

O/1041/22

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3625254  
BY XIAMEN QIUJIA TRADING CO., LTD.  
TO REGISTER THE TRADE MARK:**

**Etaa**

**IN CLASSES 21, 25 AND 28**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 426743  
BY ETAM**

## **Background and pleadings**

1. On 13 April 2021, Xiamen Qiuji Trading Co., Ltd. (“the applicant”) applied to register the trade mark **Etaa** in the UK, under number 3625254 (“the contested mark”). The contested mark was published in the Trade Marks Journal for opposition purposes on 11 June 2021. Registration is sought for the following goods:

Class 21: Cups; Containers for household or kitchen use; Bottles; Basins [bowls]; Cooking utensils, non-electric; Bottle openers, electric and non-electric; Works of art of porcelain, ceramic, earthenware or glass; Baby baths, portable; Syringes for watering flowers and plants; Combs; Brushes; Toothbrushes; Cosmetic utensils; Make-up removing appliances; Litter trays for pets; Cages for household pets; Ultrasonic mosquito repellents; Feeding vessels for pets.

Class 25: Clothes; Coats; Skirts; Topcoats; Uniforms; Vests; Trousers; Pyjamas; clothing; shoes; Hats; Hosiery; Scarfs; Gloves [clothing]; boots; Underwear; Pants.

Class 28: Games; Carnival masks; Toys; Toy models; Toy drones; Checkerboards; Balls for games; Body-building apparatus; Archery implements; Skateboards; Machines for physical exercises; Knee guards [sports articles]; Elbow guards [sports articles]; Ornaments for Christmas trees, except illumination articles and confectionery; Christmas trees of synthetic material; Fishing tackle; Yoga straps; Yoga blocks; Yoga swings.

2. On 10 September 2021, ETAM (“the opponent”) filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods in the application. To support its claim, the opponent relies upon the following marks:

ETAM

UK trade mark number 495777

Filing date: 9 October 1928

Registration date: 9 October 1928

("the first earlier mark")



UK trade mark number 801115884<sup>1</sup>

Filing date: 9 February 2012

Registration date: 15 April 2013

("the second earlier mark")

3. The first earlier mark is registered in respect of goods in class 25. The second earlier mark is registered in respect of goods in classes 3, 18, and 25. For the purposes of the opposition under section 5(2)(b), the opponent relies upon the following goods:

#### **First earlier mark**

Class 25: Articles of clothing

#### **Second earlier mark**

Class 18: Handbags; travel bags; backpacks; beach bags.

Class 25: Clothing, footwear; clothing for men, women and children, dresses, skirts, underskirts, pant skirts, slacks, shorts; Bermuda shorts, undershorts, shirts, blouses, bodices, tee-shirts, sweat-

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<sup>1</sup> On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing IREU. As a result of the opponent's IREU 1115884 being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and the international registration date is treated as the filing date.

shirts, vests, shawls, scarves, belts (clothing), socks, pajamas, dressing gowns, bathing suits, bathrobes; shoes.

4. Given the respective filing dates, the opponent's marks are earlier marks, in accordance with section 6 of the Act. As they had been registered for more than five years at the filing date of the application, they are subject to the proof of use requirements specified within section 6A of the Act.

5. The opponent essentially argues that the competing marks are highly similar, and the parties' goods are either identical or similar. On this basis, the opponent contends that there is a likelihood of confusion, including the likelihood of association. In its notice of opposition, the opponent made a statement of use in respect of all the goods it relies upon.

6. The applicant filed a counterstatement denying the grounds of opposition. Within its counterstatement, the applicant denies that the marks are similar and denies that the goods are identical or similar.<sup>2</sup> It disputes that there is a likelihood of confusion. Moreover, the applicant requested that the opponent demonstrates proof of use in respect of the second earlier mark.

7. The opponent is professionally represented by Wynne-Jones IP Limited, whereas the applicant is professionally represented by Meifang Ke. Evidence has been filed by the opponent in these proceedings. Both parties were given the option of an oral hearing, though neither asked to be heard on this matter. However, the opponent filed written submissions in lieu of an oral hearing. Whilst I do not intend to summarise these, I have taken them into consideration and will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

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

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<sup>2</sup> Counterstatement, paragraphs 8-12.

## **Evidence and submissions**

9. The opponent's evidence comprises a witness statement of Pierre Milchior dated 7 April 2021, together with Exhibits PM1 to PM15.<sup>3</sup> Pierre Milchior confirms that they are President of the opponent company, a position they have held since September 1989 and the incorporation of the company in France. The purpose of their statement is to give evidence as to the history and activities of the opponent, as well as to its use of the second earlier mark.

10. As noted above, the opponent also filed written submissions in lieu of a hearing.

11. Whilst the opponent's evidence and submissions will not be summarised here, I have taken it all into consideration in reaching my decision and will refer to it below, as and where necessary.

## **Decision**

### **Proof of use**

12. The relevant statutory provisions are as follows:

6A(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), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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<sup>3</sup> The opponent originally sought to rely upon additional evidence, that being Exhibit PM16. However, it was filed in an incorrect manner. On 9 May 2022, the opponent, through its representatives, confirmed via email that it no longer wished to rely on it.

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

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

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

(5)-(5A) [Repealed]

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

13. As the second earlier mark, which is subject to proof of use, is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.—(1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

14. The onus is on the opponent, as the proprietor of the second earlier mark, to show use made of the mark as section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

15. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the second earlier mark is the five-year period ending with the filing date of the application at issue, i.e. 14 April 2016 to 13 April 2021.

16. 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 Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [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].”

17. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark” is not, therefore, genuine use.

18. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union (“CJEU”) noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the

European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

19. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open

the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

20. The General Court ("GC") restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of an EUTM. Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

21. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5-year period. In making the required assessment I must consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- v) The geographical extent of the use shown

22. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. (as he then was) 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.”

### *Genuine use*

23. Pierre Milchior gives evidence that he is the President of the Opponent, a position which they have held since 1989 when the company was incorporated in France.<sup>4</sup> Mr Milchior explains that the opponent’s company is a subsidiary of Etam Développement which was created in 1916.<sup>5</sup> Mr Milchior gives the history of the company, its innovation and its successes, which is supported by a timeline from its company website [www.etam.co.uk/notre-univers/notre-histoire-savoir-faire/](http://www.etam.co.uk/notre-univers/notre-histoire-savoir-faire/).<sup>6</sup> Although many of the events fall outside the relevant period. In support there is also an online article by [www.buildingourpast.com](http://www.buildingourpast.com),<sup>7</sup> dated 26 May 2016 and entitled “Forgotten fashions.” It refers to the Etam mark and discusses historic Etam events that occurred outside the relevant period.

24. Pierre Milchior explains that in 2012 Etam introduced an annual live show to open Paris Fashion week and that, on average, there are 4,000 guests and 70 models showcasing Etam’s products. Provided in support of these annual shows are several articles and social media posts referring to the second earlier mark. The first is a Mail Online article which refers to the 2015 annual show;<sup>8</sup> however, it is dated 4 March 2015 and is, therefore, from outside of the relevant period. There are a number of articles that relate to the 2016 Etam live annual show celebrating Etam’s 100<sup>th</sup> anniversary, including: an online article from Euronews, dated 27 September 2016<sup>9</sup> (which also mentions streaming access to the live Etam show), an undated printout from an online article from the website [www.multivu.com](http://www.multivu.com),<sup>10</sup> and a Mail Online article, published on 28 September 2016. Additional Mail Online articles published on 27 September 2017, 26 September 2018, 25 September 2018, and 29 September

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<sup>4</sup> Pierre Milchior’s witness statement, paragraph 1 & Exhibit PM1

<sup>5</sup> Pierre Milchior’s witness statement, paragraph 2 & Exhibit PM2

<sup>6</sup> Exhibit PM3, pages 6-28

<sup>7</sup> Ibid, pages 29-30

<sup>8</sup> Exhibit PM8, pages 48-50

<sup>9</sup> Ibid, page 56

<sup>10</sup> Ibid, page 52

2020,<sup>11</sup> provide details of subsequent live fashion shows held annually by Etam within the relevant period, which primarily feature lingerie goods. An article dated 27 September 2017, from the website [www.wwd.com/fashion-news/fashion-scoops](http://www.wwd.com/fashion-news/fashion-scoops) entitled “Charli XCX performs at Etam live show”,<sup>12</sup> also provides details of the 2017 Etam live show. There are also annual Instagram posts under the second earlier mark to celebrate and promote Etam’s live shows.<sup>13</sup> Starting with a post, dated 28 September 2016, promoting the 2016 Etam live show which celebrated the brand’s 100-year anniversary, and then posts dated 26 September 2017, 27 September 2018, and 23 September 2020 to promote Etam’s annual live shows. Included in the social media evidence is a post that clearly shows the second earlier mark when advertising the Etam live 2019 show.<sup>14</sup> Despite the post itself being undated, I am satisfied from the content that it evidences activity from within the relevant period. From this social media evidence, it is clear that the fashion shows focused mainly on lingerie. Pierre Milchior explains that, since 2018, Etam’s live shows are streamed on Facebook, Instagram and YouTube.<sup>15</sup> Mr Milchior states that the shows are streamed on the French television network W9 generating more than 10 million views per year worldwide. However, there is no documentary evidence to support this claim and no information of how many people from within the EU watched these live streams.

25. The opponent has provided a copy of what appears to be its own magazine bearing the second earlier mark on the cover page with the words “100 years of French Liberte”.<sup>16</sup> The article discusses the history of the company first founded in 1916 and its 100 years in existence including details of Etam live fashion shows and its 100<sup>th</sup> anniversary live show as discussed above. Much of the magazine is taken up with mention of artists, musicians, designers and model collaborations and attendees at Etam live shows. However, it is unclear whether the magazine was for internal purposes only or whether the magazine was circulated to the general public in the relevant territories.

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<sup>11</sup> Exhibit PM8

<sup>12</sup> Ibid, pages 57-58

<sup>13</sup> Exhibit PM8

<sup>14</sup> Ibid, page 67

<sup>15</sup> Pierre Milchior’s witness statement, paragraph 26

<sup>16</sup> Exhibit PM8



26. The opponent has included within the evidence screenshots from Etam's social media posts.<sup>17</sup> Whilst some of these posts are outside of the relevant period, others are dated between 22 April 2016 and 8 March 2021, i.e. within the relevant period. Etam's Instagram page evidences use of the second earlier mark, with its posts mainly promoting lingerie, but also including goods such as swimwear, sportswear, tops, skirts bags, jackets, dresses, shorts, jeans, shoes and boots. I note that on many of these goods the second earlier mark is present on either the goods themselves or the labels.

27. Pierre Milchior explains that over the years Etam has worked with famous supermodels such as Natalia Vodianova, Laetitia Casta, Constance Jablonski, Camille Rowe and Ciondy Bruna.<sup>18</sup> Evidence has been provided of these supermodels' Instagram pages.<sup>19</sup> The evidence is undated but appears to postdate the relevant period as many of the pages refer to events in 2022. Therefore, I cannot take into account the number of followers as evidence of Etam's reach. Even if I could take this information into account, I do not know where these followers are based or whether they purchased any goods under the second earlier mark. Additionally, a printout of Etam's Facebook page has been provided, dated 15 April 2019.<sup>20</sup> Although there is clearly use of the second earlier mark on the Facebook page, I note that it only has one confirmed view in the form of a 'like' of the post. On the matter of celebrity endorsements, there is also a British Vogue article,<sup>21</sup> dated 9 February 2009, discussing the supermodel Natalia Vodianova joining the opponent's company as brand ambassador. However, I am conscious that this article pre-dates the relevant period.

28. Pierre Milchior claims that in 2017, Etam re-entered the British market through sales on its website referring to Exhibit PM10.<sup>22</sup> However, Exhibit PM10 consists of a screenshot from the opponent's website regarding a collaboration (discussed below). Contrary to Mr Milchior's statement, there are two articles from 2011 that discuss Etam's re-launch into the UK market through its online website. The first is from

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<sup>17</sup> Exhibit PM8 and Exhibit PM11

<sup>18</sup> Pierre Milchior's witness statement, paragraph 26

<sup>19</sup> Exhibit PM9

<sup>20</sup> Ibid, page 91

<sup>21</sup> Exhibit PM6, pages 39-41

<sup>22</sup> Pierre Milchior's witness statement, paragraph 28

Harper's Bazaar, dated January 2011,<sup>23</sup> whilst the second is from the Mail Online, dated 23 June 2011.<sup>24</sup> In support of sales via online channels the opponent has provided evidence of Etam's website [www.etam.co.uk](http://www.etam.co.uk),<sup>25</sup> which show clothing goods for sale such as bras, pants, pajamas, sportswear and swimwear. The second earlier mark is prominent at the top of each page and the domain name indicates that the website targets UK consumers. However, the printouts were obtained on 8 February 2022, i.e. after the relevant period, and this evidence is otherwise undated. As a result, I am unable to take this evidence into account for my proof of use assessment. The opponent has also provided a screenshot of the website [www.int.etam.com/en/home](http://www.int.etam.com/en/home), obtained using the internet archive "Wayback Machine".<sup>26</sup> The screenshot is dated 25 September 2017 (within the relevant period); it shows the mark 'Etam Paris' and indicates that delivery can be selected for the UK along with 15+ other countries in Europe. However, there is no information confirming what goods are for sale, the other countries that the goods can be sold and delivered to, the number of internet users of the website, nor that anyone bought goods through this website in the form of relevant invoice evidence.

29. Mr Milchior explains that in 2018 Etam collaborated with the French brand Le Coq Sportif to launch two collections (one for yoga and one for running).<sup>27</sup> Printouts from the website [www.etam-groupe.com/en/temps\\_forts/etam-x-le-coq-sportif-2/](http://www.etam-groupe.com/en/temps_forts/etam-x-le-coq-sportif-2/) have been provided which evidences this collaboration and what appears to be promotion of the collaboration at the Etam live show in 2020.<sup>28</sup> What is not clear is how many sales were generated from this collaboration or what goods were sold under the second earlier mark as the picture only shows the mark on a box not on the goods themselves.

30. Mr Milchior states that since 2020, Etam have had 608 Etam points-of-sale around the EU including Russia and Switzerland.<sup>29</sup> It is unclear the exact points of sale solely for the EU territory, however, even taking into consideration that a proportion of those

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<sup>23</sup> Exhibit PM6, page 38

<sup>24</sup> Exhibit PM7

<sup>25</sup> Exhibit PM11

<sup>26</sup> Exhibit PM7, page 46

<sup>27</sup> Pierre Milchior's witness statement, paragraph 27

<sup>28</sup> Exhibit PM10

<sup>29</sup> Pierre Milchior's witness statement, paragraph 41

points-of-sale are likely to have been located in Russia and Switzerland, that still leaves a significant number of points-of-sale within the EU. The opponent also claims that in 2020 Etam held a 12% share of the lingerie market in France,<sup>30</sup> which is unchallenged.

31. Pierre Milchior provides a breakdown of the sales in the UK from 2017-2021, which it is claimed total €1,327,634,<sup>31</sup> as well as the sales for the whole of the EU which is said to amount to €2,568,012,000.<sup>32</sup> He explains in his witness statement that these sales cover the following territories: Austria, Benelux, Bulgaria, Czech Republic, Germany, Denmark, Estonia, Spain, Finland, France, United Kingdom, Greece, Ireland, Italy, Lithuania, Poland, Portugal, Sweden, Slovenia and Slovakia.<sup>33</sup> The geographical extent of the sales under the Etam mark in the UK is also provided.<sup>34</sup> The narrative evidence suggests that sales cover regions across the whole of the UK. Mr Milchior also provides the advertising figures for the UK and Europe from 2016-2021, which it is said equates to €2,993,000.<sup>35</sup> I am mindful that there is no direct evidence of sales, with the exception of one invoice that postdates the relevant period.<sup>36</sup> However, that said, I am aware that the narrative evidence has not been challenged by the applicant and these are not insignificant figures. Furthermore, the figures do not differentiate between those that relate to the goods in class 18 and those that relate to the goods in class 25. In relation to the invoice, it appears to be addressed to a customer in Tunbridge Wells. However, the invoice has not been translated and is dated 1 January 2022, postdating the relevant period. Moreover, there is no information included on the invoice regarding the number of items sold or what those items were. However, a value of €49.62 is provided, which appears to be for the amount for the entire invoice.

32. Mr Milchior states that Etam is present on all social media platforms<sup>37</sup> and provides direct evidence showing the opponent's mark on several of these, including

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<sup>30</sup> Pierre Milchior's witness statement, paragraph 41

<sup>31</sup> Pierre Milchior's witness statement, paragraph 32

<sup>32</sup> Pierre Milchior's witness statement, paragraph 34

<sup>33</sup> Ibid

<sup>34</sup> Pierre Milchior's witness statement, paragraph 35

<sup>35</sup> Pierre Milchior's witness statement, paragraph 33

<sup>36</sup> Exhibit PM12

<sup>37</sup> Pierre Milchior's witness statement, paragraph 37

Instagram, Snapchat, Facebook, Pinterest, Twitter and YouTube.<sup>38</sup> However, with the exception of the social media activity already acknowledged above (mainly Instagram) and Facebook evidence which confirms the creation of Etam's Facebook page on 15 April 2019, the evidence provided is dated outside the relevant period.

33. Mr Milchior says that the opponent owns several domain names with the word Etam included<sup>39</sup> and provides evidence of the ownership and creation of these domains. Of these, only three appear to have been created within the relevant period. These three appear to be domain names for the UK, the USA and Czech Republic. The opponent has also provided screenshots from some of these websites.<sup>40</sup> Although these screenshots clearly show the second earlier mark and references to the countries they target, they are undated. Furthermore, there is no information in relation to how many views these websites have had in the relevant period, or how many sales have been generated from these websites.

34. Mr Milchior claims that in 2018, Etam were elected best retailer and its spontaneous brand awareness was 91%. This is supported by printouts from Etam's website [www.etam-groupe.com](http://www.etam-groupe.com).<sup>41</sup> However, there is no information surrounding these claims. For example, there is no information about how many people were asked, what they were asked, who elected Etam best retailer, or on what basis.

35. I bear in mind that, although criticisms can be made of individual items of evidence, the registrar must stand back and take a view of the evidence in its entirety.<sup>42</sup> Whilst a breakdown of turnover and advertising figures for each of the goods relied upon has not been provided, the overall unchallenged sales figures under the Etam mark are over €2 billion<sup>43</sup> for the EU and UK within the relevant period and the overall unopposed advertising figures total around €2 million<sup>44</sup> for the same. These are far from insignificant sums; indeed, the unchallenged evidence is that the opponent holds

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<sup>38</sup> Exhibit PM13

<sup>39</sup> Pierre Milchior's witness statement, paragraph 38

<sup>40</sup> Exhibit PM14

<sup>41</sup> Exhibit PM15

<sup>42</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

<sup>43</sup> This figure consists of the EU figures within the relevant period before the Implementation Period completion date following the withdrawal agreement, i.e. from 14 April 2016 to 31 December 2020, and the UK figures from 1 January 2021 to the end of the relevant period, i.e. 13 April 2021.

<sup>44</sup> *Ibid*

a 12% share of the lingerie market in France, a country within the relevant territory. The evidence shows there is a large number of points-of-sales in the EU which supports the large sales figures above. The narrative evidence also suggests that the geographical extent of sales under the Etam mark spans most of the UK and many territories in the EU listed above. Whilst there is no exact breakdown of the EU sales figures, the total amount is so substantial that even if broken down proportionately the figure for each country would not be insignificant. Furthermore, despite there being no direct documentary sales evidence, I acknowledge that the narrative evidence remains unchallenged. There is evidence that the Etam brand held live shows for Paris fashion week annually within the relevant period, which were livestreamed on internet platforms and on a French television channel generating over 10 million views a year. At these events, the evidence suggests that Etam predominantly showcased lingerie, which resulted in a number of UK national publications referencing the brand and its lingerie goods each year. In addition, the Etam brand has also been referenced in international publications, such as, Euronews. The opponent has established use of its second earlier mark on its social media platforms Instagram and Facebook within the relevant period. During this time, there is evidence of regular Instagram activity promoting the goods relied upon, with the second earlier mark visible on many of the goods themselves or their labels. However, there are limitations to the social media evidence of these goods, such as, a lack of information regarding the sales generated from this social media activity, and the location of its followers. Even affording some weight to the live shows and social media evidence, there is a lack of direct evidence demonstrating exactly what goods were for sale within the relevant period as the printouts and screenshots of Etam's webpages are undated. Nevertheless, from the evidential picture overall, I am prepared to accept that Etam has attempted to create and maintain a market for its goods under the Etam mark within the EU and UK. Taking all the evidence as a whole into account, I am satisfied that the opponent has demonstrated genuine use of its second earlier mark within the EU and UK, within the relevant period.

*Form of the mark*

The logo for the brand Etam, featuring the word "Etam" in a stylized, italicized serif font.

photographed for social media and in photographs of Etam's live shows. In addition, there is a magazine publication from the opponent where this mark is present on the cover and subsequent pages. However, I note that on Etam's website, the mark appears with the word "Paris" written underneath, which does not form part of the registered mark. However, as the word "Paris" is descriptive of the geographical origin of the company, its impact is minimal as it would not be attributed any trade mark significance.<sup>45</sup> I remind myself that that 'use' of a mark encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark, provided it will be perceived as indicative of the origin of the goods or services.<sup>46</sup> In the context of the marks evidenced, the word "Etam" continues to be the indicator of economic origin. Equally, in publications, reference to the Etam brand appears in a word-only format. I acknowledge that figurative marks are not typically inserted into articles when referring to the names of brands. As such, I consider the evidenced marks to be acceptable variant use of the second earlier as registered.

### *Fair specification*

37. I must now consider whether, or the extent to which, the evidence shows use of the second earlier mark in relation to the goods relied upon. I must bear in mind that fair protection is not to be achieved by identifying and defining particular examples of goods for which there has been genuine use, but, rather, the particular categories of goods 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 for the goods and services concerned.<sup>47</sup> In arriving at a fair specification, I must consider how the average consumer would fairly describe the goods shown in evidence; the task is not to describe the use made by the earlier mark in the narrowest possible terms, unless that is what an average consumer would do. I remind myself that a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods covered by the registration.<sup>48</sup>

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<sup>45</sup> *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, paragraph 16

<sup>46</sup> *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

<sup>47</sup> *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10

<sup>48</sup> *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

The unchallenged evidence is that the opponent has a 12% share of the lingerie market in France. Whilst there is no evidence before me that pinpoints the exact monetary figure this would equate to, or a breakdown of the sales figures for these goods, I am prepared to accept that a significant proportion of the overall turnover figures result from sales of lingerie. This is because collectively the relevant evidence establishing use of the second earlier mark, such as evidence of fashion shows, social media activity and Etam's own published magazine, predominately relate to its lingerie. The national and international publications referring to the Etam brand also relate primarily to lingerie goods. In contrast, the evidence of use relating to other terms included within the opponent's specification, such as clothing, dresses, skirts, shorts; shirts, blouses, tee-shirts, sweat-shirts, vests, scarves, belts (clothing), pajamas, bathing suits, and bags, is much weaker. I have no evidence of the market share held by Etam in relation to these goods. I am unable to place weight on the website evidence showing the some of these goods for sale as they postdate the relevant period. Therefore, use of the mark on these goods is evidenced mainly through Etam's Instagram posts, which has its limitations. For example, (as discussed above) there is no evidence of where the followers are based, or the number of sales generated from the social media promotion of these goods. From the evidence before me, these goods were not typically promoted at the live fashion shows. These goods are not seen in the national and international publications. The evidence of use relating to footwear is also weak. In addition to the Instagram posts there is promotional evidence from the Etam website of sports footwear in reference to Etam's collaboration. However, this evidence is not supported by any links that would indicate the items can be bought. The number of potential consumers that would have viewed the site is also not clear. Similarly, footwear is also not particularly promoted at Etam's live fashion shows. For the remaining goods within the opponent's specification there is no evidence of use of the mark at all. Accordingly, for the reasons I have provided above, the use shown by the opponent overwhelmingly relates to lingerie. I am satisfied that the goods would be fairly described by the average consumer as lingerie which would be perceived as an identifiable sub-category within the broader term "clothing" relied upon by the opponent.

38. Therefore, taking all the above into account, I consider a fair specification of the second earlier mark to be:

Class 25: Lingerie

### **Section 5(2)(b)**

39. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

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

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

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

### **Case law**

40. I am guided by the following principles which 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.

### *My approach*

41. As a result of my findings above and the narrowing of the specification for the second earlier mark, the first earlier mark is broader in scope. Moreover, as a word-only registration, the first earlier mark is clearly more similar to the contested mark than the second earlier mark. Consequently, I will focus on the first earlier mark, which I believe to be the opponent's best case. However, I will return to consider the second earlier mark if it becomes necessary to do so.

### **Comparison of goods**

42. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

43. Put simply, this means that whether the goods or services are in the same or different classes is not decisive in determining whether they are similar or dissimilar. Therefore, what matters is the actual goods or services at issue and whether they are similar or not having regard to the case law that follows.

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

“In assessing the similarity of the goods or services concerned, [...] 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”.

45. 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.

46. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*,<sup>49</sup> the GC stated that:

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

47. Regarding the interpretation of terms in specifications, in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of

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<sup>49</sup> Case T-133/05

the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

48. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

49. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that ‘complementary’ means:

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

50. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he then was), sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes”,

whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

51. The goods to be compared are outlined below.

<b><i>Goods under the applicant's mark</i></b>	<b><i>Goods under the first earlier mark</i></b>
<u>Class 21</u> Cups; Containers for household or kitchen use; Bottles; Basins [bowls]; Cooking utensils, non-electric; Bottle openers, electric and non-electric; Works of art of porcelain, ceramic, earthenware or glass; Baby baths, portable; Syringes for watering flowers and plants; Combs; Brushes; Toothbrushes; Cosmetic utensils; Make-up removing appliances; Litter trays for pets; Cages for household pets; Ultrasonic mosquito repellents; Feeding vessels for pets.	
<u>Class 25</u> Clothes; Coats; Skirts; Topcoats; Uniforms; Vests; Trousers; Pyjamas; clothing; shoes; Hats; Hosiery; Scarfs; Gloves [clothing]; boots; Underwear; Pants.	<u>Class 25</u> Articles of clothing

Class 28

Games; Carnival masks; Toys; Toy models; Toy drones; Checkerboards; Balls for games; Body-building apparatus; Archery implements; Skateboards; Machines for physical exercises; Knee guards [sports articles]; Elbow guards [sports articles]; Ornaments for Christmas trees, except illumination articles and confectionery; Christmas trees of synthetic material; Fishing tackle; Yoga straps; Yoga blocks; Yoga swings.

Class 21

*Cups; Containers for household or kitchen use; Bottles; Basins [bowls]; Cooking utensils, non-electric; Bottle openers, electric and non-electric; Works of art of porcelain, ceramic, earthenware or glass; Syringes for watering flowers and plants;*

52. The opponent argues that the applicant's goods "*Containers for household or kitchen use; Bottles*" are similar to the opponent's goods as the "distribution channels can be the same, and [they] are customarily sold in the same shops and they can be complementary." In my opinion, the applicant's above terms all relate to kitchenware and gardening equipment which differ in nature, method of use, and intended purpose to "articles of clothing" in class 25 of the first earlier mark. The trade channels differ as clothes and kitchenware will be produced by different manufactures and are typically sold at different stores. In circumstances where they are sold in larger department stores or supermarkets, the goods are typically found in separate areas. The goods are not competitive as kitchenware is not a suitable substitute for clothing. Neither are they complementary in nature as one is not indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods lies with the

same undertaking. Although users may be the same this will be on a generalised level that does not engage similarity. As a result, I find these goods dissimilar.

*Baby baths, portable;*

53. The applicant's term "baby baths, portable" and the opponent's goods, "articles of clothing", are dissimilar. There is no overlap in nature, method of use or intended purpose between these goods as one is for bathing babies and the other is to be worn. The trade channels are also different as they are not typically offered by the same undertakings and even in circumstances where they are, such as in baby shops, they will be in different sections of those outlets. The goods are not complementary as baby baths are not indispensable or important to the use of clothing. Neither are the goods competitive in nature as clothing will not fulfil the need for a baby bath and vice versa. Users will overlap in the broad sense that users of the applicant's goods will also use clothes. However, that alone is not enough to engage similarity.

*Combs; Brushes; Toothbrushes; Cosmetic utensils; Make-up removing appliances;*

54. The applicant's above terms can be described as cosmetic appliances, either for the hair, face, body or teeth. These goods differ in nature and method of use to the opponent's clothing. They differ in intended purpose as the core purpose of clothing is to wear, whereas the core purpose of the applicant's goods is to assist the improvement of a person's appearance whether that be their hair, face, teeth, or body. The goods will have different distribution channels and will typically be sold in different stores. The goods are neither complementary as cosmetic appliances are not indispensable or important to clothing, nor competitive in nature as one cannot replace the other. Users will overlap only at a generalised level. Consequently, the goods are dissimilar.

*Litter trays for pets; Cages for household pets; Feeding vessels for pets; Ultrasonic mosquito repellents;*

55. Finally in class 21, the applicant's terms above all relate to items for pets and insect repellent. These goods differ in nature, method of use and intended purpose to the



opponent's class 25 goods which are to be worn. The trade channels also differ as the applied-for terms are not usually found in clothing stores. Furthermore, users will overlap only on a general level. The goods are neither competitive nor complementary. Therefore, I find that the goods are dissimilar.

## Class 25

### *Clothes; clothing*

56. Although the above terms and the opponent's term "articles of clothing" are expressed slightly differently, they describe the same goods. Therefore, I find that they are identical.

*Coats; Skirts; Topcoats; Uniforms; Vests; Trousers; Pyjamas; Hosiery; Gloves [clothing]; Underwear; Pants.*

57. The applicant's terms above, being particular examples of clothing, are encompassed by the opponent's broader term "articles of clothing" and, as such, I find that the respective goods are *Merit* identical.

### *Shoes; boots*

58. The applied-for terms above can be described as footwear. These goods are different in nature to the opponent's "articles of clothing", as footwear is usually made of different material to clothing in order to protect the feet outdoors. The method of use will differ as the applicant's goods are to be worn on the feet whereas the opponent's goods are to be worn on the body. However, the intended purpose will overlap as both the respective goods are for covering the body/feet for practical purposes. The goods will overlap in producer and trade distribution channels as the goods will be sold in the same shops. They will also be purchased by the same users. The goods are not complementary as one is not indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods lies with the same undertaking. Neither are the goods competitive in nature as shoes will not satisfy the need for clothing to cover the body and vice versa. Overall, I find that the goods are similar to a medium degree.

### *Hats*

59. The applicant's above term and the opponent's class 25 term "articles of clothing" overlap in nature and intended purpose, as they can be made from similar materials and are both worn on the body for practical purposes, such as to cover the body or to keep warm. Method of use will differ as one is specifically intended to be worn on the head whereas the other is worn on the body. The goods are not competitive in nature as a hat designed for a person's head cannot be worn elsewhere. Neither are the goods complementary in nature as although they may be offered by the same undertakings, one is not indispensable or important for the use of the other. The goods will reach the market through the same trade channels, and users will be the same. Taking everything into account, I find that the goods are similar to a medium degree.

### *Scarfs*

60. Unlike clothes more generally, scarves have a specific function, i.e. to cover the neck. However, the goods overlap in nature, method of use and intended purpose to the extent that they are both worn for the practical purpose of covering the body. Typically, they are found at the same retail outlets and consumers would expect stores that sold items of clothing to also offer scarves. It is also reasonable to expect the same manufacturers and designers to produce both clothing and scarves. Users will be the same. However, the goods are not competitive in nature, as a scarf will not be sufficient for covering the body other than the neck. Neither are the goods complementary, as one is not indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods lies with the same undertaking. Accordingly, I find that the goods are similar to a medium degree.

### Class 28

*Balls for games; Body-building apparatus; Archery implements; Skateboards; Machines for physical exercises; Knee guards [sports articles]; Elbow guards [sports articles]; Yoga straps; Yoga blocks; Yoga swings; Fishing tackle*

61. The opponent has referred to two EUIPO cases within its submissions, one from the Opposition Division and the other from the Board of Appeal.<sup>50</sup> I keep in mind, that although EU cases are persuasive, I am not bound by these decisions. Especially as the comparisons are not a direct parallel to the goods I must consider. The opponent's term "articles of clothing" would include sportswear. I consider sportswear and the applicants terms above to be different in nature and method of use as clothing is to be worn for the purpose of covering the body whereas sporting articles and equipment are used for participating in sport or exercise. There is an overlap in intended purpose to the extent that they are both used for sport, however, this is rather limited. Furthermore, the goods will target the same consumers and may overlap in distribution channels as both may be sold in sporting stores. The goods are not competitive in nature as sportswear cannot replace the need for sporting equipment. Neither are the goods complementary as one is not indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods lies with the same undertaking. Overall, I find that the goods are similar to a low degree.

*Games; Toys; Toy models; Toy drones; Checkerboards*

62. The applicant's above terms can be broadly described as games and toys. I consider that the opponent's "articles of clothing" and the applicant's goods differ in nature, method of use and intended purpose as one is for wearing and the other is for playing. The goods have different distribution channels and users only overlap in a general sense. The goods are not in competition as games or toys cannot relieve the need for clothing. Furthermore, the goods are not complementary as clothing is not indispensable or important for playing with games or toys. Consequently, I find that the goods are dissimilar.

*Carnival masks*

63. The applicant's term "carnival masks" and the opponent's goods overlap in nature to the extent that they are both worn, however, this is very general. The goods differ in method of use and intended purpose as carnival masks are worn on the

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<sup>50</sup> Opponent's written submissions, paragraphs 3.12 and 3.14.

face specifically for carnivals, whereas clothes are for daily use and worn on the body. The goods are not typically found in the same retail establishments as clothing is found in clothing stores whereas carnival masks will be offered at specialist event/costume stores. Neither are the goods complementary or competitive in nature. Users will be the same but only on a generalised level. Overall, taking everything above into account, I find that the goods are dissimilar.

*Ornaments for Christmas trees, except illumination articles and confectionery; Christmas trees of synthetic material*

64. The applicant's above terms and the opponent's goods differ in nature, method of use, intended purpose and trade distribution channels. The goods are neither complementary nor competitive in nature. Furthermore, users overlap only in a broad sense which fails to engage any similarity. As a result, I find that the goods are dissimilar.

65. As some degree of similarity between the goods is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition must fail against goods of the application that I have found to be dissimilar, namely:<sup>51</sup>

Class 21: Cups; Containers for household or kitchen use; Bottles; Basins [bowls]; Cooking utensils, non-electric; Bottle openers, electric and non-electric; Works of art of porcelain, ceramic, earthenware or glass; Baby baths, portable; Syringes for watering flowers and plants; Combs; Brushes; Toothbrushes; Cosmetic utensils; Make-up removing appliances; Litter trays for pets; Cages for household pets; Ultrasonic mosquito repellents; Feeding vessels for pets.

Class 28: Carnival masks; Games; Toys; Toy models; Toy drones; Checkerboards; Ornaments for Christmas trees, except illumination articles and confectionery; Christmas trees of synthetic material

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<sup>51</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49.

## **The average consumer and the nature of the purchasing act**

66. 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.

67. 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. (as he then was) 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.”

68. I find that the average consumer of the goods at issue will be a member of the general public. The cost of the goods is likely to vary, from an inexpensive pair of socks to a more expensive piece of sporting equipment. On average, consumers are likely to purchase clothing rather frequently and sporting articles or sporting equipment more occasionally. I find that the purchasing process is likely to be fairly casual in relation to class 25 goods, however, consideration will be given to the materials used, the fit, the aesthetic appearance and the durability of the goods. In relation to goods in class 28 the purchasing process will be more careful than casual with consideration given to the cost, quality and durability. Taking the above factors into account, I find that, overall, consumers will demonstrate an average level of attention in respect of these goods. The goods are likely to be obtained through retail outlets, their online equivalents or via a catalogue. Overall, I am of

the view that visual considerations would dominate the purchasing process. However, I do not discount aural considerations entirely as it is possible that the purchasing of these kinds of goods would involve discussions with sales assistants.

### Comparison of the marks

69. It is clear from *Sabel BV v. Puma AG*<sup>52</sup> that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. [...] 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.”

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

71. The respective trade marks are shown below:

First earlier mark	Contested mark
ETAM	Etaa

<sup>52</sup> Case C-251/95, paragraph 23

### Overall impressions

72. The first earlier mark is in word-only format and encompasses the word “ETAM” in upper case. Given that it is the only element of the mark, the overall impression lies in the word itself.

73. As for the contested mark, it is also in word-only format and consists of the word “Etaa”. The word is not stylised and there are no other components to the mark. As such, the overall impression of the mark lies in the word itself.

### Visual comparison

74. The competing marks are similar as they are both in word-only format and are the same length, both consisting of four letters. Furthermore, the respective marks consist of the same first three letters, “ETA” with only the last letter differing. This similarity appears at the beginning of the respective marks, a position which is generally considered to have more impact on UK consumers.<sup>53</sup> I do not consider the distinction in letter case between the first earlier mark and the contested mark to be a point of significant difference between them. This is because the registration of word-only marks provides protection for the word itself, irrespective of whether it is presented in upper or lower case. The competing marks are visually different in that the first earlier mark ends with the letter “M” whereas the contested mark ends with the letter “a”. Taking into account the overall impressions, I find that the competing marks are visually similar to a high degree.

### Aural comparison

75. The first earlier mark and the contested mark both comprise two syllables, i.e. “ET-AM” and “ET-AA”, respectively. The first syllable is identical, with the only difference resulting from the sounds of the last letters of the respective marks.

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<sup>53</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Overall, I find that there is between a medium and high degree of aural similarity between the marks.

### Conceptual comparison

76. The opponent contends that “none of the signs has a meaning in the relevant language”.<sup>54</sup> I have no submissions from the applicant as to whether either of the marks will convey any meaning to consumers. However, I agree that the marks appear to have no clear meaning and would, therefore, be perceived as invented words. As a result, I find that the marks are conceptually neutral.

### **Distinctive character of the earlier mark**

77. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. 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 *Windsurfing Chiemsee 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

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<sup>54</sup> Opponent’s written submissions, paragraph 4.9



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).”

78. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Dictionary words which do not allude to the goods will be somewhere in between. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion, the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced by virtue of use on the market.

79. As the first earlier mark is comprised of one plain word with no other elements, its distinctiveness lies indivisibly in the word itself. Furthermore, the word “ETAM” has no clear and obvious meaning within the English language and will, therefore, be perceived by consumers as an invented word. Consequently, the first earlier mark possesses a high level of inherent distinctive character.

80. Evidence of use has been filed by the opponent and I am now required to assess whether the opponent has demonstrated that the first earlier mark has an enhanced degree of distinctive character at the relevant date. The opponent claims that it has,<sup>55</sup> whereas I have no comments from the applicant on the matter.

81. The evidence shows that the first earlier mark has been used sporadically in the UK for decades. This is evidenced through its social media activity, the opponent’s own brochure, its online website which gives a timeline of the Etam brand, and

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<sup>55</sup> Opponent’s written submissions, paragraphs 5.13.

certain online national publications which demonstrate the extent of the mark's exposure. Furthermore, the sales evidence shows UK sales have totalled over €1 million within the relevant period, with a steady increase of sales year on year. I also have evidence of the EU advertising and promotional expenditure, however that figure is not broken down for the UK. The evidence shows that the opponent's customer-base is geographically spread across the UK. I find the turnover figures respectable. However, no specific details as to the size of the relevant market in the UK have been provided and I have no evidence or submissions from the opponent in relation to the UK market share for lingerie held by the first earlier mark. There is also no information regarding the number of internet users which have accessed the online sites or the user's location. In relation specifically to the social media activity provided, there is no evidence of the number of followers/subscribers or again their location. Taking into account the evidential picture as a whole, on balance, the evidence before me does not support a finding that the distinctiveness of the first earlier mark has been enhanced by virtue of use. Furthermore, even if it has, it would be unlikely to make a material difference to the outcome of the opponent's claim as I have already found the first earlier mark to be inherently highly distinctive.

### **Likelihood of confusion**

82. Whether there is a likelihood of confusion must be assessed globally, taking into account a number of factors. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. It is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be aware of the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

83. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where

the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

84. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C. (as he then was), 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).”

85. These examples are not exhaustive but provide helpful focus.

86. I have found that the applicant’s goods are either identical or similar to between a low and medium degree to the goods of the first earlier mark. I have found that the average consumer of the goods will be the general public who will pay an average level of attention. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations. The overall impression of the contested marks lies in their respective words, i.e. “ETAM” and “Etaa. I have found that the first earlier mark and the contested mark are visually similar to a high degree, aurally similar to between a medium and high degree and conceptually neutral. I have also found that the first earlier mark possesses a high degree of inherent distinctive character.

87. I acknowledge that there are differences between the marks. The first earlier mark ends with the letter “M” and the contested mark ends with the letter “a”. However, the marks are both word-only marks and they are identical in length, both consisting of four letters. The first three letters in each of the marks are identical, as discussed above, this is a position that is considered to have more of an impact on UK consumers. Furthermore, I do not consider the distinction in letter case between the competing marks to be a point of significant difference between them. As previously explained, the registration of word-only marks (such as the first earlier mark) provides protection for the word itself, irrespective of whether it is presented in upper or lower case. Aurally, the first syllable of the competing marks is identical and the only difference in the second syllable results from the different last letter in the respective marks. Furthermore, as both marks are invented words there is no conceptual hook to help consumers distinguish between the marks. I recognise that the marks only consist of four letters. However, I bear in mind the comments of Mr James Mellor Q.C. (as he was then), sitting as the appointed

person in *Robert Bosch GmbH v Bosco Brands Limited*,<sup>56</sup> where he said, “there are no special tests which apply to ‘short’ marks [...] In reality, the tribunal simply has to apply the well-established propositions for assessing the visual, aural and conceptual similarities.” Taking into account the overall levels of similarity between the marks, the aforementioned difference in the last letter is likely to be insufficient to distinguish the marks from one another. In my judgement, taking into consideration imperfect recollection, it is highly likely that consumers, paying no more than an average level of attention during the purchasing process, would misremember the marks for one another, and fail to recall the differences; especially as the earlier mark has a high level of distinctive character. Consequently, I find that there is a likelihood of direct confusion for goods which I have found to be similar to at least a medium degree. However, where I have found that the goods are similar to only a low degree, I consider that the differences between the goods will offset the similarities between the marks under the principle of interdependency.

88. As I have found a likelihood of confusion based upon the first earlier mark it is not necessary to go on to consider the opponent’s reliance on the second earlier mark. In my view, consideration of the second earlier mark would not improve the opponent’s position in respect of the goods for which I have found no likelihood of confusion, since the specification is narrower and the marks are less similar.

### **Conclusion**

89. The opposition under section 5(2)(b) of the Act has been partially successful. Subject to any appeal against my decision, the application will be refused in respect of the following goods:

Class 25: Clothes; Coats; Skirts; Topcoats; Uniforms; Vests; Trousers; Pyjamas; clothing; shoes; Hats; Hosiery; Scarfs; Gloves [clothing]; boots; Underwear; Pants.

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<sup>56</sup> BL O/301/20, paragraph 43

90. The application will proceed to registration in the UK in relation to the following goods, against which the opposition has failed:

Class 21: Cups; Containers for household or kitchen use; Bottles; Basins [bowls]; Cooking utensils, non-electric; Bottle openers, electric and non-electric; Works of art of porcelain, ceramic, earthenware or glass; Baby baths, portable; Syringes for watering flowers and plants; Combs; Brushes; Toothbrushes; Cosmetic utensils; Make-up removing appliances; Litter trays for pets; Cages for household pets; Ultrasonic mosquito repellents; Feeding vessels for pets.

Class 28: Games; Carnival masks; Toys; Toy models; Toy drones; Checkerboards; Balls for games; Body-building apparatus; Archery implements; Skateboards; Machines for physical exercises; Knee guards [sports articles]; Elbow guards [sports articles]; Ornaments for Christmas trees, except illumination articles and confectionery; Christmas trees of synthetic material; Fishing tackle; Yoga straps; Yoga blocks; Yoga swings.

### **Costs**

91. Both parties have been successful in part, however the applicant has enjoyed a greater measure of success. Therefore, the applicant is entitled to a contribution towards their costs based upon the scale published in Annex A of Tribunal Practice Notice 2 of 2016, with an appropriate reduction to reflect the opponent's degree of success. Applying this guidance, in the circumstances I award the applicant the sum of **£250** as a contribution toward the costs of reviewing the opponent's notice of opposition and preparing a counterstatement.

92. Accordingly, I hereby order ETAM to pay Xiamen Qiuji Trading Co., Ltd. the sum of **£250**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 25<sup>th</sup> day of November 2022**

**Sarah Wallace**  
**For the Registrar**