

**O/603/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
APPLICATION NO. 340044  
BY JOWONG INTERNATIONAL TRADING LLC  
TO REGISTER:**

**Pineapple&Star**

**AS A TRADE MARK IN CLASS 25**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 417620  
BY PINEAPPLE HOLDINGS LIMITED**

## Background and pleadings

1. On 17 May 2019 Jowong International Trading LLC (“the applicant”) applied to register the trade mark Pineapple&Star in the UK. The application was accepted and published in the Trade Marks Journal on 26 July 2019 in respect of the following goods<sup>1</sup>:

**Class 25:** *Berets; Cap peaks; Fashion hats; Headwear; Paper hats for use as clothing items; Skull caps; Top hats; Caps being headwear.*

2. Pineapple Holdings Limited (“the opponent”) opposed the mark on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. For the purposes of its opposition based upon Section 5(2)(b), the opponent relies on the following trade marks:

**EU007084437** (“the first earlier mark”)

PINEAPPLE

**Filing date:** 12 April 2006

**Date of entry in register:** 02 October 2008

Goods relied upon:

**Class 18:** *Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; bags, handbags, purses, rucksacks, wallets and cases; umbrellas and parasols.*

**Class 25:** *Clothing, footwear, headgear.*

**UK00002456098** (“the second earlier mark”)



<sup>1</sup> The applied for specification initially contained the term *Hooded sweatshirts*, however, this was removed after the filing of the opposition.

**Filing date:** 21 May 2007

**Date of entry in register:** 18 January 2008

Goods and services relied upon:

**Class 18:** *Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; bags, handbags, purses, rucksacks, wallets and cases; umbrellas and parasols.*

**Class 25:** *Clothing, footwear, headgear.*

**Class 35:** *The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase clothes and fashion accessories from a retail store or from a clothing and fashion accessories catalogue by mail order or by means of telecommunications, namely by means of the telephone or by means of an Internet website; retail services in the fields of toiletries, cosmetics and perfumery, weighing and measuring apparatus and instruments, audio and video recordings (featuring dance, theatre, stage performance, singing, martial arts, yoga, cheerleading, massage, therapy treatments, reflexology, acupuncture, alternative medicines, aromatherapy, osteopathy, performing arts, exercise and related matters), downloadable electronic publications and electronic files (featuring dance, theatre, stage performance, singing, martial arts, yoga, cheerleading, massage, therapy treatments, reflexology, acupuncture, alternative medicines, aromatherapy, osteopathy, performing arts, exercise and related matters), watches, clocks, jewellery, imitation jewellery, printed matter, writing and drawing implements, articles made from leather or from imitation leather, bags, trunks, cases, handbags, rucksacks, purses, wallets, umbrellas, parasols, furniture, ornaments, mirrors, picture frames, household utensils and containers, water bottles, brushes and combs, glassware, porcelain, earthenware and table ware, goods made of textile materials, clothing, footwear, lace and embroidery, buttons, badges, hair bands, hair slides, hair grips, hair ties, hair pins, hair ornaments, toys, games and playthings and exercise apparatus.*

**EU005016911** ("the third earlier mark")

PINEAPPLE

**Filing date:** 12 April 2006

**Date of entry in register:** 20 October 2011

Services relied upon:

**Class 35:** *The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase such goods in a retail clothes and fashion accessories store or from a clothing and fashion accessories catalogue by mail order or by means of telecommunications, including by means of the Internet; retail services in the fields of toiletries, cosmetics and perfumery, audio and video recordings (featuring dance, theatre, stage performance, singing, martial arts, yoga, cheerleading, massage, therapy treatments, reflexology, acupuncture, alternative medicines, aromatherapy, osteopathy, performing arts, exercise and related matters), downloadable electronic publications and electronic files (featuring dance, theatre, stage performance, singing, martial arts, yoga, cheerleading, massage, therapy treatments, reflexology, acupuncture, alternative medicines, aromatherapy, osteopathy, performing arts, exercise and related matters), watches, clocks, jewellery, imitation jewellery, printed matter, writing and drawing implements, articles made from leather or from imitation leather, bags, trunks, cases, handbags, rucksacks, purses, wallets, umbrellas, parasols, furniture, ornaments, mirrors, picture frames, household utensils and containers, water bottles, brushes and combs, glassware, porcelain, earthenware and table ware, goods made of textile materials, clothing, footwear, lace and embroidery, buttons, badges, hair bands, hair slides, hair grips, hair ties, hair pins, hair ornaments, toys, games and playthings and exercise apparatus.*

**UK00003080076** ("the fourth earlier mark")

PINEAPPLE 100% DANCE

**Filing date:** 04 November 2014

**Date of entry in register:** 20 February 2015

Goods relied upon


**Class 25:** *Footwear, clothing, headgear.*

4. The opponent's marks are all earlier marks within the meaning of Section 6(1) of the Act because they have an earlier filing date than the contested application. The first, the second and the third earlier mark completed their registration procedure more than five years before the application date of the contested mark and, as a result, are potentially subject to the proof of use provisions.

5. The opponent claims that the competing marks are similar and that the applicant's goods are either identical or similar to the opponent's goods and services. The opponent argues that these factors result in a likelihood of confusion.

6. For the purposes of its opposition based upon section 5(3) of the Act, the opponent relies on the first and second earlier marks only and claims a reputation in respect of the goods and services listed above for which the first and second earlier marks are registered. The opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the earlier marks. In particular, the opponent contends that unfair advantage would result in increased sales for the applicant and loss of sales for the opponent and that there would be dilution, blurring and tarnishing.

7. For the purposes of its opposition based upon Section 5(4)(a) of the Act, the

opponent relies upon the signs PINEAPPLE and  which correspond to the first and second earlier marks. The opponent claims to have used the signs throughout the UK since as early as 1 January 1979 and 1 January 1985 respectively, in respect of the following goods and services:

Weighing and measuring apparatus and instruments; pre-recorded magnetic data carriers, recording discs; CDs, DVDs featuring dance, theatre, stage performance, singing, martial arts, yoga, cheerleading, massage, therapy treatments, reflexology, acupuncture, alternative medicines, aromatherapy, osteopathy, performing arts, exercise and related matters; downloadable electronic publications and electronic files featuring dance, theatre, stage performance, singing, martial arts, yoga, cheerleading, massage, therapy treatments, reflexology, acupuncture, alternative medicines, aromatherapy, osteopathy, performing arts, exercise and related matters; sunglasses, spectacles and spectacle cases; electrically heated apparatus for treating the hair, electrically heated hair rollers and hair curlers, Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; bags, handbags, purses, rucksacks, wallets and cases; umbrellas and parasols, Clothing, footwear, headgear, The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase clothes and fashion accessories from a retail store or from a clothing and fashion accessories catalogue by mail order or by means of telecommunications, namely by means of the telephone or by means of an Internet website; retail services in the fields of toiletries, cosmetics and perfumery, weighing and measuring apparatus and instruments, audio and video recordings (featuring dance, theatre, stage performance, singing, martial arts, yoga, cheerleading, massage, therapy treatments, reflexology, acupuncture, alternative medicines, aromatherapy, osteopathy, performing arts, exercise and related matters), downloadable electronic publications and electronic files (featuring dance, theatre, stage performance, singing, martial arts, yoga, cheerleading, massage, therapy treatments, reflexology, acupuncture, alternative medicines, aromatherapy, osteopathy, performing arts, exercise and related matters), watches, clocks, jewellery, imitation jewellery, printed matter, writing and drawing implements, articles made from leather or from imitation leather, bags, trunks, cases, handbags, rucksacks, purses, wallets, umbrellas, parasols, furniture, ornaments, mirrors, picture frames, household utensils and containers, water bottles, brushes and combs, glassware, porcelain, earthenware and table ware, goods made of textile materials, clothing, footwear, lace and embroidery, buttons, badges, hair bands, hair slides, hair grips, hair ties, hair pins, hair ornaments, toys, games and playthings and exercise apparatus, Education and training services relating to the performing arts; education and training services in the field of theatre, dance, music, cinema and media; instructional services relating to dance, the performing arts or to physical exercise; teaching of dance and other performing arts; choreographic services; entertainment services in the fields of dance, theatre, stage performance, singing, martial arts, yoga, cheerleading, massage, therapy treatments, reflexology, acupuncture, alternative medicines, aromatherapy, osteopathy, performing arts and exercise; musical and dance performances; musical and dance production services; organisation of entertainment and educational competitions; provision of information, advisory and consultative services relating to the foregoing services; production of sound and video recordings and instructional and educational publications in the fields of theatre, dance, performing arts, exercise, music, cinema and media; music publishing in respect of dance, theatre, stage performance, singing, martial arts, yoga, cheerleading, massage, therapy treatments, reflexology, acupuncture, alternative medicines, aromatherapy, osteopathy, performing arts and

exercise; TV entertainment, musical entertainment, stage shows, production of radio and of television programmes; film production; non-downloadable distribution of films and music in respect of dance, theatre, stage performance, singing, martial arts, yoga, cheerleading, massage, therapy treatments, reflexology, acupuncture, alternative medicines, aromatherapy, osteopathy, performing arts, exercise and related matters.

8. The opponent asserts that use of the applicant's mark will result in misrepresentation and damage, leading to passing off.

9. The applicant filed a counterstatement denying the claims made. In answer to Question 7 "*Do you want the opponent to provide proof of use?*", the applicant replied "*No*"<sup>2</sup>. Consequently, the opponent can rely on all the earlier marks without having to prove that it has genuinely used them. In the counterstatement the applicant also seems to incidentally accept that the opponent's goods encompass the applicant's goods and that the opponent has goodwill and reputation. It stated:

*Despite the obvious shared fields of activity of the parties and the strong goodwill vested in the opponent's business, the opponent's earlier signs are not similar enough to the contested mark (those similarities having been assessed earlier in this decision) to cause a substantial number of the opponent's customers or potential customers to believe that the applicant's goods are, in any way, connected with the opponent; there is no misrepresentation in respect of either earlier mark. Without misrepresentation, there can be no damage.*

*In conclusion, the opponents' marks are visually and aurally similar to a low degree and share little conceptual similarity with the contested mark. The opponent's goods are covering the ones of the applicant broadly. However, the applicant is only specialized in hats and caps alike products. The other goods claimed by the opponents are irrelevant. The opponents' marks have a reasonably strong reputation but no direct association or economic link can be established strongly by the concerning public at large.*

10. The applicant is represented by L & A Consultancy Ltd and the opponent by Page, White & Farrer Limited. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

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<sup>2</sup> In the original Form TM8 and counterstatement, filed on 21 November 2019, the applicant initially requested the opponent to provide proof of use without specifying which earlier rights and for which goods and services it requested the opponent provide proof of use. This was picked upon by the Tribunal and the applicant was requested to file an amended Form TM8 in order to provide the relevant details. In the amended Form TM8 filed on 21 February 2020, the applicant changed its response to 'proof of use' and no longer requested it.

## THE OPPONENT'S EVIDENCE

11. The opponent's evidence consists of the witness statement of Jeffrey Carl Tasker dated 13 May 2020. Mr Tasker has been employed by the opponent since its incorporation on 22 March 2001 and is also a Director of the opponent's company since 1 October 2007.

12. I have read all of the evidence. The following appears to me to be the most relevant:

- The mark PINEAPPLE has been used since 1978 by the opponent or its predecessor in title. The mark was first used by its founder, Debbie Moore OBE, in relation to a dance studio which opened in London in 1978. This was followed by a second PINEAPPLE dance studio called PINEAPPLE WEST, which was also opened in London in 1981. The creation of PINEAPPLE branded clothing followed the success of these dance studios;
- Debbie Moore was very creative in developing successful items of clothing. Her range was very successful with popstars, actresses, dancers and the general public;
- By 5 November 1982, the PINEAPPLE business was a publicly listed company on the London Stock Exchange;
- By 1984 PINEAPPLE shares had increased to £3.6 million and there were two more PINEAPPLE dance studios, one in New York and one in London;
- In 1984 the PINEAPPLE flagship store opened in London's Kings Road selling clothing followed by 12 other stores across the UK, including in Manchester, Kent and Brighton;
- The opponent's company is largely UK orientated, although it has a reputation for dance internationally. The total amount of product sold under the brand PINEAPPLE, excluding revenue from renting out space in the dance studios and organising classes, would be in excess of £500 million. Financial statements<sup>3</sup> show a turnover of £9,8 million and £7,7 million in 2011 and 2012, respectively. £7.7 million and £5.6 million of the opponent's turnover related to

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<sup>3</sup> Exhibit JCT3



the retail of fashion clothing in 2011 and 2012, respectively. In terms of geographical spread, less than £50,000 of turnover in 2012 and only £32,000 of turnover in 2010 was generated outside the UK. Audited accounts to March 2019 show a £2 million income;

- The opponent's PINEAPPLE goods (primarily clothing) have been retailed in a number of UK well-known stores including Amazon, Argos, Asos, Avon, Debenhams, Dorothy Perkins, Fenwick, JD Williams, JJB Sports, Matalan, Harrods, Next, Oasis, Very, Littlewoods, Boots and Tesco;
- The opponent also sells PINEAPPLE branded goods through its own website at [pineapple.uk.com](http://pineapple.uk.com), which has been operational since 2005 and maintains a prominent PINEAPPLE store in London. The opponent opened a new store in 2019;
- The opponent's PINEAPPLE clothing is often retailed by specialist dancewear companies;
- PINEAPPLE clothing has been sold in department stores continuously in the UK since 1999. The opponent has had contractual agreements with large department stores such as Debenhams since that time;
- The PINEAPPLE clothing range is not limited to dancewear. When the opponent started with Debenhams, their brief to the opponent was to create a range of womenswear that was pretty, sexy and feminine with an emphasis on mesh skirts, camis and lace dresses, rather than dancewear. The opponent used *"the fashion blocks (patterns) based upon dancewear to create comfortable, flowing, body-conscious clothing"*. Mr Tasker states that this *"was a great success"* and that the opponent effectively *"took the dance element and put it into streetwear"*; however, it was some years later that the brand PINEAPPLE adapted to fit a changing markets, as active wear became more popular and it was seen on the catwalks. According to Mr Tasker, the PINEAPPLE brand is not simply for dancers and it is now synonymous with *"good quality, a comfortable fit as well as style"*;
- Other retailers of PINEAPPLE branded clothing include House of Fraser and John Lewis. The opponent also worked with other companies to produce items of streetwear that were sold through New Look, Shop Direct and TK Maxx.

- PINEAPPLE dance studios are internationally renowned. The opponent hires out its studios in London, which are particularly popular with West End shows;
- Over the past decade the opponent has spent £800,000 on UK promotion and advertising. Marketing activities includes promotion through attendance at clothes shows and exhibitions, including in Birmingham (from 2001 to 2014) and at the Move It Exhibition (between 2007 and 2014). In 2012 the opponent has been involved in a joint promotion with the Elle modelling agency in a modelling competition; this was advertised in Look Magazine and the Daily Mail. The PINEAPPLE brand was also advertised in a TV series based on the London dance studio which was broadcast on Sky One after 2010;
- The opponent has successfully opposed other UK trade mark applications, including an application for the mark PINEAPPLE HEAD. In that decision (BL-O-141-18), the hearing officer confirmed that the opponent's turnover figures were substantial and that the distinctiveness of the mark had been elevated to a high degree in respect of dancewear and leisure clothing;
- The opponent uses the mark PINEAPPLE in conjunction with images of stars;
- The word STAR is a weak element and there is a large number of coexisting UK traders already using the word STAR in the context of clothing and headgear.

13. The following supporting material is contained within the exhibits produced by Mr Tasker:

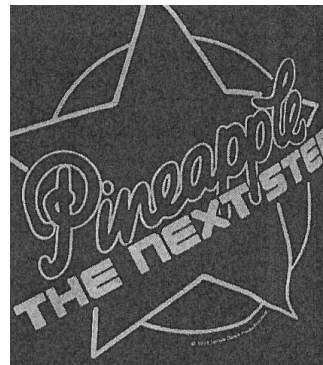
- Copies of online articles (dated prior to the relevant date) and printouts from the opponent's website and from Wikipedia confirming the history and success of the brand PINEAPPLE and its founder Debbie Moore. An article from [www.telegraph.co.uk](http://www.telegraph.co.uk) describes Debbie Moore as the matriarch of "*Pineapple dance empire*"<sup>4</sup>;
- Advertising material showing women's clothing under the mark PINEAPPLE in magazines such as VOGUE prior to the relevant date. The items include dresses, jumpsuits and tops<sup>5</sup>;

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<sup>4</sup> Exhibit JCT1-2

<sup>5</sup> Exhibit JCT4

- Printouts from the opponent’s websites and from UK online retailers, including Debenhams, showing PINEAPPLE branded clothes for sales prior to the relevant date. Examples include items of dancewear and casualwear, including joggers, leggings, tops, hoodies, jumpers, shorts, tracksuit pants, t-shirts and vests<sup>6</sup>;
- Printouts from the opponent’s website and from other websites promoting PINEAPPLE dance studios experiences, prior to the relevant date. The material refers to PINEAPPLE dance studios as “*internationally renowned*”<sup>7</sup>;
- Printouts from Wikipedia about PINEAPPLE DANCE STUDIO TV SERIES. Only one series was produced and aired on Sky1 in 2010<sup>8</sup>;
- Copy of two decisions, namely a decision issued by the EUIPO’s opposition division, refusing an application for the trade mark PINEAPPLE PAPA in class 25 on the basis that there was a likelihood of confusion with the opponent’s earlier PINEAPPLE mark, and the aforementioned decision BL-O-141-18<sup>9</sup>;
- Examples of headgear sold under the brand PINEAPPLE<sup>10</sup>;
- Examples of item of clothing and bags displaying the trade mark PINEAPPLE in conjunction with figurative elements consisting of stars<sup>11</sup>:




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<sup>6</sup> Exhibits JCT5-8

<sup>7</sup> Exhibits JCT 9-12

<sup>8</sup> Exhibit JCT13

<sup>9</sup> Exhibit JCT14

<sup>10</sup> Exhibit JCT15

<sup>11</sup> Exhibit JCT16



- Copy of an online UK article about PINEAPPLE dance studio. It states *“Founded by legendary former model and entrepreneur Debbie Moore OBE, the complex is also renowned as a rehearsal studio to the stars; Beyoncé, Kyle Minogue and Madonna have all reportedly employed the reputable space”*<sup>12</sup>;
- Printouts showing 1) that a Google search for the word ‘star’ brought up 8,300,000,000 results, 2) that a Google search for ‘star clothing uk’ brought up 542 million results and 3) online definitions of the word ‘star’<sup>13</sup>.

## DECISION

### Section 5(2)(b)

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

“5(2) A trade mark shall not be registered if because-

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

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<sup>12</sup> Exhibit JCT17

<sup>13</sup> Exhibit JCT18

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.”

15. The following principles are gleaned from the decisions of the courts of the European Union 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. The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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 the earlier mark to mind, is not sufficient;

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

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

### **The approach**

16. In support of the objection under Section 5(2)(b) the opponent relies upon four earlier registrations. The marks on which the opponent relies consist either of the word PINEAPPLE (first and third earlier mark) in a standard font, or the word PINEAPPLE in a cursive font (second earlier mark), or indeed the word PINEAPPLE together with the words 100% DANCE (fourth earlier mark). It appears to me that the high point of the opponent's case must be based on the first earlier mark consisting of the word PINEAPPLE alone (without stylisation), which covers goods (including *headgear*) in

class 25. If the opponent is unable to succeed on the basis of this registration, it is, in my view, unlikely to succeed on the basis of the remaining registrations, all of which contain additional features or cover specifications in different classes. I will proceed on that basis.

**Comparison of goods**

17. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (“GC”) stated:

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

18. The goods to be compared are as follows:

The applicant’s goods	The opponent’s goods
<p><b>Class 25:</b> <i>Berets; Cap peaks; Fashion hats; Headwear; Paper hats for use as clothing items; Skull caps; Top hats; Caps being headwear.</i></p>	<p><b>Class 25:</b> <i>Clothing, footwear, headgear.</i></p>

19. The contested *Berets; Cap peaks; Fashion hats; Headwear; Paper hats for use as clothing items; Skull caps; Top hats; Caps being headwear* fall within the broad term *headgear* in the opponent’s specification, a fact which was accepted by the applicant itself in its counterstatement when it stated “[t]he opponent’s goods are covering the ones of the applicant broadly”. The goods must be considered identical on the principle outlined in *Merici*.

## **Average consumer and the nature of the purchasing act**

20. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which 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 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.”

21. The average consumer for the goods at issue is a member of the general public. Items of headgear are most likely to be the subject of self-selection from traditional retail outlets on the high street, catalogues and websites, so visual considerations are likely to dominate the selection process, though not to the extent that aural considerations can be ignored (for example, during interactions with sales assistants). The cost of the goods at issue can vary considerably. Nevertheless, as factors such as material, size, colour, cost and compatibility with other items may all come into play, the average consumer, in my experience, will pay an average degree of attention when making their selection.

## **Comparison of the marks**

22. 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.”

23. 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. The respective trade marks are shown below:

<b>Applicant's mark</b>	<b>Opponent's first earlier mark</b>
Pineapple&Star	PINEAPPLE

### **Overall impression**

24. The first earlier mark upon which the opponent relies consists of the word 'PINEAPPLE' presented in block capital letters; the overall impression it conveys and its distinctiveness lying in the totality.

25. The applicant's mark consists of the words 'Pineapple' and 'Star', presented in title case and separated by an ampersand symbol. In terms of overall impression, the words 'Pineapple' and 'Star' share equal dominance, both being presented in the same manner and joined by the non-distinctive '&' symbol.

## Visual and aural similarity

26. The applicant states that the use of title case and uppercase letters in the respective marks creates a point of difference. This is not the correct approach. In making the visual comparison between the marks in issue, I must take into account the fact that word marks cover use in multiple types fonts and typefaces. Consequently, the word 'Pineapple' in the applicant's mark must be considered to be identical to the word 'PINEAPPLE' in the earlier mark. Whilst the applicant's mark contains an ampersand symbol and the word 'Star', which have no counterpart in the opponent's mark, the fact that the shared element, namely the word 'Pineapple', is placed at the start of the applicant's mark and it is formed of nine letters and is thus longer than the ampersand symbol and the word 'Star' (which is formed of four letters) will, in my view, result in, at least, a medium to high level of visual and aural similarity between the marks.

## Conceptual similarity

27. Conceptually, the word element 'pineapple', common to both marks, will be perceived as a reference to a large tropical fruit. The applicant's mark also includes an ampersand symbol and the word 'Star'. However, bearing in mind that the word 'Star' is a very common word and is associated with various meanings, including that of a fixed luminous point in the night sky, a famous person or an outstanding successful person or thing<sup>14</sup>, it does not add a highly distinctive concept to the mark. In its counterstatement, the applicant states that *"by combining Pineapple with "&Star" which is odd and two irrelevant elements being put together give the trade mark extra distinctiveness"*. This supports my impression that the mark applied for is simply the juxtaposition of the signs 'Pineapple', '&' and 'Star' which retain their independent meanings and do not form a whole which conveys a new concept. That is to say that the word 'pineapple' has the same meaning alone as it does as part of 'Pineapple&Star'. The marks are conceptually similar to a high degree.

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<sup>14</sup> Collins English Dictionary

### **Distinctive character of the earlier trade mark**

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-2779, 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. From an inherent perspective, the word PINEAPPLE is not descriptive of any of the goods covered by the earlier mark, namely *clothing, footwear and headgear*. On the other hand, it is not an invented or fancy word and, therefore, it has not a high degree of inherent distinctiveness. I find that the earlier mark has a normal degree of inherent distinctiveness in relation to the goods at issue. The opponent has provided a copy of a decision issued by a fellow hearing officer in 2018 in which it was found that the distinctiveness of the earlier PINEAPPLE mark had been elevated to a high degree in respect of dancewear and leisure clothing. The applicant has also accepted that the opponent’s marks “*have a reasonably strong reputation*” and I bear in mind

that, when assessing the distinctiveness of a mark, “a measure of consistency [...] is desirable<sup>15</sup>”. Taking all of the above into account, my conclusion is that the evidence before me shows that the opponent has used the mark PINEAPPLE on very substantial scale and that the use shown is sufficient for the earlier mark to have acquired an enhanced level of distinctiveness in relation to dancewear and leisure clothing.

### **Likelihood of confusion**

30. In determining whether there is a likelihood of confusion, 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 vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind.

31. Confusion can be direct or indirect. This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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

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<sup>15</sup> BL-O-478-20

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.

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).”

32. I have found the marks to be visually and aurally similar to a medium to high degree and conceptually similar to a high degree. I have found the earlier PINEAPPLE mark to be highly distinctive through use in relation to dancewear and leisure clothing. I have identified the average consumer to be a member of the general public who will purchase the goods by mainly visual means, although I do not discount aural considerations. I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the parties’ goods to be identical.

33. Taking all of the above into account, I find that even where the average consumer realises that the marks are different, he or she is likely to believe that the common and highly distinctive word ‘Pineapple’ indicates that the applicant’s mark is a variant mark used by the same undertaking, or by economically connected undertakings. This is all

the more since the distinguishing element 'Star' in the applicant's mark would, as the opponent's evidence suggests, be a popular choice for use in names or as a decorative element by brands offering goods in class 25. For example, the average consumer faced with the 'Pineapple&Star' mark being used on an item of headwear decorated with the image of a star, would understand the element '&Star' as a descriptive addition to the opponent's PINEAPPLE mark. But even if the element '&Star' is perceived as distinctive, I find that the average consumer would take the 'Pineapple&Star' mark as a whole to belong to the same stable as the earlier 'PINEAPPLE' mark. **There is a likelihood of indirect confusion.**

**34. The ground of opposition under Section 5(2)(b) succeeds.**

#### **Section 5(4)**

35. Section 5(4)(a) of the Act states as follows:

“(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.”

36. Subsection (4A) of Section 5 of the Act states:

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

37. 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).”

### **Relevant Date**

38. There is no indication that the applicant’s mark has been used prior to the application date in the UK and therefore the only relevant date is the date of the application<sup>16</sup>, namely 17 May 2019.

### **Goodwill**

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

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

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<sup>16</sup> *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O410-11

start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

40. Goodwill arises as a result of trading activities. Clearly, the opponent had been trading prior to the relevant date. In its counterstatement the applicant accepted that the opponent has “*a strong goodwill vested in its business*”. For the avoidance of doubt, I should say that even in the absence of such a concession, I would have found that the evidence filed establishes that there were extensive sales and advertising activities under the sign ‘PINEAPPLE’ prior to the relevant date and that, at that date, the opponent had a significant degree of goodwill in the UK. The opponent relies, under this ground, on a long list of goods and services, but for the purpose of this decision, it is sufficient to say that the list includes, amongst others, goods in respect of which I have found that the ‘PINEAPPLE’ mark has acquired a high degree of distinctive character through use in the UK, namely *clothing*. Accordingly, I also find that the opponent’s goodwill is in relation to dancewear and leisure clothing and that the sign ‘PINEAPPLE’ was distinctive of that goodwill at the relevant date.

### **Misrepresentation**

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

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at page 407 the question on the issue of deception or confusion is:

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’ [product].



The same proposition is stated in Halsbury's Laws of England 4<sup>th</sup> Edition Vol. 48 para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 RPC 97 at page 101."

42. Halsbury's Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff 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 feature 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 successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court 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 plaintiff and the defendant carry on business;

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

(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 confusion or 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.”

43. I recognise that 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’. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here. I have also asked myself whether the fact that most of the evidence establishes use in relation to items of dancewear and leisurewear rather than items of headgear (which are the goods for which the applicant’s mark seeks registration) would make any difference to the outcome of the decision. I do not think it would. This is because: 1) the evidence includes examples of use of the sign ‘PINEAPPLE’ in relation to headwear. For example, an invoice dated prior to the relevant date shows that 2,400 caps were sold by the opponent in the UK, so the opponent has effectively used the mark in relation to identical goods<sup>17</sup>; 2) even if the use shown is not sufficient to establish a goodwill in relation to, specifically, headwear, it is very common for those trading in clothing to also trade in headwear (and footwear) under the same mark, so even if one were to compare the opponent’s dancewear and leisure clothing and the applicant’s headwear, the goods would, effectively, be highly similar and perceived as goods belonging to the same field of activity. Accordingly, I consider that a substantial number of members of the relevant

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<sup>17</sup> JCT15

public would be misled into purchasing the applicant's goods in the mistaken belief that they were the goods of the opponent.

44. In this case, I consider that damage through diversion of sales is easily foreseeable.

**45. The ground of opposition under Section 5(4)(a) succeeds.**

### **Section 5(3)**

46. 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.

47. 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, *Addidas-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; *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* 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*).

48. The relevant date for the assessment under Section 5(3) is the date of the application, namely 17 May 2019.

## **Reputation**

49. 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."

50. In its counterstatement the opponent seems to accept that the opponent has a reasonably strong reputation but argues that no economic link can be established. I say "seems" because the concessions is made under the heading "*Section 5(4)(a) - the claim for passing off is denied*" rather than in response to the claim under Section 5(3). In any event, I should briefly say that, taking the evidence as a whole into account, in particular 1) the significant sale figures, which are in excess of £500 million; 2) the geographical extent and duration of use, with the goods being sold through major UK retailers continuously for over 40 years; and 3) the publicity generated by the exposure of the name 'PINEAPPLE' in connection with highly publicised events, relevant publications and a TV series, I am satisfied that the opponent has demonstrated that it had a reasonable reputation in the UK at the relevant date for dancewear and leisure clothing.

## Link

51. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

- The degree of similarity between the conflicting marks: For the reasons set out above, I consider the marks to be visually and aurally similar to between a medium and high degree and conceptually similar to a high degree.
- The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public. The applicant's goods are identical or highly similar to the goods for which the opponent has demonstrated a reputation.

- The strength of the earlier mark's reputation. The earlier mark has a reasonable reputation in the UK.
- The degree of the earlier mark's distinctive character, whether inherent or acquired through use. The earlier mark is inherently distinctive to a medium degree. The distinctive character of the earlier mark has been enhanced through use to a high degree.
- Whether there is a likelihood of confusion. I have found there to be a likelihood of indirect confusion.

52. In my view, taking into account the similarities between the marks and the similarities between the parties' respective goods, I consider that a significant part of the relevant public will make a link between the marks in use.

## **Damage**

53. I must now assess whether any of the pleaded types of damage will arise. The opponent has pleaded, amongst others, unfair advantage and dilution in the following terms:

"...the later mark, without due cause, would take unfair advantage of the opponent's reputation in its marks, namely, an unfair commercial advantage whereby the link in the relevant consumer's mind between the opponent's reputed marks and the mark applied for would lead to a change in the relevant consumer's economic behaviour, resulting in increased sales for the applicant's and lost sale for the opponent [...]. Furthermore, in relation to question 6 use of the later mark is likely to dilute the distinctiveness of the earlier marks by weakening the earlier mark's ability to identify the opponent's goods and services. The blurring of distinctiveness will mean that the opponent's trade marks are no longer as capable of arousing an immediate association with the opponent's goods and services"

54. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

55. Taking into account the opponent's reputation, the similarity of the marks, and the similarity of the goods, it is clear that there is potential for the opponent's image of good quality and stylish clothes to be transferred to the applicant's goods. The applicant would therefore benefit from the opponent's reputation without paying financial compensation and would, therefore, be likely to take unfair advantage of the earlier mark. Further, use of the applicant's mark would undoubtedly dilute the opponent's 'PINEAPPLE' brand. Damage is made out on the basis of unfair advantage and dilution.

56. The opposition based upon Section 5(3) also succeeds.

## **OUTCOME**

57. The opponent been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent sum of £1,200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:



Official fees:	£200
Preparing a statement and considering the applicant's counterstatement:	£200
Preparing evidence:	£800
Total	£1,200

58. I therefore order Jowong International Trading LLC to pay Pineapple Holdings Limited the sum of £1,200. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30<sup>th</sup> day of November 2020

T Perks  
For the Registrar,  
the Comptroller-General