O/0806/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3839327
IN THE NAME OF YUEXIN (WUXI) APPAREL & ACCESSORIES CO., LTD
IN RESPECT OF THE TRADE MARK

FIORETTO

IN CLASS 18

AND

THE OPPOSITION THERETO UNDER NO. 438567
BY CENTRIC BRANDS INTERNATIONAL EUROPE LIMITED

Background and pleadings

1. YUEXIN (WUXI) APPAREL & ACCESSORIES CO., LTD ("the applicant") applied to register the trade mark no. 3839327 for the mark FIORETTO in the UK on 14 October 2022. It was accepted and published in the Trade Marks Journal on 28 October 2022 in respect of the following goods:

> Class 18: *Umbrellas; school bags; rucksacks; pocket wallets; lumbar packs; mountaineering sticks; handbags; travelling bags; clothing for pets; bags for sports.*

2. On 12 January 2023, Centric Brands International Europe Limited ("the opponent") opposed the trade mark on the basis of section 5(2)(b) and section 5(3) of the Trade Marks Act 1994 ("the Act"). This is on the basis of its earlier UK trade marks below:

> Marks relied upon under section 5(2)(b)
>
> 1. FIORELLI (UK registration no. 2195383 "the '383 mark")
>
> Application date: 22 April 1999
>
> Registration date: 12 December 2008
>
> Relying on all goods in class 18, namely: *Bags; handbags; purses; cases; wallets; clutchbags; tote bags; backpacks; shopping bags; shoulder bags; billfolds; key cases; cheque book covers; card cases; briefcases; attaché cases; luggage; travelling bags; suitcases; trunks; umbrellas.*
>
> 2. FIORELLI (UK registration no. 2219833 "the '833 mark")
>
> Application date: 19 January 2000
>
> Registration date: 12 December 2008
>
> Relying on all goods, namely class 25: *Clothing; footwear; headgear.*

3. FIORELLI SIGNATURE (UK registration no. 3458573 “the ‘573 mark”)

Application date: 16 January 2020

Registration date: 8 August 2020

Relying on all goods, namely goods in classes 18 & 25 as follows:

Class 18: *Bags; handbags; purses; wallets; carrying cases; clutch bags; tote bags; shoulder bags; backpacks; rucksacks; crossbody bags; shopping bags; casual bags; duffle bags; barrel bags; work bags; sport bags; beach bags; evening bags; key cases; credit card cases; briefcases; attaché cases; satchels; luggage; travelling bags; overnight bags; weekend bags; cabin bags; holdalls; suitcases; travelling trunks; cosmetic bags; toiletry bags; leather cases; umbrellas.*

Class 25: *Footwear; parts, fittings and accessories for the aforesaid goods.*

Marks relied upon under section 5(3)

1. The ‘383 mark as above.

2. The ‘833 mark as above.

3. By virtue of their earlier filing dates (and subsequent registration), the above marks constitute earlier marks in accordance with section 6 of the Act.

4. The opponent argues that the respective goods are identical or similar and that the marks are similar, and that as such there will be a likelihood of confusion including a likelihood of association, and that the application should therefore be refused under section 5(2)(b) of the Act. The opponent also argues that it holds a reputation in the UK under the mark FIORELLI and that the similarity of the marks, coupled with its reputation, will result in an unfair advantage for the applicant, in addition to detriment to the repute and distinctive character of the earlier mark. As such, the opponent submits the application should be refused under section 5(3) of the Act.

5. The applicant filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of its earlier ‘383 and ‘833 marks relied upon.

6. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Both parties filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

7. Both parties are represented in these proceedings. The applicant is represented by Trademarkit LLP**.** The opponent is represented by Marks & Clerk LLP.

8. 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

9. The opponent filed its evidence in the form of two witness statements. The first is a witness statement in the name of Michael Hiscock, managing director of the opponent. The statement is dated 30 June 2023. This statement introduces 26 exhibits, namely Exhibit 1 to Exhibit 26. Mr Hiscock’s statement and corresponding exhibits go to the use of the marks.

10. The second statement filed by the opponent is in the name of Sarah Chittock, Chartered Trade Mark Attorney at the opponent’s representative, Marks & Clerk LLP. This statement is dated 6 July 2023 and introduces four exhibits, namely Exhibit SC1 to Exhibit SC4. This statement and the corresponding exhibits go to the meaning of various aspects of the marks.

11. The opponent’s evidence will be considered in more detail later on in this decision.

12. The applicant’s evidence was filed in the form of a witness statement in the name of Aiquing Guo, president of the applicant. The statement is dated 6 September 2023

and introduces a single exhibit, namely Exhibit AG1. The statement and the corresponding exhibit go to the use of the applicant's own mark. This evidence is of little relevance to these proceedings for the following reasons:

- The fact that the applicant is trading under the mark in the UK has, in and of itself, no bearing on any assessment I must make under section 5(2)(b) or 5(3) of the Act;

- Mr Guo states the applicant began using its mark in the UK in November 2021. The relevant date in these proceedings is 14 October 2022. A lack of evidence of any confusion during the period of less than a year prior to the relevant date is not sufficient to have any persuasive effect on my assessment as to whether there may be a likelihood of confusion in the future; and

- Evidence of how the mark is currently used in its stylised form is not relevant to the assessment of a likelihood of confusion, or that in relation to the 5(3) ground, both of which must be conducted notionally between the mark as filed and the mark as registered. These assessments must consider all of the circumstances in which the applied for trade mark might be used if registered.[1]

13. For the reasons set out above, I do not find it necessary to consider the applicant's evidence further within this decision.

Proof of use

14. The relevant statutory provisions are as follows:

Section 6A:

"(1) This section applies where

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

[1] See *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited,* Case C-533/06

(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."

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. 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 I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken 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]."

17. In this instance it is for the opponent to prove genuine use of its earlier '383 and '833 marks, both of which were registered for more than five years on the application date of the applied for mark and which are therefore subject to proof of use provisions under section 6A of the Act. The opponent must prove use of its marks within the relevant territory of the UK and in respect of the goods relied upon, within the relevant period of 15 October 2017 – 14 October 2022.

Form of the mark

18. Before I asses the evidence further, I firstly consider whether the use of the mark shown in the evidence constitutes use of the mark as registered. The marks subject to proof of use in this instance are both FIORELLI. The filing of a word mark protects the words contained in the mark, whatever form, colour or typeface are used: see LA Superquimica v EUIPO, Case T-24/17, paragraph 39. I note this mark is used in both

upper and lower case in evidence, and this clearly constitutes fair and notional use of the mark as registered.

19. I also note the mark is also used in a slightly stylised form as FIORELLI. I consider in this respect, the case of *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, in which Mr Philip Johnson, as the Appointed Person, found that the use of the mark shown below qualified as use of the registered word-only mark DREAMS. This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use.

20. Similarly, it is my view that the opponent's use of FIORELLI does not alter the distinctive character of the word mark, and it constitutes fair and normal use of the word mark as filed. I therefore consider the use of the mark in this form to be use of an acceptable variant for the purpose of showing use (and reputation) of the marks as registered.

Use of the marks

21. In the applicant's final written submissions, it is stated:

> "[T]he evidence of use filed shows only use in respect of leather handbags and backpacks. Therefore, the fair use specification for the earlier registration No UK00002195385 and UK00002219833 must be limited to "Leather handbags and backpacks" where appropriate."

22. I take this as a concession from the applicant that the opponent has shown in its evidence genuine use of the marks in relation to these goods. I will therefore consider the evidence to see if I consider genuine use of the mark to have been made in relation to any further goods in this instance.

23. Within his statement, Mr Hiscock explains that the FIORELLI brand was first launched in the UK in 1990, and since then has specialised in the design, manufacture and distribution of clothing, jewellery, bags and other accessories.[2] He confirms that Exhibit 2 is an archived extract from their website dating from 17 August 2022.[3] The page provided at Exhibit 2 states:

> About Us
>
> Fiorelli is a non-leather accessories brand and we are proud to not use animal products. We believe a Fiorelli handbag is not just an accessory, it's the finishing touch to an outfit and a trusty companion to carry your essentials in style. Fusing fashion with function to elevate your everyday style is what we do.

24. Exhibit 3 provides archived pages from the opponent's website under the mark FIORELLI showing a range of handbags, shoulder bags, cross body bags, clutch bags and backpacks, all displaying the mark. Mr Hiscock explains that this exhibit includes pages from the website dating from May 2022.[4] Exhibit 4 also comprises pages from the opponent's website displaying the mark FIORELLI, showing a range of purses. Again, this appears to be an archived webpage but no date is provided in relation to this by Mr Hiscock. The date provided on the exhibit is that on which the page was saved on 1 June 2023. However, Exhibit 6 shows further pages from web archiving site, the Wayback Machine, dated between October 2017 and June 2022 again showing the mark FIORELLI in use in relation to a range of bags and purses. The bags include shoulder bags, handbags, tote bags, cross body bags and backpacks. Where prices are shown on the webpages these are all in GBP.

25. Mr Hiscock explains that the opponent's goods are sold through a variety of well-known retailers in the UK, including ASOS.com, Next, House of Fraser, Debenhams, John Lewis and Sports Direct.[5] He explains that Exhibit 7 is an archived webpage dating from 31 March 2021 of ASOS.com. The top of the page is entitled "Women's Fiorelli". This page shows bags and shoes were for sale in GBP under the mark FIORELLI, and also makes reference on the page to jewellery being sold by the

[2] See paragraph 6 of the witness statement of Mr Hiscock
[3] As above.
[4] See paragraph 7 of the witness statement of Mr Hiscock
[5] See paragraph 13 of the witness statement of Mr Hiscock

opponent under the same mark, although there is no jewellery shown for sale under the mark on this page. Only the image of trainers can be seen on this page as the other images do not appear to have loaded on the page, but other listings under the mark for shoes including sandals and loafers under the mark are shown without the image. Exhibit 8 shows archived webpages from the retailers Next, House of Fraser, Debenhams, Sports Direct and Libre London dating between April 2018 and August 2022. These pages mainly show bags and purses for sale under the mark FIORELLI, although there are a couple of shoes for sale also under this mark, those being floral and pink trainers. The webpages are either .co.uk domains or show the goods for sale in GBP (or both).

26. Exhibit 10 provides pages from the opponent's Instagram showing goods under the mark FIORELLI, namely bags and purses. There is also reference to a make-up and brush case. The posts date between November 2017 and August 2022. Exhibit 11 shows the opponent's Facebook page with posts between 28 October 2017 and April 2022 also showing goods under this mark including bags, purses, make-up and brush cases and a cardholder. Exhibit 12 is the opponent's twitter page showing bags, purses and a card holder also under the mark FIORELLI in posts dated between August 2019 and September 2022.

27. Exhibit 14 provides a further Instagram post dating from 17 August 2021 detailing the opponent's partnership with brand 'Pretty Ballerinas' to create a collection of bespoke shoes and handbags. Exhibit 16 shows the opponent's archived webpage referencing this collection. Mr Hiscock confirms this page dates from 18 October 2021.[6] The page states:

> "*Fiorelli has teamed up with family business and independent brand Pretty Ballerinas to create a capsule collection of beautiful bespoke shoes and handbags*"

28. Promotional articles relating to the opponent's bags under its mark FIORELLI are provided between Exhibit 18 and Exhibit 25. These include at Exhibit 20 a backpack under the mark included in a list of eight vegan handbags in a Mail Online article dated

[6] See paragraph 21(b) of the witness statement of Mr Hiscock

29 April 2021, and although I note the prices in this article are shown in US dollars, there other references to the UK on this page including reference to UK news and an encouragement to readers to follow '@DailyMailFashionFinderUK'. An article dating from 21 January 2021 on site 'FashionUnited' discussing the opponent's launch of its first recycled collection is also provided, displaying bags made from recycled bottles. The bags in the image provided appear to be backpacks worn on the beach. Prices for the bags are referred to in GBP. This article states:

> "*The Recover bags are all designed to be highly functional for everyday use and are made with extremely hardwearing materials and water-resistant, added the brand. The larger bags offer an internal padded section for a laptop, multiple internal and side pockets. The bags' long straps are adjustable, and the backpacks have padded back panels for added comfort."*

29. I also note the article provided from the website www.refinery29.com dating from 18 August 2021. This includes the opponent's bags in what it describes as a "guide to the very best of eBay's Brand Outlet", which it describes elsewhere as a go-to for big name designers. For completeness, I note this article references the opponent's goods available in the brand outlet as follows:

> *"Under £50 for a great quality leather bag? Yes please!"*

30. However, I note the reference to the goods being made of leather appears to contradict other elements of evidence including that provided from the opponent's website. A further article referring to "10 insanely cute gym bags that will motivate you to get out the house" dating from 9th February 2018 is also provided on www.popsugar.co.uk. This features the FIORELLI Sport Zip Backpack. Whilst the prices are given on the print out of the website in US dollars this is clearly on a UK domain and therefore appears to be targeted at a UK audience.

31. Approximate sales figures for goods under the mark are provided between April 2016 and December 2022 by Mr Hiscock in his statement as follows:

Time Frame	Approximate Annual Sales
April 2016 - March 2017	£20 million
April 2017 - March 2018	£21 million
April 2018 - March 2019	£18 million
April 2019 - March 2020	£18 million
April 2020 - March 2021	£18 million
January 2022 - December 2022	£4 million

32. Whilst I have not detailed all of the evidence provided above, I have reviewed and considered this in its entirety. From the sum of the evidence, it is clear that the opponent has clearly made fairly extensive use of its mark in the UK within the relevant period in relation to a variety of bags and purses, including use in relation to those listed within its specification under the '383 mark, namely:

> Class 18: *Bags; handbags; purses; cases; clutchbags; tote bags; backpacks shoulder bags.*

33. I have no doubt that its use in relation to these goods is genuine use in line with the relevant case law. It is clear from the evidence as a whole that this makes up the largest portion of the business, and it is in my view reasonable to assume that the majority of the sales figures, which are spread over the relevant period, will come from the use of its mark in relation to the same.

34. Further, I note there is use of the mark in relation to footwear, including sneaker type shoes, sandals, loafers and ballerina pumps. Considering the evidence as a whole, I also find it reasonable to assume that a portion of the sales figures provided will relate to sales of these goods in the UK within the relevant period. Whilst the business in relation to these goods appears to be much smaller, from the sum of the evidence I consider it to be genuine use with the intention of creating or maintaining an outlet for these goods within the relevant market. I therefore find the opponent has

made genuine use of its mark in relation to goods falling within the category of *footwear* in class 25 under its '833 mark.

Fair specification

35. I will now determine what I believe will be a fair specification under the marks based on the use shown. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law in this regard 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."

36. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

> "iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].
>
> iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].
>
> v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average

consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

The '383 mark

37. I note again the applicant submits a fair specification under this mark would be *Leather handbags and backpacks* only. I disagree with this assessment. Firstly, I note from the evidence that the goods sold under the mark do not appear to be made of leather. Whilst there is a third-party reference in the evidence to the goods being made from this material, and I note the applicant's "about us" page submitted at Exhibit 2 from within the relevant timeframe in 2022 states they are a "non-leather" brand. Further, I note the article at Exhibit 20 listing the opponent's goods amongst a list of vegan bags, and a further article at this exhibit discussing the opponent's range of goods under the mark made from plastic bottles. Again, both of these articles are from within the relevant period in 2021.

38. Further, I consider that the terms *handbags; clutchbags; tote bags; backpacks* and *shoulder bags* as included the opponent's class 18 are already defined by the type of bag offered, and they appear to be for a range of purposes including for general everyday use, as a fashion accessory, to be taken to work, for sports or for taking to an occasion. The terms used are in my view already how the opponent's range of goods would fairly be described by the consumer. To narrow these goods further by limiting these to various bags made from a particular type or types of material would be to award unreasonably narrow protection based on the nature of the goods, that in my view would not accord with how the consumer would fairly describe them.[7] Further, considering the opponent has shown use of the mark in respect of several types of 'bag' covering a number of uses within its evidence, I believe the average consumer would fairly describe the opponent as offering the broader category of 'bags' under the mark, and would not necessarily seek to break this down into further subcategories in this instance. I also consider the term 'purses' to be sufficiently narrow, and to be how the consumer would fairly describe the purses shown in evidence by the opponent.

39. The opponent's specification also includes the term *cases.* It is my view this term is broad and may cover a number of cases for different purposes. The opponent has shown it offers make up and make-up brush cases under the mark. It is my view this is how these goods would be fairly described by the average consumer.

40. Considering the above, I find the opponent may rely on the following fair specification under its earlier '383 mark within this opposition:

> Class 18: *Bags; handbags; clutchbags; tote bags; backpacks; shoulder bags; purses; make-up cases; make-up brush cases.*

[7] See *Polfarmex S.A. v EUIPO*, Case T-677/19, EU:T:2020:424, in which the General Court said it is the purpose or intended use of a product and not the nature or a characteristic of a product that is of importance in the definition of a subcategory of goods and services.

The ‘833 mark

41. The opponent has not filed any evidence sufficient to support a finding of genuine use in relation to clothing or headgear, but it has filed evidence of footwear being offered under the mark. It is my view that the category of footwear is fairly broad, and is capable of being broken down into a large number of sub-categories. However, I note from the evidence that a selection of women’s footwear has been offered under the mark including trainers, sandals, pumps and loafers. It is my view average consumer would fairly describe the goods offered as women’s shoes. I therefore find the opponent may rely on the ‘833 mark in respect of the following goods:

> Class 25: *Women’s shoes.*

Decision

Section 5(2)(b)

42. Section 5(2)(b) of the Act is as follows:

> “5(2) A trade mark shall not be registered if because-
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

43. 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.”

The Principles

44. 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 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 great degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of the goods

45. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

46. 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.

47. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

48. In *Kurt Hesse v OHIM*, Case C-50/15 P, the 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)***,** Case T-325/06, the General Court ("GC") there is complementarity where:

> "...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".

49. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the GC 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 fur 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".

50. With the above in mind, the goods for comparison are as follows:

Earlier goods	**Contested goods**
The '383 mark Class 18: *Bags; handbags; clutchbags; tote bags; backpacks; shoulder bags; purses; make-up cases; make-up brush cases.* The '833 mark Class 25: *Women's shoes.*	Class 18: *Umbrellas; school bags; rucksacks; pocket wallets; lumbar packs; mountaineering sticks; handbags; travelling bags; clothing for pets; bags for sports.*

The ‘573 mark Class 18: *Bags; handbags; purses; wallets; carrying cases; clutch bags; tote bags; shoulder bags; backpacks; rucksacks; crossbody bags; shopping bags; casual bags; duffle bags; barrel bags; work bags; sport bags; beach bags; evening bags; key cases; credit card cases; briefcases; attaché cases; satchels; luggage; travelling bags; overnight bags; weekend bags; cabin bags; holdalls; suitcases; travelling trunks; cosmetic bags; toiletry bags; leather cases; umbrellas.* Class 25: *Footwear; parts, fittings and accessories for the aforesaid goods.*	

51. The earlier ‘383 and ‘573 marks cover the goods ‘bags’ as well as ‘handbags’ and ‘backpacks’. These goods are identical either self-evidently or in line with the principles set out in *Meric* to the contested goods *school bags; rucksacks; lumbar packs; handbags; travelling bags; bags for sports*.

52. The contested goods also include *pocket wallets*. A wallet is defined by Collins dictionary as “…a small flat folded case, usually made of leather or plastic, in which you can keep banknotes and credit cards.”[8] ‘Purse’ is offered as a synonym for wallet under this definition. A purse is defined by Collins dictionary as “… a very small bag that people keep their money in.”[9] It is my view that wallets and purses share an identical meaning, and that *pocket wallets* applied for are identical to *purses* as covered by the earlier ‘383 mark. However, if I am wrong, I consider these to be highly similar on the basis that they will share a nature, purpose, method of use and trade

[8] https://www.collinsdictionary.com/dictionary/english/wallet [accessed 7 August 2024]
[9] https://www.collinsdictionary.com/dictionary/english/purse [accessed 7 August 2024]

channels. Further, I consider *pocket wallets* to be identical to *wallets* as covered by the earlier '573 mark.

53. The contested mark covers the goods *umbrellas*. These goods are covered identically by the earlier '573 mark. However, I note here that I do not consider these to be similar to the goods covered by the earlier '383 or '833 mark. Whilst they may occasionally share trade channels, and they will share users to the extent that they will all be used by the general public, I do not consider this enough to find any meaningful similarity between these goods in this scenario.

54. In respect of the contested goods *mountaineering sticks*, again I note these will share trade channels and users only with the earlier bags. However, it is my view that in this instance, the overlap in users will be more specific, with users such as mountaineers looking for both mountaineering bags (as covered under the more general category of bags) and mountaineering sticks to be used together. These goods may also be sold in the same specialist shops. However, the nature, purpose and method of use will all differ, and they will not be complementary nor will they be in competition. Overall, I find these goods to be similar to a low degree.

55. For completeness, I have considered if the parts and fittings of footwear in class 25 will include goods such as crampons. However, I note these goods are proper to class 6[10] and will not, in my view, be included within the meaning of '*parts, fittings and accessories for'* footwear in class 25.

56. I note here that the opponent argues that *mountaineering sticks* are also highly similar to the earlier goods umbrellas on the basis that the term umbrellas will include those designed to be used as walking sticks. The opponent has not filed any evidence of the types of walking stick umbrellas described, and these are not goods I am familiar

[10] See *Altecnic Ltd's Trade Mark Application* in which the Court of Appeal decided that "the Registrar is entitled to treat the Class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the list of the specification of goods." See also *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited),* [2018] EWHC 3608 (Ch), in which the late Mr Justice Carr stated that where *"the words chosen may be vague or could refer to goods or services in numerous classes* [of the Nice classification system]*, the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services."*

with. However, in any case, I find it unlikely that umbrellas would be used as an alternative for a mountaineering stick, with umbrellas likely proving impractical for this type of activity, during which a raincoat would likely be far more appropriate. In the absence of further evidence on this point and considering what I believe to be the ordinary and natural meaning of 'umbrellas', I do not consider these to be highly similar to mountaineering sticks, or, indeed, to share any meaningful similarity with the same.

57. Finally, the contested mark covers the goods *clothing for pets*. The opponent argues these goods are similar to its earlier *footwear* and refers me to an earlier decision issued by the UK IPO within which *apparel, footwear, headgear* were found to be similar to *animal apparel* to a low degree.[11] I am not bound by previous decisions issued by the UK IPO. Further, in this matter, I note the opponent's best case for similarity with clothing for pets relies upon the goods *footwear* under its '573 mark and *Women's shoes* under its '833 mark. It is my view that these goods are even further away from clothing for pets, considering they are footwear for humans rather than clothing for humans. These goods will at best share customers and the possibility for a small similarity in nature. I do not consider there to be any meaningful similarity between these goods in this instance.

Comparison of marks

58. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall

[11] See case O/0507/23

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

59. 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.

60. The respective trade marks are shown below:

Earlier trade marks	**Contested trade mark**
FIORELLI (the '383 and '833 mark) FIORELLI SIGNATURE (the '573 mark)	FIORETTO

61. As the earlier '383 and '833 marks are identical, I will refer to these as one as "the first earlier mark".

62. The first earlier mark comprises the single word FIORELLI. The overall impression of the mark resides in this single word, that being the mark as a whole.

63. The earlier '573 mark comprises two words, those being 'FIORELLI' and 'SIGNATURE'. Due to its position in the mark and its higher level of distinctive character (for reasons I will go into later), the word FIORELLI is the most dominant and distinctive element of this mark, and the word SIGNATURE plays a lesser role in its overall impression.

64. The contested mark is the is the single word 'FIORETTO'. The overall impression of the mark resides in this single word, that being the mark as a whole.

Visual comparison

65. The first earlier mark shares the same initial five letters with the contested mark. These letters are placed at the beginning of the mark where the consumer tends to

place more importance.[12] It is also the same length, with the marks both being 8 letters in total. However, the three final letters in each mark create a notable visual difference. I find the marks are visually similar to between a medium and high degree.

66. The earlier '573 mark also shares the same five initial letters with the contested mark. The marks differ by way of the final three letters in the initial word in addition to the second 9 letter word that is present in the earlier mark which has no counterpart in the contested mark. Considering their similarities and differences, I find the marks to be visually similar to between a low and medium degree.

Aural comparison

67. It is my view that the first earlier mark will be pronounced as 'FEE-OR-ELLE-EE, and the contested mark as FEE-OR-E(H)TT-O. They coincide through the initial FEE-OR sound in each mark but differ due to the differences caused by the 'TT' versus the 'LL' following the E(H) sound, and by way of the different sounding final syllable in each. Overall, I find the marks to be aurally similar to just above a medium degree.

68. The first word in the earlier '573 mark shares the same similarities and differences with the contested mark as the first earlier mark, which are outlined above. However, this earlier mark is significantly longer than the contested mark, being that it includes the second three syllable word SIGNATURE that will be pronounced in the known way. Overall, by virtue of the similarities at the beginning of the marks, I find these to be aurally similar to a low degree.

Conceptual comparison

69. The witness statement filed by Ms Chittock for the opponent includes at Exhibit SC1 extracts from Collins dictionary (online), Wikipedia, and the website www.dailyitalianwords.com. These websites have been filed for the purpose of showing that FIORE means flower in Italian and that it may also be used as an Italian first name or surname. Further evidence filed at Exhibit SC2 and SC3 discuss the meaning of ETTO and ELLI (and 'ELLO') as suffixes in Italian words and Exhibit SC4 discusses the presence of various suffixes within Italian surnames. Whilst I have

[12] See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

considered this evidence, it is my view that none of this will be known to the average UK consumer. It is therefore my view that no meaning will be attributed to either FIORELLI or FIORETTO, although they will likely be recognised as a foreign language word, possibly of Italian origin. There is no shared conceptual meaning beyond this.

70. I note the earlier '573 mark also contains the word SIGNATURE which in my view will, in the context of the goods, be most likely understood by the UK consumer as referring to a particular style or characteristic typical of a person or entity (in this case, the opponent). It may also be considered by some as referring to the way a person or entity signs its name, but I find this the less likely scenario. Either way, it acts as a point of conceptual difference between the '573 mark and the contested mark.

Average consumer and the purchasing act

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

72. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

73. The average consumers of the goods such as umbrellas, bags, purses and footwear will primarily comprise members of the general public. These consumers will likely consider the practicality, quality, and aesthetics of the bags, purses and footwear

prior to making a purchase and will therefore pay a medium level of attention in respect of the same. Whilst I note the opponent's arguments that a lower level of attention will be paid in relation to goods such as bags, on the basis that consumers are not constrained by their body size requirements for example, I do not accept this means a lower than medium level of attention will be paid. The consumer will have other factors to consider, such as the requirement for the bag to fit their particular belongings required for whatever occasion they will take the bag to, or for purses to meet their everyday requirements for card, note or coin storage and to fit inside a particular bag or pocket. There will also be a number of professional consumers, such as those running retail establishments, that will purchase the goods in order to stock their stores. As the goods will likely be purchased in larger quantities by these consumers and considering that these purchases may directly impact the success of the business, it is likely that a slightly higher degree of attention will be paid by these consumers.

74. Whilst I note that practicality and aesthetics may still be taken into account when purchasing an umbrella, these are likely to generally have a lower price point, will be used less frequently and for shorter lengths of time than the other goods and will in my view be less of a considered purchase and will therefore warrant a slightly lower degree of attention, at between a low and medium level.

75. In respect of mountaineering sticks, I note again consumers will primarily comprise members of the general public that enjoy hiking. These consumers will likely consider the practicality and quality of the purchase, as well as possibly the aesthetics and functionality. It is my view that at least a medium level of attention will be paid in respect of the same. Where these goods are purchased by retailers, a slightly higher degree of attention will be paid for the same reasons set out in relation to bags and footwear. Where they are purchased by professional mountaineers, or mountain rescue teams for example, it is likely a relatively high degree of attention will be paid considering the heightened level of danger that may be faced and the greater reliance on equipment required in these higher risk scenarios.

76. All of the goods are likely to be primarily purchased visually, with consumers viewing the mark on websites or in stores and on the goods themselves. However, I consider that there may be verbal assistance sought from retail staff, and that

particularly in the case of professional consumers, purchases may sometimes be made over the phone. As such, I cannot completely discount the aural component.

Distinctive character of the earlier trade mark

77. 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 *WindsurfingChiemsee* 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)."

72. As set out previously, I do not consider the earlier word FIORELLI to convey a meaning to the UK consumer beyond the fact that it will likely be considered to be an unknown word of foreign, possibly Italian origin. To my mind, the use of an unknown word of foreign origin in relation to fashion items does not warrant a finding that the mark holds the highest degree of inherent distinctive character, reserved generally for entirely made-up words. However, I still consider this mark to hold an above medium level of inherent distinctiveness in respect of the goods for which use has been shown.

I do not find that the word SIGNATURE raises the inherent distinctive character of the opponent's '573 mark further, which also holds an above medium level of distinctive character by virtue of its dominant and distinctive element FIORELLI.

73. As the opponent has filed evidence of use of the earlier mark FIORELLI, I will now consider if I find the degree of distinctive character of this mark to have been enhanced through its use. When considering if the distinctive character of a mark has been enhanced through use, it is the perception of the UK consumer at the relevant date, which in this case is the filing date of the contested mark of 14 October 2022, that is key.

74. I have previously outlined the bulk of the opponent's evidence when considering proof of use in relation to this mark. I note again that the brand was first launched in the UK in 1990,[13] and I note particularly that the opponent had annual sales of between approximately 18 – 21 million GBP every year between April 2016 – March 2021. It appears sales dropped to around 4 million GBP in 2022, and there is a gap in the figures between March 2021 – January 2022. Whilst I am not aware of the price point for every item sold throughout that time, it appears from the evidence that bags retailed at least to consumers for around £50-£90 within the relevant period, and purses between £12 - £45 on average. I am not aware of how much these goods sold to retailers for. Due to the range in prices it is not possible to determine the precise number of items sold between 2016 – 2021, but this is likely to be in the hundreds of thousands each year as a minimum. I note that the goods under the mark were sold through a number of large UK retailers during the relevant period. Whilst I acknowledge the opponent has a social media presence, the evidence of this is not particularly persuasive in this regard.

75. The opponent has not provided me with exact figures for marketing spend, but it has confirmed this on average is approximately 10% of the sales figures.[14] This puts advertising spend at between approximately 1.8 – 2.1 million GBP yearly between April 2016 – March 2021, and at around £400,000 in 2022. I also note there are several promotional articles about the opponent's goods provided in the evidence. I note in

[13] See paragraph 6 of the witness statement of Mr Hiscock.
[14] See paragraph 18 of the witness statement of Mr Hiscock.

particular an article from the Mail online and the Sun (also online) both from 2021. These list the opponent's bags amongst affordable vegan bags and best work bags respectively. Whilst I note the Mail online article also makes reference to USD, I remind myself that the rest of the site appears to make reference to UK news and encourages readers to follow '@DailyMailFashionFinderUK' and therefore appears to be targeted at least partly at the UK consumer. I also note the inference made by the article on www.refinery29.com that the opponent is a "big name designer", or that its goods are at least included in an article discussing the same.

76. It is clear from the sum of the evidence that the vast majority of the opponent's business under the mark FIORELLI comes from its bags and purses collection. Considering the evidence as a whole, I find that there has been fairly substantial use of the first earlier mark in respect of these goods. I have not been provided with details of the size of the market for these goods in the UK and I find it reasonable to assume this is very large. Nonetheless, considering the sum of the evidence including reference to the longstanding use, the fairly substantial approximate sales figures and advertising spend referenced between April 2016 – March 2021, and the (albeit limited) press shown including that in major UK online newspapers, it is my view that the distinctiveness of the first earlier mark will have been increased moderately from its above medium level of distinctive character in respect of *handbags; clutchbags; tote bags; backpacks; shoulder bags* and *purses*, although not to the very highest level. It is clear from the evidence as a whole that its footwear goods and make-up cases make up a far smaller portion of the opponent's business under the mark, and I do not consider the distinctive character of the mark to have been increased in respect of these goods. I do not find the evidence displays use of the mark '573 mark FIORELLI SIGNATURE, and as such I find only the distinctiveness of the FIORELLI mark has been raised above its inherent level in this instance, in respect of the goods as outlined.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

78. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 44 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctiveness of the common elements is key.[15] I must keep in mind that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods are obtained will have a bearing on how likely the consumer is to be confused.

79. There are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.[16]

80. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

Direct confusion

81. I will begin by considering the likelihood of direct confusion in relation to the earlier '383 and the '833 registrations and the contested mark. I found the earlier mark

[15] See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.
[16] *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

FIORELLI to be visually similar to the contested mark to between a medium and high degree, and aurally similar to just above a medium degree. I did not find a conceptual meaning in either the earlier mark or the contested mark. I found the earlier mark to be inherently distinctive to an above medium degree, and that the distinctiveness of the earlier '383 mark had been moderately enhanced through use in respect of some of the goods. I found the average consumer will primarily comprise members of the general public paying somewhere between a low to medium and an at least medium degree of attention depending on the goods. I found the goods under the marks to range from identical to dissimilar.

82. Where the goods were found to be dissimilar to the goods registered under the earlier '833 mark and '383 mark, the opposition cannot succeed under section 5(2)(b) of the Act based on these marks. It therefore fails on the basis of these earlier marks in respect of the goods *umbrellas* and *clothing for pets*.

83. I consider that where the goods are identical to the earlier goods under the '383 mark, this will help to offset the differences between the marks. I also note that the similarities feature at the beginning of the marks where the consumer tends to place more importance, that the distinctiveness of the mark has been moderately enhanced in respect of the identical goods, and that there is no strong conceptual meaning in either of the marks which will further assist the consumer in recalling the marks precisely. All of these factors do point in favour of the opponent. However, I consider that there are fairly notable differences in the visual and aural comparison of the marks, and I note that in respect of the identical goods, the consumer will be paying a medium degree of attention. Whilst I accept that there are in this instance several factors in the opponent's favour, the overall assessment of a likelihood of confusion is not a mathematical equation, and having carefully considered all of these factors in my overall assessment, it is my view that the aural and visual differences between the marks are in this instance, sufficient to avoid a likelihood of direct confusion between these marks in respect of all of the goods.

84. In respect of the '573 mark, again, I found *clothing for pets* to be dissimilar to the goods protected and relied upon under this earlier mark, and as such the opposition

based on section 5(2)(b) of the Act must fail in this respect. Further, as I have found (for the most part) less favourable conditions for the opponent outside of the goods comparison under this mark than I did under the '383 and '833 marks, including a lower level of visual and aural similarity between the marks and a point of conceptual difference, it follows that there will be no likelihood of direct confusion in respect of the same. Whilst I note the lower level of attention paid in respect of the goods umbrellas which I found to be identical to goods protected under this earlier mark, considering all of the factors it is my view that there will be no likelihood of direct confusion between FIORELLI SIGNATURE and FIORETTO even in relation to these goods.

Indirect confusion

85. I will now move on to consider the likelihood of indirect confusion. In *L.A. Sugar* (cited above) Mr Iain Purvis Q.C. (as he then was), as the Appointed Person set out three examples of when indirect confusion may occur as below:

> 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)."

86. I note that the examples above were intended to be illustrative and are not exhaustive. I also keep in mind *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands,*

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

87. In respect of indirect confusion, I note that the opponent has directed me within its final written submissions to a previous decision issued by the UK Intellectual Property Office, in which the common five letter prefix 'GENTI' resulted in a likelihood of indirect confusion.[17] I note this case concerned pharmaceutical products, and the assessment of indirect confusion included marks ending with the arguably allusive suffixes 'BIO' and 'PAIN'. However, in any case, I am neither bound nor persuaded by previous decisions issued by other Hearing Officers concerning entirely different marks and goods. For completeness, I note at this stage I was also directed to this decision in respect of direct confusion, but again I note that I must consider this case on its own merits.

88. Considering all of the factors, it is my view that for those consumers who are familiar with the opponent's goods under its FIORELLI mark, the use of the applicant's mark, with it being the same length, also being foreign or Italian sounding, and with it sharing the initial five letters, may well bring the opponent's earlier FIORELLI mark to mind. I find this will particularly be the case when used in relation to identical or highly similar goods. However, this is mere association and not confusion. I do not consider these similarities in this case to be a proper basis for the consumers to conclude that the marks are likely to derive from the same economic undertaking. I therefore find no likelihood of indirect confusion between the opponent's FIORELLI marks and the contested mark.

[17] See decision BL O/1089/22

89. Again, having considered all of the factors, it is my view that it follows that there will also be no likelihood of indirect confusion between the opponent's earlier '573 and the contested mark.

90. The opposition based on section 5(2)(b) of the Act fails.

Section 5(3)

91. I will now go on to consider the opposition under section 5(3) of the Act. Section 5(3) states:

> "(3) A trade mark which-
>
> is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark".

92. Section 5(3A) states:

> "(3A) 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".

93. 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."

94. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case C-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 C-383/12P, *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; G*eneral 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) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) 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.

(h) 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.

(i) 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. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) 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).*

95. An opposition based on section 5(3) of the Act can only be successful via the establishment of several individual elements, the cumulation of which must satisfy all elements of the claim. To be successful on this ground, the opponent must prove it holds a reputation for the earlier mark relied upon amongst a significant portion of the public. It must also be established that the marks are similar. If it is found both that the marks are similar and that the earlier mark holds a qualifying reputation, it must then

be shown that this reputation, combined with the similarity between the marks, will result in the relevant public establishing a link between the marks. A link may be found on the basis that the later mark brings the earlier mark to mind. Importantly, if all three of these elements have been established, it must then be shown that the link made by the public will result in, or will be likely to result in, one of the pleaded types of damage.
96. The relevant date for consideration under section 5(3) of the Act is the application date of the opposed mark of 14 October 2022. A reputation must be shown within the relevant territory, that being the UK.

97. I remind myself at this stage that the opposition under this ground relies solely on the opponent's earlier '383 and '833 mark. Following my assessment of the proof of use provided by the opponent in respect of these marks, the specifications relied upon under these marks have been limited as follows:

> The '383 mark
> Class 18: *Bags; handbags; clutchbags; tote bags; backpacks; shoulder bags; purses; make-up cases; make-up brush cases.*
>
> The '833 mark
> Class 25: *Women's shoes.*

Reputation

98. Within its final written submissions, the applicant concedes that the opponent's evidence shows its marks "enjoy only a very modest reputation in respect of leather handbags only". I note this concession, and on this basis, I accept the opponent has at least a very modest reputation in relation to these goods. However, I will also conduct my own assessment to see if I find the reputation held to be any stronger or broader than that conceded by the applicant. I note again at this stage that to my mind, the evidence shows that the goods offered under the opponent's mark do not appear to be made of leather, and as such, any reputation the opponent may hold in respect of handbags will not, in my view, be limited to leather handbags.

99. I have outlined the high points of the opponent's evidence earlier in this decision when discussing its genuine use and enhanced distinctive character. I will briefly

outline again at this stage the opponent's longstanding use of the mark dating back over 30 years, the approximate sale figures of between 18 – 21 million GBP each year between April 2016 – March 2021 and the approximate 10% of these figures spent on marketing the brand each year. However, I do also note the missing figures and the drop in figures in 2021-2022. I note that over the years including within the relevant time period the goods have been stocked by a number of major UK retailers, and I also note the (somewhat limited) promotional articles provided discussing the opponent's bags include those in the Sun and the Mail online from 2021. I remind myself again that I have not been provided with any evidence of the size of the market for the goods, and I find it likely this is very large. However, with consideration to the sum of the evidence, it is my view that the opponent held a modest (but qualifying) reputation under its '383 mark in respect of its *handbags; clutchbags; tote bags; backpacks; shoulder bags* and *purses* in the UK at the relevant date. I do not consider that it held a reputation for the remaining goods relied upon as outlined above under the '383 mark or any goods relied upon under the '833 mark at that time.

Link

100. As I found the opponent to hold a qualifying reputation in relation to the goods outlined above under its '383 mark, I will move on to consider if I find there will be a link made between the marks, with consideration to the relevant factors set out in *Intel* below.

The degree of similarity between the respective marks and between the goods

101. I found the marks to be visually similar to between a medium and high degree, and aurally similar to just above a medium degree. I found no conceptual meaning would be conveyed by either mark to the UK consumer, but rather than both marks would be perceived as foreign words of possible Italian origin. The goods range from identical to dissimilar.

The extent of the overlap between the relevant consumers for the services

102. The relevant consumers of the goods will overlap on the basis that they will all primarily be members of the general public, as well as business owners stocking the goods.

The strength of the earlier mark's reputation

103. I found that the earlier mark held a modest reputation in respect of *handbags; clutchbags; tote bags; backpacks; shoulder bags* and *purses.*

The distinctiveness of the earlier mark

104. I found the earlier mark FIORELLI to be inherently distinctive for the goods to an above medium degree, and that the distinctiveness of the mark has been moderately increased again in respect of the goods for which the opponent holds a reputation, although not to the very highest level.

Whether there is a likelihood of confusion

105. In my assessment under section 5(2)(b), I found no likelihood of confusion between the marks.

106. With consideration to the factors above, it is my view in this instance that where the goods are types of bags or purses, or closely related items such as wallets, a link will be made between the marks. Whilst I note I found no likelihood of confusion in respect of these goods, I did find it likely the use of the contested mark would bring the earlier mark to mind in respect of identical or highly similar goods. It is my view that due to the similarities between the marks, the shared field of 'bags', the modest reputation, the degree of distinctiveness of the earlier mark, and the overlap in consumers (albeit those primarily being members of the general public), a link would be made between these marks, with the earlier mark brought to mind by the use of the contested mark on the goods as set out below:

> Class 18: *school bags; rucksacks; pocket wallets; lumbar packs; handbags; travelling bags; bags for sports.*

107. I remind myself at this stage that similarity between the goods is not required in order for a link between the marks to be found. However, the closeness of the goods

will still weigh into my assessment. In respect of the remaining contested goods, those being *umbrellas*, *mountaineering sticks* and *clothing for pets* I found there to be no or low similarity between the goods and those for which the opponent holds a reputation. I note the similarities between the marks is not at the highest level, and I consider the modest reputation held under the '383 mark for the goods as shown in the evidence. Considering all of these factors together, in this case, it is my view that there will be no link made in respect of these goods, and if a link were to be made, it would be so fleeting that it would not suffice to result in an unfair advantage or damage to the opponent or its mark.

Damage

108. As I have found there will be a link made in respect of some of the contested goods, I will go on to consider the damage as pleaded. I will begin by considering the opponent's pleadings in relation to unfair advantage.

109. In its pleadings, the opponent submits:

> "[…] the use of the applicant's mark would free-ride on the opponent's reputation and benefit from arousing an association in the mind of consumers with the opponent's mark on the basis of the opponent's investment in marketing and promoting its mark. The applicant has not made the same level of investment in marketing its own mark and would unfairly take advantage of the repute of the opponent's mark.

110. Considering the circumstances of this case, I agree with the opponent's submission above. It is my view that although modest, the opponent's reputation held under its mark in respect of various bags and purses in the UK will be the result of its longstanding and significant investment in the mark. It is my view the link made between the marks by way of the applicant's mark bringing the opponent's mark to mind will result in the applicant benefitting from an instant familiarity in the eyes of the consumer, due to the opponent's modest reputation for the identical or highly similar goods, thereby securing a commercial advantage as a direct benefit of the opponent's reputation. I therefore agree with the opponent that the applicant will gain an unfair

advantage from the use of its mark in respect of all of the goods for which a link will be made.

111. As the opponent has succeeded under unfair advantage in respect of all of the goods for which a link will be made, there is no need to consider the additional types of damage pleaded in this instance.

Final Remarks

112. The opposition based on section 5(2)(b) of the Act has failed in its entirety. However, the opposition based on section 5(3) of the Act has been partially successful. Subject to any successful appeal, the application will be refused in respect of the following goods:

> Class 18: *school bags; rucksacks; pocket wallets; lumbar packs; handbags; travelling bags; bags for sports*.

113. Subject to any successful appeal, the application may proceed to registration in respect of the following goods only:

> Class 18: *Umbrellas; mountaineering sticks; clothing for pets.*

COSTS

114. The opponent has achieved a greater portion of success overall and is therefore entitled to an award of costs in accordance with Tribunal Practice Notice 2/2016. In the circumstances I award the opponent the sum of £1225. This amount includes a 30% reduction to account for the applicant's partial success, and is calculated as follows:

Official fee:	£200
Preparing and filing the TM7 and statement of grounds:	£350

Preparing and filing the evidence and considering the other sides evidence:	£800
Preparing and filing written submissions:	£400
30% reduction for the applicant's partial success:	-£525
Total:	**£1225**

115. I therefore order YUEXIN (WUXI) APPAREL & ACCESSORIES CO., LTD to pay Centric Brands International Europe Limited the sum of £1225. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 21st day of August 2024

Rosie Le Breton

For the Registrar