

**O-0712-24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. UK00002222837**

**IN THE NAME OF AVON PRODUCTS, INC. FOR THE FOLLOWING TRADE MARK:**

**LITTLE BLACK DRESS**

**IN CLASS 3**

**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY**

**UNDER NO. 506049 BY FASHION VENTURES LIMITED**

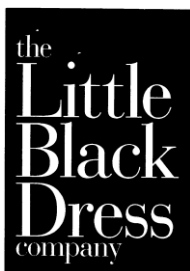
## Background and Pleadings

1. Avon Products, Inc. (“the proprietor”) is the owner of trade mark registration no. 2222837 for the mark **LITTLE BLACK DRESS** (“the contested mark”). The contested mark was filed in the United Kingdom on 18 February 2000 and registered on 5 January 2001. It stands registered for the following goods in class 3:

*Non-medicated toilet preparations; powders, creams and lotions, all for the face, hands and body; nail polish; nail polish remover; cosmetics; soaps; shower and bath preparations; preparations for the hair; preparations for cleaning the teeth; shaving and aftershave preparations; perfumes, colognes, toilet waters, eaux de Cologne; deodorants and anti-perspirants for personal use; toilet articles; essential oils.*

2. On 28 April 2023, Fashion Ventures Limited (“the applicant”) applied to have the contested mark declared invalid, in its entirety, under section 47 of the Trade Marks Act 1994 (“The Act”). The invalidation is brought under section 5(2)(b) of the Act, with the applicant seeking to rely upon the following trade marks and all goods for which they are registered, as laid out below:

United Kingdom Trade Mark (“UKTM”) 2216315:



Filing date: 6 December 1999

Registration date: 9 June 2000

*Girls' and ladies' jewellery, watches (class 14)*

*Girls' and ladies' bags, umbrellas, belts (class 18)*

*Girls' and ladies' skirts, blouses, jackets, trousers, coats, knitwear, lingerie, hosiery, nightwear, hats, footwear, scarves; but not including dresses or similar goods to dresses (class 25)*

UKTM 2220632:



*Girls' and ladies' jewellery, watches (class 14)*

*Girls' and ladies' bags, umbrellas, belts (class 18)*

*Girls' and ladies' skirts, blouses, jackets, trousers, coats, knitwear, lingerie, hosiery, nightwear, hats, footwear, scarves; but not including dresses or similar goods to dresses (class 25)*

Filing date: 29 January 2000

Registration date: 14 July 2000

3. The applicant claims that the similarity between the parties' respective goods and the high level of similarity between the respective trade marks gives rise to a likelihood of confusion, including a likelihood of association.

4. In its counterstatement, the proprietor submits that the similarity between the parties' respective marks is offset by the dissimilarity between the competing goods, such that a likelihood of confusion cannot be established. It also puts the applicant to proof of use in respect of both earlier marks.

5. The proprietor is represented by Baker & McKenzie LLP whilst the applicant is represented by Wilson Gunn. Only the applicant filed evidence during the course of

the proceedings. Neither party requested a hearing, though both parties elected instead to file written submissions in lieu. This decision is taken following a careful perusal of the papers.

### **Relevance of EU law**

6. 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.

### **Evidence**

7. The applicant's evidence comprises a witness statement from Mr Mark Christian Evans and 22 supporting exhibits. It is not clear from the witness statement in what capacity Mr Evans is acting specifically but he confirms that the facts within the witness statement originate from the accounts and records of the applicant and his own personal knowledge and that he is duly authorised to speak on the applicant's behalf. Mr Evans' statement is dated 18 September 2023.

8. I take the following from the applicant's evidence:

The applicant's UK website shows various dresses and shoes for sale and directs the user to various social media platforms. Data generated by the Wayback Machine shows that the site was active, and had been indexed, at various intervals between 2000 and 2023.

Mr Evans submits that, in the last twenty years, press and PR have been generated with a PR value of over £2 million via press articles, PR, magazine and celebrity gifting, advertorials and launches. Between 2019 and 2022, it invested £100,000 on photography; between 2020 and 2022 it spent £200,000 on digital advertising; between 2016 and 2018 it spent over £120,000 on celebrity endorsements and, over the last ten years it has invested over £100,000 in fees and expenses for trade shows throughout the UK.

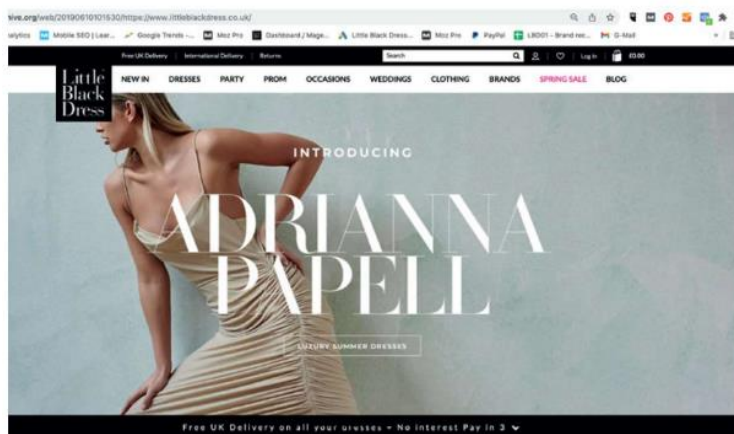
The applicant utilises platforms including Facebook, Instagram and YouTube to promote its brand, with examples of the latter two accounts also making reference to the cosmetics or beauty industry. Its Instagram account boasts over 21,900 followers.

Analytics data shows that, between 1 January 2005 and 27 April 2022, the applicant's website ([www.littleblackdress.co.uk](http://www.littleblackdress.co.uk)) was viewed over 97,000,000 times, amassing nearly 12,000,000 unique users.

Analytics from the same period also show a total of 109,440 transactions and a revenue of over £14million. The applicant provides a breakdown of its UK customer locations with London attracting the largest number of users (2,527,681).

The applicant also encloses several exhibits highlighting examples of various fashion brands and fashion houses which also operate within the cosmetics and/or beauty industry.

9. I enclose below a number of samples taken from the applicant's evidence:



10 June 2019

28 October 2020



UNIQUE + BOUTIQUE STYLE

**Little Black Dress**

THE ORIGINAL & AUTHORITY FOR LITTLE BLACK DRESSES. THE ultimate online destination for every day occasion

Page - Clothing (brand)

hello@littleblackdress.co.uk

littleblackdress.co.uk

**Photos** See All Photos

<https://ow.ly/1HRP5QPGh4Y>

Instagram

Search

Log in Sign up

## Decision

10. Section 47 of the Act reads as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D)-(2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

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

11. Section 5(2)(b) of the Act has application in invalidation proceedings because of the provisions set out in section 47(2)(a) of the Act. By virtue of this section, a registered trade mark may be declared invalid if there is an earlier trade mark which satisfies the conditions under section 5(2) of the Act and the owner of the earlier mark has not consented to the registration. In circumstances in which the earlier mark completed its registration process more than five years before the date of the application for invalidity, the use conditions must be met.

12. 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.”

13. Section 5A of the Act reads 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.”

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

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

15. The applicant’s marks qualify as earlier trade marks under the above provisions. As each mark had completed its registration process more than five years prior to the date of the application for invalidity, the use conditions must therefore be satisfied.

## **Proof of use**

16. The first issue is therefore whether, or to what extent, the applicant has shown genuine use of the earlier marks.

17. The relevant period for assessing use is the five-year period ending on the date of the application for invalidity. Consequently, the relevant period for these proceedings is 29 April 2018 to 28 April 2023.

18. In *easyGroup Ltd v Nuclei Ltd & Ors*<sup>1</sup>, 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 Bunderversammlung 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 11 Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C141/13 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].

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<sup>1</sup> [2023] EWCA Civ 1247

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].”

19. 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.

### **Form of the mark**

20. The applicant's evidence features examples of both its earlier marks, as registered. Though the majority goes to its mark ending '632, there are examples of its mark ending '215 displayed on packaging, for example. This is clearly use upon which the applicant can rely. In other exhibits, on the applicant's website for example, its mark is displayed as shown below:



Little  
Black  
Dress

The colours in which the earlier marks are registered are clearly displayed here in reverse, i.e. the words are presented in black upon a white background whereas, in the earlier marks, the background is black and the words are presented in white. It is well established that variant use of a mark is acceptable providing that it does not alter the mark's distinctive character<sup>2</sup>. I find this approach applicable here; the inverting of the colours has little bearing on the mark's distinctive character which continues to reside predominantly in its word elements.

### **Sufficient Use**

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

22. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as "warranted in the economic sector concerned to

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<sup>2</sup> See *Lactalis McLelland Limited v Arla Foods AMBA*

maintain or create a share in the market for the goods or services protected by the mark”.

23. I should first acknowledge that a portion of the applicant’s evidence falls outside of the relevant period. There are screenshots of its website, for example, and reference to various events or publications which came some years before. The transactions captured by Google Analytics, pertinent to a period spanning from 2005 to 2022, are not broken down into product type and no corresponding insight is provided in Mr Evans’ witness statement. That being said, there are examples of the applicant’s website from within the relevant period and both the Analytics data and that generated by the Wayback Machine show spikes of activity via the site and orders being placed during the relevant period. Mr Evans’ statement also confirms that the applicant invested £100,000 in photography between 2019 and 2022 and spent £200,000 on digital advertising between 2020 and 2022 in the promotion of its brand. Taking the evidence as a whole, and notwithstanding its deficiencies, I find the evidence sufficient to support a finding of genuine use and am satisfied that the applicant made an effort to create its own share of the market. However, in the absence of any supporting invoices (for example), or a comprehensive breakdown, I do not find the evidence sufficient to demonstrate use of all relied upon goods<sup>3</sup>. Viewing the wider picture and assessing what *is* shown in the applicant’s evidence, particularly the screenshots of its websites and any related articles (albeit outside of the relevant period), I find the evidence shows only a sample of the applicant’s class 25 goods. The headings displayed on the applicant’s website (within the relevant period) include “Dresses”, “Party”, “Occasions” and “Clothing”. In terms of imagery, much of the focus appears to be toward dresses, though I note these are excluded from the applicant’s specification(s). On that basis, I find it appropriate for the applicant to retain *girls’ and ladies’ skirts, blouses, jackets, trousers, coats, knitwear... but not including dresses or similar goods to dresses*.

## Case Law

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<sup>3</sup> *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10

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 Harmonisation 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.

The principles:

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

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

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

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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. Taking into account the fair specification arrived at earlier in the decision, the competing goods are as follows:

Applicant's goods	Proprietor's goods
<i>Girls' and ladies' skirts, blouses, jackets, trousers, coats, knitwear, but not including dresses or similar goods to dresses (class 25)</i>	<i>Non-medicated toilet preparations; powders, creams and lotions, all for the face, hands and body; nail polish; nail polish remover; cosmetics; soaps; shower and bath preparations; preparations for the hair; preparations for cleaning the teeth; shaving and</i>

	<i>aftershave preparations; perfumes, colognes, toilet waters, eaux de Cologne; deodorants and anti-perspirants for personal use; toilet articles; essential oils (class 3)</i>
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26. When approaching the comparison of the parties' goods, I keep in mind the relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity, which were as follows:

- (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.

27. In *Kurt Hesse v OHIM*,<sup>4</sup> the Court of Justice of the European Union (“CJEU”) stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*,<sup>5</sup> the General Court (“GC”) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

28. In its submissions, the applicant states the following in regard to the respective goods:

“14. The goods of the Later Registration are similar to the goods of the Earlier Registrations because it is common practice in the fashion industry for fashion houses to produce clothing, fashion accessories, such as jewellery and bags, and cosmetics and perfumes. Indeed, it is so common that cosmetics and perfumes are considered to be fashion accessories. The goods of the Later Registration are aimed at the same consumers as the goods of the Earlier Registrations and are provided through the same channels of trade, such as department stores.

...

20. Class 3 goods such as cosmetics, may have different functions and characteristics to those in class 25, namely clothing, however, the evidence provided by the Applicant unequivocally shows that fashion houses often offer cosmetics as part of their product line-up, a fact which the relevant consumer would be readily aware of.”

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<sup>4</sup> Case C-50/15 P

<sup>5</sup> Case T-325/06

29. In its own submissions, the proprietor states as follows:

“25. The Applicant provided evidence of very large multinational fashion houses and evidence that they produced perfumes. We consider that such evidence is irrelevant. These large fashion houses are exceptions, and it is not the norm for producers of goods in classes 14, 18 and 25 to also produce class 3 goods. Consumers would have the general understanding that producers of apparel goods such as those in class 14, 18 and 25 do not generally produce class 3 goods. We note that large companies such as Tesco sell both batteries and bananas but these goods are clearly not similar and so the evidence provided around this by Fashion Ventures Limited is not relevant in this case.

26. The Registrant denies that the respective goods coincide precisely in their nature, intended purposes, producers and trade channels and that they will be in competition or complementary. It is well established that clothing, footwear and headgear are dissimilar to personal care products falling within class 3.”

It directs me to several decisions including *Frag Comercio Internacional, SL, v OHIM*<sup>6</sup>. In paragraph 30 of that judgment the GC held that:

“Secondly, the Board of Appeal did not err in finding, in paragraph 20 of the contested decision, that the goods in Classes 18 and 25 covered by the earlier Community mark were not complementary in relation to the ‘perfumery’ in Class 3 covered by the mark applied for. In that regard, the Court has held previously that perfumery goods and leather goods in Class 18 cannot be considered similar. Perfumery goods and leather goods are plainly different as regards both their nature and their intended purpose or their method of use. Moreover, there is nothing that enables them to be regarded as in competition with each other or functionally complementary. The same conclusion must be drawn concerning

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<sup>6</sup> Case T-162/08

a comparison between perfumery goods and clothing in Class 25. Those goods, as of themselves, also differ as regards both their nature and their intended purpose or their method of use. There is nothing, either, that enables them to be regarded as in competition with each other or complementary (Case T-150/04 *Mülhens v OHIM – Minoronzoni (TOSCA BLU)* [2007] ECR II-2353, paragraphs 31 and 32).”

30. For the purpose of a comparison it is permissible to group goods or services together, as appropriate.<sup>7</sup>

*Perfumes, essential oils, colognes, eaux de Cologne*

31. I note the applicant’s submissions and the examples it has cited of various fashion houses and brands which have subsequently released a perfume, for example. However, it does not necessarily follow that they are to be deemed similar in a trade mark sense. There may be a coincidence in the goods’ users, insofar as each set of goods is purchased by the general public, but there is a distinction in the respective uses. Any similarity in the goods’ trade channels is likely to be fairly artificial and they are unlikely to be sold in any proximity. The goods are not in competition and they are not complementary to the extent that they are important or indispensable for one another. I find the goods are dissimilar.

*Powders, creams and lotions, all for the face, hands and body; nail polish; nail polish remover; cosmetics*

32. I apply much of my earlier reasoning to the consideration of the above goods. There may be some overlap in the goods’ respective users and I acknowledge the applicant’s submission insofar as it concerns cosmetics. However, I do not accept that cosmetics and perfume are so commonly produced by fashion brands that they have become “fashion accessories”. The goods are not used for the same purpose and any

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<sup>7</sup> *Separode Trade Mark* BL O-399-10 (AP)

coincidence in the respective trade channels is likely to be on a fairly broad basis. The goods are not similar in their physical nature nor are they competitive or complementary. I find no similarity.

*Soaps; shower and bath preparations; deodorants and anti-perspirants for personal use; preparations for the hair; preparations for cleaning the teeth; shaving and aftershave preparations*

33. I do not see how the above goods would engage any additional opportunity for similarity than those which have already been considered. Whilst there may be some coincidence in the goods' users, the uses are different and the physical nature is distinct. Any overlap in the goods' trade channels is likely to be reasonably artificial and the goods are not complementary or competitive. I find the goods dissimilar.

*Non-medicated toilet preparations; toilet waters, toilet articles*

34. Other than a very general opportunity for the goods to be purchased by the same consumers, I see little similarity between the above goods and those relied upon by the applicant. The goods' uses and their respective physical nature are distinct and they are not competitive nor complementary. Whilst there may be some limited opportunity for the goods to move via the same trade channels and be sold within the same (large) retail establishment, they are unlikely to be sold in any degree of vicinity to one another and I would not expect the average consumer to find it likely that the goods originate from a single or shared entity. The goods are dissimilar.

35. As some degree of similarity between the parties' goods and/or services is necessary to engage a likelihood of confusion,<sup>8</sup> the invalidation must be deemed unsuccessful.

## **Costs**

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<sup>8</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

36. The invalidation has failed in its entirety and the proprietor is therefore entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”)1/2023. In accordance with that TPN, I award costs as follows:

Considering the Application for Invalidation and

preparing a counterstatement: £200

Preparing written submissions in lieu of a hearing: £250

Total: £450

37. I order Fashion Ventures Limited to pay Avon Products, Inc. the sum of £450. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 29<sup>th</sup> day of July 2024**

**Laura Stephens**

**For the Registrar**