

O/0755/26

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBER
WO0000001797978**

BY SEMIRO JAPAN CO.,LTD

**AND A REQUEST FOR PROTECTION IN THE UK OF THE FOLLOWING TRADE
MARK:**

New Trip

IN CLASS 18

AND

AN OPPOSITION THERETO UNDER NUMBER OP000450328

BY TRIPP LIMITED

BACKGROUND AND PLEADINGS

1. International trade mark 1797978 (“**the IR**”) consists of the sign shown on the cover page of this decision and stands registered in the name of Semiro Japan CO.,LTD (“**the Holder**”). The IR is registered in the International Register with effect from 10 May 2024. With effect from the same date, the Holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement.

2. The Holder seeks protection of the IR in relation to the following goods:

Class 18: School bags; bags for campers; suitcases; handbags; backpacks; suitcases with wheels; key cases; haversacks; rucksacks; bags for sports.

3. The request to protect the IR was published for opposition purposes on 19 July 2024.

4. Tripp Limited (“**the Opponent**”) opposes the IR on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The Opponent relies upon the following earlier mark (“**the Earlier Mark**”):

UK trade mark number: UK00002561215

Representation: TRIPP

Filing date: 12 October 2010

Registration date: 25 March 2011

Relying upon the following goods:

Class 18: luggage, bags; suitcases, cabin bags; trolley bags; pilot bags; duffel bags.

5. By virtue of its earlier filing date, the above registration constitutes an earlier mark in accordance with section 6 of the Act. As the Earlier Mark was registered more

than five years prior to the designation date of the IR, this mark is subject to proof of use in accordance with section 6A of the Act.

6. The Opponent submits that the marks are similar, with TRIPP being highly distinctive for the use made of it and that the goods at issue are identical or very similar, resulting in a likelihood of confusion, including a likelihood of association.
7. The Holder filed a defence and counterstatement denying the grounds of the opposition and put the Opponent to proof of use for all goods relied upon by the Opponent. The Holder requests that the opposition be dismissed and that the IR be allowed to proceed to registration.
8. The Holder is represented by JINXUJIA and the Opponent is represented by Jensen & Son.

RELEVANCE OF EU LAW

9. 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 AND SUBMISSIONS

10. During the evidence rounds, neither party filed written submissions and only the Opponent filed evidence. This was in the form of a witness statement of Aidan Creedon, CEO of the Opponent, signed and dated 7 March 2025. The witness statement is accompanied by exhibits AC1 - AC10. Mr Creedon is duly authorised to provide evidence.
11. A hearing took place before me, by videoconference, on 6 August 2026. Prior to the hearing, the Opponent filed skeleton arguments. The Opponent was represented by David Moore of Jensen & Son. The Holder did not take part in the hearing or file written submissions in lieu.

12. I will not summarise the evidence and submissions here (either filed in writing or presented at the hearing), but I will refer to them as and where appropriate during this decision. This decision is taken following a careful consideration of all the papers.

DECISION

Proof of use

13. I will begin by assessing whether there has been genuine use of the Earlier Mark.

The law

14. Section 6A of the Act states:

“(1) This section applies where an application for registration of a trade mark has been published,

(a) 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

(b) 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.”

15. Section 100 of the Act states that:

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

16. The relevant period for the present assessment is the five-year period prior to the designation date of the IR, being 10 May 2024. The relevant period is, therefore, **11 May 2019 to 10 May 2024** (“*the relevant period*”). The onus is upon the Holder to prove that genuine use of the Earlier Mark was made in the relevant period.

17. 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*

Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky' [2008] ECR I9223, 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 subcategory 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].

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

‘19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

[...]

22. [...] it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal [...] comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.”

Assessment of the evidence of use

18. Mr Creedon provides the 2023 financial statement showing that the Opponent had a turnover of £28 million for that year.¹ The turnover figures are not broken down by reference to the goods relied upon, but the Opponent's annual report indicates that it "*operates in the suitcase and travel bags sector within the luggage industry*" and that "*turnover is attributable to one continuing activity, the retailing and wholesaling of luggage and travel goods*".² Mr Creedon also provides evidence showing that the Opponent, in 2020, occupied the 37.4% of the UK market share for bags and cases and in 2024 it occupied the 32.1% of the market share for suitcases.³
19. Mr Creedon reports that in 2020 the Opponent distributed its luggage, bags and accessories throughout the UK via 152 Debenhams stores and five brand outlets.⁴ Mr Creedon clarifies that after Debenhams stopped operating in late 2020, the Opponent maintained bricks-and-mortar retail through other physical stores located in various parts of the UK (i.e., Cheshire Oaks Designer Outlet, Ashford Designer Outlet, Boundary Outlet in Colne, Lancashire, Boundary Outlet in Walsall and Boundary Outlet in Newcastle upon Tyne).⁵ The evidence shows screenshots of Google Maps showing where the Opponent's outlets are located. I note that this part of the evidence is undated.
20. Mr Creedon indicates that the Opponent also markets via online channels, namely, the Opponent's website ('www.tripp.co.uk'), the Debenhams website, Amazon (since April 2018) and the Next platform ('www.next.co.uk').⁶ The evidence contains extracts from the Opponent's website⁷ and the Next platform⁸ showing wheeled suitcases and holdalls available for purchase. The evidence is undated.
21. The evidence relating to the Amazon website features a few extracts showing wheeled suitcases available for purchase. The evidence clearly targets the UK as

¹ Exhibit AC1.

² Exhibit AC1, pages 4 and 19.

³ Mr Creedon's witness statement and Exhibit AC10.

⁴ Mr Creedon's witness statement at [4].

⁵ Exhibit AC2.

⁶ Mr Creedon's witness statement at [5].

⁷ Exhibit AC3.

⁸ Exhibit AC5.

the prices shown are in pounds sterling. Although the evidence is undated, it also features some consumer reviews, dated between 26 July 2019 and 27 February 2025, relating to the wheeled suitcases being offered for sale.⁹

22. Mr Creedon also provides a series of extracts from UK third-party magazines and newspapers (e.g., the Daily Mail, The Independent, Expertviews, the Telegraph, Which, the Standard, The Sun), dated between June 2021 and July 2024, mentioning or reviewing TRIPP suitcases.¹⁰

23. The evidence shows a series of extracts from the Opponent's Instagram account ('trippluggage') advertising its wheeled suitcases. The posts in the evidence are dated between 14 August 2020 and September 2024. Although the evidence does not show the total number of followers for the Instagram account, the evidence shows some degree of consumer engagement in that the posts show "likes" that span from a low of 23 likes to a high of 2,365 likes.¹¹

24. Mr Creedon indicates that the Opponent advertises via both Instagram and Facebook, but no evidence has been provided in relation to the Facebook account. At the hearing, Mr Moore stated that the Opponent's Instagram posts are identically reproduced also on its Facebook account. However, no evidence has been provided to that effect.

25. Mr Creedon also reports that the Opponent regularly sends advertising emails to its database of over 2,500 customers.¹² Although I appreciate Mr Creedon's narrative evidence, I was not provided with further evidence showing the content of such advertising emails and how the Earlier Mark has been used in relation to the goods at hand.

26. The evidence also features some Feefo customer reviews, dated August/November 2020, relating to TRIPP wheeled suitcases.¹³ I note that the evidence also features some Trust Pilot customer reviews, however, these are all dated outside of the relevant period.¹⁴

⁹ Exhibit AC4.

¹⁰ Exhibit AC6.

¹¹ Exhibit AC7.

¹² Mr Creedon's witness statement at [10].

¹³ Exhibit AC 8.

¹⁴ Exhibit AC9.

27. Looking at the evidence as a whole, on the one hand, it is partially undated or dated outside of the relevant period, it does not contain advertising spend, product invoices or the volume of goods being distributed. On the other hand, the evidence shows that the Opponent's goods are offered for sale in the UK on the Opponent's online retail channels, that the Opponent registered £28 million in revenues for 2023 and that the Opponent occupied a significant percentage of its market share in 2024 for suitcases. The evidence also shows that the IR has been advertised on social media (i.e., the Opponent's Instagram account) within the relevant period, it has received various post-purchase customer reviews for its suitcase goods and it has received third-party mentions or reviews in online magazines.
28. Therefore, especially taking into account the relevant revenues in 2023 and the market share the Opponent occupied in 2024, I find that the Opponent has shown genuine use of the IR for suitcases (including wheeled suitcases).
29. Turning to the Opponent's bags and cases, the Opponent's annual report indicates that it also operates in the travel bags industry and the evidence shows that in 2020 the Opponent occupied the 37.4% of the UK market share for bags and cases. Although I appreciate that the Opponent did not provide further evidence to show use of the Earlier Mark for bags/cases, I note that for the Opponent to occupy more than 37% of the market share for bags/cases in 2020 it shows that, at least for part of the relevant period, the Opponent must have maintained a relevant commercialisation of these goods. Bearing in mind that there is not a *de minimis* rule, I find that the evidence provided sufficiently show genuine use of the Earlier Mark also for bags (including travel bags) and cases.
30. Below in this decision I will detail which goods I consider there has been genuine use for and what constitutes a fair specification.

Form of the mark

31. There is evidence of the Opponent using the word-only mark TRIPP, which will clearly be use upon which the Opponent can rely. The evidence also shows uses of the word TRIPP represented in a stylised manner as shown below:



32. The IR's distinctive character lies in the word TRIPP. The use of the mark in a different stylisation (i.e., spaced white letters and placed on a dark background) does not alter the distinctive character of the mark.¹⁵ Thus, it is an acceptable variant.

33. For the sake of completeness, I note the variant mark also contains some sort of symbol on its top right-hand side, perhaps either the ® or the © symbol. The symbol is too small in the evidence for me to clearly determine what it represents. In any case, this element, given its size and position, does not affect the mark's distinctiveness.

Fair specification

34. Having found use of the Earlier Mark, I must determine a fair specification upon which the Opponent is entitled to rely, bearing in mind the use that has been demonstrated.

35. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification. He said:

“244. As I described in *Maier v Asos*, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.

245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

¹⁵ *Lactalis McLelland Limited v Arla Foods AMBA* (Case BL O/265/22), at [14].

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other categories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

36. This approach was endorsed by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36:

“261. [...] First, there can be no doubt that an application to register a mark in respect of a broad category of goods or services may be made partly in bad faith in so far as the broad description includes distinct sub-categories of goods or services in relation to which the applicant never had any intention to use the mark, whether conditionally or otherwise. In my view, that emerges clearly from the decision of the CJEU in this case. The approach to be adopted in such a case was explored and explained by the Court of Appeal in *Merck KGaA v Merck Sharp & Dohme Corp* [2017] EWCA Civ 1834; [2018] ETMR 10, at paras 241-249 and, so far as I am aware, that approach has proved workable and appropriate and has stood the test of time, save that it must now be seen in light of the more recent guidance given by the CJEU in, for example: *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paras 36-53. There the CJEU explained, at para 40, that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use.”

37. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

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

38. From the above account of the evidence, it relates to suitcases (including wheeled suitcases), bags and cases. Mr Moore submitted that considering Mr Creedon’s evidence, the Opponent’s fair specification should be “*luggage, travel bags; suitcases, cabin bags*”.¹⁶ I agree with Mr Moore’s proposed specification. For the sake of clarity, regarding “*luggage*”, although I appreciate that this is a broad term

¹⁶ Mr Moore’s skeleton arguments at [10].

that identifies different articles to transport personal belonging, I remind myself that having found use for suitcases, bags and cases, having regard to these goods' purpose and intended use, it would be inappropriate for me to attempt to sub-divide "luggage" into narrower sub-categories.¹⁷ Accordingly, I find Mr Moore's proposed fair specification to be entirely acceptable:

Class 18 "*luggage, travel bags; suitcases, cabin bags*".

Section 5(2)(b)

39. Sections 5(2)(b) and 5A of the Act state:

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

[...]

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

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

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."

The principles

40. 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:

¹⁷ See *Pan World Brands Ltd v Tripp Ltd* (Extreme Trade Mark), BL O/161/07.

(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, 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

41. In comparing the respective specifications, all relevant factors should be considered.¹⁸ The relevant factors identified by Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [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.

¹⁸ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97.

42. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“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”.

43. Looking at the respective specifications, some terms are either identically reproduced or are *Meric* identical. For example, the Holder’s “*suitcases*” and “*suitcases with wheels*” in class 18 are identical to the Opponent’s “*suitcases*” in the same class.

44. For reasons which will later become apparent, I will first assess the likelihood of confusion where the respective marks are used in relation to identical goods.

The average consumer and the purchasing act

45. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.

46. 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;¹⁹ 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.

47. The average consumer of the goods at issue is likely to be a member of the general public. Whilst accounting for variations in price, overall, the goods are neither particularly expensive nor infrequent purchases, with considerations such as fashion trends, price, material, quality, and suitability (e.g., storage size and dimensions) taken into account in the selection process. For these reasons, I consider that a medium degree of attention will be undertaken in the purchasing process.

48. The goods are generally self-selected by the consumer from the shelves (or a display area) of a traditional retail outlet, or an online equivalent. This means that the mark will be seen and so the visual element of the mark will be the most significant (see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50). Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as word-of-mouth recommendations may be made.

¹⁹ *Lloyd Schuhfabrik Meyer*, Case C-342/97.

Comparison of trade marks

49. It is clear from *Sabel BV v Puma AG*, Case C-251/95 (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU states 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 relevant 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.”

50. 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 trade 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.

51. The marks to be compared are as follows:

The Opponent's Earlier Mark	The Holder's IR
TRIPP	New Trip

Overall impression

52. The Earlier Mark's overall impression lies in the misspelling of the single word "TRIPP" of which it is comprised.

53. The IR consists of the capitalised words "New Trip". Mr Moore, in his skeleton arguments, contends that the relevant consumers will perceive "New" as an ordinary adjective and they will discount it whilst perceiving "Trip" as the most striking component of the mark.²⁰ To this end, Mr Moore directed me to a previous decision from the Registrar where in comparing "The New Ivy League" and "THE IVY LEAGUE", the adjective "new" was found to be non-distinctive.²¹ Although I note Mr Moore's submissions, I remind myself that I am not bound by a previous Registry decision about different trade marks,²² not least because the impact of "New" in a given mark is dependent on its interplay with the other elements in the trade mark in question. In the case at hand, the Earlier Mark's distinctiveness lies in the misspelling of the word "TRIPP" which is not entirely reproduced in the IR which is comprised of the ordinary word combination "New" and "Trip", with "New" defining the following word "Trip". Therefore, I disagree with Mr Moore's submission, and I agree with the Holder that the IR's overall impression lies in the combination of the two words "New Trip" as they form a unitary meaning²³ (namely, a journey not previously undertaken).

Visual similarity

54. The Holder contends that the marks are visually different in that the Earlier Mark consists of a single five-letter word, whereas the IR is comprised of two words for a total of seven letters. Furthermore, although the marks overlap in the word "trip", this is placed at the end of the IR with the result that the marks differ in their beginnings which is where the consumers focus their attention.²⁴ Mr Moore

²⁰ Mr Moore's skeleton arguments at [20].

²¹ BL O/1124/23 at paragraph [32].

²² See BL O/669/19 at paragraphs [28] – [29].

²³ Holder's counterstatement at page 2 (paragraph c).

²⁴ Holder's counterstatement at page 2 (paragraphs a and b).

contends that the marks overlap in “trip” and the additional “P” in the Earlier Mark is a minor difference that will go unnoticed.²⁵

55. Although I appreciate the Holder’s submission that consumers generally pay more attention to the beginnings of marks, this is only a rule of thumb and since the consumers will perceive “New Trip” as a unit, they are likely to pay the same attention to both words in the mark. Furthermore, I do not find that the additional “P” in the Earlier Mark will go unnoticed: this is not only because changes in shorter marks are generally more likely to be noticed,²⁶ but also because the additional letter creates an unusual misspelling. Overall, I find the marks have a medium visual similarity.

Aural similarity

56. Mr Moore contends that consumers will voice “TRIPP” identically to the English dictionary word “trip” notwithstanding the additional “P”.²⁷ The Holder argues that the addition of “New” and the combination of the two words “New Trip” creates a different aural impression from the Earlier Mark.²⁸

57. I agree with Mr Moore that consumers will pronounce the Earlier Mark as the dictionary word “trip”. Therefore, the respective marks overlap in their sound “trip” but differ in the additional “New” in the IR. Overall, the marks have a medium degree of aural similarity.

Conceptual similarity

58. The Holder contends that the marks are conceptually different because the relevant consumers will not extract the word “trip” from the Earlier Mark.²⁹ Mr Moore contends that notwithstanding the addition of “P” to “TRIPP”, consumers will understand the Earlier Mark as communicating the idea of travel, especially when seen in connection with the goods (i.e., suitcases).³⁰ Bearing in mind that it is open to me to assess the respective marks’ meaning in relation to the registered (or

²⁵ Mr Moore’s skeleton arguments at paragraph [21].

²⁶ See *Robert Bosch GmbH v Bosco Brands UK Limited*, BL O/301/20, paragraph [38].

²⁷ Mr Moore’s skeleton arguments at paragraph [22].

²⁸ Holder’s counterstatement at page 2 and 3.

²⁹ Holder’s counterstatement at page 3.

³⁰ Mr Moore’s skeleton arguments at paragraph [23].

applied for) goods,³¹ I agree with the Opponent that both marks allude to the idea of “a journey” or “travel”. The marks differ insofar as the IR contains the additional word “new”. Mr Moore provided dictionary extracts for the word “new” indicating “something that has been recently created” or that has “never been used or owned by anyone”.³² Although I appreciate Mr Moore’s submission, I am of the view that the combination of “new” and “trip” will convey the meaning of “another journey” or “a journey not previously undertaken”. I find the marks to have a medium degree of conceptual similarity.

Distinctive character of the Earlier Mark

59. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

³¹ BL O/1174/25 at [32].

³² Mr Moore’s skeleton arguments at paragraph [17].

60. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.
61. Dealing first with the Earlier Mark's inherent distinctiveness, it consists of the unusual misspelling of the English dictionary word "trip". Mr Moore contends that the Earlier Mark has a "normal" or "medium" degree of inherent distinctiveness.³³ Taking into account the mark's misspelling and the fact that the consumers will understand the mark as alluding to a meaning (i.e., a journey) that has some semantic connection to the goods at hand (suitcases), I find that the Earlier Mark has a between low and medium degree of inherent distinctiveness.
62. Turning to the question of whether the inherent distinctiveness of the Earlier Mark has been enhanced through use, the Opponent has filed evidence of use. I already provided my account of the Opponent's evidence at paragraphs [18] – [28]. Following from my assessment of the evidence, the Opponent showed relevant revenues for the year 2023 in relation to its goods. Although I appreciate that the revenues are not broken down by goods, the Opponent has occupied a relevant market share for suitcases and bags/cases respectively in 2024 and 2020. Therefore, I find that the mark's distinctiveness has been enhanced through use to a medium degree.

Likelihood of confusion

63. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead

³³ Mr Moore's skeleton arguments at paragraph [25].

rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

64. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other (*L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10).

65. I have already elected to proceed by considering the likelihood of confusion where the marks are used in relation to identical goods. The Earlier Mark has a between low and medium inherent distinctiveness. I found that the Earlier Mark's inherent distinctiveness has been enhanced through use to a medium degree.

66. The relevant consumer is the general public and is likely to pay a medium level of attention in the selection of the goods at issue. I found the visual, aural and conceptual similarity to be medium.

67. Weighing all of these factors, even taking into account the principle of imperfect recollection and accounting for the Earlier Mark's enhanced distinctiveness to a medium degree, I find that the relevant consumers are unlikely to look at "New Trip" in the IR, disregard the additional word "New", misremember the unusual misspelling "TRIPP" in the Earlier Mark and mistake one mark for the other. I reach this conclusion especially taking into account that the marks are visually similar to a medium degree and that the purchasing act is likely to be primarily visual for all of the goods at issue.³⁴

68. Accordingly, I do not consider there to be a likelihood of direct confusion.

69. It now falls to me to consider the likelihood of indirect confusion. The concept of indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the

³⁴ *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03.

later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example).³⁵

70. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.³⁶ I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.³⁶ The Court of Appeal has also emphasised

³⁵ *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

³⁶ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.³⁷

71. Mr Moore contends that consumers who have previously encountered the “TRIPP” brand and are subsequently presented with “New Trip”, will perceive “New Trip” as a sub-brand or brand extension of the Earlier Mark, indicating that the goods are new, updated, or recently introduced products originating from the “TRIPP” brand.³⁸

72. Although I appreciate Mr Moore’s submission, I do not believe that the relevant consumers will look at “New Trip” and, remembering the “TRIPP” mark, the distinctiveness of which lies mostly in the unusual misspelling, understand it as being economically associated. I do not see a logical reason for the Opponent to change its unusual misspelling of “TRIPP” to the ordinary dictionary word “Trip”, along with adding the adjective “New” to create a syntactically correct combination of English dictionary words conveying a partially different meaning from the Earlier Mark.

73. I find that indirect confusion is unlikely to occur between the respective marks at hand.

74. Having reached that conclusion in respect of identical goods, the Opponent would be in an inferior position were I to assess the likelihood of confusion based on similar goods. Therefore, it follows that there is no likelihood of confusion (both direct and indirect) for the remaining goods at hand.

CONCLUSION

75. The opposition fails in its entirety under section 5(2)(b) of the Act.

76. The Holder has been successful. Subject to any successful appeal, the application by Semiro Japan CO.,LTD for the IR designating the UK may proceed to registration.

³⁷ *Liverpool Gin Distillery*.

³⁸ Mr Moore’s witness statement at paragraph [24].

COSTS

77. The Holder is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice (“TPN”) 1/2023. I note that the Holder has filed a detailed counterstatement addressing all the relevant matters of the case at hand. I therefore intend to award the Holder with on-scale costs above the minimum amount as outlined in the TPN. Furthermore, as the Opponent has filed evidence, I cannot exclude that the Holder did not consider it even if no comments were filed by the Holder. I therefore award the Holder a reduced amount for considering the Opponent’s evidence. Bearing that scale in mind, I award costs to the Holder as follows:

Considering the notice of opposition and preparing the counterstatement	£500
Considering the other side’s evidence	£250
Total:	£750

78. I order Tripp Limited to pay Semiro Japan CO.,LTD the sum of £750. 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 20th day of August 2026

Andrea Rossi

For the Registrar