

BL O/0534/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003508432

BY WMNS WEAR LIMITED

TO REGISTER THE TRADE MARK:

WMNS WEAR

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 421697

BY SPORTS SUPPLEMENTS LIMITED

AND

IN THE MATTER OF UK TRADE MARK

REGISTRATION NO. UK00003246645

IN THE NAME OF SPORTS SUPPLEMENTS LIMITED

FOR THE TRADE MARK:

WMN

IN CLASSES 5, 25, 29, 32 AND 35

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY UNDER NO. 504787

BY WMNS WEAR LIMITED

BACKGROUND AND PLEADINGS

1. On 6 July 2020, WMNS WEAR LIMITED (“WWL”) applied to register the trade mark **WMNS WEAR** shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 7 August 2020. WWL seeks registration for the following goods:

Class 25 Bomber jackets; Jackets [clothing]; Jogging bottoms; Jump Suits; Jumpsuits; Dresses; Leggings [trousers]; Leisurewear; Bikinis; Bodices; Bodies [clothing]; Body suits; Bodysuits; Tops [clothing]; Tennis socks; Tops [clothing]; Trousers; Windproof jackets; Women's clothing; Shapewear; Shorts; Play suits; Playsuits [clothing]; Pyjamas; Casual wear; Casualwear; Clothing; Clothing for leisure wear; Footwear; Footwear for women; Footwear; Footwear for women; Outerwear.

2. The application was opposed by Sports Supplements Limited (“SSL”) on 7 October 2020. The opposition is based upon section 5(2)(b) of Trade Marks Act 1994 (“the Act”). SSL relies on the following trade mark:

WMN

UK registration no. UK00003246645

Filing date 27 July 2017; registration date 20 October 2017.

Relying upon some of its goods for which the earlier mark is registered, namely:

Class 25 Clothing; headgear; footwear.

3. Under section 5(2)(b), SSL claims that there is a likelihood of confusion because of the similarity of the marks and the identity of the goods.

4. WWL filed a counterstatement denying the claims made.

5. On 19 April 2022, WWL sought invalidation of SSL’s mark under section 47 of the Act.

6. Relying upon section 5(4)(a), WWL claims to have used the sign “WMNS” in London and throughout the UK (online) since 30 August 2015 in relation to clothing. WWL also claims that during a period of just under two years before the filing date of SSL’s mark, WWL “had acquired goodwill and a reputation arising from trade in the UK” under its ‘WMNS’ sign in relation to clothing. Therefore, SSL’s use of its mark is likely to lead to a misrepresentation which will deceive the public into believing that the goods offered by SSL are the goods of WWL. As a result of the misrepresentation, damage will be caused to WWL’s business in the form of loss of sales, loss of exclusivity in the ‘WMNS’ sign and damage/detriment to the goodwill and reputation of WWL (including in the form of blurring, dilution and tarnishment of the mark and brand).

7. SSL filed a counterstatement denying the claims made in regard to the invalidation proceedings.

8. On 16 June 2022, the Tribunal wrote to the parties informing them of the consolidation of the opposition action no. 421697 and invalidation no. 504787.

9. Only WWL filed evidence in chief, and SSL filed evidence in reply. A hearing took place before me on 5 April 2023. WWL was represented by Mr Joshua Marshall of Counsel, instructed by Briffa. Albeit not present at the hearing, SSL provided submissions in lieu of attendance, and is represented by Withers & Rogers LLP. I make this decision having taken full account of all the papers, referring to them below as necessary.

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

PRELIMINARY ISSUE

11. On the morning of the hearing, WWL’s representatives filed a second witness statement, composed of 2 pages, without any exhibits attached, to clarify its evidence

relating to its Instagram accounts. It states the following: that “paragraphs 5, 9 and 11 of the First Witness Statement and the corresponding exhibits EJ1, EJ7 and EJ6 all relate to the same Instagram account that was created on 15 August 2015”. This is WWL’s first Instagram account which was “initially set up under the handle “@luvilounge” but subsequently changed to “@wmswear””. WWL then created a second Instagram account in February 2019, and deleted its first Instagram account in March 2019.

12. The factors to be considered in determining an application to file late evidence were considered in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) and are:

- a) The materiality of the evidence in question to the issues that the Registrar has to determine;
- b) The justice and fairness of subjecting the opposite party to the burden of the evidence in question at the stage that the registry proceedings have reached, including the reasons why the evidence was not filed earlier;
- c) Whether the admission of the further evidence would prejudice the opposite party in ways that cannot be compensated for in costs (e.g. excessive delays); and
- d) The fairness to the applicant of excluding the evidence in question, including prejudice to the applicant if it is unable to rely on such evidence.

13. The request was made at a very late stage in the proceedings, which was acknowledged by Mr Marshall, and for which he apologised. I note that he also stated at the hearing that the second witness statement has no substantive evidence in terms of fresh material to consider, and was “effectively a clarification statement”.

14. Upon inspection of the witness statement, and as highlighted above, it is only 2 pages long and did not attach any exhibits. I noted that the contents answered a question I had in regard to the original evidence, which I had prepared to ask at the

hearing. I considered the fairness to WWL if I was to not accept the witness statement into the proceedings and considered that WWL would suffer prejudice if they were unable to rely upon it, as it provided clarity on its original evidence. I also considered that albeit SSL were not present at the hearing, that accepting the evidence would not cause significant or undue delay. However, SSL would be notified of this decision in a post-hearing letter, and was given 14 days to provide any submissions on the evidence that they deemed necessary.

15. On 19 April 2023, SSL's representatives, Withers & Rodgers LLP, filed further written submissions in regard to the admitted evidence. They submitted that the second witness statement should not be admitted into the proceedings because the clarification constitutes as "new material". They furthermore stated that "the Hearing and written submissions in advance of the hearing are not opportunities for further evidence to be submitted. They are not a further chance to provide the Hearing Officer with facts".

16. I do not consider that the above argument, that clarification constitutes as new material, has any weight. I do not consider that providing clarity in regard to evidence that has already been filed within the proceedings amounts to "new material" or new evidence. New evidence would be, for example, filing multiple new exhibits of individual dated posts from the Instagram accounts, which were never referred to in the original witness statement of Ms Jones. Taking all of the above into account, I uphold my original decision to admit the evidence into the proceedings.

17. I also note that within SSL's further written submissions, they have commented on "facts submitted in SA" (WWL's skeleton argument). In my letter dated 5 April 2023, I did not ask Withers & Rodgers LLP for any submissions in regard to WWL's skeleton argument, however, for the sake of completeness, I will deal with their submissions here.

- i. The skeleton argument states that the Luvli Lounge website had "received 375,005 sessions and 335,300 visitors [in 2017 alone]". Withers & Rodgers LLP submitted that this is "statement of fact, clarifying the Witness Statement and adding further information, which should not be admitted at this late stage". I

note that in the original witness statement, at paragraph 13, Ms Jones' makes reference to the 375,006 website sessions made to their website in 2017 and refers to **exhibit EJ8** which clearly shows that there were "335,000" visitors. Therefore, the skeleton argument was not introducing any new evidence, and I disregard this point in its entirety.

- ii. Withers & Rodgers LLP draws my attention to **EJ1**, which they state does not contain a date on the Instagram site itself, and **EJ7** which shows on a separate page details of an Instagram account, however, "it is not clear what account" it is in relation to. Withers & Rodgers LLP therefore submits that the statement "**EJ7** shows the Instagram account with the handle @wmnswear_ was in existence in November 2015" in WWL's skeleton argument constitutes as statement of fact and shouldn't be admitted at this stage. However, the first witness statement of Ms Jones' clearly states that "in August 2014 we started using the Earlier Mark in conjunction with LUVLI LOUNGE (but always as two separate and distinct logos) which is why from the outset our website displayed the two logos, as did our Instagram profile. Please find at **EJ1**, a representation of the WMNS WEAR website and Instagram page evidencing use of the Earlier Mark along with the LUVLI LOUNGE logo, dated 30 August 2015 and 15 November 2015 respectively". I also note that **EJ1** does contain a screenshot of its Instagram page dated 15 November 2015. Furthermore, at paragraph 12 of her first witness statement, Ms Jones' states that "we had already set up the Instagram account "@wmnswear_" in November 2015 (please see **EJ7**)". I have no reason, nor evidence, to consider that these statements are untrue. Further, I note that the evidence is accompanied by a statement of truth. If SSL wanted to pursue their argument any further, they should have requested cross-examination. I disregard this point in its entirety.

18. However, as noted above, the second witness statement confirms that the first Instagram account was "initially set up under the handle "@luvilounge" but subsequently changed to "@wmswear"". This is why the @wmswear Instagram account exhibited in **EJ7** has the original creation date, 15 November 2015, as its @luvilounge account evidenced in **EJ1**.

19. Therefore, taking all of the above evidence and submissions into account, I consider that in correlation with the first and second witness statements of Ms Jones', the first Instagram account was set up on 15 November 2015, under the handle @luvilounge, and subsequently changed its handle name to @wmnswear, which is evidenced in **exhibits EJ6** and **EJ7**.

EVIDENCE

20. WWL's evidence consists of the first witness statement of Elizabeth Jones dated 3 October 2022. Ms Jones is one of the founders of WWL. Ms Jones' statement was accompanied by 9 exhibits (EJ1-EJ9).

21. SSL's evidence consists of the witness statement of Stephanie Davies dated 5 December 2022. Ms Davies is a Trade Mark Attorney at Withers & Rogers LLP, the representatives for SSL. Ms Davies' statement was accompanied by 4 exhibits (SD1-SD4).

22. WWL's evidence also consists of the second witness statement of Ms Jones dated 5 April 2023. This was not accompanied by any exhibits.

DECISION

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

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

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

24. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

25. The relevant parts of section 47 state:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) [...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

26. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

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

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

Relevant date

27. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: ‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before

the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

28. As SSL has filed no evidence of use, I have only the prima facie relevant date to consider i.e. 27 July 2017.

Goodwill

29. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

30. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

31. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

32. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark* [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is

enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

33. More recently, in *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC, as the Appointed Person, reviewed the authorities concerning the establishment of goodwill for the purposes of passing-off, namely *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“[...] a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

34. In *Smart Planet Technologies*, Mr Mitcheson decided that ten invoices showing sales to two customers, totalling €3,230 for around 40,000 paper cups, did not show the required significant or substantial reputation. In that case, the sign at issue was, at best, weakly distinctive and Mr Mitcheson found that this supported his conclusion.

35. The case law also shows that a small business which has more than trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though it's goodwill and reputation may be small. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the Court of Appeal held that the defendant had passed off its LUMOS nail care products as the claimant's goods. The claimant had been selling “LUMOS” anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The Claimant's sales were small; of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the

trade, including salons, clinics and a market. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at first instance put it, “very limited”, the claimant’s goodwill was found to be sufficient to entitle it to restrain the defendant’s trade under “LUMOS”. In *Stannard v Reay* [1967] F.S.R. 140, a mobile fish and chip van had been trading for three weeks, generating around £130 per week, which was held to be sufficient for an interlocutory injunction to prevent the defendants using the same sign (“MR CHIPPY”). The facts were unusual because of the very localised nature of the case.

36. WWL needs to show that, at the relevant date, it had the necessary goodwill (more than trivial) in its business and that the sign “WMNS” was distinctive of that goodwill.

37. Before I address the evidence, I note that at the hearing, Mr Marshall states that SSL has attacked WWL’s evidence “on the basis that if the granular detail is not corroborated or supported in the exhibited documents, then the evidence is effectively meaningless”. Mr Marshall states that as the witness statement is verified by a statement of truth, that this line of argument is wrong. As highlighted above in paragraph 17(ii), I consider that there is no reason, nor evidence, to consider that the statements made within Ms Jones’ witness statements are untrue because they are supported by a statement of truth. As highlighted by Mr Marshall at the hearing, if SSL wanted to pursue their argument any further, they should have requested cross-examination. I now turn to consider the evidence.

38. Ms Jones confirms that in or around February 2015, WWL established a lingerie brand under the name “LUVLI LOUNGE”. However, after a few months WWL wanted to branch out into women’s clothing in general, and therefore the brand name did not reflect all of their goods. They decided on the name “WMNS” which is intended to stand for “Women Make Nothing Simple”.

Instagram Evidence

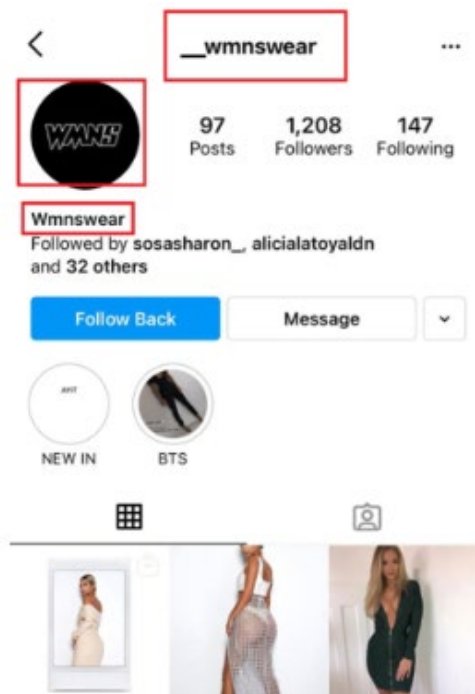
39. In August 2015, WWL started using the sign WMNS/WMNS WEAR in conjunction with its LUVLILOUNGE sign, “but always as two separate and distinct logos”. Its first Instagram page displayed both signs in conjunction. **Exhibit EJ1** contains the

following screenshot, dated 15 November 2015, showing WWL’s first Instagram page. I note that this displays both signs in its profile picture and within its bio:



40. The above bio also clearly directs the consumers to purchase their LUVLI LOUNGE | WMNSWEAR goods from “www.luvlilounge.com”.

41. As confirmed in Ms Jones’ second witness statement, **exhibit EJ7** also contains a screenshot of its first Instagram page, but after they had changed the name of the page, as follows:

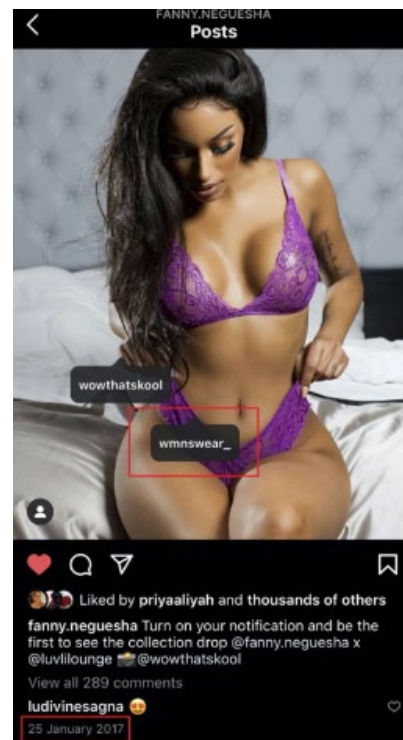


42. Firstly, I note that the name of the Instagram page is changed to “@_wmnswear” and the profile picture uses the stylised WMNS sign. Secondly, the bio no longer

makes a reference to the www.luvlilounge.com website, and therefore isn't directing its customers to this page to purchase WWL's goods. Thirdly, I note that there is a difference in the amount of posts and followers. The first screenshot of the first Instagram page has 414 posts and 15.1k followers, whereas **EJ7** shows that the account only has 97 posts and 1,208 followers. Lastly, the screenshot in **EJ7** is undated.

43. Furthermore, in February 2019, WWL set up a second Instagram account (@wmnswear_), which is exhibited in **SD2**. In March 2019, WWL deleted their first Instagram account with the aim to clearly draw a line between using their sign with the LUVLI LOUNGE sign, to the WMNS WEAR sign being used clearly on its own. However, I note that this all falls after the relevant date.

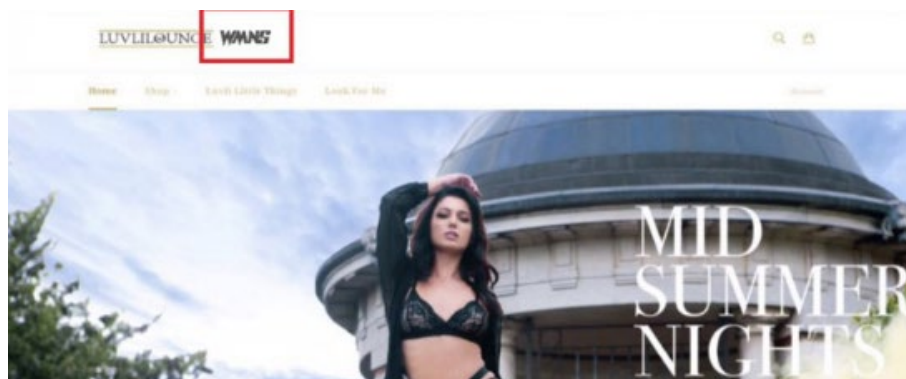
44. Ms Jones' states that WWL did not have a "large budget for marketing" and therefore "found that social media was a vital and valuable way to engage" with their target audience. On 20 July 2016, a "popular Instagram blog" 'Bloggyourlifestyle' made a post tagging the "wmnswear_" account. On 25 January 2017, a verified Instagram account, Ms Fanny Neguesha, also made a post tagging the "wmnswear_" account. These are contained within **exhibit EJ6** and shows the following:



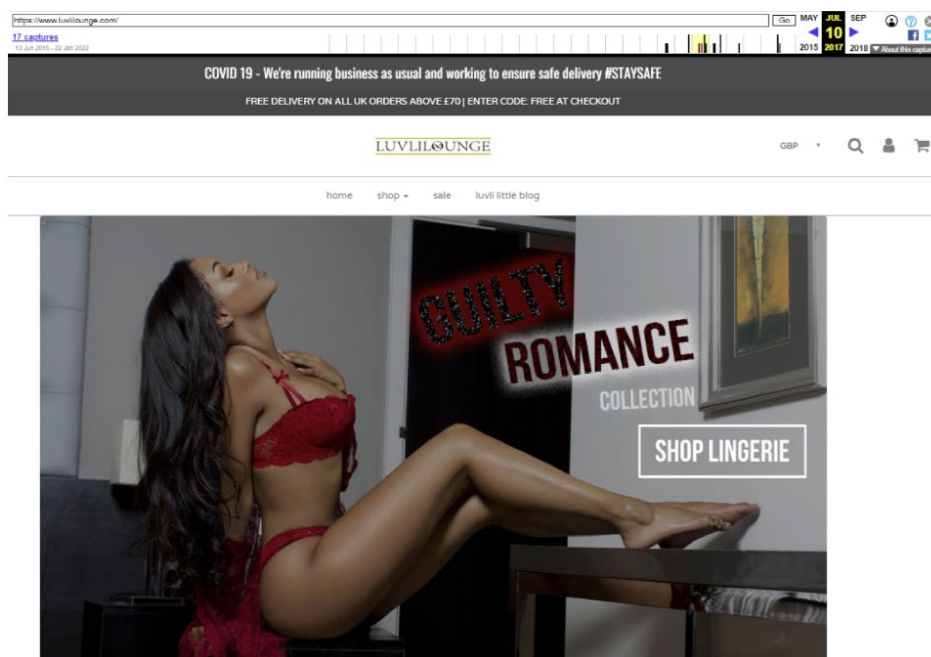
45. Ms Jones states that Ms Fanny Neguesha “has over 800,000 followers and because of the fact that she holds a public account, which is verified, she is more likely to appear on the Instagram feeds of countless other members who do not follow her”.

Website Evidence

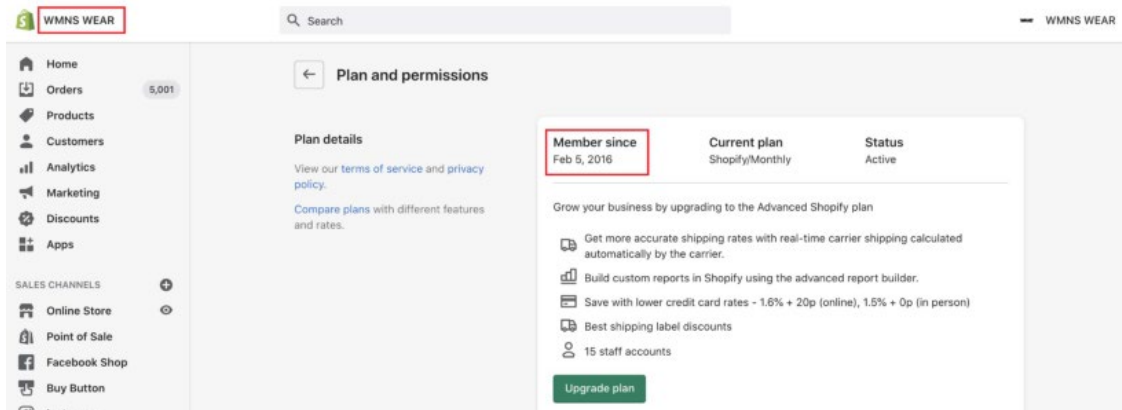
46. Firstly, exhibited at **EJ1** is a screenshot of the opponent’s website, dated 30 August 2015, which displays the following LUVLILOUNGE and WMNS signs:



47. Ms Jones’ states that from the outset, the website displayed both logos. I note that this seems to suggest that later down the line, WWL no longer displayed both signs on its website. This is supported by **exhibit SD3**, which shows that on 10 July 2017, the WMNS mark is no longer displayed on WWL’s website page:



48. Ms Jones' states that by early 2016, WWL set up a Shopify account. I note that the Shopify page is called "WMNS WEAR" and uses the "WMNS" sign. This is exhibited in **EJ2**, and shows the following:



49. I also note that the stylised sign of WMNS is clearly displayed in the top right hand corner, as follows:



50. The page confirms that it has been a member since 5 February 2016, and that they have had 5,001 orders on this page. However, I note that this exhibit is undated.

51. In her witness statement Ms Jones' states that **exhibit EJ5** contains "Shopify analytics which show that in 2017 the average order value was £92.41". Furthermore, it is clear from the following graph that sales were made from January to some point after September:



52. **Exhibit EJ9** contains Shopify analytics of the UK visitors to WWL’s MWNS WEAR Shopify page during 2017. I note that the locations are based all across the UK, including London, Manchester, Cardiff, Glasgow, Birmingham, Bristol, Sheffield and Nottingham, to name a few.

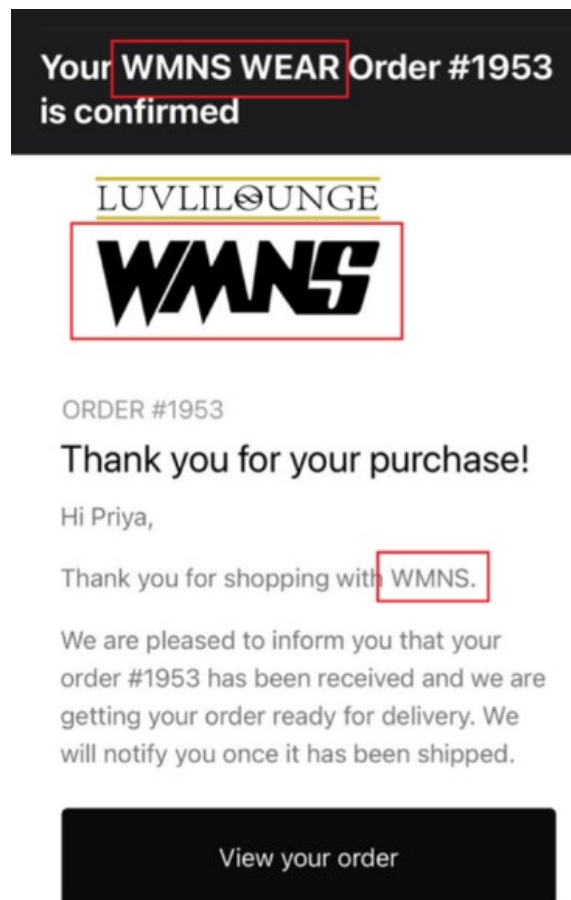
53. Ms Jones also provides the following “orders/sales in 2016 and 2017”, as supported and demonstrated by the graphs contained within **exhibit EJ4**, “to evidence the substantial trade under the Earlier Mark during the Relevant Period”:

Year	Orders
2016	724
2017	4,204

54. Therefore, the total amount of orders made, during the relevant period, amounts to 4,928. Nonetheless, I note that the above figures have not been broken down by the type of goods which were ordered by their customers. I also note that as confirmed by Mr Marshall at the hearing, WWL does not have a physical store and therefore these figures will only be in relation to online orders. However, Ms Jones has not submitted whether the above figures relate to its livilounge.com website or its WMNS Shopify page, or whether it relates to both. However, in her witness statement, Ms Jones’ states that as the average order value was £92.41 in 2017 (the figure obtained from Shopify analytics), that the approximate turnover attributable to the above orders in that year, under the WMNS WEAR sign, amounts to £388,491.64. I therefore consider that this suggests that the sales made in 2017 were made from its Shopify page.

55. Ms Jones confirms that “during the period of 2016-2017, all customers who ordered from us were being sent invoices that displayed both logos”. I note this statement is supported by **exhibit EJ3** which contains the following email order confirmation, dated 14 August 2016. As highlighted by Mr Marshall at the hearing, WMNS WEAR is used in the subject line, and in the body of the email where the

stylised WMNS sign is being used and where it thanks the customer “for shopping with WMNS”:



56. However, as highlighted by SSL, the order confirmation does not show what goods were purchased under order number #1953. I also note that highlighted by SSL, and as accepted by Mr Marshall at the hearing, this exhibit also does not show where the order was shipped to. However, as established above, **exhibit EJ9** provides information as to the location of WWL’s customers.

57. The only exhibit where it has been made apparent that the evidence is only in relation to WWL’s luvilounge.com website is **exhibit EJ8**. Ms Jones’ confirmed that there were 375,005 website sessions, and **exhibit EJ8** confirms that there were 335,300 visitors on WWL’s website in 2017. I note that the sessions were broken down by location, with 189,923 of them from the UK. However, as stated by Ms Jones’ in her witness statement, “by early 2017, we were consciously making the move away from the combined LUVLI LOUNGE and WMNS branding and focusing on

implementing the Earlier Mark on its own". I consider that this statement, in combination with **exhibit SD3** highlights that the WMNS mark would not have been displayed on the livilounge.com website in 2017.

58. In making an assessment of the existence of goodwill, I must bear in mind the evidence as a whole. In this case, WWL's sales are comparably higher in comparison to the sales in the *Lumos* case; nevertheless, they are still low (but more than trivial) by reference to the women's clothing market in which WWL is operating. Furthermore, the length of use is far from being long-standing, with evidence of sales only present for 2016 and 2017, and therefore commencing just over a year before the relevant date. There is no evidence of marketing spend, and WWL has only relied upon using Instagram to engage with its customers, with 2 posts exhibited as evidence of marketing using a verified user, and a user with a large social media following.

59. I note that at the beginning of the relevant period, the sign WMNS was used in conjunction with LUVLILOUNGE, however, I do not consider that this is fatal to the assessment of goodwill, as more than one sign can be distinctive of WWL's goodwill. The evidence shows that the sign WMNS was used on every invoice sent in 2016 and 2017, and was therefore displayed on all 4,928 order emails made during the relevant period. The sign was also used on the first Instagram page, which allowed Bloggyourlifestyle and Ms Fanny Neguesha to tag WMNS on the posts that they had made during the relevant period. Lastly, the sign was clearly used on its Shopify page.

60. As highlighted by the case law above, a small business which has more than a trivial level of goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small. Overall, my conclusion is that the evidence demonstrates a small, but not trivial, amount of goodwill at the relevant date. This is sufficient to satisfy the first required element of passing off.

61. However, whilst this may be the case, I do not consider that the goodwill vests in all of the goods relied upon (clothing). This is on the basis that the only evidence I have in regard to "clothing" is Ms Jones' statement that WMNS is a high end women's clothing brand, and the pictures of its clothing being displayed on their first and second

Instagram pages in **exhibit EJ7** and **SD2**. However, I note that **exhibit EJ7** is undated and **exhibit SD2** is from the second Instagram page which was created in February 2019, which falls after the relevant date. I also note that Ms Jones' has not broken down the above sales figures into the types of clothing goods which were sold during the relevant period. I therefore consider that the only evidence I have in relation to the goods sold under the WMNS mark, during the relevant period, is lingerie. I note that lingerie goods are displayed on the opponent's website banner and on its first Instagram page, which was created in November 2015, exhibited in **EJ1**. Furthermore, I also note that Bloggyourlifestyle and Ms Fanny Neguesha have tagged WMNS on their Instagram posts where they are wearing lingerie, as displayed in **exhibit EJ6**. Therefore, based upon the evidence before me, I consider that WWL has goodwill, but vested in lingerie only.

62. To confirm, I conclude that WWL has demonstrated a small, but sufficient, level of goodwill in its business for "lingerie". I note that there are some examples in WWL's evidence of the sign relied upon being used in a non-distinctive way. For example, where it is used alongside the LUVLI LOUNGE mark in the form WMNSWEAR, I consider that this is likely to be viewed by the relevant public as descriptive use rather than use in a trade mark sense. That is not to say that the sign WMNS is not capable of acting as a trade mark; the case law tells us that the way in which a sign is used is important (see, for example, *HOKEY POKEY* BL O/461/14). However, I am satisfied that there are plenty of examples of the sign being used in a way that is indicative of origin. For example, it is used in a way that is clearly intended to indicate origin on WWL's Instagram profile picture, on its Shopify account and on order acknowledgements.

63. I also acknowledge that at the hearing, Mr Marshall highlights that SSL's "final attack" on WWL's evidence, at paragraph 20 is that "the majority of [WWL's] evidence showing any use of the mark WMNS is in the form of the logo, which substantially differs from the word mark". As highlighted by Mr Marshall, this is "a particularly weak attack because the logo so far as it exists, is effectively stylised wording" or letters. I agree with Mr Marshall's submissions. Use of the "logo", which simply consists of the stylised letters "WMNS" constitutes as use of the WMNS sign, and therefore can be relied upon by WWL.

64. Consequently, I am satisfied that the sign relied upon is distinctive of WWL's goodwill. As a result, I will now proceed to consider whether there is misrepresentation and damage.

Misrepresentation

65. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

66. And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

67. Halsbury's Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309, it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

68. SSL’s mark consists of the letters WMN. These letters all appear identically at the beginning of WWL’s earlier sign; WMNS, with the only difference being the letter S at the end of the mark. Consequently, I consider that WWL’s earlier sign is highly visually and aurally similar to SSL’s mark. I also consider that a significant proportion of average consumers would recognise WMN and WMNS as the word “women” or “women’s” (minus the vowels) as the human eye has a well-known tendency to see what it expects to see.¹ I consider that this is supported by Mr Marshall’s comment at the hearing whereby he said that “the mark W-M-N-S, or pronounced as women’s”. I therefore consider that there would also be a high conceptual similarity between the sign and mark.

69. The average consumer for both parties’ goods, clothing (including lingerie), headgear and footwear, would be the general public. The level of attention paid is likely to be a medium degree, with visual considerations likely to dominate purchasing process.²

70. I have found that at the relevant date, WWL has a small degree of goodwill in relation to lingerie. SSL’s mark is registered for clothing, headgear and footwear. I consider that clothing would encompass lingerie. I also consider that the same clothing retail outlets would provide and distribute lingerie, headgear and footwear. Therefore, the goods are either identical, or they fall within the same fields of activity in which both parties’ carry out their businesses.

¹ *Aveda Corporation v Dabur India Limited* [2013] EWHC 589 (Ch) paragraph 48

² *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50

71. Consequently, having found the earlier sign and the contested mark are highly similar, and having found that the goods for which WWL's earlier sign has goodwill, and for which the contested mark is registered are identical or fall within the same fields of activity, it is clear that a person aware of WWL's business would, when encountering SSL's similar business under a highly similar sign, conclude that they both originate from the same undertaking. In other words, use of SSL's mark at the relevant date would have constituted a misrepresentation to a substantial number of people.

Damage

72. In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

73. In *WS Foster & Son Limited v Brooks Brothers UK Limited* [2013] EWPC 18, Mr Recorder Iain Purvis QC stated:

“55 Although proof of damage is an essential requirement of passing off cases, it will generally be presumed where a misrepresentation leading to a likelihood of deception has been established, since such deception will be likely to lead

to loss of sales and/or more general damage to the exclusivity of the Claimant's unregistered mark. Mr Aikens accepted that if there was a misrepresentation in the present case, then he had no separate case on damage. I hold that damage is inevitable, at least in the sense recognised in *Sir Robert McAlpine v Alfred McAlpine* [2004] RPC 36 at 49 (the 'blurring, diminishing or erosion' of the distinctiveness of the mark)."

74. Having found the existence of goodwill and misrepresentation, I consider that damage through diversion of sales is easily foreseeable.

75. Therefore, as the opposition 421697 filed by SSL against WWL is based on an application I have declared invalid; SSL's opposition falls away.

76. It therefore follows that WWL's trade mark application no UK00003508432 will proceed to registration.

CONCLUSION

77. The application for invalidation filed against registration no. UK00003246645 has succeeded in its entirety under sections 47 and 5(4)(a) of the Act. The trade mark registration UK00003246645 will be deemed never to have been made for all of its goods in class 25.

78. The opposition against UKTM no. 3508432 fails in its entirety.

COSTS

79. WWL has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award WWL the sum of **£1,800** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing the application for invalidity and considering the Counterstatement	£200
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Considering the Notice of opposition and preparing a Counterstatement	£200
Preparing and filing evidence	£500
Preparation for and attendance at hearing	£700
Official Fee	£200
Total	£1,800

80. I therefore order Sports Supplements Limited to pay WMNS WEAR LIMITED the sum of £1,800. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 9th day of June 2023

L FAYTER

For the Registrar