

O/0026/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER UK00003906390  
BY THE JEWEL GALLERY LIMITED  
TO REGISTER THE FOLLOWING TRADE MARK:

**THE SHARK CAGE**

IN CLASSES 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21,  
22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43,  
44, 45.

AND

AN OPPOSITION THERETO UNDER NUMBER OP600003226  
BY FREESTYLE BRANDS, LLC

## Background and Pleadings

1. On 28 April 2023, The Jewel Gallery Limited (“the applicant”) applied to register in the UK the trade mark shown on the cover page of this decision (“the contested mark”). The application was accepted and published for opposition purposes on 8 December 2023 and registration is sought for goods and services in all classes.

2. On 7 March 2024, Freestyle Brands, LLC (“the opponent”) partially opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Within its TM7F, the opponent indicated that the opposition is directed against the following applied for goods and services:

Class 14: Jewellery; horological and chronometric instruments; paste jewellery [costume jewellery]; pins [jewellery]; shoe jewellery; rings; earrings; necklaces; chokers; pendants; bracelets; charity bracelets; bangles; brooches; lapel pins; tie clips; tie bars; cuff links; cuff bracelets; charms; clocks; watch bands; watches; smart wrist watches; wristwatches with pedometer feature; charms for key chains; charms for key rings; key chain tags; key chains for use as jewellery; key chains; horological and chronometric apparatus and instruments; parts, fittings and accessories for all the aforesaid.

Class 35: Retail services, mail order services and wholesaling services connected with the sale of clocks, wrist watches, watch straps, presentation cases for watches, stopwatches, horological and chronometric instruments.

3. The opponent relies upon the following earlier United Kingdom Trade Mark (UKTM) for its opposition:

# SHARK

Filing date: 3 May 1996

Registration date: 22 September 1998

The opponent's mark is registered for goods and services in class 14, namely:

Watches and watch accessories in this class, including watch straps, watch bands, watch glasses.

4. Given the filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. As it has been registered for five years or more at the filing date of the application, it is subject to the proof of use requirements specified within section 6A of the Act.
5. Under section 5(2)(b), the opponent claims in its statement of grounds that:

*"The parties' marks are closely similar, visually, aurally and conceptually. The contested mark encompasses the Opponent's SHARK trade mark and both marks will be seen and recalled as 'SHARK' marks.*

*The parties' goods and services in Classes 14 and 35 are identical and highly similar. The Opponent's 'watches and watch accessories' are identical in part to the Applicant's watches and equivalent goods. The Applicant's jewellery goods in Class 14 are similar to the Opponent's watches. The Applicant's Class 35 retail services for watches and related goods are similar to the Opponent's goods in Class 14.*

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<sup>1</sup> The opponent's mark is a comparable mark based upon an earlier EUTM owned by the opponent. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. This comparable mark enjoys the same filing and registration dates as its European counterpart.

*There exists likelihood of confusion on the part of the public due to the close similarity between the SHARK and THE SHARK CAGE marks and the identical and similar nature of the parties' goods and services. The Applicant's mark will be seen as a natural extension of the SHARK brand and the public will believe that the goods/services offered under the Applicant's mark to originate from the Opponent [sic].”<sup>2</sup>*

As this is a fast-track case, the opponent also filed evidence of use of its mark alongside the Form TM7F.

6. The applicant filed a defence and counterstatement in which it denies similarity of the competing marks and the competing goods, further it denies any likelihood of confusion between the respective marks. The applicant also states that:

*“The word SHARK has virtually no distinctive character for straps, bands and other of the asserted goods of the Opponent's Registration, or for the challenged goods, or for the goods which are the subject of the challenged retail services made from shark skin, shark products or in the shape of sharks.”<sup>3</sup>*

In relation to the opponent's proof of use evidence, the applicant denies that it shows genuine use.

7. The applicant is represented by Beck Greener LLP; the opponent is represented by HGF Limited.
8. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1 to 3 of rule 20 of the Trade Mark Rules 2008 but provides that rule 20(4) shall continue to apply. Rule 20(4) stipulates that:

“the Registrar may, at any time, give leave to either party to file evidence upon such terms as the Registrar thinks fit”.

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<sup>2</sup> Form TM7F Q16

<sup>3</sup> Form TM8 Q8.

The net effect of these changes is to require the parties to seek leave in order to file evidence in fast-track oppositions, other than for the opponent's proof of use evidence which is mandatory and filed alongside the Form TM7F. The applicant requested to file evidence to show the distinctiveness of the word SHARK for the goods at issue, which was granted following a CMC.

9. Rule 62(5) (as amended) states that arguments in fast-track proceedings shall be heard only if

- (i) the Office requests it, or
- (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost;

otherwise, written arguments will be taken.

10. A hearing was neither requested nor considered necessary, however both parties elected to file written submissions in lieu. This decision is taken following a careful perusal of the papers.

### **Relevance of EU law**

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

### **Evidence**

12. The opponent has filed evidence alongside its Form TM7F. The evidence was accompanied by a statement of truth signed by Jeffery L Gregg, managing member

of the opponent and exhibits JG1 to JG 4. The evidence is for the purpose of demonstrating use of its mark.

13. The applicant filed evidence on 6 January 2025. The applicant's evidence comprises the witness statement of Mr Ian Bartlett, a registered trade mark agent and licensed higher courts IP litigator, as well as a partner in Beck Greener LLP dated the same. The purpose of the evidence is to show that the term "shark" is commonly used in relation to wrist watches, and in particular watch straps, to indicate that they are made of shark skin, or at least made of materials intended to imitate the look and feel of the shark skin.

## **DECISION**

### **Legislation**

14. Sections 5(2)(b) and 5A of the Act reads 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."

15. As discussed above by virtue of its earlier filing date (3 May 1996) the registration set out in paragraph 3 above, constitutes an earlier mark within the meaning of section 6(1) of the Act. As the earlier mark completed its registration procedure

more than five years before the filing date of the opposed contested mark, it is, in principle, subject to the use provisions set out in section 6A of the Act. I observe from the Form TM8 that the applicant requests proof of use of the opponent's earlier goods.

### **Proof of use legislation and case law.**

16. The proof of use provisions are set out in section 6A of the Act, the relevant parts of which state:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),  
(aa) or (ba) in relation to which the conditions set out in section 5(1),  
(2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed  
before the start of the relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

17. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

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

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

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

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

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

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

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

18. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a subcategory of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the

commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

‘19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

[...]

22. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.”

19. For use to be genuine, it must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector

concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

20. Consequently, the onus is upon the opponent to prove genuine use of the registered trade in the relevant period. The relevant period in which genuine use must be established is the five-year period ending on the filing date of the contested mark, being 28 April 2023. Therefore, the relevant period to consider for the purposes of proof of use of the earlier mark is i.e. 29 April 2018 to 28 April 2023.

21. By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use within the EU is relevant prior to IP Completion Day (i.e., 1 January 2021). With regard to assessing use within the EU, I also bear in mind that in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union (“CJEU”) held that while use of a Community trade mark in one Member State could suffice to establish genuine use in the Community, “all facts and circumstances” should be considered: see paragraph 55. These include the characteristics of the market concerned, the nature of the goods or services protected by the mark and the territorial extent and the scale of the use, as well as its frequency and regularity: see also *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor* [2016] EWHC 52, paragraphs 228-230, and *TVR Automotive Ltd v OHIM*, Case T-398/13.

22. I further observe that since *Leno* the General Court (“GC”) has held that genuine use may apply to a contested mark in circumstances where genuine use has been made in relation to services in the London and Thames Valley area,<sup>4</sup> and where genuine use concerned national use of a EUTM in only one member state.<sup>5</sup> Consequently, I accept that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM.

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<sup>4</sup> Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* upheld at [47]

<sup>5</sup> Case T-398/13, *TVR Automotive Ltd v OHIM*

## Evidence of use

23. I note the following from the opponent's evidence:

- a) The opponent claims the company has been trading as Freestyle since 1983 and is the manufacturer and seller of inter alia watches, watch straps and watch leashes. The SHARK mark has been used in relation to its goods sold in the UK and EU since at least 1998. The SHARK watch was designed in the early 1980s and was the first purpose-built surf watch. It is claimed that SHARK watches have a strong following around the world, including the EU and UK, and are popular amongst water sports enthusiasts and the wider public.<sup>6</sup>
- b) Approximate annual turnover figures have been provided for the years 2018 to 2022.<sup>7</sup> These are replicated below:

**Q11. Please provide details of the number of sales achieved under the mark in the UK (or in the EU if the earlier mark is registered or protected at Community level) during the relevant period. These figures should, if possible, be provided on an annual basis and, if possible, be split in relation to each of the goods/services for which use of the mark is claimed; estimates should be provided if exact figures are not readily available.**

*Note: You may provide financial turnover figures to illustrate the level of sales under the mark, but if you do please also provide an indication of the typical unit price for the product or service.*

Calendar Year	EU Sales Turnover - SHARK	EU SHARK units sold
2018	In excess of USD 55,000	1,104
2019	In excess of USD 88,000	1,604
Calendar Year	UK Sales Turnover - SHARK	
2020	In excess of USD 10,000	
2021	In excess of USD 10,000	
2022	In excess of USD 11,500	

Wholesale and retail unit price for SHARK watches varies; SHARK watches generally retail around the world for USD 55 - USD 65. My Exhibit JG4 shows the retail price of SHARK watches over the years.

However, it is unclear from precisely which goods these turnover figures relate. On examination of the Form TM7F, I can see that the opponent claims use for *“Watches and watch accessories in this class, including watch straps, watch*

<sup>6</sup> Form TM7F, Q13

<sup>7</sup> Form TM7F, Q11

*brands [sic].*<sup>8</sup> Yet as can be seen under the figures at Q11 replicated above, it states “*wholesale and retail unit price for SHARK watches varies; SHARK watches generally retail around the world for USD 55- USD 65. [...]*”. This appears to be in response to the above which states: “*Note: You may provide financial turnover figures to illustrate the level of sales under the mark, but if you do please also provide an indication of the typical unit price of the product or services.*” Therefore, I have interpreted these figures to relate solely to watches sold under the SHARK mark.

- c) Turnover figures are supported by evidence of invoices to UK (in Cornwall and London), French and Spanish retailers stocking SHARK products between 25 June 2018 and 2 November 2022.<sup>9</sup> The products appear to relate to watches rather than watch strap kits or accessories.
  
- d) Evidence of what are described as fulfilled orders from the opponent’s website ‘www.freestyleusa.com’ dated 18 April 2018 to 7 June 2022.<sup>10</sup> These are for individuals in the UK (with the only precise locations visible in the UK being Havant, Westcliff-on-sea and London), and in the EU prior to the IP completion date, including Belgium, France, Finland, Germany, Spain, Hungary, Denmark and Portugal. I can see that payment and shipping has been completed through the ‘myshopify’ sub-domain. These refer predominantly to watches with the only invoice for strap kits or strap tools found in Exhibit JG2 at pages 4, 8 and 20.
  
- e) There are images of SHARK goods that appear to be from website listings.<sup>11</sup> It is claimed that these are images of the goods found within the invoices and purchase orders, although it is not always possible to identify such due to the quality of the images produced. These are images of watches and watch straps kits under the SHARK brand. The mark used can be seen from the images below.

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<sup>8</sup> Form TM7F, Q7

<sup>9</sup> Exhibit JG1

<sup>10</sup> Exhibit JG2

<sup>11</sup> Exhibit JG3



As can be viewed from these images, on the watches, the word SHARK is found below what appears to be a picture or silhouette of a shark's fin. Equally, on the watch strap kits, the same mark appears as on the watches with the addition of the descriptive word "CLIP" below.

f) Archived webpages from the opponent's website 'www.freestyleusa.com'. Using the way back machine the evidence shows the website offering watches and watch straps for sale under the SHARK mark from 22 May 2018 to 7 March 2023.<sup>12</sup> These are exemplified below:

Home > Shark

COLLECTION

- Shark Classic Clip (57)
- Shark Classic Analog Clip (11)
- Shark Classic Leash (23)
- Shark Classic Analog Leash (7)
- Shark Classic (6)
- Show more

Closure

- Clip (73)
- Leash (30)
- Buckle (8)

Material

- Polyester (23)
- Silicone (11)
- Nylon (3)
- Polypropylene (1)


Watch Color

- Multi (44)
- Black (36)
- Pattem (34)
- Blue (29)
- White (21)
- Show more

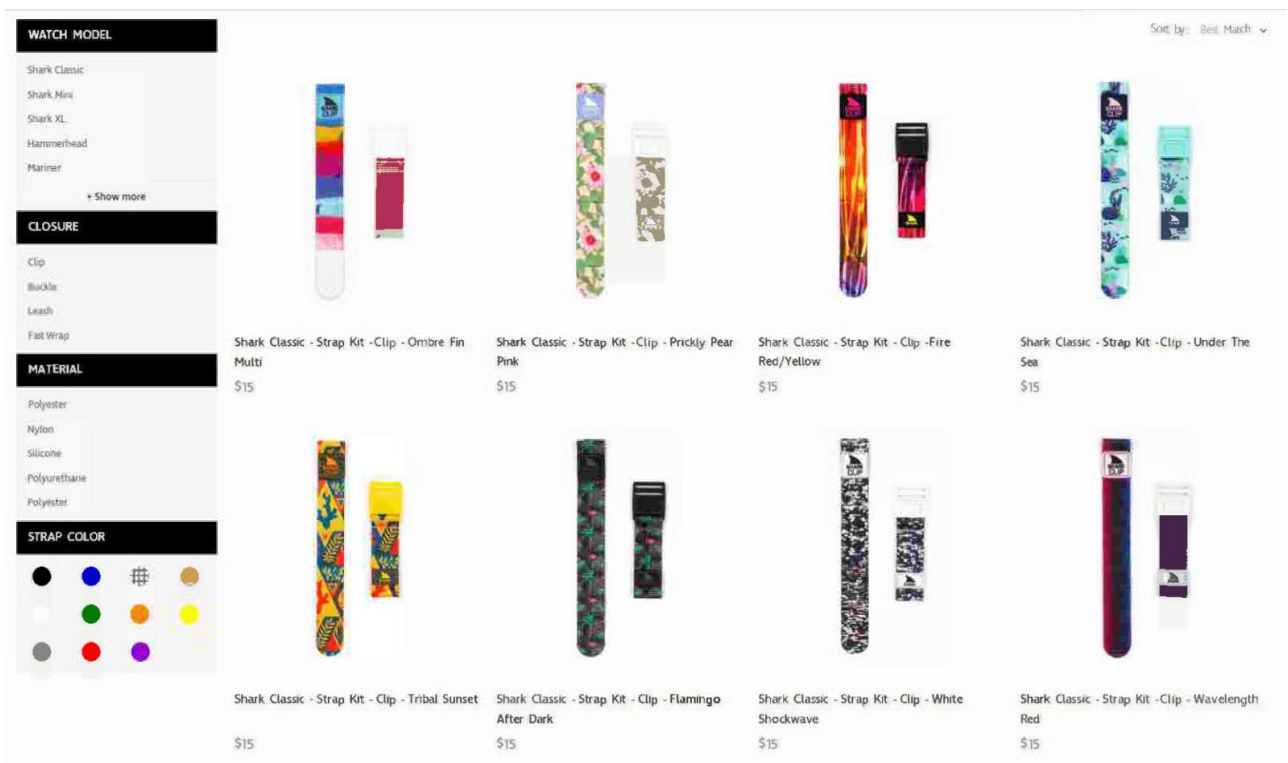
Movement Type

108 results

Sort by Best Match

 Shark Classic Leash Since '81 Neon Wave \$65	 Shark Classic Clip Since '81 Neon White \$65	 Shark Classic Clip Tie Dye Aqua Cloud \$65	 Shark Classic Clip Tie Dye Pink Splash \$65
 Shark Classic Clip Analog Tie Dye Neon Green \$65	 Shark Classic Clip Rainbow Licorice \$65	 Shark Classic Clip Pink Lemonade \$65	 Caroline Marks Shark Classic Leash Surfin Usa \$65

<sup>12</sup> Exhibit JG4



However, I do not have any details of the number of visitors to this website, or the location of those visitors.

## Form of the mark

24. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2), which can also be applied to variant use in proof of use cases. He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU\*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hyphen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or, it is supposed, figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

25. Turning to whether all use of the mark is acceptable. Addressing this point, I keep in mind that in addition to the above case law, in *Colloseum Holdings AG v Levi Strauss & Co*, Case C-12/12, the CJEU stated that use of a mark encompasses use of that mark with, or as part of, another mark, so long as it continues to be

perceived as indicative of the origin of the goods or services at issue: see paragraphs 32-36.

26. The mark appears in word only format such as in the invoices/purchase orders or on website listings along with the product description. As for the mark that appears on the watch goods, i.e. the word SHARK with an image or silhouette of a shark's fin. Keeping in mind the case law above, figurative elements are usually less likely to change the distinctive character than word elements. Moreover, in this instance, the figurative element is merely reinforcing the meaning of the word, as a shark's fin is iconic, and often the only part of a shark visible from the water's surface. Therefore, in my view, the addition of the figurative element fails to alter the distinctive character of the mark as registered, and I find it is acceptable variant use. In relation to use of the mark on the watch strap kits, I also consider this to be acceptable variant use as the addition of the descriptive element, "CLIP" does not alter the distinctiveness of the mark as registered.

### **Sufficient use**

27. Despite some shortcomings within the evidence, (not least the lack of breakdown figures for the goods relied on) from the evidential picture overall, I am prepared to accept on balance, that the evidence shows that sales made within the relevant period across both the EU and UK are on a scale sufficient to show genuine use of watch goods. Whilst I have no evidence in relation to the size of the watch market in either the UK or Europe, it is my impression that although a large market it is also an extremely competitive market and therefore total sales in excess of \$174,500 over the relevant period is not insignificant. I remind myself that the genuine use provisions do not exist in order to assess economic success or large-scale commercial use. Further, I can see that from the invoice and fulfilled purchase order evidence that the territorial extent of watch sales made in the EU prior to the IP completion date span several countries including Spain, France, Germany, Belgium, Finland, Hungary, Denmark and Portugal. As for the UK watch sales these are spread across at least the southeast and southwest of England. The invoice evidence focuses mainly on watches sold with the sales showing a

consistent and repeated pattern throughout the relevant period to both individuals and retailers. Therefore, I am satisfied that a genuine attempt has been made by the opponent to create and maintain a market presence for the watches under this brand.

28. However, in contrast, I do not find that the evidence is sufficiently solid to demonstrate genuine use in relation to watch straps and accessories under the SHARK mark as I have no specific turnover figures and limited invoice evidence for these goods.

### **Fair specification**

29. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, (which applies equally to the framing of a fair specification) as follows:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

30. In assessing whether, or the extent to which, the evidence shows use of the registered marks in relation to the goods relied upon, I bear in mind that fair protection is not to be achieved by identifying and defining particular examples of goods and services for which there has been genuine use, but, rather, the particular categories of goods and services they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer for the goods and services concerned.<sup>13</sup> In arriving at a fair specification, I must consider how the average consumer would fairly describe the goods shown in evidence; the task is not to describe the use made of the registered mark in the narrowest possible terms, unless that is what an average consumer would do. I remind myself that a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registrations.<sup>14</sup>

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<sup>13</sup> *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10

<sup>14</sup> *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

31. In relation to fair specification, having considered the evidence the only goods for which there is genuine use is in relation to watches. I observe that the applicant contends that at most the opponent's goods would be either, "*wrist watches for surfing*" or "*wrist watches for watersports*". The applicant relies on the opponent's statement where it is said: "*The SHARK watch was designed in early 1980s and was the first purpose-built surf watch... and are popular amongst water sports enthusiasts and the wider public.*".<sup>15</sup> In addition to this it is asserted that, "*They are digital waterproof watches mostly, it seems, with LCD displays for surfing and water sports. They are functional rather than being ornamental or luxury watches for dress or adornment.*"<sup>16</sup>

32. I acknowledge from the website evidence that the watches are pictured as being worn by people whilst having either the beach or water in the background. There are also images of the SHARK watch being worn by someone holding a surfboard.<sup>17</sup> Moreover, the goods are marketed as shown on images of website listings as being water resistant to 330 feet (100m).<sup>18</sup> I remind myself that the opponent should not be expected to demonstrate all possible variations of the goods covered by its registration. That said, having considered the nature of the goods for which genuine use has been shown and keeping in mind that I must consider how the average consumer would fairly describe the goods in evidence, I accept that the current specification is rather broad. As such, it would not be fair to allow the opponent to have a term that provided such a wide scope of protection for goods that are not covered in the evidence. Nevertheless, I reject "*wrist watches for surfing*" to be a fair specification, as in my view, given the evidence, this would be too narrow and artificially limit the goods in a manner that is contrary to framing a fair specification. However, I accept that "*wrist watches for water sports*" best reflects how the average consumer would describe the goods shown within the evidence.

33. Consequently, I find a fair specification to be:

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<sup>15</sup> Form TM7F, Q13

<sup>16</sup> Applicant's written submissions paragraph 25

<sup>17</sup> Exhibit JG4, page 3

<sup>18</sup> Exhibit JG3, page 1

**Relevant section 5(2) case law**

34. I am guided by the following principles which are gleaned from the decisions of the CJEU 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 and services**

35. All relevant factors relating to the goods and services should be taken into account, which include, inter alia:<sup>19</sup>

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<sup>19</sup> See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case.

- the physical nature of the goods and services;
- their intended purpose;
- their method of use / uses;
- who the users of the goods and services are;
- the trade channels through which the goods and services reach the market;
- in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
- whether they are in competition with each other (taking into account how those in trade classify the goods and services, for instance whether market research companies put them in the same or different sectors)

or

- whether they are complementary to each other. Complementary signifying that “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 and services lies with the same undertaking”.<sup>20</sup> It is noted that complementarity means that there is an autonomous criterion capable of being the sole basis for the existence of similarity.<sup>21</sup>

36. When interpreting the terms in a specification, I bear in mind that it is necessary to focus on the core of what is being described and that trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. Nevertheless, the principle should not be taken too far and where words or phrases in their ordinary and natural meaning are apt to cover the

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<sup>20</sup> *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82, see also *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL O/255/13

<sup>21</sup> *Kurt Hesse v OHIM*, Case C-50/15 P, see also *Sanco SA v OHIM*, Case T-249/11

category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.<sup>22</sup>

37. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

“365. [...] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

38. I am minded that in *Avnet Incorporated v Isoact Limited* [1998] FSR 16, Jacob J (as he then was) said at [19]:

“[...] definitions of services ... are inherently less precise than specifications of goods. [...] In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

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<sup>22</sup> *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

39. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*.<sup>23</sup>

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

40. Further, in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-133/05, the General Court (“GC”) stated that:

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

41. The goods and services to be compared are shown in the table below:

Opponent’s goods	Applicant’s goods and services
	<p><u>Class 14</u></p> <p>Jewellery; horological and chronometric instruments; paste jewellery [costume jewellery]; pins [jewellery]; shoe jewellery; rings; earrings; necklaces; chokers; pendants; bracelets; charity bracelets; bangles; brooches; lapel pins; tie clips; tie bars; cuff links; cuff bracelets; charms; clocks; watch bands;</p>

<sup>23</sup> BL O/399/10

	watches; smart wrist watches; wristwatches with pedometer feature; charms for key chains; charms for key rings; key chain tags; key chains for use as jewellery; key chains; horological and chronometric apparatus and instruments; parts, fittings and accessories for all the aforesaid.
<u>Class 14</u> Watches and watch accessories in this class, including watch straps, watch bands, watch glasses.	<u>Class 35</u> Retail services, mail order services and wholesaling services connected with the sale of clocks, wrist watches, watch straps, presentation cases for watches, stopwatches, horological and chronometric instruments.

42. The opponent's goods in class 14, for which I have found a fair specification to be "*wrist watches for water sports*" would fall under the applicant's term "*watches*". Therefore, they are identical under the *Meric* principle. As at least some of the goods are identical I will proceed on the basis that the contended goods are identical to those covered by the earlier mark. If the opposition fails, even where the goods are identical, then it follows that the opposition will also fail where the goods are only similar.

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

43. As indicated in the caselaw cited above, it is necessary to decide who the average consumer is for the parties' goods and services and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."<sup>24</sup> The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the

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<sup>24</sup> *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch).

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 and services in question.<sup>25</sup>

44. I note from the opponent's submissions that it claims that "consumers will include ordinary members of the public and the level of attention exhibited would be at best average, if not low."<sup>26</sup> However, further within its submissions it summarises that the "Opponent submits that the average consumer will exhibit an average level of care and attention for the contested goods and services in Classes 14 and 35."<sup>27</sup>

45. In contrast the applicant states that the consumers are likely to pay at least normal attention when purchasing the goods if not a higher degree of attention given the relatively high value of the goods and corresponding retail services. Further the applicant argues that the visual perception of the marks is likely to be more significant.<sup>28</sup>

46. Having considered the submissions of both parties, I find that the average consumer for the goods and services at issue will predominately be a member of the general public but could also include professionals such as jewellers.

47. I consider the costs of the goods and services to range from relatively low (for watches made with low cost materials) to possibly fairly high (for jewellery crafted from valuable metal such as platinum or gold and that may include precious or semi-precious stones). The average consumer will likely consider the material used, the size, fit, and aesthetic appearance of the goods and the ease of use of the services. Professional jewellers are likely to carry out further considerations on the materials' quality. I find the degree of attention will be medium (average) for members of the general public and above medium (average) for professional users. The goods are likely to be obtained following a visual examination of the goods from glass cabinet displays within jewellery stores or by self-selection from the shelves in retail outlets. A similar process will apply to goods online as they will

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<sup>25</sup> Lloyd Schuhfabrik Meyer, Case C-342/97.

<sup>26</sup> Paragraph 49

<sup>27</sup> Paragraph 51

<sup>28</sup> Applicant's written submissions, paragraph 11.

be selected after viewing images on websites. The services are likely to be used following a visual inspection of the shop fronts or from online websites. Overall, I am of the view that visual considerations would dominate the purchasing process, however, I do not discount aural considerations will play their part, particularly when advice is sought from sales representatives or, for word of mouth recommendations.

### **Comparison of the trade marks**

48. 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.”

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

50. The respective trade marks are shown below.

Opponent's trade mark	Applicant's trade mark
SHARK	THE SHARK CAGE

Overall impression

51. The competing marks are both word only marks. The opponent's mark contains the word "SHARK" whilst the applied for mark encompasses the words "THE SHARK CAGE". The overall impression of the opponent's mark resides in the word itself. As for the applicant's mark, the overall impression rests within the words in equal measure as they join together to form a unitary meaning.

52. Before I conduct a visual, aural and conceptual comparison, I note that the opponent states the following in relation to the inclusion of the word "THE" in the applicant's mark:

"The definite article "THE" in the beginning of the Applicant's mark introduces no particular concept and is non-distinctive considering that the remaining elements in the Applicant's mark, "SHARK CAGE", have the same meaning with or without the definitive article (see by analogy BL O-435-19, Starwood Hotels & Resorts Worldwide, LLC v Glenkeir Whiskies Limited; BL O-490-18, The White Company (UK) Limited v The Blackcompany Ltd by way of examples). For all intended purposes, the contested mark will be recalled, vocalised and remembered as 'SHARK CAGE'.<sup>29</sup>

However, whilst I accept the point that the definite article "THE" is fairly non distinct by itself, as found in both cases cited by the opponent above, I also note that Philip Harris in the *Purity* case<sup>30</sup> stated that "*Descriptiveness does not of itself render an*

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<sup>29</sup> The opponent's written submissions, paragraph 60

<sup>30</sup> BL O/115/22

*element negligent or aurally invisible.*<sup>31</sup> Although “THE” is not descriptive but rather non distinct, I see no reason why the same principle would not apply to non-distinct words. Furthermore, within the applicant’s mark I find that the words have a unitary meaning that extend beyond the individual meaning of each word on its own. For these reasons, I do not discount the definite article when carrying out a similarity assessment of the competing marks.

### Visually

53. The opponent claims that there is “*at least a moderate degree of overall visual similarity between the marks.*”<sup>32</sup> Contending that the marks coincide in the word “SHARK” and that the “CAGE” component is found at the end of the mark which reduces its impact.<sup>33</sup>

54. I agree that the marks are visually similar to the extent that they both contain the word “SHARK”. However, the applied for mark contains the additional words “THE” and “CAGE” which cause the marks to differ considerably in length. Consequently, I consider the competing marks to be visually similar to somewhere between a low and medium degree.

### Aurally

55. The opponent asserts that:

*“Aurally, the mark coincide in the sound ‘SHARK’; the word will be pronounced clearly and in identical fashion in both marks. Vocalisation of ‘CAGE’ will follow at [sic] that of ‘SHARK’ and the word ‘cage’ produces a shorter sound to that of ‘shark’. ‘Cage’ would have a reduced role in the phonetic comparison of the marks by virtue of its position in the contested mark. It is submitted that the*

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<sup>31</sup> Ibid, paragraph 31

<sup>32</sup> Opponent’s written submissions, paragraph 61

<sup>33</sup> Ibid

marks are **aurally similar at least to a moderate degree.**"<sup>34</sup> (Original emphasis)

56. I disagree with the opponent's submissions in relation to the pronunciation of the word cage and the fact that it would have a reduced role due to its position within the mark. I keep in mind that ends of marks may also be impactful,<sup>35</sup> and further that the word "SHARK" is found in the middle of the applicant's mark not at the beginning. The opponent's mark encompasses a single syllable stemming from the word "SHARK" pronounced in the usual way. Conversely, the applied for mark will contain three syllables arising from three single syllable words, i.e. "THE-SHARK-CAGE". The marks aurally overlap in the single syllable produced by the word "SHARK", which is found in the middle of the applied for mark and is the only syllable within the opponent's mark. However, the marks differ in the remaining syllables found within the applied for mark which are absent in the earlier mark. Consequently, I find that the competing marks are aurally similar to somewhere between a low and medium degree.

#### Conceptually

57. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>36</sup>

58. The opponent argues that: "*Conceptually, 'SHARK' qualifies the 'CAGE' component in the contested mark. Therefore, both marks will be understood as having something to do with sharks. Therefore, the marks are conceptually similar at least to a low degree.*"<sup>37</sup>

59. In contrast, the applicant asserts that the marks are conceptually dissimilar stating:

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<sup>34</sup> Opponent's written submissions, paragraph 62

<sup>35</sup> *Bristol Global Co Ltd v EUIPO*, T-194/14

<sup>36</sup> *Ruiz Picasso v OHIM* [2006] E.T.M.R 29.

<sup>37</sup> Opponent's submissions, paragraph 63

*“First, both contain the word SHARK, but any visual or phonetic similarity between the marks is negated by the conceptual difference. The first refers to and would immediately be understood as a predatory and dangerous marine animal. The second refers to and again would immediately be understood as a man-made safety structure, and place of refuge, probably of metal or some other strong material.*

*Second, the Opponent’s mark is presented as an abstract noun whereas the mark in the Application is preceded by the definite article crystallising the meaning as being a specific, singular structure and place of refuge.*

*Third, the grammatical subject of the mark in the Application is the word “cage”. The word “shark” plays a secondary role acting as an adjectival noun which fixes the nature of that “cage”. The terms “the”, “shark” and “cage” hang together to create a clear and unitary meaning wholly distinct from the meaning of the word “shark”.”<sup>38</sup>*

60. I acknowledge the opponent’s submission that both marks will be seen as having something to do with sharks, however, I disagree that this leads to similarity. A dog and a dog treat for example both contain the word dog, but this does not mean that they are conceptually the same, even if they do have something to do with dogs. The word “SHARK” will be understood as a large fish with sharp teeth and a pointed fin on its back, that are known for attacking people. As for the applied for mark, whilst it contains the word “SHARK”, I agree that it combines with the additional words found within the contested mark to create an entirely different meaning. With the use of the definitive article “THE” the contested mark will be perceived as referring to a particular “SHARK CAGE”. A shark cage being a strongly built metal structure that is designed to protect divers from sharks whilst they observe them in their natural habitat. Despite the overlap in the word shark, when taken as a whole the marks clearly convey very different meanings. As such I find that the marks are conceptually dissimilar.

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<sup>38</sup> Applicant’s submissions, paragraph 4

## Distinctive character of the earlier mark

61. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how 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).”

62. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

63. As discussed above, the opponent’s mark is a word only mark consisting of the single word “SHARK”. Consequently, the distinctive character of the mark lies in

the word “SHARK”. “SHARK” is a dictionary defined word which consumers will be familiar with.

64. I note that the applicant has filed evidence in the form of a short witness statement which includes screenshots. In Mr Bartlett’s witness statement, he says:

*“Between May 2024 and January 2025 I conducted internet searches which disclosed that the term “shark” is commonly used in relation to wrist watches, and in particular watch straps, to indicate that they are made of shark, and more particularly the skin of a shark, or at least made of materials intended to imitate the look and feel of the skin of a shark.”<sup>39</sup>*

65. Further, it is asserted by the applicant that its evidence demonstrates that shark skin watch straps are commonly offered to UK consumers and that “shark-skin” is often abbreviated to just “shark”.<sup>40</sup> For ease, I have included screenshots from the evidence below:

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<sup>39</sup> Witness statement of Mr Ian Bartlett, paragraph 2

<sup>40</sup> Applicant’s written submissions, paragraph 31



DI-MODELL  
Di-Modell Genuine SHARK  
SKIN Waterproof Leather  
Watch Strap in NAVY

£43.95

3 Colours



DI-WATCH STRAP  
Breitling-Style Shark Watch  
Strap and Buckle in BLACK

£32.95

4 Colours



DI-WATCH STRAP  
Breitling-Style Shark Watch  
Strap and Buckle in BROWN

£32.95

4 Colours



HIRSCH  
Hirsch NAVIGATOR Shark  
Skin Deployment Watch  
Strap in BLACK

£95.40 ~~£105.00~~

3 Colours



HIRSCH  
Hirsch NAVIGATOR Shark  
Skin Deployment Watch  
Strap in BLUE

£95.40 ~~£105.00~~

3 Colours



DI-WATCH STRAP  
Breitling-Style Shark  
Leather Watch Strap and  
Buckle in NIGHT BLUE

£32.95

4 Colours



DI-WATCH STRAP  
Breitling-Style Shark  
Deployment Watch Strap in  
BLACK

£32.95

4 Colours



DI-WATCH STRAP  
Breitling-Style Shark Skin  
Leather Watch Strap and  
Buckle Honey Brown

£32.95

4 Colours



DI-WATCH STRAP  
Breitling-Style Shark  
Deployment Watch Strap in  
BROWN

£32.95

6 Colours

HOME > HIRSCH NAVIGATOR SHARK SKIN DEPLOYMENT WATCH STRAP IN BLACK



070 05 4 50-1816 | HIRSCH  
**Hirsch NAVIGATOR Shark Skin Deployment Watch Strap in BLACK**

£95.40    ~~£159.00~~    [REVIEWS](#)

Colour Options



Width (Lug/Buckle) SIZE GUIDE

Select an option

Length SIZE GUIDE

Select an option

- 1 +

Add to Bag

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12+. T&C apply. Credit subject to status.

Description

Designed for compatibility with Breitling hardware, the Navigator boasts a novel shark skin construction, with generous padding, contrast stitching and a distinctive semi-tapered 'Sportivo' tip.

*Please note: Any watches pictured are for illustration purposes only and are not included.*



**SHARK SKIN WATCH STRAP**

£140.00  
 Tax included.

Our straps are handmade using ethically sourced skins.

- Size – 22mm wide at the lugs, 20mm wide at the buckle
- Lining – Calfskin
- Stitching – your choice

ASK A QUESTION

ADD TO CART

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## Real Shark Skin Leather Guarantee

We only and will only use real authentic leather for all of our products.

Shark skin leather is a type of exotic leather made from the skin of sharks. It is known for its unique texture and appearance, which includes a pattern of small, overlapping scales called "dermal denticles." These denticles are characteristic of shark skin and give the leather a distinctive and visually appealing look.

Shark skin leather is valued for its strength, durability, and water resistance, making it suitable for a variety of high-end products such as wallets, belts, shoes, and watch straps. The leather's resilience and unique texture have made it popular in the fashion industry for creating luxury accessories.



Black Shark Skin Leather Strap with Orange Stitching



Shark Skin Watch Strap  
- Black  
★★★★★ (35)  
£90.00



Shark Skin Watch Strap  
- Blue  
★★★★★ (14)  
£90.00



Shark Skin Watch Strap  
- Brown  
★★★★★ (4)  
£90.00



Shark Skin Watch Straps - Black leather-  
Green stitch - 18mm  
£58.00

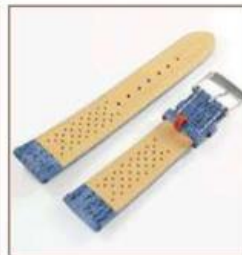
SOLD OUT



Shark Skin Watch Straps - Brown Leather  
- Black stitch - 25mm  
£58.00

### Di Modell Shark Skin Blue Waterproof Sports Watch Strap : Long : 18mm, 20mm or 22mm

Click on any of the pictures for a larger image (opens as a pop up - contact us if you want to see even bigger pictures)



Price : £48.95  
(Plus £1.95 UK postage)

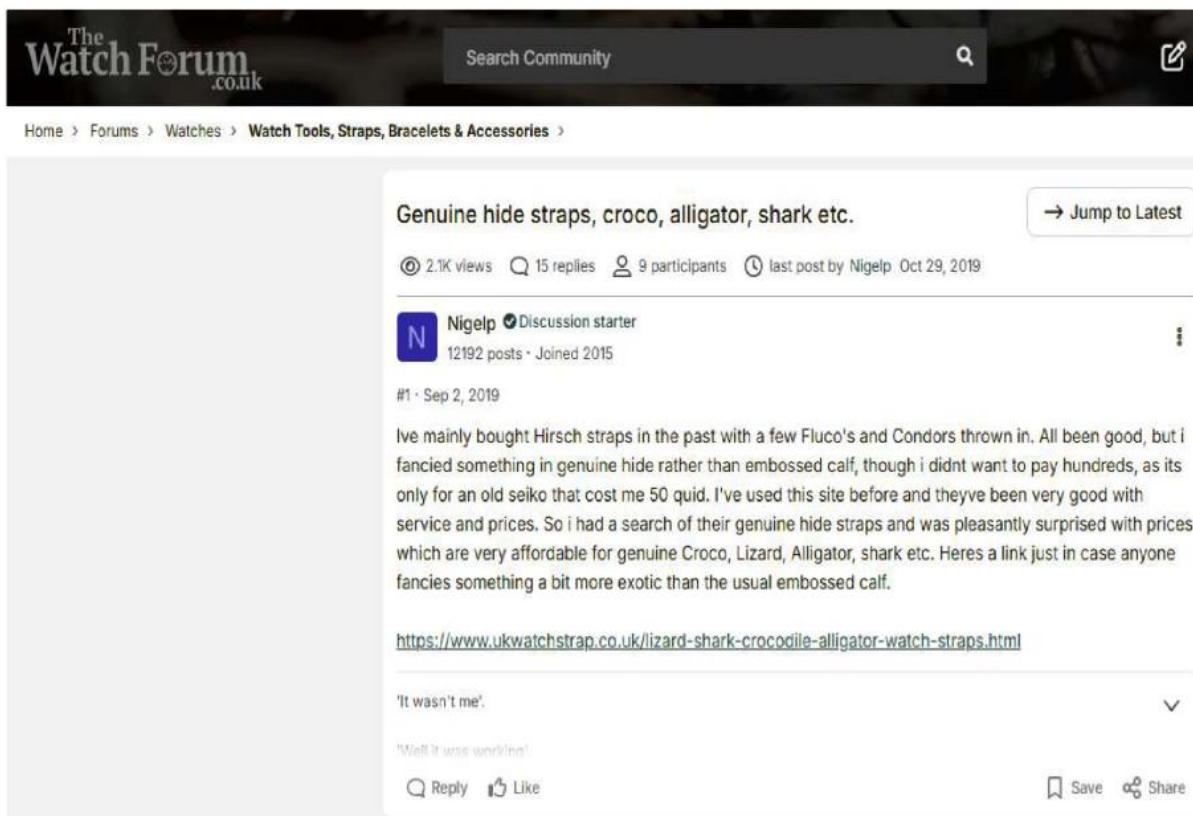
**Please note: We are sold out of this strap in 18mm, 20mm and 22mm. We have other options here**

### Product Description:

Di Modell Blue Sharkskin Waterproof Sports Watch Strap - Genuine Shark Skin - Long Length - 18mm, 20mm, 22mm, 22mm

**Please note: We are sold out of this strap in 18mm, 20mm and 22mm and don't know when we will be able to get them again. We have other options here**

Finest Quality, hand made in Germany this padded blue long length watch strap is made of genuine shark skin, with white detail stitching. Waterproof to 100m, it is sporty, durable yet comfortable, with Di Modell's patented aero lining and loop anchor for extra comfort.



66. Although Mr Bartlett states in his witness statement that these are only examples and he has found numerous others,<sup>41</sup> without sight of these I cannot examine what weight to give such evidence.

67. The opponent disagrees with the applicant's assessment of the evidence and has provided detailed submissions explaining why. These can be found at paragraphs 24 to 40 of its written submissions in lieu. However, for the purpose of this decision I will summarise the pertinent points, which are:

A) The majority of the evidence as confirmed by the witness statement of Mr Ian Bartlett (paragraph 2) relates to searches conducted between May 2024 and January 2025 which is prior to the relevant date for assessment, that being the date of application, i.e. 28 April 2023.<sup>42</sup>

<sup>41</sup> Witness statement of Ian Bartlett, paragraph 4

<sup>42</sup> Opponent's written submissions, paragraphs 24-26

- B) There are only two examples of the word “SHARK” being used in reference to shark watch straps made of shark skin and these are years apart.<sup>43</sup>
- C) Reference to shark at paragraph 5 of Mr Ian Bartlett’s witness statement, is in the context of the reference to genuine hide straps.<sup>44</sup>
- D) Limited examples are not sufficient to establish that the distinctiveness of a mark has been weakened. BL O-0429-24, *STRIPE, INC v EPYX LIMITED*; para 46.<sup>45</sup>
- E) The evidence relates only to watch straps and not watches.<sup>46</sup>

68. Having considered this evidence and the parties’ submissions, notwithstanding the dates of the evidence before me, I find that the applicant’s evidence does not adequately demonstrate that the word “SHARK” is commonly used to denote that watches are made from shark skin or imitations of shark skin. Rather, the evidence shows only one retailer using both “*shark skin*” and the word “SHARK” in relation to their shark skin watch strap products with the remaining retailers using only the term “shark skin”. Further, in relation to the forum discussions replicated on the above page, I agree with the opponent’s submissions that this is in the context of hide which is an alternative way of referring to the skin of mammals. Overall, I am not persuaded that the evidence provided sufficiently demonstrates that the word “SHARK” *solus* is commonly used to describe materials that could be used for watch straps. Therefore, as the earlier mark contains only a common dictionary defined word that I do not find to be descriptive of the goods relied upon, including watch straps, I consider the earlier mark to be inherently distinctive to a medium degree.

69. As for whether there is any enhanced distinctiveness demonstrated by the evidence provided, I keep in mind that enhanced distinctiveness relates only to use within the UK. I note from the evidence that turnover for the UK has only been provided for the years 2020 to 2022. These are 10,000 US dollars for the years

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<sup>43</sup> Ibid, paragraph 29

<sup>44</sup> Ibid, paragraphs 31 and 32

<sup>45</sup> Ibid, paragraph 40

<sup>46</sup> Ibid, paragraph 27

2020 and 2021 and 11,500 US dollars for 2022. I observe that for the UK, there are a smaller number of invoices to retailers (8 in total)<sup>47</sup> for goods under the earlier mark addressed to the UK between the years of 2019 and 2022, including to Cornwall. In relation to individual consumers, the opponent has provided fulfilled order sheets showing 10 orders to the UK between 2018 and 2021, however, these are heavily redacted so that only the country not the precise location within the UK is visible. In addition, three further invoices have also been supplied dated between 2020 and 2022.<sup>48</sup> The highest value being for \$267.05.<sup>49</sup> The invoices show orders for Westcliff-on- sea, Havant and London.<sup>50</sup> I have no evidence regarding the amount spent on marketing and advertising figures in the UK, and as for the publicity of the earlier mark, I observe that there are no third-party articles or magazine evidence. Whilst there is some website evidence,<sup>51</sup> it is not clear how far reaching this website evidence is within the UK as I have no UK viewing figures for these sites within the relevant period. Overall, having considered the evidence of the mark on the UK market, I consider that the evidence as a whole does not strike me as indicative of a level of activity that would lead to the capacity of the mark, measured from the perspective of the average consumer, to more greatly identify the goods as coming from a particular undertaking, beyond its inherent capability to do so. In reaching this decision I have borne in mind that the threshold for proving enhanced distinctiveness through use is higher than that for demonstrating genuine use.

## **Likelihood of confusion**

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

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<sup>47</sup> Noting that the invoice in exhibit JG1 at pages 29 to 30 of the evidence is a repeat of the invoice found at exhibit JG1 pages 35 to 36 of the evidence.

<sup>48</sup> Exhibit JG2

<sup>49</sup> Ibid, page 3

<sup>50</sup> Ibid, pages 20 to 23.

<sup>51</sup> Exhibits JG3 and JG4

undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

71. I have found:

- The average consumer of the goods and services will be predominantly the general public who will pay a medium (average) level of attention during the purchasing process. However, they could also be professionals such as jewellers, who will pay an above medium (average) level of attention.
- The purchasing process will be predominantly visual; however, I have not discounted aural considerations.
- The competing marks are visually and aurally similar to somewhere between a low and medium degree and conceptually dissimilar.
- The earlier mark to be inherently distinctive to a medium degree, the evidence of use before me not having enhanced the level of distinctiveness.
- Finally, there will be identity for at least some of the goods.

72. I acknowledge that the competing marks both contain the word "SHARK". However, as discussed above, the words within the applied for mark will be perceived as having a unitary meaning when combined that differs to the meaning of the word "SHARK" solus. I keep in mind that a conceptual difference between

two competing marks may counteract the visual and phonetic similarities between them.<sup>52</sup>

73. I acknowledge the opponent's argument that:

*"The earlier mark is 'SHARK'; its overall distinctiveness lies in that one component which [is] fully contained within the Applicant's mark. For the reasons discussed above (in particular para 51-56), the Opponent submits that SHARK benefits from a high level of distinctiveness particularly for watches. It is also repeated that SHARK qualifies the 'CAGE' component of the Applicant's mark; their mark will always be seen, vocalised and understood in reference to SHARK. **The fact that the marks coincide on an identical, distinctive component only increase the likelihood of confusion as per the case law referenced in para 65 above.**"*<sup>53</sup> (Original emphasis)

74. Although I accept that where a composite mark is made up of the earlier sign plus another component, it may lead to a likelihood of confusion, this is only if the earlier sign retains a distinctive significance that is independent of the mark as a whole. In contrast, it is clear from *Whyte and McKay*,<sup>54</sup> (which considered the impact of *Bimbo*<sup>55</sup> and *Medion*<sup>56</sup>) that this does not apply where the average consumer would perceive the composite mark as forming a unit and having a different meaning to those of separate components. As I have discussed above, I have found that the contested mark when taken as a whole has a different meaning to that of the earlier mark and therefore the word "SHARK" within the applied for mark does not retain an independent distinctive role in the applied for mark.<sup>57</sup> Consequently, I do not believe that the conceptual differences between the marks, will go unnoticed by the average consumer and therefore they will counteract any visual or aural similarity. Further, the additional elements in the applied for mark create a

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<sup>52</sup> *The Picasso Estate v OHIM*, Case C-361/04 P

<sup>53</sup> Opponent's written submissions, paragraph 68

<sup>54</sup> *Whyte and McKay Limited v Origin Wine UK Limited* [2015] EWCH 1271 (Ch) paras 19 -21

<sup>55</sup> *Bimbo SA v OHIM*, Case C-591/12P

<sup>56</sup> *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04

<sup>57</sup> See also by analogy BL O-339-04, where Geoffrey Hobbs found that Cardinal and Cardinal Place has different meaning such that the word Cardinal did not retain an independent and distinctive role with the contested mark.

difference in length between the marks which will not be overlooked. Overall, it is unlikely that the marks will be mistaken for one another, as such, I do not consider there to be a likelihood of direct confusion even on identical goods.

75. I will now go on to consider indirect confusion. I acknowledge that a finding of indirect confusion should not be made merely because the two marks share a common element. Furthermore, it is not sufficient that a mark merely calls to mind another mark:<sup>58</sup> This is mere association not indirect confusion.

76. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C. (as he then was), as the Appointed Person, explained that:

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

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may

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<sup>58</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

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)".

77. Further, in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

78. As referred to in the above case law, indirect confusion exists where the differences between the marks are noticed, and those differences point to the existence of an economic relationship between the marks at issue. As highlighted above, *L.A. Sugar* sets out three main categories to consider that indirect confusion typically falls into; however, this is not an exhaustive list. The opponent expresses within its submissions that indirect confusion between these marks is the more likely scenario as the public would believe that the applied for mark/goods to be a brand extension or otherwise linked with the opponent's "SHARK" brand.<sup>59</sup> The opponent identifies the following as reasons why it believes there would be a likelihood of indirect confusion. First, it claims that it is common for the market in question to create sub brands or variations of the main brand that include different motifs or

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<sup>59</sup> Opponent's written submissions, paragraph 71

additions. The opponent provides the examples of ROLEX DATEJUST, ROLEX DAYTONA, TISOT BALLADE and TISSOT SEASTAR.<sup>60</sup> Second, the opponent uses its “SHARK” mark alongside additional components for its product range, which includes: SHARK MINI, SHARK CLASSIC, SHARK X 2.0, SHARK CLIP, SHARK LEASH.<sup>61</sup>

79. In relation to the first point, whilst it may be common for the market in question to use a sub brand that includes the house brand, such as in the examples provided above, in these examples the house brand retains an independent and distinctive role, unlike the applied for mark where I have found that the additional words alter the meaning of the mark, and arguably the words ROLEX and TISOT are so strikingly distinctive (both being invented words) that consumers may reasonably believe that no one else would be using them in the course of trade. In contrast, as I have discussed above, I do not believe that the word SHARK within the applied for mark retains an independent distinctive role. Further, I do not consider the shared word “SHARK” which is an ordinary dictionary defined word, is so strikingly distinctive that it would lead the average consumer to believe that only the opponent would be using it in trade, as discussed within the first category outlined above in *L.A. Sugar*. As established earlier in my decision, the earlier mark “SHARK” has only a medium level of inherent distinctive character which has not been enhanced through use.

80. As for the second point, the “SHARK” sub brands listed by the opponent and replicated above are the type that would all comfortably sit under the second category set out above in *L.A. Sugar*. As they are all simply bolting on non-distinctive elements to the “SHARK” mark with clip and leash both referring to parts of the goods, and indeed, MINI is expressly listed as an example by Mr Purvis. However, as I have already mentioned the additional elements of the mark hang together to form a unit and therefore will not be seen as merely the addition of non-distinct elements, but rather, play an equal role in the overall impression of the contested mark.

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<sup>60</sup> Ibid, paragraph 72

<sup>61</sup> Ibid, paragraph 73

81. Further the third category does not apply as this is where the earlier mark comprises a number of elements, and a change to one of those elements appears entirely consistent with a brand extension. In this case, the earlier mark contains a single element and does not exchange one element in the mark for another in the same way as FAT FACE and BRAT FACE. I therefore do not consider that there is any likelihood of confusion based on this third category of indirect confusion.

82. I keep in mind that the helpful examples provided in *L.A. Sugar* are not supposed to be taken as an exhaustive list. However, I do not consider that consumers will believe that there is an economic link between the marks. I am unpersuaded that “THE SHARK CAGE” would be perceived as a logical sub brand of the opponent’s mark. Consequently, I find that there is no basis for finding a likelihood of indirect confusion even when factoring in the identity of the goods at issue.

Final remarks

83. Even if I had found above genuine use for the opponent beyond ‘*wrist watches for water sports*’, this would not impact the outcome of my decision as I have found there to be no likelihood of confusion even for identical goods.

## CONCLUSION

84. The opposition under section 5(2)(b) of the Act has failed. Therefore, subject to any successful appeal against my decision, the application will proceed to registration.

## COSTS

85. As the applicant has been entirely successful, it is therefore entitled to a contribution for its costs based upon the scale published in Annex A of the Tribunal Practice Notice 1 of 2023 under the heading “**Scale adaptations for trade mark fast-track opposition proceedings**”. Whilst I observe that the amount in standard

fast-track cases is capped at £600 this does not take into account the limited number of cases where a party is granted permission to file evidence. Therefore, a higher amount has been awarded to take into consideration the filing of evidence in these proceedings. As such, I award the applicant the sum of **£800** which has been calculated as follows:

Considering a notice of opposition and filing a counterstatement	£250
Filing evidence	£200 <sup>62</sup>
Filing written submissions	£350
<b>TOTAL</b>	<b>£800</b>

86. I therefore order Freestyle Brands, LLC to pay The Jewel Gallery Limited the sum of **£800**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 19<sup>th</sup> day of January 2026**

**Sarah Wallace**

**For the Registrar**

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<sup>62</sup> This award takes into consideration the fact that the evidence was very limited.