

O-518-22

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3561401

Pink Diesel

IN THE NAME OF MARINA AYTON

AND

AN OPPOSITION UNDER NO. 424641

BY DIESEL S.P.A.

Background and pleadings

1. On 27 November 2020, Maria Ayton (“the applicant”) applied to register the trade mark shown on the cover page of this decision.
2. The application was published for opposition purposes for the following goods:
Class 32 Non-alcoholic wine.
Class 33 Wines; rose wine; alcoholic drinks; white wine; red wine; sparkling wine.
3. DIESEL S.P.A. (“the opponent”) filed a notice of opposition on 25 May 2021 on the basis of sections 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods in the application. For its claim under section 5(3), the opponent relies upon all the goods covered by the following United Kingdom (“UK”) trade mark:

Mark: DIESEL

Registration No. 1559279

Filing date: 15 January 1994

Registration date: 28 July 1995

Goods:

- | | |
|----------|---|
| Class 3 | Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; all included in Class 3. |
| Class 9 | Spectacles; optical apparatus and instruments; parts and fittings for all the aforesaid goods; all included in Class 9. |
| Class 14 | Watches; clocks; costume jewellery; jewellery; parts and fittings for all the aforesaid goods; all included in Class 14. |
| Class 16 | Catalogues, photographs; all relating to clothing; calendars, diaries, address books; personal-organisers; note-pad holders; pens, pencils; pencil stands, pencil cases; paper-clip boxes; adhesive tape dispensers; patterns for making clothes; all included in Class 16. |
| Class 18 | Handbags; suitcases, trunks, knapsacks, travelling bags; vanity cases (not fitted); briefcases, attaché cases; wallets, purses, |

billfolds, keycases, passport cases, business and credit card cases; belts; umbrellas; all included in Class 18.

Class 24 Textile fabrics, all for the making of clothing and furnishings; curtains; pillowcases, bedsheets, bedspreads, blankets, comforters for beds; tablecloths, textile place mats; towels, textile napkins; all included in Class 24.

Class 25 Clothing, footwear, headgear; all included in Class 25.

4. Given its filing date, the above mark is an earlier trade mark in accordance with section 6 of the Act.
5. Under section 5(3), the claim is that the use of the contested mark would, without due cause, take unfair advantage of the reputation of the earlier mark because the applicant would unfairly capitalise upon the investment which the opponent has put into promoting its mark. The opponent further claims that the use of the contested mark would be detrimental to its reputation if goods of lesser quality than its own goods were sold under the contested mark. The opponent also claims that the contested mark would cause confusion in the minds of the purchasing public as to the origin of the goods and will cause the opponent's mark to lose its distinctiveness.
6. Under section 5(4)(a), the opponent claims goodwill in the sign DIESEL. The opponent further claims that it first used the sign as early as 1994 throughout the UK in relation to clothing, footwear, headgear, bags, wallets, purses, watches, jewellery, belts, gloves, scarves, eyewear, printed materials, calendars, diaries, and alcoholic beverages. Consequently, the opponent submits that it is entitled to prevent the use of the contested mark under the law of passing off.
7. The applicant filed a counterstatement denying the grounds of opposition and has put the opponent to proof of use of in relation to all the goods covered by the earlier mark.
8. The applicant is represented by Lewis Silkin LLP and the opponent is represented by Murgitroyd & Company. Both parties filed evidence and

submissions. Neither party requested a hearing. This decision is taken after careful reading of all the papers filed by the parties.

Evidence

9. The opponent's evidence-in-chief consists of the witness statement of Stefano Lesurum dated 18 October 2021 together with 9 exhibits. Mr Lesurum is the Head of Legal Affairs of Diesel.
10. The applicant's evidence consists of the witness statement of the applicant, Maria Ayton dated 24 December 2021 together with 2 exhibits.
11. The opponent's evidence-in-reply consists of the witness statement of Christian Finn dated 27 October 2020 with 2 exhibits. Mr Finn is a Chartered Trade Mark Attorney and a director of Murgitroyd & Company.
12. I will return to the parties' evidence later in the decision.

Section 5(3)

13. Section 5(3) states:

“(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 (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

14. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

15. The relevant case law can be found in the following judgments of the Court of Justice of European Union (“CJEU”): Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas Saloman*, Case C-487/07, *L’Oreal v Bellure*, 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; *General Motors*, paragraph 26.
- c. It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas 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.
- 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*).

Reputation

16. The applicant disputes that the opponent has established that the earlier mark had a qualifying reputation at the date of application of the contested mark, i.e. 27 November 2020 ("the relevant date").

17. The applicant has put the opponent to prove use in relation to all goods covered by the earlier mark. Under section 5(3), the opponent claims reputation based on the use of the mark in relation to all of those goods. Therefore, if I find that the earlier mark has a reputation, my findings will apply equally to the genuine use of the mark in relation to those goods for which I have found reputation. Accordingly, I do not find it necessary to make a separate finding on the genuine use of the earlier mark.

18. The opponent's evidence of reputation can be summarised as follows:

- The opponent company was founded in 1978 and has since produced over 2,000 different washes of denim.¹ The evidence shows the use of the mark DIESEL in relation to menswear, womenswear and kidswear on the opponent's website <https://uk.diesel.com/en>.² The website also shows the use of the mark in relation to bags, watches, spectacles and home products such as furniture. The web pages are undated; the only date on the pages is the date of printing, i.e., 30 July 2021.
- Pages from the opponent's brochure for Spring/Summer and Autumn/Winter collections for 2016 – 2018 are in evidence.³ The pages show the use of the mark DIESEL in relation to shoes and various clothing such as jeans, shirts and swimwear.

¹ Witness statement of Mr Lesurum, para 1.

² Exhibit D1.

³ Exhibits D2-D4.

- The mark is promoted online. The evidence consists of articles from magazine namely, Pause, Fashion United, Vogue, Fashion Network, Attitude, Campaignlive and Wonderlandmagazine.⁴ The top-level domain name for wonderlandmagazine and fashion united are .com while the top-level domain names for rest of the magazines are either .uk or .co.uk. One article is dated outside the relevant date, and another article is undated. The remaining articles are from 2019 and 2020. The mark was predominantly promoted online in relation to jeans.
- Mr Lesurum provides the following figures for the marketing expenditure in the UK for 2015 – 2020:⁵

BY COLLECTION	2015	2016	2017	2018	2019	2020
	UK	UK	UK	UK	UK	UK
<i>Euro/m</i>						
5 Pockets Male	34.6	31.1	30.1	27.9	24.4	7.3
5 Pockets Female	4.3	3.3	2.8	2.0	1.7	0.6
Diesel Male	16.0	13.8	13.0	13.2	12.6	4.7
Diesel Female	2.0	1.8	1.7	1.5	1.7	0.8
Other core business	1.1	0.3	0.2	0.3	0.0	0.0
Core Business	58.1	50.3	47.8	44.9	40.4	13.5
Footwear	1.9	1.5	1.3	0.9	1.1	0.4
Intimate	2.0	1.8	1.7	2.7	2.4	0.3
Kid	0.1	0.2	0.0	0.0	0.1	0.0
Diesel Black Gold	0.5	0.3	0.0	0.0	0.0	0.0
Sales clothing/shoes	62.6	54.1	50.8	48.5	43.9	14.2

According to Mr Lesurum, the term 5-pockets in the above table refers to a signature Diesel jeans style. No assistance has been given to understand what the remaining terms, namely “Diesel male/female”, “kid”, “intimate” “core business” and “Black Gold” means.

- Mr Lesurum states that the goods under the mark are also sold through retail outlets in the UK.⁶ The sample invoices dated between 2016 - 2019 show the sale of goods to retail outlets such as Selfridges, Harrods and House of Fraser. The mark DIESEL is presented on the right-hand top of all the invoices.

⁴ Exhibit D5

⁵ Exhibit D6

⁶ Exhibit D7

That concludes the summary of the evidence to the extent I consider necessary.

19. In order to show reputation, the opponent must demonstrate that the earlier mark DIESEL is known among a significant proportion of the public in the UK. In reaching this decision, I must consider a number of factors which, as set out in the case law above, include the market share held by the mark, the intensity, geographical extent and duration of use, and the size of the investment made by the opponent in promoting it.

20. The evidence provided in support of reputation appears to be underwhelming. The opponent has not provided any revenue figures generated under the mark, nor any details regarding the market share held by the mark. Those figures would have assisted in assessing the extent of sales of the goods and the degree of recognition of the mark among the UK public. I only have 48 sample invoices from 2016 -2019 (12 invoices from each year) to cast some light on the sale.⁷ The invoices were issued to retail outlets based in various locations in the UK including London and Glasgow. Most of the sales has been to SportsDirect.com and House of Fraser. The goods sold appear to be relatively expensive. For example, an invoice issued in 2019 to a retail outlet in Romford, London shows sale of 1204.70 GBP for 12 items.⁸ The invoices issued to House of Fraser in 2018 were for 421,994.17 GBP and 538,243.20 GBP for 10669 and 23006 items, respectively.⁹ The invoices provide only the “total number” of items sold and, therefore, are of no assistance in determining the type of goods sold under the mark. The other piece of evidence gives some indication of the goods in respect to which the mark was used. The undated pages from the opponent’s website show the use of the mark in relation to various goods such as clothing, handbags, spectacles and watches. However, so far as I can make out from the opponent’s marketing expenditure table, the mark was marketed and promoted in relation to clothing and shoes. The evidence of promotional materials was in respect of the use of the mark in relation to shoes and clothing, particularly jeans. It is, therefore, likely that the invoices concern mostly the sale

⁷ 2 invoices are addressed to recipients based in Northern Ireland.

⁸ Exhibit 7 page 49

⁹ Ibid pages 29 and 33

of clothing and shoes. The opponent appears to have spent a consistent and sizable amount in promoting and marketing clothing and shoes during 2015 - 2019. Taking the evidence in round, I accept that the opponent has demonstrated a reputation in the mark DIESEL in relation to clothing and shoes. The opponent claims that it has a strong reputation. However, based on the evidence, I am not convinced that the mark has a strong reputation. While the size of investment in promoting the mark is helpful in assessing the reputation, there is only limited evidence in the form of brochures from 2016 to 2018 and online magazines from 2019 and 2020 to show how the mark was promoted. I also have no information on the extent of the reach of those magazines and articles among the relevant UK public. In terms of the sales shown, the opponent has only provided sample invoices, and the sales shown in those invoices are low compared to the size of the UK market for clothing and shoes. I, therefore, conclude that the level of reputation shown is not strong.

Link

21. The next step is to assess whether the public will make a link between the competing marks. This is a multi-factorial assessment taking into account all the relevant factors identified in *Intel*, namely:

The degree of similarity between the conflicting marks

22. The marks are shown below:

Contested mark	Opponent's mark
Pink Diesel	DIESEL

23. The opponent's position is that the contested mark consists of Pink Diesel, which wholly incorporates the opponent's mark. The opponent further argues that the use of the word pink in relation to rosé wine is descriptive of the characteristic of the goods. In support of this claim, the opponent submits screenshots from websites that apparently refers to wine as pink wine.¹⁰ The applicant's position is that Pink, although not innately strong as a mark, plays a

¹⁰ CF1

valuable role in the contested mark as it provides visual, phonetic and conceptual differentiation and transforms the meaning of Diesel.

24. I am of the view that in relation to rosé wine, the word pink is allusive. Even if I am wrong, I bear in mind that descriptiveness does not render a word negligible in the mark.¹¹ In my view, the words, pink and diesel, contribute equally to the overall impression of the contested mark. I also bear in mind that the word pink does not have any allusive character in relation to the remaining goods covered by the contested mark. Considering these factors, I conclude that the marks are visually and aurally similar to a medium degree.

25. In relation to the concept, both parties argue that their marks centre around the concept of diesel, a fuel used in motor vehicles. The parties agree that both marks are intended to evoke the concept of fuelling up. I am of the view that the word pink qualifies the word diesel, and I must take that into account when assessing the concept given by the contested mark. For the average consumer, pink diesel does not convey an idea that is far removed from the concept of a conventional diesel. However, given that the contested mark conveys the idea of a precise colour of diesel, there is a slight conceptual difference between the marks to that extent. I, therefore, find that the marks are conceptually similar to a high degree. My findings apply equally to those goods in the contested mark's specification that are not rosé wine.

The degree of similarity between the goods covered by the respective marks, and the extent of the overlap between the relevant consumers

26. The opponent did not advance any argument on similarity between the goods. I find that the goods in the respective specifications are clearly dissimilar. Both parties' goods are likely to be purchased by the general public. The average consumer of alcoholic drinks covered by the applicant's specification would be anyone of the age 18 or above.

The strength of the earlier mark's reputation

¹¹ See Appointed Person decision in BLO-115-22

27. I have already concluded that the mark's reputation lies in clothing and shoes, and the degree of reputation evidenced is not strong.

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

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

29. The word Diesel has no allusive or suggestive character in relation to the goods for which the mark is registered. I, therefore, find that the mark is inherently distinctive to a medium degree. Following my findings on the opponent's evidence on reputation, I find that the mark has an enhanced distinctive character in relation to clothing and shoes. However, with the limited evidence

provided, I conclude that the mark's distinctive character has not been enhanced to a high degree.

30. I now turn to the opponent's claim that due to the opponent's successful collaborative work with food and drinks organisations, consumers would not be surprised if the opponent were to launch an alcoholic beverage.

31. In support of this claim, the opponent provides evidence of co-branding with undertakings in the food and drink industry. According to the opponent, the Diesel mark was used alongside Coca Cola, DISARONNO and Mustafa Gemuse Kebap in 2018 and 2019.¹²

32. The evidence of cross-collaboration consists of articles from online magazines, namely stile.it, varesenews.it and amica.it. on a limited-edition liquor named "Disaranno wears Diesel". The co-branding was between Disaranno, an Italian liqueur, and Diesel, where the liqueur bottles were wrapped in a Diesel denim pattern. The opponent has also provided screengrabs from the opponent's website <https://it.diesel.com/it/disaronno-wears-diesel/> containing references to the collaborative work with Disaranno. The examples include:



¹² Exhibit D8

33. All of the website addresses referred to in the preceding paragraph contain the top-level domain “.it” which is the country code domain for Italy. Given that the opponent has a .co.uk website specifically aimed at the UK consumers¹³, it does not appear that the evidence of cross-branding with Disaronno on its website containing .it domain was intended to target UK consumers. An extract has also been provided from Vogue Italy. However, it seems unlikely that many UK consumers would have come across this information that appeared in a magazine aimed at Italian readers. In the absence of evidence of UK consumers’ awareness of co-branding through the websites and magazines that primarily targeted Italian consumers, I attach no weight to these aspects of Mr Lesurum’s evidence.

34. An article from eat.drink.sleep.com dated 2019 casts some light on the collaborative efforts of Diesel with Disaronno in the UK.¹⁴ The relevant excerpt from the article is given below:

“The Disaronno wears Diesel 70cl bottle will be available from October in Tesco with an RRP of £18 – recommended retailer prices are at the individual retailer’s discretion.”

35. However, the opponent has not provided any information on the viewership details for eat.drink.sleep.com magazine. So, I cannot ascertain how many customers or potential customers have come across this information. Moreover, in the absence of supporting evidence, it is unclear if the limited-edition bottles were indeed sold through Tesco in the UK.

36. The screengrabs of drinksupermarket.com show that Disaronno wears Diesel 70cl bottle was offered for sale online, and the price of the bottle is provided in pounds.¹⁵ As per the screengrab, the product is no longer available for purchase. As the webpage is undated, it is unclear when the product was

¹³ Exhibit D1

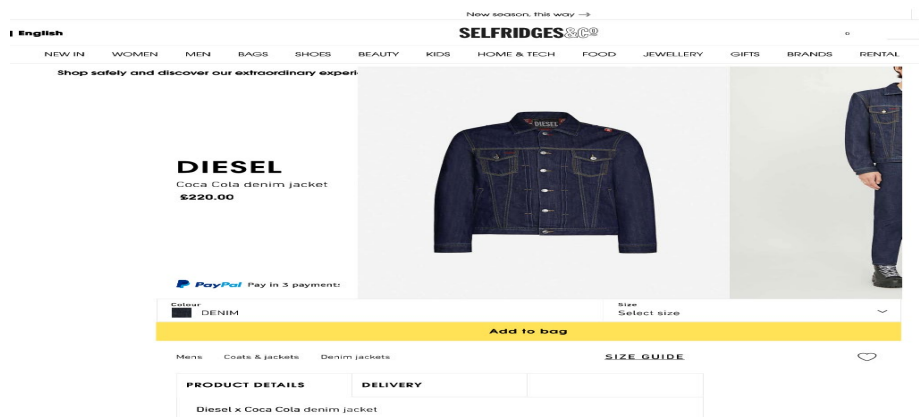
¹⁴ Exhibit D8, page 6

¹⁵ Exhibit D8, page 13

offered for sale. There is also no information on how many bottles were sold. I, therefore, attach only little weight to this evidence.

37. The other evidence in support of co-branding consists of an article from dazeddigital.com dated August 2018 on Diesel's collaboration with Mustafa Gemuse Kebap, a kebab kiosk based in Berlin.¹⁶ I do not think anything turns on this evidence as it does not give any details of UK consumers' awareness of the cross-branding efforts.

38. The screengrab from Selfridge's website shows collaborative work with Coca-Cola in the UK.¹⁷ A snippet from the webpage is given below:



39. The webpage is undated. From an article from Coca-Cola's website titled "Coca-Cola collaborates with Diesel for Capsule Collection Created from Recycled Materials", which is dated,¹⁸ I infer that this cross-branding must have happened in 2019. However, it is not clear how many of those Diesel Coca-Cola denim jackets were sold or how many customers were exposed to the cross-branding efforts by the opponent.

40. The opponent gives evidence of its future collaboration with Masi-Canevel, an Italian wine producer.¹⁹ The evidence consists of pages from online articles or Canevel's website, containing .it domain name. This evidence also suffers from

¹⁶ *Ibid*, page 37

¹⁷ *Ibid*, page 32

¹⁸ *Ibid*, page 33

¹⁹ Exhibit D9

the same defects as the evidence of collaboration with Disaronno. It is not apparent how many people in the UK came across those co-branding plans.

41. Most of the evidence of co-branding activities that occurred before the relevant date appears to have been targeted consumers primarily in Italy. So is the case with the opponent's evidence concerning future collaborative work with Masi-Canevel. From the limited evidence filed in respect of the co-branding activities in the UK, it is not clear the extent to which UK consumers were made aware of a propensity for a manufacturer of clothing and shoes to collaborate with the drinks industry to co-promote the brand.
42. Throughout the evidence of co-branding, the mark Diesel appears as a separate brand, clearly distinguishable from other brands such as Disaranno/Coca-Cola. That is not the case with the mark "Pink Diesel".



44. There is nothing in the applicant's labelling to suggest that Diesel is a different brand. While I agree with the opponent that the notional and fair use would allow the applicant to use the mark in different font sizes or typefaces, I am of the view that when encountered with the contested mark, the average consumer will look at its totality. Even though the respective marks are

conceptually similar to a high degree, that similarity is not enough to counteract the visual and aural differences. In the absence of cogent evidence to demonstrate that UK consumers recognise co-branding campaigns between Diesel and producers of alcoholic/non-alcoholic drinks, the possibility of consumers making a link between the respective undertakings is far from manifest. Also, there is no evidence that alcoholic/non-alcoholic wine/drinks are recognised as being a brand extension of clothing/shoes. Considering all these factors, I do not think that when encountered with the contested mark, the consumers would make a link between Diesel for clothing/shoes and Pink Diesel for alcoholic/non-alcoholic wine and alcoholic drinks.

45. It follows that the section 5(3) ground fails.

Section 5(4)(a)

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

“5(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, or

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”.

47. 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)."

48. There is no evidence that the contested mark was used in the UK prior to the date of application. That being the case, the matter must be assessed only as at the application date of the contested mark, i.e., 27 November 2020.²⁰

49. Under its section 5(4)(a) claim, the opponent claims goodwill in the following goods:

clothing, footwear, headgear, bags, wallets, purses, watches, jewellery, belts, gloves, scarves, eyewear, printed materials, calendars, diaries, alcoholic beverages.

50. Reputation constitutes a knowledge threshold and, therefore, reputation of the earlier mark in the UK is helpful in establishing goodwill, along with evidence of customers in the UK. I have already considered the opponent's claim of reputation in relation to clothing, footwear, headgear, bags, wallets, purses, watches, jewellery, belts, gloves, scarves, eyewear, printed materials, calendars and diaries. Based on the evidence, I concluded that the opponent has established reputation only in respect of clothing and shoes. Following my findings on reputation, I conclude that the sign Diesel has protectable goodwill in the UK in respect of clothing and shoes. The evidence is insufficient to

²⁰ See *SWORDERS TM O-212-06*

establish goodwill for the other goods listed above. I will return to the opponent's claim of goodwill in respect of alcoholic beverages later.

51. The applicant is seeking to register the mark Pink Diesel in respect of non-alcoholic wines and alcoholic wines/drinks. These goods are dissimilar to the opponent's clothing/shoes. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by Wynn-Parry J. in *McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case Falconer J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

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

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

[...]

In the same case Stephenson L.J. said at page 547:

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

52. Bearing in mind the above guidance, it is difficult to see how a misrepresentation would occur. I have already concluded that the word pink in the contested mark is not a non-distinctive or negligible element but contributes to the visual, aural and conceptual difference between the marks. Moreover, there is a very significant gap as regards the respective fields of activity. The only evidence of the use of the sign Diesel in the drinks sector in the UK is the opponent's co-branding activities with Italian liqueur brand, Disaronno. I have already concluded that the evidence shows very little about the UK consumers' awareness of the opponent's co-branding activities. Therefore, I am not convinced that the consumers are likely to be deceived into thinking that the alcoholic drinks/wines and non-alcoholic wines are from or connected in some way with the opponent.

53. I will now consider the opponent's claim of goodwill in alcoholic beverages. The opponent claims that it has used its mark on alcoholic beverages sold in the UK. Clearly, the opponent does not supply alcoholic beverages under the mark Diesel. The evidence indicates that the limited editions bottles were launched as part of a project by Disaronno, which involved teaming up with leading designer labels every year.²¹ The sign Diesel was identified as an Italian fashion brand throughout the co-branding campaign. It is, therefore, far stretched for the opponent to claim that it has generated goodwill in alcoholic beverages based on its co-branding activities with Disaronno. I, therefore, dismiss the opponent's claim that it owns goodwill in alcoholic beverages.

54. For the reasons given above, the section 5(4)(a) ground of opposition is dismissed in its entirety.

Conclusion

55. The opposition is unsuccessful. The application may proceed to registration.

Costs

56. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Tribunal Practice Notice ("TPN") 2/2016. I award costs to the applicant on the following basis:

Considering the statement of case and filing the counterstatement:	£200
Filing evidence and considering the other party's evidence:	£600
Filing written submissions:	£300

²¹ Exhibit 8, www.amica.it

Total:

£1100

57. I order DIESEL S.P.A. to pay Marina Ayton the sum of £1100. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of June 2022

Karol Thomas

For the Registrar

The Comptroller-General