O/0152/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 4040250
IN THE NAME OF EMEL SPORT LTD
TO REGISTER THE FOLLOWING SERIES OF TWO TRADE MARKS:

EMEL

and

emel

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 449688
BY "EMEL" s.c. Beata Kudrzyn, Cezary Kudrzyn

Background and pleadings

1. EMEL SPORT LTD ("the applicant") applied to register the series of two trade marks "EMEL" and "emel" in the UK on 7 April 2024, under number 4040250. Since the marks in the series only differ in the use of upper case and lower case, for ease of reference I will refer to them as "the applicant's mark" unless it becomes necessary for me to distinguish between them. It was accepted and published in the Trade Marks Journal on 9 August 2024 in respect of goods in Class 25. Following amendments, the specification is now as follows:

> *Class 25:* *Headgear; Sportswear; Athletic clothing; Clothing for sports.*

2. "EMEL" s.c. Beata Kudrzyn, Cezary Kudrzyn ("the opponent") opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed at all the goods in the application and is on the basis of its UK trade mark number 911835113, which is shown below ("the opponent's mark"):

3. This mark is a comparable mark created pursuant to Article 54 of the Withdrawal Agreement. The mark has the same legal status as if it had been applied for and registered under UK law and retains the original filing and registration dates of the EU Trade Mark from which it was created. The opponent's mark was filed on 22 May 2013 and became registered on 4 December 2015. It stands registered for the following goods:

> *Class 25:* *Footwear for children.*

4. The opponent's mark qualifies as an 'earlier trade mark' in accordance with section 6 of the Act. The earlier mark had been registered for more than five years at the filing date of the applicant's mark and is, therefore, subject to the use requirements in section 6A of the Act.

5. In its statement of grounds, the opponent contends that the competing marks are similar and that the parties' goods are similar as they are sold via the same distribution channels. On this basis, the opponent submits that there is a likelihood of confusion.

6. The applicant filed a counterstatement denying the ground of opposition. It also indicated that it would require the opponent to provide proof of use.

7. The opponent is professionally represented by Sonder & Clay and the applicant is represented by Agile IP LLP. Only the opponent filed evidence in these proceedings. No hearing was requested but both parties filed written submissions in lieu. This decision is taken following careful consideration of all the papers before me.

Relevance of EU law

8. 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[1] 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

9. The opponent's evidence consists of a witness statement provided by Mr Cezary Kudrzyn (dated 14 February 2025) and seven exhibits (CK1-CK7). Mr Kudrzyn is the co-owner of the opponent's company, which is a position that he has held since 1 February 1999. He provides evidence of use of the opponent's mark.

10. I have taken all the evidence into account in reaching my decision and will refer to it below where necessary.

Proof of use

11. Section 6A of the Act reads as follows:

> "(1) This section applies where –

[1] As amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023

(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."

12. 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.

…

(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(3) and (4) to the United Kingdom include the European Union.

13. Pursuant to the above provisions, the relevant period for assessing whether there has been genuine use of the opponent's mark is the five-year period ending with the filing date of the applicant's mark, i.e. 8 April 2019 to 7 April 2024. Within this period, the relevant territory is the EU for the period up to 31 December 2020 and the UK thereafter.

14. In *easyGroup Ltd v Nuclei Ltd & Ors*[2], 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*

[2] [2023] EWCA Civ 1247

Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [2006] ECR I-4237, Case C-442/07 V*erein Radetsky-Order v Bundervsvereinigung 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 sub-category 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].”

15. Moreover, section 100 of the Act states that:

> "If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

16. In his witness statement, Mr Kudrzyn states that the opponent sells handmade shoes for children. Although its roots date back to 1992 as a company based in Poland, the opponent has sold shoes bearing the opponent's mark on a wholesale basis in the UK in 2014.

Preliminary issue: relevant period

17. A significant proportion of the evidence filed predates the relevant period (8 April 2019 to 7 April 2024). The turnover figures provided in Mr Kudrzyn's witness statement include the years 2014 to 2018. I have therefore disregarded the sales figures provided in the witness statement for these years on the basis that they fall outside of the relevant period. Furthermore, as the relevant period began on 8 April 2019 and ended on 7 April 2024, I am mindful that the turnover figures for the years 2019 and 2024 are likely to include sales made before and after the relevant period started and finished. Although I cannot be sure of what proportion of the sales from 2019 and 2024 ought to be discounted, I am mindful that the figures for 2019 and 2024 are likely to be lower than the amounts shown in the table in paragraph 20.

18. There are also a number of other exhibits which predate the start date of the relevant period (8 April 2019). For example, Exhibit CK1 shows a footwear brochure which Mr Kudrzyn states in his witness statement was prepared in 2014. Exhibit CK4 shows the opponent's full one-page advertisement in Vogue magazine in 2015. Exhibit CK5 shows a screenshot of a social media post made on Instagram in 2015. Exhibit CK7 shows certificates and awards given to the opponent, such as a certificate awarded by the European Centre for Quality and Regional Promotion (dated 2012-13), a consumer award (dated 2017), and a Junior Design Award (2018). However, as all of these pieces of evidence fall outside of the relevant period of 8 April 2019 to 7 April 2024, I have not taken them into account. In addition to this, Exhibit CK6 shows ten pages of screenshots showing social media posts on Facebook, Instagram, and YouTube. I note that the first three screenshots on pages 1, 2, and 3 of the exhibit relate to posts made in 2016, 2017, and 2018, which were all made outside of the

relevant period. Furthermore, the screenshots on pages 4 and 5 show a date in 2019. However, as the full dates are written in what I believe to be Polish, I am unable to determine whether these screenshots relate to a date in 2019 before the relevant period began on 8 April 2019 or after it. In addition to this, the screenshot on page 10 is undated and therefore it is unclear if it falls within the relevant period. I have therefore also disregarded the first five pages and the last page of the Exhibit CK6, as they either fall or potentially fall outside of the relevant period.

19. In the witness statement, Mr Kudrzyn states that Exhibit CK2 shows "examples of the products, labels, and packing used... on shoe products sold in the United Kingdom since 2014". However, none of the images are dated, and therefore it is not possible to discern when since 2014 these examples were used or whether they have been used during the relevant period. I have therefore disregarded this exhibit too.

Sales figures

20. In his witness statement, Mr Kudrzyn provides the following sales figures:

Year	Goods	Approx turnover
2014	Leather footwear, textile footwear, wellingtons	£16,550.00
2015	Leather footwear, textile footwear, wellingtons	£20,023.00
2016	Leather footwear, textile footwear, wellingtons	£20,612.00
2017	Leather footwear, textile footwear, wellingtons	£28,650.00
2018	Leather footwear, textile footwear, wellingtons	£23,553.00
2019	Leather footwear, textile footwear, wellingtons	£62.00
2020	Leather footwear, textile footwear, wellingtons	£2,929.00
2021	Leather footwear, textile footwear, wellingtons	£7,948.00
2022	Leather footwear, textile footwear, socks, wellingtons	£21,949.00

2023	Leather footwear, textile footwear, socks, wellingtons	£51,190.00
2024	Leather footwear, textile footwear, socks, wellingtons	£38,623.00

21. Whilst the figure for the year for 2019 appears very low, there is no explanation for this in the witness statement. Mr Kudrzyn does explain that the COVID-19 pandemic caused a decline in the opponent's turnover figures in 2020. However, he highlights that since 2022, the opponent has acquired new customers and launched new product ranges which have increased turnover for the year 2023 onwards. I note that the figures for the years 2022, 2023, and 2024 relate to "leather footwear, textile footwear, socks, and wellingtons". It is my view that socks would ordinarily be described by the average consumer as clothing items, and are not included in the category of footwear. The Cambridge Dictionary defines 'footwear' as "shoes, boots, or any other outer covering for the human foot", whereas 'socks' are defined as "a piece of clothing made from soft material that covers your foot and the lower part of your leg". I am therefore of the view that socks are not footwear. The witness statement does not specify which proportion of the sales in 2022, 2023, and 2024 relate to socks and which proportion relate to footwear. In *Peter Kertels v W Sternoff LLC,*[3] Phillip Johnson sitting as the Appointed Person found the following:

> "26. Where global sales figures are provided for multiple goods sold under one trade mark this is not going to be evidence of use for any of those goods. The sales could all be in relation to good A or all in relation to good B or a split between the two. This is why particularisation is so important as without it the figures provide no evidence of use for either good A or good B. The same applies where the same good is sold under trade mark A and trade mark B.
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> 27. Evidence of sales is only useful for establishing genuine use where it sets out the sales revenue for a particular and identified good (or service) and it is clear that that good or service is sold under the trade mark. Only where there

[3] (O/385/25)

is only one good being sold and it is sold under only one trade mark can global figures be sufficient."

22. As the sales figures for the years 2022, 2023, and 2024 include socks (which are clothes, not footwear), I am unable to take into account the sales figures for these years. Moreover, the witness statement states that the figures are the "value of sales….in the United Kingdom". As stated previously, the relevant territory is the EU for the period up to 31 December 2020. However, I remind myself that sales in one Member State may be sufficient for showing use during the period in which the EU is the relevant territory. In *Leno Merken BV v Hagelkruis Beheer BV*[4], the Court of Justice of the European Union ("CJEU") noted that:

> "36. It should, however, be observed that … the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase 'in the Community' is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.
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> …
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> 50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as 'genuine use', it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national mark.
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> …

[4] Case C-149/11

…

55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A de minimis rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)."

23. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*[5], Arnold J (as he then was) reviewed the case law since Leno and concluded as follows:

"228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in Leno are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issue in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that

[5] [2016] EWHC 52

the applicant's argument is not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that 'genuine use in the Community will in general require use in more than one Member State' but 'an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State'. On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.

24. The General Court ("GC") restated its interpretation of *Leno* in *TVR Automotive Ltd v OHIM*[6] (see paragraph 57 of that judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark ("EUTM")). Consequently, in trade mark opposition and cancellation proceedings the Registrar continues to entertain the possibility 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. This applies even where there are no special factors, such as the market for the goods and/or services being limited to that area of the Union. Mr Kudrzyn has not provided any sales figures, marketing

[6] Case T-398/13

expenditure, or other information relating to outside the UK. The UK was part of the EU until IP completion day, and it is my view that the volume of sales for the year 2020 (albeit limited, although I accept Mr Kudryn's explanation that the Covid-19 pandemic affected sales), taken with the rest of the evidence, is enough to show that use was made of the mark to create or maintain a share of the market for the goods. I have therefore taken into account the UK sales figures for the year 2020 (in which the EU was the relevant territory), as well as 2021 (in which the UK was the relevant territory).

25. These sales figures are supported by Exhibit CK3, which shows invoices sent to UK customers between 2014 and 2024. I have only taken into account the invoices which are dated within the relevant period. Whilst some of the invoice is written in Polish, they also state that "all shoes are upper leather, rubber sole unisex children's shoes". Whilst limited in number, the invoices within the relevant period demonstrate sales made to businesses based across the UK, such as Peterborough, Great Dunmow, Manchester, and London.

Advertising activities

26. In his witness statement, Mr Kudrzyn states that the opponent spends money on advertising but is unable to provide marketing expenditure figures for the UK on the basis that it is not specifically aimed solely at the UK. He states that the opponent undertakes a range of advertising, including using Google Adwords "extensively since 2022", but does not provide any specific examples of this activity or any other data in relation to it.

27. Pages 5 to 9 of Exhibit CK6 show screenshots of social media posts which were made between the years 2020 to 2023. Some of the text on the screenshot is written in what I believe to be Polish, although the post caption itself is written in English, so they appear to be aimed at the English-speaking market. However, it is not clear as to how many consumers have been exposed to these posts within the EU up to 31 December 2020 and the UK thereafter. Furthermore, Mr Kudrzyn also states that the opponent has 29,500 followers on Instagram and 41,000 followers on Facebook, and that the opponent's YouTube video has been viewed by more than 26,000 people. Whilst I recognise that some of these followers and viewers might be based in the UK

(or the EU prior to 31 December 2020), there is nothing in the exhibits or witness statement which gives any further information.

Forms of the mark

28. In the invoices, the opponent uses the mark in the following manner:

29. In *Hyphen GmbH v EU IPO*[7], the GC held the following:

> "28. ..a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see judgment of 10 June 2010, ATLAS TRANSPORT, T 482/08, not published, EU:T:2010:229, paragraph 31 and the case-law cited; judgments of 5 December 2013, Maestro de Oliva, T 4/12, not published, EU:T:2013:628, paragraph 24, and 12 March 2014, Borrajo Canelo v OHIM — Tecnoazúcar (PALMA MULATA), T 381/12, not published, EU:T:2014:119, paragraph 30).
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> 29. For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true (judgment of 24 September 2015, Klement v OHIM — Bullerjan (Form of an oven), T 317/14, not published, EU:T:2015:689, paragraph 33).
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> 30. It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of

[7] Case T-146/15

those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole (judgment of 21 January 2015, Sabores de Navarra v OHIM — Frutas Solano (KIT, EL SABOR DE NAVARRA), T 46/13, not published, EU:T:2015:39, paragraph 37 and the case-law cited).

31. It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character (judgment of 21 June 2012, Fruit of the Loom v OHIM — Blueshore Management (FRUIT), T 514/10, not published, EU:T:2012:316, paragraph 38).

32. It is in the light of those considerations that it must be determined whether the Board of Appeal was correct in finding, in paragraph 9 of the contested decision, that it had not been proven that the European Union trade mark rights had been used in a manner so as to preserve them either in the form registered or in any other form that constituted an allowable difference in accordance with the second subparagraph of Article 15(1)(a) of Regulation No 207/2009."

30. As *Hyphen GmbH v EU IPO* demonstrates, the relative distinctiveness of the registered mark and the components added to or omitted from it in use are relevant factors to take into account in the required assessment. I am of the view that the distinctiveness of the mark lies primarily in the word "emel". In his submissions, the applicant states that "the term EMEL is not of English origin", which is consistent with my own understanding of the word. It is therefore my view that the average consumer will interpret the word "emel" as an invented word with no meaning, and as such, it carries a high level of distinctiveness. It is my view that the rocking horse device is allusive of goods marketed at children on the basis that a rocking horse is a traditional children's plaything. Due to this factor, as well as the principle that the eye is naturally drawn to elements of marks which can be read[8], and also the larger size of the text compared to the figurative device, it is considered that the distinctive character is

[8] See paragraph 37 of *Wassen International Ltd v OHIM (SELENIUM-ACE)* Case T-312/03

primarily vested in the highly distinctive word “emel”. Given the device’s allusive connection to goods which are aimed at children and that it may be viewed as decorative in nature when used on children’s footwear, it is my view that removing the device from the mark does not alter the distinctive character. I therefore find that the variant of the mark which contains the word “emel” in the stylised typeface is an acceptable variant of the registered mark.

Sufficient use

31. The evidence has its limitations. As stated previously, there are a number of pieces of evidence which predate the relevant period. In addition to this, there are also no details in relation to the size of the relevant market or the share of that market held by goods bearing the opponent’s mark. There are no details on the amount spent on advertising, and it is not clear how many consumers in the relevant territories have been exposed to the social media marketing activities.

32. However, an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole.[9] The evidence establishes that sales were made during the relevant period to a number of different customers across the UK. In addition to this, whilst there is no indication of market share, the turnover figures provided by Mr Kudrzyn show that just under £14,000 was generated through the sale of goods bearing the opponent’s mark in the UK in 2020-2021. These sales figures are supported by the invoices, which show sales to a number of different business customers across the UK during the years 2020 to 2024. Whilst limited in number, these documents show dated evidence that the sales were geographically widespread in the UK territory. On the face of it, the figures provided seem very modest in the context of the UK market for *footwear for children*, which I understand to be relatively large. However, these appear to be the prices paid by the retailers rather than the consumers, and therefore would be lower than the standard retail price. Moreover, I accept Mr Kudrzyn’s explanation that the COVID-19 pandemic caused a decline in the opponent’s turnover figures around this time, which affected the opponent’s ability to trade during this time. As the authorities cited above show, use does not need to be quantitatively significant for it to be considered genuine. Taking the evidential picture

[9] *New Yorker SHK Jeans GmbH & Co. KG v OHIM,* Case T-415/09

as a whole, i.e. the turnover figures and the invoices which demonstrate sales made in the UK in the relevant period, I am satisfied that there has been genuine use of the opponent's mark.

Fair specification

33. In determining a fair specification for the opponent's marks, I consider *Merck KGaA v Merck Sharp & Dohme Corp & Ors*[10] in which the Court of Appeal set out the proper approach 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

[10] [2017] EWCA Civ 1834

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."

34. This approach was approved by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)*[11], subject to the proviso that it must be seen in light of more recent guidance by the CJEU that that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use (for example, *Ferrari SpA v DU*[12], at paragraphs 36-53).

35. The sales figures which I am able to take into account demonstrate that the opponent sold "Leather footwear, textile footwear, wellingtons" bearing the opponent's mark within the relevant period. As previously stated, the invoices state that "all shoes are upper leather, rubber sole unisex children's shoes". I am unable to determine any independent sub-categories within the broader terms. For the purposes of the opposition, I therefore find that the opponent may rely on *footwear for children* at large.

Section 5(2)(b)

36. Section 5(2)(b) of the Act is as follows:

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

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

[11] [2024] UKSC 36
[12] (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106

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

37. Section 5A states: […] "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."

38. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P. The summary was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor* [2025] UKSC 25.

The principles

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods

39. In *Canon*[13], the CJEU stated, at paragraph 23 of its judgment, that when considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. The CJEU stated that those factors include their nature, intended purpose, method of use and whether they are in competition with each other or are complementary.

[13] Case C-39/97

40. The relevant factors identified by Jacob J. (as he then was) in the *Treat*[14] case, for assessing similarity were

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

41. In *Kurt Hesse v OHIM*[15]*,* the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods and services. In *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*[16], the GC stated that "complementary" means:

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

42. In *Gérard Meric v OHIM*[17], the GC confirmed that even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

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[14] [1996] R.P.C. 281
[15] Case C-50/15 P
[16] Case T-325/06
[17] Case T- 133/05

> "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."

43. The goods to be compared as follows:

The opponent's goods	The applicant's goods
Class 25: Headgear; Sportswear; Athletic clothing; Clothing for sports.	*Class 25: Footwear for children*.

44. In its statement of grounds, the opponent submits that the parties' goods are similar due to the fact that they are sold or supplied via the same distribution channels. In its submissions in lieu, the applicant argues that the opponent's goods are not similar to applicant's goods as they "differ in nature, intended purpose, usage, and target market". Furthermore, the applicant also argues that the opponent "has not sought protection for clothing or footwear as a whole and has only sought protection for a precise section of the footwear market", and that therefore the goods are distinct from each other.

45. In so far as the applicant's claim that the opponent's *footwear for children* are distinct from items relating to sport is concerned, as per the CJEU judgment in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*[18] (particularly paragraph 66), it is necessary to consider all the circumstances in which the opponent's mark might be used. Whilst I accept that the opponent's term specifies "for children", it is my view that this includes all types of footwear for children including sports shoes. As a result, even though the applicant has suggested that the opponent's protection only covers "a precise section of the footwear market", my assessment must take into account only the opponent's mark and any potential conflict with the applicant's mark. Any differences between the actual goods provided by the parties, are not relevant unless those differences are apparent from the competing marks and

[18] Case C-533/06

their specifications. Moreover, as stated previously, the fair specification of the opponent's goods based on the opponent's evidence of use was deemed to cover footwear for children at large, as the opponent has demonstrated the use of the mark (or acceptable variations thereof) on different types of children's footwear. No independent subcategories could be identified. I therefore disagree with the applicant that the term *footwear for children* does not include sports shoes, albeit aimed at a younger market than sports footwear at large.

46. For the purposes of comparing goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.[19] I have therefore assessed the applicant's goods by dividing the terms into groups as per below.

Headgear

47. *Headgear* and *footwear for children* are both physical goods which are worn to cover and protect parts of the body, albeit different parts of the body. Their use and purpose therefore overlap with that of *footwear for children*. The goods' users will broadly overlap as both will be worn by children, although *headgear* will be worn widely by other age groups too. The goods will have the same trade channels, and given the similar use and purpose, they will appear near each other within these retail environments. Where wearable items are coordinated with each other to complete an outfit, they may be viewed as being complementary[20]. I find this to be the case with these goods, as headgear may be coordinated with footwear to complete an outfit. Moreover, as consumers are likely to view the responsibility of producing the goods lies with the same undertaking, I find that there is therefore complementarity between the parties' goods. However, given that they are worn on different parts of the body, I do not find that they are likely to be in competition with each other. Overall, I find a medium degree of similarity between the goods.

Sportswear; athletic clothing; clothing for sports

[19] *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38
[20] For example, para 45 of *Gitana SA, v OHIM,* Case T-569/11

48. These goods are also physical goods which are worn to cover parts of the body, though footwear for children is specifically worn on the feet, rather than the rest of the body. However, some clothing items such as socks will also be worn on the feet. The goods' users will broadly overlap as both will be worn by children who play sport, although the applicant's goods will be worn widely by other age groups too, and the opponent's goods will feature non-sporting versions. The goods will have the same trade channels and the overlap in use and nature, and they will appear near each other within these retail environments. Where clothing and other wearable items are coordinated with each other to complete an outfit, they may be viewed as being complementary[21]. I find this to be the case with these goods, as sporting clothing may be coordinated with footwear to complete an outfit. Moreover, as consumers are likely to view the responsibility of producing the goods lies with the same undertaking, I find that there is complementarity between the parties' goods. However, given that they are worn on different parts of the body, I do not find that they are likely to be in competition with each other. Overall, I find a medium degree of similarity between the goods.

Average consumer and the purchasing act

49. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik Meyer*[22].

50. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

> (a) C Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

[21] *Gitana SA, v OHIM,* Case T-569/11, para 45
[22] Case C-342/97

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

51. The average consumer for the goods will be members of the general public. The cost of purchase is likely to vary, and the goods will be purchased on a reasonably frequent basis. Several factors may influence the average consumer when purchasing the goods, such as, inter alia, the type of material, the quality, and the aesthetic appearance. I therefore consider that that the average consumer will pay a medium level of attention when selecting the goods, although this may be slightly higher for trade customers. The goods are likely to be self-selected from shelves within retail

outlets, via online retailers, or in catalogues. In *New Look Limited v OHIM*[23], the GC stated that:

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

52. Visual considerations are therefore likely to be the primary factor when purchasing the goods. However, I do not discount the role that aural selection may play when purchasing, such as through word-of-mouth recommendations or when placing telephone orders.

Comparison of marks

53. 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 *Bimbo SA v OHIM*[24], 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."

54. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks

[23] Joined cases T-117/03 to T-119/03 and T-171/03
[24] Case C-591/12P

and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

55. The respective trade marks are shown below:

The opponent's mark	The applicant's marks
	EMEL emel

56. The opponent has not specifically commented on the marks' overall impressions. In its submissions in lieu, the applicant argues that the rocking horse device in the opponent's mark "plays a critical role as a visual indicator – arguably serving as the primary and most distinctive feature of the opponent's mark" and that the device is the "dominant and memorable visual cue recognised by consumers".

57. The opponent's mark is a composite mark which contains the word "emel". As stated previously, the average consumer is likely to interpret the word "emel" as an invented word with no meaning. As such, it carries a high level of distinctiveness. The rocking horse device is less distinctive as it is allusive of goods which are aimed at children. Due to both the principle that the eye is naturally drawn to elements of marks which can be read[25] as well as the larger size of the text compared to the figurative device, I am of the view that the word "emel" is more dominant in the overall impression of the opponent's mark. The rocking horse device plays a role within the mark's overall impression, but to a lesser degree. The colour red and the stylisation of the text also play a role, but to a much lesser degree.

[25] See paragraph 37 of *Wassen International Ltd v OHIM (SELENIUM-ACE)* Case T-312/03

58. The applicant's marks are both plain word marks. The first is written in upper case and the second is written in lower case. As word-only marks with no other elements, the marks' overall impressions lie in the words "EMEL"/"emel".

My approach

59. As the applicant's marks only differ as to the type of case, for ease of reference, I will focus my assessment on the mark "emel" in the series of two. However, for the avoidance of doubt, the same findings will also apply to the opponent's other mark "EMEL". This is because word marks are protected regardless of the case type, as shown in *LA Superquimica v European Union Intellectual Property Office (EUIPO)*[26], in which the GC held at [39] that word-only marks protect the word or words contained in the mark in whatever case, colour or typeface. The difference in capitalisation between "EMEL" and "emel" is therefore not significant. I will therefore continue to refer only to the opponent's mark "emel".

Visual comparison

60. In its statement of grounds, the opponent argues that the competing marks are very similar. In its submissions in lieu, the applicant argues that "the inclusion of the orange rocking horse introduces a striking point of differentiation between the two marks".

61. The competing marks are visually similar to each other as they both contain the word "emel". The marks differ as the opponent's mark also contains the rocking horse device which is not present in the applicant's mark. Although the colour red and the stylised typeface play lesser roles in the mark's overall impression, the use of them still represents a point of visual difference between the marks. Bearing in mind my analysis of the marks' overall impressions, I am of the view that the marks are visually similar to a medium degree.

Aural comparison

62. In its statement of grounds, the opponent argues that the marks are phonetically "very similar". In its submissions in lieu, the applicant argues that the marks are

[26] Case T-24/17

“assumed to be pronounced identically”. However, it also submits that “emel” is “is not of English origin and may therefore be pronounced differently depending on linguistic context, altering the aural similarity between the marks”.

63. It is my view that a significant majority of consumers in the UK will pronounce the word “emel” as “eh-mel” or “ee-mel”. Whilst I note the applicant’s arguments that the word may be pronounced differently depending on the linguistic context of use (and therefore affect the marks’ aural similarity), there is no evidence filed to suggest why UK consumers would pronounce “emel” differently in each mark. I am therefore of the view that the marks will be pronounced identically by consumers. However, whilst it is my view that the competing marks are therefore aurally identical, I note that the opponent has only pleaded that the marks are aurally similar, rather than aurally identical. On this basis, given the scope of the opponent’s pleaded case, I will proceed on the basis that the marks are aurally similar to a very high degree instead.

Conceptual comparison

64. In its statement of grounds, the opponent argues that the competing marks are conceptually very similar. In its submissions in lieu, the applicant argues that the word “emel” does not convey a specific meaning, and that the inclusion of the rocking horse device suggests a conceptual link to children’s products.

65. The competing marks are similar as they both contain the word “emel”. As stated previously, it is my view that the average consumer will interpret the word “emel” in both marks as a neologism. On this basis, the word within both marks is conceptually neutral.

66. The marks differ conceptually due to the inclusion of the red rocking horse device which is present in the opponent’s mark but does not feature within the applicant’s mark. Insofar as the marks convey any concept, they are dissimilar due to the inclusion of the rocking horse device. However, given that this device is allusive of goods aimed at children and is therefore lower in distinctiveness, it is my view that it is not a significant conceptual dissimilarity.

Distinctive character of the earlier trade mark

67. In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV*[27], 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)."

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

69. Although the opponent has filed evidence of use, I do not consider this evidence to be sufficient for the purposes of demonstrating that the opponent's mark had an enhanced degree of distinctive character at the relevant date of 7 April 2024. Whilst I acknowledge that the evidence demonstrates genuine use of the opponent's mark and sales of goods bearing the mark in the UK, it is considered that the evidence does not show what share of the relevant market was held by goods sold under the opponent's

[27] Case C-342/97

mark. Whilst the evidence contains sales figures for 2014 to 2024, I am unable to ascertain how significant those sales were. On the face of it, the sales figures are likely to only represent a very small proportion of the relevant UK markets. Furthermore, although the evidence contains screenshots to show posts made on social media and the witness statement, it is my view that this is not sufficient to demonstrate the extent to which the average consumer of the goods within the UK has been exposed to these social media marketing posts. In addition to this, Mr Kudrzyn is unable to provide any figures for the opponent's expenditure in relation to advertising in the UK. Taking all of these factors into account, it is my view that the evidence submitted does not support the establishment of enhanced distinctiveness. I therefore only have the inherent position to consider.

70. The opponent's mark contains the word "emel" and the red rocking horse device. As stated earlier, the word "emel" within the mark will be interpreted by the average consumer as a neologism, and as such, carries a high level of inherent distinctiveness. The rocking horse device is lower in distinctiveness on the basis that it is allusive of goods aimed at children. Taking the opponent's mark in totality, it is considered that it is inherently distinctive to a high degree.

Global assessment – conclusions on likelihood of confusion

71. 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 down to the responsible undertakings being the same or related. There is no set formula for establishing a likelihood of confusion between marks; it is a global assessment where a number of factors need to be borne in mind.

72. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and services, and the nature of the purchasing process. In doing so, I must be mindful 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.

73. In its statement of grounds, the opponent argues that there is “a genuine and real risk of confusion and/or association” between the competing marks. In its submissions in lieu, the applicant argues that “by reason of the negligible level of similarity between the goods… it is clear that there will be no confusion between consumers”.

74. Earlier in this decision I found that the applicant’s goods are similar to a medium degree to the opponent’s goods. The average consumer will be a member of the general public. The average consumer will pay a medium degree of attention when purchasing the goods. The goods will primarily be selected through visual means, although I do not discount an aural element to the selection process. I have found the marks to be visually similar to a medium degree, aurally similar to a very high degree (in line with the opponent’s pleadings), and, insofar as the marks convey any concept, they are conceptually dissimilar. In the opponent’s mark, the word “emel” is the distinctive and dominant element, with the rocking horse device (which is allusive of the goods aimed at children) playing a lesser role in the mark’s overall impression, and the use of colour and stylised typeface playing even smaller roles too. The overall impression of the applicant’s mark lies exclusively in the word “emel”. The average consumer is likely to understand as a neologism coined by the opponent, and therefore the opponent’s mark has a high level of inherent distinctiveness in totality due to the high level of distinctiveness of the word “emel”.

75. Whilst I have found that the allusive rocking horse device is lower in distinctiveness and therefore plays a lesser role in the mark’s overall impression, it is not negligible either. It is my view that it is unlikely that the average consumer, when paying a medium degree of attention, will completely overlook the differences between the marks, notwithstanding the allusive nature of the figurative device in relation to the goods. These differences are therefore likely to be sufficient to prevent the average consumer from mistaking one mark for the other. I therefore find that there is no likelihood of direct confusion.

76. I will now go on to consider indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*[28], Mr Iain Purvis Q.C., as the Appointed Person, explained that

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

[28] BL O/375/10

77. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*[29], Arnold LJ approved Mr Purvis's formulation but added:

> "13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

78. It is not sufficient that a mark merely calls to mind another mark (as per *Duebros Limited v Heirler Cenovis GmbH*[30]). This is mere association not indirect confusion. A finding of indirect confusion should not be made merely due to a shared element within marks. As per *L.A. Sugar Limited v By Back Beat Inc*[31] (set out above), indirect confusion should be identified in cases where the average consumer is likely to notice the differences between the competing marks but assume an economic link between the two undertakings based on their similarities.

79. It is my view that, even if consumers recognise the inclusion of the rocking horse device, the colour red, and the stylised typeface within the opponent's mark, these elements appear consistent with a brand variant or brand extension. The word "emel" dominates the overall impression of the opponent's mark and is highly distinctive. I am of the view that consumers are likely to view the additions of the device, the use of the colour red, and the stylised typeface within the opponent's mark as being a variation of the house mark "emel". Consumers may therefore view the differences between marks as a brand variant or brand extension of the house mark "emel", and may therefore assume a commercial association between the parties. Furthermore, I am of the view that the word "emel" is strikingly distinctive to the extent that the average consumer would assume that only the opponent is using it in a trade mark, as per the first category of instances identified in *LA Sugar.* Consequently, I find that there exists

[29] [2021] EWCA Civ 1207
[30] BL O/547/17
[31] BL O/375/10

the likelihood of indirect confusion. I find this even though the goods are similar to a medium degree due to the interdependency principle and the identical nature of the shared distinctive element.

Final remarks

80. The opposition under section 5(2)(b) has been successful in its entirety. Subject to any successful appeal, the application will be refused registration.

Costs

81. The opponent has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances I award the applicant the sum of £1,250 as a contribution towards the cost of the proceedings. The sum is calculated as follows

Official fees: £100

Preparing a statement: £250

Preparing evidence £700

Preparing submissions in lieu: £200

82. I recognise that the opponent would have spent time reviewing the applicant's submissions in lieu. However, the opponent's own submissions in lieu were very limited and not particularly lengthy. As such, I have awarded a figure below scale for this activity.

83. I therefore order EMEL SPORT LTD to pay EMEL" s.c. Beata Kudrzyn, Cezary Kudrzyn the sum of £1,250. 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 25th day of February 2026

K SERRAVALLE

For the Registrar