

**o/1104/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK3652255**

**BY LHR HOLDING LTD**

**TO REGISTER THE TRADE MARK:**

**TRU COLLECTION**

**IN CLASSES 18, 22, 25, 26 & 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 428161**

**BY THE CLIFF NEWCO LIMITED**

## **Background and pleadings**

1. On 7 June 2021, LHR Holding Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 13 August 2021. Registration is sought for the following goods and services:

Class 18: Handbags; Evening handbags; Leather handbags; Slouch handbags; Handbag straps; Fashion handbags; Ladies' handbags; Ladies handbags; Clutch handbags; Handbags for ladies; Clutch purses [handbags]; Handbags made of imitations leather; Handbags, purses and wallets; Handbags made of leather; Handbags, not of precious metal; Purses, not of precious metal [handbags]; Purses, not made of precious metal [handbags]; Handbags, not made of precious metal.

Class 22: Mesh bags for washing lingerie.

Class 25: Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Hoods [clothing]; Leisure clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Knitwear [clothing]; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing; Layettees [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Coats; Sheepskin coats; Fur coats; Coats (Top -); Trench coats; Evening coats; Dust coats; Duffle coats; Morning coats; Denim coats; Wind coats; Suit coats; Sport coats; Cotton coats; Pea coats; Rain coats; Frock coats; House coats; Leather coats; Duffel coats; Winter coats; Heavy coats; Coats of denim; Coats for women; Shoes; Work shoes; Canvas shoes; Women's shoes;

Athletic shoes; Training shoes; Flat shoes; Platform shoes; Dress shoes; Running shoes; Walking shoes; Hiking shoes; Rubber shoes; Leisure shoes; Deck shoes; Yoga shoes; Deck-shoes; Rain shoes; Leather shoes; Beach shoes; Tennis shoes; Athletics shoes; Sport shoes; Waterproof shoes; Slip-on shoes; High-heeled shoes; Nightwear; Lingerie; Maternity lingerie; Bodices [lingerie].

Class 26: Lingerie tapes

Class 35: Marketing; Market canvassing; Market campaigns; Direct marketing; Online marketing; Advertising and marketing services; Online advertising; Radio advertising; Online advertisements; Newspaper advertising; On-line advertising; Retail services relating to clothing; Retail services in relation to headgear, excluding jewelled or decorative hair or jewelled or decorative head accessories; Retail services in relation to bags, excluding jewellery bags and rolls; none of the aforesaid services in relation to, or in the field of, jewellery.

2. The application was opposed by THE CLIFF NEWCO LIMITED (“the opponent”) on 12 November 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and concerns the goods and services in classes 18, 25 and 35.

3. The opponent relies on the following trade marks:

UK901246776

TRUCCO

Filing date: 20 July 1999

Registration date: 22 January 2004

Relying upon the following goods:

Class 18: Leather and imitations of leather, and goods made of those materials and not included in other classes.

Class 25: Clothing, footwear

UK903476009

TRUCCO

Filing date: 30 October 2003

Registration date: 10 February 2005

Relying upon the following services:

Class 35: Retailing of clothing, headgear, fashion accessories of leather and imitations of leather or plastic, jewellery; retailing via global computer networks (Internet) of the aforesaid goods; advertising

4. The opponent claims that the marks are highly visually similar. It argues that its own mark is almost entirely contained within the applicant mark save for the additional letter 'C' in the earlier mark and the additional letters 'LLECTION' in the contested mark. It further asserts that the phonetic similarities are high. It claims that the marks have no meaning as such in the English language and therefore, no conceptual comparison is possible. The opponent furthers that the applicant's goods and services are identical to their own. A claim for enhanced distinctiveness of its own mark is put forward by the opponent. It concludes that in the opinion of the opponent, the high degree of similarities risks confusion and association in the market.

5. The applicant filed a counterstatement denying the claims made and put the opponent to proof of use of the earlier marks.

6. The applicant is represented by Serjeants LLP and the opponent is represented by Lara Grant.

7. The opponent filed evidence during the evidence rounds. Neither party requested a hearing but both parties provided submissions in lieu. This decision is therefore taken following careful perusal of the papers.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **Evidence**

9. The opponent's evidence consists of a witness statement by Lara Grant, who is the opponent's representative, together with four accompanying exhibits. The main purpose of the evidence is to rebut assertions of non-use made by the applicant.

10. The opponent also provided a witness statement from Pedro Valdecantos Jimenez De Andrade who is a director of THE CLIFF NEWCO LIMITED and CEO of Good Job Business S.L. which owns 75% or more shares in the opponent company. The purpose of his evidence is also to rebut the assertions of non-use.

11. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

## **Decision**

### **Section 5(2)(b)**

12. Section 5(2)(b) reads as follows:

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

(a)...

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

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

...”

14. The opponent’s marks are earlier marks, in accordance with Section 6 of the Act. The earlier marks are subject to proof of use requirements as it has been registered for five years or more before the filing date of the proprietor’s mark, as per section 6A of the Act. The applicant has requested that the opponent provides proof of use for its marks.

### **Proof of use**

15. I will begin by assessing whether there has been genuine use of the earlier marks.

16. Section 100 of the Act states that:

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

17. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks is the five-year period ending with the date of the application in issue i.e. 8 June 2016 to 7 June 2021

18. The applicant's submissions focus on the fact that the evidence provided does not show use of the mark within the UK itself. However, the opponent's marks are UK comparable marks and therefore the practice set out in Tribunal Practice Notice ("TPN") 2/2020 applies. This explains how Schedule 2A of the Act ("European Union trade marks") affects the assessment of use and reputation. It states that where use and reputation fall to be considered at any time before IP Completion Day (31 December 2020), I am to take into account use in the EU of the corresponding EU Trade Mark ("EUTM") or International Registration designating the EU ("IR(EU)") until IP Completion Day.<sup>1</sup>

19. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

"114.....The CJEU has considered what amounts to "genuine use" of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C 416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I 4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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<sup>1</sup> Paragraph 4

115. The principles established by these cases may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to



create or preserve an outlet for the goods or services that bear the mark: Ansul at [37]-[38]; Verein at [14]; Silberquelle at [18]; Centrotherm at [71]; Reber at [29].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: Ansul at [39]; La Mer at [21], [24] and [25]; Sunrider at [72] and [76]-[77]; Leno at [55].

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

## Evidence

20. The evidence provided by Ms Grant is made up of printouts of the opponent's website from the Way Back machine archive between 2016 and 2021. The mark is used on the website screenshots as shown below on Exhibits LG1, 2 and 3:

# TRUCCO

This version of the mark appears to be used on the shop fronts shown in Exhibit PVJ3Ter. Exhibit PVJ15 shows the mark but in a white font on a grey background.

21. The website screenshots also show some examples of goods but it does not show them bearing the mark itself. An example of this is below:



22. The goods shown seem to be items of women's clothing but there is no breakdown of specific items. Further, Exhibit PVJ11 shows three items - two jumpsuits and a neckerchief - for sale on amazon under the Trucco brand.

23. In Exhibit LG4 the below version of the mark is used:



24. Exhibit PVJ3 is a leaflet showing the 270 physical points of sale worldwide and refers to Trucco as being a 'fashion brand'. This is further expanded on in Exhibit PVJ15 which is a corporate leaflet with information regarding Trucco's presence around the world in the following countries: Andorra, Chile, China, Costa Rica, Czech Republic, Dominican Republic, Guatemala, Israel, Kuwait, Libya, Malaysia, Mexico, Panama, Paraguay, Peru, Qatar, Russia, Singapore, Slovakia, Spain, Taiwan, Thailand. This leaflet refers to Trucco as being a Spanish womenswear fashion brand. The Spanish stores are shown in Exhibit PVJ3B and although this does not appear to be dated it shows 57 shops in Spain.

25. Mr Valdecantos provided annual turnover details in Euros and claims the below figures relate to total sales of clothing and bags under classes 18 and 25:

2016: 24,541,000.00  
2017: 21,352,000.00  
2018: 20,353,000.00  
2019: 16,711,000.00  
2020: 7,302,000.00  
2021: 11,974,000.00

26. He states the below figures relate to use of UKTM903476009 in class 35:

2016: 685,000.00  
2017: 740,000.00  
2018: 858,000.00  
2019: 559,000.00  
2020: 559,000.00  
2021: 742,000.00

27. Further, he claims that the opponent made exports in the amounts shown in the below table between 2016 and 2021 by affixing the mark to its clothing and accessories products within the EU:

	2016	2017	2018	2019	2020	2021
<b>EXPORTS</b>	5.223.000,00	4.982.000,00	4.269.000,00	3.830.000,00	2.441.000,00	3.729.000,00

28. Mr Valdecantos also provided the opponent's advertising expenditure as follows:

Advertising expenditure in euros			
Año 2.016	414.790,26€	Año 2.020	94.542,24€
Año 2.017	340.472,38€	Año 2.021	187.707,83€
Año 2.018	350.479,17€		
Año 2.019	89.017,17€		

29. The opponent provided translated sample invoices in Exhibits PVJ5-10. I have extracted the following information from the invoices:

Date	Country	Amount (€)	No. of Goods	Goods
30/04/2016	Alicante, Spain	1956.47	111	Skirt, trousers, shirt, jacket, top, t-shirt, jumper, cardigan, dress, bag, brooch, scarf, belt, necklace, sandals
08/04/2016	Pamplona, Spain	907.93	37	Skirt, trousers, shirt, jacket, top, tshirt, cardigan, jumpsuit, dress, coat, necklace,

22/12/2016	Spain	502.08	45	Skirt, trousers, shirt, sweatshirt, jumper, cardigan, dress, coat
28/01/2016	Spain	666.03	33	Trousers, jumper, bag, skirt, t-shirt, shirt
25/08/2016	Spain	6091.86	291	Sweatshirt, t-shirt, bag, necklace, trousers, shoes, boots, sandals, skirt, shirt, jacket, jumper, dress, cardigan,
16/02/2017	Spain	1215.96	54	Shirt, cardigan, dress, bag, necklace, trousers, skirt, jacket, jumper, sweatshirt
22/06/2017	Spain	903.30	55	Shirt, skirt, trousers, t-shirt, dress
13/09/2017	Guadalajara	1600.54	58	Jumper, jacket, skirt, trousers, shirt, sweatshirt, t-shirt, cardigan, dress, coat,
10/06/2017	Las Palmas	39.94	2	Jumper, dress
17/11/2017	Portugal	162.00	4	Bags- Small, medium and large, sticker roll
05/03/2018	Alicante	120.87	9	Trousers, shirt, sweatshirt, t-shirt, trousers, jumper
06/08/2018	Pamplona	599.78	46	Skirt, trousers, shirt, jacket, sweatshirt, t-shirt, dress, bag, necklace, cardigan
20/12/2018	Murcia	303.40	17	Skirt, trousers, shirt, sweatshirt, jumper, dress, coat, bag, belt,
18/10/2018	Portugal	1701.71	1	"Generic set"
18/07/2018	Arcozelo	269.60	20	Sweatshirt, cardigan

27/03/2019	Spain	563.21	21	Skirt, jacket, sweatshirt, jumper, cardigan, dress
22/08/2019	Portugal	838.44	54	Trousers, sweatshirt, jumper, cardigan, skirt
08/05/2019	Arcozelo	457.30	31	Cardigan, shirt, t-shirt, dress
08/11/2019	Avila	2500.78	128	Scarf, cardigan, skirt, jumper, necklace, costume jewellery, shirt, trousers,
26/07/2019	Huesca	1591.86	91	Dress, trousers, shirt, sweatshirt, t-shirt, cardigan
09/06/2020	Berlin, Germany	1679.98	64	<i>The information regarding specific goods is not clear from the invoice evidence provided</i>
20/01/2020	Murcia	100.94	5	Sweatshirt, jumper, coat, scarf
11/09/2020	Portugal	252.39	21	Sweatshirt, jumper
31/07/2020	Arcozelo, Portugal	1287.63	99	Shirt, sweatshirt, trousers, dress
28/05/2021	Portugal	433.44	36	Shirt, trousers, sweatshirt, t-shirt
23/02/2021	Alicante	202.90	18	Tights, skirt, shirt, jacket, sweatshirt
04/01/2021	Alicante	459.56	22	Trousers, skirt, shirt, t-shirt, jumper, dress, coat
08/01/2021	Portugal	975.84	75	Trousers, sweatshirt, jumper, skirt, t-shirt, jumper
02/01/2021	Spain	768.30	41	Trousers, skirt, shirt, jacket, sweatshirt, t-shirt, jumper, coat

30. Exhibit PVJ12 (and PVJ12Bis) is a collection of catalogues of the opponent's products from 1985 to 2021. Most of these are outside of the relevant period but those within the relevant period show usage of the mark as shown above in paragraph 20 and all feature women in various outfits and items of clothing. They do not list the products with product numbers or pricing to show how to purchase.

31. Exhibit PVJ13 contains samples of news articles mentioning the opponent from 2015 -2021

Date	Publication	Notes
21/04/2015	ABC Style	Outside relevant dates. "Trucco, 30 years of fashion"
17/10/2016	Trendencias	New collection campaign. Refers to "Trucco women".
30/10/2017	Pinker moda	Opening in El Corte Ingles
12/06/2017	Eleconomista	Business article
04/08/2017	Modalia.es	Autumn/winter collection, aimed at women
30/11/2017	Modaes.es	Trucco goes to market. Looking for a partner for expansion.
09/10/2017	<i>The source of this article is not clear from the evidence provided</i>	Article about autumn collection
16/04/2018	Modaes.es	Trucco accelerates expansion- 4 new corners in department stores
04/04/2018	Modaes.es	Development of new brand and funding

10/09/2020	Modaes.es	Trucco resorts to closures and layoffs to avoid bankruptcy
22/10/2020	Modaes.es	Openings in Mexico and Italy
10/05/2021	Modaes.es	Resumes expansion after leaving bankruptcy proceedings. More Italian stores opening.
20/05/2021	Elle	23 long kimonos - shows the 'Trucco' kimono
23/04/2021	Noticias de Navarra	Designer having a collection with Trucco
08/10/2018	Canales Sectoriales	Trucco redesigns its digital and multichannel strategy - redesigned its web presence

32. Exhibit PVJ14 shows printouts from Pinterest which is a social media platform from 2016 to 2021. The screenshots themselves are undated but refer to "Fall-Winter" Collections for each year period. The pictures all include female models wearing various clothing items.

## **Analysis**

### **Form of the mark/how the marks are used**

33. I note that the opponent's marks are word marks. The version used almost throughout the opponent's evidence (shown again below for ease of reference) is in a relatively simple typeface and there is nothing to alter the distinctive character of the mark. I therefore find this use to be acceptable:



# TRUCCO

34. In Exhibit LG4, the mark has been used as follows:



35. I consider the following from *Zero Industry Srl v OHIM*<sup>2</sup>:

" ... it is common in the clothing sector for the same mark to be configured in various ways according to the type of product which it designates, and second, it is also common for a single clothing manufacturer to use sub-brands (signs that derive from a principal mark and which share with it a common dominant element) in order to distinguish its various lines from one another."

36. I consider that the above usage would be seen by the average consumer as a potential 'different line' or collaboration between two companies, particularly in light of the use of the 'x' between the names and therefore, they would still believe the same undertaking would be involved with the goods and services in question. I therefore find this to also be acceptable use.

## **Conclusions from the evidence on genuine use**

37. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the comparable mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the EU during the relevant five-year period. In making this assessment, I am required to consider all relevant factors, including:

- The scale and frequency of the use shown;

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<sup>2</sup> Case T-400/06, at paragraph 81

- The nature of the use shown;
- The goods and services for which has been shown;
- The nature of those goods/services and the market(s) for them; and
- The geographical extent of the use shown.

38. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>3</sup>

39. The opponent's first shop opened in Spain in 1985, there has been growth from that one store to 270 stores which are now worldwide. There are clearly stores within the EU (Ireland, Spain and Portugal), although none in the UK itself.

40. I note the opponent provided sales figures for the European countries (I note that the witness statement claims it to be for UK as well but I have no further evidence of sales points within the UK). I have noted the figures above, but the lowest figure is 2020 at over 7 million Euros. I consider that the clothing market is extremely large and these figures represent a reasonable level of sales. I also note there is no de minimis level of sales. I also note the marketing expenditure figures which range from 89,000 Euros to over 400,000 Euros (although some of this will be outside of the relevant period in 2016). Within the witness statement of Mr Valdecantos he states that advertisement and promotional activities in the UK and Europe include:

- Brochures available for download on website and social media
- Brochures sent to franchisees and points of sale
- Social media channels- Facebook, Instagram, Pinterest.
- Appearances on specialised clothing press media.

41. I have been provided with example brochures within the evidence and screenshots of their own website and Pinterest pages relating to the brand. They also provided 15 articles about the brand (although one falls outside the relevant dates). Most of these articles focus on the expansion of the brand and its development but there are some

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<sup>3</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

articles included around the goods they provide - such as the article about their autumn collection from 9 October 2017.

42. Taking all of the above into account, I am satisfied that the opponent has demonstrated genuine use of its earlier marks during the relevant period.

### **Fair specification**

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

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

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

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

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

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

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

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

45. As a reminder, the opponent's mark UK901246776 is relying on the following goods:

Class 18: Leather and imitations of leather, and goods made of those materials and not included in other classes.

Class 25: Clothing, footwear

46. Regarding the class 18 goods, I note that Exhibits PVJ12 and PVJ12Bis show around three photographs of handbags which could possibly be made from leather or imitation leather. However, there is no information within the brochures themselves nor product numbers for cross referencing which would lead me to be able to make this finding. Further, the invoice evidence provided simply refers to the goods as 'bags' and provides no information regarding the materials the bags are made from. Therefore, I cannot say that the opponent has provided evidence of use for any class 18 goods.

47. Regarding the class 25 goods, I consider the following caselaw: *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

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

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

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

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

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

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

49. I find that all of the evidence points to the opponent providing women's clothing in particular, they even refer to themselves as a 'women's fashion retailer' and there is no deviation from this to show any collections for men or children. Although the invoices show a relatively consistent range of types of clothing being purchased, following the above caselaw, I do not consider it necessary for them to show all types of women's clothing in order to receive protection for that entire category. Following on from that, I have only seen mention of women's boots, sandals and shoes within the invoice evidence. Various shoe styles are worn by the models within the catalogue evidence also. Consequently, I find a fair specification for UK901246776 to be:

Class 25: Women's clothing; Women's footwear

50. For the UK903476009 mark, the opponent is relying upon:

Class 35: Retailing of clothing, headgear, fashion accessories of leather and imitations of leather or plastic, jewellery; retailing via global computer networks (Internet) of the aforesaid goods; advertising

51. I now consider the Class 35 services. In *Netto Marken*, Case C-420/13, the CJEU held that it was possible to register a trade mark for services involved in the bringing together of other services, even where some of the latter services were provided by the trade mark proprietor itself. The court explained that:

“...even though the assortment of services offered by Netto Marken Discount could include services provided by itself, that in no way casts doubt on the fact that the supply described in its application for registration, by means of the words ‘the bringing together, for the benefit of others, of a variety of services enabling customers conveniently to purchase those services’, is capable of being categorised..... as a service. At the risk of depriving the applicant in the main proceedings of the possibility of having that sign registered as a trade mark with respect to that bringing together service, its application for registration with respect to Class 35 of the Nice Classification cannot be rejected on the sole ground that the assortment of services which it intends to provide to the consumer could also include services offered by itself.”

52. By analogy, services for the bringing together or retailing of goods may therefore include services where some of the goods brought together are the proprietor's own goods. Indeed, given that the subject matter of the services in class 35 is the bringing together of a selection of goods for the convenience of the public, and other related services intended to encourage consumers to purchase those goods from the trade mark owner, the trade origin of the goods themselves does not appear to be particularly important. Therefore, provided there is sufficient selection in the range and/or quality of goods brought together for the public's convenience so as to

constitute a service to consumers and/or other identifiable retail services are provided, such services may be protected by a trade mark in class 35. In principle, this should be possible even where the services in question are intended to induce the consumer to purchase the proprietor's own goods. I note the evidence of their own retail stores and establishments. However, I consider that the opponent has not demonstrated any use of its services in class 35 because they have not provided any evidence of the provision of advertising services to their customers. Regarding the retail services, it is not clear what services or range of goods have been available in those shops.

53. Consequently, the opponent cannot rely on any services under the UK903476009 mark.

### **Section 5(2)(b)**

54. Section 5(2)(b) reads as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

55. In making this decision, I bear in mind the following principles gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04,



*Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

56. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

58. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM) ('Meric')*, Case T-133/05, the General Court ("the GC") stated that:

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

59. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

60. The Parties' respective specifications are:

Applicant's goods and services	Opponent's goods
<p>Class 18: Handbags; Evening handbags; Leather handbags; Slouch handbags; Handbag straps; Fashion handbags; Ladies' handbags; Ladies handbags; Clutch handbags; Handbags for ladies; Clutch purses [handbags]; Handbags made of imitations leather; Handbags, purses and wallets; Handbags made of leather; Handbags, not of precious metal; Purses, not of precious metal [handbags]; Purses, not made of precious metal [handbags]; Handbags, not made of precious metal.</p> <p>Class 25: Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Hoods [clothing]; Leisure clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Knitwear [clothing]; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing; Layettees [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity</p>	<p>Class 25: Women's clothing; Women's footwear</p>

clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Coats; Sheepskin coats; Fur coats; Coats (Top -); Trench coats; Evening coats; Dust coats; Duffle coats; Morning coats; Denim coats; Wind coats; Suit coats; Sport coats; Cotton coats; Pea coats; Rain coats; Frock coats; House coats; Leather coats; Duffel coats; Winter coats; Heavy coats; Coats of denim; Coats for women; Shoes; Work shoes; Canvas shoes; Women's shoes; Athletic shoes; Training shoes; Flat shoes; Platform shoes; Dress shoes; Running shoes; Walking shoes; Hiking shoes; Rubber shoes; Leisure shoes; Deck shoes; Yoga shoes; Deck-shoes; Rain shoes; Leather shoes; Beach shoes; Tennis shoes; Athletics shoes; Sport shoes; Waterproof shoes; Slip-on shoes; High-heeled shoes; Nightwear; Lingerie; Maternity lingerie; Bodices [lingerie].

Class 35: Marketing; Market canvassing; Market campaigns; Direct marketing; Online marketing; Advertising and marketing services; Online advertising;

Radio advertising; Online advertisements; Newspaper advertising; On-line advertising; Retail services relating to clothing; Retail services in relation to headgear, excluding jewelled or decorative hair or jewelled or decorative head accessories; Retail services in relation to bags, excluding jewellery bags and rolls; none of the aforesaid services in relation to, or in the field of, jewellery.	
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### *Class 18*

61. In *El Corte Ingles SA v OHIM*, Case T-443/05 the GC found that *Clothing, footwear and headgear* in Class 25 were similar to the clothing accessories included in *Leather and imitations of leather, and goods made of those materials and not included in other classes*. I note that in a later case, *Asos plc v OHIM*, Case T-647/11, the GC found that, for example, sports bags and briefcases could not be considered clothing accessories and were not similar to class 25 goods. The principle to be applied was summarised in *Gitana SA v OHIM*, Case T-569/11:

“Moreover, in respect of the relationship between the ‘goods in leather and imitations of leather’ in Class 18 covered by the trade mark sought and the goods in Class 25 covered by the earlier mark, it is apparent also from settled case-law that the ‘goods in leather and imitations of leather’ include clothing accessories such as ‘bags or wallets’ made from that raw material and which, as such, contribute, with clothing and other clothing goods, to the external image (‘look’) of the consumer concerned, that is to say coordination of its various components at the design stage or when they are purchased. Furthermore, the fact that those goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and support the impression that the same undertaking is responsible for the production of those goods. It follows that

some consumers may perceive a close connection between clothing, footwear and headgear in Class 25 and certain 'goods made of these materials [leather and imitations of leather] and not included in other classes' in Class 18 which are clothing accessories. Consequently, clothing, shoes and headgear in Class 25 bear more than a slight degree of similarity to a category of 'goods made of these materials [leather and imitations of leather] and not included in other classes' in Class 18 consisting of clothing accessories made of those materials (see, to that effect, *PiraÑAM diseño original Juan Bolaños*, paragraph 42 above, paragraphs 49 to 51; *exē*, paragraph 42 above, paragraph 32; and *GIORDANO*, paragraph 42 above, paragraphs 25 to 27)."<sup>4</sup>

62. Nevertheless, the underlying principle is the same in that goods in class 18 are similar to 'clothing' to the extent that they may combine to form a 'coordinated look'. The opponent's specification in class 25 includes 'women's clothing'. Bearing in mind the above case law, I find that they are similar to a medium degree to the applicant's class 18 goods.

#### *Class 25*

*Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Hoods [clothing]; Leisure clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Knitwear [clothing]; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing; Layettees [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing; Triathlon clothing; Windproof clothing; Silk clothing; Work clothes; Woolen clothing; Coats; Sheepskin coats; Fur coats; Coats (Top -); Trench coats; Evening coats; Dust coats;*

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<sup>4</sup> Paragraph 45

*Duffle coats; Morning coats; Denim coats; Wind coats; Suit coats; Sport coats; Cotton coats; Pea coats; Rain coats; Frock coats; House coats; Leather coats; Duffel coats; Shoes; Work shoes; Canvas shoes; Women's shoes; Athletic shoes; Training shoes; Flat shoes; Platform shoes; Dress shoes; Running shoes; Walking shoes; Hiking shoes; Rubber shoes; Leisure shoes; Deck shoes; Yoga shoes; Deck-shoes; Rain shoes; Leather shoes; Beach shoes; Tennis shoes; Athletics shoes; Sport shoes; Waterproof shoes; Slip-on shoes; High-heeled shoes; Winter coats; Heavy coats; Coats of denim; Coats for women; Nightwear; Lingerie; Maternity lingerie; Bodices [lingerie].*

63. I find all of the above goods would be identical to the Opponent's class 25 specification either because they appear in both specifications or because they are identical under the *Meric* principles.

*Girls' clothing;*

64. Obviously, there will be an overlap in nature, purpose, trade channels and use for these goods with the opponent's 'women's clothing'. The only way they will differ is that the user of the opponent's goods will be an adult woman and the user of the applicant's goods will be a younger female. I therefore find these goods to be similar to a high degree.

*Class 35*

*Marketing; Market canvassing; Market campaigns; Direct marketing; Online marketing; Advertising and marketing services; Online advertising; Radio advertising; Online advertisements; Newspaper advertising; On-line advertising;*

65. I accept that there might be some overlap of end users of some of these services with the opponent's class 25 goods as some of the services will be directed at the general public who will likely be the purchasers of the opponent's goods. However, this on its own is not enough to find similarity between the goods and services. The use, method of use and nature of the goods and services clearly differ. Nor is there any overlap in trade channel. The fact that a business that sells goods (such as



clothing) may undertake promotion, advertising and marketing in relation to its own goods does not mean there is an overlap in trade channels. The above services in class 35 would be provided by specialist businesses to customers (business users or individuals) looking to obtain those services. I do not consider them to be complementary nor in competition. Consequently, I do not consider there to be any similarity between the goods and services.

*Retail services relating to clothing;*

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

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

67. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM* <sup>5</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM* <sup>6</sup>, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd* <sup>7</sup>, Mr Hobbs concluded that:

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<sup>5</sup> Case C-411/13P

<sup>6</sup> Case T-105/05 at paragraphs [30] to [35] of the judgement

<sup>7</sup> Case C-398/07P

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

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

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

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

68. The opponent's goods contain 'women's clothing' which I find to be complementary to the applicant's 'retail services relating to clothing' because the applicant's term includes retail of goods within the opponent's specification. The goods are indispensable to the retail services relating to them. Additionally, there is an overlap in trade channels through which the goods and services reach the average consumer. I therefore find there to be a low degree of similarity between these goods and services.

*Retail services in relation to headgear, excluding jewelled or decorative hair or jewelled or decorative head accessories; Retail services in relation to bags, excluding jewellery bags and rolls; none of the aforesaid services in relation to, or in the field of, jewellery.*

69. As noted above, in *Waterford Wedgwood Plc*, goods do not have to be the same as the goods being retailed by the services for there to be a finding of similarity. I find

the goods being retailed in these services are likely to be found in the same establishments as the opponent's 'women's clothing' together with which they will form a cohesive look. The same reasoning as paragraph 66 above applies and I therefore find there to be a very low level of similarity between the goods and services at hand.

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

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

71. Therefore, as I have found no similarity for the applicant's 'Marketing; Market canvassing; Market campaigns; Direct marketing; Online marketing; Advertising and marketing services; Online advertising; Radio advertising; Online advertisements; Newspaper advertising; On-line advertising' the opposition fails in relation to them. The opposition will continue in respect of the applicant's class 18 and 25 goods and 'Retail services relating to clothing; Retail services in relation to headgear, excluding jewelled or decorative hair or jewelled or decorative head accessories; Retail services in relation to bags, excluding jewellery bags and rolls; none of the aforesaid services in relation to, or in the field of, jewellery' in Class 35.

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

72. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

73. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

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

74. The average consumer of the goods in classes of 18 and 25 will predominantly be the general public.

75. The selection of such goods is largely a visual process, as the average consumer will wish to physically handle the goods to ensure the correct size has been selected, whilst simultaneously appraising the overall aesthetic impact. If the consumer is buying online then I also note they will see the marks on the websites. I do not, however, ignore the potential for the marks to be spoken, for example, by sales assistants in a retail establishment or when making a purchase from a catalogue, over the telephone. However, in the latter circumstances, the consumer will have had an opportunity to view the goods, perhaps electronically via an online catalogue or website, or on paper in the traditional sense of catalogue shopping. Therefore, when considering the aural impact of the marks, the visual impression of these goods will already have played a part in the consumer’s mind.

76. Although the prices of individual items will vary greatly, I consider that the average consumer will pay at least a medium degree of attention (but not the highest level) during the purchase of the remaining goods.

77. For the remaining class 35 services, I believe the average consumer will be the public at large. Retail services are likely to have been chosen by viewing promotional material (either hard copy, on television or online) and high street signage. The choice

of all of the services at issue will be largely influenced by visual considerations. There is also the possibility of word of mouth recommendations. When selecting the services at issue, the average consumer is likely to consider such things as stock, price of goods offered in comparison to other retailers, delivery method (for online retail) and knowledge of the staff. I therefore believe the average consumer will pay a medium degree of attention during the selection process.

### **Comparison of the marks**

78. 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.”

79. 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.

80. The respective trade marks are shown below:

Earlier Mark	Contested Mark
TRUCCO	TRU COLLECTION

81. The earlier mark is a word mark consisting of one word that appears to be made up. The overall impression lies in the word itself.

82. The contested mark is also a word mark but made up of two words. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of marks tend to have more visual and aural impact than the ends. ‘TRU’ comes first in the mark and also has more conceptual content – I believe the term ‘Collection’ is used throughout the fashion world when a designer brings out a new seasonal line for example or alternatively, will be seen as a group of things brought together per its dictionary definition. I therefore find that ‘TRU’ carries more weight in the overall impression

83. The earlier mark is one word containing six letters. The contested mark is two words, the first with three letters and the second with ten letters. Both marks are word marks and I acknowledge that this means both marks can be presented in different fonts, upper and lower cases and sizing.<sup>8</sup> The marks share the beginning four letters ‘TRUC’ albeit there is a space between the ‘U’ and ‘C’ in the contested mark. The contested mark contains a further eight letters not included within the earlier mark (‘LLECTION’) and the earlier mark contains an additional ‘C’. I therefore find the marks to be visually similar to at least a medium (but not the highest) degree.

84. For the earlier mark, I consider that there are two possible ways of pronouncing it. Firstly, would be *truh/koh* and the second would be *troo/koh*. Both would be two

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<sup>8</sup> *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14

syllables. I believe a significant proportion of the average consumer will use the first pronunciation however, I do not discount the second pronunciation. For the contested mark, I believe that 'TRU' will be pronounced *troo* and 'COLLECTION' will be given its ordinary everyday pronunciation. This will total four syllables. For the first pronunciation of the earlier mark, I believe the main overlap will be the beginning 'tr' sound with the 'co' sound shortly after, however the contested mark is double the amount of syllables and has very different endings. Therefore, in this instance I find them to be aurally similar to a low degree. In the event the average consumer pronounces the earlier mark as *troo/koh* then I consider the first syllables to be identical together with the 'co' sounds afterwards. However, there are still two further syllables that have no equivalent in the earlier mark and I therefore find them to be similar to a medium degree.

85. Conceptually, the earlier mark will, in my view, have no particular meaning for the average consumer. It might be viewed as an invented term or perhaps a foreign language word. Regarding the contested mark, I believe the average consumer will consider 'TRU' to be a misspelling of the word 'true' meaning something that is accurate or reliable.<sup>9</sup> 'Collection' will also be given its ordinary dictionary definition of a group of things, or particularly in relation to fashion, a designer's new clothes for the next season.<sup>10</sup> I therefore consider the conceptual meanings are clearly different and I find them to be conceptually dissimilar.

### **Distinctive Character of the Earlier Marks**

86. 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

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<sup>9</sup> <https://www.collinsdictionary.com/dictionary/english/true>

<sup>10</sup> <https://www.collinsdictionary.com/dictionary/english/collection>

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).”

87. The opponent has submitted evidence regarding use of its mark and I will review this to see whether this evidence shows that use of the mark can be said to have enhanced the distinctiveness of the earlier mark.

88. In order to do this, first I must consider the level of inherent distinctiveness the earlier mark has. For the most part, words that are descriptive or allusive of the character of the goods and services provided are on the lower end of the scale of distinctiveness whereas invented terms are likely to attract the highest level of distinctiveness.

89. For those who would view it as a possible foreign language term then I find the distinctive character to be an above average degree. For those consumers who believe it to be an invented term, it would be distinctive to a high degree.

90. The opponent did provide sales figures and example invoices as detailed above however, all the invoices are for EU countries and not within the UK and I can see no evidence of any sales within the UK itself. Given this, I do not believe that they have



shown enhanced distinctiveness in the UK market and therefore the distinctive character of the earlier mark remains at its inherent level.

### **Likelihood of Confusion**

91. There are two types of confusion that I must consider. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

92. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C. (as he then was), as the Appointed Person, explained that:

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

93. I have come to the conclusions above that the marks at issue are visually similar to at least a medium (but not the highest) degree; aurally similar to either a low or medium degree; and conceptually dissimilar and the average consumer would pay between a medium and at least a medium degree of attention. The remaining goods and services at issue have been found to be between identical and similar to a low degree. The earlier mark is inherently distinctive to either an above average or high

degree. I found the overall impression of the earlier mark was in the word itself and for the contested mark I found that the word 'TRU' carried a greater weight.

94. I note the beginning four letters of the marks are identical however in *CureVac GmbH v OHIM*, T-80/08 it was determined that this was not always a decisive matter in the finding of a likelihood of confusion. I actually consider that the differences in the concepts of the mark to be the most important element here. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

95. I find that the marks at issue have such different conceptual meanings that this will counteract any visual similarities that the marks may have, on top of the fact I have found the ends of the marks to be very different. Even where the goods are identical, I believe that the average consumer will recall the differences, in particular noting the conceptual differences and therefore I find there to be no direct confusion.

96. I will now go on to consider the possibility of indirect confusion. Again, I take guidance from Mr Purvis in *L.A. Sugar Limited* where he stated:

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

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

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

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

97. These examples are not exhaustive but provide helpful focus as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

“This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.”<sup>11</sup>

98. Turning to the above categories; firstly, the shared elements between the marks are the letters ‘TRU’ and ‘CO’ which are common letters and cannot be said to be strikingly distinctive.

99. Secondly, there is a difference in spelling between the marks, which also affects the meaning/concept of each mark when considering the terms. The earlier mark would not necessarily convey any meaning to the average UK consumer whereas the contested mark contains the meaning of truth and a group of items. I therefore do not believe that the contested marks will be considered a sub brand of the earlier brand, or vice-versa

100. The change of spelling in the marks and differing elements would not be an obvious or logical brand extension in my opinion. I do not consider this to be a step

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<sup>11</sup> Paragraph 12

that the average consumer of the goods at issue would reasonably expect a business to take.

101. Whilst the categories set out above by Mr Purvis are not exhaustive, I can find no other reason why the average consumer would, when exposed to the contested marks, assume that the goods and services at issue came from the same or an economically linked undertaking, or vice-versa.

102. I therefore find that there would be no indirect confusion between the marks.

## **Conclusion**

103. The opposition fails in its entirety.

## **Costs**

104. The applicant has been successful and is entitled to a contribution towards its costs.

105. Award of costs are based upon the scale as set out in Tribunal Practice Notice 2 of 2016. The award of costs in this matter has been calculated as follows:

Considering the Notice of Opposition	£350
And preparing Counter Statement	
Considering the other side's evidence	£500
Preparing submissions in lieu of a hearing	£350

106. I therefore order THE CLIFF NEWCO LIMITED to pay LHR Holding Ltd the sum of £1200. 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 14<sup>th</sup> day of December 2022**

**L Nicholas  
For the Registrar**