

**O-1120-22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3600633  
BY HALIL OZDEMIR IN RESPECT OF THE TRADE MARK**

goddessglam

**IN CLASS 25**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 425759 BY  
EVEDEN INC.**

## **Background and pleadings**

1. Halil Ozdemir (“the applicant”) applied to register the trade mark:

goddessglam

in the UK on 25 February 2021. It is applied for in classes 3 and 25. It was accepted and published in the Trade Marks Journal on 23 April 2021. The Class 25 goods are:

**Class 25:** *Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing]; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Knitwear [clothing]; Cloth bibs; Cyclists' clothing; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Furs [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Ties [clothing]; Outer clothing; Cashmere clothing; Bandeaux [clothing]; Women's clothing; Bodies [clothing]; Embroidered clothing; Layettes [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Thermal clothing; Belts [clothing]; Muffs [clothing]; Capes (clothing); Motorists' clothing; Boas [clothing]; Slips [clothing]; Veils [clothing]; Wraps [clothing]; Athletic clothing.*

2. Eveden Inc. (“the opponent”) opposes the application, insofar as it covers Class 25, on the basis of section 5(2)(b), section 5(3) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The section 5(2)(b) and section 5(3) grounds are on the basis of its earlier UK registration no. 3172514 in respect of the mark “GODDESS”. The following goods are relied upon:

**Class 25:** *Articles of clothing; articles of outer clothing; sportswear and leisurewear; casual wear; headgear; none of the aforesaid being t-shirts,*

*sweatshirts or baseball caps; articles of underclothing; footwear; swimwear; beachwear; corsetry; articles of lingerie; ladies' underwear; corsets; girdles; brassieres; ladies' foundation wear; hosiery; vests, knickers, petticoats; nightdresses; pyjamas and housecoats; articles of knitted outerclothing; bathing suits; stockings and pantihose; bath robes.*

3. In respect of the section 5(2)(b) ground, the opponent asserts that the respective goods are identical or similar and that the applicant's mark contains the entirety of the opponent's marks. It asserts that where the respective goods are identical, similar or complementary there would be customer confusion.

4. In respect of the section 5(3) ground, the opponent challenges only the Class 25 goods of the contested mark. It asserts that it has a reputation in relation to *Underclothing, lingerie and sports bras*. These exact terms are not listed in the opponent's specification, and I take it as a claim to a reputation in respect of the terms *articles of underclothing, articles of lingerie* (both of which will also include *sports bras*) that are listed. The opponent also claims that:

- The respective marks are confusingly similar and that the relevant public would believe there is an economic link between the respective trade mark owners;
- Use of the contested mark would take unfair advantage of the reputation of its mark because it would benefit from the promotion and reputation of the opponent's mark without expending any time, money and effort;
- Use of the contested mark will result in detriment to the opponent's mark because the opponent's reputation is for high quality, sophisticated products with a reputation for reliability. The applicant may try to bring inferior goods to market and this would cause reputational and economic damage to the opponent.

5. In respect of the section 5(4)(a) ground the opponent claims a goodwill since as early as 1990 throughout the UK in respect of *lingerie, hosiery, underwear and sports bras*. This goodwill is identified by the sign "GODDESS". The opponent contends that use of the applicant's mark would be a misrepresentation likely to damage the opponent's reputation and goodwill and cause customer confusion.

6. The applicant filed a counterstatement denying the claims made. It points to the fact that there are “countless trademark registrations with the UK IPO that is including and starting with ‘GODDESS’ word in the same classes...”.

7. The opponent filed evidence and the applicant provided three official documents from the Turkish trade mark office. These are not provided under cover of a witness statement. Unofficial translations are provided in respect of two of these. The opponent provided submissions in reply. These filings will be referred to as and where appropriate during this decision.

8. A Hearing took place on 24 November 2022, with the opponent represented by Mr Harry Rowe of Mathys & Squire LLP and the applicant represented himself.

9. 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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

### **Evidence**

10. The opponent’s evidence takes the form of the witness statement of Vaughan Waylett, Finance Director of the opponent together with Exhibits VW01 – VW10. The last of these exhibits is covered by a confidentiality order. The purpose of Mr Waylett’s evidence is to provide information regarding the scale and scope of the opponent activities under the mark “GODDESS” with the aim of illustrating that the opponent has the requisite goodwill and that its mark benefits from an enhanced level of distinctive character and from a reputation in the UK.

11. Mr Ozdemir filed documents from the Turkish Trade Mark Office, but they were not provided in a sworn format. He was given an opportunity to provide them under cover of a witness statement, but he declined to do so. I will discuss this in more detail later.

## **Decision**

### **SECTION 5(2)(b)**

12. 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”.

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings 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

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

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

15. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case,<sup>1</sup> 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.

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<sup>1</sup> [1996] R.P.C. 281

16. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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”.

17. The opponent’s specification in this class contains the broad terms *Articles of clothing*. This term covers all the goods included in the applicant’s specification and, therefore, when applying the guidance in *Merici*, the respective goods must be considered as identical.

### **Comparison of marks**

18. 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.”



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

20. The respective marks are shown below:

<b>Earlier trade mark</b>	<b>Contested trade mark</b>
GODDESS	goddessglam

21. The earlier mark consists of the single word “GODDESS” and its distinctive character obviously resides in this one and only element. The applicant’s mark consists of the two elements “goddess” and “glam” conjoined and in a specific but unremarkable font. These words will retain their own identity and character within the mark despite being conjoined because the word “goddess” is an easily identifiable word and “glam” is an easily and readily understood abbreviation meaning “glamorous”.<sup>2</sup> These two elements will be easily perceived and will create a natural break in the mark. They are both distinct elements but, by virtue of being at the start of the mark and being nearly twice as long as the abbreviation “glam”, the word “goddess” is the dominant and distinctive element.

22. In respect of visual similarity, the opponent submits that the consumer attaches greater importance to the beginning of a word mark than the end.<sup>3</sup> I agree that this is the case when considering the applicant’s mark, as I discussed above. Therefore, I agree with the submission the consumer will be drawn to the “goddess” part of the applicant’s mark. In light of all of this, I conclude that the respective marks share a medium to high level of visual similarity.

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<sup>2</sup> [glam, n.2 and adj. : Oxford English Dictionary \(oed.com\)](https://www.oed.com)

<sup>3</sup> as per Case T-133/05 *Merit v OHIM – Arbora & Ausonia* (PAM-PIM'S BABY-PROP) [2006] ECR II-2737, para 51, and Case T-472/08 *Companhia Muller de Bebidas v OHIM – Missiato Industria e Comercio (61 A NOSSA ALEGRIA)* [2010] ECR II-0000, para 62, relied upon by the opponent

23. Aurally, the opponent's mark consists of the two syllables GOD-DESS. The applicant's mark consists of the three syllables GOD-DESS-GLAM. They therefore share the same first two syllables and differ in that the third syllable is absent from the opponent's mark. I conclude that the similarities and differences result in the respective marks sharing a medium to high level of aural similarity.

24. Conceptually, Mr Rowe pointed to the meaning of "goddess" as being "a female divinity" and/or "a woman who is adored or idealized". He did not identify the source of these meanings, but I note that these definitions appear in the Oxford English Dictionary.<sup>4</sup> Mr Rowe also submitted that the additional concept of "glamour" evoked by the "glam" element of the applicant's mark complements/qualifies the idea of "goddess" without changing its meaning. It is true that the opponent's mark is likely to be perceived as a reference to a woman who is adored, whereas the concept of the applicant's mark is likely to be perceived as being that of a glamorous adored woman. Mr Rowe submitted that the overall concepts are only slightly different. I accept that the "glam" element acts in an adjectival way upon the word "goddess" and that despite the addition of this element to the applicant's mark, they still share a high level of conceptual similarity.

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

25. 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*.

26. 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:

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<sup>4</sup> [goddess, n. : Oxford English Dictionary \(oed.com\)](https://www.oed.com)

“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.”

27. Mr Rowe submitted that the average consumer for the goods at issue are members of the general public. He referred to “fast fashion” and the goods that fall into this category are sold at a low price point and he submitted that the level of care and attention is no more than average. I accept that clothing is sold across a broad range of price points, including a low price point, but I keep in mind that clothing is a regular but not an everyday purchase and there is some care and attention regardless of price because clothes are normally purchased with both aesthetics and function in mind and, because of this, I conclude that the level of care and attention will be average. With aesthetics in the mind of the consumer, the purchasing process is likely to be visual in nature, but I do not ignore the fact that aural aspects may play a role in circumstances where the consumer seeks advice or information from a sales assistant or where the consumer is exposed to aural promotion such as radio advertisements.

### **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-0000, paragraph 49).

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

29. The opponent’s mark consists of the single word “GODDESS” that is a widely understood and ordinary dictionary word. Consequently, it is not of the highest level of distinctive character unlike, for example, an invented word. Further, the word is also a vague allusion to the wearer of the opponent’s goods being adored or idealised. Taking all of this into account, I conclude that the mark is endowed with no more than a medium level of inherent distinctive character.

30. The opponent also claims that its mark benefits from an enhanced level of distinctive character in respect of a wide range of clothing products because it has been used in the UK for a number of years. It provides the following relevant evidence:

- The opponent is a manufacturing company with a focus on women’s lingerie and swimwear. These are marketed under a variety of brands, one of which is “GODDESS” that has been used continuously in the UK since 2002;<sup>5</sup>
- Extracts from the opponent’s website [www.goddessbra.com](http://www.goddessbra.com), obtained on 18 November 2019, is provided showing numerous photographs of bras under the heading “Goddess”;<sup>6</sup>

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<sup>5</sup> Mr Waylett’s witness statement, para 4

<sup>6</sup> Exhibit VW02

- This website is accessed by customers around the world “including a significant number of UK visitors”. The number of sessions originating from the UK are provided for the years 2014 to 2021 and range between 3,867 to 6,783 before jumping to 13,561 in 2020 and to 27,235 in 2021;<sup>7</sup>
- The mark has been communicated “perpetually” to consumers via its website and the websites of varied distributors that offer “GODDESS” goods in the UK.<sup>8</sup> Extracts from UK distributors’ websites are shown advertising “Goddess” goods, namely, from:
  - www.boobydoo.co.uk dated 23 March 2017, and showing bras,
  - www.affairlingerie.com also dated 23 March 2017, showing bras, some priced in pounds
  - www.amplebosom.com, dated 27 March 2015 and 4 April 2019, showing briefs and bras priced in pounds,
  - www.simplybe.co.uk, dated 14 July 2016 and 5 November 2017, showing bras and briefs priced in pounds;
- the opponent commissions the production and distribution of product brochures for the “GODDESS” brand i.e. for the Spring/Summer and Autumn/Winter each year.<sup>9</sup> Example brochures are provided from the years 2015 – 2019.<sup>10</sup> These are described as a “Goddess Trade Workbook” on the front cover and are in English but are clearly produced with worldwide use in mind because they contain a list of contact addresses around the world;
- An exhibit<sup>11</sup> subject to a confidentiality order is provided in relation to these “brochures” but as they are for worldwide use, they are of no relevance in assessing their impact in the UK;
- Copies of press releases relating to bras and briefs are provided from 2016 – 2019.<sup>12</sup> To what extent these were targeted at the UK consumer is unknown. I note that the contact email address, where provided, is [press@wacoal-europe.com](mailto:press@wacoal-europe.com). The brochures referred to above identify Wacoal Europe as a French based company and is listed in addition to the UK located distributor

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<sup>7</sup> Mr Waylett’s witness statement, para 7

<sup>8</sup> Ibid, para 9 and Exhibit VW03

<sup>9</sup> Ibid, para 11

<sup>10</sup> Exhibit VW04

<sup>11</sup> Exhibit VW05

<sup>12</sup> Exhibit VW06

Wacoal EMEA Ltd.<sup>13</sup> This is also reinforced by an article in the online version of Underlines Magazine,<sup>14</sup> dated 25 January 2017, that reports that Wacoal Europe has launched a new B2B website in English (but presumably not targeted at only the UK market);

- The “Goddess” brand is also promoted to the UK consumer via trade shows such as the INDX Intimate Apparel road show and the Harrogate road show (24 February 2017);<sup>15</sup>
- The “Goddess” brand has featured in a number of well-known publications such as the Financial Times and Underlines magazine (that describes itself as “[t]he priority business publication for intimate apparel, beachwear, hosiery, bodywear and textiles”).<sup>16</sup> These articles are provided.<sup>17</sup> The Financial Times article is entitled “A tale from Japan of secret pacts and high-end lingerie”, dated 31 January 2019, and mentions the Japanese arm of Wacoal and the fact that it controls a large number of global lingerie brands including “Goddess”;
- The following sales figures for “GODDESS” branded garments sold in the UK between 2014 are provided:<sup>18</sup>

<b>Year</b>	<b>Sales (GBP)</b>
2014	399,900
2015	366,274
2016	307,998
2017	425,302
2018	432,940
2019	335,267
2020	297,003
2021	294,179
<b>TOTAL</b>	<b>1,932,414</b>

<sup>13</sup> Exhibit VW04

<sup>14</sup> Pages 198 – 200 of Exhibit VW07

<sup>15</sup> Mr Waylett’s witness statement, paa15 and Exhibit VW07

<sup>16</sup> Exhibit VW12

<sup>17</sup> Exhibit VW07

<sup>18</sup> Exhibit VW08

- Example invoices from the period June 2014 to January 2021 are provided<sup>19</sup> and illustrate that at least seven businesses were invoiced for bras that appear to be identified by brands shown elsewhere in the evidence as being sub-brands for specific styles of bras sold under the “GODDESS” brand. Exhibit VW10 is covered by a confidentiality order and illustrates sales data for these specific “GODDESS” products.

31. Taking all of this evidence into account, there have been UK sales of a little over £1.6 million between 2014 and the relevant date in these proceedings (25 February 2021). Mr Rowe submitted that the evidence demonstrates that the opponent’s mark benefits from an enhanced level of distinctive character. Whilst this level of sales is not insignificant, it is nonetheless low when placed in context of the UK clothing market or the UK lingerie market. This combined with the inability of parts of the evidence to accurately reflect the scale of promotion in the UK leads me to conclude that the use is insufficient to result in any enhanced level of distinctive character. If I am wrong in concluding the use in this way, any enhanced distinctive character would be such as to not have any material impact upon my considerations regarding the likelihood of confusion.

### **Global Assessment – Conclusions on Likelihood of Confusion**

32. There is no simple formula for determining whether there is a likelihood of confusion. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective services and vice versa (*Canon* at [17]). In making my assessment, I must consider the various factors from the perspective of the average consumer, bearing in mind 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 (*Lloyd Schuhfabrik* at [26]).

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<sup>19</sup> Exhibit VW09

33. In the current case, I have found that:

- The respective goods are identical;
- “GODDESS” is the only element of the opponent’s mark and, therefore, the dominant and distinctive element. “Goddess” is the dominant element of the applicant’s mark;
- The respective marks share a medium to high level of visual and aural similarity and a high level of conceptual similarity;
- The average consumer is a member of the general public who will pay an average degree of care and attention during the purchasing act. This will be visual in nature, but I do not ignore that aural considerations may play a part;
- The opponent’s mark is endowed with a medium level of inherent distinctive character that is not enhanced through use but if I am wrong any enhancement is not material to my finding.

34. These conclusions all point in the direction of a likelihood of confusion. Mr Rowe claimed that the word “goddess” dominates the applicant’s mark because the word “glam” is low in distinctive character. Mr Ozdemir submitted that both words “goddess” and “glam” are not “privately invented brand word[s]” such as NIKE, ADIDAS and GUCCI and that they are “anonymous and commonly used words”. I understand these comments to be drawing attention to “goddess” and “glam” being ordinary, easily understood words that are free for all to use and that he should not be stopped from using them because of this. It is not only invented words such as ADIDAS or KODAK that are entitled to trade mark protection. Ordinary dictionary words are also entitled to protection provided that they do not designate a quality of the goods or services or are in some other way lacking in distinctive character. In the current case, the word “GODDESS” may allude to the wearer of the parties’ goods, but it does not designate a characteristic of the goods, nor is it otherwise non-distinctive. Further, the registration of a mark is *prima facie* evidence of validity<sup>20</sup> and, consequently, the opponent’s mark must be considered to be validly registered and, therefore, entitled to protection. In conclusion, I reject the applicant’s submission.

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<sup>20</sup> See section 72 of the Act



35. The applicant also relied upon the fact that the UK register includes numerous marks that consist of, or contain, the word “Goddess” in the same classes. I note these but I keep in mind the comments in *Zero Industry Srl v OHIM*, Case T-400/06, where the General Court (“the GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71). “

36. As Mr Rowe submitted at the hearing, it is not known on what basis the “Goddess” marks exist on the register. Taking account of the guidance of the court, I agree with Mr Rowe and find that the existence of other “Goddess” marks on the UK register does not advance the applicant’s defence.

37. I also comment briefly on the applicant’s reliance upon a number of documents from the Turkish trade mark office. These are not admissible because they were not provided under cover of a witness statement, and neither were they accompanied by an independent translation (but I note that informal translations were provided for a couple of these documents). Even if these documents were acceptable evidence, they would have had no bearing on the outcome of these proceedings. They relate to proceedings before the Turkish office that, Mr Ozdemir informed me, are still under appeal. They are irrelevant for the following reasons: (i) they relate to a relative grounds dispute involving the applicant’s mark and the mark “GLAM”, so the

considerations are different to the current case; (ii) the decision will have been considered from the perspective of the Turkish consumer and not, as in the current case, the UK consumer; (iii) the Turkish proceedings have not been finally determined being subject to a yet, undecided appeal. I need say no more on this.

38. As I set out in the preceding paragraphs, none of the applicant's submissions are persuasive and I am left to decide the ground by undertaking the standard global analysis. In this respect, Mr Rowe submitted that marks are read from left to right and the reader is drawn to the "goddess" element of the applicant's mark. The GC<sup>21</sup> has recognised that, as a general rule, the consumer normally attaches more importance to the first part of words. I consider that this is the case here, with the word "goddess" being easily identifiable in the applicant's mark and, as Mr Rowe submitted, the word "glam" compliments the first element as they both allude to the appearance of the wearer of the goods. Keeping this in mind, together with my findings identified at paragraph 34, above, and in particular that the respective goods are identical, I have little hesitation in concluding that, when factoring in imperfect recollection, there is a likelihood of direct confusion. In these circumstances, one mark is likely to be misremembered for the other.

39. I also consider the likelihood of indirect confusion in circumstances where the addition of the word "glam" will be noticed by the consumer. In *L.A. Sugar Limited v By 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

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<sup>21</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paras 81 - 83

earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example)”.

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

goddessglam

## **SECTION 5(4)(a)**

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

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

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

43. Subsection (4A) of Section 5 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.”

44. At the hearing, I pressed Mr Rowe to explain how the opponent believed this ground placed it in a better position than its case based upon section 5(2)(b). He explained that it would place the opponent in a better position in circumstances where the level of similarity between the respective goods was lower. I assume this was based on the possibility that in circumstances where I were to find a lower level of similarity, I may go on to conclude that, as a result, there would be no likelihood of confusion. However, it is self-evident that the respective goods relevant to my section 5(2)(b) considerations were identical. Therefore, the circumstances do not exist for the opponent to need to rely upon the section 5(4)(a) ground.

45. Therefore, I will comment only briefly on the merits of this ground. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires “a substantial number of members of the public are deceived” rather than whether the “average consumer are confused”, but I also take account of the comments of Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501. He commented that it is doubtful whether the difference between the legal tests will produce different outcomes.

46. The relevant date for the purposes of assessing whether section 5(4)(a) applies is always the application date of the contested mark<sup>22</sup>, in this case, 25 February 2021, being the same relevant date as for the section 5(2)(b) ground. There is no counter claim that the applicant has used its mark, so this is the only relevant date.

47. In the current case, having considered the evidence carefully, I find that the opponent has demonstrated the requisite goodwill but only in respect of *lingerie, underwear and sports bras*. This is despite the use being insufficient to result in an enhanced level of distinctive character of the opponent’s mark. Passing off does not protect goodwill of trivial extent,<sup>23</sup> but can protect signs even though the goodwill is small.<sup>24</sup> In the current case, the level of sales is higher than that considered in the *Lumos* case and there has been repeat sales over a period of at least six years. I conclude that such use is sufficient to clear the lower hurdle for demonstrating goodwill than is required for demonstrating enhanced level of distinctive character and explains the difference in these findings.

48. The scope of goodwill is a much narrower than the scope of services that the opponent was entitled to rely upon for the purposes of section 5(2)(b) and, therefore, limits the potential to achieve the same level of success. It is self-evident that the applicant’s *Clothing; Clothes; ...; Sports clothing; Leather clothing; ... Girls' clothing; ... Cashmere clothing; ... Women's clothing; Bodies [clothing]; Embroidered clothing; ... Maternity clothing; Thermal clothing; ... Slips [clothing]; ... Athletic clothing* are

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<sup>22</sup> *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, para 43

<sup>23</sup> See *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. at para 62

<sup>24</sup> *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590

broad terms that include *lingerie*, *underwear* and/or *sports bras*. Further, the applicant's *combinations [clothing]* could be combinations of *lingerie* being goods that the opponent's goodwill is attached. Consequently, in respect of all these terms, there would be misrepresentation for the same reasons that I have found a likelihood of confusion under section 5(2)(b).

49. All of the applicant's remaining goods, namely, ...; *Wristbands [clothing]*; *Tops [clothing]*; *Knitted clothing*; *Oilskins [clothing]*; *Motorcyclists' clothing*; *Hoods [clothing]*; *Leisure clothing*; *Infant clothing*; *Children's clothing*; *Childrens' clothing*; ...; *Gloves [clothing]*; *Waterproof clothing*; *Plush clothing*; ...; *Swaddling clothes*; *Knitwear [clothing]*; *Cloth bibs*; *Cyclists' clothing*; *Playsuits [clothing]*; *Slipovers [clothing]*; *Jerseys [clothing]*; *Weatherproof clothing*; *Casual clothing*; *Denims [clothing]*; ...; *Furs [clothing]*; *Shorts [clothing]*; *Collars [clothing]*; *Babies' clothing*; *Ties [clothing]*; *Outer clothing*; ...; *Bandeaux [clothing]*; ...; *Layettes [clothing]*; *Jackets [clothing]*; *Kerchiefs [clothing]*; *Chaps (clothing)*; ...; *Belts [clothing]*; *Muffs [clothing]*; *Capes (clothing)*; *Motorists' clothing*; *Boas [clothing]*; ...; *Veils [clothing]*; *Wraps [clothing]* are not, or do not include the goods relied upon by the opponent. However, clothing manufacturers will often provide a broad range of clothing and the consumer is familiar with seeing a brand being used across these broad ranges. Consequently, the respective goods will share trade channels and where the consumer encounters the applicant's mark in use, he/she is likely to be deceived and believe that they are provided by the same or linked undertaking the goods of the opponent. Whilst there was potential to achieve a lower level of success compared to the section 5(2)(b) ground, I conclude that such a misrepresentation will lead to damage to the opponent's business by attracting trade away from it.

50. In summary, the ground based upon section 5(4)(a) is also successful.

### **SECTION 5(3)**

51. Section 5(3) states:

“(3) A trade mark which-

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

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

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

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



53. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the types of damage claimed will occur and/or that the contested mark will, without due cause, take unfair advantage of the reputation and/or distinctive character of the reputed mark. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

54. The relevant date for the assessment under section 5(3) is the date of the application i.e. 25 February 2021.

## **Reputation**

55. The authoritative statement as to what is required to demonstrate reputation comes from the CJEU in the *General Motors* case<sup>5</sup> where the court 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."

56. In *Burgerista Operations GmbH v Burgista Bros Limited*,<sup>25</sup> Judge Hacon stated that "*Reputation constitutes a knowledge threshold.*" The nature of the reputation may bring with it other qualities and values, but in the first instance it is simply a question of how many of the potential consumers of the goods/services covered by the earlier mark know about it.

57. I have found that the opponent's use of its mark is insufficient to find that the mark benefits from an enhanced distinctive character for the purposes of section 5(2)(b). There are different considerations when assessing reputation. Reputation is simply a knowledge threshold whereas distinctive character is a measure of how strongly the mark identifies the goods of a single undertaking. In order for the mark to strongly identify the goods of a particular undertaking to a significant part of the public, it must first be known by at least that section of the public. Therefore, it should be easier to demonstrate a reputation than it is to show that a mark has acquired an enhanced level of distinctiveness through use.

58. Having identified this, I must consider whether the opponent's mark has a reputation and is known by a significant part of the public concerned by its *lingerie*, *underwear* and *sports bras*. The evidence I summarised at paragraph 31, above, is relevant here. The opponent has £1.6 million turnover in the UK across the seven complete years up to the year before the relevant date. This is an average of just under £230,000 a year. This clearly shows reasonably long-standing use in the UK, but mere use does not equate to a reputation. To approach it in such way would mean that every mark that has been used would also be found to have a reputation. This is not the purpose of section 5(3), that exists to provide a level of enhanced protection to marks

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<sup>25</sup> [2018] EWHC (IPEC)

with a reputation. In this case, taking account of the self-evidently huge size of the lingerie market in the UK, such turnover is very small.

59. When looking at the promotion of the goods under the mark, whilst the brochures and press releases provided are in the English language, they are clearly international in nature and appear to be produced for use across the opponent's various markets around the world. Consequently, it is not possible to say, with any certainty, what level of impact these promotional materials have had upon the UK consumer.

60. The opponent also relies upon a mention in a Financial Times article and a number of articles from the trade magazine "Underlines". Whilst I recognise the large reach of a publication such as the Financial Times, it is one article about business affairs in Japan that makes a passing reference to the opponent's mark. Such an article, even appearing in the Financial Times will have a negligible impact upon its reputation in the UK. The articles in "Underlines" magazine will have assisted to the same extent in raising the profile of the mark to the trade in the UK and I keep this in mind.

61. Finally, the opponent relies on the fact that its website receives visits from the UK. As I noted earlier, these visits ranged between 3,867 to 6,783 for the years 2014 to 2021 before jumping to 13,561 in 2020 and to 27,235 in 2021. Most of 2021 was after the relevant date in these proceedings and it is not possible for me to establish what proportion of the 2021 figure relates to the period prior to the relevant date.

62. Taking all of this into account, there has clearly been use in the UK, but this has been modest in nature, and I find that this use is insufficient to generate the necessary reputation for the purposes of section 5(3) of the Act. Consequently, the ground based upon section 5(3) fails.

63. I point out that the hurdle to be cleared, in order to demonstrate reputation for the purposes of section 5(3), is higher than it is for demonstrating goodwill for the purposes of section 5(4)(a), where a small goodwill is sufficient. This is why the opponent has achieved a different outcome under section 5(3) than it has under section 5(4)(a).

64. If I am wrong on finding that the opponent's mark does not have the requisite reputation, success under this ground could have been no better than already achieved in respect of its section 5(2)(b) ground.

## **SUMMARY**

65. The opposition has been successful in respect of the grounds based upon section 5(2)(b) and section 5(4)(a) of the Act and the Class 25 specification is removed from the contested application. It will, therefore, proceed to registration in respect of Class 3 only.

66. The ground based upon section 5(3) fails.

## **COSTS**

67. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1150 as a contribution towards the cost of the proceedings. I make no award in respect of the preparing and filing of evidence because this did not advance the opponent's case. The evidence failed to support the claim of an enhanced level of distinctive character under section 5(2)(b), nor reputation under section 5(3). It did demonstrate that the opponent benefits from goodwill in the UK for the purposes of section 5(4)(a) but this ground was superfluous to the opponent's case and it did not advance the opponent's case over and above its case under section 5(2)(b).

68. With the above comments in mind, I calculate the award as follows:

Official fee:	£200
Preparing and filing Form TM7 and considering the counterstatement:	£450
Preparing for, and attending the hearing:	£500
<b>Total:</b>	<b>£1150</b>

69. I therefore order Halil Ozdemir to pay Eveden Inc. the sum of £1150. 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 19<sup>th</sup> day of December 2022**

**Mark Bryant**  
**For the Registrar**