

O-625-21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3468254

BY YI CHANG LANQUIER GARMENT CO., LTD.

TO REGISTER:



AS A TRADE MARK IN CLASSES 5, 10, 18, 20, 21, 22, 24, 25, 28 & 35

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 421327 BY

A&H SPORTSWEAR CO., INC.

BACKGROUND & PLEADINGS

1. On 19 February 2020, Yi Chang Lanqier Garment Co., Ltd. (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the goods and services in classes 5, 10, 18, 20, 21, 22, 24, 25, 28 & 35 shown in the Annex to this decision.

2. On 4 September 2020, the application was opposed by A&H Sportswear Co., Inc. (“the opponent”) under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Although the opposition based upon sections 5(2)(b) and 5(4)(a) of the Act was only directed at the goods in class 25 of the application, the opposition based upon section 5(3) of the Act was directed against all of the goods and services for which registration was being sought. However, in a letter dated 3 June 2021 accompanying its written submissions filed in lieu of a hearing, the opponent’s representatives, Potter Clarkson LLP (“PC”), indicated that the opposition based upon section 5(3) of the Act should only have been directed against class 25 of the application. It is upon that basis I shall proceed.

3. In relation to its objection based upon section 5(2)(b) of the Act, the opponent relies upon the United Kingdom and European Union (“EUTM”) trade marks and goods shown below:

(1) UK no. 2019409 (series of two) which was filed on 3 May 1995 and entered in the register on 23 August 1996:

MIRACLESUIT
Miraclesuit

Class 25 - Underwear; hosiery; swimwear.

(2) EUTM no. 43018 for the trade mark MIRACLESUIT which was filed on 1 April 1996 and entered in the register on 12 June 2001:

Class 25 - Clothing, namely swimwear, various items of underclothing and hosiery and shapewear, namely, girdles and other shape-controlling apparel; bodysuits, leotards and leggings.

4. Insofar as its objection based upon section 5(3) of the Act is concerned, the opponent relies upon the UK trade mark shown above, adding that its trade mark enjoys a reputation for all the goods upon which it relies. Having answered “Yes” to question 3 in the Notice of opposition which states:

“Is it claimed that the similarity between the [trade marks being relied upon] and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?”

the opponent states:

“7. The opponent further submits that it has acquired a reputation as a result of extensive use of the mark MIRACLESUIT throughout the UK. The mark MIRACLESUIT has been used by the opponent in the UK since at least as early as October 2004 in relation to a range of underwear, hosiery and swimwear...

8. As a result of the extensive use of the mark MIRACLESUIT, the opponent has acquired a reputation amongst UK consumers for a range of underwear, hosiery and swimwear which is sold throughout the UK in highly regarded retail outlets both online and in stores.

9. Consumers are likely to associate the MIRACLE BABY mark with the opponent’s well-established range of underwear, hosiery and swimwear and thus the applicant would enjoy an advantage in the marketplace which is unfair.

10. The opponent has invested a significant sum in marketing and promotional activities within the UK to build up a reputation in its MIRACLE

marks. Any connection made by consumers between the opponent's established product range and the applicant's products is likely to cause detriment to the reputation of the opponent's trade marks, particularly if the applicant's products are of lower quality than the opponent's products. As there is in fact no economic relationship between the applicant and the opponent, the opponent does not have any ability to exercise quality control over the applicant's product which could result in detriment to the opponent's mark.

11. Further, there is a risk of detriment to the distinctive character of the opponent's MIRACLE marks as a result of an association with the applicant's MIRACLE BABY mark. This has the potential to reduce the value of the trade mark and also to affect the purchasing decisions of consumers in the marketplace."

5. Finally, in relation to its objection based upon section 5(4)(a) of the Act, the opponent states:

"14. The opponent has acquired substantial trading goodwill in the mark MIRACLESUIT in relation to underwear and swimwear throughout the UK. As a result of this goodwill, any use by the applicant of the mark MIRACLE BABY in relation to the identical or similar goods would constitute a misrepresentation to the public which is likely to cause damage to the opponent's business."

6. The applicant filed a counterstatement which, in essence, consists of a denial of the grounds upon which the opposition is based; I shall return to the counterstatement in more detail later in this decision. However, as these are the only comments I have from the applicant, I note that having explained that it was founded in 2012 and is a "producer, designer and exporter of infants and kids products", it states:

"2. The application is for a figurative mark, which gives no claim solely for the words "MIRACLE BABY". The imagery element of the mark makes up over

50% of the mark, meaning it would be fair to assume this is the main element of the mark the average consumer would recognise, and this is in fact the distinctive element of the mark, not MIRACLE.

3. MIRACLESUIT is phonetically different to MIRACLE BABY.

4. We therefore dispute the opponents view that that the marks are either visual, phonetically, or conceptually similar when the mark is looked at in its entirety.

5. The designated goods of the two marks has little chance to lead to confusion. The opponent claims in paragraph 4 that the goods “are identical and highly similar to the goods covered by the opponent’s earlier marks”. By reviewing the opponent’s goods “*Clothing, namely swimwear, various items of underclothing and hosiery and shapewear, namely, girdles and other shape-controlling apparel; bodysuits, leotards and leggings.*”, there is only one similar good “*bathing suits*” which has previously been offered to removed by way of limitation.

6. By looking at the opponent’s goods, and their own website, it is clear the products are targeted at women, almost entirely focussed on swimwear. The applicant’s goods are primarily focussed for infants and kids, and apart from “*bathing suits*”, are for entirely different goods.

7. Therefore, the average consumer looking for women’s swimwear is highly unlikely to see products targeted at children and infants alongside the rest of the applicant’s logo and believe the goods are those from the opponent.

8. The applicant refers in paragraph 10 & 11 that the allowance of a mark which contains “MIRACLE” will be at the detriment of the distinctive element of their mark. Even a brief search on the UK trade mark search service shows a variety of marks both national and EU marks which contain the word “MIRACLE” all within class 25, several of which specifically are for goods and

services highly similar to those of the opponents mark. One of which is even the applicants EU mark 017891873 which received no previous opposition.

9. As mentioned in paragraph 2, the applicant's application is that of a figurative mark. The successful registration of the applicant's mark is that of a mark combined with imagery, giving no exclusive use of the words "MIRACLEBABY", meaning there would be no detriment to the distinctiveness of "MIRACLE"

10. It would be fair to assume therefore that the registration of a figurative mark, which regardless already has protection in the UK since 5th September 2018 through EU registration 017891873, is unlikely to alter the distinctiveness of "MIRACLE" especially when viewed alongside the numerous registrations containing this element.

11. The applicant notes the goodwill the opponent has built up over the years. However, the successful registration of the applicants' mark with products primarily targeted at children and infants will not lead to misrepresentation or any loss for the opponent, as the link between the two audiences is slim at best.

12. Previous successful applications from third parties that contain the word "MIRACLE" have been registered in class 25 with such goods as "*Bras (clothing).*", "*Apparel, women's clothing, sportswear and jeans.*", "*Clothing; footwear; hosiery; tights; stockings; socks.*", "*Lingerie; bras.*". The opponent has not opposed/or been successful in opposition against any of these third party trade marks registered within the UK and EU, where there would be a higher chance of the opponent potentially suffering a misrepresentation and thus damages than the applicants mark.

13. It is therefore asserted that with totally different target audiences and products, alongside the lack of action/success against previously registered marks containing MIRACLE with similar products, the potential claim of

passing off finalised in paragraph 15 is an egregious argument which has no basis.”

7. In these proceedings, the opponent is represented by PC and the applicant by BKIP. Only the opponent filed evidence. At the conclusion of the evidence rounds the parties were asked if they wished to be heard, failing which, a decision from the papers would be issued. While neither party requested a hearing, the opponent elected to file written submissions in lieu. I shall bear these written submissions in mind referring to them to the extent I consider it appropriate later in this decision.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

DECISION

9. The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act which read as follows:

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

(a)...

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

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

(3) A trade mark which is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a

reputation in the United Kingdom (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 the repute of the earlier trade mark.

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

(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,

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.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

10. In these proceedings the opponent is relying upon the three trade marks (two registrations) shown in paragraph 3, all of which qualify as earlier trade marks under the provisions of section 6 of the Act. Given the interplay between the date on which the opponent's trade marks were entered in the register and the application date of the trade mark being opposed, the earlier trade marks being relied upon are, in principle, subject to the proof of use provisions contained in section 6A of the Act. In its Notice of opposition, the opponent states that it has used its earlier trade marks in relation to all the goods upon which it is relying. However, as in its counterstatement the applicant chose not to ask the opponent to provide proof of use, the opponent

can rely upon the goods in these earlier trade marks without having to demonstrate that they have been used in relation to such goods.

The objection based upon section 5(2)(b) of the Act

Case law

11. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

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

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

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

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

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

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

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

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

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

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

The applicant's counterstatement

12. This raises a number of issues which I need to deal with. Throughout the counterstatement, the applicant comments on what it regards as the differences in the competing goods/average consumers including by reference to, inter alia, goods shown on the opponent's website, stating that its own goods are "primarily focused for infants and kids". However, while some of its goods are so limited, the vast majority are not. In addition, as the applicant has not asked the opponent to provide

proof of use, what I must do is compare the words as they appear in the competing specification on a notional and fair basis. The applicant also refers to other trade marks in class 25 which include the word “MIRACLE” including an earlier trade mark it owns. Insofar as the former is concerned, this does not assist the applicant for the reasons explained by the General Court (“GC”) in *Zero Industry Srl v OHIM*, Case T-400/06, where it 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).”

13. As to the latter, the applicant refers to European Union Trade Mark no. 17891873 i.e.



14. I note that this trade mark which was applied for on 26 April 2018 and entered in the register on 5 September 2018, stands registered for the same goods in class 25 applied for in these proceedings.

15. However, as a review of the database of the European Union Intellectual Property Office indicates that that trade mark is currently the subject of a cancellation action filed by the opponent in these proceedings, this too does not assist the applicant.

Comparison of goods

16. Bearing the above in mind, the comparison is as follows:

Opponent's goods	Applicant's goods in class 25
<p>(1)</p> <p>Class 25 - Underwear; hosiery; swimwear.</p> <p>&</p> <p>(2)</p> <p>Class 25 - Clothing, namely swimwear, various items of underclothing and hosiery and shapewear, namely, girdles and other shape-controlling apparel; bodysuits, leotards and leggings.</p>	<p>Class 25 - Babies' pants [underwear]; bath robes; bibs, not of paper; boots; aprons [clothing]; bathing suits; caps [headwear]; chasubles; clothing; footwear; shoes; gabardines [clothing]; hats; hosiery; ponchos; pyjamas; scarves; shawls; trousers; turbans; socks; sandals; sarongs; dressing gowns; girdles; skirts; skorts; valenki [felted boots]; neck scarves [mufflers]; mittens; layettes [clothing].</p>

17. The use of the word “namely” in the specification of trade mark no. 2 has the effect of limiting the specification which is, as a consequence, to be construed as:

“swimwear, girdles and other shape-controlling apparel; bodysuits, leotards and leggings.”

18. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

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

19. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49].

Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

My approach to the comparison of goods

23. Given the very limited stylisation present in the second trade mark in trade mark no. 1, it is not necessary for me to distinguish between which goods appear in which of the opponent's specifications. The applicant's goods are shown below in bold.

“hosiery” and “girdles”;

24. As the term “hosiery” and “girdles” appear in the opponent's specification, the competing goods are literally identical.

“Babies’ pants [underwear]”, “bathing suits” and “socks”;

25. As the terms “Underwear” and “hosiery” appear in the opponent's specification, the applicant's “babies pants [underwear]” and “socks” are to be regarded as identical on the *Meric* principle. As the term “swimwear” in the opponent's specification is simply an alternative way of describing “bathing suits” in the applicant's specification, the competing goods are to be regarded as identical.

“bibs, not of paper”;

26. Although the intended purpose and method of use of the above goods will differ from those of the opponent, the nature, users and trade channels are likely to overlap, with such goods being sold alongside, for example, underwear for babies. As the opponent's specification includes “underwear” at large, there is what I regard as a medium degree of similarity between the above named goods and those of the opponent I have identified.

“clothing”;

27. As this term is broad enough to include the opponent's named goods, once again, the competing goods are to be regarded as identical on the *Meric* principle.

“layettes [clothing]”;

28. I note that collinsdictionary.com defines the above as follows:

“layette – Noun - a complete set of articles, including clothing, bedclothes, and other accessories, for a newborn baby.”

29. Given the definition of this term mentioned above, it is broad enough to include, for example, goods which would fall within the terms “underwear”, “hosiery” and “swimwear” included in the opponent’s specification (which would, of course, include such goods for a newborn baby). Once again the competing goods are to be regarded as identical on the *Merit* principle.

“trousers”, “skirts” and “skorts”;

30. I note that collinsdictionary.com defines “skort” as follows:

“skort – Noun a pair of shorts with a front panel which gives the appearance of a skirt.”

31. Given the likely overlap in, at least, the users, nature, method of use and trade channels between the above named goods and, for example, “underwear”, “swimwear” and “leggings” in the opponent’s specification, such goods are, in my view, similar to a medium degree.

“boots”, “footwear”, “shoes”, “sandals” and “valenki [felted boots]”;

32. All the above are footwear (either at large or particular types). Although the nature, intended purpose and method of use of such goods and those of the opponent are likely to differ, given the likely overlap in, at least, the users and trade channels, it results in what I regard as a low degree of similarity between the competing goods.

"caps [headwear]", "hats" and "turbans";

33. All of the above are headwear of one sort or another. Once again the likely overlap in the users and trade channels, results in a low degree of similarity between the competing goods.

"sarongs";

34. In its written submissions, the opponent states:

"38...The Applicant's 'sarongs' are highly similar to the Opponent's 'swimsuits', as sarongs are typically worn at the beach, over swimsuits. As such, it is submitted that the goods are complimentary. These goods also have the same nature (items of clothing), purpose (covering the body and/or fashion purposes), method of use (for use on the body), sales outlets (being found in the same area of clothing shops) and are likely to be manufactured, marketed or provided by the same undertaking (i.e. clothing companies or, more specifically, swimwear companies)."

35. Although I do not agree that the competing goods are complementary (at least in the sense outlined in the case law), I agree for the other reasons the opponent states that the goods are highly similar to, at least, "swimwear" in the opponent's specification.

"bath robes", "pyjamas" and "dressing gowns";

36. In its written submissions, the opponent states:

"38...The Applicant's 'bath robes', 'dressing gowns' and 'pyjamas' are highly similar to the Opponent's 'items of underclothing' as they have the same nature (items of clothing), purpose (covering the body), method of use, sales outlets (being found in the same area of clothing stores, namely the underwear/bath wear/night wear section of shops) and are likely to be

manufactured, marketed or provided by the same undertaking (clothing companies).”

37. Once again, insofar as, at least, “underwear”, “girdles and other shape-controlling apparel” in the opponent’s specification are concerned, I agree with the opponent’s position albeit, in my view, it only results in a medium degree of similarity.

“gabardines [clothing]”, “ponchos”, “scarves”, “shawls”, “neck scarves” [mufflers]” and “mittens”;

38. The above are all general items of clothing or accessories. The likely overlap in the respective nature, users and trade channels between such goods and the opponent’s goods, results in a low degree of similarity between the above named goods and those of the opponent.

“aprons [clothing]”;

39. I note that collinsdictionary.com defines “apron” as:

“a piece of clothing that you put on over the front of your normal clothes and tie round your waist, especially when you are cooking, in order to prevent your clothes from getting dirty.”

40. Although there may be an overlap in the nature and users of the above named goods and those of the opponent, the intended purpose and method of use will differ, they are likely to be sold in different areas of, for example, a supermarket and there is no competitive or complementary relationship in play. Considered overall, there is no meaningful degree of similarity between the above named goods and those of the opponent.

“chasubles”;

41. I note that collinsdictionary.com defines the above term as shown below:

“**chasuble** – Noun – Christianity - a long sleeveless outer vestment worn by a priest when celebrating Mass.”

42. Even though the nature of the above goods and those of the opponent may be the same, given the very specific intended purpose of the applicant’s named goods and what is likely to be the very different trade channels by which they reach the average consumer, once again, there is, in my view, no meaningful degree of similarity between the applicant’s above named goods and those of the opponent. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

43. Proceeding on that basis, the opposition to “aprons [clothing]” and “chasubles” in the application fails and is dismissed accordingly.

The average consumer and the nature of the purchasing act

44. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods I have found to be identical/similar. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably

well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

45. In its submissions the opponent states:

“41. The Contested Goods and the Opponent’s protected goods can be generally classified as articles of clothing. These are everyday consumer items and, therefore, the relevant consumer in this case will be the public at large, who will pay a normal degree of attention when selecting the goods at issue.”

46. I agree the average consumer of the goods at issue is a member of the general public. As such a consumer will, for the most part, self-select such goods from the shelves of a bricks-and-mortar retail outlet or from the equivalent pages of a website or catalogue, visual considerations are likely to dominate the selection process. That said, as such goods may also be the subject of, for example, word-of-mouth recommendations or oral requests to sales assistants (both in person and by telephone), aural considerations must not be forgotten.

47. When selecting the goods at issue, the average consumer will be alive to factors such as cost, size, colour, material and compatibility with other items. As a consequence, I agree with the opponent that the average consumer can be expected to pay a normal (medium) degree of attention to their selection.


Comparison of trade marks

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

components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

49. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

Opponent’s trade marks	Applicant’s trade mark
1. MIRACLESUIT <i>Miraclesuit</i> (series of two) & 2. MIRACLESUIT	

Overall impression

The opponent’s trade marks

50. The opponent relies on the three trade marks shown above. The first trade mark in trade mark no. 1 and trade mark no. 2 consist of the words “MIRACLE” and SUIT” presented in upper case letters in a standard typeface with the two words conjoined.

Both words and their meanings will be very well-known to the average consumer. The second trade mark in trade mark no. 1 contains the same two conjoined words presented in title case in a slightly stylised script. However, the degree of stylisation is minimal and adds very little to the overall impression conveyed. Although the word “SUIT” will contribute to the overall impression conveyed, when used in relation to, for example, “swimwear” and “bodysuits” in its specifications, the word “SUIT” is likely to be regarded as descriptive in nature. That, however, may not be the case in relation to, for example, hosiery. Regardless, given the well-established use of the word “SUIT” in relation to clothing generally (with which I am satisfied the average consumer will be very familiar), even though the laudatory word “MIRACLE” appears first in the opponent’s trade marks, the overall impression they convey and their distinctiveness lies in the totalities created.

The applicant’s trade mark

51. The applicant’s trade mark consists of three components. The first, is a rectangular box in which the second and third components can be found. Acting as it does as a background, it has no distinctive character and will make very little contribution to the overall impression conveyed. The second component consists of a device which the opponent describes as “comprising three human figures”, adding that as the goods “are meant for human use”, it is of low distinctive character. Although stylised, I agree that the opponent’s reference to “three human figures” is a not unreasonable characterisation. However, given its size, positioning and the degree of stylisation/shading present, it is a moderately distinctive component and will make a not-insignificant contribution to the overall impression the applicant’s trade mark conveys. The third component consists of the words “miracle” and “baby” presented in black in a slightly stylised but unremarkable lower case script. The meaning of the word “baby” will be well-known to the average consumer. In its submissions, the opponent argues that the word “baby” is:

“9...“descriptive of the contested goods, as it will be understood as informing customers that the goods in question are directed at infants.”

52. When considered in relation to goods for babies that is a reasonable submission. However, even when not for goods for babies and for the same reasons mentioned above in relation to the word “SUIT” in the opponent’s trade marks, I reach the same conclusion. As the word “miracle” qualifies the word “baby” and as the totality creates a unit (the meaning of which is likely to be known to many average consumers – see paragraph 56), neither word dominates the other. The unit created will make an important contribution to both the overall impression conveyed and the trade mark’s distinctiveness.

53. In approaching the comparison which follows, I will bear the above conclusions in mind and I shall simply refer to the opponent’s trade marks as “MIRACLESUIT”.

Visual similarity

54. The opponent’s trade marks consist of eleven letters, the first seven letters being formed by the word “MIRACLE”. The word “miracle” also appears as the first word in the third component of the applicant’s trade mark. The final four letters in each trade mark i.e. “SUIT” and “baby” are completely different. Finally, the (device) component in the applicant’s trade mark is alien to the opponent’s trade marks. Weighing the similarities and differences whilst keeping in mind that all the trade marks contains the word “MIRACLE”/“miracle”, results in what I consider to be between a low and medium degree of visual similarity.

Aural similarity

55. As the words in all the earlier trade marks will be very well-known to the average consumer, how they will be pronounced is easily predictable. In addition, it is well-established that when a trade mark consists of a combination of words and figurative components, it is by the word component that it is most likely to be referred to. Proceeding on that basis, the competing trade marks will be pronounced as four and five syllable combinations respectively i.e. “MIR-A-CLE-SUIT” and “mir-a-cle-ba-by”. The fact that the first three syllables are identical in all of the trade marks results in a medium degree of aural similarity between them.

Conceptual similarity

56. In its submissions, the opponent states:

“29. When considered as a whole, the Contested Mark would be understood as clothing directed at infants having certain ‘miraculous’ characteristics, while the Opponent’s Earlier Marks would be understood as alluding to clothing comprising suits also having certain ‘miraculous’ characteristics. As such, the respective marks are conceptually similar to a high degree.”

57. The opponent does not, I note, mention the device component in the applicant’s trade mark. However, as this depicts two large images (which I think the average consumer is likely to construe as parental figures) between which appears a smaller image (which I think the average consumer is likely to construe as representing a baby), to the extent it contains what will be understood as the device of a baby, the second component reinforces the conceptual message conveyed by the word “baby” in the third component. I agree that the opponent’s trade marks are most likely to convey the concept the opponent suggests. However, the words “miracle baby” in the applicant’s trade mark are, in my view, likely to convey the concept of a baby that has been born or survived against the odds. Although the competing trade marks share the laudatory concept of something that is miraculous, when considered as totalities, they are conceptually different.

Distinctive character of the earlier trade mark

58. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings -

Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

Inherent distinctive character

59. In its submissions, the opponent states:

“43. It is submitted that the Opponent’s Earlier Marks are at least of normal inherent distinctive character, as they are not descriptive or allusive in relation to the goods covered by the registrations.”

60. In its submissions filed in relation to conceptual similarity, the opponents states that its trade marks will be understood as:

“29...alluding to clothing comprising suits also having certain ‘miraculous’ characteristics..”.

61. That submission is not, in my view, consistent with the opponent’s submission to the effect that its earlier trade marks are “not descriptive or allusive in relation to the goods covered by the registrations.” Given the laudatory nature of the word “MIRACLE” and as the addition of the descriptive/non-distinctive word “SUIT” does little or nothing to improve the position, absent use, the opponent’s earlier trade marks are possessed of a low degree of distinctive character.

Enhanced distinctiveness

62. That, of course, it not the end of the matter as the opponent has also filed evidence. This consists of a witness statement, dated 30 December 2020, from Mark Waldman, the opponent’s President, a position he has held since 1992.

63. Mr Waldman states that the opponent has used its MIRACLESUIT trade mark in the UK since 2004 “for a range of shapewear, including underwear and swimwear.” He explains that in the UK, MIRACLESUIT products are sold in various high street retailers as well as online, adding that its primary UK distributor for MIRACLESUIT

products is Patricia Eve Ltd. Mr Waldman provides eleven exhibits in support of his claim that:

“7..the MIRACLESUIT brand has become widely recognised in the industry and among consumers...”

64. The opponent’s evidence has not been challenged by the applicant and, in its counterstatement, it “notes the goodwill the opponent has built up over the years”. Although I do not intend to summarise the opponent’s evidence here in any great detail, for the avoidance of doubt, I have read it and will keep its contents in mind when reaching a conclusion. The key points emerging from this evidence are, in my view, as follows:

- in an article from www.globalintimatewear.com dated 27 April 2011 headed “Miraclesuit swimwear sales up by 49 percent”...“year on year in the UK”, the director of the opponent’s “primary UK distributor” (i.e. Patricia Eve Ltd), Mike Eve, stated: ‘The current demand for Miraclesuit swimwear is truly overwhelming. We have worked very hard this past year on raising the brand’s profile in the UK, investing in PR and advertising campaigns...’;
- pages from next.co.uk, patricia-eve.co.uk, johnlewis.com, figleaves.com and Simply Beach are provided which either bear printing dates of 12 March 2020 (i.e. after the material date) or are undated and which show MIRACLESUIT being used, primarily, on shapewear i.e. swimwear and underwear for women. All of the prices shown are in sterling;
- surveys conducted by Underlines magazine (a trade publication) in 2009/10 and 2010/11 indicate that MIRACLESUIT is the UK’s “favourite shape and swimwear brand” and, in September 2015, the same publication further indicated that MIRACLESUIT “remains in the lead as UK’s Fav Shapewear Brand”;

- in the period 2010-2019, sales by the opponent's licensee to its primary UK distributor of MIRACLESUIT products amounted to some £5.6m. I note the goods are further marked up by both the distributor and retailer;
- MIRACLESUIT branded products have featured in, inter alia, the UK local and national press. A very wide range of articles from as early as 2010 and going to beyond the relevant date are provided and include, for example, extracts from *Good Housekeeping* magazine, *Daily Telegraph*, *Daily Mail*, *Evening Standard*, *Mirror Online*, *Woman's Weekly* and the *Independent*. All of the articles refer to the MIRACLESUIT trade mark primarily in the context of shapewear i.e. swimwear and underwear for women;
- MIRACLESUIT branded products have also been commented upon by "independent bloggers and social commentators". All of the articles provided mention MIRACLESUIT in the context of shapewear i.e. swimwear and underwear for women, date from prior to the date of the application for registration and a number clearly originate in the UK;
- MIRACLESUIT briefs were featured in an episode of the ITV television show "This Morning" which aired on 4 June 2019;
- between 2010 and 2014 and in 2016 and 2017, the MIRACLESUIT brand was promoted at the MODA fashion trade exhibition held in Birmingham, at The London Swimwear Show (from 2013-2018), at Pure London (2013) and at INDX Intimate Apparel (2017-2019);
- in 2015, MIRACLESUIT was shortlisted by the UK Lingerie Awards in the "Shapewear Brand of the Year" category;
- between 2013 and 2018 MIRACLESUIT was mentioned in a range of "survey reports" conducted with those in the retail trade. The reports from, for example, inter alia, "Beachwear Report" show that MIRACLESUIT branded swimwear or shapewear for women consistently appears in the top five most popular brands in the UK and Ireland with the reports including the following comments: "a consistent bestseller for British and Irish consumers", "holds

the top spot for shaping swimwear in the UK/Ireland”, “the most popular brand in the UK and Ireland for shaping swimwear”, “the number one choice’ under the sub heading Brand Values in the UK/Ireland section”, “in terms of shapewear, MIRACLESUIT still leads the way” and “for over a decade, this American brand retains its number one slot in the UK.”

65. Mr Waldman states:

“20. The above materials show that the MIRACLESUIT trade mark has generated substantial goodwill and reputation among a significant portion of the relevant UK public, namely consumers of shaping underwear and swimwear.”

Assessment of the opponent’s evidence

66. As the opponent’s President since 1992, Mr Waldman is well-placed to give evidence on its behalf. In his unchallenged evidence, he states that the opponent has used its MIRACLESUIT trade mark in the UK since 2004 for “a range of shapewear, including underwear and swimwear.” The opponent’s evidence, is, however, far from perfect. For example, no evidence has been provided of the size of the market concerned or the market share the opponent enjoys nor have any details been provided of the amount it has invested in promoting the trade mark. However, when considered as a totality, it would, I think, be unrealistic for me not to conclude that, in particular, the length of use, the not-insignificant turnover figures achieved, the degree of attention the opponent’s trade mark has garnered in, inter alia, the national press and in trade related publications (the latter of which report on the success of the MIRACLESUIT brand) and the number of exhibitions the opponent has attended to promote its MIRACLESUIT brand to the trade is, by the material date in these proceedings, likely to have built upon the trade mark’s inherent distinctive character, resulting in a trade mark possessing a fairly high degree of enhanced distinctiveness for shapewear i.e. swimwear and underwear for women.

Likelihood of confusion

67. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

68. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

69. Earlier in this decision I concluded that:

- where not identical (either literally or on the *Meric* principle), the applicant's remaining goods are similar to the opponent's goods to at least a low degree;
- the average consumer of the goods at issue is a member of the general public who, whilst not ignoring aural considerations, will select such goods by predominantly visual means whilst paying a medium degree of attention during that process;
- the competing trade marks are visually similar to between a low and medium degree, aurally similar to a medium degree and, when considered as totalities, conceptually different;

- absent use, the earlier trade marks are possessed of a low degree of distinctive character;
- given the use that has been made since 2004 in relation to shapewear i.e. swimwear and underwear for women, the earlier trade mark enjoys a fairly high degree of enhanced distinctiveness in relation to such goods.

70. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

71. In *Nokia Oyj v OHIM*, Case T-460/07, the GC stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

72. Having already concluded that it is the visual aspect of the competing trade marks that it is the most important for the purposes of comparison (and having assessed the competing trade marks in this respect as similar to between a low and medium degree), even in relation to those goods which I have found to be identical, in particular, the visual and conceptual differences between the competing trade marks is, in my view, simply too great to go unnoticed by the average consumer. In short, there is no likelihood of direct confusion. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

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

74. Considered absent use, given what I regard as the laudatory nature of the word “MIRACLE”/“miracle” and the descriptive nature of the words “SUIT” and “baby”, I am not persuaded that either the sharing of the word “MIRACLE” or the totalities that are created when that word is combined with the words “SUIT” and “baby”, is sufficient for the average consumer to come to the conclusion posited by Mr Purvis above. Much more likely, in my view, is that the average consumer would assume that goods sold under the competing trade marks were from unrelated undertakings and the word “MIRACLE” was being used to extol the virtue of the parties’ respective goods.

75. I must, of course, also consider the matter on the basis of the use the opponent has made of its earlier trade marks in relation to shapewear i.e. swimwear and underwear for women. However, for the reasons mentioned in paragraphs 72 and 74, I remain unpersuaded that even when used in relation to goods which are identical to those upon which the opponent’s trade mark enjoys an enhanced

distinctive character, the average consumer is likely to reach the conclusion Mr Purvis suggests. As a consequence, the opposition to the goods in class 25 fails.

Conclusion under section 5(2)(b) of the Act

76. The opposition has failed in relation to all the goods in class 25 and, subject to any successful appeal, the application in class 25 will proceed to registration.

The objection based upon section 5(3) of the Act

77. 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*. 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*.

(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*).

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

“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.”

79. In Case C-408/01, *Adidas-Salomon*, the CJEU held:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

80. On the basis of the evidence mentioned earlier, I am satisfied that by the material date in these proceedings the use the opponent had made of its “MIRACLESUIT” trade mark in the UK in relation to shapewear i.e. swimwear and underwear for women was sufficient for it to have achieved the necessary qualifying reputation in the UK to satisfy the test outlined in *General Motors*. Having reached that conclusion, I must now go on to consider whether having taken account of all relevant factors, the public will make the required mental ‘link’ between the competing trade marks.

81. In determining whether the public will make the required mental ‘link’, the following factors in *Intel* are to be considered: (i) the degree of similarity between the conflicting trade marks, (ii) the nature of the goods for which the conflicting trade 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, (iii) the strength of the earlier trade mark’s reputation, (iv) the degree of the earlier trade mark’s distinctive character, whether inherent or acquired through use, and (v) whether there is a likelihood of confusion.

82. I have assessed many of the above factors earlier under section 5(2)(b) of the Act, concluding that even in relation to identical goods there is no likelihood of confusion. Notwithstanding the fairly high degree of enhanced distinctiveness/strong reputation the MIRACLESUIT trade mark enjoys in relation shapewear i.e. swimwear and underwear for women, for the same reasons mentioned earlier, even when used on identical goods, I do not think that upon seeing the applicant’s trade mark the opponent’s trade mark will be called to mind i.e. no link will be formed. Without the necessary link there can be none of the adverse consequences for the opponent

contemplated by this section of the Act and the opposition based upon section 5(3) of the Act fails accordingly.

Conclusion under Section 5(3) of the Act

83. The opposition fails in relation to all the goods in class 25 and, subject to any successful appeal, the application in class 25 will proceed to registration.

The objection based upon section 5(4)(a) of the Act

84. 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).”

85. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act. Having reviewed the relevant case law, he stated:

“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.’ ”

86. As the applicant has filed no evidence of any use it may have made of its trade mark, the relevant date is the date of the filing of the application i.e. 19 February 2020.

87. I can deal with this objection fairly briefly. As I mentioned earlier, in its counterstatement, the applicant “notes the goodwill the opponent has built up over the years”. I agree and accept that by the material date in these proceedings the business the opponent had conducted in the UK under its “MIRACLESUIT” trade mark in relation to shapewear i.e. swimwear and underwear for women is more than sufficient for it to have generated the necessary goodwill for it to rely upon the law of passing-off. However, having already found no confusion (under section 5(2)(b)) and no link (under section 5(3)), I also find there will be no misrepresentation. Without a misrepresentation there can be no damage and, as a consequence, the opposition to the goods in class 25 fails accordingly.

Conclusion under section 5(4)(a) of the Act

88. The opposition based upon section 5(4)(a) of the Act fails in relation to all the goods in class 25 and, subject to any successful appeal, the application in class 25 will proceed to registration

Overall conclusion

89. The goods and services in classes 5, 10, 18, 20, 21, 22, 24, 28 & 35 are no longer being opposed and will, in due course, proceed to registration regardless. Insofar as class 25 is concerned, the opposition has failed under all grounds and, subject to any successful appeal, the application in class 25 will also proceed to registration.

Costs

90. As the applicant has been successful it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Applying the above guidance, but reminding myself that following the filing of its counterstatement the applicant played no part in these proceedings, I award costs to the applicant in the amount of £300 in respect of its reviewing of the Notice of opposition and the filing of a counterstatement.

91. I order A&H Sportswear Co., Inc. to pay to Yi Chang Lanqier Garment Co., Ltd. the sum of **£300**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of August 2021



C J BOWEN
For the Registrar

Class 5

Aseptic cotton; bandages for dressings; vitamin preparations; cotton for medical purposes; dressings, medical; vulnerary sponges; salts for medical purposes; surgical dressings; lacteal flour for babies; gauze for dressings; absorbent cotton; malted milk beverages for medical purposes; sanitary towels; sanitary tampons; sterilising preparations; food for babies; panty liners [sanitary]; napkins for incontinents; dietary fibre; pants, absorbent, for incontinents; breast-nursing pads; nutritional supplements; babies' diapers [napkins]; babies' napkin-pants [diaper-pants]; albumin dietary supplements; diapers for pets; cotton swabs for medical purposes; infant formula; powdered milk for babies; pharmaceuticals.

Class 10

Abdominal belts; abdominal corsets; bandages, elastic; bandages for joints, anatomical; childbirth mattresses; compression garments; clothing especially for operating rooms; commode chairs; cushions for medical purposes; dummies [teats] for babies; teats; feeding bottles; feeding bottle teats; incubators for babies; knee bandages, orthopaedic; surgical sponges; suspensory bandages; soporific pillows for insomnia; abdominal pads; slings [supporting bandages]; nursing appliances; ophthalmometers; sterile sheets, surgical; stockings for varices; suture materials; syringes for injections; scalpels; maternity belts; inhalers; insufflators; breast pumps; Breast milk storage bottles.

Class 18

Bags [envelopes, pouches] of leather, for packaging; handbags; kid; net bags for shopping; pouch baby carriers; purses; sling bags for carrying infants; slings for carrying infants; valises; umbrellas; walking stick seats; traces [harness]; shopping bags; randsels [Japanese school satchels]; credit card cases [wallets]; bags; bags for sports; saddlery; suitcases; wheeled shopping bags; whips; umbrella or parasol ribs; travelling trunks; travelling bags; pocket wallets; imitation leather; key cases; muzzles; haversacks; collars for animals; diaper bags .

Class 20

Air pillows, not for medical purposes; air cushions, not for medical purposes; baby changing mats; bamboo; barrels, not of metal; casks, not of metal; beds*; bedding, except linen; bolsters; chests for toys; costume stands; bassinets; cradles; crates; cupboards; cushions; divans; furniture; head-rests [furniture]; high chairs for babies; infant walkers; inflatable furniture; mats for infant playpens; mattresses; mats, removable, for sinks; pillows; playpens for babies; sleeping pads; sleeping mats; tables; stuffed animals; clips of plastic for hanging toys.

Class 21

Baby baths, portable; chopsticks; coasters, not of paper or textile; combs; cups; mugs; lazy susans; pots; saucers; sponges for household purposes; toothbrushes;

urns; pie servers; tart scoops; mess-tins; make-up sponges; kettles, non-electric; isothermic bags; jugs; glue-pots; food steamers, non-electric; flasks*;bottles; epergnes; dishes; demijohns; carboys; cruets; cosmetic utensils; bowls [basins]; bird baths; buckets.

Class 22

Awnings of textile; sacks for the transport and storage of materials in bulk; canvas for sails; down [feathers]; eiderdown; hammocks; liber; linters;nets*; packing [cushioning, stuffing] materials, not of rubber, plastics, paper or cardboard; padding materials, not of rubber, plastics, paper or cardboard; ropes; tarpaulins; tents; tow; textile fibers [fibres]; whipcord; wood wool; sails; raffia; body bags; brattice cloth; raw cotton; hemp; feathers for bedding; bags [envelopes, pouches] of textile, for packaging; ropes, not of metal; animal hair; sash cords; mail bags.

Class 24

Bath linen, except clothing; brocades; cloth; diaper changing cloths for babies; cotton fabrics; diapered linen; fabric; felt; face towels of textile; gauze [cloth]; fustian; dimity; handkerchiefs of textile; pillow shams; pillowcases; towels of textile; bed linen; bed blankets; coasters of textile; cloths for removing make-up; cheviots [cloth]; crepon; haircloth [sackcloth]; mosquito nets; mattress covers; marabouts [cloth]; moleskin [fabric]; tulle; covers for cushions; zephyr [cloth];sleeping bags.

Class 25

Babies' pants [underwear]; bath robes; bibs, not of paper; boots; aprons [clothing]; bathing suits; caps [headwear]; chasubles; clothing; footwear; shoes; gabardines [clothing]; hats; hosiery; ponchos; pyjamas; scarves; shawls; trousers; turbans; socks; sandals; sarongs; dressing gowns; girdles; skirts; skorts; valenki [felted boots]; neck scarves [mufflers]; mittens; layettes [clothing] .

Class 28

Building blocks [toys];board games; caps for pistols [toys]; chessboards; fishing tackle; knee guards [sports articles]; flying discs [toys]; games; jigsaw puzzles; kites; masks [playthings]; matryoshka dolls; mobiles [toys; percussion caps [toys]; piñatas; plush toys; stuffed toys; puppets; quoits; scooters [toys]; soap bubbles [toys]; toys; toy vehicles; toys for pets; trampolines; golf gloves; foosball tables; bob-sleighs; body-building apparatus; bodyboards; balls for games.

Class 35

Advertising/publicity on-line advertising on a computer network; business management consultancy; commercial administration of the licensing of the goods and services of others; sales promotion for others; procurement services for others [purchasing goods and services for other businesses] marketing; telemarketing services; provision of an on-line marketplace for buyers and sellers of goods and services; advertising/publicity demonstration of goods; modelling for advertising or sales promotion; presentation of goods on communication media, for retail purposes;

market studies; business appraisals; business management assistance; business organization consultancy; import-export agency services; shop window dressing.