

O/0506/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. UK00003947508 AND UK00003947511

IN THE NAME OF LICHENG DISTRICT SHIEN SHOE STORE

FOR THE TRADE MARKS:

**shien**

AND

**shien诗恩**

IN CLASSES 3, 9, 14, 18, 25, 26, 35 AND 42

AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS

THERE TO UNDER NOS. 444989 AND 444990

BY ROADGET BUSINESS PTE. LTD

## BACKGROUND AND PLEADINGS

1. On 20 August 2023, Licheng District Shien Shoe Store (“the applicant”) applied to register the following trade marks, in the UK:

shien

UKTM no. 3947508

Priority date: 19 August 2023

(“the First Application”)

**shien诗恩**

UKTM no. 3947511

Priority date: 19 August 2023

(“the Second Application”)

(together “the applications”)

2. The applications were published for opposition purposes on 29 September 2023 and protection is sought for the goods and services shown in Annex 1 to this decision.

3. On 29 December 2023, the applications were opposed by Roadget Business Pte. Ltd (“the opponent”) based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following trade marks:

**SHEIN**

UKTM no. 3704949

Filing date: 30 September 2021

Registration date: 8 April 2022

EU filing date: 15 May 2018<sup>1</sup>

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<sup>1</sup> This trade mark was filed pursuant to Article 59 of the Withdrawal Agreement between the EU and the UK. The effect of this is that the opponent is entitled to rely upon the EU filing date shown here.

("the First Earlier Mark")

**SHEIN**

UKTM no. 3551044

Filing date: 2 November 2020

Registration date: 19 March 2021

("the Second Earlier Mark")

**SHEIN**

UKTM no. 3277376

Filing date: 15 December 2017

Registration date: 6 April 2018

("the Third Earlier Mark")

(together "the earlier marks")

4. Under both grounds, the opponent relies upon the goods and services set out in Annex 2 to this decision. Under section 5(2)(b) of the Act, the opponent claims that the marks are similar, and the goods and services are similar, with the result that there is a likelihood of confusion. Under section 5(3) of the Act, the opponent claims that use of the applications, without due cause, would take unfair advantage of, and/or be detrimental to, the distinctive character and/or repute of the earlier marks.

5. Under section 5(4)(a) of the Act, the opponent relies upon the sign SHEIN which it claims to have been using throughout the UK since January 2015 in relation to "cosmetics, downloadable software, computer programs, eyewear, jewellery, bags, clothing, hair accessories, retail services". The opponent claims that use of the applications would be contrary to the law of passing off.

6. The applicant filed counterstatements denying the grounds of opposition and putting the opponent to proof of use of the Third Earlier Mark.

7. On 26 March 2024, the proceedings were consolidated pursuant to Rule 62(1)(g) of the Trade Marks Rules 2008.

8. Neither party requested a hearing and only the opponent filed written submissions in lieu. This decision is taken following a careful consideration of the papers on file.

## **REPRESENTATION**

9. The applicant is represented by Marcin Ociepka.

10. The opponent is represented by Harbottle & Lewis LLP.

## **EVIDENCE AND SUBMISSIONS**

11. The opponent filed evidence in the form of:

- a. The witness statement of Samuel George Alexander Flack dated 2 December 2024, which is accompanied by 15 exhibits (SF1 to SF15). Mr Flack is an Associate acting on behalf of the opponent in these proceedings.
- b. The witness statement of Timothy Paul Democratis dated 21 October 2024, which is accompanied by 2 exhibits (TPD1 and TPD2). Mr Democratis is the Assistant General Counsel of Shein Distribution UK Limited, which is a wholly owned subsidiary of the opponent.

12. The opponent filed written submissions in lieu dated 23 May 2025.

## **RELEVANCE OF EU LAW**

13. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated

law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## **DECISION**

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

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

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

(a)...

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

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

15. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

16. Given their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the First and Second Earlier Marks had completed their registration process less than 5 years prior to the filing date of the applications in issue, they are not subject to the use provisions of section 6A of the Act. By contrast, the Third Earlier Mark is subject to the use provisions. Consequently, I will begin by assessing whether the opponent has put the Third Earlier Mark to genuine use during the relevant period.

## Proof of use

17. The relevant statutory provisions are as follows:

“6(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

18. Section 100 of the Act is also relevant, which reads:

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

19. The relevant period for assessing genuine use is the five-year period ending with the priority date of the applications in issue i.e. 20 August 2018 to 19 August 2023.

20. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider*

*Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37];

*Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

21. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

22. Mr Democratis states that the opponent’s UK subsidiary “markets and distributes clothing, cosmetics, jewellery, bags and luggage, hair accessories, textiles and homeware and a range of other products, many of which are marketed and distributed specifically under and by reference to the SHEIN name...”. Mr Flack explains that the opponent’s “initial focus was clothes” but that “over time [it] expanded into a number of related markets, such as homeware, electronics, office supplies, tools, bags (including cosmetic bags and luggage), accessories (including hats, gloves and scarves), jewellery and more”. Clearly, therefore, whilst the opponent’s initial focus was on the clothing sector, it now sells a vast range of goods.

23. I make two initial observations on the opponent’s evidence. Firstly, a lot of it lacks specificity in terms of use in the UK. For example, Mr Flack has provided evidence regarding the opponent’s global annual revenue targets.<sup>2</sup> This is unhelpful in terms of showing genuine use within the UK market. Secondly, given the statements made by the witnesses set out above regarding the breadth of the goods sold by the opponent, there is a noticeable lack of breakdown of any information by product category. Professor Phillip Johnson, sitting as the appointed person, in *EROS BODYGLIDE*, described the issue with such evidence as follows:<sup>3</sup>

“26. Where global sales figures are provided for multiple goods sold under one trade mark this is not going to be evidence of use for any of those goods. The sales could all be in relation to good A or all in relation to good B or a split between the two. This is why particularisation is so important as without it the

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<sup>2</sup> Exhibit SF2

<sup>3</sup> BL O/0984/25

figures provide no evidence of use for either good A or good B. The same applies where the same good is sold under trade mark A or trade mark B.”

With that in mind, I will now consider the evidence that has been filed insofar as I am able to identify it as relating to the goods and services in question.

#### Class 14

24. A screenshot of the opponent’s website has been provided which shows a jewellery section of that website on 6 September 2018.<sup>4</sup> Mr Flack states that he has been “informed by the Opponent that Shein has listed and marketed travel bags and accessories on its UK website (www.shein.co.uk) since that date”.<sup>5</sup> Whilst the evidence shows that the opponent’s UK subsidiary had a revenue of over £1.5billion in the year ending December 2023 (at least some of which falls within the relevant period), this relates to “the sale of fashion apparel and accessory products through its online platforms, online store and mobile app”.<sup>6</sup> It is not, therefore, broken down to reflect the position in relation to class 14 goods.

25. Mr Flack states:

“17. I am informed by the Opponent that Shein sold the products within the categories referred to above [...] on its mobile app and UK website during the Relevant Period.”

26. However, absolutely no sales numbers have been provided for goods that are within this class. Whilst there is evidence of advertising/promotional activities, there is no evidence which enables me to identify any such activities in relation to this class.

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<sup>4</sup> Exhibit SF1

<sup>5</sup> I bear in mind that parts of Mr Flack’s narrative evidence are hearsay, having been provided to him from unidentified third parties. However, I note that no issue with this has been raised by the applicant and Mr Democratis (who does himself have firsthand knowledge of such matters given his position within the opponent’s subsidiary) appears to endorse the accuracy of Mr Flack’s evidence (see paragraph 15 of Mr Democratis’ statement).

<sup>6</sup> Exhibit TPD1

## Class 18

27. Mr Flack states that “bags and purses” have been available for sale on the opponent’s UK website since 6 September 2018 and that the use in that regard has continued since that date.<sup>7</sup> Again, Mr Flack points to the fact that sales of these goods have been made during the relevant period, but no evidence has been filed which enables me to assess the scale of that use. Similarly, as discussed above, there is no advertising/promotional evidence which I am able to connect with goods in this class specifically.

## Class 35

28. Plainly, the opponent advertises its own goods, but that is not the provision of an advertising service within this class. There is no evidence at all of wholesale activities in the UK, nor is there evidence of the opponent providing any of the business services relied upon.

29. The high point of the opponent’s case in this class relates to the retail services specification. Clearly, the opponent has been selling its own clothing goods through its website and mobile application. On Black Friday 2022, which falls in November, the opponent’s UK website had 2.5million UK visitors.<sup>8</sup> This was the second highest website traffic result amongst fashion retailers. The opponent’s UK retail application had 6.7million downloads in 2023, although I appreciate that not all of these will have fallen within the relevant period. I bear in mind that selling one’s own goods may constitute use of a mark in relation to retail services.<sup>9</sup> It is clear from the screenshots of the opponent’s website that they have brought together a range of goods during the relevant period which includes a range of clothing items. In this regard, I note that the screenshot shown refers to both women, men and kids which, given that the opponent is predominantly a clothing retailer, I take to be a reference to the fact that they sell clothing for each of those user groups. In my view, the fact that those goods originate from the opponent does not prevent this from amounting to the provision of a retail

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<sup>7</sup> Exhibit SF1

<sup>8</sup> Exhibit SF10

<sup>9</sup> *Netto Marken*, Case C-420/13

service. Consequently, I find that there has been genuine use for online retail services in relation to clothing. Whilst I bear in mind that the opponent's retail services relate to a broader range of goods than just clothing alone, I find the evidence filed to be insufficiently solid to support a finding of genuine use for any broader range of goods. Consequently, I consider a fair specification for the Third Earlier Mark to be:<sup>10</sup>

Class 35 Online retail store services in the field of clothing.

### **Section 5(2)(b) – case law**

30. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

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

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

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

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

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<sup>10</sup> *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

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

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

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

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

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

32. 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.

33. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

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

*v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”*

### Class 3

*Cosmetics; perfumes; cosmetic creams; false nails; make-up removing preparations; nail care preparations; nail varnish; sunscreen preparations.*

34. These terms appear identically in the specification of the First Earlier Mark.

*Make-up; anti-wrinkle cream; beauty creams; cosmetic preparations for baths; eye cream; face and body lotions; facial beauty masks; hand masks for skin care; make-up kits comprised of cosmetics and makeup, non-medicated skin care preparations, cosmetic creams, beauty creams, face and body lotions, facial cleansers, skin cleansers, facial beauty masks, skin toners, non-medicated exfoliating preparations for skin and face, night cream, makeup removing preparations, non-medicated skin serums, eye cream; night cream; non-medicated skin care preparations; non-medicated skin serums; skin toners; tissues impregnated with cosmetic lotions.*

35. All of these terms are identical on the principle outlined in *Meric* to “cosmetics” in the specification of the First Earlier Mark.

*Cologne; fragrances; eau de cologne; sachets for perfuming linen; scented linen water.*

36. These terms are identical on the principle outlined in *Meric* to “perfumes” in the specification of the First Earlier Mark.

*Dentifrices.*

37. This term is self-evidently identical to the term “dentifrice” in the specification of the First Earlier Mark.

*Toothpaste; non-medicated mouthwashes;*

38. My understanding is that the term “dentifrice” in the specification of the First Earlier Mark covers any substance used for cleaning the teeth. Consequently, both of these terms will fall within that broader category and will be identical on the principle outlined in *Meric*.

*Bath preparations, not for medical purposes; deodorant soap; facial cleansers; non-medicated bar soap; non-medicated exfoliating preparations for skin and face; non-medicated toiletry preparations; skin cleansers.*

39. These terms are identical on the principle outlined in *Meric* to “cleaning preparations” in the specification of the First Earlier Mark.

*Cuticle removing preparations; nail buffing preparations; nail cream; nail varnish removers.*

40. These terms are identical on the principle outlined in *Meric* to “nail care preparations” in the specification of the First Earlier Mark.

*Essential oils.*

41. This term is identical on the principle outlined in *Meric* to “oils for cosmetic purposes” in the specification of the First Earlier Mark.

*Oils for toiletry purposes.*

42. In my view, this is likely to be synonymous with the term “oils for cosmetic purposes” in the specification of the First Earlier Mark. Consequently, I consider them to be identical. However, even if that is not the case, they will overlap in nature, method of use, trade channels and user with the opponent’s goods. Consequently, they will be highly similar.

*Sunscreen creams; sunscreen sticks.*

43. These terms are identical on the principle outlined in *Meric* to “sunscreen preparations” in the specification of the First Earlier Mark.

#### Class 9

*Downloadable software applications for mobile phones; computer programs, downloadable; computer software applications, downloadable.*

44. These goods are all types of downloadable software and are, therefore, identical on the principle outlined in *Meric* to “computer software applications, downloadable, none of the aforesaid being for footwear, shoe inserts, insoles, socks orthopaedic products and/or the production of such goods” in the specification of the First Earlier Mark.

*Downloadable e-wallets.*

45. I understand this term to refer to a type of downloadable software that stores payment information and allows digital transactions. Consequently, I find this term to be identical on the principle outlined in *Meric* to “software applications, downloadable, none of the aforesaid being for footwear, shoe inserts, insoles, socks orthopaedic products and/or the production of such goods” in the specification of the First Earlier Mark.

*Computer programs, recorded.*

46. My understanding is that this term refers to computer programs which are recorded on a physical medium rather than being downloadable per se. However, these goods will overlap in purpose, nature (to the extent that they are both types of software), user and trade channels with the term “software applications, downloadable, none of the aforesaid being for footwear, shoe inserts, insoles, socks orthopaedic products and/or the production of such goods” in the specification of the First Earlier Mark. There will

also be an element of competition between them, given the overlapping purpose. Consequently, I find the goods to be similar to a high degree.

*Eyeglasses.*

47. This term appears identically in the specification of the First Earlier Mark.

#### Class 14

*Jewelry; costume jewelry; necklaces; earrings; bracelets; rings; brooches; watches; hat ornaments of precious metal; pins being jewelry.*

48. All of these goods are likely to be sold through the same trade channels as the term “hair clips” in the specification of the First Earlier Mark. Whilst I bear in mind that it will not always be the case, there will be some instances of these goods being made of the same materials (such as bridal hair clips which are made of metal and precious stones). There may be an overlap in trade channels, and the goods will be sold to the same users. The method of use and purpose will overlap to the extent that they are intended to adorn the body, although the specific method of use/purpose will differ. Given the differing specific purposes, I do not consider competition likely. Taking all of this into account, I find the goods to be similar to at least a medium degree.

#### Class 18

*Wallets; purses; knapsacks; suitcases; beach bags; all-purpose sports bags; book bags; travel utensils made of leather, namely, travel cases; shopping bags, namely, leather shopping bag, textile shopping bag; travel kits, namely, travel cases; string bags for shopping.*

49. These goods are likely to be sold through the same trade channels to the same users as “clothing, excluding footwear and socks” in the specification of the Second Earlier Mark. The purpose of the goods will differ, as will the method of use and nature. In my view, there is between a low and medium degree of similarity between these

goods. I can see no other point of similarity in the opponent's specifications which put it in any stronger position.

*Handbags.*

50. These goods are likely to be sold through the same trade channels to the same user as "clothing, excluding footwear and socks" in the specification of the Second Earlier Mark. I also bear in mind that they are likely to be chosen as part of an outfit, resulting in aesthetic complementarity. Consequently, I find these goods to be similar to a medium degree.

Class 25

*Scarves; dresses; kimonos; shirts; tank tops; camisoles; blouses; T-shirts; knitwear, namely, knit tops, knit bottoms; sweaters; jumpers; coats; vests; parkas; capes; sweatshirts; lingerie; negligees; swimwear; jackets; blazers; leggings; jumpsuits; pants; trousers, shorts; shawls; bikinis; night gowns; pajamas; bathrobes; gloves; bras; bustiers; rainwear; aprons.*

51. These goods are identical on the principle outlined in *Meric* to "clothing, excluding footwear and socks" in the specification of the Second Earlier Mark.

*Shoes; flat shoes;<sup>11</sup> pumps; heels; sandals; boots; socks; belts for clothing; hats.*

52. These goods are likely to be sold through the same trade channels to the same user as "clothing, excluding footwear and socks" in the specification of the Second Earlier Mark. There is an overlap in purpose and method of use, as they will all be worn on the body for the purposes of protection from the elements/warmth. The nature may overlap, as there may be some common materials used for each. In my view, the goods are similar to at least a medium degree.

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<sup>11</sup> I note that in the specification of the Second Application this term appears as "flats" rather than "flat shoes", but I understand both to cover the same goods and so nothing will turn on this distinction.

## Class 26

*Hair clips; hair pins; belt buckles; Bobby pins; hat ornaments not of precious metal.*

53. All of these terms appear identically in the specification of the First Earlier Mark.

*Hair accessories, namely, jaw clips.*

54. This term is identical on the principle outlined in *Meric* to “hair clips” in the specification of the First Earlier Mark.

*Hat pins.*

55. This term is self-evidently identical or identical on the principle outlined in *Meric* to “hat pins for securing hats” in the specification of the First Earlier Mark.

## Class 35

*Online retail store services in relation to clothing [...]*

56. This term is self-evidently identical to “online retail services in the field of clothing” in the specification of the Third Earlier Mark.

*Online retail store services in relation to [...] accessories, footwear, and jewellery.<sup>12</sup>*

57. These services overlap in nature with “online retail services in the field of clothing” in the specification of the Third Earlier Mark, all being retail services provided online. However, they differ in the type of goods to which they relate. Despite this, there will be some overlap in method of use and purpose. There will clearly be an overlap in trade channels, as such services are often provided by the same undertakings, and they will be sold to the same users. In my view, these services are highly similar.

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<sup>12</sup> I note that in the specification of the Second Application this word “jewelry” is used instead of “jewellery” as shown here. However, given that the meaning is identical, nothing will turn on this.

*Provision of an online marketplace for buyers and sellers of goods and services.*

58. These services will overlap in nature with “online retail services in the field of clothing” in the specification of the Third Earlier Mark in that they are services aimed at selling goods which are provided online. There will also be an overlap in method of use and purpose for the same reason. However, the fact that these are in the form of an online marketplace will create a point of difference. The trade channels are unlikely to overlap (in my experience, providers of online marketplaces are typically focussed on just that service, as opposed to other types of retail), but the user will be the same. There may also be an element of competition. In my view, these services are similar to at least a medium degree.

*Sales promotion for others; Advertising services.*

59. These services overlap in purpose and nature with “online retail services in the field of clothing” because retail and sales promotion/advertising are ultimately intended to help sell a product/service. The method of use is likely to differ. There is unlikely to be any overlap in trade channels, as advertising/sales promotion services are likely to be offered by specialist businesses, which are unlikely to also offer a retail service. The user may overlap only to the extent that the services are all capable of being used by the general public. There is no obvious competition or complementarity. Consequently, I find the services to be similar to a low degree.

#### Class 42

*Computer software design; Updating of computer software.*

60. These services relate to the creation and maintenance of computer software. They are, therefore, likely to overlap in user and trade channels with “computer software applications, downloadable, none of the aforesaid being for footwear, shoe inserts, insoles, socks orthopaedic products and/or the production of such goods” in the specification of the First Earlier Mark. They will also be important or indispensable for each other such that the average consumer would expect the same undertaking to be

responsible for both. Consequently, I find the goods and services to be similar to a medium degree.

*Information technology [IT] consultancy.*

61. This is a broad term which could encompass both of the terms discussed in the previous paragraph. Consequently, I find these services to be similar to “computer software applications, downloadable, none of the aforesaid being for footwear, shoe inserts, insoles, socks orthopaedic products and/or the production of such goods” in the specification of the First Earlier Mark to a medium degree, for the same reasons.

*Software as a service [SaaS].*

62. These services are likely to overlap in purpose and method of use with “computer software applications, downloadable, none of the aforesaid being for footwear, shoe inserts, insoles, socks orthopaedic products and/or the production of such goods” in the specification of the First Earlier Mark. The nature will differ as one is a service and the other is not. However, the goods and services are likely to be in competition with each other and are likely to be provided through the same trade channels to the same users. Consequently, I find them to be highly similar.

**The average consumer and the nature of the purchasing act**

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

64. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

65. The average consumer for the goods and services is likely to include both members of the general public and business users. The goods and services will vary in frequency of purchase and cost, but they are unlikely to be every day/very low-cost purchases. In my view, factors such as aesthetics, functionality and/or ease of use are likely to be considered for the goods, and factors such as useability, customer service standards and/or qualifications of service provider are likely to be considered when purchasing the services. In my view, at least a medium degree of attention will be paid

during the purchasing process, but it may be higher where the goods/services are technical in nature, attract a particularly high cost or are purchased for the benefit of the user's business.

66. The goods are likely to be purchased following self-selection from retail outlets or online/app store equivalents. Similarly, the services are likely to be purchased following perusal of signage on physical premises, websites or advertisements. Consequently, the purchasing process is likely to be predominantly visual. However, I do not discount an aural component to the purchase given that word-of-mouth recommendations may play a part and/or advice from retail assistants may be sought.

### **Comparison of trade marks**

67. It is clear from *Sabel* 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 impression created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

69. The respective trade marks are shown below:

Opponent's trade marks <sup>13</sup>	Applicant's trade marks
<p><b>SHEIN</b></p>	<p>shien (the First Application)</p> <p><b>shien诗恩</b> (the Second Application)</p>

### Overall Impression

70. The First Application consists of the word SHIEN in lower case. There are no other elements to contribute the overall impression which lies in the word itself.

71. The Second Application consists of the word SHIEN in a lower case, minimally stylised font. This is presented alongside two characters which appear to be from a different language. The eye is naturally drawn to the element of the mark that can be read by the UK consumer, and so the word SHIEN plays the greater role in the overall impression. The stylisation and characters play a lesser role.

72. The earlier marks consists of the word SHEIN in a minimally stylised font. The word itself plays the greatest role in the overall impression with the stylisation playing a lesser role.

### Visual Comparison

73. Visually, the First Application and the earlier marks overlap in the presence of the same 5 letters, albeit the letters E and I are reversed. The First Application is a word only mark, and so could be used in any typeface. Whilst I bear in mind that differences

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<sup>13</sup> I note that the Third Earlier Mark appears slightly differently to the First and Second Earlier Marks. This appears to me to simply be a result of the way that the mark has been captured. However, for the avoidance of doubt, it differs in such minor ways to the First and Second Earlier Marks that the comparison I set out here applies equally to it.

in shorter marks tend to make more of an impact, the fact that the reversed letters appear in the middle of the mark makes their impact less noticeable. In my view, the marks are visually highly similar.

74. Visually, the same applies to the comparison with the Second Application, with the additional point of difference created by the characters at the end of the mark (and which are absent from the earlier marks). The differences in case/font are also points of visual difference, albeit very minimal in their impact. In my view, the marks are visually similar to between a medium and high degree.

#### Aural Comparison

75. Aurally, the First Application is an invented word, meaning there may be a number of different ways that it will be pronounced. In my view, it is most likely to be pronounced as SHINE or SHEEN. I also find the earlier marks are likely to be pronounced in the same way. Consequently, I find that they are aurally identical. If I am wrong in that finding, then any difference in pronunciation will be minimal and they will be aurally highly similar.

76. Aurally, the characters at the end of the Second Application will not be articulated by the UK average consumer. Consequently, the same findings apply as discussed in the previous paragraph.

#### Conceptual Comparison

77. Conceptually, I find that the words SHIEN/SHEIN are invented and are unlikely to be attributed any meaning by the average consumer. I also find that no meaning will be attributed to the characters at the end of the Second Application. Consequently, I do not consider that any meaning will be conveyed by any of the marks in issue and the conceptual position is neutral.

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

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

79. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods/services, to those with high inherent distinctive character, such as invented words with no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

80. The earlier marks consist of the word SHEIN in a slightly stylised font. The word SHEIN is an invented word which has no meaning. In my view, it is inherently distinctive to a high degree. I do not consider that the minimal stylisation contributes

to the distinctiveness to any meaningful degree. Whilst I would have found the distinctiveness of the earlier marks to have been enhanced through use for at least some of the goods/services in issue, I will proceed on the basis of the inherent distinctiveness of the marks alone for the purposes of assessing this ground of opposition.

### **Likelihood of confusion**

81. 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 them 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 goods and services may be offset by a greater degree of similarity between the marks, 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.

82. I have found as follows:

- a. The goods and services vary from being identical to similar to a low degree.
- b. The average consumer for the goods and services will include both members of the general public and business users, who will pay at least a medium degree of attention during the purchasing process (although, in some circumstances, it may be higher).

- c. The First Application and the earlier marks are visually highly similar, aurally identical or highly similar (depending on how they are pronounced) and conceptually neutral.
- d. The Second Application and the earlier marks are visually similar to between a medium and high degree, aurally identical or highly similar (depending on how they are pronounced) and conceptually neutral.
- e. The earlier marks are inherently distinctive to a high degree.

83. Given the similarity of the marks, I find it likely that there will be direct confusion in respect of both applications. This is because the difference in the order of the letters I and E in the words SHEIN/SHIEN (which are invented) is likely to be overlooked and, in respect of the Second Application, the characters (which will convey no meaning for the average consumer) are also likely to be overlooked, particularly given their position at the end of the mark. Further, taking account of the interdependency principle, I find that this will apply for all of the goods and services that I have found to be similar or identical. This is because the distance between the goods and services (where they are similar to only a low degree) will be offset by the similarity of the marks. Consequently, I find there to be a likelihood of direct confusion for all goods and services.

84. In respect of the Second Application, if I am wrong in my finding that the characters at the end of the mark will be overlooked, I find that there is still a likelihood of indirect confusion. This is because the words SHEIN/SHIEN are still likely to be mistakenly recalled or misremembered as each other, and the addition of the foreign language character is likely to be viewed as simply a translation of the word itself. Consequently, I find there to be a likelihood of indirect confusion for all goods and services.

85. The oppositions based upon section 5(2)(b) of the Act succeed in their entirety.

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

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

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom 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.”

87. Section 5(3A) of the Act states:

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

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

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

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29 and Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks

and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in

order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

89. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks and the applications are similar. Secondly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the earlier marks being brought to mind by the later marks. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods/services 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.

### **Similarity of the marks**

90. For the reasons given above, I find the marks to be similar.

### **Reputation**

91. 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."

92. The opponent's UK website has been active since at least 25 December 2016.<sup>14</sup> That represents a period of just under 8 years of trade at the relevant date. By January 2024, the opponent had a market share of 2.2% in the UK clothing market.<sup>15</sup> To put this into context, well known fashion retailer Zara had a market share of 2.4% at that time. I bear in mind that this is some 5 months after the relevant date. However, there is also evidence that during the 16 months leading up to the end of 2022, the opponent's UK business made £1.1 billion in sales, suggesting that the opponent also had a strong market share prior to the relevant date.<sup>16</sup> Although I do not have evidence of actual sales of individual products, the evidence of the scale of the opponent's business in relation to clothing is further supported by the evidence already discussed regarding the number of UK visitors to the opponent's website and app. The opponent's promotional activities prior to the relevant date include the online festivals called SHEIN TOGETHER held during the Covid-19 pandemic, which took place in 2020 and 2021. These featured music acts such as Katy Perry and Rita Ora. I bear in mind that no UK specific advertising figures have been provided. However, taking the evidence as a whole into account, I am satisfied that the opponent had a reasonable reputation for clothing and online retail of clothing at the relevant date.

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<sup>14</sup> Exhibit SF8

<sup>15</sup> Exhibit SF9

<sup>16</sup> Exhibit SF10

## Link

93. 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 (i) the degree of similarity between the conflicting marks; (ii) the nature of the goods and services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods and services, and the relevant section of the public; (iii) the strength of the earlier mark's reputation; (iv) the degree of the earlier mark's distinctive character, whether inherent or acquired through use and (v) whether there is a likelihood of confusion.

### The degree of similarity between the conflicting marks

94. I apply the same findings set out above regarding the similarity of the marks.

### 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

95. Whilst I have carried out a comparison of goods and services above, I must decide the issue anew here, accounting only for those goods and services that I have found the opponent benefits from a reputation in.

### Class 3

96. The applicant's goods in this class are, broadly speaking, cosmetics and toiletries. Clearly, these goods differ in nature, purpose and method of use to the goods for which the opponent has a reputation. The user will plainly overlap, as they can all be used by members of the general public. In terms of trade channels, I bear in mind that there is evidence before me that the opponent does, in fact, sell beauty items (albeit I have no evidence as to what degree). Whilst I do not find the goods to be similar as such, I accept that there may be a degree of connection between them as large fashion retailers can, in some circumstances, expand into the cosmetics/toiletries sector.

### Class 9

97. Insofar as the goods in this class are software related goods, there is plainly no overlap in nature, method of use or purpose. The applicant's goods are not limited to any particular type of software (with the exception of those that relate to e-wallets, which are plainly connected with retail), meaning they could include software which relates to the retail sector. As shown in the opponent's evidence, businesses that retail clothing can have their own software to enable them to do so. There may, therefore, be an overlap in trade channels. The user will also be the same. Consequently, I find the goods to be similar to a low degree.

98. With regard to *eyeglasses* in the applicant's specifications these plainly differ in nature and purpose from the goods and services for which the opponent has a reputation. There is some, albeit minimal, overlap in method of use in that the goods are all worn on the body. The user will plainly be the same. I accept that there may be some connection in terms of trade channels, because large fashion retailers can, in some circumstances, expand into eyewear. If the goods are not similar as such, there remains a connection between them.

### Classes 14 and 26

99. I find there to be an overlap in trade channels between the applicant's goods and those for which the opponent has a reputation, because it is not uncommon for fashion retailers to sell both clothing and jewellery/accessories to compliment those outfits. The users will plainly overlap. There is an overlap in method of use and purpose, to the extent that both goods are used to adorn the body. The nature of the goods will differ. In my view, there is a medium degree of similarity between the goods.

### Class 18

100. For the same reasons given above, I find there to be at least between a low and medium degree of similarity between the goods in this class and the opponent's clothing goods.

### Class 25

101. For the same reasons given above, the goods in this class will either be identical to the opponent's clothing goods or will be similar to a medium degree.

### Class 35

102. For the same reasons given above, the applicant's retail services will be either identical to those services for which the opponent has a reputation or highly similar.

103. As explained above, the applicant's marketplace services are similar to the opponent's services to a medium degree and the advertising/sales promotion services are similar to a low degree.

### Class 42

104. These services all relate to, or include, the creation, provision or maintenance of software. Plainly, clothing retailers can also provide mobile applications to their customers (as shown in the evidence). Consequently, whilst I do not find the goods and services to be similar as such, there is some connection between them.

### The strength of the earlier marks' reputation

105. The earlier marks had a reasonable reputation for clothing and online retail of clothing in the UK at the relevant date.

### The degree of the earlier marks' distinctive character, whether inherent or acquired through use

106. I apply the same findings here as set out above in relation to the inherent distinctiveness of the mark. Whilst the tests for reputation and enhanced distinctiveness are different, they take account of the same factors. In my view, for the same reasons given above, the distinctiveness of the earlier marks has been

enhanced to a very high degree through use in relation to clothing and online retail of clothing.

#### Whether there is a likelihood of confusion

107. For the same reasons given above, I find there to be a likelihood of confusion.

#### Conclusions on link

108. Taking all of the relevant factors into account, I find that a link will be made in the mind of the relevant public. This is particularly the case given the similarity of the marks and the distinctiveness of the earlier marks (both inherently and through use). In my view, against a backdrop where the opponent benefits from a reputation, the use of such similar marks in relation to goods or services which might be viewed as being connected to those that are offered by the opponent (such as part of its mobile application provision or an expansion into different areas of trade) is likely to result in the relevant public making a link between the marks. The common element is not a word for which common use might be attributed to coincidence. Consequently, I find a link is made out.

#### **Damage**

#### Unfair advantage

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

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is

most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

110. Where the relevant public believe that the goods and services of the applicant are those of the opponent, there will plainly be unfair advantage. In addition to this, the evidence shows that the opponent is associated with affordability, with the strap line “save money. Live in style!” appearing on UK social media.<sup>17</sup> Plainly, that is an image which is capable of being transferred to the applicant. It seems clear to me that there is unfair advantage. As the opponent has succeeded under this head of damage, I do not need to consider the remaining ones.

111. The oppositions based upon section 5(3) of the Act succeed in their entirety.

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

112. Given that the opponent has, in my view, succeeded very clearly under sections 5(2)(b) and 5(3) of the Act, I do not consider it necessary to assess the section 5(4)(a) ground in any detail. However, for the avoidance of doubt, I would also have found in the opponent’s favour under this ground. This is because the opponent plainly has goodwill in relation to clothing and retail services related to clothing. Those goods are at least connected to all of the goods and services in the specifications of the applications for the reasons given above. Given the connection between the fields of activity and the similarity of the marks/signs, there is plainly misrepresentation and damage.

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<sup>17</sup> Exhibit SF12

## CONCLUSION

113. The oppositions are successful in their entirety and, subject to any appeal, the applications are refused.

## COSTS

114. The opponent has been successful and is, therefore, entitled to a contribution towards its costs, based upon the scale set out in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of **£2,100**, calculated as follows:

Preparing Notices of opposition and considering the counterstatements	£400
Preparing evidence	£900
Preparing written submissions in lieu	£400
Official fees (x2)	£400
<b>Total</b>	<b>£2,100</b>

115. I therefore order Licheng District Shien Shoe Store to pay Roadget Business Pte. Ltd the sum of **£2,100**. This 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 15<sup>th</sup> day of June 2026**

**S WILSON**

**For the Registrar**

## ANNEX 1

### **The First Application**

#### Class 3

Cologne; cosmetics; dentifrices; fragrances; make-up; perfumes; toothpaste; anti-wrinkle cream; bath preparations, not for medical purposes; beauty creams; cosmetic creams; cosmetic preparations for baths; cuticle removing preparations; deodorant soap; eau de cologne; essential oils; eye cream; face and body lotions; facial beauty masks; facial cleansers; false nails; hand masks for skin care; make-up kits comprised of cosmetics and makeup, non-medicated skin care preparations, cosmetic creams, beauty creams, face and body lotions, facial cleansers, skin cleansers, facial beauty masks, skin toners, non-medicated exfoliating preparations for skin and face, night cream, makeup removing preparations, non-medicated skin serums, eye cream; make-up removing preparations; nail buffing preparations; nail care preparations; nail cream; nail varnish; nail varnish removers; night cream; non-medicated bar soap; non-medicated exfoliating preparations for skin and face; non-medicated mouthwashes; non-medicated skin care preparations; non-medicated skin serums; non-medicated toiletry preparations; oils for toiletry purposes; sachets for perfuming linen; scented linen water; skin cleansers; skin toners; sunscreen creams; sunscreen preparations; sunscreen sticks; tissues impregnated with cosmetic lotions.

#### Class 9

Downloadable software applications for mobile phones; computer programs, downloadable; computer software applications, downloadable; downloadable e-wallets; computer programs, recorded; eyeglasses.

#### Class 14

Jewelry; costume jewelry; necklaces; earrings; bracelets; rings; brooches; watches; hat ornaments of precious metal; pins being jewelry.

#### Class 18

Wallets; handbags; purses; knapsacks; suitcases; beach bags; all-purpose sports bags; book bags; travel utensils made of leather, namely, travel cases; shopping bags,

namely, leather shopping bag, textile shopping bag; travel kits, namely, travel cases; string bags for shopping.

### Class 25

Scarves; dresses; kimonos; shirts; tank tops; camisoles; blouses; T-shirts; knitwear, namely, knit tops, knit bottoms; sweaters; jumpers; coats; vests; parkas; capes; sweatshirts; lingerie; negligees; swimwear; jackets; blazers; leggings; jumpsuits; pants; trousers, shorts; shoes; flat shoes; pumps; heels; sandals; boots; shawls; socks; bikinis; night gowns; pajamas; bathrobes; gloves; bras; bustiers; rainwear; aprons; belts for clothing; hats.

### Class 26

Hair clips; hair accessories, namely, jaw clips; hair pins; hat pins; belt buckles; Bobby pins; hat ornaments not of precious metal.

### Class 35

Online retail store services in relation to clothing, accessories, footwear, and jewellery; provision of an online marketplace for buyers and sellers of goods and services; sales promotion for others; Advertising services.

### Class 42

Computer software design; Updating of computer software; software as a service [SaaS]; information technology [IT] consultancy.

## **The Second Application**

### Class 3

Cologne; cosmetics; dentifrices; fragrances; make-up; perfumes; toothpaste; anti-wrinkle cream; bath preparations, not for medical purposes; beauty creams; cosmetic creams; cosmetic preparations for baths; cuticle removing preparations; deodorant soap; eau de cologne; essential oils; eye cream; face and body lotions; facial beauty masks; facial cleansers; false nails; hand masks for skin care; make-up kits comprised of cosmetics and makeup, non-medicated skin care preparations, cosmetic creams, beauty creams, face and body lotions, facial cleansers, skin cleansers, facial beauty masks, skin toners, non-medicated exfoliating preparations for skin and face, night

cream, makeup removing preparations, non-medicated skin serums, eye cream; make-up removing preparations; nail buffing preparations; nail care preparations; nail cream; nail varnish; nail varnish removers; night cream; non-medicated bar soap; non-medicated exfoliating preparations for skin and face; non-medicated mouthwashes; non-medicated skin care preparations; non-medicated skin serums; non-medicated toiletry preparations; oils for toiletry purposes; sachets for perfuming linen; scented linen water; skin cleansers; skin toners; sunscreen creams; sunscreen preparations; sunscreen sticks; tissues impregnated with cosmetic lotions.

#### Class 9

Downloadable software applications for mobile phones; computer programs, downloadable; computer software applications, downloadable; downloadable e-wallets; computer programs, recorded; eyeglasses.

#### Class 14

Jewelry; costume jewelry; necklaces; earrings; bracelets; rings; brooches; watches; hat ornaments of precious metal; pins being jewelry.

#### Class 18

Wallets; handbags; purses; knapsacks; suitcases; beach bags; all-purpose sports bags; book bags; travel utensils made of leather, namely, travel cases; shopping bags, namely, leather shopping bag, textile shopping bag; travel kits, namely, travel cases; string bags for shopping.

#### Class 25

Scarves; dresses; kimonos; shirts; tank tops; camisoles; blouses; T-shirts; knitwear, namely, knit tops, knit bottoms; sweaters; jumpers; coats; vests; parkas; capes; sweatshirts; lingerie; negligees; swimwear; jackets; blazers; leggings; jumpsuits; pants; trousers, shorts; shoes; flats; pumps; heels; sandals; boots; shawls; socks; bikinis; night gowns; pajamas; bathrobes; gloves; bras; bustiers; rainwear; aprons; belts for clothing; hats.

Class 26

Hair clips; hair accessories, namely, jaw clips; hair pins; hat pins; belt buckles; Bobby pins; hat ornaments not of precious metal.

Class 35

Online retail store services in the fields of clothing, accessories, footwear, and jewelry; provision of an online marketplace for buyers and sellers of goods and services; sales promotion for others; Advertising services.

Class 42

Computer software design; Updating of computer software; software as a service [SaaS]; information technology [IT] consultancy.

## ANNEX 2

### **The First Earlier Mark**

#### Class 3

Cosmetics; Make-up powder; Powder (Make-up -); Eyebrow cosmetics; Eyebrow pencils; Pencils (Eyebrow -); Cosmetic creams; Creams (Cosmetic -); Mascara; Lipsticks; Beauty masks; Cleaning preparations; Cosmetic kits; Adhesives for cosmetic purposes; Cotton sticks for cosmetic purposes; Dentifrice; Eyelashes (False -); False eyelashes; Nails (False -); False nails; Hair dyes; Hair straightening preparations; Lip glosses; Lipstick cases; Make-up preparations; Make-up removing preparations; Nail varnish; Nail care preparations; Oils for cosmetic purposes; Perfumes; Shoe polish; Skin whitening creams; Sunscreen preparations.

#### Class 9

Phone cases; Eyeglasses; Digital photo frames; Bathroom scales; Sunglasses; Computer software applications, downloadable, none of the aforesaid being for footwear, shoe inserts, insoles, socks orthopaedic products and/or the production of such goods; Spectacle cases; Spectacle frames; Remote control apparatus; Counters; all of the aforesaid not including goods in the orthopaedic sector.

#### Class 26

Hair clips; Claw clips [hair accessories]; Hair pins; Hat pins for securing hats; Belt buckles; Bobby pins; Hat ornaments, not of precious metal.

#### Class 42

Designing (Dress -); Dress designing; Graphic art design; Industrial design; Design (Industrial -); Information technology [IT] consultancy; Packaging design; Web site design consultancy; Cosmetic research; Computer programming; Computer software design; Consultancy in the design and development of computer hardware; Computer system analysis; Computer system design; Creating, maintaining and hosting the websites of others; Providing search engines for the internet; Creating and designing website-based indexes of information for others [information technology services].

## **The Second Earlier Mark**

### Class 25

Clothing, excluding footwear and socks; scarves; dresses; kimonos; shirts; tank tops; camisoles; blouses; t-shirts; knitted clothing; knitwear, namely, knit tops; knitted underwear; sweaters; jumpers; coats; vests; parkas; capes; sweatshirts; jerseys; hooded tops; sportswear; swimwear; jackets; blazers; suits; leggings (trousers); leggings (leg warmers); jumpsuits; pants; trousers; shorts; bikinis; loungewear; sleepwear; night gowns; pyjamas; bathrobes; gloves; bras; bustiers; lingerie; negligees; rainwear; aprons; belts for clothing; hats; shawls; aprons; fancy dress costumes.

## **The Third Earlier Mark**

### Class 14

Jewelry; costume jewelry; necklaces; ear-rings; bracelets; rings; brooches; watches; cuff links; charms; pins being jewelry.

### Class 18

Wallets; handbags; purses; knapsacks; suitcases; all-purpose sports bags; briefcases; travel suitcases; umbrellas and parasols; walking sticks; string bags for shopping.

### Class 35

Advertising, marketing and promotional services including commercial information and advice for consumer information in the choice of products and services; Business assistance, management and administrative services; Business analysis, research and information services; Sales promotion; Wholesale and retail services connected with clothing, luggage and carrying bags; On-line wholesale and retail services connected with clothing, luggage and carrying bags; On-line wholesale and retail services connected with clothing, luggage and carrying bags; import-export agencies; organization of trade fairs for commercial or advertising purposes.