercial exploitation of the mark in order to maintain a share in the market. I also note there is no *de minimis* level of sales. Taking all of the above evidence into account, I am satisfied that the opponent has demonstrated genuine use of its earlier 'DREAMS' mark during the relevant period.

30. I am now required to determine in relation to which goods the mark has been used and, if that use is not on everything relied upon (in the registered specification), or a reasonable range of goods within the terms in the specification, to decide upon a reduced, fair specification represented by the use. In doing so, I am guided by *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*, in which Mr Justice Carr summed up the law relating to partial revocation as follows:¹⁶

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

¹⁵ *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, General Court of the European Union, Case T-415/09.

¹⁶ [2016] EWHC 3103 (Ch).

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("*Asos*") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

31. Bearing in mind the caselaw above, and in relation to clothing, I have considered whether use has only been demonstrated within a subcategory of goods, e.g. casual clothing. However, I am content that use spanning a range of goods (such as shirts, jackets and more formal dresses) has been demonstrated and therefore such a limitation would be too restrictive, as well as being subjective. I do however recognise that all the photographs of the goods, style codes and corresponding invoices relate solely to womenswear. This is supported by the wider exhibits, such as the trade fair photographs at Exhibit FF13 and the listing for the 2023 'Springfair' which describes the opponent as "supplying excellent

quality ladies fashion” and Mr Sharif’s witness statement detailing the opponent “deals primarily in ladies’ fashion wear”.¹⁷ While some of the invoices do not specifically reference women’s clothing and include neutral terms such as “trousers”, I have no evidence to support the notion that these relate to menswear. I conclude that the evidence does not support a finding of genuine use across all the goods claimed, which is ‘*Clothing*’. The evidence shows use only in relation to ‘Women’s clothing’, the opponent is therefore only entitled to rely upon these goods for its section 5(2)(b) ground.

Section 5(2)(b)

32. 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.”

Section 5A states:

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

33. In considering the opposition under this section, I am guided by the following principles which are taken from the decisions of the 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 B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98,

¹⁷ Paragraph 6.

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-334/05P and Bimbo SA v OHIM, Case C-591/12P:

The principles

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question. 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

34. It is settled case law that I must make my comparison of the goods on the basis of all relevant factors. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

35. Additionally, in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court of the European Union (“GC”) stated that:

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

36. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that

customers may think that the responsibility for those goods lies with the same undertaking.”

37. The applicant admits identity between the goods on its TM8. However, this was on the basis that the opponent proved use across the goods claimed, i.e. “*clothing*” at large. Following my assessment, the goods comparison must be conducted on the fair specification represented by the use. Therefore, the goods to be compared are as follows:

The applicant’s goods	The opponent’s goods
<p>Class 25: <i>Clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Woolen clothing; Layettees [clothing]; Clothing layettes; Garments for protecting clothing; Linen clothing; Headbands for clothing; Clothes; Gloves [clothing]; Gloves as clothing; Aprons [clothing]; Jerseys [clothing]; Shorts [clothing]; Denims [clothing]; Cashmere clothing; Capes (clothing); Silk clothing; Leather clothing; Clothing of leather; Leather (Clothing of -); Parts of clothing, footwear and headgear; Collars [clothing]; Veils [clothing]; Knitted clothing; Corsets [clothing, foundation garments]; Embroidered clothing; Hoods [clothing]; Windproof clothing; Wristbands [clothing]; Belts [clothing]; Belts for clothing; Casual clothing; Rainproof clothing; Bandeaux [clothing]; Waterproof clothing; Jackets</i></p>	<p>Class 25: <i>Women’s clothing.</i></p>

<p>being sports clothing; Visors [clothing]; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Latex clothing; Trunks being clothing; Playsuits [clothing]; Woven clothing; Infant clothing; Drawers [clothing]; Drawers as clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Ties [clothing]; Clothing for children; Muffs [clothing]; Bodies [clothing]; Clothing for infants; Clothing for babies; Tops [clothing]; Weatherproof clothing; Clothing for cycling; Water-resistant clothing; Fabric belts [clothing]; Pockets for clothing; Handwarmers [clothing]; Clothing for skiing; Beach clothing; Triathlon clothing; Chaps (clothing); Thermal clothing; Cowls [clothing]; Fishing clothing; Men's clothing; Dance clothing; Mitts [clothing]; Braces for clothing; Plush clothing.</p>	
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38. The opponent's "*Women's clothing*" clearly falls within the ambit of "*Clothing*" found within the applicant's specification and is therefore identical as per the principles outlined by *Meric*.

39. All the remaining terms within the applicant's specification relate to clothing for babies and infants, men's clothing or particular items of clothing/constituent parts of clothing not specified by gender. For the purposes of procedural economy, I will continue my assessment on the goods for which I have already found identity (i.e. "*Clothing*" at large) as this is the opponent's best case. If I find a likelihood of

confusion for those goods, I will revisit the other goods listed above to determine the level of similarity and whether the same finding applies.

The average consumer and the nature of the purchasing act

40. As the case law indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

41. The parties are in agreement that the average consumer of the goods is a member of the general public. I consider that the goods are likely to be selected visually from the shelves of a shop (or their online equivalent), from signage on the high street, or from the pages of a catalogue. Therefore, visual considerations are dominant. That said, word-of-mouth recommendations may also play a part in the selection process, so aural considerations play a role. Overall, the goods are likely to be purchased relatively frequently. Due to the everyday nature of these items, the opponent contends that the level of attention will be relatively low. I disagree, since considerations will be given to factors such as style, fit, colour, material or suitability of the products, demanding at least a medium degree of attention.


Comparison of the marks

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

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

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

44. The respective marks are shown below:

Applicant's contested mark	Opponent's earlier mark
	DREAMS

Overall Impression

45. The opponent's mark comprises the capitalised word 'DREAMS'. As a word only mark, the mark's overall impression resides solely in this word. The applicant's mark consists of the words 'WILDEST DREAMS' in a dark navy, upper-case typeface. The words are placed one on top of the other in an arching curve. My view is that both words make an equal contribution to the mark and the overall impression lies in the totality of the mark, with the stylised typeface of the mark playing a small role overall.

Visual similarity

46. Both parties agree the opponent's earlier mark is encompassed in the applicant's mark in its entirety. A point of difference is the addition of 'WILDEST', placed at the beginning of the applicant's mark (i.e. where consumers tend to focus), for which there is no counterpart in the opponent's mark. Taking all of this into account and bearing in mind the overall impression of the marks, I am of the view that the applicant's contested marks are visually similar to the opponent's earlier mark to a low to medium degree.

Aural similarity

47. In terms of the pronunciation, I consider that 'DREAMS' will be pronounced identically in both marks. The first word, 'WILDEST', will also be articulated in the applicant's mark (in its usual manner) creating a phonetic difference. The applicant's mark is three syllables long, compared to the opponent's single syllable mark. The applicant contends there is "very little or no aural overlap in the marks".¹⁸ It is clear that at least some aural similarity is present due to the shared 'DREAMS' element, though I note this word falls second in the applicant's mark. My view is that the marks are aurally similar to a low to medium degree.

¹⁸ Paragraph 36 of applicant's written submissions.

Conceptual similarity

48. Conceptually, both the applicant's and opponent's marks contain the word 'DREAMS'. In its written submissions, the opponent contends that this "dominant common link between the signs...will be understood by the average consumer as a series of mental images that occur whilst imagining a vision or an ambition, or whilst asleep".¹⁹ Regarding the additional 'WILDEST' in the applicant's mark, it states this "does not create any conceptual difference to render the mark individually distinctive from the Opponent's mark". Instead, that it is a "standard superlative to express fantastical ideas" and, in the applicant's mark, a "natural description of a type of dream, rather than a creative or novel phrase that adds new meaning."²⁰

49. I note the opponent's definition of 'DREAMS' and the applicant's evidence on the same (Exhibit RP1). Taking these into account and my understanding of the term, I define it as a series of thoughts or mental images that occur when sleeping, or a reference to an individual's ambitions, goals or aspirations. I disagree with the opponent's view regarding 'WILDEST' not creating any distinctive conceptual difference in the applicant's mark. 'Wildest' is the superlative of 'Wild' which typically means uncontrolled, violent or extreme.²¹ The opponent itself references that 'WILDEST' in the context of the applicant's mark is an expression of "fantastical ideas". I agree with this interpretation as used in the contested mark. Though (unlike the opponent) it is my view that 'WILDEST DREAMS' provides a different conceptual meaning for the average consumer, compared to 'DREAMS' *solus*. That is moving it away mental images when sleeping and/or ambitions towards a more specific concept, that is something which is a fantastical, or perhaps implausible, ambition or desire. For example, as used in the phrase "not [or never] in my wildest dreams". I agree with the applicant's definition that 'WILDEST DREAMS' is the "notion of something which is unattainable and in

¹⁹ Page 3 of opponent's written submissions.

²⁰ Ibid.

²¹ Cambridge dictionary definition of 'wild'

(<https://dictionary.cambridge.org/dictionary/english/wild> accessed 28th November 2025)

most scenarios, highly unlikely (for example, winning the lottery)".²² Overall, I consider the marks to be conceptually similar to a low to medium degree.

Distinctive character of the earlier mark

50. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are descriptive or highly allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

51. Distinctive character is a measure of how strongly the earlier mark identifies the goods of services for which it is registered (and on which it may rely), determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identifies the goods as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

“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).

52. In terms of inherent distinctiveness, the mark is an existing English word (as opposed to an invented word) with no direct link or association with the goods. I have considered whether it is descriptive of the sleepwear, but I think this would

²² Paragraph 41 of written submissions.

be mildly allusive at best. Therefore, I consider it of average inherent distinctiveness.

53. The assessment as to whether there is a likelihood of confusion includes considering whether the distinctive character of the earlier mark has been enhanced (i.e. more distinctiveness has been acquired) through the use made of it. The opponent argues that its mark is of at least normal inherent distinctive character but has not made any claims of enhanced distinctiveness. However, since it has submitted evidence of proof of use, I have considered this. I rely on the relevant parts of the opponent's evidence as summarised in paragraphs 21 to 29 above, bearing in mind that the relevant date for the assessment regarding enhanced distinctiveness is the filing date of the contested application.

54. The annual sales figures for the UK are reasonable but I have no figures regarding advertising expenditure and reach for the UK, and no evidence was provided to show the market share the opponent occupies. In light of the considerable size of the UK clothing market, I am not able to find the sales figures provided as substantial or significant within the context of the market as a whole. Therefore, whilst I found the opponent's evidence sufficient to show genuine use, I am not satisfied that it is sufficient to provide enhanced distinctiveness through use.

GLOBAL ASSESSMENT – conclusions on likelihood of confusion

55. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertaking being the same or related.

56. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the goods may be offset by a greater degree of similarity

between the trade marks, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing act. In doing so, I must take into account the fact that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

57. The opponent's written submissions focus on the common word 'DREAMS' being the dominant and independently distinctive element of both marks. It argues that the applicant's mark does not feature "distinctive stylisation or subject matter that could be said to differentiate the visual appearance of the mark...much further than if the Applicant's mark has been filed in plain text".²³ The applicant argues both words in its mark are of equal size and positioning, therefore it being clear that neither takes dominance in the mark. Further, it contends that the stylistic elements of its mark are sufficient to distinguish it from the opponent's earlier right, describing the style as "akin to a US collegiate style commonly used on clothing".²⁴ Regarding the additional 'WILDEST', it highlights that this appears first in the mark and creates a different overall impression for the average consumer. As indicated in my earlier assessment (see paragraph 45 above), my view is that the overall impression resides in the entirety of the applicant's mark with both words playing an equal role. I agree with the applicant's suggestions insofar as the typeface of its mark evoking a common "collegiate" style, but my view is that this stylisation makes a much smaller contribution.

58. Conceptually, the opponent deems the shared 'DREAMS' element creates a high level of similarity and that 'WILDEST' is merely a prefix or adjective adding "no significant distinctiveness" independent of 'DREAMS'. It argues the consequence being that goods bearing the applicant's mark would be perceived by the relevant public as originating from the same commercial origin as the opponent's goods. In relation to this, I bear in mind that in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the

²³ Page 3 of written submissions.

²⁴ Paragraph 25 of written submissions.

impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

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

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

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of

confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

Paragraph 20 in the quotation above is of particular relevance to the case in point. The ‘WILDEST’ element in the applicant’s mark does indeed act as a prefix and as an adjective to the ‘DREAMS’ element (as argued by the opponent) however, I reject the conclusion that this provides “no significant distinctiveness” independent of ‘DREAMS’ and the opponent’s assertion that ‘DREAMS’ will “catch consumers’ attention to a greater extent, as it is the noun”. In keeping with the caselaw quoted above, this is a case where ‘WILDEST’ acts as a qualifier to ‘DREAMS’ (and vice versa). The words in combination provide a conceptual meaning greater than the sum of its parts, as already found at paragraph 49 above. Due to this, I agree with the applicant’s view that the average consumer will “engage with the mark as a whole and not simply focus on the DREAMS element”.²⁵

59. Finally, both sides quote previous decisions in their submissions which they deem relevant to this opposition. The opponent quotes *Camper, SL vs OHIM*, T-43/05 on the basis that it unreasonable to expect the public to distinguish between the marks. I disagree and have considered the decision referenced but note that it is not on all fours with this case. In particular, with respect to the similarities between the two figurative marks in that case. The applicant (at Exhibit RP3) quotes previous cases before this Tribunal. I have borne these in mind, though I highlight that they are not binding on me and I must base my decision only on the relevant facts of this opposition.

60. To summarise my global assessment, I have identified the average consumer to be a member of the general public who will select the goods primarily by visual means (although not discounting the aural component), and that the degree of attention paid will be medium. I have found the parties’ goods to be identical and the marks to be visually and aurally similar to a low to medium degree. Conceptually, they are also similar to a low to medium degree. The common

²⁵ Paragraph 51 of written submissions.

'DREAMS' element of the marks holds an average level of inherent distinctive character, however the additional 'WILDEST' element in the contested mark contributes to its overall impression and acts as a qualifier to 'DREAMS', thus forming a unit.

61. Taking all of this into account, I consider it unlikely that the marks will be mistakenly recalled or misremembered as each other, even allowing for imperfect recollection and the identity of the goods. Although the finding of identical goods is in the opponent's favour, the mark comparison found no more than a low to medium level of aural and visual similarity. Further, and importantly, the additional 'WILDEST' element in the applicant's mark (resulting in a low to medium level of similarity) provides an important conceptual difference, forming the unit, 'WILDEST DREAMS', which gives a hook for the average consumer to differentiate between the two marks. Therefore, consumers will be able to notice the difference between the marks (even when not compared side by side) and they will not be directly mistaken for each other. This remains the case with a medium level of attention being paid to the purchasing process.

62. The opponent also makes submissions regarding indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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

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

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

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

63. These examples are, clearly, not intended to be an exhaustive list but illustrate some of the circumstances in which indirect confusion may arise. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor KC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

64. The opponent asserts consumers would perceive the 'WILDEST' element of the contested mark as a brand extension of its brand, 'DREAMS'. However, I cannot see any basis for this or for indirect confusion. Even once the average consumer recognises the differences between the marks, and does not mistake one for the other, I do not consider that there would be the expectation for the goods to come from the same or economically linked undertakings.

65. I have found the earlier mark, 'DREAMS' to be inherently distinctive to an average degree and not enhanced by use. Therefore, it has clearly not reached the strikingly distinctive level which leads to the assumption that it could only be used by a single undertaking, and I cannot agree that the 'WILDEST' element is a non-distinctive addition. I note that even if had I found enhanced distinctiveness for the earlier mark at paragraph 54 of my decision, I do not consider this would have been to a sufficient degree to elevate the mark for indirect confusion to be applicable. Further, the change provided by the additional 'WILDEST' element (located at the beginning of the mark) is not logical or consistent with a brand extension.²⁶ I disagree, for reasons already given, with the opponent's suggestion that 'DREAMS' retains an independently distinctive role within the applicant's mark. Each word in the applicant's mark qualifies the other to form a unit with its own concept. On this I also bear in mind *Dirtybird Restaurants Ltd v. Salima Vellani*, BL O/413/18, where Mr Geoffrey Hobbs QC (as he was at the time), sitting as the Appointed Person, said:

"18. There is no rule or presumption to the effect that the concurrent use of a trade mark and one of its components for identical or similar goods or services will always or necessarily give rise to the perception that the goods or services concerned come from the same or economically linked undertakings. That might or might not be the case. In order to determine whether it is, the decision taker must give as much or as little significance to the visual, aural and conceptual differences and similarities between the marks in issue as the relevant average consumer would have attached to them at the relevant point in time (which in this case was July/August 2015). It is axiomatic that the relevant average consumer is to be regarded as reasonably well-informed and reasonably observant and circumspect. However, (s)he is not to be regarded as a person who normally engages in extended thought processes for the purpose of pairing and matching trade

²⁶ The example foreshadowed in Paragraph 17(3) of *L.A. Sugar Limited* is where the earlier mark comprises two or more elements whereas the earlier mark which is the focus of this decision is a single word. However, I note that this is an illustrative example, therefore I have applied the principles as they relate to the case before me. I also note that the opponent has an earlier mark comprising of two words ('DREAMS LONDON') which I reference again at paragraph 69.

marks or actively considering how they might be developed or appropriated for use as siblings of other marks. Indirect confusion of the kind described by Mr Iain Purvis QC in paras. [16] and [17] of his decision in *L.A. Sugar* is a matter of instinctive reaction to precipitating factors rather than the result of detailed analysis, as emphasised by Mr James Mellor QC sitting as the Appointed Person in *Duebros Ltd v Heirler Cenovis GmbH* (BL O/547/17; 27 October 2017) at para. 81.”

66. In the present case, the change of ‘DREAMS’ to ‘WILDEST DREAMS’ is not logical and consistent with a brand extension and the average consumer would not instinctively ‘pair up’ these two marks. I consider that the concept provided by the unit ‘WILDEST DREAMS’ in the applicant’s mark will be immediately recognised by the average consumer and distinguishes it from the opponent’s ‘DREAMS’ *solus*. At best, there might be a calling to mind between the two marks, but this is mere association and not indirect confusion. Were this to occur, I believe the average consumer would attribute any similarity to coincidence rather than economic connection. Further, I am not able to identify any other reasons which would lead to indirect confusion.

67. There is no likelihood of confusion, either directly or indirectly. As I have found no likelihood of confusion with respect to identical goods, I do not need to consider the likelihood of confusion (or level of similarity) with respect to the remaining non-identical goods as these would, by default, be less similar to those already compared.

68. As described at paragraph 13 above, my focus within this decision has been on the opponent’s ‘DREAMS’ mark as its best case, having been replicated in its entirety within the applicant’s mark. For the sake of completeness, I do not consider that the applicant’s ‘DREAM’ (in the singular) mark would progress the opponent’s case any further. This is also true of the opponent’s third mark, ‘DREAMS LONDON’. The opponent makes specific arguments in relation to this being similar to the applicant’s mark since it comprises of ‘DREAMS’ plus an additional word and has the same number of syllables. However, my findings above are still applicable for this earlier mark, in particular regarding ‘WILDEST

DREAMS' forming a unit which is conceptually different to the opponent's mark and there not being any logical brand extensions between the two.

CONCLUSION

69. The opposition under section 5(2)(b) is dismissed, and the mark may be registered in respect of all the goods.

COSTS

70. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £1900.00, calculated as follows:

Preparing a statement and considering the other side's statement	£450
Preparing evidence, considering and commenting on the other side's evidence	£1000
Preparing submissions in lieu of a hearing	£450
Total	£1900

71. I therefore order Flick Fashions Limited to pay Mr Joseph Johnson the sum of **£1900.00**. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 18th day of December 2025

C IRELAND

For the Registrar