

O/794/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO.
UK00003590243 BY ALEXANDER LYDAMORE
TO REGISTER:**

GOOSE SKATEBOARDS

AS A TRADE MARK IN THE UNITED KINGDOM

IN CLASSES 25 AND 28

AND

**IN THE MATTER OF
OPPOSITION THERETO UNDER NO. 425309**

BY GOLDEN GOOSE S.P.A.

BACKGROUND AND PLEADINGS

1. On 4 February 2021, Alexander Lydamore (“the applicant”) applied to register “GOOSE SKATEBOARDS” as a trade mark in the United Kingdom in respect of the following goods:

Class 25: Clothing; Clothes; Tops [clothing]; Hoods [clothing]; Leisure clothing; Sports clothing; Waterproof clothing; Girls' clothing; Casual clothing; Denims [clothing]; Shorts [clothing]; Athletic clothing.

Class 28: Skateboards; Skateboard wheels; Skateboard trucks; Bags for skateboards; Skateboards [recreational equipment].

2. The application was published for opposition purposes on 2 April 2021 and, on 2 July 2021, the application was opposed in its entirety by Golden Goose S.P.A. (“the opponent”). The opposition is brought under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

3. For the purpose of its section 5(2)(b) and 5(3) claims, the opponent relies upon the following trade marks, the relevant details of which are laid out below:

United Kingdom Trade Mark (“UKTM”) 918240635

GOLDEN GOOSE

Filing date: 12 November 2018

Registration date: 15 May 2020

Relies upon:

Class 9: Electronic checking (supervision) devices incorporating microprocessors and accelerometers, for identifying, storing, communicating, monitoring, uploading and downloading data and information in relation to fitness and physical exercise; Downloadable applications and software for smartwatches and mobile devices for managing, checking

(supervision) and modification of data, enabling users to check presentation and the information contained in the aforesaid devices; Wearable sensors for checking (supervision) of fitness and physical exercise enabling biometric data to be collected, incorporating monitors and displays, sold as a single unit; Smartwatches; Wearable activity trackers; Pedometers.

Class 14: Horological articles consisting predominantly of wristwatches incorporating software for sending and receiving data or for monitoring personal physical activity; Bracelets, rings or necklaces incorporating software for sending and receiving data or for monitoring personal physical activity.

Class 18: Leather and imitation leather; Animal skins, hides; Luggage and carrying bags; Umbrellas and parasols; Walking sticks; Whips, harness and saddlery; Collars, leads and clothing for animals; Attache cases; Sport bags; Bags for climbers; Bags for campers; Casual bags; Beach bags; Boston bags; Clutch bags (hand bags); Gym bags; Briefcases [leather goods]; Cross-body bags; Bags for carrying pets; Bags for jewellery of textile materials (empty); Pouch baby carriers; Travelling bags; Saddlebags; Shopping bags; Chain mesh purses; Handbag frames; Tool bags of leather, empty; Bags [envelopes, pouches] of leather, for packaging; Satchels; Bags Game -) [hunting accessories]; Garment bags for travel; Wallets; Net bags for shopping; Suitcases; Briefbags; Card cases [notecases]; Credit card cases [wallets]; Handbags; Hat boxes of leather; Haversacks; Key cases; Music cases; Vanity cases, not fitted; Purses; Backpacks; Suitcase handles; Traveling trunks; Travelling sets [leatherware]; Boxes of leather or leatherboard; Cases of leather or leatherboard; Chin straps, of leather; Fur; Straps (Leather -); Imitation leather; Laces (Leather -); Leather thread; Leatherboard; Leather straps; Collars for animals.

Class 25: Clothing, footwear, headgear, clothing of imitations of leather; Leather clothing; Clothing for gymnastics; Gowns; Bathrobes; Bandanas [neckerchiefs]; Bibs, not of paper; Berets; Boas [necklets]; Suspenders; Corsets; Stockings; Socks; Shirts; Bodices [lingerie]; Hats; Coats; Hoods [clothing]; Belts [clothing]; Belts (Money -) [clothing]; Tights; Shoulder wraps; Detachable collars; Headgear; Layettees [clothing]; Swimming costumes; Masquerade costumes; Beachwear; Neckties; Ascots; Headbands [clothing]; Pocket squares; Jackets [clothing]; Garters; Skirts; Suits; Pinafore dresses; Girdles; Gloves [clothing]; Ski gloves; Rainproof clothing; Knitwear [clothing]; Jumpers; Leg warmers; Leggings [trousers]; Liveries; Hosiery; Sweaters; Muffs [clothing]; Skorts; Boxer shorts;

Waistcoats; Trousers; Parkas; Furs [clothing]; Fur stoles; Pyjamas; Cuffs; Ponchos; Stocking suspenders; Sock suspenders; Brassieres; Sandals; Bath sandals; Shoes; Bath slippers; Gymnastic shoes; Beach shoes; Training shoes; Footwear soles; Shawls; Sashes for wear; Briefs; Topcoats; Outerclothing; Petticoats; Half-boots; Boots; Combinations [clothing]; Visors [headwear]; Wooden shoes; Sweat-absorbent underwear; Earbands; Slips [underclothing]; Short sleeved T-shirts; t- shirts (long sleeved).

UKTM 918238055

GOLDEN GOOSE / ★

Filing date: 27 December 2018

Registration date: 12 May 2020

Relies upon:

Class 9: Electronic checking (supervision) devices incorporating microprocessors and accelerometers, for identifying, storing, communicating, monitoring, uploading and downloading data and information in relation to fitness and physical exercise; Downloadable applications and software for smartwatches and mobile devices for managing, checking (supervision) and modification of data, enabling users to check presentation and the information contained in the aforesaid devices; Wearable sensors for checking (supervision) of fitness and physical exercise enabling biometric data to be collected, incorporating monitors and displays, sold as a single unit; Smartwatches; Wearable activity trackers; Pedometers.

Class 14: Horological articles consisting predominantly of wristwatches incorporating software for sending and receiving data or for monitoring personal physical activity; Bracelets, rings or necklaces incorporating software for sending and receiving data or for monitoring personal physical activity.

Class 18: Leather and imitation leather; Animal skins, hides; Luggage and carrying bags; Umbrellas and parasols; Walking sticks; Whips, harness and saddlery; Collars, leads and clothing for animals; Attache cases; Sport bags; Bags for climbers; Bags for campers; Casual

bags; Beach bags; Boston bags; Clutch bags (hand bags); Gym bags; Briefcases [leather goods]; Cross-body bags; Bags for carrying pets; Bags for jewellery of textile materials (empty); Pouch baby carriers; Travelling bags; Saddlebags; Shopping bags; Chain mesh purses; Handbag frames; Tool bags of leather, empty; Bags [envelopes, pouches] of leather, for packaging; Satchels; Bags (Game -) [hunting accessories]; Garment bags for travel; Wallets; Net bags for shopping; Suitcases; Briefbags; Card cases [notecases]; Credit card cases [wallets]; Handbags; Hat boxes of leather; Haversacks; Key cases; Music cases; Vanity cases, not fitted; Purses; Backpacks; Suitcase handles; Traveling tunks; Travelling sets [leatherware]; Boxes of leather or leatherboard; Cases of leather or leatherboard; Chin straps, of leather; Fur; Straps (Leather -); Imitation leather; Laces (Leather -); Leather thread; Leatherboard; Leather straps; Collars for animals.

Class 25: Clothing, footwear, headgear, clothing of imitations of leather; Leather clothing; Clothing for gymnastics; Gowns; Bathrobes; Bandanas [neckerchiefs]; Bibs, not of paper; Berets; Boas [necklets]; Suspenders; Corsets; Stockings; Socks; Shirts; Bodices [lingerie]; Hats; Coats; Hoods [clothing]; Belts [clothing]; Belts (Money -) [clothing]; Tights; Shoulder wraps; Detachable collars; Headgear; Layettes [clothing]; Swimming costumes; Masquerade costumes; Beachwear; Neckties; Ascots; Headbands [clothing]; Pocket squares; Jackets [clothing]; Garters; Skirts; Suits; Pinafore dresses; Girdles; Gloves [clothing]; Ski gloves; Rainproof clothing; Knitwear [clothing]; Jumpers; Leg warmers; Leggings [trousers]; Liveries; Hosiery; Sweaters; Muffs [clothing]; Skorts; Boxer shorts; Waistcoats; Trousers; Parkas; Furs [clothing]; Fur stoles; Pyjamas; Cuffs; Ponchos; Stocking suspenders; Sock suspenders; Brassieres; Sandals; Bath sandals; Shoes; Bath slippers; Gymnastic shoes; Beach shoes; Training shoes; Footwear soles; Shawls; Sashes for wear; Briefs; Topcoats; Outerclothing; Petticoats; Half-boots; Boots; Combinations [clothing]; Visors [headwear]; Wooden shoes; Sweat-absorbent underwear; Earbands; Slips [underclothing]; Short sleeved T-shirts; t-shirts (long sleeved).

4. Both earlier marks qualify as an acceptable basis to oppose the application at hand, in accordance with section 6 of the Act. As neither had been registered for more than five years at the date of the contested application, neither is subject to the proof of use requirements defined in section 6A of the Act. Consequently, the opponent can rely upon both marks and all goods and services it has identified without providing evidence of use.

5. In respect of its 5(2)(b) claim, the opponent submits that the similarity between the parties' marks, paired with the identity and/or similarity between the respective goods, would result in a likelihood of confusion, including a likelihood of association. For the purpose of its claim under section 5(3), the opponent contends that, were the applicant to use the contested mark, it would derive an illegitimate benefit from the presumed association by free-riding on the coat tails of the opponent's reputation. It further contends that such use would tarnish the reputation of the earlier marks and dilute their distinctive character.

6. In its counterstatement, the applicant concludes that the parties' marks share a low degree of similarity and effectively denies that the relevant public would be likely to consider that the goods provided under the applied-for mark originate from the opponent or an associated undertaking. In reply to the opponent's pleading under section 5(3), the applicant denies the allegations of free-riding, tarnishing and dilution. He also highlights that there is no evidence to suggest that the applicant nor his undertakings engage in any disreputable behaviour.

7. The opponent is represented by Potter Clarkson LLP and the applicant is unrepresented. Only the opponent filed evidence during the course of these proceedings, which will be summarised to the extent that it is considered necessary. The parties were given the option of an oral hearing and though neither asked to be heard on the matter, the opponent elected instead to file written submissions in lieu. Again, I do not intend to summarise these but will refer to them throughout this decision, as and where necessary. This decision is taken following a careful perusal of the papers before me, keeping all submissions in mind.

EVIDENCE

Opponent's evidence in chief

8. The opponent's evidence comprises a witness statement from Mr Paolo Dal Ferro, Chief Financial Officer for the opponent, dated 14 February 2022 and supported by exhibits EXH1 to EXH15.

9. The opponent's company is based in Italy and was founded in 2000 by Francesca Rinaldo and Alessandro Gallo after collaboration with an established Venetian tailor. Mr Dal Ferro submits that the company immediately stood out for its high quality products and that its aesthetic earned the brand a vast international following, putting it among the most sought-after brands in the contemporary fashion industry. The GOLDEN GOOSE product line includes goods such as footwear, clothing, bags and accessories. At Exhibit 1 Mr Dal Ferro provides an extract from the opponent's website alongside pages from its 2017 and 2019/20 catalogues. He explains that the product catalogues are available in the English language and have been circulated in the UK. Examples of those extracts are shown below:



Pale mauve cropped Journey Collection hooded sweatshirt with tone-on-tone Golden lettering on the back

£260.00



Pastel lilac round-neck Journey Collection pullover with distressed finish and silver-colored lettering

£405.00



Cropped Journey Collection hooded sweatshirt in gray with dark blue Golden lettering

£260.00



Super-Star sneakers with black glitter star and old-rose leather heel tab
£410.00



Super-Star Sabots in white leather with blue glitter star and dove-gray suede tongue
£410.00



Super-Star sneakers with Sneakers Lover print
£410.00



DRESS: CHIERO 035WPC056A1 — LEGGINGS: NORI 035WPC056A2 — BOOTS: WISH STAR 035WPC056B3
 PILET: SHONI 035WPC056A5 — BIANCHIA: ANA 035WPC056A6



10. At EXH2 is an article dated 16 June 2020 published in Italian publication *Il sole 24 ore*, headed “Permira perfects the purchase of Golden Goose, ex Chanel CEO becomes

¹ Golden Goose Deluxe Brand (Venezia): Foreword – FW2019/20; Spring Summer 2017/18; Spring/Summer 2017 MAN

non-executive president”². Further text from the article reads “...Golden Goose is considered a luxury “hare”: in less than twenty years it has passed from the core business of artisan sneakers to the total look and today the brand is present in Europe, United States and Asia, with a network of 100 direct-managed stores and a rapidly growing online presence...”.

11. An article dated 19 May 2015, enclosed at Exhibit EXH3, shows that Italian private equity fund DGPA Capital acquired a 75% stake in the opponent’s company in 2013, estimated at EUR45 million³. Mr Dal Ferro submits that this prompted GOLDEN GOOSE to expand internationally, specifically by way of opening flagship and corner stores in Milan, Seoul, Paris, Tokyo, Beirut and Amsterdam. The article states that the GOLDEN GOOSE label is available in 45 U.S. department stores and that it was looking for a suitable location in London, hoping to debut in 2016.

12. An article in *Fashion United* of 26 May 2015, enclosed at EXH4, is headed “Ergon Capital pays more than 100 million (EUR) for Golden Goose”. Mr Dal Ferro points to the section of the article which cites a quote from CEO Roberta Benaglia. It reads:

“Thanks to the work of our harmonious team, the target of doubling the turnover in three years within 2016 has been reached one year in advance (from 29 million to 73 million euros in 2015)”.

13. At EXH5 are extracts from an article published in Financial Times⁴ on 2 February 2017 which confirms that Golden Goose Deluxe Brand was purchased by US buyout group Carlyle for EUR400m. The article reads:

“Established in 2000 with headquarters in Venice, Golden Goose sells shoes that can cost up to EUR400 a pair, which have a well-known star design.

The company, which also sells leather jackets and tshirts, has benefited from a fast-growing high-end lifestyle fashion sector. It occupies a strong position in the luxury sneaker market worldwide.

² Translation provided by the opponent

³ <https://wwd.com/>; 19 May 2015

⁴ www.ft.com

The company generated revenues of more than EUR100m last year, with international markets accounting for almost 60 per cent of such revenues.”

14. As shown in a further Financial Times article enclosed at EXH6, in 2020 Golden Goose was acquired by private equity firm Permira for just under EUR1.3billion. The article refers to the brand’s sneakers attracting a ‘celebrity following’ including Taylor Swift, Gwyneth Paltrow and Jude Law. The article also states that revenues rose from EUR140million when Carlyle purchased it in 2017 to more than EUR260million last year [2020], with trainers making up approximately 80 per cent of its revenues. A principal at Permira, Ms Tara Alhadeff, said the acquisition was “really about backing the sneaker trend”.

15. Of the company’s financial position, Mr Dal Ferra submits that the sales figures for products bearing the GOLDEN GOOSE mark in the EU between 2015 and 2020 reached nearly EUR500million. At EXH7 is a declaration regarding the opponent’s turnover and marketing expenses (reproduced below) and Mr Dal Ferra also provides turnover figures related specifically to the United Kingdom, also below:

DECLARE

that the turnover relating to sales in the **European Union** of products bearing the trademarks: GOLDEN GOOSE word no. 18240635 (UE) and **GOLDEN GOOSE / *** no. 18238055 (UE) from 2015 to 2020, amount to Euro:

2015	2016	2017	2018	2019	2020
52.987.183	62.843.757	82.391.722	89.492.768	111.238.695	98.617.590

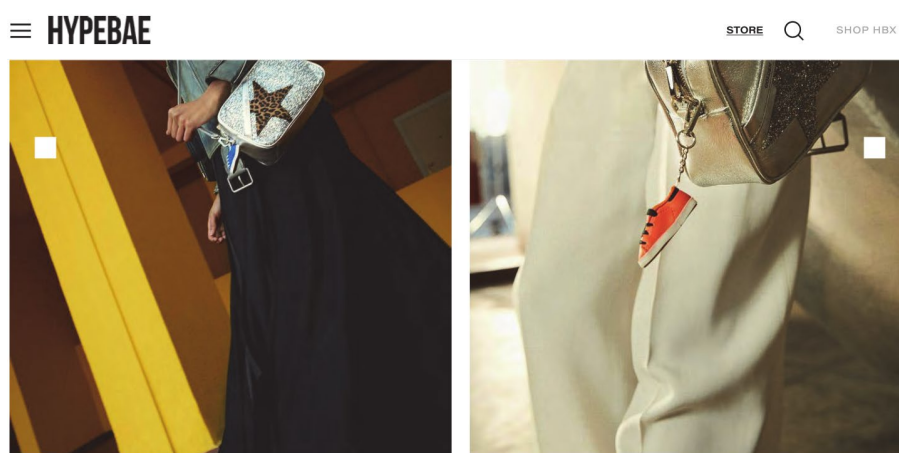
Moreover, the marketing expenses supported by Golden Goose S.p.A. from 2015 to 2020 amount to Euro:

2015	2016	2017	2018	2019	2020
1.691.054	3.078.178	4.117.977	4.565.260	4.121.462	4.197.502

Year	Turnover (€)
2015	3,256,282
2016	6,251,333
2017	11,144,345
2018	13,790,332
2019	20,492,729
2020	17,445,321
Total	72,380,342

16. Whilst the pages are undated, extracts from the opponent’s website⁵ enclosed at EXH8 show that it operates a number of flagship stores in the UK, specifically London, and a number of European member states including Austria, Belgium, Germany, Denmark, Spain, France, Italy, The Netherlands and Portugal. At EXH9 is a WWD article dated 11 June 2016 announcing the opening of the first Golden Goose London store. The article states that Golden Goose is “Known for its roughed-up, patchwork leather sneakers with built-in platforms, the brand is carried by retailers including Browns, Selfridges, Harvey Nichols, Matchesfashion.com and Net-a-porter.” The article also reveals that Golden Goose notched double-digit growth in Britain in the three years prior and that the brand was set to post revenues over 100 million Euros; 32 percent higher than the previous year.

17. At EXH10 are a number of 2020 and 2021 articles, some surpassing the relevant date, from UK publications or publications available to UK consumers featuring the opponent’s goods. A sample of those are shown below:



FASHION
GOLDEN GOOSE KICKS OFF AN OPTIMISTIC NEW YEAR IN LATEST RESTAR CAMPAIGN

Featuring ready-to-wear apparel and the brand's signature distressed sneakers.

By YeEun Kim Jan 9, 2021 1.1K

⁵ www.goldengoose.com

Leopard Print Lovelies: Top Clothing & Accessory Selects



Felicity Carter Contributor
Style & Beauty

Follow

Superstar Sneaker by Golden Goose: Sneaker favorite Golden Goose have merged leather and suede with sequin embellishment and then there's the velvet applique. Italian made and intentionally distressed (a brand signature) wear with your favorite jeans.



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18. At EXH11, Mr Dal Ferro encloses an array of articles which feature the opponent's goods in UK and EU publications from 2015 to 2019, broken down by country. A sample of those are reproduced below:

21/02/15	In Touch GER - Style	
N° 1	Circulation: 85000	
Pag. 20	<i>Trendoptik</i>	
	Golden Goose	
	Scarf	

TRENDOPTIK Streifen



Satte Juwelennuancen mit schimmerndem Finish – für diese Luxus-Liner heißt es jetzt „volle Fahrt voraus“!



IN THE MIX
Edelstahluhr mit Stoffarmband. Nixon, ca. 89 Euro.

HAPPY HOUR
Asymmetrisches Cocktailkleid. Oasis, ca. 59 Euro.



NICOLE RICHIÉ (33)
It-Girl Nicole trägt dem hippen Print-Rock von Alberta Ferretti zum Blumen-Top des gleichen Labels.

SOFTIE
Tuch aus Wolle und Seide. Golden Goose, ca. 88 Euro.

01/01/16	Il Sole 24 Ore ITA - IL	
N°77	Diffusione 265.743	
Pag.118	Cose, stili e tendenze	
Golden Goose Deluxe Brand, Pantaloni		
Mimo Visconti, Redattori/Stylist		Daria Riva, Truccatori/Parrucchieri

Journal Cose, stili e tendenze

01. BROOKSFIELD
Blazer destrutturato monopetto in lana a due bottoni (289 euro); maglione in lana girocollo (135 euro). **ALPHA STUDIO**, pantaloni in lana grezza con coulisse in vita (135 euro). **GOLDEN GOOSE DELUXE BRAND**, stivaletti in pelle con motivo coda di rondine, doppia banda elastica ai lati e suola carrarmata (169,50 euro). **NERO GIARDINI**.

02. SARTORIA LATORRE
Giacca monopetto in lana disegnata in principe di Galles moderno (699 euro) e pantaloni a signoretta con pinces in cotone jacquard (169 euro). Maglione in cashmere girocollo (443 euro). **JAMES PERSE**, 24 ore in pelle morbida con doppio bottono chiusura centrale e tasche laterali (194 euro). **NERO GIARDINI**.

03. BOGLIOLI
Giacca doppiopetto in lana destrutturata principe di Galles (1.240 euro), maglione in cashmere (448 euro) e pantaloni in velluto a coste con pinces in vita (286 euro).

04. TOMBOLINI
Giacca in lana e cashmere monopetto a due bottoni (807 euro). Maglione in lana con collo alto e bottoni a treccia (202 euro) e pantaloni in velluto a microquadri slim fit (215 euro), tutto **LA MARTINA**.

05. L.B.M. 1911
Giacca in lana a quadri monopetto (da 550 euro). Maglione in lana a coste (150 euro). **GANT RUGGER**, pantaloni (275 euro).

01/01/17	Good Housekeeping UK	
N° 13	Circulation: 443750	
Pag. 115	style	
Golden Goose		
Sport shoes		

GH to the RESCUE

STYLE

It's top-to-toe glamour this season for our champion of style

Wendy Rigg
FASHION EDITOR

December is a whirl of drinks parties with fashion insiders, and for me it's all about relaxed glamour. I'll be investing in super-stylish tuxedo pants, which will work with different tops, and flats or heels. It's always tricky attending fashion events - someone else is always guaranteed to be wearing the same thing! So I prefer to wear some vintage, or shop from under-the-radar brands. I go to Rixolondon.co.uk for unique prints on pussy-bow blouses, and I love my vintage-style tops and jackets from Southendandco.co.uk. At home, we check out Christmas tree with trinkets collected over the years - and a fairy ballerina who has graced the top spot for as long as I can remember. Her skirt is

I always buy my Mum a **Liberty print blouse** as she loves the traditional floral. Blouse, £39, 8-16, Liberty (liberty.co.uk).

Introduce the men in your life to coburnage they may not have thought of. Scarf, £55, Jaeger (jaeger.com).


My niece and I love to buy **buying fishbones** as I love to buy them online. Princess coat, £200, Kate Spade (katespade.com).

There's nothing better than yet another pair of trainers, and these Golden Goose ones caught my eye. Trainers, £290, 36-41, Golden Goose (thefetch.com).

Shoes come first for cool teens. I have gift boxes hidden in my

Friends and my sister love bags and pouch pyjamas. Metallic bag, £390

What I'll be giving
Here's Wendy's travelling-home-for-Christmas-list

01/01/17	Cosmopolitan UK	
N° 13	Circulation: 400575	
Pag. 56	Wear	
	Golden Goose	
	Jeans	

Wear

THE JEANIUS... RIPPED JEANS

This month, **Amy Bannerman** works out if she's ready to let rip with torn denim

OK, I'm coming clean in the name of honest journalism. I don't like ripped denim. Or I didn't until I started work on this page and researched ripped styling, past and present. I have concluded that there is a science to wearing this look well. At no point should your whole thigh be out – where it looks like you were browsing Tinder on an escalator, face-planted and half your jeans got ripped off. Khloé Kardashian is a fan of this look. I'm sure she's keen to show off her bod, but I feel a bit annoyed at paying for holes. Surely if you want to show that much skin you just wear shorts, non?

If you want to join the ripped-denim massive, jeans must either be super-tight and black with minimal, subtle rips (see Hailey Baldwin) – a tight pair in a pale wash will make you look like a sausage auditioning for *Britain's Next Top Sausage* – or classic blue non-stretch with rips that look like they've occurred through wear and fun times (see Fei Fei Sun). Rips on the hemline are a solution for those who don't want to flash too much leg – chop the hem off any jeans with sharp fabric scissors, then wash and tumble dry to speed up the fraying process (the less stretch in the fabric, the shaggier the fraying), or try ReDone's new 'No Waiste' numbers. They've removed the waistband, so no more jeans digging in to give that two-tummy silhouette. Whichever variation on ripping you settle on, it'll make your outfit look cooler, because the thing about ripped jeans is that they're for rebels. I can report, hand-on-heart, that I am writing this wearing my subtly ripped Current Elliott pale-blue basics, but annoyingly this meant I had to shave my legs this morning in preparation for their outing. Oh yeah, I forgot to mention that bit. BORRRRINGGGGGG.

MY FAVES
Amy wears: Jumps, £79.99, New Look.
Above right: £38, Guise.
Far right: £55-£49.5, Below: £306, Golden Goose at MatchesFashion.com.

Jeans, £99, Toast

Bandana, £32, Free People

Boots, £69.99, Zara

Hailey Baldwin


Fei Fei Sun

STYLING: STEPHANIE LIAO; HAIR: NICK FERRARIS; GROOMING: GUY AARON; MAKEUP: AMY WATSON; JACKET AND DEN: VINTAGE; SHOES: ZARA; GOLDEN GOOSE: GOLDEN GOOSE


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17/03/17	Wall Street Journal Europe UK	
N° 76	Circulation: 1876928	
Pag. 22	Ed Europe - SIGNED, SWEET, DELIVERED	
	Golden Goose	
	Sport shoes	



01/04/18	Elle SPA	
N° 379	Circulation: 171347	
Pag. 66	<i>El toque maestro</i>	
	Golden Goose Deluxe Brand	
	Jeans	



23/04/18	Grazia UK	
N° 675	Circulation: 138992	
Pag. 55	<i>All out americana</i>	
	Golden Goose	
	Trousers	






THE SUN
April 26, 2018
REACH: 3,740,836



19. Enclosed at Exhibit 12 is a (what I presume to be internal) marketing report dated 19 June 2019 and headed 'VIPs WEARING GOLDEN GOOSE'. The report features photographs of different celebrities wearing Golden Goose goods, alongside a brief biography and the number of their Instagram 'followers'. Celebrities include Taylor Swift, Reese Witherspoon and Chris Hemsworth (as shown below). The report also states which country the celebrity originates from, with some originating from the USA, though Mr Dal Ferro submits that consumers in the UK and EU tend to be familiar with, and "follow", US celebrities, given the 'global reach' of US media productions.


VIPs wearing GG 08.06.2019



Taylor Swift

Singer
[taylorswift](#) 115M followers
USA

BIO: Taylor Swift is an American singer-songwriter. As one of the world's leading contemporary recording artists, she is known for narrative songs about her personal life, which has received widespread media coverage. (29 years old)



Marketing Office GOLDEN GOOSE / ★



Reese Witherspoon

Actress
[reesewitherspoon](#) 16.8M followers
 USA

BIO: Reese Witherspoon is an American actress, producer, and entrepreneur. She is the recipient of several accolades, including an Academy Award, a Primetime Emmy Award, a BAFTA Award, a Screen Actors Guild Award, two Golden Globe Awards and two Critics' Choice Awards. (42 years old)



Marketing Office

GOLDEN GOOSE / ★



Chris Hemsworth

Actor
[chrishemsworth](#) 25.4M followers
 Australia

BIO: Christopher Hemsworth is an Australian actor. He rose to prominence playing Kim Hyde in the Australian TV series Home and Away. Hemsworth has also appeared in Star Trek, A Perfect Getaway, The Cabin in the Woods, m Snow White and the Huntsman, and many more. Thor and Avengers.



Marketing Office

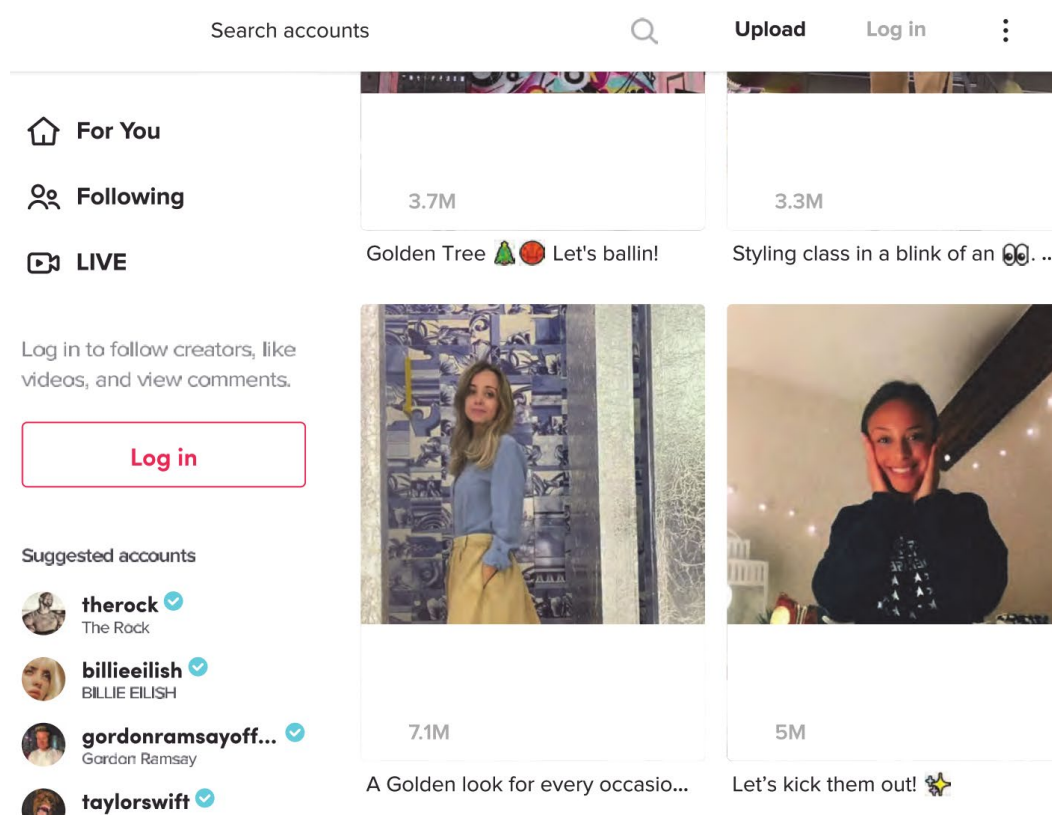
GOLDEN GOOSE / ★

20. In the music video of British artist Noel Gallagher, more specifically his band 'High Flying Birds', for "Everybody's On The Run", viewed on YouTube nearly 5 million times, the opponent's GOLDEN GOOSE trainers are featured repeatedly. Extracts are provided at Exhibit 13 including the image shown below:



21. At Exhibit 14, the opponent shows that it utilizes various social media channels to promote its brand. A screenshot of its Instagram profile "goldengoose" shows that it has

amassed 893,000 followers. Its posts on Tik Tok can accumulate up to 7.1 million views per post, as shown below. A video concerning the history of the Golden Goose brand, subtitled 'Where Everything Began', was posted to You Tube on 22 January 2021 and has generated over 100,000 views.



22. Mr Dal Ferro submits that the opponent also promotes its brand by participating in trade shows in 'key fashion locations'. By way of example, it encloses extracts at Exhibit 15 pertaining to the Luxury Law Summit (Europe) held in London (though conducted as a Virtual Event) on 3 September 2020. The extracts include a biography of Mr Silvio Campara, who was appointed to CEO of Golden Goose in September of 2018. The summit and associated conferences are referred to as "must attend events each year for business leaders and leading counsel for the luxury sector".

Preliminary matter: state of the register

23. I note the following extract from the applicant's counterstatement and intend to respond briefly, below.

“...it is noted that the Opponent’s statement of grounds hinges seemingly entirely upon the overlap of the element ‘GOOSE’ in the marks. However, it is respectfully submitted that the Register contains multiple such marks in class 25 (for example) that have accrued comparable reputations. An example for the Examiner’s consideration would be ‘CANADA GOOSE’.

Thus, a negative conclusion for the Applicant would be inconsistent with such a state of the Register. That is, taking the above example of ‘CANADA GOOSE’, it is submitted that the average consumer of goods/services in class 25 and associated classes has come to distinguish between marks containing ‘GOOSE’ by the other elements in the mark, thus the Opponent cannot validly lay claim to any reputation being acquired from the element ‘GOOSE’ alone.”

24. Absent of any evidence or supporting argument, the existence of such marks on the register will not have any bearing on the outcome of these proceedings. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II 4865, paragraph 68, and Case T 29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II 5309, paragraph 71). “

25. That line of the applicant’s reasoning will therefore play no part in my considerations as to a likelihood of confusion.

DECISION

Section 5(2)(b)

Legislation and case law

26. Sections 5(2)(b) and 5A of The Act read as follows:

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

[...]

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

28. The applied for goods and those relied upon by the opponent are laid out at paragraphs 1 and 3 of this decision.

29 Both specifications feature the term *clothing* in class 25. These are literally identical.

30. Where goods or services are not literally identical, the GC laid out a further provision for identity in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, where it stated:

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

Clothes; Tops [clothing]; Hoods [clothing]; Leisure clothing; Sports clothing; Waterproof clothing; Girls' clothing; Casual clothing; Denims [clothing]; Shorts [clothing]; Athletic clothing.

31. The opponent relies upon *clothing*, in class 25. To my mind, in accordance with the *Meric* principle, this encompasses all of the terms for which the applicant seeks registration in the same class. All of the applicant's class 25 goods are therefore to be considered identical.

32. In my comparison of the remaining goods, I will consider factors including their nature, intended purpose, method of use and whether they are in competition or are

complementary.⁷ In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

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

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

Bags for skateboards

⁷ *Canon*, Case C-39/97

34. The opponent relies upon *sport bags* which, to my mind, refers to bags which are utilised to store or transport sporting equipment or accessories, for example. Given that skateboarding is recognized as both a recreational activity and a sport, such equipment could include skateboards themselves. I must, however, acknowledge that the goods are in different classes and am therefore minded to conclude that the goods are (at least) highly similar. The goods are closely tied in their use, will likely share users and channels of trade and could occupy both competitive and complementary roles.

Skateboards; Skateboard wheels; Skateboard trucks; Skateboards [recreational equipment]

35. The opponent relies upon *sport bags*. Whilst such bags will be used to transport or store sports equipment (which could include skateboards or skateboarding accessories), the above goods are used to facilitate the activity or sport itself, being either skateboards or parts thereof. The users of the respective goods are likely to be shared. There will not be any great deal of similarity in the goods' physical nature, though some compatibility will be considered. The trade channels are likely to be the same, or at least similar, though the goods are not competitive. The goods do, however, share a degree of complementarity and would likely be used, and sold, alongside one another and, in my experience, it would not be unusual for an entity offering skateboards themselves, and their parts, to also offer bags intended to house such goods. On balance, I find a medium degree of similarity.

The average consumer and the nature of the purchasing act

36. 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 (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

37. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, 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.”

38. The average consumer of the goods is likely to be a member of the general public, with the goods generally being self-selected from a traditional high street retail outlet or online equivalent. With that in mind, the marks’ visual impact is likely to play the greater role, though I do not discount the relevance of the marks’ aural positions as recommendations could be sought from sales assistants, for example. The goods are generally purchased fairly frequently, though less so in respect of the applicant’s class 28 goods, and the price can vary fairly widely. Nevertheless, the consumer will likely be alive to considerations such as compatibility, quality and sustainability during the selection process for all goods. Weighing all factors, I find the average consumer will typically apply a medium degree of attention to the purchase.

Distinctive character of the earlier marks

39. In *Lloyd Schuhfabrik Meyer & Co. GmbH*, the Court of Justice of the European Union (“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).”

40. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services for which they are registered, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will typically fall somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

41. I begin by considering the inherent distinctiveness of the opponent's word only mark. Whilst it comprises two ordinary words with which the average consumer will be entirely familiar, to my mind, the words have no relationship to the goods on which the opponent relies for the purpose of the opposition; I cannot identify any allusive nor descriptive properties. On balance, I find the mark's inherent distinctiveness to be of a medium degree.

42. The opponent's figurative mark comprises the same two words (GOLDEN GOOSE), alongside a forward slash and a depiction of a partial star. Particularly given that the mark's figurative elements are likely to be seen as decorative and make little impact on the mark's distinctive character, I find the inherent distinctiveness of the figurative mark to be of a medium degree.

43. I will now consider whether the distinctiveness of the earlier marks has been enhanced as a result of the use made of them. The relevant market for an assessment of enhanced distinctiveness is the UK market specifically. The opponent opened its first London store in 2016 and the evidence shows that it operates a number of London stores and its website caters to the UK consumer, currently at least. Its product catalogues are circulated in the UK, with extracts provided from 2017 and 2019/20, though it is not clear how widely. The opponent's goods have featured in a range of publications, be it online or in print, either specifically targeting or available to, consumers in the UK; some with a considerable readership, including those which are UK-based publications. The opponent's annual turnover in the UK is sizeable (exceeding EUR20million in 2019 and EUR17million in 2020), though I accept that the apparel market, at large, is likely to be vast and I do not have an indication of its specific share. Whilst its turnover is not separated into distinct goods, and footwear is heavily featured in the opponent's evidence, the mark is clearly used on a range of clothing goods and has further been featured on a variety of clothing products in UK publications. As to the number of celebrities spotted wearing the opponent's goods, I agree that many of them are likely to be followed by UK consumers and that they have somewhat of a 'global reach', as submitted by Mr Dal Ferro in his statement. The number of views amassed on Youtube by the High Flying Birds music video which heavily features the opponent's footwear is significant but simply because the video belongs to a British artist I cannot assume that

the viewers are predominantly UK-based, nor can I assume that those views occurred prior to the relevant date. I find the marketing expenditure substantial but I do not have sight of the expenditure relating solely to the UK, only the EU at large, though the turnover would suggest that a fair amount can be attributed to the UK⁸. Notwithstanding the deficiencies I have noted, I am satisfied that the evidence supports a finding of enhanced distinctiveness. Reflecting on the evidence as a whole, I find the distinctiveness of the marks relied upon by the opponent has been enhanced to a degree between medium and high in respect of clothing and footwear.

Comparison of trade marks

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

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

45. It would be wrong, therefore, to artificially dissect the trade marks, though it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

46. The trade marks to be compared are as follows:

⁸ The opponent's UK turnover from 2015-2020 is laid out at paragraph 15 of this decision

Opponent's marks	Applicant's mark
<p data-bbox="197 309 464 338">UKTM 918240635:</p> <p data-bbox="188 416 584 461">GOLDEN GOOSE</p> <p data-bbox="188 562 456 591">UKTM 918238055:</p> <p data-bbox="188 674 699 719">GOLDEN GOOSE / ★</p>	<p data-bbox="823 477 1385 521">GOOSE SKATEBOARDS</p>

47. The opponent's word only mark comprises two words of six and five letters, respectively. The words hang together and neither is necessarily more dominant than the other, though GOLDEN will naturally be viewed as an adjective serving to qualify or describe a quality of the word which follows it (GOOSE), which becomes the subject of the mark. The mark's overall impression resides in the unit created by the two words it comprises.

48. In its figurative mark, the words GOLDEN GOOSE are presented in upper case in a fine yet unremarkable font and they precede a forward slash and a partial depiction of a black star, with some of the left side omitted. With the figurative elements likely to be viewed as decorative, the mark's overall impression lies predominantly in its word elements, and my above comments apply.

49. The applicant's mark combines two words of five and eleven letters; GOOSE SKATEBOARDS. The mark's overall impression lies in the mark as a whole, though the words do not hang together. GOOSE is likely to carry a greater weight; in the case of the class 25 goods, SKATEBOARDS could be considered suggestive of the nature of the goods. The clothing could target those in the skateboarding community, for example, or the clothing could possess a 'skater' style. GOOSE plays a greater weight still in the case of the applicant's class 28 goods, where SKATEBOARDS plays a directly descriptive role.

The opponent's word only mark

50. Both marks consist solely of two words. Visually, the marks clearly coincide in the word GOOSE, being the second word of two in the opponent's mark and the first of two words in the applicant's mark. Additionally, both marks begin with the letters G-O. There is little similarity in the words with which GOOSE is paired in the respective marks, GOLDEN and SKATEBOARDS, and they occupy different positions within the marks. Weighing those considerations, notwithstanding the identical element GOOSE, I find the visual similarity fairly low.

51. Aurally, the earlier mark will likely be articulated in three syllables; GOLE-DUN-GOOSE. The applicant's mark will likely also be articulated in three syllables, specifically GOOSE-SKATE-BORDS. The marks share an identical syllable in GOOSE, albeit in different positions, and both marks comprise three syllables. Weighing those similarities against the differences between the remaining syllables, I find the aural similarity to be fairly low.

52. I note the applicant's comments regarding the conceptual position of the opponent's 'GOLDEN GOOSE', defined as "a continuing source of wealth or profit"⁹. It also submits that it has featured in a number of folk tales and legends, which marries with my own understanding. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer, and it is from the perspective of the average consumer that I must consider the likely concept evoked by the respective marks.¹⁰ In my view, for the average consumer, the term GOLDEN GOOSE is likely to be readily understood fairly literally as a goose which is golden in colour, or perhaps a goose which lays golden eggs, reminiscent of the fable or tale. The concept conveyed may consequently carry an element of luck or fortune, for example. Both words in the applicant's mark will be easily understood; a goose as a water bird and skateboards as a board on wheels which users ride upon. The respective marks are tied conceptually in their incorporation of a goose. The goose is absent of any descriptive insight or 'lucky' conceptual connotation in the applicant's mark, and 'SKATEBOARDS' introduces a concept absent to the opponent's

⁹ The applicant cites Oxford Dictionaries in its counterstatement

¹⁰ *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29.

mark, though I must weigh those findings against what I have made of the marks' overall impressions. I find the conceptual similarity to be of at least a medium degree.

The opponent's figurative mark

53. Visually, the marks both contain two word elements and they share an identical word element in GOOSE, albeit in different positions. Their second words differ in length and the opponent's figurative mark also incorporates a forward slash and an image of a partially complete star. On balance, I find the visual similarity of a low degree (less than that I have found in the word only mark).

54. As the figurative details in the opponent's second mark are unlikely to be expressed orally, I find it will be articulated identically to the opponent's word-only mark. My earlier reasoning therefore applies and I find the marks aurally similar to a fairly low degree.

55. Particularly given what I have found regarding the mark's overall impression, the figurative elements in the opponent's mark are unlikely to contribute any conceptual significance. Consequently, I refer to my above conclusion regarding the marks' conceptual similarity. I find the marks conceptually similar to at least a medium degree.

Likelihood of confusion

56. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion.

57. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

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

59. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where he 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.”

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

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

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

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

60. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

61. I begin by considering a likelihood of direct confusion. As the case law explains, this is a simple matter of the average consumer mistaking one mark for the other. I have found the inherent distinctiveness of the earlier marks to be of a medium degree and that the distinctiveness of the opponent’s earlier marks has been enhanced to above a medium degree (in respect of clothing and footwear). I have further found the visual similarity between the respective marks of a fairly low or low degree, and that visual considerations are likely to play the largest role in the selection process. The average consumer is likely to apply a medium degree of attention to its selection of the goods. Even when I consider a likelihood of confusion in respect of identical goods, to my mind, the marks’ differences

will not be overlooked. The consumer may identify a common element in GOOSE, but I do not find it likely that it would mistake one mark for the other. Having reached that conclusion in respect of identical goods, it follows that the likelihood of confusion is lesser still in relation to goods which are similar to only a medium or highly similar degree. There is no likelihood of direct confusion.

62. Consideration of a likelihood of indirect confusion calls for a more multifaceted assessment. It requires acknowledgement of a thought process on the part of the average consumer in which it identifies the marks' differences but attributes the marks' similarities to them originating from a single or related origin. It is important to note at the outset that a finding of indirect confusion is not to be considered a consolation prize for failing to find direct confusion; it requires a proper basis¹¹. The examples provided in *L.A. Sugar* offer a helpful indication of the circumstances in which indirect confusion may arise, but they are not intended to be exhaustive. Throughout my assessment I keep in mind the enhanced distinctiveness of the earlier marks. The word GOOSE has no relationship to the goods at hand and is a shared concept in both parties' marks. It is the conceptual 'subject' of the earlier marks and the word which carries the greater distinctive weight of two words in the application. Though I keep in mind what I have said regarding the conceptual impact of pairing GOLDEN with GOOSE, insofar as it becomes reminiscent of the folktale, in the context of the parties' class 25 goods, in my experience it would not be unusual for a single brand to offer different ranges in this field and the consumer would, in my view, readily identify a common element in GOOSE. *GOLDEN GOOSE*, for example, could therefore be seen as an indication of a high-end range of clothing and *GOOSE SKATEBOARDS* as a nod towards the goods' nature or intended consumer; those with an interest in skating or skateboarding perhaps, though that is only an example. I also keep in mind the effect of the interdependency principle, in which any lesser degree of similarity between the respective marks can be offset by a greater degree of similarity, or an identity, between the respective specifications. In the case of the applicant's class 28 goods, whilst I have found only a medium degree of similarity, or a high degree in the case of *bags for skateboards*, and I keep in mind that the earlier marks' enhanced distinctiveness extends only to clothing and footwear, an even greater weight and distinctiveness is placed on the later mark's GOOSE element on account of the descriptive nature of SKATEBOARDS and it is the distinctiveness of the common element

¹¹ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

which is key to my assessment. In respect of all goods, GOOSE, while an ordinary dictionary word, its presence in both marks may be perceived as unusual and considered more than coincidental. Consequently, the consumer may erroneously conclude that the respective marks originate from a shared or at least related entity, both incorporating the term 'GOOSE' and trading in identical or similar goods. In other words, I find a likelihood of indirect confusion.

Section 5(3)

Legislation and case law

63. Section 5(3) of the Act states:

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

64. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oréal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas-Salomon, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oréal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oréal v Bellure*).

65. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its earlier mark has achieved a level of knowledge, or reputation, amongst a significant part of the public. Secondly, the opponent must establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods or services are similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

66. The relevant date for the assessment under section 5(3) is the date the application was filed, namely, 4 February 2021.

Reputation

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

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

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

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

Reputation

68. The opponent’s company was launched in 2000 in Italy, though much of the evidence dates from 2015 onwards. I do not have sight of the market share held by the opponent, but the size of the relevant market is likely to be vast. The articles featuring in the evidence show an increasing value placed on the company’s worth, gathering some momentum, with interest shown from a number of investors and equity firms. Sales of Golden Goose goods reached nearly EUR500 million between 2015 and 2020 in the EU. Its turnover in the UK alone stood at EUR3,256,282 in 2015, 6,251,333 in 2016, 11,144,345 in 2017, 13,790,332 in 2018, 20,492,729 in 2019 and 17,445,321 in 2020. As for its investment in the promotion of its brand, the opponent’s marketing expenses totalled EUR1,691,054 in 2015, 3,078,178 in 2016, 4,117,977 in 2017, 4,565,260 in 2018, 4,121,462 in 2019 and 4,197,502 in 2020. In the years prior to the relevant date the evidence shows the opponent’s goods featured in a wide number of publications across the EU, including the UK, many with significant readership, and its goods have been spotted on a number of high profile figures and celebrities likely to, and shown to have, a wide following (though I accept this is not limited to the EU or UK). Similarly, whilst not divided according to geographical location, there is shown to be what I would consider a significant following toward the opponent’s social media channels. With regards the goods featured in the evidence, though much of the attention is directed toward the opponent’s footwear, its trainers specifically, and, at one time, these appear to have been the driving factor behind its success and what the brand was “known for”¹², the evidence shows use across a wide range of clothing and footwear goods for men,

¹² See EXH6, EXH9

women and children. I am satisfied that the evidence suggests that a significant part of the relevant EU public, and indeed the UK public, had an awareness of the earlier mark at the relevant date. The evidence shows a strong reputation in clothing and footwear.

Link

69. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

I have found the conflicting marks visually similar to a fairly low or low degree, aurally similar to a fairly low degree and conceptually similar to at least a medium 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

I have found the parties' respective goods identical, highly similar or similar to a medium degree.

The strength of the earlier mark's reputation

I have found the mark to enjoy a strong reputation in clothing and footwear.

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

I have found the inherent distinctiveness of the earlier marks to be of a medium degree, and found the distinctiveness enhanced to between a medium and high degree on account of the use made of it in relation to clothing and footwear.

Whether there is a likelihood of confusion

I have concluded that there exists a likelihood of indirect confusion.

70. I have found the earlier marks' distinctiveness to have been enhanced to between a medium and high degree. The respective goods are similar to a medium degree, high degree or are identical. Weighing all previous findings, I have found that the average consumer will erroneously conclude that the marks originate from a shared or related entity. Taking all of this into account, particularly the enhanced distinctiveness of the opponent's marks and the strength of its reputation, it is my view that a significant part of the relevant public will make the requisite link between the respective trade marks. I reach that conclusion having borne in mind the limitation to the opponent's enhanced distinctiveness and reputation, extending only to *clothing and footwear*, and that the conflict with the applicant's class 28 goods is against the opponent's *sport bags*. Still, in regards those goods, I have found a greater weight placed upon the application's GOOSE element and, nonetheless, it is not a requirement for section 5(3) that the goods be similar. On reflection of the strength of the opponent's reputation and the enhanced distinctiveness awarded to the mark in the UK, I find it likely that a link will be made insofar as the earlier marks will be brought to mind in regards all goods for which the applicant seeks registration.

Damage

71. I must now assess whether any of the pleaded types of damage will arise. As already explained, the opponent submits that, were the applicant to make use of the contested mark, it would derive an illegitimate benefit from the association with the opponent's early marks, consequently free-riding on the coat tails of the opponent's reputation.

72. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's

intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

73. I have already found that there is a likelihood confusion between the competing marks, whereby a consumer may select the applicant's goods in the mistaken belief that they originate from the opponent or an associated undertaking. That being so, even if there is no intention on the part of the applicant, it is clearly foreseeable that, in those circumstances, it would secure an unfair commercial advantage, benefitting from the reputation already established by the opponent and potentially diverting consumers (toward the applicant). As a finding of unfair advantage is sufficient to satisfy a claim under section 5(3), I need not consider the remaining heads of damage.

74. The opposition under section 5(3) succeeds.

CONCLUSION

75. The opposition has succeeded on both grounds. Subject to any successful appeal, the application will be refused.

COSTS

76. The opponent has been successful and is entitled to a contribution toward its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. In accordance with that TPN, I award costs to the opponent as follows:

Filing a form TM7 (official fee):	£200
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Preparing a Notice of Opposition and considering the counterstatement:	£200
Preparing evidence:	£600
Preparing written submissions:	£200
Total:	£1200

77. I order Alexander Lydamore to pay Golden Goose S.P.A. the sum of £1200. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an unsuccessful appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 14th day of September 2022

**Laura Stephens
For the Registrar,
The Comptroller General**