

BL O/1129/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NUMBER UK00002222837

LITTLE BLACK DRESS

IN THE NAME OF
AVON PRODUCTS, INC

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 506049 BY
FASHION VENTURES LIMITED

AND

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY
FASHION VENTURES LIMITED
AGAINST DECISION NO. O/0712/24
DATED 29th JULY 2024

MR. SAIYEEM JUNED (of Wilson Gunn) appeared for the Invalidity Applicant/Appellant.
MS. RACHEL WILKINSON-DUFFY (of Baker & McKenzie LLP) appeared
for the Registered Proprietor/Respondent.

APPEAL DECISION

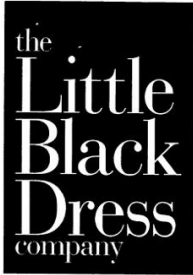
Introduction & Background

1. This is an appeal by the applicant for invalidity Fashion Ventures Limited (“the Invalidity Applicant”) from decision BL O/0712/24 of Laura Stephens sitting as a Hearing Officer on behalf of the Registrar of Trade Marks, dated 29th July 2024.
2. Avon Products, Inc (“the Proprietor”) is the Registered Proprietor of UK Trade Mark registration No. 2222837 for the mark LITTLE BLACK DRESS (“the Registration”). The contested mark was filed in the United Kingdom on 18 February 2000 and registered on 5 January 2001. It is registered for the following goods in class 3:

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

3. On 28 April 2023, the Invalidity Applicant applied to have the Registration declared invalid under section 47 (2)/5 (2) (b) of the Trade Marks Act 1994 (“The Act”). The Invalidity Applicant relied on its following registrations:

United Kingdom Trade Mark (“UKTM”) 2216315



Filing date: 6 December 1999

Registration date: 9 June 2000

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

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

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

UKTM 2220632



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

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

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

Filing date: 29 January 2000

Registration date: 14 July 2000

4. The Earlier Marks having been on the register for more than 5 years prior to the date of the application for the declaration invalidity, by virtue of S. 47 (2A) the Invalidity Applicant was required to prove that the Earlier Marks had been put to genuine use as set out in S. 47 (2B) (a).
5. The Invalidity Applicant filed evidence to prove genuine use and, as it put it, “to show that it is common for fashion houses to offer cosmetics”. A key submission of the Invalidity Applicant was that:

“The goods of the Later Registration are similar to the goods of the Earlier Registrations

because it is common practice in the fashion industry for fashion houses to produce clothing, fashion accessories, such as jewellery and bags, and cosmetics and perfumes.”

The Hearing Officer’s Decision

6. The Hearing Officer’s decision was straightforward. First, they approached the issue of the Earlier Mark’s genuine use. After reviewing the evidence they concluded that genuine use had been shown for only:

“girls’ and ladies’ skirts, blouses, jackets, trousers, coats, knitwear... but not including dresses or similar goods to dresses”

in class 25. There is no appeal from this finding.

7. Next, approaching the S. 47 (2)/5 (2) (b) ground of invalidity, the Hearing Officer began the comparison of the parties’ goods at [26-27] by reminding herself of the relevant legal principles. There is no suggestion on appeal that the Hearing Officer misdirected herself on these principles in any way.

8. The Hearing Officer then went on to compare the parties’ goods. They found that the Invalidity Applicant’s class 25 clothing goods were dissimilar to all of the Proprietor’s class 3 goods ([28-34]). At [35], they concluded:

“As some degree of similarity between the parties’ goods and/or services is necessary to engage a likelihood of confusion, the invalidation must be deemed unsuccessful.”

The Appeal

9. The Invalidity Applicant appealed on the basis that the Hearing Officer erred “in correctly interpreting and applying the evidence filed by the parties in the Invalidation”; that they “failed to give due weight to the state of the marketplace and the view of the average consumer”, that the Hearing Officer should have found that “the average consumer is highly likely to consider there to be an economic connection between the two offerings and that the goods originated from the same entity” and, consequently, that they should have found a likelihood of confusion.

Standard of Appeal

10. The standard of appeal is well-known. It is limited to a review, not a re-hearing. I should only interfere with the Hearing Officer’s findings of fact if the decision was rationally insupportable (*Volpi v Volpi* [2022] EWCA Civ 464, [2022] 4 WLR 48 at [2](v) (Lewison LJ). In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court

should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. (*Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch), at [24]).

11. Specifically on the question of the assessment of the comparison of goods and services, I remind myself that the Registrar is a specialist tribunal and it is well established that judicial caution and restraint is required when considering whether to set aside a Hearing Officer's decision on such matters (*Extreme Networks Limited v Extreme Limited*, [2024] EWCA Civ 1386, per Arnold LJ at [31])

12. I bear these principles in mind.

Merits of the Appeal

13. It is fair to say the Grounds of Appeal were not pleaded with clarity as to the nature of the error alleged to have been made by the Hearing Officer. Considered *prima facie*, the thrust of the appeal seems to be that the Hearing Officer gave insufficient weight to the Invalidity Applicant's evidence that it is commonplace for the parties' respective goods to come from a common economically-linked source. Had sufficient weight been given to such matters then a likelihood of confusion should have followed.

14. What was *not* expressly included in the Grounds of Appeal was any challenge to the Hearing Officer's finding that the parties' goods were dissimilar. In effect the appeal was directed to the conclusions as to the likelihood of confusion arising from the Hearing Officer's multi-factorial evaluation rather than to their underlying factual findings. That being so, arguably the appeal was doomed to failure from the outset, since it is a pre-requisite for success under S. 5 (2) (b) that there is at least some similarity between the parties' goods. This was pointed out by the Ms Wilkinson-Duffy in her Skeleton Argument and at the Hearing, and it is a point with which I have considerable sympathy.

15. Mr Juned submitted that the similarity of the parties' goods was indeed in play because the challenge related to the Hearing Officer's failure to give due weight to the evidence that fashion houses commonly traded in perfumes as well which, he argued, amounted to similarity to at least some degree.

16. Ultimately, in my view it does not matter much how the scope of the pleaded appeal is resolved because the outcome is the same either way. Even giving the Mr Juned's submissions the benefit of the doubt the appeal fails, for the following reasons.

17. The Hearing Officer's assessment of the Invalidity Applicant's evidence and submissions was as follows:

“8. I take the following from the applicant’s evidence:*(followed by a summary)*...The applicant also encloses several exhibits highlighting examples of various fashion brands and fashion houses which also operate within the cosmetics and/or beauty industry.

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

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

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

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

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

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

It directs me to several decisions including *Frag Comercio Internacional, SL, v OHIM*.

In paragraph 30 of that judgment the GC held that:

“Secondly, the Board of Appeal did not err in finding, in paragraph 20 of the contested decision, that the goods in Classes 18 and 25 covered by the earlier Community mark were not complementary in relation to the ‘perfumery’ in Class 3 covered by the mark applied for. In that regard, the Court has held previously that perfumery goods and leather goods in Class 18 cannot be considered similar. Perfumery goods and leather goods are plainly different as regards both their nature and their intended purpose or their method of use. Moreover, there is nothing that enables them to be regarded as in competition with each other or functionally complementary. The same conclusion must be drawn concerning a comparison between perfumery goods and clothing in Class 25. Those goods, as of themselves, also differ as regards both their nature and their intended purpose or their method of use. There is nothing, either, that enables them to be regarded as in competition with each other or complementary (Case T-150/04 *Mülhens v OHIM – Minoronzoni (TOSCA BLU)* [2007] ECR II-2353, paragraphs 31 and 32).”

Perfumes, essential oils, colognes, eaux de Cologne

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

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

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

become “fashion accessories”. The goods are not used for the same purpose and any coincidence in the respective trade channels is likely to be on a fairly broad basis. The goods are not similar in their physical nature nor are they competitive or complementary. I find no similarity.

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

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

Non-medicated toilet preparations; toilet waters, toilet articles

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

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

18. From this it can be seen that the Hearing Officer reviewed the Invalidity Applicant’s evidence and submissions – and those of the Proprietor - for what they were worth and gave them the weight they considered appropriate in reaching their assessment. I see no error of law or principle here.

19. Mr Juned’s submissions to the contrary went no further than the repetition of the arguments made to the Hearing Officer and a vaguely defined suggestion that they should have given more (without saying how much more) weight to the evidence that fashion houses selling class 25 goods also deal in perfumes and the like.

20. It is well established that such matters, especially evidential weight and findings of fact such as the similarity/dissimilarity of goods, are essentially the preserve of the Hearing Officer and will only be vulnerable to appeal in exceptional circumstances. There are no such circumstances here. The Hearing Officer weighed up all of the relevant factors and reached entirely justifiable conclusions.

21. It follows that the Appeal is dismissed in full.

Costs

22. The Proprietor as the successful party is entitled to its costs. Both sides were content with costs “on the scale” which, in this case, is set out in Tribunal Practice Notice TPN 1/2023 Annex A.

23. The Hearing Officer awarded Avon Products, Inc £450. Taking a broad-brush approach to this appeal I award Avon Products, Inc £2000. The total sum of £2450 is payable by Fashion Ventures Limited to Avon Products, Inc. within 21 days of the date of issue of this Decision.

Philip Harris
Appointed Person
27 November 2025