

O/1138/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003675784

BY ANITA KRISTOF

TO REGISTER:

D&J
DOG & JACKET®

AS A TRADE MARK IN CLASS 18

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 428258 BY

DOLCE & GABBANA TRADEMARKS S.R.L.

BACKGROUND AND PLEADINGS

1. On 1 August 2021, Anita Kristof (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods:

Class 18: Pet clothing; Pets (Clothing for -); Clothing for pets; Clothing for domestic pets.

2. The applicant’s mark was published for opposition purposes on 17 September 2021 and, on 17 November 2021, it was opposed by Dolce & Gabbana Trademarks S.R.L. (“the opponent”). The opposition is based on sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”).
3. In respect of the 5(2)(b) and 5(3) grounds, the opponent relies on the following registrations:



(Series of two)

UK registration no: 2043278

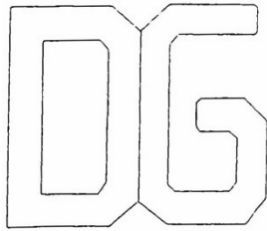
Filing date 2 November 1995; registration date 1 November 1996

(“the opponent’s first registration”);

D&G

UK registration no: 900452359¹

Filing date 10 September 1996; registration date 22 February 1999
("the opponent's second registration"); and



International Registration designating the UK: 845608

International registration date 10 February 2005; date protection granted in the UK
24 March 2006

Priority date 19 October 2004

("the opponent's third registration").

4. The goods that the opponent relies on under these grounds are set out in the **Annex** to this decision. Under its 5(2)(b) ground, the opponent relies only on those goods that are underlined. As for its 5(3) ground, the opponent relies on all of the goods contained in the Annex, being all of the goods in its first and second marks but only some of the goods in its third.
5. Under its 5(2)(b) ground, the opponent pleads that in consideration of the degree of similarity of the marks and the similarity of the goods at issue, there is a high likelihood of confusion or association between the marks at issue.
6. In respect of the 5(3) ground, I have set out above that the opponent has claimed that its first and second registrations enjoy a reputation for all of the goods for which

¹ The trade mark relied upon by the opponent is a comparable trade mark. It is based on the opponent's earlier EUTM, being registration number 0452359. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM.

they are registered. This is confirmed by virtue of the opponent selecting ‘all goods and services’ at question one of section B of its notice of opposition. However, its statement of grounds contradict this as it goes on to claim that its registrations have acquired a reputation in the UK in relation to clothing, leather goods and fashion accessories. This does not, in my view, cover all of the goods contained in those registrations’ specifications. I will address this point later in this decision. Under this ground, the opponent claims that as a result of the reputation of its registrations, use of the applicant’s mark would, without due cause, take unfair advantage of the distinctive character and repute of those registrations and be detrimental to the distinctive character and/or reputation of the same.

7. Turning to the opponent’s 5(4)(a) ground, it relies on the following signs:

DG

(“the opponent’s first sign”);



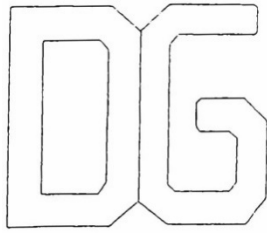
(“the opponents second sign”);

DOLCE & GABBANA

(“the opponent’s third sign”);



(“the opponent’s fourth sign”); and



("the opponent's fifth sign").

8. The opponent claims that it has been using the above signs throughout the UK since at least 1996 in respect of "clothing and leather goods". As a result of this use, the opponent claims to be the owner of goodwill and in light of the fact that the marks at issue are highly similar and the goods are similar, use of the applicant's mark would constitute a misrepresentation to consumers as to the commercial origin of the goods in question which would result in damage caused to the opponent.
9. Lastly, I turn to the opponent's 3(6) ground. The opponent claims that the applicant was, as at the time of filing her application, aware of the long-standing use of the opponent's registrations on a global scale. As a result, the opponent contends that the application was made with the aim of taking advantage of the goodwill and high reputation enjoyed by the opponent in its marks and signs. The opponent goes on to state that it believes that the applicant has not acted according to the standards of fair commercial practices and, therefore, believes that the application was filed in bad faith.
10. The applicant filed a counterstatement denying that the marks at issue and the parties' goods are similar. I note that the counterstatement made no reference to the opponent's 3(6) ground.
11. The opponent is represented by Marks & Clerk LLP and the applicant is unrepresented. Only the opponent filed evidence in chief. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

12. 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

13. As above, only the opponent filed evidence. The opponent's evidence in chief came in the form of the witness statement of Alfonso Dolce dated 30 May 2022. Mr Dolce is the Chairman of the Board of Directors of the opponent and has held this position since its establishment. His statement is accompanied by 17 exhibits, being those labelled Exhibits 1 to 16 (with Exhibit 9 being split into Exhibit 9a and 9b). I do not intend to summarise the entirety of Mr Dolce's evidence here but note that it does provide an explanation confirming that the opponent licenses the use of its marks and other intellectual property to Dolce & Gabbana S.R.L. Mr Dolce also confirms that any goodwill generated through use of those intellectual property rights is owned by the opponent.

14. I will refer to points from the evidence or submissions where necessary.

DECISION

Section 3(6): legislation and case law

15. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith”

16. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v*

Franz Hauswirth GmbH, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnet for Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. It summarised the law as follows:

“68. The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other

sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify

the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]”.

17. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull*.

18. The opponent's pleaded case under the present ground is that the applicant, in filing her application, had no intention other than to benefit from the goodwill and reputation enjoyed by the opponent in its marks and unregistered signs. If such a claim is proven then it is sufficient to give rise to a finding that the applicant has acted in bad faith.²

19. The opponent's submissions referred to the case of *Lindt* (cited above) and set out that it is “necessary to consider the applicant's knowledge of a third party using an identical/similar sign for identical/similar products capable of being confused with the sign for which registration is sought.”³ The opponent is correct to suggest as such, however, I refer to paragraph 40 of *Lindt* which sets out that:

“the fact that an applicant knows or must know that a third party has long been using [...] an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought is not sufficient, in itself, to permit the conclusion that the applicant was acting in bad faith.”

20. It is not enough to simply suggest that the applicant was aware of the opponent's registrations and that by filing for her mark she was acting in bad faith. While the applicant has not sought to expressly deny the 3(6) grounds brought against her,

² *Trump International Limited v DDTM Operations LLC*, [2019] EWHC 769 (Ch).

³ Paragraph 103 of the opponent's submissions

the opponent did not file any evidence attempting to point towards the intention of the applicant as at the relevant date, being the date of the application at issue. While I appreciate that the opponent's submissions sought to address this ground in some detail, this is not supported by any evidence of fact. As a result, there is nothing before me to suggest that the applicant was aware of the existence of the opponent as at the relevant date. Even if she was, without anything further to guide me on her intention at that time, it is of no relevance. The submissions filed are noted but, as I have set out above, a claim of bad faith is a serious allegation that must be distinctly proven. In the present case, the fact that the applicant has not rebutted the allegation of bad faith is not enough to find for the opponent given that it has failed raise a *prima facie* case. As a result, its reliance upon this ground must fail. I will now proceed to consider the remaining grounds of the opposition, starting with 5(2)(b).

Section 5(2)(b): legislation and case law

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

“(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 or association with the earlier trade mark.”

22. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

23. The trade marks relied on by the opponent qualify as “earlier trade marks” for the purposes of the claimed grounds since they were applied for at an earlier date than the applicant’s mark.⁴ The opponent’s registrations had completed their registration processes more than five years before the filing date of the applicant’s mark; however, the applicant did not seek to request that the opponent provide proof of use for its registrations. Therefore, the opponent’s registrations are not subject to proof of use pursuant to section 6A of the Act. This means that the opponent can rely upon all of the goods highlighted under the 5(2)(b) ground of its notice of opposition.

24. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (“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;

⁴ See Section 6(1)(a) of the Act

- (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

25. The competing goods are as follows:

The opponent's goods	The applicant's goods
<p><i>The opponent's first registration</i></p> <p><u>Class 18</u> Leather, hide and imitations thereof; articles made from the aforesaid materials; articles of luggage, trunks, suitcases, bags, travelling bags, handbags, harness and other saddlery articles.</p> <p><u>Class 25</u> Clothing made of leather; jackets, sweaters, jumpers, petticoats, fur coats, raincoats, overcoats, greatcoats, anoraks, wind-resistant jackets, hats, scarves, foulards, neckties.</p>	<p>Class 18 Pet clothing; Pets (Clothing for -); Clothing for pets; Clothing for domestic pets.</p>
<p><i>The opponent's second registration</i></p> <p><u>Class 18</u> Bags; handbags; sports bags; travelling bags; trunks; rucksacks; skins, hide and leatherware; leather and goods made of leather; imitations of skins and leather and goods made</p>	

<p>of these materials; parasols; whips; harness and saddlery.</p> <p><u>Class 25</u> Clothing for gentlemen, ladies and children in general, including, clothing in leather; shirts; jumpers [shirt fronts]; skirts; suits; jackets [clothing]; T-shirts; waterproof clothing; overcoats; topcoats; windcheaters; ski trousers; belts; furs; sashes for wear; gloves; dressing gowns.</p>	
<p><i>The opponent's third registration</i></p> <p><u>Class 18</u> Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins and hides; trunks and suitcases; umbrellas, parasols and walking sticks; whips, harness and saddlery.</p> <p><u>Class 25</u> Clothing, footwear, headgear.</p>	

26. When making the comparison assessing the similarity of the goods or services, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“[...] 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”.

27. 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.

28. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if the goods specified in the contested trade mark application are included in a more general category covered by a term under the earlier mark (or vice versa).

29. While I have no submissions from the applicant, I note that her counterstatement sets out that the goods are not similar. This is because her goods are not made for humans and are not made of leather but, instead, are jackets for dogs made from fleece, bamboo and PVA. While I agree that her terms do not cover goods made for humans, there is nothing in the terms applied for that prevent them from being

made from leather and neither are they limited to fleece, bamboo or PVC jackets for dogs. Instead, they are terms that cover all types of clothing for any pet (domestic or otherwise) in any material. As my assessment of the goods at issue is a notional one, the intention of the applicant is not relevant and I must take into account any and all goods that the terms may cover.

30. I have submissions from the opponent wherein it argues that the term “clothing” in its third mark is so broad that it might be considered to comprise of clothing designed for use by animals as well as humans. As a result, it claims that the applicant’s goods fall within its own and are, therefore, identical under the principle outlined in *Meric*. In an ordinary sense, I appreciate that clothing can be said to cover clothing for any and everything. However, the explanatory note in the Nice Classification sets out that class 25 goods includes clothing, footwear and headwear for human beings.⁵ I, therefore, disagree with the opponent’s submissions on this point. In anticipation of this outcome, the opponent also submitted an alternative argument that the applicant’s goods are at least highly similar to the opponent’s clothing goods and bags in classes 25 and 18, respectively. The opponent referred to a decision of this Tribunal (being case no. BL O/108/15) wherein the Hearing Officer concluded that there is a high degree of similarity between clothing in class 25 and clothing for domestic pets.

31. For the avoidance of doubt, I am not bound by this decision referred to by the opponent. While I accept that there is some degree of similarity between the applicant’s goods, namely “pet clothing”, “pets (Clothing for -)”, “clothing for pets” and “clothing for domestic pets” and “clothing” in the opponent’s third registration’s specification, I do not agree that this extends to high. At their core, I accept that there is some overlap in nature, method of use and purpose on the basis that they are all clothing goods made from the same materials that will be worn by the wearer in the ordinary way for similar purposes, i.e. to keep warm or for aesthetic purposes. However, the fact that the opponent’s goods are worn by humans whereas the applicant’s goods are worn by animals means that the degree of overlap between these factors is very limited. I accept that the user will be the same

⁵https://www.wipo.int/classifications/nice/nclpub/en/fr/?basic_numbers=show&class_number=25&explanatory_notes=show&lang=en&menulang=en&mode=flat¬ion=&pagination=no&version=20220101

in that someone buying clothing for their pet is also a user of the opponent's broad clothing goods. As for trade channels, I appreciate that some companies may offer clothing for pets and humans alike, however, I have no evidence before me to demonstrate that such a practice is common in the trade. Further, I do not consider that the goods will be sold in the same shops but even if they are (in that a large retailer may sell human clothes and pet clothes, for example), they would not be placed within close proximity of one another. Therefore, I see no overlap in trade channels. Lastly, there is no degree of complementarity or competition between the goods. Taking all of the above into account and bearing in mind Section 60A(1)(b) of the Act which states that goods are not to be regarded as dissimilar on the ground that they are in different classes, I am of the view that the limited nature of the overlaps discussed result in a finding that these goods are similar to a low degree.

32. While I note that the opponent's first and second registrations do not include the broad term of "clothing", they do include similar terms such as "clothing made of leather" and "clothing for gentlemen, ladies and children in general, including, clothing in leather", respectively. I am of the view that for these terms, the same reasoning discussed at paragraph 31 above applies and, therefore, I find that they are also similar to the applicant's goods to a low degree. In the event that I am wrong in respect of "clothing made of leather" on the basis that animal clothing tends not to be made of leather, I note that the opponent's first mark also includes a range of clothing goods such as "jackets, sweaters, jumpers, petticoats, [...] raincoats, overcoats, greatcoats, anoraks, wind-resistant jackets." I see no reason why the reasoning discussed above would not also apply to these goods and, again, I find that they are similar to a low degree.

33. The opponent has also provided submissions in respect of the comparison between the applicant's goods and its own goods in class 18 of its registrations. The opponent argues that its class 18 goods, namely "leather goods made of leather" and "imitations of skin and leather and goods made of these materials" are sufficiently broad enough to include pet clothing made of leather or imitation leather. As a result, the opponent claims that they are identical. While I accept that

the opponent's terms are very broad, I am of the view that they are general terms that should be narrowly interpreted in such a way that they only cover such goods that are clearly covered by their literal meanings.⁶ This, in my view, covers goods such as handbags, belts and luggage, as well as other similar type goods. Consequently, I do not consider that these terms will be interpreted in a way that covers clothing for pets made of leather and, therefore, dismiss the opponent's submissions on this point. For the avoidance of doubt, I find that the same finding applies to the remainder of the opponent's class 18 goods, namely that they are all dissimilar.

The average consumer and the nature of the purchasing act

34. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

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

35. The opponent's submissions set out that the average consumer for the goods at issue will be the general public who will pay a low or medium level of attention. This is on the basis that the parties' goods are not particularly specialised or technically

⁶ See paragraph 56 of *Sky v Skykick* [2020] EWHC 990 (Ch)

sophisticated. I agree with respect to the identity of the average consumer, being the general public at large. I also agree that the user will pay a medium degree of attention, however, I do not agree that it will extend to low. While I appreciate the goods are not particularly specialised or technical, the average consumer will still pay attention to various considerations such as current fashion trends, materials used, suitability and durability. I find that this applies regardless of whether the user is buying clothes for humans or for their pets. I appreciate that the price and frequency of purchase of these goods may vary, however, I consider that the user will still take into account the same considerations even where the goods are of low cost and purchased relatively frequently. To conclude, I find that the average consumer will be members of the general public who pay a medium degree of attention during the purchasing process.

36. The goods at issue are most likely to be sold through a range of retailers and their online or catalogue equivalents. In physical retailers, the goods at issue will be displayed on shelves or racks, where they will be viewed and self-selected by the consumer. A similar process will apply to websites and catalogues, where the consumer will select the goods having viewed an image displayed on a webpage or in a catalogue. The selection of the goods at issue will, therefore, be primarily visual. That being said, I do not discount aural considerations in the form of advice sought from sales assistants or word of mouth recommendations.

Comparison of the marks

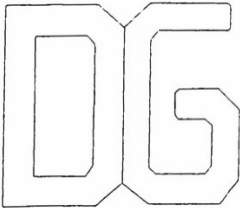
37. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

38. 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.”

39. 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.

40. The respective trade marks are shown below:

The opponent's registrations	The applicant's mark
<p style="text-align: center;">D&G DOLCE & GABBANA</p> <p style="text-align: center;">D&G DOLCE & GABBANA (Series of two) ("the opponent's first registration")</p> <p style="text-align: center;">D&G ("the opponent's second registration")</p> <p style="text-align: center;"> ("the opponent's third registration")</p>	<p style="text-align: center;">D&J DOG & JACKET®</p>

41. I have detailed submissions from the opponent in respect of the comparison of the marks at issue. I also note that the applicant made comments in her counterstatement as to why the marks are not similar. I do not intend to reproduce these here but confirm that I have taken them into account in making the following assessment.

Overall Impression

The applicant's mark

42. The applicant's mark is a figurative mark that consists of two separate word elements and a figurative one. The first word element is 'D&J' displayed in a bold black standard typeface. The ampersand is displayed smaller than the letters D and J but I do not consider that this difference in size will be noticed as it is only slight. Below this element are the words 'DOG & JACKET' displayed in the same typeface as 'D&J' but presented a lot smaller. Here the ampersand is presented at around half the size of the words. While I have said that the difference in size regarding the ampersand discussed above will not be noticed, I consider that it will be here on the basis that it is displayed significantly smaller than the words themselves. Having said that, I do not consider that it will have any great impact. At the end of the word 'JACKET' is a small black circle with a paw print within it. Given its size in contrast to the remaining elements, I am of the view that this element will be overlooked and will have no impact on the mark as a whole. Further, its presence is so small that even if it is noticed, it is likely to be illegible and misunderstood as being a registered trademark sign (®) and, therefore, disregarded from a trade mark perspective. Overall, I consider that due to its size, the 'D&J' element will dominate the overall impression of the mark with the words 'DOG & JACKET' playing a lesser role.

The opponent's registrations

43. The opponent's first registration is a series of two marks (as confirmed by the registration's entry on the trade mark register). Both marks are a combination of

two word elements, being the letters 'D&G' which sits above the words 'DOLCE & GABBANA'. Both of these are displayed in a bold black standard typeface, albeit the letters 'D&G' are considerably larger than the words 'DOLCE & GABBANA'. The only difference between the marks in the series is the size of the respective 'DOLCE & GABBANA' elements. In the first mark, this element is displayed significantly smaller than the 'D&G' element whereas in the second mark it is still displayed smaller but is of an equal width to 'D&G'. I am of the view that in both marks, the letters 'D&G' play the greatest role due to their sizes in the marks with the words 'DOLCE & GABBANA' contributing to a lesser degree.

44. The opponent's second registration is just one element, being a figurative presentation of the letters 'D&G' in a bold standard typeface. There are no other elements that contribute to the overall impression of the mark. As for the opponent's third registration, this is a figurative display of the letters 'DG' that are conjoined and presented in a white standard typeface with a black outline. While the stylisation will be noticed, its impact on the mark will be limited with the letters 'DG' dominating the overall impression.

Visual Comparison

The applicant's mark and the opponent's first registration

45. The way in which the first mark of the opponent's first registration and the applicant's mark are displayed is the same, even insofar as the comparative size difference between the marks' top initial element and their bottom word elements. As a result, I am of the view that it is this mark that represents the opponent's best case in respect of the visual comparison. I will, therefore, base the following comparison on that mark.

46. Firstly, I wish to address the get ups of the marks as wholes. Both marks consist of a two letters, being 'D&G' in the opponent's mark and 'D&J' in the applicant's mark. These elements both sit on top of two words, being 'DOLCE & GABBANA' in the opponent's mark and 'DOG & JACKET' in the applicant's mark. I note that in

both marks the ampersand separating the bottom words is displayed significantly smaller than the words themselves. While the typefaces used in the marks are not remarkable, they are identical (if not, very highly similar). In my view, this results in a very distinctively similar (but not particularly striking) get up across the marks. Further, the beginning of the marks are identical in that they both start with 'D&'. This is a particular point of similarity when one considers that (1) they form part of the dominant elements of the respective marks and (2) average consumers tend to focus on the beginnings of marks.⁷ While the remaining elements differ, I find that when taking all of the above into account, the marks are visually similar to between a medium and high degree.

The applicant's mark and the opponent's second registration

47. Visually, these marks share the same 'D&' element that is, like the marks discussed above, displayed in the same (if not, highly similar) typeface. It could be said that these marks have less points of difference due the absence of the words 'DOLCE & GABBANA' in the opponent's second registration when compared to its first. However, the absence of this element alters the get up of the opponent's second registration to the point that it is not the same get up as the applicant's mark. Taking this into account with the highly similar beginning element of 'D&' and the large size of this element within the applicant's mark, I consider that these marks are visually similar to a medium degree.

The applicant's mark and the opponent's third registration

48. While these marks both start with the letter 'D', they are presented in different ways. The fact that they begin with the same letter does give rise to a level of similarity, however, I do not consider it is particularly pronounced, especially given the stylistic differences between the marks. In my view, these marks are visually similar to a low degree.

⁷ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Aural Comparison

49. Aurally, I consider that the applicant's mark will be pronounced fully, i.e. 'DEE-AND-JAY-DOG-AND-JACK-ITT'. The marks within opponent's first registration will also be pronounced fully, i.e. 'DEE-AND-JEE-'DOL-CHAY-AND-GAB-ANN-AH' or 'DEE-AND-JEE-DOL-CHEE-AND-GAB-ANN-AH'. The first two syllables are identical with the third being somewhat similar due to the phonetic closeness between the way in which 'J' and 'G' are pronounced. The marks are also of a similar length with the applicant's mark being seven syllables with opponent's being nine. Despite both marks using an additional 'AND' (albeit placed in different parts of the respective marks), all other elements are dissimilar. Taking all of this into account, I am of the view that the marks are aurally similar to a low degree.

50. The opponent's second registration will be pronounced 'DEE-AND-JEE'. The similarities between this and the applicant's mark lie in the same elements as discussed above. However, the differences are somewhat lessened due to the fact that the opponent's second registration does not consist of the 'DOLCE & GABBANA' element. Having said that, the additional elements in the applicant's mark will still contribute, particularly given that they contribute to the differing lengths of the marks. Taking all of this into account, I am of the view that these marks are aurally similar to a medium degree.

51. The opponent's third registration will simply be pronounced as 'DEE-JEE'. The only difference in this comparison and the one immediately preceding it is the absence of 'AND' between the two syllables. Taking all of the differences into account, whilst bearing in mind the first syllable is identical, I am of the view that these marks are aurally similar to a low degree.

Conceptual Comparison

52. Firstly, I wish to address the submission of the opponent that 'GABBANA', while being the surname of one of the designers who founded the opponent's brand, also means 'loose overcoat' in Italian. On this basis, the opponent argues that Italian speaking consumers in the UK will recognise the conceptual similarity between

'GABBANA' and 'JACKET' in the applicant's mark. On this point, there is no evidence of the word 'GABBANA' meaning 'loose overcoat' in Italian. In any event, even if such evidence was provided, I have nothing before me to assist in determining the amount of Italian speakers that are present in the UK. In the absence of such, I am not willing to accept that they would constitute a significant proportion of average consumers.

53. In considering the applicant's mark, I am of the view that the meaning of the letters 'D&J' will be made clear by the presence of the words beneath them, in that they stand for 'DOG & JACKET'. This will dominate the concept of the mark. When viewed together, the words 'DOG' and 'JACKET' are a combination of ordinary words with an obvious meaning, i.e. a jacket for a dog. However, the addition of the '&' between them creates a somewhat unusual impression of the element as a whole. Having said that, it would still be understood as alluding to the fact that the applicant provides jackets for dogs, which is a good that is covered by the terms in its specification. Even if the mark is encountered on goods that are not jackets for dogs, it will still allude to clothing for pets.

54. Like the applicant's mark above, the meaning of the letters in the marks of the opponent's first registration will be made clear by the presence of the words beneath them, being 'DOLCE & GABBANA'. I do not consider that this will have any obvious meaning to the average consumer in the UK outside of possibly being either understood as names of a foreign origin (maybe Italian, maybe not) or unknown foreign words. When compared with the concept of the applicant's mark, I am of the view that they are conceptually dissimilar.

55. As for the opponent's second and third registrations, there is no additional element present that will qualify what 'D&G' or 'DG' mean. As a combination of two letters, they provide no immediately graspable concept and are, in my view, conceptually dissimilar to the applicant's mark.

Distinctive character of the opponent's registrations

56. 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).”

57. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. While not expressly pleaded in the notice of opposition, the opponent has submitted that its mark enjoys an enhanced degree of distinctiveness through use. The fact it was not initially pleaded is not fatal to the opponent's submissions.

58. Before considering the position in respect of enhanced distinctiveness through use, it is necessary to consider the inherent position. The marks in the opponent's first registration consist of the letters 'D&G' above the words 'DOLCE & GABBANA'. The use of 'D&G' is not, in my view, particularly remarkable as average consumers are used to seeing these types of initialisms in trade marks. Having said that, I have found that the words 'DOLCE & GABBANA' will not have any obvious meaning and are, therefore, neither allusive or descriptive of the goods at issue. While it may be the case that they are surnames of the founders of the opponent's brand, I am not convinced that the average consumer would be aware of this. Even if they were, it is my understanding that these are not common surnames in the UK. Alternatively, they will simply be viewed as foreign words with no obvious meaning in the UK. I am of the view that in either circumstance, the opponent's first registration enjoys an above medium degree of inherent distinctive character, but I do not consider that it extends to high.

59. As for the opponent's second and third registrations, I have set out above that use of initialisms isn't particularly remarkable from a trade mark perspective. That being said, in the context of these marks, they have no obvious meaning. It is my view that these marks enjoy a medium degree of inherent distinctive character.

60. Turning to consider the evidence, it is necessary to first discuss the explanation from Mr Dolce regarding the opponent's business practice of how it brands its goods. Mr Dolce explains that all of his company's goods always feature the words 'DOLCE & GABBANA' on the 'swing ticket' and other labels attached to the products. In addition, Mr Dolce explains that the company's goods often include the opponent's registrations on the items themselves. On this point, I note that evidence has been provided of a number of products showing all of the opponent's registrations on various types of clothing, bags and jewelry.⁸ Mr Dolce confirms that all of these goods were produced and sold between 2017 and 2021.

⁸ Exhibit 4

61. Sales figures in the UK have been provided for 2017 to 2021.⁹ [REDACTED]

[REDACTED]

[REDACTED]. These are clearly significant figures that indicate the operation of a very large business.

62. In addition to the turnover discussed above, the opponent has provided a number of sample invoices that cover a number of sales in the United Kingdom between 4 January 2019 and 14 December 2021.¹⁰ The latter date is after the relevant date (being 1 August 2021), however, I note that of the 78 pages of invoices in total only the last three pages are dated after that. These will be discounted but do not, in my view, take away from the fact that the invoices show a wide range of goods being sold to the United Kingdom. Helpfully, the opponent has also provided images of the products sold in these invoices and I note that these include either a variation of the letters 'DG' or the opponent's first registration.

⁹ CONFIDENTIAL Exhibit 6

¹⁰ Exhibit 7

63. Mr Dolce goes on to discuss the marketing efforts of the opponent. Evidence of the UK expenditure has been provided.¹¹ While I do not intend to reproduce the yearly breakdown of the spend, [REDACTED]
[REDACTED]
[REDACTED]. I am of the view that this figure represents a significant spend during this time.

64. On the point of advertising, a number of examples of marketing campaigns are provided for the opponent's products and events.¹² I note that this evidence shows examples of the opponent's campaigns from Summer 2017 to Fall/Winter 2018/2019. I note that where branding is shown on the garments advertised, it features the letters 'DG', 'D&G' or the words 'DOLCE & GABBANA'. In addition to the advertising campaigns, Mr Dolce has provided examples of various editorials in magazines such as GQ, Grazia and Harper's Bazaar featuring the letters 'DG' or 'D&G'.¹³ Mr Dolce sets out that these are well-known UK magazines. While this is not supported by evidence, it has not been challenged either so have no reason to disbelieve the opponent on this point.

65. In respect of press coverage, I note that in addition to the editorials referred to above, evidence has been provided in respect of the opponent's involvement and attendance at events in the UK such as the 'Art Adorned: Christie's x Dolce & Gabbana Alta' event that was held at Christie's in London in 2019 and another event called 'The Sun in a London Night' that was held at Harrods in 2017.¹⁴ Further, Mr Dolce confirms in his evidence that the opponent regularly attends London Fashion Week. While there is no evidence to suggest the reach of these events, it is my understanding that London Fashion Week is a prominent event in the industry that attracts many attendees and, as evidenced by the press articles provided,¹⁵ a number of fashion publications also attend the event and cover it accordingly. In making my point regarding the prominence of London Fashion Week, I do so while being conscious not to assume my own knowledge is more

¹¹ CONFIDENTIAL Exhibit 8

¹² Exhibit 9a

¹³ Exhibit 9b

¹⁴ Exhibit 15

¹⁵ See pages 4 to 13 of Exhibit 15

widespread than it is, however, I do not consider this to be something that is in serious dispute.¹⁶

66. A number of the opponent's catalogues have also been provided. These are dated between 2017 and 2021 and Mr Dolce confirms that they were targeted at the UK market.¹⁷ I note that these include both fashion show catalogues and the more general seasonal catalogues. Where branding is visible in these catalogues, I note that it shows either a 'DG' or 'D&G' logo or includes the words 'DOLCE & GABBANA'. The latest catalogue show is for the Spring/Summer 2021 catalogue. Given that the relevant date falls in the summer of 2021 and based on my understanding that fashion brands often provide their seasonal catalogues ahead of time, I am content to conclude that these all fall prior to the relevant date. Visitors to the opponent's website are also discussed and I note that between 2017 and 2021, there were a total of 6,250,391 'new users' to the website from within the UK.¹⁸

67. Lastly, I note that the evidence shows an article from GQ magazine in 2012 confirming that the opponent was named as one of the designers of the year. The article refers to the fact that this award goes to the opponent's designers "after nearly three decades at the top of their game". This article is from GQ's British website and I note that the article also refers to the England football team at Euro 2012, further reinforcing its aim at the UK market.

68. Throughout the above summary, I have made references to general figures provided by the opponent for 2021 in respect of its turnover and advertising. In the present case, the relevant date is 1 August 2021. As a result, some of the general figures for 2021 will include figures from after the relevant date meaning that they are not relevant to the present assessment. That being said, the figures provided are extremely significant and even if I were to discount a proportion of the general 2021 figures, I am satisfied that the evidence points toward the opponent operating a very large business that sells clothing, leather goods and shoes. I am also

¹⁶ *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08

¹⁷ Exhibit 10

¹⁸ Exhibit 12

satisfied that 'DG', D&G' and 'DOLCE & GABBANA' will be associated with the business to the point that the average consumer would, because of the use made of the opponent's registrations, immediately associate them with one undertaking, being the opponent. As a result of this extensive use, I am content to conclude that the opponent's registrations all enjoy a high degree of distinctive character as a result of the use made of them.

Likelihood of confusion

69. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

70. I have found the parties' goods to be similar to a low degree. I have found the average consumer for the goods to be members of the general public who will select the goods at issue via primarily visual means, although I do not discount an aural component playing a part. On this point, I refer to the case of *New Look*¹⁹ (which has also been cited by the opponent in its submissions) wherein the GC set out that where goods are selected by primarily visual means, the average

¹⁹ *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03

consumer tends to attribute more importance to the visual similarity between marks. I have concluded that the average consumer will pay a medium degree of attention when selecting the goods at issue. I have found that the opponent's registrations are inherently distinctive to a medium degree but that this has been enhanced to a high degree as a result of the use made of all three of the marks relied upon. While this is a factor that weighs in the opponent's favour, it does not automatically give rise to a finding of confusion. In respect of the similarity of the marks at issue, I have found them to be as follows:

- a. The opponent's first registration is visually similar to between a medium and high degree, aurally similar to a low degree and conceptually dissimilar to the applicant's mark;
- b. The opponent's second registration is visually and aurally similar to a medium degree and conceptually dissimilar to the applicant's mark; and
- c. The opponent's third registration is visually and aurally similar to a low degree and conceptually dissimilar to the applicant's mark.

71. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am not convinced that the marks would be mistakenly recalled or misremembered for one another. While I appreciate that the applicant's mark consists of its 'D&J' element and that this is similar to the opponent's first and second registrations' 'D&G' element, even to the point that it is presented in the same way, I am of the view that it is the 'DOG & JACKET' element that will allow the average consumer to correctly recall and remember the marks. I find that this is particularly the case given that the applicant's mark carries the conceptual hook of pet clothing, one that is not shared within any of the opponent's registrations. While it may be the case that the 'D&G' and 'DG' elements across the marks are highly distinctive as a result of their use, the clear difference presented by the 'DOG & JACKET' element will still be noticed, regardless of how well-known the 'D&G' or 'DG' elements in the opponent's registrations are. Consequently, I do not consider there to be any likelihood of direct confusion.

72. Turning now to consider a likelihood of indirect confusion, I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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

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

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

73. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

74. In support of its claim to the existence of a likelihood of indirect confusion, the opponent submits that the applicant's mark may be seen as a new product line of the opponent or that there is a partnership with or endorsement provided by the opponent. While noted, I am of the view that the differences between the marks are not differences that the average consumer would expect to see in any of the scenarios highlighted by the opponent. On the contrary, the differences will be understood as pointing to the existence of separate and unconnected undertakings. For example, I fail to see why the average consumer would believe that a company with highly distinctive marks that are dominated by the letters 'DG' or 'D&G' would extend their brand or create a sub-brand in such a way that it alters those highly distinctive elements. Further, I do not consider that the average consumer would consider it consistent or logical that the opponent would remove the letter 'G', replace it with a 'J' and then add the additional element of 'DOG & JACKET'. The latter point is of particular importance when compared to the equivalent element in the opponent's first registration, being 'DOLCE & GABBANA'. I also fail to see why the average consumer would also believe that the opponent would enter into a partnership or endorsement deal and then proceed to alter their marks so as to remove its 'D&G' or 'DOLCE & GABBANA' elements. On the contrary, I am of the view that the average consumer would expect such a partnership or endorsement to have quite a striking connection to the entirety of

the 'D&G' element or at least consist of either the word 'DOLCE' or 'GABBANA'. Even if the average consumer, upon being confronted by the applicant's mark on goods that are similar to a low degree, was to call to mind the opponent's registrations (particularly the first mark in its first registration due to the shared get up), this is mere association not indirect confusion.²⁰ Consequently, I do not consider that there is any likelihood of indirect confusion between any of the marks at issue.

75. As a result of my findings above, the opposition under section 5(2)(b) fails in its entirety. I will now proceed to consider the remaining grounds of the opposition.

Section 5(3)

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

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

77. 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*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

²⁰ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

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 Salomon, 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 holder 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*).

78. The conditions of section 5(3) are cumulative. There must be similarity between the marks, the opponent must also show that its marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. The opponent must also establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Assuming that these conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

79. The relevant date for the assessment under section 5(3) is the date of the application at issue, being 1 August 2021.

Reputation

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

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

81. Under its 5(3) ground, the opponent relies on the same marks as it did under its 5(2)(b) ground. Under that ground, the opponent relied on a limited range of goods for each of its registrations. Here, the opponent relies on the same limited set of goods as it did above for its third registration only. However for the remaining registrations, the opponent claims to have obtained a reputation in all of the goods for which they are registered.

the remaining evidence as a whole, particularly the evidence of coverage in various UK-wide publications and presence at prominent events such as London Fashion Week, I am satisfied that the opponent enjoys a very strong reputation in the UK in all of its registrations. I will now discuss to what goods this finding applies to.

84. As I have discussed above, the opponent's statement of grounds set out that it has acquired a reputation in the UK for clothing, leather goods and fashion accessories. In my view, this does not fall in line with the claim that it has acquired a reputation for all of the goods relied upon. For example, the opponent's first and second registrations consist of a range of cosmetic goods in class 3. These are not clothing, leather goods or fashion accessories. Further, I note that the opponent's second registration include goods such as cash registers and life-saving and teaching apparatus and instruments. Again, these are not items of clothing, leather goods or fashion accessories. On this point, I accept that the evidence relates to a wide range of goods but I see no evidence that points to sales of class 3 goods.²¹

[REDACTED]

[REDACTED]. I, therefore, do not consider that the opponent's reputation extends to the class 3 goods relied upon.

85. Given the broad range of goods included in the specification and shown in the evidence, I do not intend to discuss in any great detail what goods are covered by the evidence and what are not. However, I will say briefly that the evidence covers clothing goods, leather goods, various types of bags and accessories such as sunglasses. In respect of clothing, the range of goods shown in the evidence is significant and I note that the sub-categories provided for in the turnover evidence cover a very broad range of goods including [REDACTED]. Each of these sub-categories have significant sales figures attached to them and I am satisfied that the evidence as a whole is sufficient to cover the broad clothing terms in the opponent's specification.

²¹ On the point of perfumes, I note, for example, at pages 2 and 8 of Exhibit 3 that there are images of perfume but no evidence of sales in relation to the same.

As for the opponent's class 18 goods, I do not consider that the reputation extends to broad terms such as "articles made from leather" or actual leather hides and imitations of skin themselves but, instead, should be limited to only the specific goods referred to in the evidence or those that would ordinarily be covered by the sub-categories listed in the opponent's turnover evidence, being [REDACTED]

[REDACTED]. As was the case for clothing above, each of these categories have significant sales figures attached to them and I am content to accept that the reputation extends to these types of goods also. To confirm, I consider that the opponent enjoys a reputation in the following goods:

The opponent's first registration

Class 9: Sunglasses.

Class 18: Articles of luggage, suitcases, bags, travelling bags, satchels, rucksacks, purses, wallets, handbags.

Class 25: Clothing made of leather; suits, dresses, frocks, skirts, trousers, jeans, pants, waistcoats, jackets, sweaters, jumpers, jerseys, articles of underclothing, vests, singlets, pyjamas, nightdresses, dressing gowns, foundation garments, corsets, brassieres, garters, drawers, petticoats, hosiery, socks, stockings, tights, work clothing, coats, fur coats, raincoats, overcoats, greatcoats, anoraks, wind-resistant jackets, bathing costumes, scarves, foulards, neckties, belts, gloves, footwear, shoes, sports shoes, boots, slippers.

The opponent's second registration

Class 9: Sunglasses.

Class 18: Bags; handbags; sports bags; gent's handbags; pocket wallets; coin purses; purses; travelling bags; rucksacks.

Class 25: Clothing for gentlemen, ladies and children in general, including, clothing in leather; shirts; jumpers [shirt fronts]; skirts; suits; jackets [clothing]; trousers; shorts; sports jerseys; T-shirts; pyjamas; stockings; singlets; pants; brassieres; underwear; hats; headscarves; neckties; waterproof clothing; overcoats; topcoats; swimsuits; tracksuits; windcheaters; belts; gloves; dressing gowns; footwear in general, including, slippers, shoes, sports shoes, boots and sandals.

The opponent's third registration

Class 18: Suitcases.

Class 25: Clothing, footwear, headgear.

Link

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

The degree of similarity between the conflicting marks.

87. As the marks at issue here are the same as those assessed under the 5(2)(b) ground above, I rely on the same findings here in that:

- a. The opponent's first registration is visually similar to between a medium and high degree, aurally similar to a low degree and conceptually dissimilar to the applicant's mark;

- b. The opponent's second registration is visually and aurally similar to a medium degree and conceptually dissimilar to the applicant's mark; and
- c. The opponent's third registration is visually and aurally similar to a low degree and conceptually dissimilar to the applicant's mark.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

88. My assessment under 5(2)(b) above was made in respect of a more limited set of goods than those for which the opponent enjoys a reputation in under this ground. The additional goods at issue here include sunglasses as well as additional class 18 goods and items of clothing. While I find that "sunglasses" are dissimilar to the applicant's goods, I see no reason why the same findings made in respect of the class 18 and class 25 goods above will not also apply here. To confirm, I consider that the applicant's goods are similar to a low degree with the opponent's class 25 goods but dissimilar to its class 18 goods. On this point, I note that the relevant section of the relevant public concerned with the parties' goods will be the same, even for dissimilar goods.

The strength of the earlier mark's reputation

89. The opponent enjoys a very strong reputation in all three of its registrations.

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

90. The opponent's first registration enjoys an above medium degree of inherent distinctive character (but not high). The opponent's second and third registrations marks enjoy a medium degree of inherent distinctive character. As a result of the use mark of the marks, I have found that all of them are distinctive to a high degree.

Whether there is a likelihood of confusion

91. I have found above that there is no likelihood of either direct or indirect confusion.

Conclusion on link

92. In assessing the marks at issue, I consider that it is the first mark within the opponent's first registration that offers the best case for the existence of a link (for the purpose of the remainder of this ground, I will refer to this mark simply as "the opponent's mark"). This is on the basis that the applicant's mark shares the same get up with the opponent's mark and, therefore, is similar to a higher degree with this than it is with the remaining registrations. If necessary, I will return to consider the remaining registrations.

93. While the marks differ in the presence of the words 'DOLCE & GABBANA' and 'DOG & JACKET', the first elements in the marks, being 'D&G' and 'D&J', are highly similar. As alluded to above, the marks also share the same get up. While I appreciate that the presentation of an initialism above the words that the letters stand for are not particularly remarkable from a trade mark perspective, I note that the presentation of these marks is identical, even down to the relative sizing of the components of the mark and presence of a smaller '&' between the words in the bottom elements. Further, I note that the marks will be displayed on goods that are similar, albeit to only a low degree. Taking these points into account together with the level of reputation and distinctive character of the opponent's mark, I am of the view that a significant proportion of the relevant public concerned with the goods at issue will consider there to be a link between the marks.

Damage

94. The opponent has pleaded that use of the applicant's mark would, without due cause, take unfair advantage of the reputation of the opponent's registrations and/or be detrimental to the distinctive character or reputation of the opponent's registrations. I will deal with each head of damage in turn below.

Unfair Advantage

95. While I note that I have found there to be no confusion in the present case, I am reminded of the case of *Lonsdale Sports Limited v Erol*, [2013] EWHC 2956 (Ch) wherein Norris J. rejected a claim that there was a likelihood of confusion between the appellant's mark and the respondent's mark. However, he found that:

“34. As I have said above, at a first glance the block of text in the Respondent's Mark looks like something that Lonsdale might be connected with (a first impression soon dispelled in the case of the average consumer). But that first glance is important. Those who look at the wearer of a product bearing the Respondent's Mark might not get more than a glance and might think the wearer was clad in a Lonsdale product. The creation of that illusion might be quite enough for the purchaser of a "look-alike" product: indeed who but such a person would knowingly buy a "pretend" product? Further, it undoubtedly dilutes the true "Lonsdale" brand by putting into circulation products which do not proclaim distinctiveness but rather affinity with a reputable brand.

35. In my judgment the case under s.5(3) was made out on the evidence as found by the Hearing Officer.”

96. I am of the view that a similar outcome will apply in the present circumstances. By applying to register a mark with the same get up and a highly similar first element, being 'D&J', as the opponent, the applicant is going to benefit from a transfer of image from the opponent's mark onto its own. I accept that on further inspection it may be the case that the average consumer confronted by the applicant's mark would dispel any connection between the parties, however, as per the case law set out above, the first glance is important. I find that a consumer may, upon seeing the applicant's mark on an item of clothing worn by a dog passing them by, it would remind them of the opponent's mark. This is particularly the case given that, in this scenario, the marks is likely to be very small so the consumer will be unable to conduct a complete inspection of the mark. So while there may be no likelihood of

confusion between the marks, the creation of the illusion that the applicant's mark is connected with the opponent's mark is such that it would achieve instant familiarity in the eyes of a significant proportion of the relevant public, thereby securing a commercial advantage and benefitting from the opponent's reputation without paying financial compensation. Such commercial advantage would not exist were it not for the very strong reputation of the opponent's mark. Therefore, I find it likely that the applicant's mark take unfair advantage of the opponent's mark.

Detriment to distinctive character

97. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the opponent's other heads of damage. However, for the sake of completeness, I will briefly consider detriment to distinctive character on the basis that, as per the reasoning set out in the passage of *Lonsdale* reproduced above, the presence of the applicant's mark undoubtedly dilutes the true 'D&G' brand by putting into circulation products which do not proclaim distinctiveness but rather affinity with a reputable brand by sharing the same get up of the opponent's reputed registration. In these circumstances, I consider that there is a serious risk that detriment to distinctive character would occur.

98. The opposition based upon section 5(3) succeeds in its entirety.

Section 5(4)(a)

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

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

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

(aa)

(b)

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

100. 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.”

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

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

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

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

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

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation¹ among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source² or are connected.

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

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

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

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

Relevant Date

103. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander Q.C., as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

104. The applicant’s mark does not have a priority date, and neither is there any evidence of any earlier use that is capable of being the start of the behaviour complained above. As a result, the relevant date for the 5(4)(a) assessment falls on the filing date of the application at issue, being 1 August 2021.

Goodwill

105. The first hurdle for the opponent is that it needs to show that, at the relevant date, it had the necessary goodwill in its business and that its signs were distinctive

and/or associated with that goodwill. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

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

106. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

107. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

108. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

109. Goodwill arises as a result of trading activities. Following on from the reasoning given throughout this decision regarding enhanced distinctiveness and reputation, I do not consider it controversial to suggest at this point that the opponent clearly enjoys a very strong level of goodwill and that its second, fourth and fifth signs (being identical to the opponent's first, second and third registrations) relied upon here are distinctive of and/or associated with that goodwill. I appreciate that there are two additional signs relied upon in the current ground that were not subject to the grounds assessed above, being the word only signs 'DG' and 'DOLCE & GABBANA' (being the opponent's first and third signs, respectively). Given the frequent presence of both 'DG' and 'DOLCE & GABBANA' throughout the evidence, I see no reason why the goodwill in the opponent's business would not also be associated with these signs. As a result, I consider that the above finding of a very strong level of goodwill applies to these signs also. As set out in the evidence (and as mentioned to at paragraph 13 above), the opponent confirms that any goodwill accrued as a result of the use of these signs vests in the opponent.

110. I remind myself that the opponent claims to have obtained goodwill in its signs for "clothing and leather goods". This is a very broad term and while I accept that the opponent has demonstrated goodwill in "clothing" at large (for the same reasons given at paragraph 85 above), I do not consider it has done so for "leather goods" on the basis that this would cover any and all goods made of leather. In light of the evidence filed, it is clearly not the case that the opponent has traded in all types of leather goods. As a result, I consider it appropriate to limit the opponent's goodwill to only the following goods:

Bags; handbags; sports bags; gent's handbags; pocket wallets; coin purses; purses; travelling bags; rucksacks; satchels, rucksacks, wallets; suitcases; all of the aforesaid made of leather; Clothing.

111. I will now proceed to consider misrepresentation and damage.

Misrepresentation and damage

112. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

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

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

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

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

113. In assessing misrepresentation, I consider it necessary to divide the opponent's signs into two groups. This is on the basis that I have already assessed a likelihood of confusion in respect of the opponent's second, fourth and fifth signs (on the

basis that they are identical to the opponent's first, second and third registrations). The relevance of this will become obvious below. I have not yet assessed the opponent's first and third signs so will deal with them separately.

The opponent's second, fourth and fifth signs

114. When considering 5(4)(a) grounds, I am reminded that although the test for misrepresentation is different from that for likelihood of confusion in that it entails "deception of a substantial number of members of the public" rather than "confusion of the average consumer", it is unlikely that the difference between the legal tests will produce different outcomes.²² I believe that to be the case here, regardless of the size of the opponent's goodwill. On the basis that I have found there to be no likelihood of confusion under the 5(2)(b) ground above, I do not consider that a substantial number of members of the relevant public would be misled into purchasing the applicant's goods in the mistaken belief that they are the goods of the opponent. While I note that the 5(2)(b) assessment did not include an assessment based on gent's handbags, pocket wallets, coin purses, purses or wallets (all of which made of leather), being additional goods for which the opponent now enjoys goodwill in, I do not consider that this puts the opponent in any better position. As there is no misrepresentation in respect of similar goods, I see no reason why there would be for these additional dissimilar goods. Without misrepresentation, there can be no damage meaning that the opponent's reliance upon the 5(4)(a) ground fails in respect of its second, fourth and fifth signs.

The opponent's first and third signs

115. Even taking into account the level of goodwill and the fact that the goods are similar to a degree (following the same reasoning set out under the 5(2)(b) grounds in that clothing is similar to a low degree with the applicant's goods), I am of the view that the significant differences presented by the applicant's mark when compared to these two signs will be noticed and will lead to a substantial number of members of the public understanding that the goods provided under the marks

²² *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501

at issue are offered by separate and unconnected undertakings. As a result, I conclude that members of the public will not be deceived into purchasing the applicant's goods in the mistaken belief that they are the goods of the opponent.

116. My findings above mean that there is no misrepresentation. Without this, there can be no damage under the present ground. Therefore, the opponent's reliance on the 5(4)(a) ground fails.

CONCLUSION

117. While the opposition has failed in respect of the 3(6), 5(2)(b) and 5(4)(a) grounds, it has succeeded in full in respect of the 5(3) ground and, therefore, the application is refused in its entirety.

COSTS

118. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. Despite the fact that the opponent has only succeeded in respect of one of its grounds, I consider that a full costs award is appropriate. In the circumstances, I award the opponent the sum of **£1,200** as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition:	£200
Preparing evidence:	£500
Preparing written submissions in lieu:	£300
Official fees:	£200
Total:	£1,200

119. I hereby order Anita Kristof to pay Dolce & Gabbana Trademarks S.R.L. the sum of £1,200. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 28th day of December 2022

A COOPER
For the Registrar

ANNEX

The opponent's first registration

Class 3

Cosmetics, make-up preparations, preparations for removing make-up, eye shadows, lipsticks, nail varnishes, beauty masks, cosmetic kits; soaps, liquid soaps, toilet soaps; bath salts; talcum powder; perfumery articles, perfumes, essential oils; deodorants; shampoos, hair lotions; toothpastes; tanning oils and creams, bleaching and softening substances.

Class 9

Sunglasses, eyeglasses, eyeglass frames, eyeglass cases, chains for eyeglasses; optical lenses; contact lenses; containers for contact lenses; telephone sets; hi-fi systems.

Class 18

Leather, hide and imitations thereof; articles made from the aforesaid materials; articles of luggage, trunks, suitcases, bags, travelling bags, briefcases, portfolios, folders, satchels, rucksacks, purses, wallets, handbags, sunshades, beach umbrellas, umbrellas, walking sticks, harness and other saddlery articles.

Class 25

Clothing made of leather; suits, dresses, frocks, skirts, trousers, jeans, pants, waistcoats, jackets, sweaters, jumpers, jerseys, articles of underclothing, vests, singlets, pyjamas, nightdresses, dressing gowns, foundation garments, corsets, brassieres, garters, drawers, petticoats, hosiery, socks, stockings, tights, work clothing, coats, fur coats, raincoats, overcoats, greatcoats, anoraks, wind-resistant jackets, bathing costumes, sporting overalls, ski pants, hats, scarves, foulards, neckties, belts, gloves, footwear, shoes, sports shoes, boots, slippers.

The opponent's second registration

Class 3

Cosmetics in general, including: face creams; mascara; eye liner; eyeshadows; make-up pencils; face clays; lipsticks; foundation; body lotions; nail varnishes; nail strengtheners; acetone; cosmetic kits; perfumery, including perfumes; solid perfumes; deodorants; essential oils; soaps; liquid soaps; cakes of toilet soap; foam bath; talcum powder; dentifrices; shampoos; hair lotions; Permanent waving and setting preparations for the hair; gel; hair dyes; sun-tanning oils and lotions; depilatory preparations; detergents; bleach; fabric softeners [for laundry use]; soaps; bleaching preparations and other substances for laundry use; cleaning, polishing, scouring, scraping and abrasive preparations.

Class 9

Spectacles; sunglasses; spectacle frames; contact lenses; containers and cases for contact lenses; apparatus for recording, transmission or reproduction of sound or images; sound recording discs; scientific, nautical, surveying and electric apparatus and instruments; photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; coin or counter-operated apparatus; cash registers.

Class 18

Bags; handbags; sports bags; gent's handbags; pocket wallets; coin purses; purses; travelling bags; trunks; rucksacks; briefcases; document holders; key cases (leatherware); vanity cases (not fitted); skins, hide and leatherware; leather and goods made of leather; imitations of skins and leather and goods made of these materials; parasols; parasols; umbrellas; walking-sticks; whips; harness and saddlery.

Class 25

Clothing for gentlemen, ladies and children in general, including, clothing in leather; shirts; jumpers [shirt fronts]; skirts; suits; jackets [clothing]; trousers; shorts; sports jerseys; T-shirts; pyjamas; stockings; singlets; corsets [underclothing]; suspenders; pants; brassieres; underwear; hats; headscarves; neckties; waterproof clothing;

overcoats; topcoats; swimsuits; tracksuits; windcheaters; ski trousers; belts; furs; sashes for wear; gloves; dressing gowns; footwear in general, including, slippers, shoes, sports shoes, boots and sandals.

The opponent's third registration

Class 18

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins and hides; trunks and suitcases; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25

Clothing, footwear, headgear.