

**0/030/18**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION No. 3115154**

**BY ALTEREGO RETAIL GROUP LIMITED**

**AND**

**OPPOSITION No. 405288**



**BY RETAIL ROYALTY COMPANY**

## Background and pleadings

1. This is an opposition by Retail Royalty Company (“the opponent”) to an application filed on 26<sup>th</sup> June 2015 (“the relevant date”) by Alterego Retail Group Limited (“the applicant”) to register the mark shown below in classes 14, 18, 24 and 25.



2. The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The s.5(2)(b) ground is based on the opponent’s earlier marks, as shown below.

Number	Mark	Classes	Filing and registration dates
EUTM 13945233	AE	3, 18, 25 and 35	13 April 2015 and 25 September 2015
UK 2532738	AE	18, 25 and 35	13 April 2005 and 30 April 2010
EUTM 4901931		18, 25 and 42	15 February 2006 and 12 January 2007
EUTM 5194907		9, 18, 25 and 42	12 July 2006 and 29 April 2011

3. According to the opponent, the earlier marks are similar to the contested mark and are registered in relation to identical or similar goods/services. Therefore, there is a likelihood of confusion on the part of the public.

4. The s.5(3) ground is based upon the first two marks in the above table, i.e. the letters AE alone. According to the opponent, these earlier marks have acquired a reputation in the UK (and EU) and use of the contested mark, without due cause, would take unfair advantage of, and/or be detrimental to, the distinctive character or repute of the earlier AE marks.

5. The s.5(4)(a) ground is based upon the opponent's claim that it has used the sign AE since 2006 in the UK on key rings, wrist bands, leather goods, bags, wallets, purses, umbrellas, pet apparel, pet clothing, pet collars, leashes; towels; clothing, footwear and headgear. The opponent claims that use of the contested mark would amount to a misrepresentation to the public which would damage the goodwill in the opponent's business. Consequently, use of the mark would be prohibited under the law of passing off.

6. The applicant filed a counterstatement denying the claims.

7. The matter came before a different Hearing Officer on 16<sup>th</sup> September 2016 ("the original Hearing Officer"). The original Hearing Officer instructed herself by reference to, inter alia, the following passage from the Court of Appeal's judgment in *J.W. Spear & Sons Ltd & others v. Zynga Inc.*<sup>1</sup> (Floyd LJ giving judgment) that where there is no overall similarity between the competing marks, there is no need to assess whether there is a likelihood of confusion:

"58. Thus I do not consider that any of these cases provides direct authority which suggests that there is a minimum threshold of similarity. The cases suggest instead that overall similarity is a binary question. Where there is some overall similarity, even faint, then it is necessary to carry out the global assessment, taking account of all relevant circumstances. Moreover, in such cases, the enhanced distinctive character of the mark may play a role in increasing the likelihood of confusion.

---

<sup>1</sup> [2015] EWCA Civ 290

59. On the other hand the cases do show that the General Court has said that where there is (a) average visual and phonetic similarity, but no conceptual similarity (*Wesergold*), or (b) a number of visual and phonetic features which precluded the signs from being perceived as similar (*Ferrero*), or (c) no visual or phonetic similarity but a low degree of conceptual similarity (*Lufthansa*), or (d) a common suffix (*Kaul*), there may yet be no similarity overall between mark and sign. I have no difficulty with these conclusions: it is only overall similarity which counts.

60. Thus I would summarise the position in the following way:

i) The court should assess the phonetic, visual and conceptual similarity of mark and sign and decide whether, overall, mark and sign would be perceived as having any similarity by the average consumer.

ii) If no overall similarity at all would be perceived, the court would be justified in declining to go on and consider the likelihood of confusion applying the global appreciation test, as Article 9(1)(b) is conditional on the existence of some similarity. Such situations are not likely to occur often in contested litigation, but where they do occur, it is not legitimate to take account of any enhanced reputation or recognition of the mark.

iii) Where the average consumer would perceive some overall similarity, however faint, the court must go on to conduct the global appreciation test for the likelihood of confusion, taking account where appropriate of any enhanced reputation or recognition of the mark.

iv) In conducting the global appreciation test the court must take forward its assessment of the degree of similarity perceived by the average consumer between mark and sign."

8. The original Hearing Officer found that the earlier marks would not be perceived as representing the letters AE at all. She therefore found that there was no overall

similarity between the marks. Accordingly, she rejected the ground of opposition based on s.5(2)(b) of the Act. For similar reasons, she also rejected the grounds of opposition based on s.5(3) and s.5(4)(a) of the Act.

9. The opponent appealed to the Appointed Person. The appeal came before Mr Daniel Alexander QC. Mr Alexander issued his decision on 28<sup>th</sup> September 2017.<sup>2</sup> The key part of the Appointed Person's decision is re-produced below.

“28. In cases where there is real ambiguity as to how a mark may be perceived, which is possible in this case, it is legitimate, in my view, to have regard to the range of ways in which the mark could reasonably be regarded by a reasonably observant average consumer in considering the issue of similarity.

29. I have no doubt that the hearing officer was right in her description of one way in which the mark could be and would be perceived. To my mind, to the extent that it has a verbal content, the mark more naturally appears as an “EE” double letter in a logo form and, even if it is viewed as a combination of As and Es, these would not necessarily be viewed in the specific order, A-E, of the opponent's mark or even limited to two letters (as in of the opponent's mark).

30. However, I am not persuaded that the matter can rest there. In my view in this case, the hearing officer fell into error in leaving out of account the fact that the applicant's mark could also readily be read as an AE mark, was in fact intended to be read as a stylised form of AE (with a negative reflection) and was taken to be such albeit by the UKIPO in its registration classification process. That in my judgment leads to there being a degree of similarity with the opponent's earlier registration, even though not all actual consumers would take it in that way.

---

<sup>2</sup> BL O/468/17

31. In my judgment, in cases where a disputed mark is genuinely ambiguous in the message it sends and where, if is viewed in one of those ways, it would be identical to the earlier mark in the message it conveys, that is a factor of which account can and should be taken in evaluating both whether it is similar and whether there is, as a result, a material likelihood of confusion. I am not satisfied that the hearing officer did so in this case and that led to a finding of no similarity in the marks when it should have led to a finding of some, albeit limited, similarity between the respective marks (in the sense that, to some, it would have appeared as highly similar). Of course, a finding of this sort of similarity – which might loosely be described as “similarity by ambiguous denotation or connotation” would not automatically lead to a finding that there was a likelihood of confusion for some or all of the goods in question, not least because the mark in question may only be slightly ambiguous and the likelihood of an average consumer being confused may be correspondingly low. Nonetheless, the *Scrabble/Scramble* case suggests that, in such a situation, it is appropriate to conduct an evaluation of likelihood of confusion where any sort of similarity is found.”

32. -

33. The hearing officer did not evaluate of the likelihood of confusion with respect to any of the goods for which the applicant’s mark was proposed to be registered, which is required even if the degree of similarity is modest. The appellant contends that I should make the evaluation.

34. Although it would be open to me to do so and there are advantages in that course of the kind alluded to in the judgments of Floyd LJ in the Court of Appeal in *Scrabble/Scramble*, the difficulty in this case is that I do not have the benefit of any factual findings of the hearing officer as to either:

- a. the similarity or identity of all the goods in issue; or
- b. the reputation of the earlier mark with respect to particular goods (which may affect the case with respect to different goods in different classes differently) and which may affect the perception of the average

consumer.

35. It would be possible to make such findings for the first time but since likelihood of confusion is the critical issue in the case and the respective marks appear to be core marks for the parties and their respective businesses, in my view it would be appropriate not to deprive the parties of a right of appeal on this issue by simply determining the question of likelihood of confusion myself, even though that may provide greater speed of resolution and probably lower cost. It is possible that a hearing officer may determine that, despite this decision, the likelihood of confusion was insufficient to refuse registration or that such was only warranted for a limited class of goods. Moreover, in cases of this kind the mere fact that an earlier mark enjoys a reputation does not necessarily mean that confusion is more likely. There are fine judgments to be made here and the primary body for making them is the Registrar.

36. I therefore consider that right course is to remit the case to a different hearing officer to consider the issue of whether such similarity as there may be between the marks (on the basis I have outlined) leads to a likelihood of confusion and, if so, for which, if any, goods. He or she may also consider whether (if it is necessary to do so) the mark should be refused under section 5(3) or 5(4)(a) as well. Although it would be for the hearing officer to decide how this should best be done, it seems to me that it would be appropriate for this to be a paper exercise relying on the submissions made previously.”

10. The opponent exercised its right to be heard again before a decision was taken on the merits of the opposition. Thus the matter came before me on 21<sup>st</sup> December 2017. As before, the opponent was represented by Mr Matthew Dick of D Young & Co, Chartered Trade Mark Attorneys. The applicant was not represented but filed written submissions in lieu of attendance.

## The evidence

11. Only the opponent filed evidence. This consists of a witness statement by Esta Cohen, the opponent's Vice President. Ms Cohen explains that the opponent is a US company and a subsidiary of American Eagle Outfitters, inc. The latter offers "*high-quality, on-trend clothing, accessories and personal care products at affordable prices.*" According to Ms Cohen, in 2014 the opponent's AMERICAN EAGLE brand was named as the No.2 preferred clothing brand and No.7 preferred shopping website in the USA. The opponent first started using the AE mark in the UK/EU in 2006 in relation to goods "*such as clothing*" via the website [www.ae.com](http://www.ae.com). In 2012, the opponent opened a retail store in Poland. In November 2014, it opened a store in London. By the date of Ms Cohen's statement in April 2016, the opponent had three stores in the UK in Westfield shopping centres in London and Stratford and Bluewater, Kent.

12. There are no pictures of the frontage, or any other signage, of these stores in evidence, except rather oddly, a photograph of the base of a clothing display stand. The letters 'AE – EST 1977' are embossed on the stand in the same colour as the base itself (black) making it hard to read, at least on the photograph.<sup>3</sup> Ms Cohen also provides a copy of a shopping bag used in the stores. This is shown below.



---

<sup>3</sup> See exhibit EC4



As can be seen, the bags are prominently branded with the device of an American eagle and the words AMERICAN EAGLE OUTFITTERS. However, the letters ae.com appear on the side of the bag beneath another iteration of the word mark.

13. Ms Cohen states that *“many clothing items and other products sold by the opponent within the UK, whether online or in-store, feature the AE mark on their swing tags in the form of an AE website address.”* She provides some examples, one of which is shown below.<sup>4</sup>

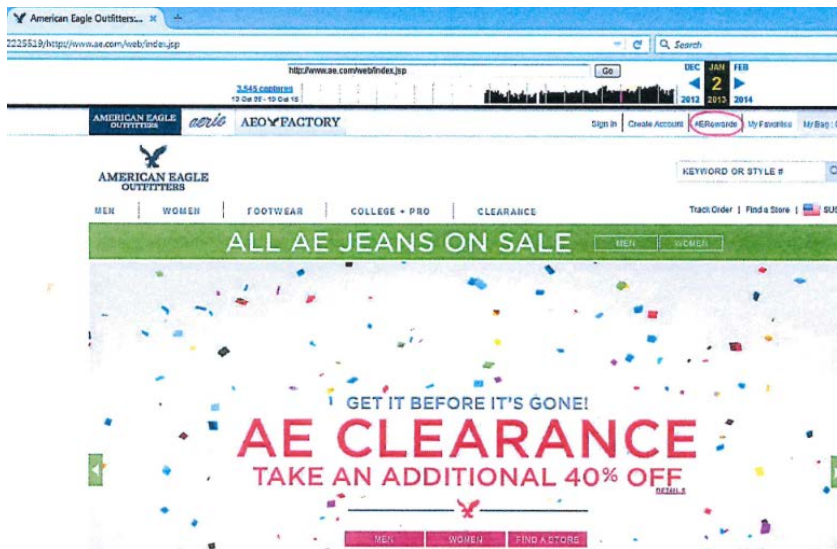


14. Ms Cohen claims that *“every sale conducted through the AE website to UK consumers is made under the opponent’s AE mark as it features in the domain name and elsewhere throughout the website.”* Numerous examples of pages from the ae.com website between 2006 and 2015 are in evidence.<sup>5</sup> Many of these have been obtained using the Wayback machine. The following example from 2013 appears to be typical of the home page.

---

<sup>4</sup> See EC7

<sup>5</sup> See EC5, EC6 and EC8



As can be seen, this particular page also contains an advertisement for an 'AE Clearance' sale. It can be seen that there is a customer reward scheme called AERewards. The letters AE and ae.com, along with AEO, AMERICAN EAGLE OUTFITTERS and the device of an American eagle were listed across the bottom of the home page around this time.<sup>6</sup>

15. The products shown on the website include clothing, hats, footwear, watches, jewellery, bags, wallets, belts, and sunglasses.<sup>7</sup> The letters AE sometimes appear on the goods themselves, usually on baseball hats, beanies, casual trousers, shorts and tops.<sup>8</sup>

16. All the prices on the opponent's website are shown in \$US. However, Ms Cohen provides copies of 27 invoices dated between 2009 and 2014 addressed to UK customers, which she says are just a representative sample of a larger number. All the prices are in \$US, but the products appear to have been delivered to the UK. According to Ms Cohen all the products with style numbers related to products which bore the AE mark. All the products listed have style numbers. The products are mostly clothing. The invoices record the 'Brand' in each case as being AEO.

---

<sup>6</sup> See EC6, page 96

<sup>7</sup> See EC5, EC6 & EC8

<sup>8</sup> See EC8 and EC9

17. Ms Cohen provided UK sales figures for 2006 to 2015.<sup>9</sup> However, these are subject to a confidentiality order. The public version of this decision will be redacted accordingly. [

REDACTED

] Some of the opponent's goods were re-sold on eBay in £ sterling.<sup>10</sup> Ms Cohen also provides figures for worldwide advertising expenditure under the AE mark. These are also subject to a confidentiality order. However, as they are not specific to the UK or EU there is no need for me to say anything more about them.

18. According to Ms Cohen, there were over 4m visits from the UK to the opponent's ae.com website between 2011 and 2015. In 2012 mail shots featuring the AE mark were sent to all UK customers on the opponent's mailing list. Ms Cohen does not say how many customers this was. By the date of her statement in 2016, there were 36k UK customers on the list. Between November 2014 and October 2015, over 18k consumers within the UK signed up to receive mail shots from the opponent. I note that this coincided with the opening of the opponent's first retail store in the UK.

19. Ms Cohen says that advertising of the AE mark has been extensive in the UK since the opening of the opponent's flagship store in 2014. According to her *"Over 856 million PR impressions have been logged over 120 outlets; over 12.1 million mall media impressions have been logged; and over 4 million impressions have been logged via the AE-branded, UK-specific Facebook, Instagram and Twitter accounts."* I do not understand what any of this means.

20. Ms Cohen provides copies of the opponent's social media sites Twitter, Instagram, Pinterest, Google+ and Wanelo together with the number of followers.<sup>11</sup> Apparently, the opponent has 46k UK followers on a separate UK Twitter account

---

<sup>9</sup> See EC11

<sup>10</sup> See EC12

<sup>11</sup> See EC20

and 87k followers of UK pages of Pinterest site. However, this was in 2016 and therefore after the relevant date.

21. However. Ms Cohen also provides some screen shots from the opponent's Facebook pages from 2010 to 2015 which she says shows use of the AE mark, including by Facebook users from the EU who refer to the brand as AE.<sup>12</sup> These pages do indeed show use of the AE mark (i.e. 'AE jeans', 'AE Spring catalogue'), but always in the context of more prominent branding for AMERICAN EAGLE OUTFITTERS. The only customers that are clearly based in the UK (or the EU) and who left comments on Facebook in November 2014 asking about the opening of "AE" stores. In context, that was obviously shorthand for American Eagle.

22. Finally, Ms Cohen provides the names of various celebrities that have endorsed the opponent's products or been photographed wearing them. She exhibits pages from a website called coolspotters.com showing Mila Kunis, Emma Roberts, Selena Gomez and Miley Cyrus wearing AE clothing. However, these pages are from October 2015 (i.e. after the relevant date) and it is not clear how many (if any) of the UK (or EU) public would have seen them. There are also photographs from 2011 said to show Emma Rossum and Justin Bieber wearing the opponent's products in the USA. These come from the opponent's own American Eagle Outfitters Facebook page.

### **The correct starting point for this decision**

23. There was some discussion at the hearing as to the extent to which I am bound by findings of the original Hearing Officer and/or the Appointed Person. In particular, whether I was bound to start from the premise that the respective goods/services are identical or highly similar. The original Hearing Officer stated that some of the goods were clearly identical and that for reasons of procedural economy she would proceed on the "*assumption*" that all the goods/services were identical or highly similar. The Appointed Person noted in paragraph 3 of his decision that the opponent relied on a number of earlier marks including "*...a registration for the mark AE in respect of*

---

<sup>12</sup> See EC19

*kinds of goods which were rightly held to be identical or very similar to the goods in the applicant's registration.*" However, as I have explained, the original Hearing Officer did not make any findings as to the identity or similarity of the goods/services. Despite what he said in paragraph 3 of his decision, the Appointed Person clearly appreciated that because in paragraph 34 of his decision he cited the absence of findings about the similarity between the goods/services as one of the reasons why he could not evaluate the likelihood of confusion on appeal. It follows that it is for me to decide that matter as part of my re-assessment of the opposition.

24. There was also some discussion at the hearing as to whether I was bound to adopt the Appointed Person's evaluation of the degree of similarity between the marks. In particular, Mr Dick submitted that the Appointed Person's statement in paragraph 31 of his decision that *"...where a disputed mark is genuinely ambiguous in the message it sends and where, if is viewed in one of those ways, it would be identical to the earlier mark in the message it conveys"*, required me to find that the AE marks are identical to the contested mark, or highly similar, at least to those consumers who see the letters AE in the contested mark. The Appointed Person did indeed say that the resemblance between the marks *"...should have led to a finding of some, albeit limited, similarity between the respective marks (in the sense that, to some, it would have appeared as highly similar)."* However, he then explained what he meant by this in saying *"Of course, a finding of this sort of similarity – which might loosely be described as "similarity by ambiguous denotation or connotation" would not automatically lead to a finding that there was a likelihood of confusion for some or all of the goods in question, not least because the mark in question may only be slightly ambiguous and the likelihood of an average consumer being confused may be correspondingly low."*

25. I think it is clear from this last sentence of the decision that the Appointed Person was not directing the registrar to evaluate the likelihood of confusion on the basis that those consumers who see the letters AE in the contested mark will therefore see the marks as highly similar overall. He was simply saying that to those who see the letters AE in the contested mark, the verbal elements of the marks will be the same. I will therefore start my assessment from the position that the Appointed Person has held that there is some similarity between the marks and that it is for me to assess

what impact this has on the likelihood of confusion etc. bearing in mind what he said about the respective marks having “*similarity by ambiguous denotation or connotation*” to “*some*” consumers.

### **Opposition under section 5(2)(b)**

26. Section 5(2)(b) of the Act is 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”.

### Comparison of goods and services

27. The opponent relies on four earlier marks. The applicant has not put the opponent to proof of use of any of the marks. However, the opponent’s best case is plainly based on the two earlier registrations for the letters AE *per se*. Of these, EUTM 13945233 is registered for the widest specification. It is therefore convenient to base my assessment on this earlier trade mark.

28. The specification of goods for the contested mark is set out in Annex A. It is unusually long, detailed and repetitive. This is probably because the applicant is not legally represented and unfamiliar with normal classification practice. For the sake of brevity and clarity I have substituted my own summary of the applicant’s goods in the following comparison.

<b>Goods covered by contested mark</b>	<b>Goods/services covered by earlier trade mark</b>
<p>Class 3: None</p> <p>Class 14: Jewellery; imitation and costume jewellery; gemstones (previous, semi-precious or non-precious); articles for making up into jewellery; body-piercing rings and studs; watches and bands and straps therefor; cases and boxes for watches and jewellery; decorative boxes; trinkets and charms; figurines of precious metals or stones; sculptures being works of art; tie-pins and cuff links.</p> <p>Class 18: Bags, cases, wallets, pouches, holders and purses; backpacks; beach umbrellas; bits, blankets, collars, coverings, masks and clothing, all for animals; cane handles; skins (furs); whips; covers and carriers for clothes; umbrellas and parasols.</p> <p>Class 24: Bathroom linen, sheets and towels; Bedding: blankets; handkerchiefs; napkins, cloth labels; household textiles; mats and cloths; fabrics; flags; textile labels; materials for making into clothing; window covers made from textiles.</p>	<p>Class 3: Fragrances; toiletries for the care and cleaning of the hair and skin; cosmetics.</p> <p>Class 14: None</p> <p>Class 18: Bags; handbags; backpacks; umbrellas; wallets; purses.</p>

Class 25: Clothing; footwear; headgear.	Class 25: Clothing; footwear; headgear.
Class 35: None	Class 35: Retail services and online retail services in relation to fragrances, toiletries for the care and cleaning of the hair and skin, cosmetics, bags, handbags, backpacks, umbrellas, wallets, purses, clothing, footwear, headgear, jewellery and watches.

29. The goods covered by class 25 of the application are specific examples of clothing, footwear and headgear. The respective goods in class 25 are therefore identical.

30. The respective goods in class 18 are also identical, except for cases, pouches, holders; bits, blankets, collars, coverings, masks and clothing for animals; whips: cane handles; skins (furs); covers and carriers for clothes, and parasols.

31. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*<sup>13</sup> the court stated at paragraph 23 of its judgment that:

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

32. In *Kurt Hesse v OHIM*,<sup>14</sup> the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity

---

<sup>13</sup> Case C-39/97

<sup>14</sup> Case C-50/15 P



between goods. In *Boston Scientific Ltd v OHIM*,<sup>15</sup> the General Court had earlier 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”.

33. Even if they are not identical, *cases*, *holders* and *pouches* are clearly highly similar to *bags*. *Parasols* are plainly highly similar to *umbrellas*. *Cane handles* could be a part of an umbrella, so although the nature and purpose of the goods is different, they are complementary goods, the one being parts/fittings for the other, and likely to be sold by the same undertakings. These goods are therefore similar to a low degree. *Covers* and *clothing* for animals are similar to *clothing* (for humans) in class 25 to a low degree. This is because they are similar in nature and purpose to a certain degree. *Skins (furs)* in class 18 are similar in nature to skins (furs) used for clothing in class 25. These are specialist goods likely to originate from similar trade channels at the top of the supply chain. I therefore find that these goods are similar to a low degree.

34. Although *covers and carriers for clothes* are complementary to clothing in the literal sense of those words there is no evidence that clothes covers and carriers are normally marketed by the same undertakings that market clothing. Consequently, I decline to find that these goods are complementary in the sense indicated in the case law.<sup>16</sup> They are not similar in any other way. I therefore conclude that these goods are dissimilar. *Bits, blankets, collars and masks for animals* and *whips* are not similar in any way that I can see to any of the goods or services covered by the earlier mark.

---

<sup>15</sup> Case T-325/06

<sup>16</sup> As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13: “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.”

35. *Materials for making into clothing* is similar to *clothing* in class 25 to a low degree. This is because there is some similarity in purpose. Further, it is still possible to buy made-to-measure clothes where the starting point of the transaction is the purchase of materials.

36. Mr Dick submitted that *towels* in class 24 are similar to bath robes, which are covered by the registration of the earlier mark for *clothing*. I reject this. The purposes and methods of use of the goods are different and they are not complementary or competitive. Admittedly, they can be made from the same material, but absent particular circumstances in the trade, as may be the case with (say) furs, this is not sufficient to establish that towels are similar goods to bath robes. More generally, Mr Dick submitted that the applicant's goods in class 24 should be treated as similar to the class 25 goods and retail services covered by the earlier mark because "*it is common for fashion houses to expand into homeware products, e.g. towels, linens etc.*" In this connection, Mr Dick pointed to well-known High street names NEXT and ZARA. However, the difficulty with this submission is that it is not based on the inherent characteristics of *clothing/retailing of clothing* and homeware products, or the usual marketing conditions for such goods/services. Instead it depends on the goods/services marketed under the earlier mark being those of a fashion house, which is not a clear or precise sub-category of clothing or associated retail services.

37. The opponent's approach would mean that the same goods and/or services might be regarded as being similar or dissimilar, depending on the reputation of the earlier mark. Adopting such an 'elastic' approach to similarity of goods/services would undermine the requirement in s.5(2) of the Act for the respective goods/services to be objectively similar, at least to some extent. It would also make it unduly difficult for other operators in the market sectors concerned to assess whether a particular mark is free for use in relation to particular goods/services. I therefore reject the approach proposed by the opponent.

38. There is no evidence that the public would normally expect homeware products to be marketed by, or with the consent of, undertakings that provide *clothing* or associated retail services. I see no other similarity between any of the goods in class 24 of the application (other than *materials for making into clothing*) and any of the

goods/services covered by the earlier mark. I therefore find that the respective goods/services are not similar. I note that the courts have rejected similar attempts to broaden the protection afforded to marks under provisions of law equivalent to s.5(2) of the Act when it comes to marks claiming to have a particular kind of reputation with the public. For example, in *Compagnie des montres Longines, Francillon SA v OHIM*,<sup>17</sup>, the General Court rejected the argument that sunglasses, jewellery and watches were similar to clothing on the basis that they were all types of luxury goods and the earlier mark had a reputation as a luxury brand.

39. The goods covered by class 14 of the contested mark are similar to a moderate degree to the retail services in class 35 for which the earlier mark is registered, particularly to *retail services and online retail services in relation to jewellery and watches*, which are complementary to the applicant's class 14 goods.

40. As some similarity of goods is an essential pre-requisite under s.5(2) of the Act, it follows that the opposition under s.5(2)(b) must fail insofar as the following goods are concerned:

Class 18: Covers and carriers for clothes: bits, blankets, collars and masks for animals; whips

Class 24: all goods, except materials for making into clothing (including any terms that could cover such goods).

#### Global comparison

41. For the remaining goods covered by the application it is necessary to undertake a global comparison of the likelihood of confusion arising from the use of the marks. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson*

---

<sup>17</sup> Case T-505/12

*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.*

*The principles*

(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.

#### Distinctive character of the earlier mark

42. In *Lloyd Schuhfabrik Meyer & Co. v GmbH v Klijsen Handel BV*, 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 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).”

43. The earlier mark consists of the letters AE *per se*. There is no suggestion that the mark is descriptive of the goods/services at issue. However, letter marks may be harder to protect as trade marks compared to some other types of marks: see *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co. KG*.<sup>18</sup> This is because they are very simple marks which do not stand out as much as (say) an invented word or a fancy design. The letters A and E are vowels and therefore amongst the most commonly used letters in the alphabet. However, as with other types of marks, the distinctive character of such marks must be assessed in relation to the goods/services covered by the trade mark. The goods/services covered by the earlier mark are everyday goods and services of kinds widely available on the High street and via the internet. In my view, the letters AE have a below average level of inherent distinctiveness in relation to the goods/services at issue.

44. The opponent claims that the earlier mark had acquired a high level of factual distinctiveness as a result of the use of the mark prior to the relevant date. The Appointed Person observed that the original Hearing Officer had not made any findings as to the reputation of the earlier mark. He continued in paragraph 35 of his decision that “*Moreover, in cases of this kind the mere fact that an earlier mark enjoys a reputation does not necessarily mean that confusion is more likely.*” Mr Dick submitted that this was an error because the case law of the CJEU indicates that 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 see no error in the Appointed Person’s statement. Although use of a trade mark may result in the mark acquiring a reputation and an enhanced level of distinctive character, reputation and distinctive character are different, albeit related, concepts. A highly descriptive or non-distinctive mark may acquire a substantial reputation

---

<sup>18</sup> Case C-265/09 P, CJEU

without ever becoming highly distinctive. If it were otherwise there would be no need for the assessment of distinctiveness to always take into account “...in particular, of the inherent characteristics of the mark.” Further, a mark of normal distinctiveness may acquire a modest reputation amongst a certain sub-section of the relevant public, whilst remaining unknown to a substantial majority of them. In these circumstances, the ‘reputation’ of the mark may not have enhanced its level of distinctiveness to any significant part of the relevant public. It is a question of fact and degree. In any event, the Appointed Person refused to decide for himself whether the earlier mark had a reputation and, if so, for which goods/services. Accordingly, it must be for me to assess whether the distinctive character of the earlier mark had been enhanced through use prior to the relevant date.

45. I acknowledge that the earlier mark had been used on the opponent’s ae.com website for 9 years prior to the relevant date. Customers from the UK had bought goods from that website, some of which bore the mark AE. However, the recorded sales of goods (nearly all clothing) in the UK (and EU) via the website cannot account for more than a tiny fraction of the UK and EU markets for clothing. This is not surprising given that the website had prices in \$US and therefore must have appeared to have been primarily directed at the USA. Further, the opponent has not provided figures showing how much it spent promoting the earlier mark in the UK or EU. In my view, the high point of this aspect of the opponent’s evidence is that there were over 4 million visits from the UK to the opponent’s ae.com website between 2011 and 2015. This sounds a lot, but the number of visits does not reflect the number of visitors (one visitor can make numerous visits over a four year period). Further, there is no way of knowing how many of these visits were accidental and therefore fleeting visits which made no lasting impression. Certainly the number of visits from the UK to the opponent’s website bears little relation to the opponent’s UK customer list which only amounted to 36k by April 2016. And over 18k of these signed up between November 2014 and October 2015 after the opening of the opponent’s first retail store in the UK. I am therefore left with the impression that prior to November 2014 the opponent’s ‘reputation’ in the UK was limited to just some spillover from its reputation in the USA.

46. Additionally, although the opponent used AE on its website, the more prominent branding was AMERICAN EAGLE OUTFITTERS and the device of an American Eagle. In context, AE was shorthand for American Eagle. This makes it harder to assess how strongly the letters AE by themselves identified the goods or services for which the earlier mark is registered, i.e. how distinctive the letters were out of a context in which they appeared alongside the words AMERICAN EAGLE.

47. The opponent's UK sales appear to have increased many times following the opening of the opponent's first UK retail store in November 2014. However, this was only 8 months prior to the relevant date. Additionally, the opponent has conspicuously failed to show the branding of its UK stores leaving me to believe that it was primarily AMERICAN EAGLE (OUTFITTERS) rather than AE. That is certainly the impression that consumers would have gained from looking at the opponent's shopping bags shown in paragraph 12 above.

48. Taking all these factors into account, I decline to find that the distinctive character of the earlier mark in the UK had been enhanced to a material extent through use of the mark in the EU prior to the relevant date.

49. Mr Dick urged me to follow the decision of the EU IPO in opposition B002752965, which concerned the opponent's registration of a device representing an American eagle. The Opposition division found that the mark had a reputation in the UK, and therefore in the EU, in relation to certain items of casual clothing. However, as Mr Dick acknowledged, the marks at issue are different and I have not seen the evidence filed at the EU IPO. Consequently, this is irrelevant.

50. I conclude that the earlier mark has a below average degree of inherent distinctive character which had not been materially enhanced in the UK through use of the mark in the EU prior to the relevant date.


#### Comparison of marks

51. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the



average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components.

52. The respective trade marks are shown below:

AE	
Earlier trade mark	Contested trade mark

53. The opponent submits that *“the contested mark is nothing more than the letters ‘A’ and ‘E’ reflected on a horizontal plane and with their basic colours (black and white) also reversed as part of that reflection.”*

54. The appointed Person’s decision requires me to *“have regard to the range of ways in which the mark could reasonably be regarded by a reasonably observant average consumer in considering the issue of similarity”* and to have in mind that some consumers will read the letters ‘A’ and ‘E’ (in that order) in the contested mark.

55. Considering first the perception of those consumers who do not read the letters AE in the contested mark and who instead read the letters EE or a combination of As and Es, but not in the specific order (or limited to) A-E, I find that there is no visual, aural or conceptual similarity and, therefore, no overall similarity between the marks.

56. This accords with the assessment of the original Hearing Officer. The Appointed Person also considered that *“to the extent that it has a verbal content, the [contested] mark more naturally appears as an “EE” double letter in a logo form.”* I

agree with that. I therefore find that more average consumers will see the contested mark this way than read the verbal content as AE. It would be artificial to attempt to assess the proportion of average consumers who see it one way or the other (including as EA or AEE) with any more precision than that. However, I will assume that a potentially significant minority of average consumers will see the verbal content as A-E.

57. Those consumers who read the verbal content of the contested mark as A-E can hardly fail to notice that there is much more to the contested mark than these letters. This is even evident from the opponent's description of the mark at paragraph 53 above. In my view, the contested mark is a complex logo mark. Those average consumers who see the letters A-E (in that order, possibly repeated) will nevertheless be aware of the ambiguous verbal content of the mark, which is a result of the clever way in which the letters AE are overlaid and the resulting logo reflected directly beneath itself in a contrasting colourway. Comparing the look of the logo to the look of the letters AE as such, I find that there is only a low degree of visual similarity between the marks, even to those who see the letters A-E in the contested logo mark.

58. From an aural perspective, those consumers who see the letters A-E in the contested mark will, if they attempt to verbalise the mark at all, call it an AE or AE-AE mark. The earlier mark is unambiguously AE. Therefore, the marks will be aurally identical or highly similar to those consumers who see the contested mark in this way and verbalise it accordingly.

59. Staying with consumers who see the letters A-E in the contested mark, the opponent submitted before the original Hearing Officer that the marks were conceptually identical because the letters AE are "*identically meaningless*" in the marks. I agree with the latter point. However, in my view, this means that the marks have no semantic content and are therefore conceptually neutral. To the extent that the letters AE represent the 'idea' of the marks, I have taken this into account in my assessment of the visual and aural similarities between them.

## Average consumer and the selection process

60. The average consumer of the goods covered by the application which are identical or similar to the goods/services covered by the earlier mark, is likely to be a member of the general public. In *New Look Limited v OHIM*,<sup>19</sup> the General Court stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

And

“50..... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

---

<sup>19</sup> Joined cases T-117/03 to T-119/03 and T-171/03

61. I find that the goods at issue are likely to be selected primarily by visual means through advertisements, online from websites or through physical inspections of the goods in shops. However, even though the trade mark is likely to be seen before any orders are placed, word of mouth recommendations and verbal enquiries may also play some part in the selection process.

62. 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*. There is nothing about the (identical and similar) goods covered by the contested mark which makes me believe that consumers will pay an unusually high or low degree of attention during the selection process. I therefore find that average consumers of the goods at issue are likely to pay a normal or average degree of attention.

#### Likelihood of confusion

63. There is no likelihood of confusion amongst those average consumers – probably the majority - who do not read the letters A-E in the contested mark. This is because the marks will not appear similar to those consumers.

64. Turning to the section of average consumers who read the letters A-E in the contested mark, I find that the degree of visual difference between the letters AE *per se* and the logo that comprises the contested mark is sufficient to rule out the likelihood of direct visual confusion. In reaching this finding I have made some allowance for imperfect recollection and also for the identity of some of the goods.

65. This section of average consumers may verbalise the contested mark as A-E. If they do it will sound the same as the earlier mark. However, the importance of this to the likelihood of confusion is mitigated by two factors. Firstly, the degree of ambiguity about the letters present in the contested mark is likely to be apparent even to consumers who settle on A-E. Consequently, consumers who have the contested mark in mind are likely to be cautious about relying on just this verbal description of it

when making enquiries or recommendations. The same will be true of those receiving enquiries or recommendations by reference to the letters AE, who know of the contested mark, and consider whether the oral enquiry or recommendation relates to this mark. Secondly, as I stated earlier, the selection process for the goods covered by the application is likely to be a primarily visual one. Consumers are unlikely to place orders without sight of the trade mark. In these circumstances, there is only limited potential for aural confusion. Moreover, as Mr Iain Purvis QC as the Appointed Person stated in *Royal Academy of Arts v Errea Sport S.p.a.*<sup>20</sup>:

“In essence [the] argument was that there was bound to be a likelihood of confusion in this case because of the aural ‘identity’ between the marks (if one tried to ask for goods using an aural version of the earlier mark, one would ask for ‘RA’ goods, just as one would ask for the applicant’s goods). This argument seems to me to fly in the face of the necessary ‘global’ assessment, bearing in mind the visual, conceptual and aural similarities, which the tribunal must carry out.”

66. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation*,<sup>21</sup> Kitchin L.J. considered the relationship between the average consumer and the likelihood of confusion. He concluded that:

“if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

67. This was in the context of infringement, but the same approach is appropriate under s.5(2).<sup>22</sup> It is not therefore necessary for me to find that the majority of average consumers will be confused. However, if the most that can be said is that occasional confusion amongst a few average consumers cannot be ruled out, then this is not sufficient. Rather the question is whether there is a likelihood of confusion amongst a

---

<sup>20</sup> BL O/010/16, at paragraph

<sup>21</sup> [2016] EWCA Civ 41, at paragraph 34(v)

<sup>22</sup> See *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch), Mann J.

significant proportion of the relevant public displaying the characteristics attributed to an average consumer of such goods/services.

68. The fact that a significant proportion of the relevant public will not see any similarity between the marks is plainly relevant to the required assessment. The limited scope for direct confusion even amongst those who see some similarity between the marks is also relevant. Taken together I find that these facts are sufficient to rule out the likelihood of direct confusion.

69. I must also consider the possibility of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*,<sup>23</sup> Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

70. The “something in common” in this case, at least to the section of the relevant public who sees the contested mark in one way, is the letters A-E. What is the mental process through which such consumers would conclude that the presence of the letters A-E in the contested mark means that it is used by the same undertaking that uses the letter trade mark AE? One possible answer to this is that the letters are so distinctive that the public wouldn’t expect there to be more than one user of marks consisting, or including, these letters. However, I have found that the letters

---

<sup>23</sup> Case BL O/375/10

concerned have a below average degree of inherent distinctiveness in relation to the goods/services at issue, which had not been enhanced to any material extent through use of the earlier mark prior to the relevant date. Another possible answer is that variant marks are relatively common in the clothing sector and the contested mark is therefore likely to be seen as a stylisation of the earlier AE letter mark. Indeed, the opponent makes the point that it uses AE in certain stylised forms. There is some evidence of this, but all the forms used by the opponent are unambiguously AE marks. In my view, the contested mark is much more than the letters AE with some stylisation. I do not therefore find it likely that average consumers will see the contested mark as a natural variation on, or development of, the AE letter mark. As Mr James Mellor QC, as the Appointed Person, was keen to stress in *Duebros Limited v Heirler Cenovis GmbH*:<sup>24</sup>

“..... a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (emphasis added)

71. Taking account of the common element (to some consumers) in the context of the later mark as a whole, I find that there is no likelihood of indirect confusion either. The opposition under s.5(2)(b) based on the earlier AE mark therefore fails.

72. The opponent submitted that all the opposed goods in class 24 (including those I have found to be dissimilar to the goods and services covered by the earlier EUTM 13945233) are similar to “*design and stylisation of textiles*” in class 42 of its earlier EUTM 5194907 (Miss AE device) and “*industrial and fashion design of clothing textiles, machines and civil and industrial manufactured articles in general*” in class 42 of its earlier EUTM 4901931 (AE Wings device).

---

<sup>24</sup> BL O/547/17 at paragraph 81.4 of his decision

73. The marks in question are shown in paragraph 2 above. They are less similar to the contested mark than the letters AE *per se*. The services relied upon are essentially design services. These appear to be services provided mainly to undertakings that trade in textile goods. I am therefore doubtful whether the services are similar to textiles as goods. However, there is no need to formally determine that point. Having found that there is no likelihood of confusion with the opponent's AE mark, even where the goods are identical, it follows that there is no likelihood of confusion where the marks are less similar and the goods/services are (at most) similar to a low degree. The opposition under s.5(2)(b) based on the opponent's other three earlier marks therefore takes the opponent's case no further.

74. I find that the opposition under s.5(2)(b) fails.

#### **The opposition under s.5(4)(a)**

75. Section 5(4)(a) states:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

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

76. In *Discount Outlet v Feel Good UK*,<sup>25</sup> Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court stated that:

---

<sup>25</sup> [2017] EWHC 1400 IPEC



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

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

77. The opponent claims that the letters AE have been used since 2006 in relation to *key rings, wrist bands, leather goods, bags, wallets, purses, umbrellas, pet apparel, pet clothing, pet collars, leashes; towels; clothing, footwear and headgear* and that the opponent has acquired goodwill in the UK as a result. I am prepared to accept that the opponent has used the mark AE in relation to casual clothing exported to, or sold in, the UK. I will assume that, at the relevant date, the letters AE were distinctive of the opponent’s UK trade in such goods.

78. In my view, the opponent’s case under s.5(4)(a) falls down at this point. This is because, for the reasons I gave in my analysis under s.5(2)(b), the contested mark is unlikely to be mistaken for the opponent’s AE mark and there is no likelihood that “*a substantial number*” of the opponent’s customers or potential customers will be deceived. Consequently, use of the contested mark would not constitute a misrepresentation to the public. The s.5(4)(a) ground of opposition is therefore also rejected.

### **The opposition under section 5(3)**

79. Section 5(3) states:

“(3) A trade mark which-

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

### Reputation

80. The opponent claims that the earlier AE mark has acquired a reputation in the UK and EU in relation to clothing, fashion accessories and related goods. I accept that the earlier AE mark has been used in the UK and EU since 2006 in relation to casual clothing.

81. Mr Dick drew my attention to the comments of Arnold J. in *Enterprise Holdings Inc. v Europcar Group UK Ltd*<sup>26</sup> where the judge stated that proving a reputation “*is not a particularly onerous requirement.*” However, the facts in that case were far removed from those in this case. The evidence before Arnold J. showed that the claimant was in fact the market leading car hire company in the UK with a 30% share of the UK market. It was in that context that the judge said that proving a reputation “*is not a particularly onerous requirement.*” He had no reason to turn his mind to situations where the claimant had only a tiny and/or unquantified share of the relevant market in the UK or EU.

82. I note that the requirements for establishing a qualifying reputation under article 5(2) of the Trade Mark Directive (section 5(3) of the Act) were considered by Advocate General Jacobs in *General Motors*.<sup>27</sup> The Advocate General noted that Article 5(2) did not appear in the initial proposal for the Directive put forward by the Commission which considered that such extensive protection was not justified for national trade marks, but should be restricted to a limited number of Community marks, namely marks of wide repute.<sup>28</sup> However, in the course of negotiations in the

---

<sup>26</sup> [2015] EWHC 17 (Ch)

<sup>27</sup> Case C-375/97

<sup>28</sup> See the Commission proposal, OJ 1980 C 351, p. 1 and *EC Bulletin*, Supplement 5/80.

Council, a provision protecting marks with a reputation was included at the request of the Benelux countries, and became Article 5(2) of the Directive. The Advocate General concluded that a trade mark with a reputation within the meaning of Article 5(2) of the Directive should be interpreted as meaning a mark which is known to a significant part of the relevant sectors of the public, but which need not attain the same degree of renown as a mark which is well known within the meaning of the Paris Convention.

83. The CJEU essentially followed the Advocate General's Opinion in finding that:

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

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

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

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

84. It is clear from this that the 'reputation' required in order for a trade mark to qualify for protection under s.5(3) cannot be equated with the requirement for goodwill and reputation under the common law of passing off. The latter protects businesses with even a modest local reputation against damaging

misrepresentations by third parties. The former provides more extensive protection than usual to registered marks “*known by a significant part of the public concerned by the products or services*” “*in a substantial part of [the relevant territory]*”.

85. Applying the criteria identified by the CJEU to the facts before me I find that:

- There is no evidence of the share of the UK or EU market for casual clothing held by the mark;
- The established value and volume of sales of casual clothing under the mark appears to be a tiny fraction of the UK and EU market for such goods;
- The mark was used for about 9 years prior to the relevant date, mainly via the opponent’s website which advertised the goods for sale in \$US dollars;
- The AE mark appears to have been one of a number of marks used to distinguish the goods, including AMERICAN EAGLE OUTFITTERS, the device of an American eagle and the letters AEO;
- It is not clear how many retail outlets the opponent had in the UK or EU prior to the relevant date, but it may have been limited to one store in Poland and one in London;
- It is not clear how prominently the AE mark was used in relation to those outlets or the goods sold through them;
- There is no evidence as to the amount spent promoting the AE mark in the UK or the EU.

86. In my view, the evidence fails to establish that the mark had acquired a reputation in the UK or EU in relation to casual clothing amongst “*a significant part of the public concerned by the products or services covered by that trade mark.*” If I am wrong about that, then I find that the mark had acquired only a modest reputation by the relevant date.

Link

87. Assuming that the earlier mark had a qualifying reputation at the relevant date, it is necessary to evaluate whether the public when confronted with the later mark

would make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind.<sup>29</sup> Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness.<sup>30</sup> Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future.<sup>31</sup>

88. The factors identified in *Intel* are:

*The degree of similarity between the conflicting marks*

Depending on the differing perceptions of consumers, the marks will appear dissimilar or similar to a low degree

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

Casual clothing is identical to many of the goods covered by class 25 of the contested mark and similar to the other goods in class 25. Although the other goods covered by the contested mark do not appear to be similar to casual clothing, they are (or could be) fashion goods. Consequently, there is a connection of sorts between the goods. Nearly all of the applicant's goods are marketed to the general public. The section of the public targeted by the marks is therefore largely the same.

*The strength of the earlier mark's reputation in the EU/UK*

---

<sup>29</sup> CJEU, *Intel*, Case C-252/07, paragraph 63

<sup>30</sup> *Intel*, paragraph 79.

<sup>31</sup> *Intel*, paragraph 68

I find that it was modest (at most) at the relevant date.

*The degree of the earlier mark's distinctive character, whether inherent or acquired through use*

The earlier mark has a below average degree of inherent distinctiveness. Even if it had acquired a modest reputation by the relevant date, it was not enough to have made the earlier mark particularly distinctive.

89. Taking all the relevant factors into account I find that, at the relevant date, the public would not have made a link between the earlier mark and the contested mark. It follows that the contested mark could not have caused any of the types of injury set out in the section.

#### Injury to earlier mark

90. Assuming that I am wrong about that too, and that a section of the public would have made a link between the marks, I will briefly consider the types of injury suggested by the opponent.

91. The opponent pleaded that it will be perceived as the user of the contested mark, or that the user of the contested mark will be perceived as economically connected with the user of the opponent's mark. I have already rejected this proposition in my analysis under s.5(2) and s.5(4)(a). This aspect of s.5(3) case was therefore also bound to fail.

92. Additionally, or alternatively, the opponent complains that the reputation of the earlier mark may suffer from the link with the contested mark because it cannot control the quality of the goods marketed under that mark. However, in the absence of any likelihood of confusion it is not easy to understand how simply being reminded of the earlier mark will tarnish any reputation it has with the public in the UK. Indeed, in *Unite The Union v The Unite Group Plc*,<sup>32</sup> Ms Anna Carboni as the Appointed

---

<sup>32</sup> Case BL O/219/13

Person rejected the proposition that a link between an earlier mark with a reputation and a later mark with the mere potential to create a negative association because of the potential quality of the goods/services marketed under it was sufficient to found an opposition based on detriment to reputation. I would therefore have rejected this head of injury to the earlier mark.

93. Turning to unfair advantage, the opponent claims that the earlier mark will be “*riding on the coat tails*” of the reputation of the earlier mark. However, absent a likelihood of confusion on the part of the public, or the earlier mark having a substantial reputation in the UK, it is not obvious why this should be so. In *Aktieselskabet af 21. november 2001 v OHIM*,<sup>33</sup> the CJEU stated that:

“22. With regard to the appellant’s argument concerning the standard of proof required of the existence of unfair advantage taken of the repute of the earlier mark, it must be noted that it is not necessary to demonstrate actual and present injury to an earlier mark; it is sufficient that evidence be produced enabling it to be concluded *prima facie* that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future (see, by analogy, concerning the provisions of Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-252/07 Intel Corporation [2008] ECR I-0000, paragraph 38).”

94. In my view, the opponent has done no more than point to the hypothetical risk of unfair advantage being taken of the earlier AE mark. I would therefore have rejected this aspect of the opponent’s case too.

95. Finally, the opponent claims that use of the later mark will dilute the distinctive character of the earlier AE mark and that this will lead to lost sales. According to the opponent, consumers of the opponent’s goods/services may purchase fewer such goods/services if the opponent’s AE mark ceases to be linked (or is less immediately linked) with the opponent’s image of a wholesome, positive lifestyle brand.

---

<sup>33</sup> Case C-197/07P

96. In *Environmental Manufacturing LLP v OHIM*,<sup>34</sup> the CJEU stated that:

“34. According to the Court’s case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).

35. Admittedly, paragraph 77 of the *Intel Corporation* judgment, which begins with the words ‘[i]t follows that’, immediately follows the assessment of the weakening of the ability to identify and the dispersion of the identity of the earlier mark; it could thus be considered to be merely an explanation of the previous paragraph. However, the same wording, reproduced in paragraph 81 and in the operative part of that judgment, is autonomous. The fact that it appears in the operative part of the judgment makes its importance clear.

36. The wording of the above case-law is explicit. It follows that, without adducing evidence that that condition is met, the detriment or the risk of detriment to the distinctive character of the earlier mark provided for in Article 8(5) of Regulation No 207/2009 cannot be established.

37. The concept of ‘change in the economic behaviour of the average consumer’ lays down an objective condition. That change cannot be deduced solely from subjective elements such as consumers’ perceptions. The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds.

---

<sup>34</sup> Case C-383/12P



38 The General Court, at paragraph 53 of the judgment under appeal, dismissed the assessment of the condition laid down by the *Intel Corporation* judgment, and, consequently, erred in law.

39. The General Court found, at paragraph 62 of the judgment under appeal, that ‘the fact that competitors use somewhat similar signs for identical or similar goods compromises the immediate connection that the relevant public makes between the signs and the goods at issue, which is likely to undermine the earlier mark’s ability to identify the goods for which it is registered as coming from the proprietor of that mark’.

40. However, in its judgment in *Intel Corporation*, the Court clearly indicated that it was necessary to demand a higher standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, within the meaning of Article 8(5) of Regulation No 207/2009.

41. Accepting the criterion put forward by the General Court could, in addition, lead to a situation in which economic operators improperly appropriate certain signs, which could damage competition.

42. Admittedly, Regulation No 207/2009 and the Court’s case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.”

97. In the absence of a likelihood of confusion, I do not accept that use of the contested mark would result in the opponent’s mark ceasing to be linked with any of the qualities or values with which it may currently be associated. I am particularly mindful of the CJEU’s guidance that:

“The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds.”

98. Given the modest (at best) reputation of the opponent’s mark in the UK and the relative lack of distinctiveness of the letters AE, I do not accept that the mere coincidence of there being two marks, one comprising and one including (to some), the letters AE presents a serious risk of a change in the economic behaviour of consumers. The opponent’s case is based on mere suppositions. I would therefore have rejected the claim that use of the contested mark would be detrimental to the distinctive character of the earlier mark.

99. The s.5(3) ground is therefore also rejected.

### **Outcome**

100. The opposition is rejected.

### **Costs**

101. The original Hearing Officer ordered the opponent to pay the applicant the sum of £450 in costs. The Appointed Person decided that:

“37. In view of this decision, which has not determined this opposition finally, I consider that the right award of costs would be to leave the costs award before the hearing officer undisturbed but to award the appellant a contribution to the costs of this appeal in the sum of **£500**. It would be for the hearing officer deciding the next stage of the case to make such award as he or she sees fit in respect of that stage.”

102. The applicant provided some brief written submissions in lieu of attending the hearing. The applicant will also have spent time considering the opponent’s skeleton.

So far as I can see, these are the only costs incurred by the applicant since the opposition was remitted. Therefore, in addition to the costs ordered by the original Hearing Officer, I order Retail Royalty Company to pay Alterego Retail Group Limited the sum of £100 as a contribution towards the additional costs incurred in dealing with the remitted opposition.

**Dated this 12<sup>th</sup> day of January 2018**

**Allan James  
For the Registrar**

## Annex A

### Class 14

Agate as jewellery Agates Amulets [jewellery] Amulets being jewellery Ankle bracelets Articles of imitation jewellery Articles of jewellery Articles of jewellery coated with precious metals Articles of jewellery made from rope chain Articles of jewellery made of precious metals Articles of jewellery with ornamental stones Articles of jewellery with precious stones Artificial gem stones Artificial jewellery Artificial stones [precious or semi-precious] Automatic watches Bands for watches Bangle bracelets Bangles Beads for making jewelry Body-piercing rings Body-piercing studs Bracelets Bracelets [jewellery, jewelry (Am.)] Bracelets [jewelry] Bracelets and watches combined Bracelets for watches Bracelets of precious metal Brooches [jewellery, jewelry (Am.)] Buckles for watchstraps Cases [fitted] for jewels Cases [fitted] for watches Cases adapted to contain items of jewellery Cases adapted to contain watches Cases for jewels Cases for watches Cases for watches [presentation] Cases for watches and clocks Chains [jewellery, jewelry (Am.)] Charms for collar jewelry and bracelet Charms of precious metals Charms of semi-precious metals Chokers Clip earrings Clips (Tie -) Clips of silver [jewellery] Clock faces Clocks and watches Clocks and watches in general Clocks and watches, electric Closures for necklaces Copper tokens Costume jewellery Cuff links Cuff links and tie clips Cuff links made of gold Cuff links made of imitation gold Cuff links of precious metals with semi-precious stones Cufflinks Cuff-links Cultured pearls Cut diamonds Decorative articles [trinkets or jewellery] for personal use Decorative boxes made of precious metal Decorative brooches [jewellery] Decorative cuff link covers Decorative pins [jewellery] Decorative pins of precious metal Diamond [unwrought] Diamonds Dress ornaments in the nature of jewellery Dress watches Ear clips Ear ornaments in the nature of jewellery Ear studs Earrings Earrings of precious metal Electric watches Electronic timepieces Electronic watches Emerald Emeralds Enamelled jewellery Fake jewellery Fancy keyrings of precious metals Fashion jewellery Figurines made from gold Figurines made from silver Figurines of precious metal Figurines of precious stones Finger rings Fitted covers for jewelry rings to protect against impact, abrasion, and damage to the ring's band and stones Flexible wire bands for wear as a bracelet Friendship rings Gems Gemstones Gold Gold bracelets Gold chains Gold earrings Gold jewellery Gold plated bracelets Gold plated brooches [jewellery] Gold plated chains Gold plated earrings Gold plated rings Gold rings Gold thread [jewellery, jewelry (Am.)] Gold thread jewelry Imitation gold Imitation jewellery Imitation jewellery ornaments Imitation jewelry Imitation pearls Imitation precious stones Items of jewellery Ivory [jewellery, jewelry (Am.)] Jade [jewellery] Jewel cases [fitted] Jewellery Jewellery articles Jewellery boxes Jewellery cases Jewellery cases [caskets] Jewellery coated with precious metals Jewellery containing gold Jewellery fashioned from non-precious metals Jewellery for personal wear Jewellery in the form of beads Jewellery incorporating diamonds Jewellery incorporating pearls Jewellery incorporating precious stones Jewellery items Jewellery made of crystal Jewellery made of non-precious metal Jewellery of yellow amber Jewellery ornaments Jewellery rope chain for anklets Jewellery rope chain for bracelets Jewellery rope chain for necklaces Jewellery stones Jewellery watches Jewellery, including imitation jewellery and plastic jewellery Jewellery Jewelry Jewelry Jewelry (Paste -) [costume jewelry] Jewelry boxes Jewelry boxes of precious metal Jewelry brooches Jewelry cases Jewelry cases [caskets] Jewelry of yellow amber Jewelry

pins for use on hats Key chains as jewellery [trinkets or fobs] Key charms [trinkets or fobs] Key charms of precious metals Key holders [trinkets or fobs] Key rings of precious metals Leather watch straps Locketts Man-made pearls Natural gem stones Neck chains Necklaces Necklaces [jewellery, jewelry (Am.)] Necklaces [jewellery] Non-leather watch straps Opal Ornamental pins made of precious metal Ornamental sculptures made of precious metal Pearl Pearls Pearls [jewellery, jewelry (Am.)] Pearls [jewellery] Pearls made of ambroid [pressed amber] Pendant watches Pendants Pendants [jewellery] Pendants for watch chains Pins (Ornamental -) Pins [jewellery, jewelry (Am.)] Pins being jewellery Pins being jewelry Precious and semi-precious gems Precious gemstones Precious jewellery Precious stones and watches Presentation boxes for watches Ring bands [jewellery] Ring holders of precious metal Rings [jewellery, jewelry (Am.)] Rings [jewellery] Rings [jewellery] made of non-precious metal Rings [jewellery] made of precious metal Rings [jewelry] Rings [trinket] Rings being jewellery Rings coated with precious metals Rope chain [jewellery] made of common metal Rope chain made of precious metal Ruby Sapphire Sapphires Semi-precious gemstones Semi-wrought precious stones and their imitations Silver Small jewellery boxes of precious metals Sports watches Statues of precious metal Statues of precious metal of religious icons Statuettes made of semi-precious stones Sterling silver jewellery Tiaras Tie clips Tie pins Tie tacks of precious metals Tie-pins of precious metal Topaz Trinkets [jewellery, jewelry (Am.)] Trinkets coated with precious metal Watch bands Watch boxes Watch straps Watch straps made of metal or leather or plastic Watch straps of nylon Watch straps of plastic Watch straps of polyvinyl chloride Watch straps of synthetic material Watchstraps Women's jewelry Women's watches Wooden jewellery boxes Works of art of precious metal Wrist bands [charity] Wrist straps for watches Wrist watch bands, jewellery rolls for travel.

## **Class 18**

Airline travel bags All purpose sport bags All-purpose athletic bags Animal carriers [bags] Animal harnesses Animal hides Animal leashes Back packs Backpacks Backpacks [rucksacks] Bags Bags for clothes Bags for sports Bags for sports\* Bags for umbrellas Bags (Garment -) for travel Bags made of imitation leather Bags made of leather Bags (Net -) for shopping Bags (Nose -) [feed bags] Beach bags Beach umbrellas Beachbags Beauty cases Beauty cases [not fitted] Belt bags Belt bags and hip bags Belt pouches Belts (Leather shoulder -) Billfolds Bits for animals Bits for animals [harness] Bits [harness] Blankets for animals Book bags Boot bags Boston bags Boxes of leather (Hat -) Boxes of leather or leather board Boxes of vulcanised fibre Briefcases and attache cases Briefcases for documents Briefcases [leather goods] Briefcases [leatherware] Briefcases made of leather Bum bags Bumbags Business card cases Butts [parts of hides] Camping bags Cane handles Canes Canvas bags Card cases [notecases] Card holders Carriers for suits, shirts and dresses Carry-all bags Carryalls Carrying cases for documents Carrying cases Carry-on bags Cases for holding keys Cases for keys Cases of imitation leather Casual bags Chain mesh purses Chamois leather, other than for cleaning purposes Change purses Changing bags Charm bags (omamori-ire) Chin straps, of leather Cloth bags Clothes for animals Clothing for animals Clothing for domestic pets Clothing for pets Clutch bags Clutch purses Clutches [purses] Coats for cats Coats for dogs Coin holders Coin purses Coin purses not made of precious metal Coin purses, not of precious metals Collars for animals Collars for cats Collars for pets

Collars for pets bearing medical information Collars of animals Combination walking sticks and umbrellas Cosmetic bags Cosmetic bags [not fitted] Cosmetic bags sold empty Cosmetic cases sold empty Cosmetic purses Costumes for animals Courier bags Coverings of skins [furs] Covers and wraps for animals Covers for umbrellas Covers (Umbrella -) Credit card cases Credit card cases [wallets] Credit card holders Credit card holders made of imitation leather Credit card holders made of leather Credit-card holders Daypacks Diaper bags Diplomatic bags Dispatch cases Document cases Document suitcases Dog bellybands Dog clothing Dog coats Dog collars Dog leashes Dog parkas Dog shoes Draw reins Driving licence cases Duffel bags for travel Duffel bags Electronic pet collars Evening bags Evening handbags Evening purses Face masks for equines Fanny packs Flexible bags for garments Flight bags Foal slips Folding briefcases Folio cases Garden umbrellas Garment bags Garment bags for travel Garment bags for travel made of leather Garment carriers Garments for pets Gentlemen's handbags Gladstone bags Golf umbrellas Gym bags Handbags Handbags for men Handbags, purses and wallets Handles (Suitcase -) Handles (Walking stick -) Japanese paper umbrellas (karakasa) Japanese utility pouches (shingen-bukuro) Jockey sticks Key bags Key cases Key cases of imitation leather Key holders Key pouches Key wallets Keycases Key-cases Key-cases of leather and skins Knitted bags, not of precious metals Laces (Leather -) Ladies handbags Lashes [whips] Leather bags Leather bags and wallets Leather briefcases Leather for shoes Leather handbags Leather pouches Leather purses Leather suitcases Leather thongs Leather wallets Luggage Make-up bags Parasols Parasols [sun umbrellas] Pet clothing Pet hair bows Pets (Clothing for -) Pochettes Pocket wallets Pocketbooks [handbags] Polyurethane leather Portfolio cases [briefcases] Pouches for holding make-up, keys and other personal items Pouches of leather Pouches, of leather, for packaging Pullmans Purse frames Purses Purses [leatherware] Purses not made of precious metal Purses [not of precious metal] Purses, not of precious metal Purses of precious metal Rainproof parasols Roll bags Ruck sacks Rucksacks Rugs for animals Satchels School bags School book bags School knapsacks School satchels Schoolbags Schoolchildren's backpacks Semi-worked fur Shaving bags sold empty Shoe bags Shopping bags Shopping bags made of skin Shopping bags with wheels attached Shoulder bags Sling bags Slings for carrying babies Slings for carrying infants Small backpacks Small bags for men Small clutch purses Small purses Small rucksacks Small suitcases Sports bags Tie cases Toiletry cases sold empty Travel bags Travel cases Travel garment covers Travel luggage Traveling bags Travelling bags Travelling bags [leatherware] Travelling bags made of leather Travelling cases Travelling cases of leather Travelling handbags Travelling sets Travelling sets [leatherware] Travelling trunks Trunks Trunks and travelling bags Trunks [luggage] Umbrella bags Umbrella covers Umbrella frames Umbrella handles Umbrella or parasol ribs Umbrella rings Umbrella sticks Umbrellas Umbrellas and parasols Umbrellas for children Unfitted vanity cases Unworked leather Valises Valves of leather Vanity cases, not fitted Vanity cases sold empty Waist bags Waist packs Waist pouches Wallets Wallets including card holders Wallets [not of precious metal] Wallets, not of precious metal Wallets of precious metal Wallets (Pocket -) Wallets with card compartments Weekend bags Wheeled bags Wheeled shopping bags Wrist mounted carryall bags Wrist mounted purses.

## **Class 24**

Bath linen, except clothing Bath sheets Bath sheets (towels) Bath towels Bathroom linen Bathroom towels Beach towels Bean bag covers Bed clothes Bed coverings Bed covers Bed covers of paper Bed linen Bed linen and table linen Bed linen made of non-woven textile material Bed linen of paper Bed pads Bed quilts Bed sheets Blankets Blankets for outdoor use Cloth handkerchiefs Cloth labels Cloth napkins Coasters of textile Coated textiles Covers for cushions Covers for duvets Covers for eiderdown and duvets Covers for mattresses Covers for pillows Cushion covers Dish mats Dish towels Elasticated woven textile materials Embroidery fabric Fabric for use in the manufacture of clothing Fabric for use in the manufacture of purses Fabric linings for clothing Fabric wall coverings Fabrics being textile piece goods for use in embroidery Fabrics being textile piece goods made of mixtures of fibres Face cloths Face towels Flags of textile Flannel Furnishing covers for household use Hand towels Household linens Household textile goods Household textiles Labels made of textile materials Labels of cloth Labels of textile for bar codes Labels of textile for identifying clothing Labels (textile) Labels (textile-) for identifying clothing Labels (textile-) for identifying linen Labels (textile-) for marking clothing Labels (textile-) for marking linen Linen for the bed Linen (household-) Lingerie fabrics Materials for making into clothing Materials for use in making clothes Silk Silk base mixed fabrics Waterproof fabrics Window covering products made of textile material Woollen fabrics for use in the manufacture of coats Woollen fabrics for use in the manufacture of jackets Woollen fabrics for use in the manufacture of suits Woollen fabrics for use in the manufacture of trousers Woven labels Woven silk fabrics.

## **Class 25**

Ankle boots Ankle socks Ankle warmers Anoraks Anti-perspirant socks Aprons Aprons [clothing] Ascots Athletic clothing Athletic tights Athletics footwear Athletics hose Athletics shoes Athletics vests Athletics wear Bandanas Bandanas [neckerchiefs] Barber smocks Baseball caps Baseball caps and hats Baseball shoes Baseball uniforms Basic upper garment of Korean traditional clothes [Jeogori] Basketball shoes Basketball sneakers Bath robes Bath sandals Bath shoes Bath slippers Bath wraps Bathing caps Bathing costumes Bathing costumes for women Bathing drawers Bathing gowns Bathing suit cover-ups Bathing suits Bathing suits for men Bathing trunks Bathing wraps Bathrobes Bathwraps Beach clothes Beach footwear Beach hats Beach robes Beach shoes Beach wraps Beachwear Beanies Bed jackets Bed socks Belts [clothing] Belts made from imitation leather Belts made of leather Belts made out of cloth Belts (Money -) [clothing] Belts of textile Berets Bermuda shorts Bib overalls Bib shorts Bibs, not of paper Bikinis Blazers Bloomers Blouses Blouson jackets Blousons Boas Boas [clothing] Boas [necklets] Bobble hats Bodices Bodices [lingerie] Body linen [garments] Body stockings Body suits Body warmers Body warmers [clothing] Boiler suits Boleros Bolo ties with precious metal tips Bonnets Bonnets [headware] Boot uppers Booties Boots \* Bottoms [clothing] Bow ties Boxer briefs Boxer shorts Braces for clothing [suspenders] Braces [suspenders] Bras Brassieres Breeches Breeches for wear Bridal wear Bridesmaid dresses Bridesmaids wear Briefs Burnouses Bushjackets Bustiers Bustle holder bands for obi (obiage) Bustles for obi-knots (obiage-shin) Button down shirts Caftans Cagoules Camiknickers Camisoles Canvas shoes Cap peaks Cap visors Capes Caps [headwear] Caps (Shower -) Caps with visors Car coats Cardigans Cashmere

scarves Casual clothing Casual footwear Casual jackets Casual shirts Casual trousers Casualwear Chaps (clothing) Chasubles Chefs' whites Chemise tops Chemises Chemisettes Children's headwear Christening gowns Christening robes Cloaks Clothes for sports Clothing \* Clothing, footwear, headgear Clothing for children Clothing for cycling Clothing for cyclists, Clothing made of leather Clothing of imitations of leather Clothing of leather Coats Coats made of cotton Coats of denim Coats (Top -) Cocktail dresses Collar protectors Collared shirts Collars Collars [clothing] Combative sports uniforms Combinations [clothing] Corduroy trousers Corselets Corsets Corsets [clothing, foundation garments] Corsets [foundation clothing] Corsets [underclothing] Costumes Costumes for use in role-playing games Costumes (Masquerade -) Cotton coats Coveralls Cowls [clothing] Cravates Cravats Crinolines Cuffs Culotte skirts Culottes Cumberbunds Cycling pants Cycling shoes Cycling shorts Denim jackets Denims [clothing] Desert boots Detachable collars Detachable neckpieces for kimonos (haneri) Dinner jackets Dinner suits Donkey jackets Down jackets Drawers [clothing] Dress pants Dress shields Dress shirts Dress shoes Dress suits Dresses Dresses for evening wear Dresses made from skins Dressing gowns Driving gloves Duffel coats Dungarees Dust coats Ear muffs Ear muffs [clothing] Espadrilles Esparto shoes or sandals Esparto shoes or sandals Evening coats Evening dresses Evening gowns Evening suits Evening wear Eye masks Fabric belts Fancy dress costumes Fashion hats Fedoras Fezzes Fitted swimming costumes with bra cups Flat caps Fleece shorts Fleeces Footless tights Formal evening wear Foundation garments Frames (Hat -) [skeletons] Full-length kimonos (nagagi) Fur coats Fur coats and jackets Fur hats Fur jackets Fur muffs Fur stoles Furs [clothing] Gabardines Gabardines [clothing] Gaiter straps Gaiters Galoshes Garments for protecting clothing Garter belts Garters Gilets Girdles Girdles [corsets] Gloves Gloves as clothing Gloves [clothing] Golf caps Gym shorts Gymwear Halloween costumes Halter tops Handwarmers [clothing] Hat frames [skeletons] Hats Hats (Paper -) [clothing] Head bands Head scarves Head sweatbands Head wear Headbands Headbands against sweating Headbands [clothing] Headbands for clothing Headdresses [veils] Headgear for wear Headscarfs Headscarves Headshawls Headsquares Headwear Heavy jackets Hooded pullovers Hooded sweatshirts Hooded tops Hoods Hoods [clothing] Hosiery House coats Housecoats Inner socks for footwear Jackets Jackets and socks Jackets [clothing] Jackets (Stuff -) [clothing] Japanese footwear of rice straw (waraji) Japanese kimonos Japanese sleeping robes (nemaki) Japanese style sandals of felt Japanese style sandals of leather Japanese style sandals (zori) Japanese style socks (tabi) Japanese style socks (tabi covers) Jeans Jerkins Jerseys Jerseys [clothing] Jockstraps [underwear] Jodhpurs Jogging bottoms Jogging bottoms [clothing] Jogging pants Jogging shoes Jogging suits Jogging tops Judo suits Jump Suits Jumper dresses Jumper suits Jumpers Jumpers [pullovers] Jumpers [sweaters] Kaftans Kerchiefs [clothing] Kilts Kimonos Knee-high stockings Knickerbockers Knickers Knit jackets Knit shirts Knitted gloves Knitted underwear Knitwear Knitwear [clothing] Korean outer jackets worn over basic garment [Magoja] Korean topcoats [Durumagi] Korean traditional women's waistcoats [Baeja] Ladies' suits Ladies' underwear Layettes Layettes [clothing] Leather belts [clothing] Leather clothing Leather (Clothing of -) Leather (Clothing of imitations of -) Leather coats Leather garments Leather headwear Leather jackets Leather pants Leather waistcoats Leg warmers Leggings [leg warmers] Leggings [trousers] Legwarmers Leisure suits Leisure wear Leisurewear Leotards Light-reflecting coats Light-reflecting jackets Linen (Body -) [garments] Lingerie Linings (Ready-made -) [parts of clothing] Long



jackets Long sleeve pullovers Long sleeved vests Loungewear Lounging robes Low wooden clogs (hiyori-geta) Low wooden clogs (koma-geta) Lumberjackets Masks (Sleep -) Masquerade costumes Maternity clothing Maternity wear Men's and women's jackets, coats, trousers, vests Men's socks Men's suits Menswear Miters [hats] Mitres [hats] Mittens Mitts [clothing] Moccasins Money belts [clothing] Monokinis Morning coats Mufflers Mufflers [clothing] Mufflers [neck scarves] Muffs Muffs [clothing] Mules Nappy pants [clothing] Neck scarfs [mufflers] Neck scarves Neckerchiefs Neckties Neckwear Negligees Night gowns Nightcaps Nightdresses Nightgowns Nighties Nightshirts Nightwear One-piece suits Open-necked shirts Outerclotthing Overcoats Overshoes Overtrousers Over-trousers Pajamas (Am.) Pantie-girdles Panties Panties, shorts and briefs Pants Pantyhose Paper clothing Pareus Parkas Party hats [clothing] Pea coats Peaked headwear Peaks (Cap -) Pedal pushers Peignoirs Pelerines Pelisses Perspiration absorbent underwear clothing Petticoats Pinafore dresses Pinafores Pique shirts Pirate pants Pleated skirts for formal kimonos (hakama) Plimsolls Pocket kerchiefs Pocket squares Pocket squares [clothing] Pockets for clothing Polo knit tops Polo neck jumpers Polo shirts Polo sweaters Ponchos Pop socks Rain coats Rain hats Rain ponchos Rain suits Rain trousers Rain wear Raincoats Rainproof clothing Rainproof jackets Rainshoes Rainsuits Rainwear Ramie shirts Ready-made clothing Ready-made linings [parts of clothing] Removable collars Robes Robes (Bath -) Roll necks [clothing] Romper suits Rompers Rugby jerseys Rugby shirts Rugby shorts Rugby tops Running Suits Running vests Sandals and beach shoes Sarees Saris Sarongs Sash bands for kimono (obi) Sashes for wear Scarfs Scarves School uniforms Sedge hats (suge-gasa) Serapes Shawls Shawls and headscarves Shawls and stoles Shawls [from tricot only] Sheepskin coats Shell suits Shields (Dress -) Shift dresses Shirt fronts Shirt yokes Shirts Shirts and slips Shirts for suits Short overcoat for kimono (haori) Short petticoats Short sets [clothing] Short trousers Shorts Shorts [clothing] Short-sleeve shirts Short-sleeved or long-sleeved t-shirts Short-sleeved shirts Shoulder scarves Shoulder wraps Shoulder wraps [clothing] Shoulder wraps for clothing Shower caps Silk scarves Silk ties Singlets Skirt suits Skirts Skorts Skull caps Slacks Sleep masks Sleeping garments Sleepwear Sleeved jackets Sleeveless jackets Sleeveless jerseys Slip-on shoes Slipovers Slipovers [clothing] Slippers Slippers made of leather Slips Slips [clothing] Slips [undergarments] Small hats Smocks Smoking jackets Sock suspenders Socks Socks and stockings Sport shirts Sport stockings Sports caps and hats Sports jackets Sports jerseys Sports jerseys and breeches for sports Sports over uniforms Sports overuniforms Sports shirts Sports shirts with short sleeves Sports shoes \* Sports singlets Sports socks Sports vests Sportswear Stocking suspenders Stockings Stockings (Heel pieces for -) Stockings [sweat-absorbent] Stockings (Sweat-absorbent -) Stoles Stoles (Fur -) Strapless bras Straps (Gaiter -) Stuff jackets [clothing] Suede jackets Suits Suits (Bathing -) Suits made of leather Suits of leather Sun hats Sun visors Sun visors [headwear] Suspender belts Suspender belts for men Suspender belts for women Suspenders Suspenders [braces] Sweat bands Sweat bands for the head Sweat bands for the wrist Sweat bottoms Sweat pants Sweat shirts Sweat shorts Sweat suits Sweat-absorbent underclothing [underwear] Sweat-absorbent underwear Sweat-absorbent underwear Sweatbands Sweaters Sweatjackets Sweatpants Sweatshirts Sweatshorts Sweatsuits Swim briefs Swim suits Swim wear for gentlemen and ladies Swimming caps Swimming caps [bathing caps] Swimming costumes Swimming suits Swimming trunks Swimsuits Swimwear Tabards Tail coats Tam o'shanter Tams Tank tops Tank-tops Tartan kilts Teddies Teddies

[undergarments] Tee-shirts Tennis dresses Tennis pullovers Tennis shirts Tennis shorts Tennis skirts Tennis socks Tennis sweatbands Theatrical costumes Thermal underwear Thermally insulated clothing Thongs Three piece suits [clothing] Ties Ties [clothing] Tightening-up strings for kimonos (datejime) Tights Togas Top coats Top hats Topcoats Tops [clothing] Toques [hats] Track and field shoes Track pants Track suits Tracksuit bottoms Tracksuit tops Tracksuits Trainers Trainers [footwear] Training suits Trench coats Trenchcoats Trews Trouser socks Trouser straps Trousers Trousers for children Trousers for sweating Trousers of leather Trousers shorts Trunks Trunks (Bathing -) T-shirts Tunics Turbans Turtleneck pullovers Turtleneck sweaters Turtlenecks Tuxedo belts Tuxedos Twin sets Umpires uniforms Under garments Under shirts Underclothes Underclothing Underclothing (Anti-sweat -) Underclothing for women Undergarments Underpants Undershirts Undershirts for kimonos (juban) Undershirts for kimonos (koshimaki) Underskirts Underwear Underwear (Anti-sweat -) Uniforms Uniforms for nurses Unitards Uppers (Footwear -) Veils Veils [clothing] Vest tops Vests Waist belts Waist strings for kimonos (koshihimo) Waistbands Waistcoats Warm up suits Warm-up jackets Warm-up pants Warm-up suits Warm-up tops Waterpolo caps Waterproof capes Waterproof clothing Waterproof outerclothing Waterproof pants Waterproof trousers Weatherproof jackets Wedding dresses Wedding gowns Wind coats Wind jackets Women's ceremonial dresses Women's foldable slippers Women's suits Womens' underclothing Womens' undergarments Women's underwear Woollen socks Woollen tights Woolly hats Wrap belts for kimonos (datemaki) Wraps [clothing] Wrist warmers Wristbands Wristbands [clothing] Yashmaghs Yashmaks Yokes (Shirt -) Zori.