

O/758/21

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3501010
BY KOREA GINSENG CORP.
TO REGISTER THE TRADE MARK**

CKJ

IN CLASS 3

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 421398
BY CALVIN KLEIN TRADEMARK TRUST**

BACKGROUND AND PLEADINGS

1. On 16 June 2020, Korea Ginseng Corp. (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 10 July 2020 and registration is sought for the following goods:

Class 3: *Flavorings for beverages (essential oils); antistatic preparations for household purposes; laundry starch; massage oil; cosmetic preparations for baths; body creams; baby oils; cosmetic preparations for skin care; hand lotions; perfumes; lotions for cosmetic purposes; mask pack for cosmetic purposes; oils for cosmetic purposes; cosmetics; air fragrancing preparations; soaps for household use; soaps (not for personal use); shampoos; mouth washes (not for medical purposes); deodorants for pets; shampoos for pets; cosmetics for animals; toiletries; essential oils.*

2. On 8 September 2020, Calvin Klein Trademark Trust (“the opponent”) opposed the application on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. In the original pleadings the opponent initially relied upon six trade marks, as set out in the annex hereto. However, it subsequently confirmed¹ that it no longer relies on the goods in class 18 and on the ‘EU ‘CK’ monogram mark (which is identical to the UK ‘CK’ monogram mark). For the purposes of the opposition therefore the opponent now relies on the following five trade marks² under Sections 5(2)(b) and 5(3) of the Act:

¹ Hearing of 22 July 2021 and skeleton arguments of 20 July 2021

² By virtue of the transitional provisions set out in paragraph 7(1) of Schedule 5 to the Trade Marks (Amendment etc.) (EU Exit) Regulations made pursuant to the European Union (Withdrawal) Act 2018, earlier EU trade marks filed before 31 December 2020 continue to constitute relevant earlier trade marks for the purposes of Sections 5 and 6 of the Trade Marks Act 1994 (“the Act”). Therefore, the opponent can continue to rely on the earlier EU marks notwithstanding the UK’s exit from the EU.

UK00002061305 (“the ‘CK BE’ mark”)

CK BE
CK be
CKBE
CKbe
CKB
CKb



Number of marks in series: 7

Filing date: 15 March 1996; Date of entry in the register: 24 January 1997

Class 3: *Non-medicated toilet and bath preparations, namely eau de toilette; soap; talc; skin moisturizer, body lotions and creams, bath oil; massage oil; personal deodorants and antiperspirants; hair care preparations; suntan preparations, all for men and women; potpourri, fragrant sachets; fine air fragrances; all goods in Class 3.*

UK00002130839 (“the ‘CK ONE’ mark”)



CK ONE	ck-one
CK one	ck-one
cK one	CK1
ck one	cK1
CK-ONE	ck1
CK-one	CK-1
cK-one	ck-1

Number of marks in series: 15

Filing date: 25 April 1997; Date of entry in the register: 05 June 1998

Class 3: *Non-medicated toilet and bath preparations, eau de toilette, soap, talc, skin moisturizer, body lotions and creams, bath oil, body wash; all for personal use; massage oil; personal deodorants and anti-perspirants; hair care preparations; suncare preparations, all for men and women; potpourri; fragrant sachets; room fragrances; but not including colophony soaps.*

UK00002150421 ("the 'CK' monogram mark")



Filing date: 08 November 1997; Date of entry in register: 19 February 1999

Class 25: *Clothing, footwear and headgear; women's, men's, boy's and girl's wearing apparel; jump suits, shirts, blouses, jackets, bathing suits, pants, shorts, warm-up suits, capes, walking shorts, jeans, suits, dinner jackets, raincoats, ties, stockings/tights, hats/caps, outer coats, sweaters, skirts, belts, coats, fur-trimmed coats, furs, vests, T-shirts, tennis and golf dresses, shorts, beach and swimming cover-ups, rainwear/raincoats, ponchos, tank tops, footwear; shoes, active sport shoes, sneakers, boots, slippers; blazers, pants, shirts, socks, gloves, dresses, shearling coats and jackets, scarves/shawls, sports jackets; men's and boy's underwear; sleepwear, loungewear including but not limited to briefs, boxers, athletic underwear, sport knits, T-shirts, tank tops, undershirts, basic underwear and robes, knitted and woven sleepwear, sleep shirts, pyjama tops, pyjama bottoms, breakfast jackets, smoking jackets, bed jackets, cover-ups, knitted and woven loungewear, lounging pants and tops, lounge jackets; women's and girl's underwear; intimate apparel and sleepwear, loungewear, bodywear, foundations, bras, girdles, garter belts, all-in-ones, corselettes, body stockings, control briefs, control hipsters, contarter bikinis, bra slips, bra top camisoles, waist cinchers, bustiers, merry widows, camisettes, leotards and unitards; daywear including but not limited to culottes, bikinis, hipsters, briefs, slips, blouse slips, camisole slips, chemise slips, culotte slips, evening slips, maternity slips, panty slips, princess slips, shadow panel slips, strapless slips, suit slips, tailored slips, half slips, petti-slips, bra slips, chemises, teddies, camisoles, bra top camisoles, bralettes, tap pants and petti-pants, daywear, loungewear, sleepwear and bodywear including but not limited to night gowns, toga nightgowns, night shirts, pyjamas, shortie pyjamas, baby-doll pyjamas, T-shirt pyjamas, french maid sleepers, harem pyjamas, hostess culottes, lounging pyjamas, rompers, sleep shorts, peignoirs, bed jackets, caftans, jumpsuits, teddies, bathrobes, dressing gowns, kimonos, housecoats, beach togas, beach*

wrap-ups, breakfast, brunch coats, cocoons, dusters, hostess robes, kabuki robes, lounging robes, monk's robes, bra tops, crop tops and leggings.

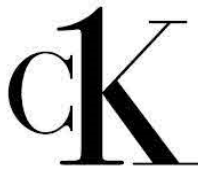
EU008864126 (“the ‘CKU’ mark”)

CKU

Filing date: 05 February 2010; Date of entry in the register: 05 July 2010

Class 25: *Underwear, sleepwear, t-shirts, tank tops, pajamas, sleep shirts, robes, briefs, boxers, athletic underwear, sport knit underwear, and loungewear, namely, lounging pants, shirts and tops, and lounge jackets; women's intimate apparel, sleep-wear, loungewear, bodywear and daywear, namely, underwear, bras, control briefs, control hipsters, control bikinis, camisoles, camisettes, bikinis, hipsters, briefs, slips, chemises, teddies, camisoles, bralettes, and petti-pants, nightgowns, night shirts, pajamas, sleep shorts, and bathrobes.*

UK00003374267 (“the UK ‘CK’ monogram mark”)



Filing date: 11 February 2019; Date of entry in the register: 03 May 2019

Class 3: *Soaps; detergents; bleaching preparations, cleaning preparations; perfumery, toilet water, aftershave, cologne; essential oils; aromatherapy products, not for medical use; massage preparations, not for medical use; deodorants and antiperspirants; preparations for the care of the scalp and hair; shampoos and conditioners; hair colourants; hair styling products; toothpaste; mouthwash, not for medical use; preparations for the care of the mouth and teeth; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool, cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks, facial packs.*

4. Under Section 5(2)(b), the opponent claims that the applicant's mark is similar to the earlier marks and that the goods are identical or similar, resulting in a likelihood of confusion.

5. Under Section 5(3) of the Act, the opponent claims to have established an extensive reputation in its marks in the UK since at least the 1990s and to be known for providing extremely high standards of products under the marks. According to the opponent, use of the applicant's mark would, without due cause, 1) tarnish or otherwise cause detriment to its reputation, particularly if consumers purchase the applicant's goods in the mistaken belief that they are related to (or provided by) the opponent and/or 2) reduce the uniqueness and distinctiveness of the earlier marks.

6. Given their dates of filing, the opponent's marks qualify as earlier marks in accordance with Section 6 of the Act. As the UK 'CK' monogram mark had not been registered for five years when the application was filed, the opponent may rely upon all of the goods identified without showing that the mark has been used. However, as the other marks had completed their registration procedure more than five years before the date the application was filed, they are, as a consequence, subject to the proof of use provisions contained in Section 6A of the Act.

7. Under Section 5(4)(a), the proceedings proceeded on the applicant's understanding that the opponent relied on one single earlier unregistered mark, namely the 'CK' mark. The opponent claimed to have used this mark throughout the UK since the mid-1990s in relation to clothing, perfumes, toiletries, and cosmetics. However, at the hearing it was shown that the Form TM7 that was filed via an email on 7 September 2020 referred to two additional unregistered marks, namely the marks 'CK ONE' and 'CKJ'. I accepted that there had been a mistake when the documents were uploaded on to the UKIPO system and served on the applicant. Further, since the opponent confirmed that it did not intend to file additional evidence (because, from their perspective, it was an error, not an amendment of pleadings), the parties indicated that they were content to proceed. I also gave directions for further written submissions to be filed by the parties in relation to the two additional unregistered marks which were relied upon by the opponent.

8. The applicant filed a counterstatement conceding that some of the parties' goods in class 3 are identical or similar but otherwise denying the claims. It also put the opponent to proof of use.

9. Both parties filed evidence during the evidence rounds. The applicant also filed written submissions. I shall refer to the evidence and submissions to the extent I consider necessary.

10. The applicant is represented by Wilson Gunn. The opponent is represented by Forresters IP LLP. A hearing took place on 22 July 2021 via videoconference. The applicant was represented by Mr Andrew Marsden of Wilson Gunn. The opponent was represented by Ms Kate Cruse of Foresters IP LLP.

11. 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 Trade Marks 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.

The opponent's evidence

12. The opponent's evidence consists of four witness statements. Deirdre Miles-Graeter gave two witness statements dated 25 January 2021 and 8 February 2021 respectively. The other witness statements are by Mark Bhandal and Kathryn Cruse.

Deirdre Miles-Graeter's witness statements

13. Deirdre Miles-Graeter is the vice-president at the opponent's company. The company is responsible for overseeing and managing all trade mark matters for Calvin Klein Inc. which is the beneficial owners of the marks owned by the opponent. In her first witness statement, Ms Miles-Graeter talks about Calvin Klein trade marks having achieved tremendous fame and recognition and Calvin Klein products being among the most popular of their kind in the world.

14. According to Ms Miles-Graeter, Coty Inc. acquired the licensing agreement for Calvin Klein's fragrance line from Unilever in 2005 and continues to sell Calvin Klein perfumes around the world on behalf of Calvin Klein and under the term of a license agreement. Coty made the following net sale in the EU between 2017 and 2020:³ USD209,450,000 (2017), USD234,550,000 (2018), USD273,050,000(2019) and USD215,950,000 (2020). In her second witness statement, Ms Miles-Graeter explains that these figures relate to Calvin Klein perfumes sales in the EU, including sales made under the brands 'CK ONE' and 'CK BE', and that 16% of those sales are UK sales.

15. Ms Miles-Graeter also confirms that use of Calvin Klein trade marks as identified and shown in the evidence is use by the opponent or with its consent.

Mark Bhandal's witness statement

16. Mark Bhandal is a senior trade mark attorney with Forresters IP LLP, the opponent's representative in these proceedings. Mr Bhandal says that Calvin Klein is a well-known fashion designer and that his brand is known worldwide. The main points emerging from Mr Bhandal's evidence are as follows:

- Calvin Klein is well-known designer of fashion items, including clothing, luxury perfumes, footwear, eyewear, watches and jewellery. The company, founded in 1968 by Calvin Klein and his business partner, faced major financial difficulties in the 1990s, and was eventually sold to Phillips-Van Heusen Corporation in 2003;
- The Calvin Klein brand is said to include 'CK Calvin Klein', 'Calvin Klein', 'Calvin Klein Jeans', 'Calvin Klein Underwear' and 'Calvin Klein Performance';
- Some of the evidence⁴ refers to global retail sales for Calvin Klein exceeding USD9 billion in 2016, however, Mr Bhandal states that the worldwide total revenue for Calvin Klein sales was £2,543 million in 2017, £2,740 million in 2018 and £2,694 million in 2019. 27% of the 2019 sales came from the EU and the EU total revenue was approximately £728 million in 2019;

³ The figures are presented in US dollars

⁴ Annex 2

- Mr Bhandal conducted a search for “Calvin Klein perfume”. The results include two of the trade marks relied upon in these proceedings namely ‘CK ONE’ and ‘CK BE’, as well as other brand names, including ‘Woman’, ‘Euphoria’, ‘Eternity’, ‘Escape’, ‘Contradiction’, ‘Beauty’, ‘Truth’, ‘CKIN2U’, ‘Obsession’ and ‘CK Free’. ‘CK ONE’ was launched in 1994 and its main characteristic is that it is gender fluid. Images of packaging for ‘CKIN2U’, ‘CK FREE’, ‘CK ONE’ and ‘CK BE’ perfumes are provided which show that these trade marks are always used together with the name ‘Calvin Klein’;
- A Nelson report shows that Coty Prestige Ltd spent over USD10 million on advertising Calvin Klein fragrances between 2015 and 2020. The brands included in the report are ‘CK EVERYONE’, ‘CK IN2U’, ‘CK UNISEX’ and ‘CK2’;
- Calvin Klein adverts are iconic, controversial and globally recognised. Examples of historical advert campaigns are provided including an advert for Calvin Klein Jeans from 1980;
- Calvin Klein has a strong online presence. Examples of pages from Calvin Klein social media accounts and from its UK based website (www.calvinklein.co.uk) are provided. As well as selling goods online and in stores, Calvin Klein sells goods via authorised retailers in the UK including Selfridges, John Lewis, Debenhams, ASOS and Amazon;
- Mr Bhandal provides the results of online searches for ‘CKJ CALVIN’, ‘CKJ JEANS’, ‘CKU CALVIN’, ‘CKU UNDERWEAR’, ‘CK BE’ and ‘CK ONE’ and extracts from the UKIPO database showing two registrations for the mark ‘CKJ’ (stylised). The status of both registrations is “dead”;
- The evidence provided by Mr Bhandal in relation to goodwill is as follows:

Goodwill

50. I recall from own experiences that I owned a pair of jeans which had CKJ on the label which doubled as a belt hoop.
51. I would suggest that there is a vast amount of goodwill that is vested in the marks CK, the CK monogram logo, CK ONE, CK BE and was also in CKJ mark. Even though the CKJ marks have been abandoned in the UK, goodwill still resides in this sign.
52. On 20 January 2021, I conducted an Internet search for ‘CKJ images’ and discovered the below images which show use of the mark CKJ still continues, particularly on jean product labelling and branding.



Kathryn Cruse's witness statement

17. Ms Cruse is a partner and trade mark attorney with Forresters IP LLP, the opponent's representative in these proceedings. Ms Cruse's statement is a vehicle for introducing the results of Internet searches which show:

- 'CK ONE' and 'CK BE' perfumes available for sale from online retailers, including Debenhams, Boots, The Perfume Shop and price comparison websites;⁵
- Extracts from an advertising archive website showing historical examples of advertisements regarding 'CK ONE' and 'CK BE' perfumes;⁶
- Extracts from www.statista.com showing statistics for 'CK ONE'.⁷ The relevant paragraph is highlighted:

Perfume for women brands of Calvin Klein Great Britain 2013-2019, by number of users

Published by Statista Research Department, Sep 9, 2020



In 2019, Calvin Klein Eternity replaced Calvin Klein One as the company's most used perfume and eau de toilette for women brands in Great Britain. Ranked third and fourth were Calvin Klein Obsession and Calvin Klein Euphoria.

The applicant's evidence

18. The applicant's evidence consists of a witness statement by Andrew Marsden, who is a trade mark attorney with Wilson Gunn, the applicant's representative in these proceedings. Mr Marsden exhibits copies of three decisions concerning foreign parallel proceedings before the Chinese, Japanese and Turkish trade mark offices. The decisions concern three oppositions based on the mark 'CK' against three applications to register the mark 'CKJ' in classes 29, 30 and 31; in all three cases, the outcome is the same, namely the refusal of the opposition. Whilst this evidence is noted, these decisions are not binding upon me and their potential persuasive value is extremely limited (if they have any) because 1) the conflicts between the parties relate to different goods and 2) it is not clear whether the Chinese, Japanese and Turkish law reflects the provisions under the EU and UK law.

⁵ Annexes KC1-9

⁶ Annexes KC10-12

⁷ Annexes KC13-14

DECISION

Proof of use

19. The relevant statutory provisions are set out in Section 6A of the Act which reads:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the

form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

20. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm*

Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], [2014] ETMR, Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21].

But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

21. As one of the earlier marks that is subject to proof of use is a EUTM, I must consider the EU as the market in which the opponent is required to show genuine use: see *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11.

22. In assessing the opponent’s evidence, I also have regard to the following guidance. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

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

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision,

what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

23. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can

legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

24. The marks that are subject to proof of use are the ‘CK BE’, the ‘CK ONE’, the ‘CK’ monogram and the ‘CKU’ marks. The relevant period during which genuine use must be shown is the five years ending with the filing date of the contested mark, which is 16 June 2020. The relevant period is therefore 17 June 2015 to 16 June 2020. For the ‘CK BE’, the ‘CK ONE’ and the ‘CK’ monogram marks, the territory in which use must be shown is the UK; for the ‘CKU’ mark it is the EU.

25. In his submissions of 10 May 2021, the applicant stated:

“The opponent has submitted a significant amount of evidence. Whilst the evidence demonstrates a reputation, this is limited to perfumery products and clothing.”

26. At the hearing Mr Marsden conceded that Calvin Klein is a luxury and a well-known brand. However, this concession was given with the caveat that *“we cannot focus on general knowledge”* and that whilst the opponent admitted *“a fairly strong reputation”*, it was important to focus on the evidence filed. Although Mr Marsden reiterated that the evidence shows reputation for perfumes, he also appeared to backtrack somewhat upon the previous admission that the opponent has a reputation for clothing, by saying that, *“whilst there might be a reputation for clothing”* the evidence does not completely support this claim.⁸

27. At the hearing I asked Mr Marsden to clarify whether, given that he had accepted that Calvin Klein had a reputation, he also accepted an existing reputation for the marks pleaded. Mr Marsden confirmed that he accepted that ‘CK’ has a reputation and

⁸ Page 23 of Transcript

that all of the marks relied upon have a reputation with the exception of 'CKU'. As regard the marks 'CK ONE', 'CK BE' and 'CK',⁹ Mr Marsden further clarified that reputation was conceded in relation to perfumes, not clothing, and that the reputation of the mark 'CK ONE' was accepted in relation to the mark incorporating the word 'ONE', not the numeral 1, although he recognised that the concession "*might be a bit tricky*" given that it is a single registration.

28. Given that the opponent's case is that the earlier marks have acquired a reputation through use, and given that the factors I am required to look at when assessing whether a mark has acquired a reputation through use are the same as (or similar to) those which I must consider when assessing proof of use, I take Mr Marsden's concession about the reputation of the 'CK ONE' and 'CK BE' marks, in relation to perfumes, as implicitly conceding that these marks have also been genuinely used during the relevant period. It would seem to me rather odd to find that these marks have acquired a reputation through use at the relevant date in relation to perfumes, but have not been genuinely used in the five year period ending on the same date.

29. In relation to the 'CK' monogram and 'CKU' marks (which are relied upon only in relation to goods in class 25) the evidence, I have to say, does not do justice to the use the opponent might have made (if it has done so) of these marks in the clothing sector. First, leaving aside the absence of invoices, there is no indication of what the sale figures relating to clothing (let alone the various subcategories of clothing covered by the specifications) might have been during the relevant period, in the relevant territories. Second, even I were to accept that, being that Calvin Klein is a well-known fashion designer, a significant proportion of the global turnover figures were generated by the sale of clothing in the EU and the UK, most of the evidence relating to clothing¹⁰ show use of the marks 'Calvin Klein', 'CK Calvin Klein' or 'Calvin Klein Underwear'. Admittedly, the evidence contains a few examples of the 'CK' monogram mark being printed on items of clothing,¹¹ as well as a few references to the mark 'CKU' in the results of Google searches, however, such evidence is a wholly inadequate basis to

⁹ I assume the reference to the CK mark relates to the UK 'CK' monogram mark which is registered for goods in class 3 and is not subject to proof of use, the other CK monogram mark being relied upon only for goods in class 25.

¹⁰ Annex 2

¹¹ Annex 11

find (without a favourable assumption from my part – which I am not prepared to make - or any concession from the other side) that these marks have been genuinely used during the relevant period. The fact that Calvin Klein is a famous fashion designer does not mean that the opponent was exonerated from filing evidence to sustain its claims in relation to the ‘CK’ monogram and ‘CKU’ mark for goods in class 25.

Fair specification

30. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:¹²

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

31. As regard the extent of the use (conceded or otherwise proven), I agree with Mr Marsden that the evidence concerning the marks ‘CK ONE’ and ‘CK BE’ only show use for perfumes. Consequently, I find that a fair specification would be *perfumes* and *eau de toilette* for the ‘CK ONE’ mark (which covers *non-medicated toilet and bath preparations* and *eau de toilette*, perfumes being a subcategory of non-medicated toilet and bath preparations) and *eau de toilette* for the ‘CK BE’ mark (which covers *non-medicated toilet and bath preparations, namely eau de toilette*, eau de toilette being the only type of non-medicated toilet and bath preparations covered by the mark).

Section 5(2)(b)

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

¹² See also *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) (at [47]):

“A trade mark shall not be registered if because-

[...]

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

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

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

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods

34. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

35. 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.

36. 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 OHIM*, Case T-325/06, the General Court (“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”.

37. The law requires that goods also be considered identical where one party’s description of its goods encompasses the specific goods covered by the other party’s description (and vice versa).¹³

38. The goods to be compare are as follows:

Applicant’s goods	Opponent’s goods
<p>Class 3: <i>Flavorings for beverages (essential oils); antistatic preparations for household purposes; laundry starch; massage oil; cosmetic preparations for baths; body creams; baby oils; cosmetic preparations for skin care; hand lotions; perfumes; lotions for cosmetic purposes; mask pack for cosmetic purposes; oils for cosmetic purposes; cosmetics; air fragrancing preparations; soaps for household use; soaps (not for personal use); shampoos; mouth washes (not for medical purposes); deodorants for pets; shampoos for pets; cosmetics for animals; toiletries; essential oils.</i></p>	<p>The ‘CK ONE’ mark (after proof of use) Class 3: <i>Perfumes and eau de toilette</i></p>
	<p>The ‘CK BE’ mark (after proof of use) Class 3: <i>Eau de toilette</i></p>
	<p>The UK ‘CK’ monogram mark (not subject to proof of use) Class 3: <i>Soaps; detergents; bleaching preparations, cleaning preparations; perfumery, toilet water, aftershave, cologne; essential oils; aromatherapy products, not for medical use; massage preparations, not for medical use; deodorants and antiperspirants; preparations for the care of the scalp and hair; shampoos and conditioners; hair colourants; hair styling products; toothpaste; mouthwash, not for medical use; preparations for the care of the mouth and teeth; non-medicated toilet preparations; bath and shower</i></p>

¹³ See *Gérard Meric v OHIM*, Case T-33/05, GC.

	<pre> preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool, cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks, facial packs. </pre>
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The 'CK ONE' and 'CK BE' marks

39. Although Mr Marsden conceded that the class 3 goods are identical or at least similar, I understand his concession to refer only to the specifications as they are registered. I do not consider that Mr Marsden's concession applies to the restricted specification which reflects the use made of the marks. Taking first the comparison of the goods for which proof of use has been accepted, I make the following findings:

40. Flavorings for beverages (essential oils); antistatic preparations for household purposes; laundry starch; soaps for household use; soaps (not for personal use); air fragrancing preparations; deodorants for pets; shampoos for pets; cosmetics for animals. These goods are household goods, goods used in the production of beverages, or goods for pets, not personal beautification products. The nature, purposes, uses and methods of use are different, and the goods are neither competitive nor complementary. The goods are sold through different channels or, if sold in the same shops, they are unlikely to be found in close proximity to each other. These goods are dissimilar.

41. Cosmetic preparations for baths; body creams; cosmetic preparations for skin care; hand lotions; lotions for cosmetic purposes; mask pack for cosmetic purposes; cosmetics; toiletries. These goods are used in conjunction with the opponent's

perfumes and *eau de toilette* as part of a person's beauty regime. This creates some similarity in purpose, although I accept that they are not in competition and that the methods of use differ. However, they are likely to be sold in close proximity to each other and serve a clear complementary role as the average consumer is likely to believe that the respective goods are offered by the same or economically connected undertakings. I consider these goods to be similar to a medium to high degree.

42. Perfumes. These goods are self-evidently identical to the opponent's *perfumes and eau de toilette*.

43. Essential oils; massage oil; oils for cosmetic purposes. These goods can be used for perfuming and massaging purposes and, thus, are highly similar to the opponent's goods.

Baby oils. Whilst some baby oils are perfumed, a number of them are fragrance free. The users and specific purpose of the goods are different, and the goods are unlikely to be sold in close proximity to each other. The goods are neither complementary nor in competition. These goods are similar to a low degree.

44. Shampoos. These goods are used as part of a daily hygiene routine and have a similar purpose to that of the opponent's goods, i.e. they are used to improve a person's appearance. However, the nature, uses and methods of use are different, the goods are unlikely to be found in close proximity to each other and are neither competitive nor complementary. Finally, it is not unusual for manufacturers of perfumes to also produce fragranced shampoo products. These goods are similar to a low to medium degree.

45. Mouth washes (not for medical purposes). These goods are used for oral hygiene and might have breath freshening properties. Although these goods and the opponent's goods target the same users and have a similar purpose, namely to enhance the odour of the body, their method of use is different because *mouth washes* are gargled whilst *perfumes* and *eau de toilette* are worn on the skin. Further, the goods are neither competitive nor complementary and are unlikely to be found in close

proximity to each other. These goods are dissimilar, or if I am wrong, they are only similar to a low degree.

UK 'CK' monogram mark

46. Turning to the remaining UK 'CK' monogram mark, Mr Marsden conceded that the goods are identical or at least similar.

Average consumer

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

48. 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.”

49. The average consumer of the parties' products in class 3 will be a member of the general public. The goods will often be self-selected from a shelf (or the online or catalogue equivalent) and the marks may be exposed visually in advertising and websites. However, it is not unusual to find sales assistants and advisors involved in the purchasing process, so aural considerations may play a part. Even in these cases, however, the customer will normally see the goods before completing a purchase.

50. As regards the level of attention the average consumer will pay when selecting the goods, Ms Cruse argued that consumers are increasingly buying online, and that whilst trade mark law suggests that the average consumer is reasonably well informed and circumspect, the way in which purchases are being made nowadays is changing with concentration levels dwindling. She stated:

“The famous thing about online shopping, especially when you deal with Amazon and Apple Pay and the like, is that it is just one click. One click and it is in the bag, it is coming towards your house and that is it. The results of this dangerous trend have been noted in the newspapers during the last couple of weeks where it has been divulged that huge amounts of goods are being destroyed by Amazon warehouses instead of being returned to the company who sold those products to the end user [...]”

51. Whilst it is possible that online sales have grown over the past years and will continue to grow in the future, I do not accept that the average consumer, for the purpose of the assessment I am required to make, is a person with a low level of concentration who acts like a 'moron in a hurry' (in the phrase used by Foster J in *Morning Star Co-operative Society v Express Newspapers*)¹⁴ purchasing the goods inadvertently “by one click”. As Mr Ian Purvis reiterated in BL-O-730/21 “*we are not concerned in trade mark cases with consumers who are unwary or careless*”. Consequently, I reject Ms Cruse’s argument.

52. The parties’ goods in class 3 are likely to be available in a range of prices – though, as a general rule, they are relatively low value, fairly frequent purchases, and are unlikely to demand a higher level of attention to be paid in their selection. The purchasing process will be a normal, reasonably considered one, and the level of attention will be medium, neither higher nor lower than the norm.

¹⁴ [1979] FSR 113, 117


Comparison of marks


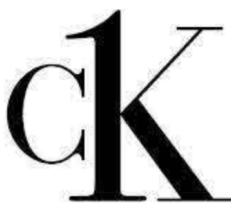
53. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference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

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

54. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

55. The respective marks are shown below:

Applicant's mark	Opponent's marks
	 <p>(the 'CK BE' mark)</p>

<h1>CKJ</h1>	<div style="text-align: center;">  </div> <hr/> <table style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 50%;">CK ONE</td> <td style="width: 50%;">ck-one</td> </tr> <tr> <td>CK one</td> <td>ck-one</td> </tr> <tr> <td>cK one</td> <td>CK1</td> </tr> <tr> <td>ck one</td> <td>cK1</td> </tr> <tr> <td>CK-ONE</td> <td>ck1</td> </tr> <tr> <td>CK-one</td> <td>CK-1</td> </tr> <tr> <td>cK-one</td> <td>ck-1</td> </tr> </table> <p style="text-align: center;">(the 'CK ONE' mark)</p>	CK ONE	ck-one	CK one	ck-one	cK one	CK1	ck one	cK1	CK-ONE	ck1	CK-one	CK-1	cK-one	ck-1
CK ONE	ck-one														
CK one	ck-one														
cK one	CK1														
ck one	cK1														
CK-ONE	ck1														
CK-one	CK-1														
cK-one	ck-1														
	<div style="text-align: center;">  </div> <p style="text-align: center;">(the UK 'CK' monogram mark)</p>														


Overall impression

The applicant's mark

56. The applicant's mark is a word mark that consists of the three letters 'CKJ' in a bold typeface. The letters do not form a recognisable dictionary word. In his submissions, Mr Marsden referred to the applicant's mark being stylised. Although there might be a slight stylisation of the letters, it is very minimal (I would say imperceptible) and, as such, make a weak to negligible contribution to the overall impression of the mark.

The opponent's 'CK BE' mark


57. The opponent's 'CK BE' mark is a series of 7 marks including the following

variations: 'CK BE', 'CK be', 'CKBE', 'CKbe', 'CKB', 'CKb' and  (the monogram 'CK be' mark).

58. In the 'CK BE', 'CK be' and 'CKbe' marks, the letters 'CK' and 'BE/be' will be perceived as separate components due to the presence of a space between 'CK' and 'BE/be' and/or the use of upper and lower case letters. The marks 'CKBE', 'CKB' and 'CKb' will be seen as strings of three or four letters or as three/four-letter acronyms. In each case, none of the words/letters will dominate the others.

59. In the 'CK be' monogram mark, the letter 'K' is significantly larger than the letter 'C' and the word 'be' is relatively small. As such the letters 'CK' will play the greatest role in the overall impression. However, the word 'be' and the way the elements are combined within the mark, including their size, stylisation and position, will also contribute to the overall impression.

The opponent's 'CK ONE' mark

60. The opponent's 'CK ONE' mark is a series of 15 marks including the following variations: 'CK ONE', 'CK one', 'cK one', 'ck one', 'CK-ONE', 'CK-one', 'cK-one', 'ck-one', 'CK1', 'cK1', 'ck1', 'CK-1', 'ck-1' and  (the 'CK ONE' monogram mark).

61. In all of the word-only marks, the letters 'CK' and the number 'ONE/one/1' will be perceived as separate components due to the presence of a space/hyphen between 'CK' and 'ONE/one' and/or the use of the numeral 1. The letters 'CK' will have a slightly more distinctive role within these marks, due to the lower inherent distinctiveness of the number 'ONE/1'.

62. In the 'CK ONE' monogram mark, the letter 'K' is significantly larger than the letter 'C' and the word 'one' is relatively small. As such the letters 'CK' will play the greatest role of the overall impression. However, the word 'one' and the way the elements are combined within the mark, including their size, stylisation and position, will also contribute to the overall impression.

The opponent's UK 'CK' monogram mark

63. The opponent's UK 'CK' monogram mark consists of the two letters 'C' and 'K'. The letter 'K' is significantly larger than the letter 'C' and the stem of the letter 'K' is stylised in such a way that it gives the impression of the number 1. The size and

stylisation of the letter 'K' is such as to make it slightly more dominant, however, this is offset by the position of the letter 'C' at the beginning of the mark, and the overall impression of the mark will still be in the combination of both letters.

Visual similarity

The opponent's 'CK BE' mark and the applicant's 'CKJ' mark

64. Visually, the applicant's 'CKJ' mark and the opponent's '**CK BE**', '**CK be**' and '**CKbe**' marks coincide in the first two letters 'CK' but differ in their endings, namely, the letters 'BE/be' in the opponent's marks and the letter 'J' in the applicant's mark. Further, the applicant's 'CKJ' mark will be seen as a string of three letters with no meaning whilst the applicant's marks will be seen as a combination of two elements, one of which is a recognisable dictionary word, namely the word 'BE/be'. Given that the marks are short, the difference created by the different third letter and the addition of a fourth letter in the opponent's marks (which will be perceived as made up of two elements rather than one as in the applicant's mark) create a different visual impression. **The marks are similar to a low to medium degree.** The same applies to the mark 'CKBE', with the only difference being that the element 'BE' might not be identifiable and that the mark will be perceived as a string of four letters.

65. **The marks 'CKB' and 'CKb'** will be seen as strings of three letters. The marks share the first two letters, but their last letter differs, namely the letter 'J' in the applicant's mark and the letter 'B/b' in the opponent's mark. The marks at issue are short marks and ordinarily small differences have a bigger impact in short marks however, in light of the fact that two out of the three letters are identical **I consider the marks to be similar to a medium degree.**

66. Moving on to **the 'CK BE' monogram mark**, the visual impact created by the relative size and position of the elements 'CK' and 'be' means that **the visual similarity between the marks is reduced to a very low degree.**

The opponent's 'CK ONE' mark and the applicant's 'CKJ' mark

67. The marks '**CK ONE**', '**CK one**', '**cK one**', '**ck one**', '**CK-ONE**', '**CK-one**', '**cK-one**', '**ck-one**' and the applicant's 'CKJ' mark coincide in the first two letters 'CK' but

differ in their endings, namely, the word 'ONE/one' in the opponent's marks and the letter 'J' in the applicant's mark. Some of the marks in the series also include a hyphen and a space which may go unnoticed. **The marks are similar to a low to medium degree.**

68. As regard the marks 'CK1', 'cK1', 'ck1', 'CK-1', 'ck-1', the degree of similarity is higher, because the letter 'J' and the number 1 are visually more similar, although not to the point that the average consumer will not be able to distinguish a letter from a number. **The marks are similar to a medium to high degree.**

69. Moving on to **the 'CK ONE' monogram mark**, the visual impact created by the size and position of the elements 'CK' and 'one' means that **the visual similarity between the marks is reduced to a very low degree.**

The opponent's UK 'CK' monogram mark and the applicant's 'CKJ' mark

70. Visually, the applicant's 'CKJ' mark and the opponent's **UK 'CK' monogram mark** coincide in the first two letters 'CK' but differ in the presence of the letter 'J' in the applicant's mark (which has no counterpart in the opponent's mark) and in the stylisation of the letter 'K' and the use of different size letters in the opponent's mark (which has no counterpart in the applicant's mark). **The marks are similar to a low to medium degree.**

Aural similarity

71. Aurally, the applicant's 'CKJ' mark will be pronounced as three separate letters, namely the letters 'C', 'K' and 'J'. The opponent's **UK 'CK' monogram mark** will be pronounced as the two letters 'C' and 'K'. **The marks are aurally similar to a medium to high degree.**

72. Moving on to the other two marks, the addition of the word 'BE' (or the letters 'B' and 'E' pronounced as single letters) and the word 'ONE' in **the marks 'CK BE' and 'CK ONE'** reduces the level of aural similarity to **low to medium. The only exception is represented by the marks CKB (of the 'CK BE' series) that is similar to a medium degree.**

Conceptual similarity

73. The applicant's 'CKJ' mark will be perceived as a string of three letters with no meaning. At the hearing Mr Marsden explained that the letters 'CKJ' are the initials for the person who is behind the applicant's company and stand for Cheong Kwan Jang, however, he also recognised that this is not relevant because the average consumer would not know that.

74. Moving on to the opponent's marks, it is clear that 'CK' is an abbreviation derived from Calvin Klein's name. It is also clear from the evidence filed that 'CK' has generally been used in conjunction with the name Calvin Klein (as shown below) in which case, I accept, it will inevitably be seen as an abbreviation of the name Calvin Klein:



CK Calvin Klein



Calvin Klein

CK Be

Eau de Toilette

Product code: 1032763 | RRP £59.00

£59.00

Perfume points: 59.0 Not a

75. I also accept that the evidence includes some examples of 'CK' being used as a standalone mark on items of clothing. However, when the mark 'CK' appears without the name Calvin Klein, the letters 'CK' are always presented in the same distinctive manner as the 'CK BE' monogram mark, the 'CK ONE' monogram mark and the UK 'CK' monogram mark as follows:



76. Consequently, if the public has been educated to recognise the letters 'CK' as a Calvin Klein mark (or a secondary house mark/signature mark) in relation to the goods concerned – as, it seems to me, it was implicitly conceded by Mr Marsden when he accepted the reputation of the 'CK' monogram mark in relation to perfumes - that can be true only in relation to the letters 'CK' used in the same script as that used in the 'CK BE', 'CK ONE' and the 'CK' monogram marks. Likewise, I accept that the marks 'CK BE' and 'CK ONE' might enjoy a degree of public recognition as the name of two perfumes released by the fashion designer Calvin Klein. However, the plain letters 'CK' are not, to the best of my knowledge, an accepted or known abbreviation for Calvin Klein. Consequently, my conclusion is that in the absence of the name Calvin Klein or the distinguishing stylisation, the plain letters 'CK' (used on their own as a standalone mark) will NOT convey any conceptual association with the name Calvin Klein.

77. Insofar as the applicant's mark will be perceived as a combination of the three letters 'C', 'K' and 'J' and the opponent's marks will be perceived as a combination of the two letters 'C' and 'K' plus the dictionary word 'BE' or the number 'ONE/1', the marks are conceptually different because 1) the sequences 'CKJ' (in the applicant's mark) and 'CK' (in the opponent's marks) have no meaning but the words 'BE' and 'ONE' (in the opponent's marks) will be given their dictionary meaning and 2) the sequences 'CKJ' and 'CK' in the respective marks are not identical and there is nothing in the marks which supplement their meaning.

78. Consequently, even if I were to take into account that the marks 'CK BE' and 'CK ONE' are used and associated with the name Calvin Klein, that would not apply to the applicant's mark and the marks would still be **conceptually different**. Since the letters 'CK' are not separated from the letter 'J' or artificially highlighted (and I consider that use of the applicant's mark in that way is likely to take it beyond the boundaries of what is normal and fair use), they do not play an independent distinctive role within the

mark; hence, I can see no reason why the average consumer would perceive the letters 'CK' in the applicant's 'CKJ' mark as a separate element and understand them as an abbreviation for Calvin Klein.

79. This also applies to the comparison between the applicant's mark and the UK 'CK' monogram mark, to the extent that due to the distinguishing stylisation, the letters 'C' and 'K' might be recognised as a Calvin Klein's signature mark.

80. Insofar as the applicant's 'CKJ' mark will be perceived as a sequence of three letters and the opponent's 'CKBE', 'CKB' and 'CKb' marks (of the 'CK BE' series of marks) will be perceived as sequences of four/three letters, neither mark will convey any meaning and the conceptual position is neutral. This also applies to the comparison between the applicant's 'CKJ' mark and the opponent's UK 'CK' monogram mark, to the extent that the stylised letters 'C' and 'K' in the opponent's mark might be perceived as a random combination of two letters and might not be associated with Calvin Klein.

Distinctive character of earlier mark

81. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been

registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

82. I will begin by assessing the inherent distinctiveness of the earlier marks.

83. The ‘CK BE’ and the ‘CK ONE’ marks are neither descriptive nor allusive in relation to the goods concerned. The letters ‘CK’ are meaningless and the words ‘BE’ and ‘ONE’ are ordinary dictionary words, but the combinations ‘CK BE’ and ‘CK ONE’ are, as wholes, distinctive to a medium degree.

84. The verbal element of the UK ‘CK’ monogram mark are simply two letters and are (without the stylisation) distinctive to a low degree. Whilst the stylisation of the letters adds some distinctiveness to the mark (which is, at most, medium), it is only the distinctiveness of the common element that matters¹⁵ and since the stylisation of the letters in the applicant’s mark is different, the increased distinctiveness created by the stylisation of the letters ‘C’ and ‘K’ in the opponent’s marks does not assist the opponent. The same applies to the ‘CK BE’ and the ‘CK ONE’ monogram marks.

85. I will now consider the impact of the applicant’s admission regarding reputation in relation to enhanced distinctiveness. Reputation and enhanced distinctiveness are not the same thing; reputation represents a knowledge threshold and distinctiveness is a measure of how strongly the mark indicates to consumers that the goods/services originate from one undertaking. In *CXO2*,¹⁶ Mr Phillip Johnson, sitting as the appointed person, stated:

¹⁵ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

¹⁶ *O2 Worldwide Ltd v CXO2.COM (UK) Limited* BL O/393/19

“I agree with the Hearing Officer that reputation in itself does not make a mark highly distinctive. However, while distinctiveness and reputation are different, the nature, factors and evidence used to prove enhanced distinctiveness are the same as for reputation. Furthermore, reputation for the purposes of section 5(3) is a higher threshold than for acquired distinctiveness. In other words, if there is a reputation then distinctiveness should be enhanced. Where it fits on the distinctiveness scale after this enhancement is a question of fact for each individual case.”

86. In light of this, I consider that having admitted that the opponent benefits from a reputation under Section 5(3), it follows that the applicant must also accept that the distinctiveness of the earlier marks in relation to which the opponent has a reputation, must also have been enhanced. The extent of any enhanced distinctiveness must be considered on the facts and, consequently, it is to that assessment that I now turn.

87. Given 1) Mr Marsden’s concessions as regards the reputation of the ‘CK BE’ mark, ‘CK ONE’ mark and UK ‘CK’ monogram mark in relation to perfumes; 2) the evidence of extensive marketing exposure; 2) the evidence that until 2018-2019 ‘Calvin Klein One’ was the company’s most used perfumes for women brands in the UK and 3) the evidence relating to the sales figures for Calvin Klein perfumes which shows that 16% of the EU sales achieved between 2017 and 2020 (which amounts to nearly \$1 billion) were UK sales, **I accept that the distinctive character of the ‘CK ONE’, ‘CK BE’ and UK ‘CK’ monogram mark has been enhanced through use to a very high degree in relation to *perfumes* and *eau de toilette*. This conclusion applies to all of the marks in the two series, with the exception of the marks ‘CKBE’, ‘CKB’ and ‘CKb’, since these marks, as standalone marks, will not necessarily be understood as identifying the brand ‘CK BE’ from Calvin Klein. **As sequences of three letters, these marks have a low degree of distinctive character.****

Likelihood of confusion

88. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

89. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where 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.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

90. I have found the applicant’s ‘CKJ’ mark and the opponent’s ‘CK BE’ mark to be visually similar to a degree ranging between very low and medium (depending on the marks in the series), aurally similar to a degree between low and medium and conceptually different. I have found the applicant’s ‘CKJ’ mark and the opponent’s ‘CK ONE’ mark to be visually similar to a degree ranging between very low and medium-to-high, (depending on the marks in the series), aurally similar to between a low and medium degree and conceptually different. I have found the applicant’s ‘CKJ’ mark and the opponent’s UK ‘CK’ monogram mark to be visually similar to a low to medium degree, aurally similar to a medium to high degree and conceptually neutral (if the letters ‘CK’ are perceived as a sequence of two random letters) or different (if the letters ‘CK’ are perceived as the initials of Calvin Klein). I have found that the ‘CK BE’ and ‘CK ONE’ marks are inherently distinctive to a medium degree, which has been enhanced through use to a very high degree in relation to *perfumes* and *eau de toilette*. I have found that the letters ‘CK’ in the UK ‘CK’ monogram mark are inherently distinctive to a low degree and that taking into account the distinctiveness added by the stylisation and the use made of the mark, the mark has become distinctive to also a very high degree. I have found the average consumer to be a member of the general public, who will purchase the relevant goods predominantly by visual means (although I do not discount an aural component). I have found that a medium degree of attention will be paid during the purchasing process. I found that some of the goods are identical and some are similar.

91. In her oral submissions, Ms Cruse commented on the likelihood of confusion in the following terms:

"If I were to go on the Amazon app and search for CKJ because I wanted to buy some jeans and I saw a perfume as an option within those choices appear, I might think, "I love CK One, I bet this is good. Oh, this is a new perfume from Calvin Klein. Oh whoops, I clicked 'buy now'," and there it is it is coming towards me. I would naturally think those goods originate from the opponent company and naturally think those goods would be of a good quality. The fact that they come to me in Amazon packaging and perhaps include a trade mark similar to Calvin Klein's may lead me to continue to think that I am able to use those goods without checking the origin of them, and if the goods are under par Calvin Klein's goodwill will be damaged because I will cease purchasing goods of the opponent's company, and I may even write a review on the Calvin Klein's website or somewhere else saying how disappointed I was with the product purchase. The same can be said in relation to any search conducted on line for CK perfume".

92. Ms Cruse's argument seemed to proceed on the assumption that the opponent can rely on the mark 'CKJ' (which, it is alleged, has been used by the opponent in relation to jeans as an abbreviation for 'Calvin Klein Jeans') under Section 5(2)(b). However, the opponent's registrations for the mark 'CKJ' are "dead" and the mark 'CKJ' is not covered by the pleadings under Section 5(2)(b). Consequently, the mark 'CKJ' is effectively out of scope, since the opponent has made no claim based on that mark under Section 5(2)(b). It also follows that it cannot be assumed that average consumers are aware of the opponent's use of the mark 'CKJ' as an abbreviation for Calvin Klein Jeans in relation to jeans products and that they would infer, on the basis of that knowledge, that the applicant's 'CKJ' mark is effectively Calvin Klein's 'CKJ' mark used on goods in class 3 - that is essentially what Ms Cruse argued.

93. Further, I reject the notion that the letters 'CK' in the applicant's 'CKJ' mark will be seen as meaning Calvin Klein in the absence of the name Calvin Klein. In this connection, I do not forget that there is evidence as to how the initials 'CK' are used, namely with the name Calvin Klein and/or with the distinguishing stylisation of the Calvin Klein's monogram marks. It does not seem inherently likely that the public would dissect the applicant's 'CKJ' mark in such a way that it would be perceived to

be the initials for Calvin Klein bearing the additional letter 'J' – especially given that it is not clear what the letter 'J' would indicate in the context of the relevant goods in class 3. Further, I do not consider that the applicant's 'CKJ' mark could be presented in such a way that, for instance, the letter 'J' would be separated from the letters 'CK' or artificially highlighted because this would take the mark beyond the boundaries of what is normal and fair use.

94. It follows that, as regards direct confusion, the opponent paradoxically has achieved a better case in respect of the mark that is not necessarily associated with Calvin Klein, namely the mark 'CKB' (within which the element 'CK' does not stand out). I also consider that on a par with the 'CKB' mark, the mark 'CK1' gives the opponent the best chance of success, because it is visually more similar to the applicant's 'CKJ' mark than the other earlier marks. However, as I have already stated above, even taking into account the effect of imperfect recollection, the visual difference between the marks are not such that the average consumer will mistake or misremember the letter 'J' for the letter 'B' or the number 1. In this connection, I bear in mind that the impact created by a different single letter is more significant in a short word or letter combination than it would be in a longer word or combination of letters. The marks are not close enough to be directly confused. That is also my view of the matter in relation to the UK 'CK' monogram mark; I do not consider that from a visual or aural standpoint there is any danger of confusion between the marks. **There is unlikely to be any direct confusion.**

95. As regard indirect confusion, I will consider it in the context of the family of marks argument advanced by the opponent.

Family of marks

96. The opponent relies on a family of marks argument in the following terms:¹⁷

“The evidence provided shows that the Opponent also uses the CK + suffix formula when launching new brands, in particular see paragraph 23 of Mark Bhandal’s witness statement, showing huge amounts of expenditure on

¹⁷ See the opponent's skeleton argument

advertising in relation to CK EVERYONE, CK IN2U, CK UNISEX and CK2 for class 3 goods.

In addition to the Opponent's huge amount of use of CK+suffix brands for perfume, the Opponent's evidence shows huge use of that formula for clothing – in relation to CKJ and CKU.

The average consumer will also be aware of a number of trade marks owned by the Opponent that begin with the letters CK and end with a suffix. Some will understand that the suffix forms a message in relation to the goods (for example ONE or BE) or an extra letter, which, again acts as an abbreviation, such as CKJ (meaning CK JEANSWEAR) or CKU (meaning CK YOU), but not all.

Trade marks beginning with CK and ending with a suffix, such as J, U, ONE, BE, IN2U, etc. are recognised by the average consumer in the UK as originating from the Opponent, due to the copious amount of use made by the Opponent of those trade marks in the UK”.

97. It is well established that where it is shown that the proprietor “has used a “family” of trade marks with a common feature, and a third party uses a sign which shares that common feature, this can support the existence of a likelihood of confusion.”¹⁸ An essential element for a family of trade marks to be established is therefore that they have been in use.¹⁹

98. For the reasons set out in the previous section relating to genuine use, I have no difficulty finding that the opponent has not established use of the mark ‘CKU’. Consequently, the opponent cannot rely on this mark to sustain its family of marks argument. Likewise, since the mark ‘CKJ’ - which is relied upon under Section 5(4)(a) - is an unregistered mark, it cannot be relied upon as part of the family of marks argument under Section 5(2)(b). As regard the opponent’s reliance on the additional marks ‘CK EVERYONE’, ‘CK IN2U’, ‘CK UNISEX’ and ‘CK2’, as Mr Marsden correctly

¹⁸ *EasyGroup Limited v Easyway SBH* [2021] EWHC 2007 (IPEC)

¹⁹ *Beck, Koller & Company (England) Limited* RPC LX1V paragraph 26

observed, these marks were not pleaded, so I shall say no more about them. Finally, since the opponent characterised the relevant “family of marks” as concerning use of trade marks incorporating what is described as “*the CK + suffix formula*”, the UK ‘CK’ monogram mark cannot form part of that family, because the element ‘CK’ is not followed by any suffix. What the opponent’s family of marks comes down to is, therefore, the two marks ‘CK BE’ and the ‘CK ONE’, in relation to which I have accepted that extensive use has been made.

99. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the CJEU stated that:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series

another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

100. The first thing I should say is that I do not think that two marks are "*a sufficient number of trade marks capable of constituting a family or a series*". But, even if they were, the common element of the marks is that they are formed by the letters 'CK' followed by a word or a number. The applicant's 'CKJ' mark does not follow the common format of the opponent's marks in that the letters 'CK' do not represent a separate element within the mark and are not followed by a word or a number. Neither do I find that the applicant's 'CKJ' mark would, for any other reasons, be perceived as a brand or a variant of the opponent's marks and/or that the average consumer would be likely to assume that there is an economic link between the parties' marks.

101. For all these reasons, I have come to the clear view that **there is unlikely to be any indirect confusion on the part of the public.**

102. **The opposition fails under Section 5(2)(b).**

Section 5(4)(a)

103. 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”.

104. 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.”

105. 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).”

The Relevant Date

106. The date for assessing a passing off claim in opposition proceedings is typically the date the application,²⁰ the subject of the opposition, was filed, in this case 16 June 2020. The applicant has not filed any evidence, so there is no evidence supporting an earlier relevant date.

Goodwill

107. 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 custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

108. 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*

²⁰ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11

(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; 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.”

109. 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.”

110. Under Section 5(4)(a) the opponent’s claim goodwill in the marks ‘CK’ (in relation to clothing, perfumes, toiletries and cosmetics), ‘CK ONE’ (in relation to perfumes and cosmetics) and ‘CKJ’ (in relation to clothing).

111. Whilst I accept that the opponent has reputation and goodwill associated with the mark ‘CK ONE’ for perfumes, there is no evidence of the plain letters ‘CK’ being used as a standalone mark without the name Calvin Klein or without the distinguishing stylisation of the Calvin Klein’s earlier monogram marks. Consequently, I reject the

opponent's claim that it had goodwill associated with the mark 'CK' alone at the relevant date.

112. In any event, Ms Cruse's argument under Section 5(4)(a) was in large part concerned with the sign 'CKJ'. I think this made sense. Given my finding under Section 5(2)(b) that there would be no likelihood of confusion on the basis of the opponent's 'CK ONE' mark, the opponent is not going to do any better with the goodwill associated with the 'CK ONE' mark. Likewise, assuming that it could be established, that the opponent had goodwill associated with the word-mark 'CK' alone, there would be no greater likelihood of misrepresentation, because I do not consider that from a visual or, aural standpoint, there is any danger of confusion between 'CKJ' and 'CK'; nor do I consider that goods sold under the mark 'CKJ' will be misrepresented as being those of the opponent trading under the 'CK' mark.

113. As regard the use of the mark 'CKJ', the only evidence provided by the opponent in relation to this mark is as follows:

- Annex 2: is an online article from the website www.pvh.com printed on 12 January 2021. It refers to the brand Calvin Klein Jeans being promoted in 2018 and 2019 through campaigns enlisting some US celebrities;
- Annexes 14 and 15: are copies of results from Google searches for 'CKJ Calvin' and 'CKJ Jeans';
- Annex 20: are copies of records from the UKIPO websites showing two registrations for the mark 'CKJ' which are qualified as "dead";
- Paragraphs 50-53 of Mr Bhandal's witness statement.

114. Although Mr Bhandal's statement contains three examples of the mark 'CKJ' being used on items of clothing and Mr Bhandal states that he owned a pair of jeans that had 'CKJ' on the label, this is not sufficient to establish that the opponent had, at the relevant date, goodwill associated with the mark 'CKJ' in the UK. There is no indication of sales made or turnover achieved under the 'CKJ' mark and there is no mention of consumers. The evidence does not demonstrate any tangible activity in the UK. Although Mr Bhandal said that he owned a pair of 'CKJ' branded jeans, he said

nothing about how and when the goods were purchased. It is true that there are some references to the mark 'CKJ' being advertised in 2018-2019, however, this evidence seems to refer to the US market and there is no indication of any specific marketing campaign being run in the UK. Further, the fact that the two UK registrations for the mark 'CKJ' have been abandoned raises the question of why, if the opponent had a protectable goodwill in the UK associated with the sign 'CKJ', it did not seek to maintain those registrations on the UK register. Although the webpages showing the results of the Google searches contain a number of references to 'CKJ' jeans being available for sale from Calvin Klein's UK official websites, this evidence was printed after the relevant date, but, in any event, the fact the goods were available for sale does not establish, without anything more, goodwill (or, alternatively, goodwill of more than trivial nature).²¹

115. Overall, I am not satisfied on the evidence before me that the opponent has indeed established that it owned at the relevant date a protectable goodwill in the 'CKJ' mark.

116. **The claim under Section 5(4)(a) also fails.**

Section 5(3)

117. Section 5(3) states:

“(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 the repute of the earlier trade mark.

118. Section 5(3A) states:

²¹ *Hart v Relentless Records* [2002] EWHC 1984 (Ch)

“(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.”

119. 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 Salomon*, 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*).

120. The relevant date for the assessment under Section 5(3) is the date of the application, namely 16 June 2020.

Reputation

121. 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.”

122. Under Section 5(3) the opponent relies on the same earlier marks relied upon under Section 5(2)(b). I have already mentioned that the applicant has accepted that the opponent has a reputation in the ‘CK ONE’ mark, in the ‘CK BE’ mark and in the UK ‘CK’ monogram mark in relation to perfumes. Taking into account the extent of the use made, I consider that the opponent’s reputation is significant.

Link

123. 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. I have addressed this point in the section regarding the likelihood of confusion.

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

The strength of the earlier mark's reputation. The earlier marks enjoy a significant reputation in relation to goods which are identical to some of goods covered by the applicant's mark;

The degree of the earlier mark's distinctive character, whether inherent or acquired through use. I have addressed this point in the section regarding the distinctive character.

Whether there is a likelihood of confusion. In dealing with Section 5(2)(b) I have already found that the marks are not sufficiently similar to give raise to a likelihood of confusion on the part of the public.

124. Although I recognise that a likelihood of confusion is not necessary to substantiate an objection under Section 5(3), the marks at issue are simply not similar enough to cause a significant part of the relevant public to call to mind (or make a connection with) the earlier marks, even taking into account the reputation enjoyed by these marks. In this connection, it is worth remembering that the degree of recognition of the earlier marks derives from the huge reputation of Calvin Klein. I have already rejected the notion that the letters 'CK' in the applicant's 'CKJ' mark will be seen as meaning Calvin Klein in the absence of the name Calvin Klein. Consequently, even if a mental link between the marks were made it would be so fleeting not to result in any damage.

125. The opposition under Section 5(3) also fails.

Overall outcome

126. The opposition fails in its entirety and the contested application may proceed to registration.

Costs

127. The applicant having been successful, is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. I assess this as follows:

Filing a counterstatement and considering a notice of opposition:	£300
Filing evidence and considering the opponent's evidence:	£500
Attending a hearing:	£700
Total:	£1,500

128. I have not awarded any costs to the applicant in relation to the written submissions filed after the hearing, as the issue arose out of an oversight in the administrative process of serving the Form TM7.

129. I therefore order Calvin Klein Trademark Trust to pay Korea Ginseng Corp. the sum of £1,500. This sum to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of any appeal proceedings.

Dated this 12th day of October 2021

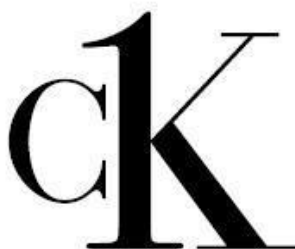
Teresa Perks

For the Registrar,

the Comptroller-General

Annex

EU018021272 (“the EU ‘CK’ monogram mark”)

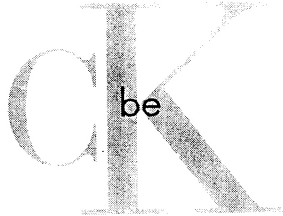


Filing date: 11 February 2019; Date of entry in the register: 15 June 2019

Class 3: Soaps; detergents; bleaching preparations, cleaning preparations; perfumery, toilet water, aftershave, cologne; essential oils; aromatherapy products, not for medical use; massage preparations, not for medical use; deodorants and antiperspirants; preparations for the care of the scalp and hair; shampoos and conditioners; hair colourants; hair styling products; toothpaste; mouthwash, not for medical use; preparations for the care of the mouth and teeth; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool, cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks, facial packs.

UK00002061305 (“the ‘CK BE’ mark”)

CK BE
CK be
CKBE
CKbe
CKB
CKb



Number of marks in series: 7

Filing date: 15 March 1996; Date of entry in the register: 24 January 1997

Class 3: *Non-medicated toilet and bath preparations, namely eau de toilette; soap; talc; skin moisturizer, body lotions and creams, bath oil; massage oil; personal deodorants and antiperspirants; hair care preparations; suntan preparations, all for men and women; potpourri, fragrant sachets; fine air fragrances; all goods in Class 3.*

UK00002130839 (“the ‘CK ONE’ mark”)



CK ONE	ck-one
CK one	ck-one
cK one	CK1
ck one	cK1
CK-ONE	ck1
CK-one	CK-1
ck-one	ck-1

Number of marks in series: 15

Filing date: 25 April 1997; Date of entry in the register: 05 June 1998

Class 3: *Non-medicated toilet and bath preparations, eau de toilette, soap, talc, skin moisturizer, body lotions and creams, bath oil, body wash; all for personal use; massage oil; personal deodorants and anti-perspirants; hair care preparations; suncare preparations, all for men and women; potpourri; fragrant sachets; room fragrances; but not including colophony soaps.*

UK00002150421 ("the 'CK' mark")



Filing date: 08 November 1997; Date of entry in register: 19 February 1999

Class 18: *Leather goods and goods made of imitations of leather; handbags, wallets, key cases, change purses, cosmetic bags and pouches, portfolios, suit bags, trunks, suit cases, toilet kits, billfolds, duffle bags, tote bags, brief cases and attache cases, luggage, overnight cases, credit card holders, business card holders; umbrellas, parasols.*

Class 25: *Clothing, footwear and headgear; women's, men's, boy's and girl's wearing apparel; jump suits, shirts, blouses, jackets, bathing suits, pants, shorts, warm-up suits, capes, walking shorts, jeans, suits, dinner jackets, raincoats, ties, stockings/tights, hats/caps, outer coats, sweaters, skirts, belts, coats, fur-trimmed coats, furs, vests, T-shirts, tennis and golf dresses, shorts, beach and swimming cover-ups, rainwear/raincoats, ponchos, tank tops, footwear; shoes, active sport shoes, sneakers, boots, slippers; blazers, pants, shirts, socks, gloves, dresses, shearling coats and jackets, scarves/shawls, sports jackets; men's and boy's underwear; sleepwear, loungewear including but not limited to briefs, boxers, athletic underwear, sport knits, T-shirts, tank tops, undershirts, basic underwear and robes, knitted and woven sleepwear, sleep shirts, pyjama tops, pyjama bottoms, breakfast jackets, smoking jackets, bed jackets, cover-ups, knitted and woven loungewear, lounging pants and tops, lounge jackets; women's and girl's underwear; intimate apparel and sleepwear, loungewear, bodywear, foundations, bras, girdles, garter belts, all-in-ones, corselettes, body stockings, control briefs, control hipsters,*

contarter bikinis, bra slips, bra top camisoles, waist cinchers, bustiers, merry widows, camisettes, leotards and unitards; daywear including but not limited to culottes, bikinis, hipsters, briefs, slips, blouse slips, camisole slips, chemise slips, culotte slips, evening slips, maternity slips, panty slips, princess slips, shadow panel slips, strapless slips, suit slips, tailored slips, half slips, petti-slips, bra slips, chemises, teddies, camisoles, bra top camisoles, bralettes, tap pants and petti-pants, daywear, loungewear, sleepwear and bodywear including but not limited to night gowns, toga nightgowns, night shirts, pyjamas, shortie pyjamas, baby-doll pyjamas, T-shirt pyjamas, french maid sleepers, harem pyjamas, hostess culottes, lounging pyjamas, rompers, sleep shorts, peignoirs, bed jackets, caftans, jumpsuits, teddies, bathrobes, dressing gowns, kimonos, housecoats, beach togas, beach wrap-ups, breakfast, brunch coats, cocoons, dusters, hostess robes, kabuki robes, lounging robes, monk's robes, bra tops, crop tops and leggings.


EU008864126 (“the ‘CKU’ mark”)

CKU

Filing date: 05 February 2010; Date of entry in the register: 05 July 2010

Class 25: *Underwear, sleepwear, t-shirts, tank tops, pajamas, sleep shirts, robes, briefs, boxers, athletic underwear, sport knit underwear, and loungewear, namely, lounging pants, shirts and tops, and lounge jackets; women's intimate apparel, sleep-wear, loungewear, bodywear and daywear, namely, underwear, bras, control briefs, control hipsters, control bikinis, camisoles, camisettes, bikinis, hipsters, briefs, slips, chemises, teddies, camisoles, bralettes, and petti-pants, nightgowns, night shirts, pajamas, sleep shorts, and bathrobes.*

UK00003374267 (“the UK ‘CK’ monogram mark”)



Filing date: 11 February 2019; Date of entry in the register: 03 May 2019

Class 3: *Soaps; detergents; bleaching preparations, cleaning preparations; perfumery, toilet water, aftershave, cologne; essential oils; aromatherapy products,*

not for medical use; massage preparations, not for medical use; deodorants and antiperspirants; preparations for the care of the scalp and hair; shampoos and conditioners; hair colourants; hair styling products; toothpaste; mouthwash, not for medical use; preparations for the care of the mouth and teeth; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool, cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks, facial packs.