

O/1030/25

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001674374

DESIGNATING THE UK

BY ALAÏA SA



IN CLASSES 36, 37 AND 41

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 505772

BY AZZEDINE ALAIA SAS

BACKGROUND AND PLEADINGS

1. International trade mark 1674374 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is Alaïa SA. The IR is registered with effect from 24 May 2022. 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. The date of protection of the IR in the UK is 15 November 2022 for the following services:

Class 36 Insurance services; financial affairs; monetary affairs; real estate affairs.

Class 37 Construction; repair; installation services.

Class 41 Education; training; entertainment; sporting and cultural activities excluding fashion shows and fashion events.

2. On 27 January 2023, AZZEDINE ALAIA SAS (“the applicant”) applied to have the IR declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application is based upon sections 5(3) and 5(4)(a) of the Act.

3. Under section 5(3), the applicant relies upon the following trade marks:

ALAÏA

UK registration no. UK00003466880

Filing date 14 February 2020.

Registration date 9 August 2020.

(The First Earlier Mark)

ALAÏA PARIS

Comparable trade mark (IR) registration no. UK00801267484

Filing date 20 March 2015.

Registration date 10 August 2016.

Priority date 27 February 2015.

(The Second Earlier Mark)

4. The applicant's marks qualify as earlier marks pursuant to section 6 of the Act. I also bear in mind that the applicant's Second Earlier Mark is a comparable mark. Following the end of the transition period of the UK's withdrawal from the EU, all international (EU) trade mark designations registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (IR)' retains the same designation date (filing date), priority date (if applicable) and registration date of the international (EU) trade mark designation.

5. The applicant relies upon some of the First and Second Earlier Mark's goods and services, contained in Annex 1 to this decision.

6. The applicant claims that due to the similarity of the parties marks, the holder will "free-ride on the reputation" of the applicant's earlier marks, benefitting unfairly from their reputation and prestige, "without making efforts of its own" in regard to marketing and promotional investment, or paying any financial compensation. The applicant claims that such use will take unfair advantage of and be detrimental to the repute of the earlier marks, which will tarnish and reduce their power of attraction. The applicant also claims that there is no control over the quality of the holder's services and thus there is a risk in damage to the applicant's reputation. Lastly, the applicant claims that use of the contested IR will erode the "distinctiveness, exclusivity and singularity" of the applicant's earlier marks, and will result in a reduction of the applicant's marks' ability to identify the services as coming from the applicant.

7. Under section 5(4)(a), the applicant relies upon its **ALAIÄ** sign which it claims to have used throughout the UK since at least 2008 for perfumes, clothes for women, trousers, suits, dresses, trousers, jackets, pullovers, shirts, blouses, coats, pyjamas, nightgowns, bathing suits, socks, stockings, tights, underwear, lingerie, shoes, boots,

slippers, headgear, belts (clothing), the bringing together, for the benefit for others, a variety of goods enabling customers to conveniently view and order them in a retail store, the bringing together, for the benefit for others, a variety of goods enabling customers to conveniently view and order them via mail-order sales catalogues or by any means of electronic communication, and, the bringing together, for the benefit for others, a variety of goods enabling customers to conveniently view and order them via web sites. The applicant claims that use of the proprietor's IR would be contrary to the law of passing off.

8. The holder filed a counterstatement denying the claims made, and subject the Second Earlier Mark to proof of use.¹

9. The applicant is represented by Keltie LLP and the holder is represented by Abel & Imray LLP. Both parties filed evidence in chief, and the applicant filed evidence in reply. Neither party requested a hearing, but the applicant filed submissions in lieu. I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

RELEVANCE OF EU LAW

10. 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

11. The applicant's evidence includes the witness statement of Elizabeth May dated 5 July 2023. Ms May is a solicitor, employed by Richemont International Limited as

¹ The evidential threshold is greater for establishing a reputation than establishing proof of use. On this basis, I have only assessed whether the evidence shows that the applicant has a reputation in relation to its earlier marks.

Maison Lead IP Counsel. Richemont International Limited is a part of the Richemont Group of companies, which includes the applicant. Ms May's statement is accompanied by 29 exhibits (EM1-EM29).

12. The holder's evidence consists of the witness statement of Matthew Peter Smith dated 8 January 2024. Mr Smith is a Chartered Trade Mark Attorney and member of Abel & Imray LLP, the representatives of the holder. Mr Smith's statement is accompanied by 7 exhibits (MPS1-MPS7). I note that **exhibits MPS1 to MPS6** contain extracts from the UK IPO database showing the registration of 3 "ALAIA" marks for classes 20 or 33 (furniture and wine), as well as undated printouts of these marks being used in brochures or on websites. However, I have not been provided with any accompanying submissions from Mr Smith as to what this evidence has been filed in support of, or what it is meant to demonstrate. Nevertheless, I note that this evidence would be typically filed in support of a state of the register argument.

13. In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06 in which the GC stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71)."

14. The mere fact that there are multiple marks on the Register which contains the word "ALAIA" in the UK is not relevant to my assessment. Firstly, the marks provided

in Mr Smith's evidence do not appear in the same classes for which the First and Second Earlier Marks are registered. Moreover, whilst Mr Smith has tried to support this evidence and provided examples of how these marks are used in practice, this evidence is limited as it does not show, for example, any turnover or sales information or market share percentage for any of the registrations. I also note that all of the evidence is undated. I therefore find that the evidence is insufficient to establish frequent use of the mark by third parties. On this basis, the evidence does not assist the holder.

15. The applicant's evidence in reply consists of the witness statement of Alistair Gay dated 13 May 2024. Mr Gay is a Chartered Trade Mark Attorney and partner at the firm Keltie LLP, the representatives of the applicant. Mr Gay's statement is accompanied by 9 exhibits (AG-01 – AG-09).

DECISION

16. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

“47. (1) [...]

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

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

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

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

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

[...]

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

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

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

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

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

(3) [...]

(4) [...]

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

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

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

Section 5(3)

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

“5(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

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

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

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

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

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

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

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.

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

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

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

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


(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

20. The conditions of section 5(3) are cumulative. Firstly, the applicant's marks and the holder's IR must be identical or similar. Secondly, the applicant must show that its earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must have established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the applicant's marks being brought to mind by the later mark. Fourthly, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

21. The relevant date for the assessment under section 5(3) is the UK designation date of the holder's IR i.e. 24 May 2022.

Similarity of the marks

22. The respective trade marks are shown below:

Applicant's marks	Holder's IR
<p data-bbox="363 539 624 622">ALAÏA</p> <p data-bbox="320 656 671 689">(The First Earlier Mark)</p> <p data-bbox="248 786 743 869">ALAÏA PARIS</p> <p data-bbox="296 898 695 931">(The Second Earlier Mark)</p>	 <p>The logo is circular with a black background and white text and graphics. At the top, there are three stylized evergreen trees. Below them, the word "ALAÏA" is written in a standard, all-caps, sans-serif font. Underneath "ALAÏA", the word "Chalet" is written in a white, cursive, lowercase font. At the bottom of the circle, there is a stylized mountain range with three peaks. The entire design is enclosed within two concentric white circular outlines.</p>

23. The First Earlier Mark is composed of the word “ALAÏA”. The Second Earlier Mark is also composed of the word “ALAÏA”, followed by the word “PARIS”. The holder’s IR consists of the word “ALAÏA”, followed by the word “chalet”. The words “ALAÏA chalet” in the holder’s IR are presented in a white typeface (“ALAÏA” being presented in a standard capitalised typeface, whereas “chalet” is presented in a lower-case conjoined typeface) against a black circular background, with three mountains presented at the bottom, connected to two white circular outlines. I also note that three tree devices are presented at the top of the mark, above the word “ALAÏA”. To the extent that all three marks share the use of word “ALAÏA”, they are all visually and aurally similar. I consider that the First Earlier Mark and the holder’s IR are visually and aurally similar to a medium degree, and the Second Earlier Mark and the holder’s IR are also visually and aurally similar to a medium degree.

24. As to the concept conveyed by the parties’ marks, I firstly find that the word “PARIS” in the Second Earlier Mark will be understood by the average consumer as denoting the location of where the goods, services or applicant originates. I also consider that the ordinary dictionary word “chalet” in the holder’s IR will be understood

to the average consumer as denoting a small wooden house which is typically found in a mountain area. This is reinforced by the depiction of mountains at the bottom of the holder's mark (and the tree devices at the top of the mark). In regard to the word "ALAÏA" found in all of the parties' marks, if this element is perceived as an invented word, or a foreign language word, it will not evoke any meaning to the average UK consumer. This element is therefore conceptually neutral, with the word "PARIS" in the Second Earlier Mark and the word "chalet" (with the mountain and tree devices) in the holder's IR, acting as conceptual points of difference.

Reputation

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

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

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

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

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

26. In determining whether the applicant has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must

take all of the evidence into account including “the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it.”

27. Ms May states that the ALAÏA mark was established and launched by the famous designer Azzedine Alaïa in 1981, and that “the brand is used in relation to bespoke and read-to-wear *haute couture* fashion, and related fashion accessories”. Ms May states that Azzedine Alaïa’s career “skyrocketed” when two fashion editors at Elle supported him in their editorials. I note that the applicant’s evidence includes various Elle magazine articles, including **exhibit EM1**, which contains an “Elle 1992 flashback” article dated 3 May 2010. It states that Mr Alaïa was “probably one of the only designers who can claim to have dressed both a First Lady and Grace Jones”, as well as having dressed Madonna, Victoria Beckham and Katie Holmes. The article states that the clothing is “extraordinarily pricey” with cardigans priced around \$1,400 and dresses between \$2,500 and \$3,500, with Alaïa designs consistently selling “very well at the select international retailers that carry the line”. This article contains screenshots depicting the tops, skirts and dresses created by Azzedine Alaïa, amongst the wording “curve clinging styles that show off the body are Alaïa’s specialty”. **Exhibit EM3** contains screenshots from the applicant’s website, which show a timeline of the Alaïa brand. The timeline is from 1935 to 2019 and depicts the different exhibitions and collections of Alaïa, including the following, which was also depicted in the aforementioned Elle magazine evidence:²



² Left: screenshot from the applicant’s website, Right: picture from Elle magazine

28. I note that **exhibit EM22** contains an article from HarpersBazaar UK dated 3 May 2018, titled “6 ways Azzedine Alaïa changed the fashion landscape as we know it”. I note the following from this article:

- a) It calls Azzedine Alaïa a “true artist” who has an “extraordinary legacy and pervasive influence”.
- b) Alaïa “molded his clothes to the female form”, with “fit and flare shapes and nipped-in waists” being his “key signatures”.
- c) “The designer invented the body-con silhouette”, with Naomi Campbell stating that “no other dress can make a woman look and feel as good as an Alaïa dress because it cinches a woman’s body perfectly.”
- d) “The phrases “timelessness” and “investment pieces” are bandied around a lot in fashion, but Alaïa’s work is truly deserving of both.”
- e) “Without advertising or marketing, Alaïa’s collections have never ceased to appeal”.
- f) “When Cher from *Clueless* was held at gunpoint and told her perpetrator “But this is an Alaïa”, it meant something- that Alaïa had transcended fashion into popular culture. His influence overflowed from fashion into the broader world, making him an internationally known name.”
- g) “The fashion world will always borrow from his legacy”.

29. The HarpersBazaar article also talks about the passing of Azzedine Alaïa in November 2017, and that he was to be “celebrated with a dedicated retrospective exhibition at the Design Museum in London”. Ms May provides evidence of this exhibition which was held from June to October 2018. The Design Museum’s website states that this is the first UK solo exhibition of his work, which includes his garments from the 1980’s to 2017. The website also stated that Azzedine Alaïa’s approach “earned him an esteemed client list” including Grace Jones, Michelle Obama and Rhianna,³ and that the exhibition was rated as the “biggest fashion exhibition of the year” according to Culture Whisper. This exhibition was also discussed in a Vogue article dated 9 May 2018,⁴ which confirms that 60 pieces were displayed at the

³ Exhibit EM10

⁴ Exhibit EM11

exhibition including “many famous Alaïa numbers” such as the bandage dress and the 2003 long black fitted dress. The exhibition was also reported on fashionunited.uk and in a Guardian article dated 9 May 2018.⁵ I note that these articles show the dresses that were on display in the exhibition, and comments on how “the exaggerated height of the mannequins amplifies what Alaïa’s clothes have always done, which is to make women look extraordinary”.⁶

30. His “esteemed client list” also included Kim Kardashian, Naomi Campbell, Victoria Beckham, Kylie Jenner and Adele. **Exhibits EXM26A to EM26I** contains a selection of examples from the UK press, including Maria Clair, Vogue, Daily Mail and PopSugar, dated between 7 March 2019 to 13 March 2023, discussing and depicting these celebrities wearing bodysuits, dresses, platform boots and coats by Alaïa. Lady Gaga also wore an Alaïa dress at the Oscars in 2017, with her stylist Brandon Maxwell stating that “when I heard Gaga would be doing the Oscars, it was a no brainer. There is no one that makes a dress like Mr. Alaïa”.⁷ An article from W dated 20 November 2017 also comments on Lady Gaga’s tribute to Azzedine Alaïa at the 2017 AMAs by wearing two form-fitting Alaïa minidresses.⁸ I note that the article contained two tweets from Lady Gaga’s account which have 43.3k and 65.6k likes each, with the caption highlighting that she is wearing “#Alaïa” in the attached video and photo. This was also reported in an i-D article contained in **exhibit EM15A** which highlighted that she wore “two classic Alaïa numbers” alongside pictures of both dresses.

31. Ms May has provided multiple examples from UK press releases contained in **exhibits EM14, EM15b and EM16** dated between 30 July 2007 to 26 September 2018.⁹ I note that Azzedine Alaïa is commended as one of “Paris’s most prestige designers”,¹⁰ and he is frequently described as the “king of cling”,¹¹ due to the tight silhouette that he used throughout his career, including his “bodycon collections which put Alaïa on the fashion map”.¹² As noted above, Azzedine Alaïa passed in November

⁵ **Exhibit EM11**

⁶ The Guardian article, **exhibit EM11**

⁷ **Exhibit EM15A**, Vogue article dated 23 February 2015

⁸ **Exhibit EM15A**

⁹ The Oscars article regarding Rhianna wearing one of his designs is dated 13 March 2023, which falls after the relevant date.

¹⁰ The Telegraph article, July 2017, **exhibit EM15b**

¹¹ **EM13** Vogue article, **EM13** Sun article, **EM13** The Times article, **EM18** The Telegraph article.

¹² Vogue article in **exhibit EM16**

2017, which Ms May notes was widely reported in UK articles contained in **exhibits EM14** and **EM15b**. I note some of the comments that were made in these articles:

- Vogue stated that he “was highly revered for his garments that moulded the body into extraordinary proportions”.
- The Independent stated that “his first ready-to-wear collection in 1980 was a commercial smash hit and his business would grow to an annual turnover of £40m a year”.
- The title of the Sun article calls Azzedine Alaïa a “legendary designer”.
- In the second Vogue article, they state that Azzedine Alaïa is “one of the great fashion masters of our era” with an “illustrious” career as he “dressed some of the world’s biggest stars including Grace Jones, Madonna and Tina Turner”. The article also states that it was “clear that his legacy made a lasting impact” as many stars such as Kim Kardashian West, Rhianna and Linda Evangelista all posted tributes to him on Instagram after his passing.

32. While the above article evidence clearly all relates to Alaïa clothing, Ms May has also provided examples of UK press relating to its fragrances contained in **exhibits EM17** and **EM18**. The announcement of its release was reported in a VOGUE article dated 22 January 2013, which states that Azzedine Alaïa has signed a fragrance and cosmetics license, with the Telegraph article dated 1 July 2015 stating that “Alaïa Paris” is Azzedine Alaïa’s first fragrance which has “been created to go on like a sexy second skin, just like his designs”. This is supported by **exhibit EM19** and **EM20** which contains articles regarding the awards won by the applicant for their “ALAÏA PARIS” fragrances, including:

- a) The Fragrance Foundation Awards 2016; Best new female packaging and design.
- b) Lalique Fragrance Foundation award; Best New Female Print Campaign (2016).
- c) 9th Academy of Perfume Awards 2016; Best female perfume prize in the niche category.

33. In support of the aforementioned evidence, Ms May has provided the applicant's following turnover figures for 2016 to 2020 in relation to Alaïa branded products in the EU. In her witness statement, Ms May confirms that the product segment "leather goods" comprises inter alia purses, bags and belts, and that "readywear" comprises of clothing and footwear:

Country	Product Segment	Fiscal Year	Fiscal Year	Fiscal Year	Fiscal Year	Fiscal Year
		2020	2019	2018	2017	2016
		(1,000 €)	(1,000 €)	(1,000 €)	(1,000 €)	(1,000 €)
UK	Leather goods	2,600	3,100	1,750	1,700	1,050
	Readywear	5,600	5,850	4,100	4,150	5,000
	Eyewear	-	-	-	-	-
	Fragrance	5	10	-	-	-
France	Leather goods	2,350	2,950	1,150	1,400	1,450
	Readywear	5,550	8,000	8,850	9,100	11,500
	Eyewear	50	50	-	-	-
	Fragrance	30	50	20	30	-
Italy	Leather goods	650	650	350	500	500
	Readywear	800	1,150	1,200	2,100	2,300
	Eyewear	-	-	-	-	-
	Fragrance	2	1	-	-	-
Germany	Leather goods	850	250	50	100	150
	Readywear	750	900	750	800	1,100
	Eyewear	-	-	-	-	-
	Fragrance	1	-	-	-	-
Spain	Leather goods	80	90	20	40	50
	Readywear	60	200	150	200	300
	Other segments	-	-	5	50	50
Belgium	Leather goods	30	30	-	-	-
	Readywear	10	30	-	-	-
Austria	Leather goods	30	40	-	-	-
	Readywear	40	50	-	-	-
Netherlands	Leather goods	15	30	-	-	-
	Readywear	15	10	-	-	-
Greece	Leather goods	40	30	-	-	-
	Readywear	20	35	-	-	-
Portugal	Leather goods	5	10	-	-	-
	Readywear	5	1	-	-	-
Luxembourg	Leather goods	1	1	-	-	-
	Readywear	0	2	-	-	-
Totals		19,689	20,423	18,396	20,170	23,450

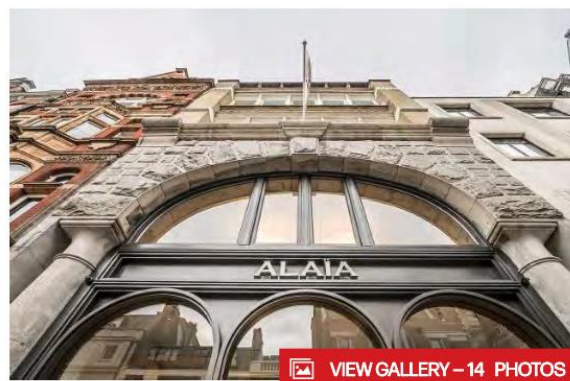
34. Ms May confirms that the total turnover for 2016 to 2020 for the UK alone was "in the region of Euro 32 million" and the total for the EU "was in the region of Euro 100 million". I have also been provided with the following broken down turnover figures for 2021 to 2023 in relation to Alaïa branded products sold in the UK:

			Annual Prior Year (HR)	Annual Prior Year (HR)	Annual Prior Year (HR)
		Fiscal year	2023 sales	2022 sales	2021 sales
Distribution Channel	Geography	Product Segment	EUR	EUR	EUR
Online retail	United Kingdom	Leather goods	In excess of 1m	In excess of 950,000	In excess of 300,000
Online retail	United Kingdom	Readywear	In excess of 800,000	In excess of 850,000	In excess of 350,000

Online retail	United Kingdom	Fragrance	In excess of 20,000	In excess of 25,000	In excess of 3,000
Retail	United Kingdom	Leather goods	In excess of 1.5m	In excess of 800,000	In excess of 200,000
Retail	United Kingdom	Readywear	In excess of 2.2m	In excess of 2.2m	In excess of 650,000
Wholesale	United Kingdom	Leather goods	In excess of 1.2m	In excess of 250,000	In excess of 200,000
Wholesale	United Kingdom	Readywear	In excess of 2.2m	In excess of 1.2m	In excess of 550,000
Totals			In excess of 9.5m	In excess of 6.5m	In excess of 2.2m

35. Ms May confirms that the total turnover for 2021 to 2023 in the UK “was in the region of Euro 18 million”.

36. In support of the above evidence, I have been provided with a sample of 4 redacted receipts for Alaïa branded products sold at the applicant’s flagship Bond Street London Store in **exhibit EM23**. The opening of this store was reported in third-party articles, including TATLER, on 27 April 2018.¹³ This article states that Naomi Campbell hosted the opening, and that the “store was heralded as an immediate hit success story for the iconic Parisian brand and late designer”. In the WWD article dated 16 April 2018,¹⁴ it highlights that this is the “first flagship outside of the French capital, where it currently operates two stores and sells at shops including Galeries Lafayette, 10 Corso Como and Harrods”. The article states that the store spans 3 floors, which will “stock Alaïa’s full range, including ready-to-wear, shoes, bags and accessories as well as limited-edition pieces and couture by appointment”. The article also comments on how the “U.K. market is important to the brand” and that they already have Harrods, Selfridges and Dover Street Market selling their goods, now alongside this new flagship store. This article also contains the following photo which demonstrates that the First Earlier Mark was being used on the outside of the shop as part of its signage:



¹³Exhibit EM8

¹⁴Exhibit EM8



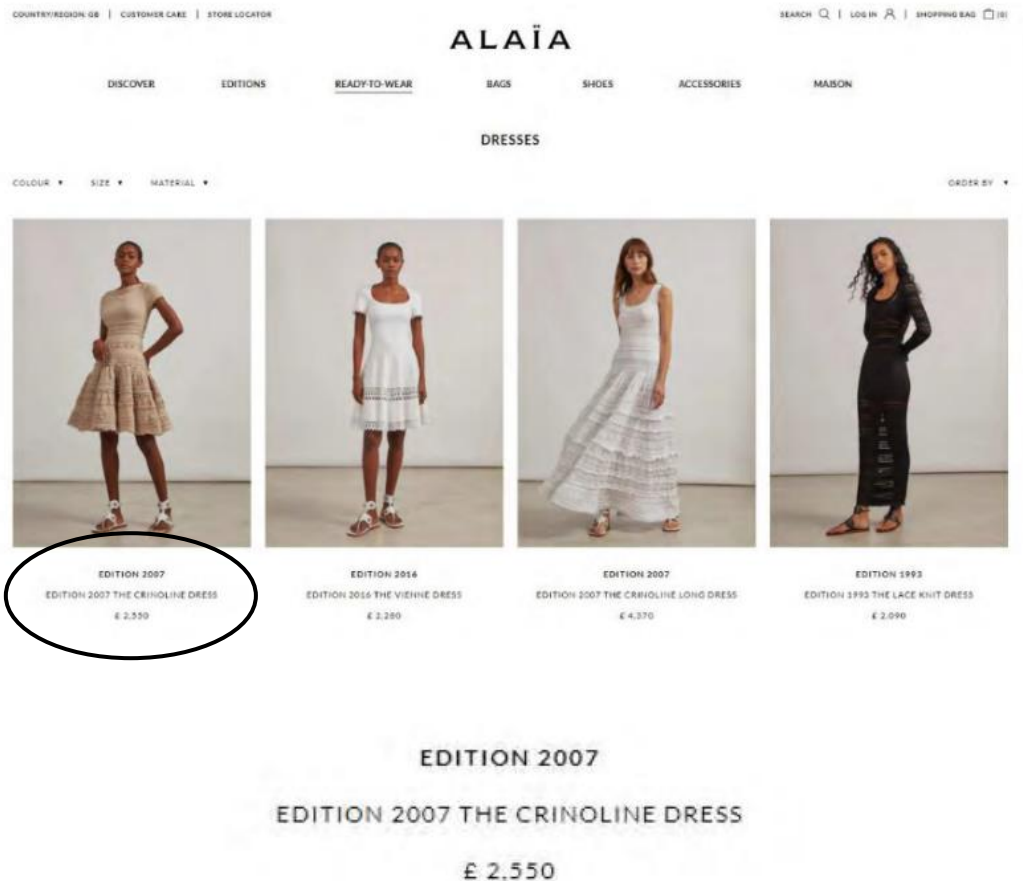
37. The receipts contained in **exhibit EM23** are headed with the Second Earlier “ALAÏA PARIS” mark, and are dated between 2 July 2019 to 1 July 2022. The only goods which are clearly listed as being sold are denim jeans priced at £660 and sunglasses priced at £390. It is not clear what the remaining items are, based on their receipt name (for example “calf leather” sold for £1,340). I also note that the price of the receipts vary between £1,520.00 and £8,590.00.

38. I have also been provided with a range of invoices dated between 23 October 2018 and 24 August 2022 relating to Alaïa branded products, which Ms May confirms were sold in the UK.¹⁵ The invoices from NET-A-PORTER are clearly being shipped to UK customers based in London and Glasgow. The customer’s name and address in the Alaïa Bond Street invoices are redacted, but the Second Earlier Mark and the Bond Street address of the Alaïa store is contained in the top left-hand corner of the invoices. The goods sold within these invoices include dresses, jumpers, handbags, bodysuits, trousers, clutch bags, fragrances, jeans and belts, and the price of the invoices range between £550 and £8,590.00.

39. The applicant also sells its Alaïa branded products in the EU and UK through its website maison-alaia.com. I have been provided with screenshots from its website showing the sale of sunglasses, books, perfumes, bags, shoes (boots, heels and

¹⁵ **Exhibit EM24**

sandals), dresses, skirts and belts.¹⁶ I note that goods are priced at between £960 and £11,830. I also bear in mind that the majority of the screenshots are dated 10 April 2019 and 11 April 2019. However, for those screenshots which are undated, some of the items being sold have yearly edition numbers, for example, as follows:



40. I therefore consider it is reasonable to infer that these items were most likely released in their edition year. I also note that in the majority of the screenshots, the banner of the applicant's website clearly uses the ALAÏA mark. To support the above evidence, at **exhibit EM25**, Ms May has provided me with Google Analytics data for its website from 1 September 2018 to 3 July 2023. This shows that France was the second biggest user, the UK was the fourth biggest user, Germany and Italy were the fifth and sixth biggest users, and Ireland was the tenth biggest user of the website. The exhibit also contains a breakdown of the UK users which shows the following data:

¹⁶ Exhibit EM3

Region	Acquisition			Behavior			Conversions
	Users ↓	New Users	Sessions	Bounce Rate	Pages / Session	Avg. Session Duration	Transactions
	381,078 % of Total: 8.78% (4,341,228)	375,386 % of Total: 8.59% (4,370,188)	479,030 % of Total: 8.38% (5,718,277)	41.78% Avg for View: 41.47% (0.74%)	2.73 Avg for View: 2.99 (-8.90%)	00:01:32 Avg for View: 00:01:49 (-15.92%)	1,670 % of Total: 18.96% (15,234)
1. England	336,828 (87.44%)	330,621 (88.07%)	421,445 (87.98%)	41.89%	2.71	00:01:32	1,407 (84.25%)
2. Scotland	33,097 (8.59%)	30,235 (8.05%)	39,596 (8.27%)	40.16%	2.85	00:01:32	192 (11.50%)
3. Wales	6,771 (1.76%)	6,524 (1.74%)	7,793 (1.63%)	44.80%	2.36	00:01:00	24 (1.44%)
4. Northern Ireland	4,654 (1.21%)	4,440 (1.18%)	5,616 (1.17%)	43.32%	2.32	00:01:21	14 (0.84%)
5. (not set)	3,725 (0.97%)	3,441 (0.92%)	4,421 (0.92%)	38.77%	3.92	00:02:30	32 (1.92%)
6. Isle of Man	126 (0.03%)	125 (0.03%)	159 (0.03%)	36.48%	2.93	00:01:25	1 (0.06%)

City	Acquisition			Behavior			Conversions
	Users ↓	New Users	Sessions	Bounce Rate	Pages / Session	Avg. Session Duration	Transactions
	381,078 % of Total: 8.78% (4,341,228)	375,386 % of Total: 8.59% (4,370,188)	479,030 % of Total: 8.38% (5,718,277)	41.78% Avg for View: 41.47% (0.74%)	2.73 Avg for View: 2.99 (-8.90%)	00:01:32 Avg for View: 00:01:49 (-15.92%)	1,670 % of Total: 18.96% (15,234)
1. London	165,590 (42.43%)	162,309 (43.24%)	217,414 (45.39%)	39.84%	3.03	00:01:53	830 (49.70%)
2. (not set)	30,564 (7.83%)	28,770 (7.66%)	35,663 (7.44%)	42.91%	2.73	00:01:30	146 (8.74%)
3. Edinburgh	18,421 (4.72%)	16,168 (4.31%)	22,786 (4.76%)	37.24%	3.29	00:01:56	134 (8.02%)
4. Birmingham	8,578 (2.20%)	8,203 (2.19%)	9,885 (2.06%)	46.49%	2.13	00:00:58	17 (1.02%)
5. Manchester	6,655 (1.71%)	6,332 (1.69%)	7,601 (1.59%)	50.23%	2.20	00:01:04	9 (0.54%)
6. Glasgow	5,106 (1.31%)	4,926 (1.31%)	6,008 (1.25%)	44.44%	2.30	00:01:04	17 (1.02%)
7. Leeds	4,519 (1.16%)	4,298 (1.14%)	5,250 (1.10%)	44.84%	2.19	00:01:05	14 (0.84%)
8. Liverpool	4,439 (1.14%)	4,258 (1.13%)	5,146 (1.07%)	46.44%	2.15	00:00:59	8 (0.48%)
9. Bristol	3,754 (0.96%)	3,559 (0.95%)	4,312 (0.90%)	42.95%	2.35	00:01:06	9 (0.54%)
10. Newcastle upon Tyne	2,854 (0.73%)	2,601 (0.69%)	3,234 (0.68%)	44.68%	2.28	00:01:03	6 (0.36%)

41. I have also been provided with printouts of third-party stores selling the applicant's goods from 7 June 2019 to 17 August 2022 exhibited in **EM4**. I bear in mind that as the applicant has included 4 screenshots per page on this exhibit, the quality of the screenshots themselves has degraded, making some of the content illegible. I therefore note the following from what can clearly be read:

- a) The shoes and handbags shown for sale on Selfridges.com range between £299 and £2,950, and these are sold under the mark "AZZEDINE ALAÏA".
- b) The perfume goods shown for sale on Selfridges.com are sold under the Alaïa Paris mark.

- c) The dresses, shirts, tops, shorts, bags, shoes, belts and sunglasses shown for sale on NET-A-PORTER.com range between €361 to €12,360. These goods are sold under the “ALAÏA” mark.

42. Ms May has provided me with undated photographs of the applicant’s goods including its bags, wallets, sunglasses, shoes, perfume and blazers, contained in **exhibit EM5**. I note that the mark “ALAÏA PARIS” is used on all of these goods. Whilst there are also photos of a denim jacket and shirt, I am unable to find a mark being used on these goods.

43. I have also been provided with 2018 and 2022 ALAÏA Look Books in **exhibits EM6** and **EM7**, which Ms May confirms was “circulated to retailers of ALAÏA goods, to allow them to select and order stock for the coming season, and which are reported in the fashion press”. The first 2018 Look Book contains photos of models wearing a variety of clothing such as tops, skirts, coats and shoes. However, I note that this book does not contain any prices or codes for the pieces. The second and third 2018 Look Books contains photos of bags, purses, belts, and shoes, with both containing product codes next to the items. The December 2022 Look Book contains multiple photos of models wearing a broad variety of clothing, accessorized with shoes and bags, but again, there are no prices or product codes for these pieces. Nonetheless, the following “ALAÏA PARIS” mark is still clearly used at the beginning of all the Look Books:



44. I note that the Second Earlier Mark is a comparable UK trade mark (IR). Therefore, I can consider the evidence that pertains to the EU until IP Completion Day (31 December 2020), and the UK, in order to determine its reputation in both territories. However, I also remind myself that a link has to be made in the mind of the UK relevant public¹⁷ and therefore I will focus on the applicant’s UK evidence only.

¹⁷ *China Construction Bank Corporation v Groupement Des Cartes Bancaires*, (Case BL O/281/14)

45. Before I make any assessment on the level of reputation established by the applicant's evidence, I bear in mind that in its submissions in lieu, the applicant draws to my attention to the EUIPO opposition decision contained in **exhibit AG-05**, in which the applicant's predecessor was acting as the applicant. In this case, the EUIPO finds that based on the evidence before them, "the earlier mark enjoys a reputation amongst the relevant public". On this basis, the applicant submits that it was "evident that the earlier marks enjoy a significant reputation in the UK". However, firstly, I am not bound by EUIPO decisions. Secondly, I do not know what evidence was before the EUIPO for them to make such a finding, and thirdly, the EUIPO did not find that the marks enjoyed a "significant" reputation, they simply found that it enjoyed a reputation without specifying a level. On this basis, I do not consider that EUIPO decision evidence assists the applicant.

46. I bear in mind that throughout her witness statement, Ms May refers to the "fame" and "reputation" of the designer Azzedine Alaïa.¹⁸ She also states that "the brand ALAÏA and Mr. Alaïa go hand-in-hand" and that they "are interchangeable as references, in the same way that in, the world of fashion, ARMANI signifies Giorgio Armani (and vice versa), LAGERFIELD signifies Karl Lagerfeld (and vice versa) and Christian Dior signifies DIOR (and vice versa). In other words, [...] the fame of Azzedine Alaïa represents the fame of the ALAÏA brand and vice versa". I find that in the world of luxury and high-end fashion, it is typical for the brand itself to be named after its founding designer. This does of course create a connection between them. Nevertheless, it is also clear from the above that there is also a significant amount of evidence which pertains to the brand itself. The total turnover made under the Alaïa mark for the financial years 2016 to June 2023 for the UK alone was in excess of €50 million. This figure has been broken down by the types of goods sold including readywear (which is clothing and footwear), leather goods (which is purses, bags and belts), eyewear and fragrances. This evidence is supported by invoice and receipt evidence from the applicant's flagship London store, the opening of which was reported on in third-party articles, which allows me to determine that the store clearly used the First Earlier Mark as signage, and the Second Earlier Mark on its receipts. I have also been provided with screenshots of the applicant's website alongside its user

¹⁸ Paragraphs 15, 22, 24 and 25

figures, and a breakdown of its users (via UK region, which shows a significant geographical spread), which shows that from 1 September 2018 to 3 July 2023, there were a total of 381,078 UK-based users, with over 479,000 sessions. I have also been provided with third-party website evidence showing Alaïa goods for sale, which is supported by invoice evidence from NET-A-PORTER, showing Alaïa goods being shipped to London and Glasgow. The applicant's evidence also includes numerous third-party article evidence pertaining to celebrities wearing ALAÏA clothing, many of which are listed as being a part of his "esteemed client list". In relation to the applicant's perfume goods, I note that I have been provided with a list of awards won by their "ALAÏA PARIS" fragrances. Therefore, taking the above into account, I am satisfied that the applicant has demonstrated a fairly notable reputation in the UK in relation to the First and Second Earlier Mark's following goods and services:

First Earlier Mark

Class 3 Perfumes.

Class 25 Shoes, belts for clothing.

Second Earlier Mark

Class 3 Perfumes.

Class 18 Handbags.

Class 25 Shoes, belts (clothing).

Class 35 The bringing together, for the benefit of others, perfume, handbags, shoes, belts (clothing) and clothing for women, enabling customers to conveniently view and order them in a retail store.¹⁹

¹⁹ It is noted that selling one's own goods is not the same thing as offering retail services: see *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14 at [9]. However, bearing in mind paragraphs 11 to 18 of *LIVE! (word mark)* Case BL O/1202/24, I find that the photographs and third party reports of the applicant's London Bond Street retail store in combination with the invoice and receipt evidence which pertains to the store, is sufficient evidence of the applicant having a reputation for such services.

47. In regard to the applicant's remaining goods, that being class 25 women's clothing, I note that all of the third-party article evidence which comments on the legacy of Azzedine Alaïa and his designs is always in relation to these goods. For example, the celebrities including Naomi Campbell, Kim Kardashian, Kylie Kardashian, Victoria Beckham, Adele, Lady Gaga, Madonna Michelle Obama and Rhianna, are all described as being dressed in, or wearing, ALAÏA clothing.

48. Throughout the evidence, Azzedine Alaïa is described as having an "extraordinary legacy" being labeled as the "king of cling", who invented the bodycon silhouette. It was his bodycon collections that "put Alaïa on the fashion map". The aforementioned articles also talk about how he "molded his clothes to the female form", and that he "was highly revered for his garments that moulded the body into extraordinary proportions". The Naomi Campbell quote which I note appears in 2 of the articles contained within the evidence, refers to his dresses cinching a woman's body perfectly.²⁰ The exhibition at the Design Museum in London included 60 garments from the 1980's to 2017, including "many famous Alaïa numbers" such as the bandage dress and the 2003 long black fitted dress. I also note that the VOGUE article states that "the exhibition charts the designers' career in clothing" and the 10 images of the exhibition clearly only shows Alaïa clothing on display, 7 of which are of his dresses.

49. Therefore, bearing in mind all of the aforementioned evidence, I am satisfied that the applicant has demonstrated above a reasonably strong reputation in the UK in relation to the First and Second Earlier Mark's following goods:

First Earlier Mark

Class 25 Clothes for women.

Second Earlier Mark

Class 25 Clothing for women.

²⁰ The HarpersBazaar UK article dated 3 May 2018 in **Exhibit EM22** and The Guardian Article dated 9 May 2018 in **Exhibit EM11**.

Link

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

The degree of similarity between the conflicting marks

As noted in paragraphs 23 and 24 above, I have found that the First Earlier Mark and the holder's IR are visually and aurally similar to a medium degree, and the Second Earlier Mark and the holder's IR are also visually and aurally similar to a medium degree. I found that the "ALAÏA" elements in the parties marks were conceptually neutral with the words "PARIS" in the Second Earlier Mark and the word "chalet" (with the mountain and tree devices) in the holder's IR, acting as conceptual points of difference.

I also note that the applicant has provided significant evidence in regard to the fame of Azzedine Alaïa, the founder and designer of the ALAÏA. As noted above, I have found that in the world of luxury and high-end fashion, it is typical for the brand itself to be named after its founding designer, which creates a connection between them.

I bear in mind that there are cases where the reputation and fame attached to the names of the individuals for their roles in society has been parlayed into conceptual meaning, such as C-361/04 P *PICASSO/PICARO* and C-449/18 *MESSI*. These are, of course, exceptions rather than the rule.²¹ In this case, the evidence shows that the individual, Azzedine Alaïa, is highly connected to the brand ALAÏA, by virtue of it being named after him. This has been highly covered in the media, in some of the biggest newspapers and magazines. On this basis, I consider that the evidence shows that the reputation of Azzedine Alaïa has attached itself to the word "ALAÏA" and that consumers when seeing the applicant's marks, will automatically associate it with Azzedine Alaïa.

²¹ *Retail Royalty Company v Harringtons Clothing Limited*, O/593/20 paragraph 76

Therefore, conceptually, the ALAÏA element of the applicant's marks will evoke and bring to mind the fame of its founding designer, Azzedine Alaïa.

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

In the applicant's submissions in lieu, they state that as the evidence illustrates that the applicant's goods can retail between \$2,500 and \$3,500, "it is conceivable" that consumers may believe that financial affairs, namely insurance services, would be conducted by a company bearing the ALAÏA sign. However, I struggle to follow this line of argument. I appreciate that the applicant's goods are expensive, and therefore a consumer may choose to obtain insurance to protect them. However, fashion brands/retail stores do not provide insurance services, and I have no evidence to support this notion. Insurance can only be purchased from insurance companies and for the holder's remaining class 36 services, these would be provided by financial undertakings and those qualified to give financial advice (such as financial advisors). Therefore the parties' goods and services clearly do not overlap in trade channels. The holder's class 36 services are all financial, and therefore clearly do not overlap in nature, method of use or purpose with the applicant's clothing for women, perfumes, shoes, belts and handbags goods or the bringing together of such goods for customers to view them in a retail store. The parties' goods and services are neither in competition nor complementary. I therefore find that they are dissimilar.

The holder's class 37 construction, repair and installation services also clearly do not overlap in nature, method of use or purpose with the applicant's clothing for women, perfumes, shoes, belts and handbags goods or the bringing together of such goods for customers to view them in a retail store. The holder's services would be provided by builders and construction companies. Therefore, the goods and services clearly do not overlap in trade channels, and they are neither in competition nor complementary. I therefore find that they are clearly dissimilar.

The holder's class 41 education services, training services and sporting and cultural activities (excluding fashion shows and fashion events) would be provided by educational undertakings, and sporting and cultural undertakings. I also bear in mind that the holder's sporting and cultural activities exclude fashion shows and fashion events, which would have been the closest connecting services to the applicant's clothing goods. Therefore, it is clear that the holder's services do not overlap in nature, purpose, method of use or trade channels with the applicant's clothing for women, perfumes, shoes, belts and handbags goods or the bringing together of such goods for customers to view them in a retail store. The goods and services are neither in competition nor complementary. I therefore find that the services are dissimilar.

I am dealing with the holder's class 41 "entertainment" services separately on the basis that Mr Gay has provided evidence pertaining to the overlap of the gaming and fashion industries. I bear in mind that gaming services would be encompassed by the holder's term "entertainment".

Exhibits AG-02 to AG-04 contains 5 articles dated between 30 November 2021 and 1 November 2022 from third party websites such as Gucci, the Financial Times, Burberry and Vogue Business, commenting on designer clothing being used in the gaming world. The Financial Times article dated 30 November 2021 comments on how The Fashion Awards "launched a gaming category, the latest step in a deepening relationship between the two worlds". The awards were presented by Gucci's creative director, and for those who could not attend in person, a virtual recreation of the venue was created in the game ROBLOX. The article also comments on brands such as Moschino being used in the "The Sims" game, Marc Jacobs and Valentino designing outfits for the game "Animal Crossing", Balenciaga debuting its Fall 2021 collection in a "beautiful walking simulator game", having also partnered with Fortnite in September 2021, with Burberry, Dior and Hermes all having made mobile games. This article also comments on how designers are interested in the gaming world on the basis that it allows them to advertise to younger customers, as well as the virtual item market being lucrative, and that the "virtual skin market" (which the name for virtual clothing) is estimated at \$4 billion a year. In the Burberry article dated 1

November 2022, it comments on the launch of its own game within the world of “Minecraft”. The article states that they are excited to announce “Minecraft’s first luxury goods collaborations with one of the most iconic fashion brands in the world, Burberry”. The Vogue Business article comments on how the luxury brand Dior is “stepping up its presence in the metaverse” collaborating with the racing game “Gran Turismo Sport” (GT Sport) which brings Dior’s designs into the virtual world, by designing “a virtual capsule of skins to outfit avatars on GT Sport”. The article also lists other “luxury house collaborations” with games including Louis Vuitton’s “pioneering partnership” with League of Legends in 2019. **Exhibit AG-01** also contains an article from “anzu” commenting on the world of fashion and gaming. While this article is dated 17 January 2023, it refers to The Sims 2 releasing a H&M stuff pack containing H&M branded clothing in 2007. It also refers to Prada featuring their clothing in Riders Republic (racing game), albeit there is no date provided when this occurred. The article also states that fashion brands are using in-game ads, including Levi’s, which promoted its jeans in games such as Tennis Clash and Rider Zero, but again no date is provided for these collaborations.

While Mr Gay does not give specific reasons as to why the aforementioned evidence was filed, in its submissions in lieu, under the “nature of the goods and services” heading, the applicant states that fashion brands are expanding into entertainment services. I therefore find that the evidence has been filed to show that there is a link between the applicant’s clothing goods and the holder’s entertainment services. While I note that the article evidence briefly mentions that Burberry, Dior and Hermes all have made mobile games (albeit I have no specific dates as to when they were created), there is no further evidence to support this, for example, to show what types of games they were, or showing their availability to be downloaded on app stores before the relevant date. I therefore find that this minimal evidence is not sufficient on its own to establish an overlap in trade channels, that being, the same undertakings providing both games and clothing. Nevertheless, it is clear that all of the aforementioned evidence provided by the applicant shows that there is a collaboration between fashion brands and gaming undertakings by bringing designer clothing into games such as The Sims or Animal Crossing. While I have found that gaming

services would be encompassed by the holder's term "entertainment", the virtual goods which appear in these games, such as the designer "skins", would not be encompassed by the term "entertainment". I find that virtual goods, such as virtual clothing, would fall within class 9 of the NICE specification.²² However, the holder has not applied for virtual goods in class 9. I therefore find that the applicant's above evidence only assists in establishing a connection between fashion brands and virtual clothing goods, and not entertainment services. On this basis, I find that the evidence does not assist the applicant.

In its submissions in lieu, the applicant states that fashion shows and fashion events are also a form of entertainment. I note that the term "organization of fashion shows for entertainment purposes" is included in the WIPO Nice Classification list. However, I do not consider that this is similar to the applicant's clothing for women, perfumes, shoes, belts and handbags goods or the bringing together of such goods for customers to view them in a retail store. Fashion houses might present and promote their creations at fashion shows, however, promoting one's own product is a form of marketing and advertising and fashion houses do not offer the services of organising fashion shows for others. The contested services are professional services directed at the organisation of fashion shows for third parties and would be provided by professional agencies engaged in providing fashion show management services. The services would include the handling of logistical tasks relating, for example, to the booking of a venue and the arranging of catering services, as well as the hiring of models. The users of these services would be those interested in using fashion shows for entertainment purposes, i.e. clothing designers, whereas the applicant's goods and services target the general public, so the consumers are different. Whilst fashion shows cannot be rendered without clothing, handbags and shoes, this does not create a complementary relationship in the trade mark sense as the relevant public would not expect a manufacturer of clothing to provide the contested services to others. I therefore find no similarity here.

²² <https://guidelines.euipo.europa.eu/2214311/2215360/trade-mark-guidelines/4-4-1-virtual-goods>

For the remaining services that would be encompassed by the applicant's term "entertainment", the applicant has not provided any submissions as to where the similarity would lie, and in the absence of any such claim, I do not need to consider these services any further. Nevertheless, even if I am wrong to assume that the applicant has not brought a claim of similarity based on other entertainment services, it is not clear why these services would be similar to the applicant's clothing for women, perfumes, shoes, belts and handbags goods or the bringing together of such goods for customers to view them in a retail store. There is no obvious overlap in nature, method of use, purpose or trade channels, and the goods and services are neither in competition nor complementary. I therefore find that they are dissimilar.

The strength of the earlier marks' reputation

I have found that the applicant has shown a fairly notable reputation for perfumes, shoes, belts, handbags and the bringing together of such goods for customers to view them in a retail store, and the applicant has shown a reasonably strong reputation for clothing for women.

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

As noted above, the First and Second Earlier Marks are composed of the word "ALAÏA", which, based on the evidence, I have found would evoke and bring to mind the fame of Azzedine Alaïa. As the applicant's goods and services are clothing based, I find that to be named after the founding designer would make the mark inherently distinctive to a lower degree. However, I also appreciate that the surname "ALAÏA" is unusual, and therefore I find that the First Earlier Mark is inherently distinctive to at least a medium degree. I do not find that the word "PARIS" contributes to the distinctiveness of the Second Earlier Mark and therefore it is also inherently distinctive to at least a medium degree.

As noted above, I have found that the First and Second Earlier Marks have a fairly notable or reasonably strong reputation for the aforementioned goods and

services. I recognise that reputation is not the same as enhanced distinctive character, but similar factors are to be taken into account in both assessments. Therefore, I find that the evidence is, for the reasons set out above in relation to reputation, sufficient to establish enhanced distinctiveness of the First and Second Earlier Marks. For its perfumes, shoes, belts, handbags and the bringing together of such goods for customers to view them in a retail store and website, I find that the distinctiveness of the First and Second Earlier Marks have been enhanced to between a medium and high degree. For its clothing for women, I find that the distinctiveness of the First and Second Earlier Marks have been enhanced to a high degree.

Whether there is a likelihood of confusion

Where the goods and services are dissimilar, there can be no likelihood of confusion.²³

51. I am now required to determine whether, in this particular case, the relevant public would bring the applicant's marks to mind when confronted with the holder's IR. That is, to make a link between them.

52. I remind myself at this stage that finding similarity between the goods and services, or indeed a likelihood of confusion, is not required in order to find a link would be made between the marks. However, the closeness of the goods and services is a factor to taken into account when considering if the use of the later mark would bring the earlier marks to mind.

53. Taking all of the above into account, I do not consider that the applicant's above submissions or evidence is strong, nor specific enough, to establish that a link could be made between the holder's class 36, 37 and 41 services which are entirely different in nature, method of use, purpose, or trade channels with the applicant's clothing for women, perfumes, shoes, belts and handbags goods or the bringing together of such goods for customers to view them in a retail store. I have therefore found the goods

²³ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

and services to be dissimilar based on the factors identified in *Treat*.²⁴ While this case is usually applied in the context of a section 5(2)(b) claim, I find that the *Treat* factors can be considered, and are useful when assessing the similarity of the parties' goods and services in the context of section 5(3).

54. Notwithstanding the fact that the parties goods and services are likely to overlap in user, I find that the parties goods and services are too removed from one another. Therefore, even though the applicant's reputation is fairly notable for perfumes, shoes, belts, handbags or the bringing together of such goods for customers to view them in a retail store, and reasonably strong for women's clothing, it is still not strong enough to bridge the gap between them. I consider that the distance between the goods and services is sufficient to offset any similarity between the parties' marks. While I note that the similarity of the marks derives from the word "ALAIËA", I have found that the concept conveyed by this element in the applicant's marks is the fame of its founding designer Azzedine Alaïa, who was known to make flattering and figure hugging clothing for women. This again reinforces that the average consumer would not make a connection between the parties' marks on the basis that Azzedine Alaïa's fame and reputation vests in being a clothing designer, a concept which is subsequently conveyed by the applicant's earlier marks being used on women's clothing goods and retail services relating to the same. However, as noted above, as the holder's IR has been registered for financial services, construction services, educational services and entertainment services, I find that these services are too far removed from what the applicant's reputation (and the concept conveyed by its marks) vests in. In light of this, I consider that upon encountering the marks, the average consumer is unlikely to make a link between them.

55. As I have found there to be no link between the marks in the minds of the relevant public in the UK, there can be no resulting damage caused to the applicant's earlier mark. However, even if a link is made, it would be so fleeting that it would not suffice to result in an unfair advantage or damage to the applicant or its marks.

56. As I have found there to be no link, the opposition based upon section 5(3) fails.

²⁴ [1996] R.P.C. 281

Section 5(4)(a)

57. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

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

aa)...

b) ...

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

58. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

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

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

deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

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

Relevant date

60. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'"

61. As the holder has filed no evidence of use, I have only the prima facie relevant date to consider i.e. 24 May 2022.

Goodwill

62. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

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

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

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.

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

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

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

65. Goodwill arises as a result of trading activities, and it is clear from the turnover figures provided by Ms May that the applicant's company has been trading under the ALAÏA sign since at least 2016. As noted in paragraphs 33 and 34 above, I have been provided with turnover tables showing a breakdown of goods sold under this sign in the EU and UK. I am therefore able to determine that the goods sold under the applicant's sign are fragrance, eyewear, clothing for women, footwear, purses, bags and belts.²⁵

66. Ms May confirms that the total turnover for 2016 to 2020 for the UK alone was “in the region of Euro 32 million” and the total turnover for 2021 to 2023 in the UK “was in the region of Euro 18 million”. These figures are supported by a range of receipts and invoices dated between 23 October 2018 and 24 August 2022 showing the sale of ALAÏA goods (include dresses, jumpers, handbags, bodysuits, trousers, clutch bags, fragrances, jeans and belts) in the UK.²⁶ A proportion of the receipts and invoices pertain to the sales made in ALAÏA's flagship London Bond Street Store, whilst the remaining receipts which pertain to sales made via the third party store NET-A-PORTER. All of this evidence is supported by third party article evidence which reported on the opening of the store, and screenshot evidence from NET-A-PORTER's website selling ALAÏA dresses, shirts, tops, shorts, bags, shoes, belts and sunglasses. Therefore, taking into account the evidence as a whole, I am satisfied that the applicant has demonstrated a fairly notable degree of goodwill prior to the relevant date in relation to perfumes, shoes and belts (clothing), which are all terms the applicant relies

²⁵ As explained by Ms May in paragraph 34 of my decision.

²⁶ **Exhibit EM24**

upon under section 5(4)(a). I also find that the applicant has demonstrated a fairly notable degree of goodwill prior to the relevant date in relation to the bringing together, for the benefit for others, a variety of clothing goods enabling customers to conveniently view and order them in a retail store (which is a sub-category of the term “the bringing together, for the benefit for others, a variety of goods enabling customers to conveniently view and order them in a retail store” which the applicant relies upon under section 5(4)(a)). In regard to the term “clothing for women”, I find that the evidence summarised in paragraphs 47 and 48 means I am able to find that the applicant has demonstrated a reasonably strong degree of goodwill prior to the relevant date in relation to these goods.

67. I also bear in mind that all of the above evidence shows the use of its ALAÏA sign on its invoices and screenshots of its website evidence. The opening of the flagship London Bond Street Store which was reported on in third-party articles clearly shows the ALAÏA sign being used on the storefront. The applicant has also provided me with numerous third-party articles showing its “esteemed client list” of celebrities wearing ALAÏA clothing (including Naomi Campbell, Kim Kardashian and Lady Gaga), and that the Design Museum in London held an exhibition showing 60 of ALAÏA’s “famous numbers” from the 1980’s to 2017 (the exhibition of which was reported in VOGUE). In light of this, I am satisfied that the ALAÏA sign was distinctive of its goodwill at the relevant date.

Misrepresentation and damage

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

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

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the

public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]"

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

And later in the same judgment:

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

69. The goods for which the applicant has shown goodwill, that being perfumes, clothes for women, shoes and belts (clothing), are dissimilar to all of the holder's class 36, 37 and 41 services, for the same reasons set out in paragraph 50 above.

70. The services for which the applicant has shown goodwill, that being the bringing together, for the benefit for others, a variety of clothing goods enabling customers to conveniently view and order them in a retail store, are also dissimilar to all of the holder's class 36, 37 and 41 services, for the same reasons set out in paragraph 50.

71. I note that, per *Harrods Limited v Harrodian School Limited*,²⁷ this does not preclude a successful section 5(4)(a) claim. However, I also bear in mind that in *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the

²⁷ [1996] RPC 697 (CA)

less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that;

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

"...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, **is a heavy burden**; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. **When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.**" (my emphasis)

72. While I bear in mind that the parties' marks are composed of, or include, the word "ALAÏA", the reputation of Azzedine Alaïa has attached itself to the applicant's earlier sign. Therefore, conceptually, the applicant's earlier sign, which is being used on clothing goods and services, evokes and brings to mind the fame of the clothing designer Azzedine Alaïa, whereas the holder's IR will simply be perceived as an invented word with no meaning. Moreover, the holder's IR includes the ordinary dictionary word "Chalet" (being a a small wooden house which is typically found in a mountain area), a concept which is supported by the mountain and tree devices contained within the IR.

73. Taking all of the above into account, albeit the applicant clearly had a fairly notable or reasonably strong goodwill at the relevant date, I consider that the differences between the goods and services would be sufficient to avoid misrepresentation occurring. I find that the fields of activity that the applicant operates are too far removed from the fields of activity that the holder operates in, and therefore, I consider that these differences are sufficient to avoid a substantial number of members of the relevant public purchasing the holder's services in the mistaken belief that they are provided by the applicant's business.

74. As there is no misrepresentation, there can be no damage.

75. The opposition under section 5(4)(a) is unsuccessful.

CONCLUSION

76. The application for invalidation is unsuccessful and, subject to any appeal, the contested IR may remain registered.

COSTS

77. The holder has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023.

78. While I bear in mind that the holder did provide evidence in chief, this evidence was exceptionally short and was filed in relation to an argument that I found to be irrelevant to the decision I was required to make. On the basis that the evidence was of no use in these proceedings, I make no award relating thereto. In the circumstances, I award the holder the sum of **£250** for considering the applicant's statement of grounds and preparing a counterstatement.

79. I therefore order AZZEDINE ALAIA SAS to pay Alaïa SA the sum of £250. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 5th day of November 2025

L FAYTER

For the Registrar

ANNEX 1

First Earlier Mark

Class 3

Perfumes.

Class 25

Clothes for women, trousers, suits, dresses, jackets, blouses, sweaters, shirts, coats, pyjamas, night shirts, swimsuits, socks, tights, stockings, underwear, lingerie, slippers, shoes, sandals, boots, belts for clothing, headwear.

Second Earlier Mark

Class 3

Perfumes.

Class 18

Handbags.

Class 25

Clothing for women, suits, dresses, trousers, jackets, pullovers, shirts, blouses, coats, pajamas, nightgowns, bathing suits, socks, stockings, tights, underwear, lingerie, shoes, boots, slippers, headgear, belts (clothing).

Class 35

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and order them in a retail store; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and order them via mail-order sales catalogs or by any means of electronic communication; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and to order them via web sites; promotion through sponsored links on websites of others; advertising services.