O/1205/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003873352
BY IFONLYIF LTD
TO REGISTER THE FOLLOWING TRADE MARK:

IF ONLY IF

AND

IF ONLY IF

(SERIES OF TWO)

IN CLASSES 18, 24, 25 AND 35

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 440803
BY AKTIESELSKABET AF 21. NOVEMBER 2001

BACKGROUND AND PLEADINGS

1. On 1 February 2023, IFONLYIF LTD ("the applicant") applied to register the series of two trade marks shown on the cover page of this decision, in the UK. The application was accepted and published for opposition purposes on 10 February 2023 in respect of the following goods and services:

> **Class 18:** *Luggage; bags; wash bags; toiletry bags; tote bags; overnight bags; parts, fittings and accessories for the aforesaid.*
>
> **Class 24:** *Textiles; textile goods; linens; bed linen; children's bed linen; sheets; duvet covers; pillow cases; quilts; household linen; cushion covers; bath linen; towels; bed canopies; parts, fittings and accessories for the aforesaid.*
>
> **Class 25:** *Clothing; footwear; headgear; nightwear; nightdresses; shawls; dressing gowns; slippers; socks; cashmere clothing; cashmere scarves; clothing for children; nightwear for children; parts, fittings and accessories for the aforesaid.*
>
> **Class 35:** *Retail and online retail services in relation to the sale of candles, scented candles, luggage, bags, wash bags, toiletry bags, tote bags, overnight bags, textiles, textile goods, linens, bed linen, children's bed linen, sheets, duvet covers, pillow cases, quilts, household linen, cushion covers, bath linen, towels, bed canopies, clothing, footwear, headgear, nightwear, nightdresses, shawls, dressing gowns, slippers, socks, cashmere clothing, cashmere scarves, clothing for children and nightwear for children; information, advisory and consultancy services in relation to the aforesaid; providing business information in the field of social media.*

2. On 10 May 2023, the application was opposed in full by Aktieselskabet af 21. november 2001 ("the opponent") on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

3. Under Section 5(2)(b), the opponent relies on the three trade mark registrations shown below:[1]

Trade mark number: UK00900638833 (the "ONLY earlier mark") Trade Mark: ONLY Filing date: 25 September 1997 Registration date: 07 January 2000 The mark is registered for various goods in classes 14, 18 and 25, but the opponent relies upon the following goods only: **Class 18:** *handbags; purses.* **Class 25:** *Clothing, footwear and headgear.*
Trade mark number: UK00912158283 ("the ONLY & SONS earlier mark") Trade Mark: ONLY & SONS Filing date: 20 September 2013 Registration date: 11 April 2014 The mark is registered for various goods and services in classes 9, 18, 25 and 35, but the opponent relies upon the following goods only: **Class 25:** *Clothing*
Trade mark number: UK00905647219 ("the ONLY PLAY earlier mark") Trade Mark: ONLY PLAY Filing date: 29 January 2007 Registration date: 07 December 2007 The mark is registered for various goods in classes 9, 14, 18 and 25, but the opponent relies upon the following goods only: **Class 25:** *Clothing*

[1] On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM. As a result, the opponent's earlier EUTMs were automatically converted into comparable UK trade marks. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

4. The opponent claims that the marks are similar, that the goods and services are identical or similar, and that the opponent's marks have acquired an enhanced level of distinctiveness through use. The opponent also claims that the marks relied upon are a family of marks. It states:

> "The Opponent is the proprietor of a family of trade marks and rights with the common feature ONLY. These include the Earlier Registrations, and the brands KIDS ONLY, ONLY MATERNITY, ONLY LIFE and ONLY CARMAKONA. Also, as noted above, the Opponent uses ONLY in a sans serif capitalised form which is similar to that used in the second mark in the Application. Further evidence of these rights can be provided in due course, but they are used on the Opponent's website. The existence of this family of ONLY rights, with the ONLY element used in different parts of the marks, supports the likelihood of confusion on the part of the public that will be caused by the Application, particularly as part of the family or as a sub-brand of ONLY. In particular, the IF ONLY IF Sign will be considered by the average consumer as being a sub-brand in relation to nightwear and bedroom related products, given the subtle conceptual implication of delicate items […] when [the Sign is] used in conjunction with the goods in relation to which the Application is applied for."

5. These factors, the opponent claims, will lead to a likelihood of confusion and the application should be refused under Section 5(2)(b).

6. Under Section 5(3), the opponent relies on the same earlier marks set out above, which, it claims, have a reputation in relation to the same goods relied upon under Section 5(2)(b). The opponent claims that use of the applicant's mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

7. Under Section 5(4)(a), the opponent relies on three unregistered signs corresponding to the three earlier marks relied upon under Section 5(2)(b) and 5(3) and claims to have used those signs throughout the UK in relation to the same goods identified under Section 5(2)(b) and 5(3) since 2005 (for the sign ONLY), 2015 (for the sign ONLY & SONS) and 2006 (for the sign ONLY PLAY). Although the Form TM7

identifies only these three signs as being relied upon under Section 5(4)(a), in its statement of grounds, under the heading *"Section 5(4) Trade Marks Act 1994 (Passing Off)"*, the opponent continues to refer to the *"earlier registrations*" having been used as part of a family of marks, also mentioning marks that are not relied upon in this opposition and stating as follows:

> "As set out above, the Earlier Registrations have been used as part of a family of marks, which includes KIDS ONLY, ONLY MATERNITY, ONLY LIFE and ONLY CARMAKONA and their goodwill and reputation extends to use in this form."

8. In addition, the opponent refers to *"the ONLY Registration and the Only & Sons Registrations"* being used in the following form, and points to the visual similarity between the typeface used in the application and that used by the opponent:

ONLY

ONLY & SONS

9. The opponent claims that use of the application would constitute a misrepresentation that the applicant's goods and services are those of the opponent, or are otherwise licensed or authorised by the opponent, which would cause damage to the opponent's business.

10. The trade marks relied upon by the opponent are considered earlier marks in accordance with Section 6(1)(a) of the Act given that they were filed for registration earlier than the filing date of the applicant's mark. As they had been registered for five years at the date the applicant's mark was filed, in accordance with Section 6A of the Act, they are all subject to proof of use. Accordingly, the opponent made a statement that it has used the earlier marks in relation to the goods upon which it relies.

11. The applicant filed a counterstatement on 19 July 2023. Aside from conceding that the applied-for goods in class 18 and 25 are similar to the goods covered by the earlier marks, and that the terms *'clothing; footwear; headgear'* are identical, the applicant

denied the opponent's claims and put the opponent to proof of use in relation to the goods relied upon.

12. The opponent is represented by Browne Jacobson LLP. The applicant is represented by DLA Piper UK LLP. Only the opponent filed evidence. It also filed written submissions dated 9 November 2023. Neither party requested a hearing and neither party filed written submissions. This decision is taken following careful consideration of all the papers before me.

THE EVIDENCE

13. The opponent's evidence is given in the witness statements of Lene Utoft Nielsen who is the legal manager of intellectual property for the *"BESTSELLER group of company".* Although Mr Nielsen does not explain what the relationship between the opponent and the BESTSELLER group of company is, in its statement of grounds, the opponent states that it is commonly known as Bestseller. Further, the opponent's address and the address provided for BESTSELLER by Mr Nielsen are the same.

14. Mr Nielsen's statement is dated 9 November 2023 and is accompanied by 9 exhibits being those labelled LUN1 – LUN9. Mr Nielsen's evidence is aimed at supporting the opponent's claims that it has put the earlier marks to genuine use and that it enjoys reputation and goodwill under and by reference to them.

15. I do not intend to summarise the evidence and submissions at this stage, but I confirm that I have given due consideration to all of the documents filed by both parties.

RELEVANCE OF EU LAW

16. 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

Proof of use

17. 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."

18. 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."

19. The relevant period in which genuine use must be established is the five-year period ending with the filing date of the contested application: 2 February 2018 to 1 February 2023. As the earlier marks subject to proof of use are all comparable marks, use within the EU (including the UK) is relevant for the period ending with IP

Completion Day, i.e. 2 February 2018 to 31 December 2020.[2] From 1 January 2021 onwards, however, the relevant territory is the UK only.

20. 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 Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].
>
> 106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:
>
> (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

[2] See paragraph 7 of Part 1, Schedule 2A of the Act.

(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]."

21. With regards to assessing use within the EU (which is relevant due to the earlier marks being 'comparable marks'), I also bear in mind that in *Leno Merken BV v Hagelkruis Beheer BV,* Case C-149/11, the Court of Justice of the European Union (CJEU) found that while use of a Community trade mark in one member state could suffice to establish genuine use in the Community, *"all facts and circumstances"* should be considered including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.[3]

The grounds that the opponent seeks to argue.

22. In its submissions, the opponent states:

[3] See also *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 (paragraphs 228-230) and Case T-398/13, *TVR Automotive Ltd v OHIM* (paragraph 57)

> “For reasons of proportionality and in respect of the Opposition only, the Opponent is proceeding solely in respect of the following marks and grounds:
>
> a. The ONLY Registration for the goods "clothing, headgear" for all grounds.
> b. The ONLY Registration for the goods "footwear" in respect of section 5(2)(b).
> c. The ONLY & SONS Registration for the goods "clothing" in respect section 5(2)(b).
> d. The ONLY PLAY Registration for the goods "clothing" in respect of section 5(2)(b).”

23. Hence, the opponent no longer relies on the ‘ONLY & SONS’ earlier mark and the ‘ONLY PLAY’ earlier mark for the purpose of Section 5(3). It also withdrew reliance on the signs ‘ONLY & SONS’ and ‘ONLY PLAY’ under Section 5(4)(a).

24. As a result, the ‘ONLY & SONS’ earlier mark and the ‘ONLY PLAY’ earlier mark are now relied upon just under Section 5(2)(b) and just in relation to clothing in class 25.

25. The ‘ONLY’ earlier mark and the corresponding unregistered sign ‘ONLY’ are relied upon under Section 5(2)(b), 5(3) and 5(4)(a) as follows: (i) under Section 5(2)(b) for *clothing, headgear and footwear* and (ii) under Section 5(3) and 5(4)(a) for *clothing, headgear*.

26. For the sake of clarity, I should perhaps explain that although the terminology used by the opponent, namely “*the ONLY Registration*”, refers to a registered trade mark (in this case the ‘ONLY’ earlier mark) seemly suggesting that the opponent no longer relies on the Section 5(4)(a) ground (which is based solely on unregistered signs), given that: (a) the opponent has confirmed that it continues to rely on the trade mark ‘ONLY’ for all grounds; (b) in its statement of grounds, under the heading “*Section 5(4) Trade Marks Act 1994 (Passing Off)”,* the opponent states that it has built a substantial goodwill under *“its Earlier Registrations”* (rather than under its earlier unregistered signs), evidently using an inaccurate terminology, (c) the ‘ONLY’ unregistered sign and the goods relied upon under Section 5(4)(a) are identical to the ‘ONLY’ registered trade mark and the goods relied upon under Sections 5(2)(b) and 5(3), I consider that notwithstanding the ambiguous reference to *“the ONLY Registration*”, the opponent’s

intention is to continue to rely on both the registered trade mark ‘ONLY’ under Sections 5(2)(b) and 5(3) and the unregistered sign ‘ONLY’ under Section 5(4)(a).

27. With this in mind, I now turn to the evidence.

The evidence

28. Mr Nielsen identifies the opponent as the *“BESTSELLER group's trade mark company”* and says that *“the ONLY Companies”* are part of the BESTSELLER Group and conduct all business activity in relation to the earlier registrations under a licence from the opponent. Mr Nielsen states that the earlier mark ‘ONLY’ has been used extensively in the EU and the UK with the opponent’s consent.

29. Mr Nielsen provides the following UK sales figures for units of ‘ONLY’ branded clothing, footwear and headgear sold between 2018 and 2022:

April to July 2023 - 976,088 units
FY 21/22 - 1,139,654 units
FY 20/21 -1,126,655 units
FY 19/20 - 770,465 units
FY 18/19 - 889,436 units

30. Mr Nielsen says that goods bearing the earlier trade marks are sold through the opponent's own website and UK resellers including ASOS, M and M Direct, Sainsbury's, Dorothy Perkins, Lipsy and New Look.

31. Mr Nielsen also provides *“total marketing spend in the UK for the ONLY brands”* as follows:

April to July 2023 - £63,047
FY 21/22 - £87,791
FY 19/20 - £94,992
FY 18/19 - £186,293

32. Although the number of "likes" for the opponent's 'ONLY' global Facebook page and the number of followers of the opponent's Instagram page were 918,000 and 356,000 as of September 2023, this evidence has little, if any, relevance because it is outside the relevant period (i.e. it is eight months after the end of the relevant period) and it is impossible to determine the proportion of "likes" and followers which relates to the UK or the EU.

33. Admittedly, Mr Nielson's evidence is very concise. That said, it is possible to be concise but nonetheless establish genuine use. That is the case here. The witness statement clearly evidences that goods featuring the earlier marks were sold in the UK throughout the five-year relevant period; the quantity of goods is also an item of evidence showing that a total of over 4.9million units were sold in the UK, pointing to a real commercial exploitation of the marks on the market. Further, the sales figures are supported by examples of invoices which demonstrate that the opponent's goods were sold to major UK retailers including Sainsbury, Lipsy, New Look, Dorothy Perkins, M and M and Asos; whilst not all sales are supported by invoices, the seven invoices exhibited are in respect of goods worth more than £100,000.[4] The UK total marketing spend for the relevant period is in the region of £430,000 which is not an insignificant sum of money.

34. I must now consider whether, or the extent to which, the evidence shows use of the earlier marks in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

[4] There is an additional invoice, but it is dated 2017 and is outside the relevant period.

35. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

> "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].
>
> 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 Pl*c [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."

36. I am satisfied that the opponent has established real commercial use of the earlier mark 'ONLY' during the relevant period in the UK in relation to clothing and headwear for women. The sale figures are said to relate to 'ONLY' branded goods and all the invoices exhibited display the mark 'ONLY'; further, Mr Nielsen says that the invoices illustrate purchase of 'ONLY' branded goods, as shown by the reference 'ONL' in the product description. There is also evidence of 'ONLY' branded goods being available for sale from the websites of major UK retailers including New Look, Asos and Next. Although the sales figures are not broken down by product, the goods shown in evidence are all items of womenswear and headwear for women, including beanies, hats, dresses, pullovers, sweaters, cardigans, tops, jackets, coats, puffers, ponchos, jumpers, jeans, skirts, jumpsuits. However, there is no evidence of use in relation to footwear. Lastly, the evidence does give a clear impression that the brand is a womenswear brand as it shows that 'ONLY' is always listed under the women's category, and it is described as a "*fashion brand with denim at its core"* and *"a high street brand [that is] all about confident style and laid-back femininity".*

37. Turning to the other two marks, the evidence shows use of the mark 'ONLY & SONS' in relation to a line of menswear available for sale from, *inter alia*, the websites of Asos, New Look and Next. It also shows use of the mark 'ONLY PLAY', in relation to a line of sportwear for women available for sale from, *inter alia,* the website of New Look. Although it is not clear what proportion of the sales achieved during the relevant period relate to goods bearing these marks (as opposed to the 'ONLY' earlier mark which appears to be the opponent's main brand in relation to which the sales figures are supplied), I consider that the evidence showing that goods bearing the marks 'ONLY & SONS' and 'ONLY PLAY' were offered for sale by major UK retailers is sufficient to offset the absence of quantifiable sales information since it demonstrate a *bona fide* effort to *"create or preserve an outlet for the goods or services that bear the mark"* (Ansul at [37]-[38]).

38. With that in mind, I consider a fair specification to be:

For the 'ONLY' earlier mark: Class 25: *clothing for women, headwear for women.*
For the 'ONLY & SONS' earlier mark: Class 25: *clothing for men.*
For the 'ONLY PLAY' earlier mark: Class 25: *sport clothing for women.*

Section 5(2)(b)

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

> "5(2) A trade mark shall not be registered if because –
>
> (a)…
> (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."

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

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

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

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

42. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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."

43. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

44. In *Gérard Meric v OHIM* Case T-133/05, the General Court ("GC") stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysterne 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."

45. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v 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."

46. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same

undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes."

47. Whilst on the other hand:

> "[…] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

48. In light of my previous finding, the competing goods are as follows:

The applicant's goods and services	**The opponent's goods**
Class 18: *Luggage; bags; wash bags; toiletry bags; tote bags; overnight bags; parts, fittings and accessories for the aforesaid.*	
Class 24: *Textiles; textile goods; linens; bed linen; children's bed linen; sheets; duvet covers; pillow cases; quilts; household linen; cushion covers; bath linen; towels; bed canopies; parts, fittings and accessories for the aforesaid.*	
Class 25: *Clothing; footwear; headgear; nightwear; nightdresses; shawls; dressing gowns; slippers; socks; cashmere clothing; cashmere scarves; clothing for children; nightwear for children; parts, fittings and accessories for the aforesaid.*	The 'ONLY' earlier mark **Class 25:** *clothing for women, headwear for women* The 'ONLY & SONS' earlier mark **Class 25:** *clothing for men.*

	The ‘ONLY PLAY’ earlier mark **Class 25:** *sport clothing for women*
Class 35: *Retail and online retail services in relation to the sale of candles, scented candles, luggage, bags, wash bags, toiletry bags, tote bags, overnight bags, textiles, textile goods, linens, bed linen, children’s bed linen, sheets, duvet covers, pillow cases, quilts, household linen, cushion covers, bath linen, towels, bed canopies, clothing, footwear, headgear, nightwear, nightdresses, shawls, dressing gowns, slippers, socks, cashmere clothing, cashmere scarves, clothing for children and nightwear for children; information, advisory and consultancy services in relation to the aforesaid; providing business information in the field of social media.*	

49. Before I move on to the comparison of goods, I want to point out that aside from claiming that the goods are identical or similar, the opponent made extremely few submissions on the similarity of the goods, the only points made being as follows:

a. all of the goods in class 25 of the application are identical to the *“clothing, footwear, headgear”* goods of the earlier marks;

b. the goods in class 18 of the application are identical or highly similar to the goods of the ‘ONLY’ earlier mark;

c. the applied-for services in class 35 are similar to the *“clothing, footwear, headgear”* goods of the earlier marks because those retail services are complementary to the goods; clothing manufacturers will often operate

retail stores selling clothing and also all of the other goods listed in class 35 of the application;

d. all of the other goods and services of the application are similar to the goods of the earlier marks and can often be found in stores selling a range of clothing and related household goods.

50. As regard point (b), aside from the fact that the respective goods in class 18 and 25 are self-evidently not identical, no explanation has been provided as to why the goods are similar. As regards to points (c) and (d), first the opponent's claim in respect of the coincidence of trade channels is not supported by any evidence, and second, the mere fact that there may be some similarity of trade channels does not mean that there is overall similarity given the other differences between the goods, as stated by Amanda Michaels, sitting as the Appointed Person, in *COPALLI, COPAL TREE* Trade Marks, BL O/1078/24:

> "The mere fact that there may be some similarity of trade channels, as explained by the Hearing Officer, does not mean that there is overall similarity given the other differences between the goods. Taking the trade channels point to extremes would mean that one would risk making a finding of similarity between orange juice and peanuts simply because both might be sold in supermarkets or in pubs. Plainly that cannot be right, when the reason for examining the similarity of the parties' goods is to consider to what extent the two kinds of goods are liable to be perceived as "related" by the average consumer. As Mr Hobbs KC said in Burn trade mark O/074/19 at p 14:
>
> "for the purposes of an objection to registration under section 5(2)(b) [the factors] must be sufficient to establish a basis for maintaining that the goods in issue are what may be termed "kindred goods", the nature or characteristics of which or the nature or characteristics of commerce in which are such that a single economic undertaking would naturally be regarded as directly or indirectly responsible for providing goods of the kind in question."

51. I now turn to the comparison.

Class 18

Bags; tote bags.

52. The term *bags* in the applied-for specification includes handbags. *Tote bags* are also handbags. Fashion accessories such as handbags have consistently been found to be similar to clothing based on the fact that they share a common aesthetic function, since these goods jointly contribute to the 'look' of the consumers.[5] It is, in fact, a common customer behaviour to aesthetically combine those goods when purchasing them and their aesthetic coordination may also be considered at the design stage. Moreover, these goods usually coincide in their producers and are commonly found in the same retail outlets. Consequently, whilst the nature, purpose and method of use of the goods is different, they target the same users, share trade channels and are complementary. Overall, they are similar to a **low degree.**

Parts, fittings and accessories for bags and *tote bags*

53. I consider that *parts, fittings and accessories for bags* and *tote bags* are one step removed from the opponent's clothing goods and are **dissimilar.**

Luggage; wash bags; toiletry bags; overnight bags; parts, fittings and accessories for the aforesaid.

54. These goods are dissimilar to the opponent's goods. The nature and the main purpose of these goods are different. The main function of clothing and headwear is to dress the human body whilst the main purpose of luggage, toiletry bags and overnight bags is to carrying things when travelling or for an overnight trip or stay. The goods have different uses and methods of use, do not have the same distribution channels (or if they do, they are likely to be found on different shelves) and are neither in competition nor complementary as consumers do not aesthetically combine those goods with clothing when purchasing them. Although the goods target the same

[5] See for example the GC's decision T 39/10, *Pucci,* at § 76-77.

consumers, that is a too general level of commonality which does not justify a finding of similarity. These goods are **dissimilar.**

Class 24

Textiles; textile goods; linens; bed linen; children's bed linen; sheets; duvet covers; pillow cases; quilts; household linen; cushion covers; bath linen; towels; bed canopies; parts, fittings and accessories for the aforesaid

55. The main commonality between the applied-for *textiles; textile goods; linens; bed linen; children's bed linen; sheets; duvet covers; pillow cases; quilts; household linen; cushion covers; bath linen; towels; bed canopies* and the opponent's clothing goods is that the latter are made of textile material. However, this is not enough to justify a finding of similarity. The goods have different nature and serve completely different purposes, namely that clothing is to be worn by people for protection and/or fashion, whereas the contested textile goods are mainly for household purposes and interior decoration. Therefore, their uses and method of use is different. Moreover, they are not complementary, are not usually manufactured by the same undertaking and have different distribution channels and sales outlets (or are displayed in different sections of stores). Whilst some consumers might buy textile to make their own clothes, that is not the norm, and does not make the goods truly competitive. Once again, although the goods target the same consumers, that is a too general level of commonality which does not justify a finding of similarity. These goods are **dissimilar.**

Class 25

Clothing; headgear; nightwear; nightdresses; shawls; dressing gowns; socks; cashmere clothing; cashmere scarves; clothing for children; nightwear for children.

56. The opposed terms *clothing; headgear; nightwear; nightdresses; shawls; dressing gowns; socks; cashmere clothing; cashmere scarves;* are all encompassed by the opponent's broad terms *clothing for women, headwear for women* (as covered by the ONLY earlier mark) and are identical on the principle outlined in *Meric.*

57. The opposed terms *clothing, headgear, nightwear; dressing gowns; socks; cashmere clothing; cashmere scarves* are also encompassed by the opponent's term *clothing for men* (as covered by the 'ONLY & SONS' earlier mark) and are identical (*Meric).* Likewise, *clothing, headgear* are identical to the opponent's term *sport clothing for women* (as covered by the 'ONLY PLAY' earlier mark).

58. Insofar as they are not identical to the goods listed above, the remaining goods are also similar to, at least, a medium degree to the opponent's *clothing for women* (as covered by the 'ONLY' earlier mark), *clothing for men* (as covered by the 'ONLY & SONS' earlier mark) and *sport clothing for women* (as covered by the 'ONLY PLAY' earlier mark). The goods have the same nature, purpose, and method of use as they are all items of clothing, are distributed through the same trade channels, and are usually produced by the same manufacturers. However, the goods might be designed for different uses, in which case they are neither complementary not in competition. These goods are **either identical or similar to, at least, a medium degree.**

Parts, fittings and accessories for clothing, headgear, nightwear, nightdresses, shawls, dressing gowns, socks, cashmere clothing, cashmere scarves, clothing for children, nightwear for children.

59. These goods include parts, fittings and accessories for various items of clothing that are removable and can be sold separately. To the extent that I found the applied-for *clothing; headgear; nightwear; nightdresses; shawls; dressing gowns; socks; cashmere clothing; cashmere scarves; clothing for children; nightwear for children* to be identical or similar to the opponent's clothing goods, the parts, fittings and accessories for these goods are also similar to the opponent's goods as they can target the same relevant public (i.e. members of the general public) and are complementary. They might also share the same distribution channels. I consider these goods to be similar to a **low degree.**

Footwear; slippers.

60. The applied-for *footwear* and *slippers* and the opponent's clothing goods serve the same purpose since they are used to cover and protect various parts of the human

body against the elements. They are also often found in the same retail outlets. Moreover, the goods target the same consumers, might be complementary and are manufactured by the same producers. However, they have a different nature and are not in competition. I consider these goods to be similar to a **medium degree.**

Parts, fittings and accessories for footwear and slippers.

61. I consider that *parts, fittings and accessories for footwear* and *slippers* are one step removed from the opponent's clothing goods and are **dissimilar.**

Class 35

Retail and online retail services in relation to the sale of candles, scented candles, luggage, bags, wash bags, toiletry bags, tote bags, overnight bags, textiles, textile goods, linens, bed linen, children's bed linen, sheets, duvet covers, pillow cases, quilts, household linen, cushion covers, bath linen, towels, bed canopies, clothing, footwear, headgear, nightwear, nightdresses, shawls, dressing gowns, slippers, socks, cashmere clothing, cashmere scarves, clothing for children and nightwear for children; information, advisory and consultancy services in relation to the aforesaid; providing business information in the field of social media.

62. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

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

> "9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount

to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are *'similar'* to goods are not clear cut."

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

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services <u>normally</u> associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

65. In my view, the complementarity between the parties' goods and services is sufficiently pronounced only in respect of retail services relating to goods which I found to be identical or similar to the opponent's goods, namely *Retail and online retail services in relation to the sale of bags, tote bags, clothing, footwear, headgear, nightwear, nightdresses, shawls, dressing gowns, slippers, socks, cashmere clothing, cashmere scarves, clothing for children and nightwear for children*. I cannot detect any meaningful level of similarity between the opponent's clothing goods and the remaining retail services, which I consider to be dissimilar. Whilst I note the opponent's submission that clothing manufacturers will often operate retail stores selling clothing and also all of the other goods listed in class 35 of the application, as I have said, there is no evidence that clothing manufacturers would sell, for example, candles, luggage or textiles.

66. *Information, advisory and consultancy services in relation to the aforesaid.* I consider these services to be one step removed from the opponent's clothing goods and to be **dissimilar.**

67. *Providing business information in the field of social media.* I cannot detect any meaningful similarity between the opponent's clothing goods and these services. Apart from being different in nature, the applied-for services consist of providing business information in the field of social media. This is not the purpose of the opponent's clothing goods. Furthermore, these goods and services have different methods of use and are neither in competition nor complementary, target different consumers and do not share trade channels. These services are **dissimilar.**

68. In *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA, Lady Justice Arden stated that:

> "49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to

be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

69. Accordingly, since some similarity of goods is essential, the opposition under Section 5(2)(b) fails in relation to the goods which I found to be dissimilar, namely:

> **Class 18:** *Luggage; wash bags; toiletry bags; overnight bags; parts, fittings and accessories for the aforesaid; parts, fittings and accessories for bags* and *tote bags.*
>
> **Class 24:** *Textiles; textile goods; linens; bed linen; children's bed linen; sheets; duvet covers; pillow cases; quilts; household linen; cushion covers; bath linen; towels; bed canopies; parts, fittings and accessories for the aforesaid.*
>
> **Class 25:** *Parts, fittings and accessories for footwear and slippers.*
>
> **Class 35:** *Retail and online retail services in relation to the sale of candles, scented candles, luggage, wash bags, toiletry bags, overnight bags, textiles, textile goods, linens, bed linen, children's bed linen, sheets, duvet covers, pillow cases, quilts, household linen, cushion covers, bath linen, towels, bed canopies; information, advisory and consultancy services in relation to the aforesaid; information, advisory and consultancy services in relation to retail and online retail services in relation to the sale of bags, tote bags, clothing, footwear, headgear, nightwear, nightdresses, shawls, dressing gowns, slippers, socks, cashmere clothing, cashmere scarves, clothing for children and nightwear for children; providing business information in the field of social media.*

Average consumer

70. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective goods. I must then determine the manner in which the 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. (as he then was) described the average consumer in these terms:

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

71. The average consumer for the parties' goods and services in class 18, 25 and 35 will be a member of the general public.

72. The cost of purchase is likely to vary, and the goods will be purchased relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process, such as materials used, cut, aesthetic appearance and durability. When selecting the services, the average consumer is likely to consider such things as stock, price of goods offered in comparison to other retailers, expertise/knowledge of staff and delivery time. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting both the goods and the services.

73. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, online or catalogue equivalent. This means that the mark will be seen and so the visual element of the mark will be the most significant. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.

74. As for the retail services at issue, I consider that these are most likely to be selected having considered, for example, promotional material (in hard copy and online), signage appearing on the high street (for physical retailers only) or web content from retailers' websites. The selection process will therefore be primarily a visual one, but

aural considerations might also play a part as the services might be the subject of word-of-mouth recommendations.

Comparison of marks

75. 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."

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

77. The respective marks are shown below:

The applicant's mark	**The opponent's marks**
IF ONLY IF	ONLY ONLY & SONS ONLY PLAY

78. Although the application is a series of two marks, they are nearly identical, the only difference being that the second mark in the series is presented in a slightly stylised font. I will therefore carry out the comparison of the marks at issue on the basis on the first mark in the series, which is a word-only mark and is closer to the opponent's earlier marks.

Overall impression

79. The applicant's mark consists of the words 'IF ONLY IF'. The opponent states that *"the ONLY element of the mark is the centrepiece and the most eye catching and will be primarily remembered on an imperfect recollection".* It also states that *"if and only if"* is a phrase and that the "*application has distinguished itself from this phrase by removing the word "and", which makes the ONLY element, which appears when "and" would be expected, more prominent".* Conversely, the applicant states that *"the term IF is much more likely to be seen as playing a dominant role within [the applied-for mark], not least due to the fact that it is repeated at both the beginning and the end of [this] mark"* and that *"ONLY is the softer word, sandwiched between the two instances of IF and serves to emphasise the conditional nature of the term IF".*

80. In my view, the overall impression of the mark lies in the combination of the three words 'IF', 'ONLY' and 'IF' which come together to form a unit. I have searched various online dictionaries to see whether anything with the phrase "if only if" came up, but the only result I obtained was "If only" which is defined as follows: *"We use if only to express a strong wish that things could be different. It means the same as I wish but is stronger. We use it to talk about past, present and future unreal conditions"* (Cambridge online dictionary). Although 'if only if" might not be a commonly used phrase in English, and in spoken English the phrase 'if only' would be more commonly used, I consider that the average consumer will consider 'if only if' to be a phrase similar to 'if only' and carrying the same meaning. Although perhaps not grammatically correct, the phrase is intelligible and the mark will be perceived as forming a composite whole, in which no individual word plays a greater or lesser role.

81. The opponent's 'ONLY' earlier mark consists of the four-letter word 'ONLY'. This comprises the whole of the mark and it is within this element that the overall impression of the mark resides.

82. The opponent's 'ONLY & SONS' earlier mark consists of the words 'ONLY & SONS'. The mark is likely to be seen as referring to an individual with the surname 'ONLY', given that the element '& SONS' is a suffix that is normally used with a surname or a full name in historic family business names. The mark as a whole will therefore be perceived as indicating a company named after someone whose surname is 'ONLY' and his children. Alternatively, bearing in mind the fact that 'ONLY' is a common English word (rather than an obvious surname) the element 'ONLY' will still be perceived as the main identifier of a company name. Finally, bearing in mind the nature of the goods concerned, some consumers might see the word 'ONLY' as the brand name and the element '& SONS' as involving a play on words to indicate that the company offers clothing for boys or men. Either way, the element 'ONLY' plays the greater role in the overall impression.

83. The opponent's 'ONLY PLAY' earlier mark consists of the words 'ONLY PLAY'. The two words could be perceived as a single unit. However, since the conceptual interaction between these elements is not particularly strong, in the sense that it does not create a meaningful phrase, they could also be perceived as two separate elements. In the former scenario, both elements will contribute equally to the overall impression. In contrast, in the latter scenario, the element 'ONLY' will be perceived as having relatively more weight, as the element 'PLAY' will be perceived as indicating that the goods are clothing for playing sports.

Visual similarity

84. Visually, the applied-for mark and the 'ONLY' earlier mark have different structures and lengths, being an eight-letter mark made up of three words and a four-letter mark made up of one word. Both marks share the letters 'ONLY' that sit in the middle of the applicant's mark and make up the entirety of the opponent's mark. The marks differ in the presence of the letters 'IF' that sit twice, before and after the word 'ONLY', in the applicant's mark. These differences have no counterpart in the opponent's mark and

constitutes a point of visual difference. Taking all of this into account and bearing in mind that the only similarity between the marks lies in the middle of the applicant's mark (albeit being the only element of the opponent's mark), which somehow reduces its impact, I am of the view that the marks are similar to a medium degree.

85. The applied-for mark and the 'ONLY & SONS' earlier mark are both three-word marks. However, this does not necessarily result in an increased level of similarity, as the elements '& SONS' add further differences between the marks in terms of structure and letters. Furthermore, the shared element 'ONLY' is the only coinciding element, and it still appears at the beginning of the opponent's mark, as opposed to the middle of the applicant's mark. I am of the view that the marks are similar to a low to medium degree.

86. Similar considerations apply to the 'ONLY PLAY' earlier mark: although the marks have the same number of letters, they are different in terms of structure, letters and words (three words *versus* two). Furthermore, the shared element 'ONLY' is the only coinciding element, and it still appears at the beginning of the opponent's mark as opposed to the middle of the applicant's mark. I am of the view that the marks are similar to a low to medium degree.

Aural similarity

87. Aurally, the pronunciation of the marks coincides in the sound of the shared element 'ONLY'. The pronunciation differs in the sound of the element 'IF' which is repeated twice before and after the element 'ONLY' (in the applicant's mark) and in the sound of the element '& SONS', (in the 'ONLY & SONS' earlier mark) where the pronunciation of the ampersand will be 'and', and 'PLAY' (in the 'ONLY PLAY' earlier mark). I am of the view that the marks are similar to a medium degree (when comparing the applicant's mark with the 'ONLY' earlier mark) and low to medium degree (when comparing the applicant's mark with the 'ONLY & SONS' earlier mark and the 'ONLY PLAY' earlier mark).

Conceptual similarity

88. Conceptually, in its statement of grounds the opponent refers to the differentiating elements between the marks (namely the words 'IF' in the applicant's mark and the words '& SONS' and 'PLAY' in the opponent's earlier marks) as being perceived by the consumer as an indication of another sub-brand of the 'ONLY' family. However, that is rather to jump the gun. The conceptual comparison of the marks must be conducted based on the semantic content conveyed by the marks, the opponent's comments about the marks being perceived as sub-brand being relevant only in the context of a likelihood of indirect confusion. Nevertheless, under the heading *"Likelihood of confusion"* the opponent refers to the applicant's mark conveying *"the subtle conceptual implication of delicate items […] when used in conjunction with the goods in relation to which the Application is applied for".*

89. Whilst both the applicant's mark and the earlier mark 'ONLY' share the same meaning of the coinciding element 'ONLY', which is *"used to show that there is a single one or very few of something, or that there are no others"* (Cambridge online dictionary), as it will be recalled, I have concluded that the average consumer will consider 'IF ONLY IF' to be a phrase similar to 'if only' and carrying the same meaning of expressing a strong wish that things could be different. There is, therefore, in the applicant's mark a conceptual interaction that creates an inseparable whole with a semantic value that is distinct from those of its individual components and, in particular, from that of the word 'ONLY' considered in isolation. Overall, I consider that there is a low degree of conceptual similarity between the marks at issue.

90. Turning to the 'ONLY & SONS' earlier mark and the 'ONLY PLAY' earlier mark, the addition of the words '& SONS' and 'PLAY' does not alter the meaning of the element 'ONLY' which will still be perceived as an adverb or an adjective meaning one, alone, exclusively, solely. Further, the words '& SONS' and 'PLAY' introduce additional concepts which have no counterpart in the applicant's mark. I consider that there is a very low degree of conceptual similarity between the marks at issue.

Distinctive character of earlier mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

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

93. The opponent's earlier marks consist of the word 'ONLY', ONLY & SONS' and 'ONLY PLAY'. I consider that the word 'ONLY' is weakly inherently distinctive, because it is extremely common in English. It is also somehow laudatory as it could be

perceived as alluding to the fact that the goods are unique or that there are no other brands or clothing like it, i.e. it is the 'only' brand. As such, it has a low to medium degree of distinctive character. Whilst the additional elements '& SONS' and ''PLAY' might increase the distinctiveness of the other two earlier marks, it does not assist the opponent because it is the distinctiveness of the common element that is the key.

94. I will now consider whether the distinctiveness of the 'ONLY' earlier mark has been enhanced through use.[6]

95. I have already discussed the evidence of use above. Whilst I found that the evidence is sufficient to establish genuine use, that does not mean that the distinctiveness of the earlier marks has been enhanced through the use made of them.

96. A finding of genuine use only requires a sufficient level of use (as per the case of *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, this need not be quantitively significant). Conversely, distinctive character is a measure of how strongly the mark identifies the goods/services of a single undertaking. Evidence used to prove enhanced distinctiveness is the same as for reputation;[7] further, enhanced distinctiveness requires recognition of the mark by the relevant public. In general, a party who is unable to show that the earlier mark is known to a significant proportion of the relevant public is unlikely to be able to show that the distinctiveness of the mark has been materially enhanced through use.

97. In this case, whilst the evidence demonstrates that the earlier mark 'ONLY' has been used in relation to clothing goods during the relevant period, the sales and marketing figures cover solely the five-year period 2018-2022, which is relatively short. Further, whilst nearly 5 million units were sold during the relevant period, it equates to less than, or just over, 1 million units per year.

[6] The claim to enhanced distinctiveness is limited to this mark 'ONLY' as it is apparent from paragraph 6 of the opponent's written submissions which state: "The B2 381 377 finding referred to above pre-dating 31 December 2020 is relevant to consider alongside the extensive use of the mark that has been made in the UK since 1 January 2021 and conclude that the ONLY Registration has a significant reputation and enjoys enhanced distinctiveness."
[7] CX02 Trade Mark, BL O/393/19 at paragraph 39

98. In its statement of grounds, the opponent claims that due to the significant number of sales made in the EU (prior to 31 December 2020) and the UK, the earlier registrations enjoy enhanced distinctiveness. However, the number of sales is only one of the factors that must be taken into account in determining whether the mark has become more distinctive that it inherently is, the other factors including 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.[8] I also note that although the opponent refers to sales made in the EU, it provided only UK sale figures; in any event, given that enhanced distinctiveness must be assessed from the perspective of the UK consumers, EU sales would be irrelevant even if they had been provided.

99. As regard the other factors I have listed, there is no information about the market share held by the mark, meaning that it is not possible to contextualise the sales figures given by Mr Nielsen. Additionally, given that the relevant market for clothing and headwear for women is likely to be very large indeed, the volume of sales achieved by the opponent does not strike me as indicating that because of the mark, a significant proportion of the relevant section of the public identifies the goods as originating from the opponent. Lastly, although marketing figures have been provided, there is nothing in the evidence which shows how prominent these activities were or enable me to conclude that as a result of the promotional activities carried out by the opponent, the distinctiveness of the mark has been enhanced.

100. In any event, even if I were to conclude that the earlier mark 'ONLY' has achieved some degree of enhancement through use, the use shown is not sufficiently extensive to push the mark very far up the distinctiveness scale or materially increase the distinctiveness of the mark to above a medium degree.

[8] C-342/97, Lloyd Schuhfabrik, at paragraph 23

101. For the sake of completeness, I should mention that in its submissions, the opponent relies on a decision of the EUIPO where it was found that the earlier mark 'ONLY' benefits from reputation. It states:

> "The repute and strength of the mark dates back some time. In as early as 2015, the Opposition Division of the Office for Harmonization in the Internal Market (as it was then) found, in opposition number B2 381 377, that EU trade mark number 638833 (of which the ONLY Registration is the UK comparable mark) has "acquired a reputation and a high degree of distinctiveness through its use" on the basis of the evidence submitted by the Opponent. That decision noted:
>
> "The opponent has filed a market survey in which 1,500 interviews were conducted with 15-40 year old women. In response to the question 'Write down the first 10 brands within female clothes you can think of', around 40% on average of all age target groups of respondents recognised 'ONLY'. When presented with a list of trade marks for clothes, around 92% on average of all age target groups of respondents recognised 'ONLY'. This places the mark in third place among the market leaders. 86% of respondents bought 'ONLY' products (clothes or accessories) and 87% knew somebody that had bought these products".

102. I reject the argument. First, it is not clear whether the decision found that the mark had acquired a reputation and enhanced distinctiveness in the UK or in other territories of the EU. Second, the decision was based on different evidence which has not been filed in these proceedings. Third, the decision is not binding upon me.

Likelihood of confusion

103. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services 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 services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

104. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark,* BL O/375/10, where Iain Purvis Q.C. (as he then was) 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)."

105. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

> "13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

106. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17. This is mere association not indirect confusion.

107. Earlier in this decision I found that:

- The goods and services vary from identical to similar to a low degree, whilst some are dissimilar.

- The average consumer for the goods and services is a member of the general public who will pay a medium degree of attention during the purchasing process.

- Visual considerations are likely to dominate the selection of the goods and services, although I do not discount aural considerations completely.

- The application and the ‘ONLY’ earlier mark are visually and aurally similar to a medium degree and conceptually similar to a low degree.

- The application and the ‘ONLY & SONS’ earlier mark are visually and aurally similar to a low to medium degree, and conceptually similar to a very low degree. The same goes for the ‘ONLY PLAY’ earlier mark.

- Inherently, the earlier marks are distinctive to a low to medium degree. The distinctiveness of the mark ‘ONLY’ has not been enhanced though use, but if it has, it has to, at best, a medium degree.

108. The opponent’s primary case is that there is a likelihood of indirect confusion reinforced by the existence of a family of marks. It states as follows:

> “The Opponent is the proprietor of a family of trade marks and rights with the common feature ONLY. These include the Earlier Registrations, and the brands KIDS ONLY, ONLY MATERNITY, ONLY LIFE and ONLY CARMAKONA. Also, as noted above, the Opponent uses ONLY in a sans serif capitalised form which is similar to that used in the second mark in the Application. Further evidence of these rights can be provided in due course but they are used on the Opponent’s website. The existence of this family of ONLY rights, with the ONLY element used in different parts of the marks, supports the likelihood of confusion on the part of the public that will be caused by the Application, particularly as part of the family or as a sub-brand of ONLY. In particular, the IF ONLY IF Sign will be considered by the average consumer as being a sub-brand in relation to nightwear and bedroom related products, given the subtle conceptual implication of delicate items Sign when used in conjunction with the goods in relation to which the Application is applied for”.

109. I reject the submission. The opponent cannot rely on earlier marks that have not been pleaded, namely ‘KIDS ONLY’, ‘ONLY MATERNITY’, ‘ONLY LIFE’ and ‘ONLY CARMAKONA’, even if it claims that they belong to its family of marks. First, there is no evidence of the opponent having earlier registered rights in those marks. Normally,

the trade marks constituting a 'family' and used as such are all registered marks; although it cannot be precluded that the 'family of marks' doctrine may include non-registered trade marks,[9] the opponent did not list any of those marks in its TM7 which is the form used to identify the earlier marks relied upon in the pleadings. Second, if there was any doubt about what earlier rights have been pleaded, in its written submissions the opponent clearly narrowed its claim to the trade marks 'ONLY', 'ONLY & SONS' and 'ONLY PLAY' which were pleaded in the TM7. Third, the evidence about the other trade marks KIDS ONLY', 'ONLY MATERNITY', 'ONLY LIFE' and 'ONLY CARMAKONA', is very limited[10] and consists of undated screenshots from the website www.only.com; this does not establish the presence of these marks in the UK at the relevant date. I will therefore consider the family of marks argument as limited to the pleaded marks.

110. Although the opponent does not seem to claim that there is a likelihood of direct confusion, for the sake of completeness I should say that even considering that the average consumer only rarely has the chance to make a direct comparison between the different marks and must place trust in the imperfect picture of them that he or she has kept in mind, the differences introduced by the double verbal element 'IF' in the applicant's mark will not be overlooked, especially given the conceptual whole created by the mark. Given the differences between the marks, which will not go unnoticed by the average consumer paying a medium degree of attention, there is no likelihood of confusion between the applicant's mark 'IF ONLY IF' and the earlier mark 'ONLY' even in relation to identical goods. The presence of other verbal elements in the 'ONLY & SONS' earlier mark and the 'ONLY PLAY' earlier mark makes a likelihood of confusion even more unlikely.

111. Turning to indirect confusion, the applicant's mark 'IF ONLY IF' does not fall within any of the example categories identified by Mr Purvis QC because:

(a) the common element is not so strikingly distinctive that the average consumer would assume that no-one else, but the brand owner, would be using it in a

[9] See EUIPO guidelines for examination of European Union trade marks.
[10] LUN006

trade mark at all. On the contrary, I have found that the shared element 'ONLY' which represents the entirety of the earlier mark (and the second word of the applicant's mark), is an extremely common English word with an inherently weak distinctive character. Even if the distinctiveness of the earlier mark had been increased to medium, that can plainly make no difference, as the word 'ONLY' remains an extremely common English word which will always create some doubt in the public's mind as to whether all the goods/services marketed under a mark incorporating that word originate from the same undertaking. Lastly, the word 'ONLY' does not retain an independent distinctive character within the applicant's mark, as the phrase 'IF ONLY IF' forms a unit with a semantic value that is distinct from that of the word 'ONLY' considered in isolation;

(b) the applicant's mark 'IF ONLY IF' cannot be said to add a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension;

(c) the change from 'ONLY' to 'IF ONLY IF' does not appear consistent with a brand extension or with the opponent's family of marks. The other two trade marks of the opponent's family of marks, i.e. 'ONLY & SONS' and 'ONLY PLAY', follow in fact a clear pattern of adding an allusive element to the main brand 'ONLY', i.e. '& SONS' for menswear and 'PLAY' for sportwear, which is not reproduced in the application.

112. Whilst I bear in mind that the examples listed in *LA Sugar* are not intended to be exhaustive, I can see no other reason for indirect confusion to arise.

113. Finally, I have not overlooked the opponent's argument that the applicant's mark *"will be considered by the average consumer as being a sub-brand in relation to nightwear and bedroom related products, given the subtle conceptual implication of delicate items when used in conjunction with the goods in relation to which the application is applied for".* There are various issues with this argument. First, it does not apply to the goods in class 18 which I found to be similar and cannot apply to the

bedroom related textile products which I found to be dissimilar. Second, I cannot see how the mark 'IF ONLY IF' understood as a phrase expressing a strong wish that things could be different would, when applied to items of nightwear, be perceived as conveying a subtle conceptual implication that the goods are delicate. Third, as I have concluded above, the applicant's mark does not reproduced the structure common to the sub-brands 'ONLY & SONS' and 'ONLY PLAY' which combines the word 'ONLY with a word which is allusive of a characteristic of the goods, i.e. the words '& SONS' indicating that it is a line of menswear and the word 'PLAY' indicating that it is a line of sportwear. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the CJEU stated that:

> "62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a 'family' or 'series' of marks.
>
> 63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon* v *OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a 'family' or 'series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.
>
> 64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order

for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

114. Accordingly, even an average consumer who is familiar with the opponent's family of marks would not regard the applicant's 'IF ONLY IF' mark as part of the opponent's family. At most, the application could merely call the earlier mark(s) to mind, however, as I have previously stated, that would be mere association not indirect confusion.

115. The opposition under Section 5(2)(b) fails in its entirety.

Section 5(3)

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

"5(3) A trade mark which -

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

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

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which

the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).*

118. The conditions of Section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks and the applicant's mark are similar. Secondly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the earlier marks being brought to mind by the later mark. Finally, assuming the first three conditions have been met, Section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes

of Section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

119. The relevant date for the assessment under Section 5(3) is the filing date of the application at issue, being 01 February 2023.

Reputation

120. In *General Motors,* Case C-375/97, the CJEU held that:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
>
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

121. Whilst enhanced distinctiveness and reputation are different, the factors relevant to both assessments are the same. For the same reasons given above, I consider that

the opponent has not demonstrated a reputation in the UK at the relevant date. The opposition under Section 5(3) fails at the first hurdle.

122. Alternatively, if I am wrong, any reputation built in the UK by the opponent under the earlier mark 'ONLY' is small. In those circumstances and taking into account the small size of the opponent's reputation, the degree of similarity between the marks at issue is not sufficient for the public to establish a connection or link between them. As it will be recalled, the application forms a unit creating a different concept which has no counterpart in the opponent's trade mark 'ONLY' and the average consumer is unlikely draw out the element ONLY as freestanding such that a link would be made. The existence of the other two sub-brands of the 'ONLY' family of marks is not sufficient to increase the likelihood of a link being made given that the application does not to reproduce the structure common to the 'ONLY' family of marks.

123. In any event, the opponent's case as pleaded is that it has *"carefully cultivated a cool, playful and value conscious image over a number of years for its ONLY Registration and the application would unfairly benefit from the transfer of that image it to its goods."* Even if the opponent had established the existence of such a reputation (which, in my view, has not), the mental link caused by the application would be too insubstantial and fleeting to result in a transfer of image and an exploitation of the reputation of earlier mark. The opposition under Section 5(3) is also unsuccessful.

Section 5(4)(a)

124. Section 5(4)(a) states:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > (aa) […]

(b) […]

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

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

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

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

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

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

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar

that the defendant's goods or business are from the same source or are connected.

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

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

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

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

The relevant date

127. Since the applicant did not file evidence of use, the relevant date is the filing date of the application, namely 01 February 2023.

Goodwill

128. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223:

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

129. For the same reasons given in relation to genuine use, I am satisfied that the opponent had sufficient goodwill under the sign 'ONLY' to sustain a passing-off claim at the relevant date for clothing for women and headwear for women.

Misrepresentation

130. The earlier sign relied upon under this ground is identical to the trade mark 'ONLY' which is relied upon under Section 5(2)(b); the goods are also identical to those considered under Section 5(2)(b). Whilst the test for misrepresentation is different from that for likelihood of confusion in that it entails "*deception of a substantial number of members of the public"* rather than *"confusion of the average consumer*", it has been acknowledged that they are unlikely to produce different outcomes in practice.[11] Certainly, I believe that to be the case here. For the same reasons set out above, I consider that there would not be deception of a substantial number of members of the public where the applicant's mark is used on goods which are identical to those for which the opponent has goodwill. It follows that there will be no misrepresentation for the goods and services which I found to be less similar or dissimilar.

131. The opposition under Section 5(4)(a) also fails.

[11] *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501

OUTCOME

132. The opposition fails under all grounds. The application will proceed to registration.

COSTS

133. The applicant has been successful and is, therefore, 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 sum of £600, calculated as follows:

Preparing a counterstatement:	£400
Reviewing the evidence:	£200
Total	£600

134. I therefore order Aktieselskabet af 21. november 2001 to pay IFONLYIF LTD the sum of £600. This sum is to 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 19th day of December 2024

TERESA PERKS
For the Registrar