



Press Summary

24 June 2025

Iconix Luxembourg Holdings SARL (Respondent) v Dream Pairs Europe Inc and another (Appellants)

[2025] UKSC 25

On appeal from [2024] EWCA Civ 29

Justices: Lord Hodge (Deputy President), Lord Briggs, Lord Hamblen, Lord Stephens and Lady Rose

Background to the Appeal

Iconix owns the sportswear brand UMBRO and is the registered proprietor of two trade marks (“the UMBRO Trade Marks”), which have been used as logos on football boots in the UK since 1987. Since 2018, Dream Pairs has sold a variety of footwear branded with a logo (“the DP Sign”) in the UK, via Amazon and eBay.

Iconix brought the present action against Dream Pairs for infringement of the UMBRO Trade Marks by use of the DP Sign on footwear, pursuant to section 10(2) of the Trade Marks Act 1994 (“the Act”). Section 10(2)(b) provides that:

“A person infringes a registered trade mark if he uses in the course of trade a sign where because ...

(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.”

Iconix claimed that the DP Sign was similar to the UMBRO Trade Marks such that its use on footwear was likely to cause confusion on the part of the public. The High Court dismissed Iconix’s claim. It found that there was “a very low degree of similarity” between the UMBRO Trade Marks and the DP Sign and no likelihood of confusion. The Court of Appeal allowed Iconix’s appeal. The Court of Appeal held that the judge’s conclusion that there was a very low degree of similarity was irrational when the DP Sign was considered viewed from any angle other than square-on. The Court of Appeal assessed similarity and confusion for itself. It concluded that there was “a moderately high level of similarity” between the UMBRO Trade Marks and the DP Sign in the post-sale context, particularly when the DP Sign was viewed on a football boot by a viewer standing nearby and looking down at it. It also concluded that there

was a likelihood of confusion on the part of a significant proportion of consumers. Dream Pairs now appeals to the Supreme Court.

Judgment

The Supreme Court unanimously allows the appeal. The Supreme Court rejects Dream Pairs' arguments that realistic post-sale circumstances cannot be taken into account in order to assess similarity, and that only post-sale confusion jeopardising the function of a trade mark as a guarantee of origin in a subsequent transactional context can amount to an actionable infringement. However, the Court of Appeal was not justified in substituting its view of the similarity and confusion assessments for that of the trial judge. Lord Briggs and Lord Stephens give the judgment, with which the other members of the Court agree.

Reasons for the Judgment

The legal framework

The UMBRO Trade Marks are registered under the Act. The Act transposed into UK law Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of EU Member States relating to trade marks. The Act was amended to implement subsequent EU Directives. The protection of trade marks under the Act has been interpreted in line with the case law of the Court of Justice of the European Union ("the CJEU") [12]-[15]. The UK is also bound by the Agreement on the Trade-Related Aspects of Intellectual Property Rights ("the TRIPS Agreement") [18].

The essential function of a registered trade mark is to guarantee the identity of the origin of the goods or services in relation to which it is used [17].

Section 10 of the Act provides for infringement proceedings. The proceedings in this case are brought under section 10(2)(b). In order to establish infringement under section 10(2)(b), six conditions must be satisfied: (i) there must be use of a sign by a third party within the UK; (ii) the use must be in the course of trade; (iii) it must be without the consent of the proprietor of the trade mark; (iv) it must be of a sign which is at least similar to the trade mark; (v) it must be in relation to goods or services which are at least similar to those for which the trade mark is registered; and (vi) it must give rise to a likelihood of confusion on the part of the public [23]. The dispute in this case relates to conditions (iv) as to similarity and (vi) as to likelihood of confusion [26].

To assess the degree of similarity between the marks, the court determines the degree of visual, aural and conceptual similarity between them [31]. If the sign is similar to the trade mark, then the court must assess whether there is a likelihood of confusion on the part of the public [34].

The Court sets out principles regarding the assessment of likelihood of confusion, as distilled from CJEU case law and summarised by the UK courts. "The public" does not (always) mean everyone but rather the relevant public, that is (following CJEU case law): "the average consumer of the category of goods or services in question". The average consumer need not be an actual purchaser of the specific goods or services in respect of which a potentially infringing sign is used. In this case, the public concerned with footwear is the UK adult population generally [35]-[36]. The average consumer is deemed to be reasonably well-informed and observant; they normally perceive a mark as a whole and do not analyse its details. The likelihood of confusion must be considered globally. Similarities should be assessed by reference to the overall impressions created by the marks. Mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient [38]. The sign must be considered in its context. In this case, in the post-sale context, a realistic and representative

way in which the average consumer will encounter the sign is by seeing it from head height on footwear being worn by another person [40]-[41].

The similarity issue

Dream Pairs argued that when assessing similarity, as a matter of law, the court should only consider the intrinsic features of the marks on a side-by-side analysis, leaving out of account any realistic and representative viewing angles in the post-sale environment. It is only if there is an intrinsic similarity that the court should make a global assessment of the likelihood of confusion at which stage it is appropriate to take into account realistic and representative viewing angles in the post-sale environment. Even if that legal argument is correct, the trial judge did carry out a side-by-side analysis of the UMBRO Trade Marks and the DP Sign, and held there was a faint resemblance between them. This finding has not been challenged. The trial judge then correctly conducted a global assessment of the likelihood of confusion, during which he took into account realistic and representative viewing angles [42]-[46].

In any event, that legal argument is incorrect. Realistic and representative post-sale circumstances can be taken into account to establish whether the signs are similar and if so the degree of similarity. This is for several reasons. First, the CJEU decision in *Equivalenza* is authority for the proposition that when assessing similarity, it is impermissible to consider post-sale circumstances in order to rule out intrinsic similarities between the signs. It is not authority for the proposition that when assessing similarity, post-sale circumstances cannot be considered to establish similarities between the signs. Second, if Dream Pairs' submissions are correct then a global assessment of the likelihood of confusion would be ruled out where there was no intrinsic similarity between the signs even if in a realistic and representative post-sale environment there was similarity. Third, taking into account how the sign is perceived in a realistic post-sale environment is consistent with the CJEU's statement in *Equivalenza* that the comparison must be based on the overall impression made by the signs to the relevant public [60]-[65].

The confusion issue

The Court rejects Dream Pairs' submission that only post-sale confusion jeopardising the essential function of a trade mark as a guarantee of origin at the point of a subsequent sale or in a subsequent transactional context can amount to an actionable infringement. The Court also rejects Dream Pairs' submission that before there can be an actionable infringement, the post-sale confusion must result in damage at the point of sale or in a transactional context in the sense of influencing consumers when they make a choice about the goods or services in question. None of the CJEU authorities support these propositions. Nor is there any reason in principle to adopt them. There is also no mention of the point of purchase or a transactional context in the TRIPS Agreement or the EU Directives [86]-[92].

Was the Court of Appeal entitled to re-make the decision?

The question of whether there is a trade mark infringement under section 10(2)(b) is a multi-factorial assessment. It involves the finding of facts, the application of principles and rules of law to those facts, and the evaluative decision of whether something has happened which falls within a statutory definition. Reasonable minds, faithfully applying the relevant law and principles, may reach different conclusions. The decision of an appellate court trumps that of the court below, but the law has imposed constraints on the role of an appellate court in order to prevent a free-for-all when a party wishes to challenge the decision of the trial judge. When considering a challenge to an evaluative decision of a first-instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the judge's decision was wrong because of an identifiable flaw such as a gap of logic, inconsistency, or a failure to take into account a material factor. It is not enough to show that the appeal court might have arrived at a different evaluation [93]-[95].

The Court of Appeal's criticism of the trial judge was misplaced. The judge gave careful consideration to the effect of viewing the DP Sign from different angles, and the post-sale context, but did not regard those considerations as detracting from his conclusion about faint similarity or unlikelihood of confusion. There were no matters such as irrationality or error of principle or of law which justified the Court of Appeal in substituting their own different views of the answer to the multifactorial question facing the judge [109]-[116]. Therefore, the Supreme Court allows the appeal.

References in square brackets are to paragraphs in the judgment.

NOTE:

This summary is provided to assist in understanding the Court's decision. It does not form part of the reasons for the decision. The full judgment of the Court is the only authoritative document. Judgments are public documents and are available at: [Decided cases - The Supreme Court](#)