O/0189/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004003723
BY UMAR & SONS TRADING CO. LTD
TO REGISTER:

AS A TRADE MARK IN CLASSES 7, 9 AND 12

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 447903
BY WIGGLE LIMITED

BACKGROUND AND PLEADINGS

1. On 18 January 2024, UMAR & SONS TRADING CO. LTD ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 08 March 2024 in respect of the following goods:

> **Class 7:** *Carburetors [vehicle parts]; Cam covers [vehicle parts]; Engine cases [vehicle parts]; Mechanical engine parts for land vehicles; Power valve for carburetors [vehicle parts]; Filters being parts of motors; Joints [parts of engines]; Sumps being parts of vehicle gearboxes [other than land vehicle]; Cranks [parts of water vehicles]; Push rods [vehicle engine parts]; Bushes being parts of motors; Axles [machine parts]; Rocker arms [vehicle engine parts]; Cast iron parts for pipes [parts of machines]; Cranks [parts of air vehicles]; Regulators being machine parts; Regulators as machine parts; Cylinder covers [parts of machines]; Housings [parts of machines]; Bushings for use as parts of machines; Bushings [parts of machines]; Bushings being parts of machines; Oil coolers [vehicle engine parts]; Oil tanks [vehicle engine parts]; Valve assemblies of metal [parts of machines]; Springs [parts of machines]; Springs being parts of machines; Cams being parts of machines; Dampers [parts of machines]; Bushes being parts of engines; Regulators [parts of machines]; Regulators being parts of machines; Intake manifolds [vehicle parts]; Filters being parts of engines; Hoods [machine parts]; Stop valves of metal [parts of machines]; Brushes being parts of motors; Cowlings [parts of machines].*
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> **Class 9:** *Computer components and parts; Component parts for aerials.*
>
> **Class 12:** *Bodywork parts for vehicles; Structural parts for automobiles; Bearings [parts of vehicles]; Windshields [land vehicle parts]; Interior trim parts of automobiles; Parts and fittings for vehicles; Transmissions [land vehicle parts]; Clips adapted for fastening automobile parts to automobile bodies; Structural parts for motorcycles; Fenders [land vehicle parts]; Windshield wipers [vehicle parts]; Headlight mounts [parts of motorcycles]; Brakes [bicycle parts]; Bicycle structural parts; Axles [land vehicle parts]; Structural parts for*

trucks; Windshield visors [vehicle parts]; Sumps being parts of land vehicle gearboxes; Struts (Non-metallic -) parts of vehicles; Differentials [land vehicle parts]; Drive gears [land vehicle parts]; Automobiles and structural parts therefor; Tire chains [land vehicle parts]; Reservoirs (metal -) [parts of vehicles]; Car body modification parts for sale in kit form; Wheels [land vehicle parts]; Sprockets [bicycle parts]; Cranks [parts of land vehicles]; Brake cables [parts of motorcycles]; Idler arms [vehicle parts]; Chains [bicycle parts]; Brake calipers [parts of motorcycles]; Parts and fittings for land vehicles; Clutch cables [parts of motorcycles]; Suspension struts [vehicle parts]; Ball joints [vehicle parts]; Consoles being parts of vehicle interiors; Carriage body parts; Brake pedals [parts of motorcycles]; Rearview mirrors [vehicle parts]; Structural parts for vans; Front spacers [parts of motorcycles]; Brake rotors [parts of motorcycles]; Parts and fittings for water vehicles; Steering wheels [vehicle parts]; Hood shields as structural parts of vehicles; Towing tractors, and structural parts therefor; Structural parts of bicycles; Drive belts [land vehicle parts]; Seat posts [parts of vehicles]; Change-speed gears [bicycle parts]; Seat pillars [parts of vehicles].

2. On 10 June 2024, the application was partially opposed by Wiggle Limited ("the opponent") based upon Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act").

3. Under both the Section 5(2)(b) and the Section 5(3) ground, the opposition is directed against the applied-for goods in class 12 with the opponent relying on (and claiming reputation for) its registered goods in class 12 of the following trade marks:

UK00003638961 ("the first earlier mark or word-only mark") PRIME Filing date: 10 May 2021 Registration date: 08 October 2021 **Class 12:** *Vehicles; apparatus for locomotion by land, water and air; bicycles; and parts fittings and accessories for all the aforesaid goods; frames, saddles, wheels,*

tyres, inner tubes, spokes, brakes, gears, shock absorbers, chains, chain guards, handlebars, twist grips, luggage carriers, bells, bags, direction signals and stands, valves, handle bar stems, handlebar tapes, handlebar grips, seatposts, power meters all of the aforesaid being for bicycles; structural parts of bicycles; fittings for bicycles for carrying luggage; fittings for bicycles for carrying beverages; fittings for bicycles for carrying computers; anti-theft alarms for vehicles; anti-theft, security and safety devices and equipment for vehicles.
UK00913183751 ("the second earlier mark or figurative mark")[1] Filing date: 19 August 2014 Registration date: 12 January 2015 **Class 12:** *Vehicles; apparatus for locomotion by land, water and air; bicycles; and parts fittings and accessories for all the aforesaid goods; frames, saddles, wheels, tyres, inner tubes, spokes, brakes, gears, shock absorbers, chains, chain guards, handlebars, twist grips, luggage carriers, bells, bags, direction signals and stands, all of the aforesaid being for bicycles; structural parts of bicycles; fittings for bicycles for carrying luggage; fittings for bicycles for carrying beverages; anti-theft alarms for vehicles; anti-theft, security and safety devices and equipment for vehicles.*

4. By virtue of their earlier filing dates, the trade marks relied upon by the opponent are "earlier marks" in accordance with Section 6 of the Act. Only the second earlier mark had been registered for more than five years at the filing date of the contested mark, and, as such, is theoretically subject to the use conditions under Section 6A of the Act. However, in its counterstatement, the applicant elected not to put the opponent to proof of use - this means that the opponent can rely upon all of the goods it has identified without having to prove genuine use.

[1] Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent's earlier mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

5. Under Section 5(2)(b), the opponent claims there is a likelihood of confusion because the goods are identical or highly similar, and the marks are highly similar. In particular, the opponent states that the dominant and distinctive element of the application is the shared element 'PRIME' and that the average consumer will place very little trade mark value on the distinguishing element 'PARTS' in the application due to its descriptive nature.

6. Under Section 5(3), the opponent claims that its earlier marks enjoy a reputation in relation to all of the goods identified above. In particular, the opponent states that it has been operating as a retailer of cycling products since at least 1999, and over the years has invested a large sum of money in promoting and advertising its business. Further, the opponent states that use of the applicant's mark will take unfair advantage of, or being detrimental to, the distinctive character or the repute of the opponent's earlier marks.

7. The applicant filed a defence and counterstatement, denying the opponent's claims. In particular, the applicant states that the font and logo in the respective marks are totally different and that the word 'PRIME' is very common. Nothing further was filed by the applicant.

8. The opponent is represented by Abion UK Limited, and the applicant is not professionally represented.

9. Only the opponent filed evidence. Neither party requested a hearing, but the opponent filed submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

Relevance of EU Law

10. 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

11. The opponent's evidence came in the form of a witness statement from Daniel Meenan dated 9 September 2024. Mr Meenan is the director of the opponent's company,[2] and his witness statement is accompanied by 17 exhibits (being those labelled DM1-DM17). Mr Meenan's evidence is aimed at showing use of the earlier mark by the opponent in order to support the claim based on reputation.

12. I do not intend to summarise the evidence (or submissions) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Section 5(2)(b)

13. Section 5(2)(b) of the Act reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a) …
> (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."

[2] Daniel Meenan says that he is a director of Brands Holdings Limited but then he refers to the opponent Wiggle Limited as his company.

14. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25:

> (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, in certain circumstances, be dominated by one or more of its components;
>
> (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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; and
(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

15. In *Gérard Meric v Office for Harmonisation in the Internal Market,* 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 fur 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."

16. The contested goods in class 12 include vehicles as well as parts, fittings and accessories for vehicles and bicycles, and are as follows:

Class 12: *Bodywork parts for vehicles; Structural parts for automobiles; Bearings [parts of vehicles]; Windshields [land vehicle parts]; Interior trim parts of automobiles; Parts and fittings for vehicles; Transmissions [land vehicle*

parts]; Clips adapted for fastening automobile parts to automobile bodies; Structural parts for motorcycles; Fenders [land vehicle parts]; Windshield wipers [vehicle parts]; Headlight mounts [parts of motorcycles]; Brakes [bicycle parts]; Bicycle structural parts; Axles [land vehicle parts]; Structural parts for trucks; Windshield visors [vehicle parts]; Sumps being parts of land vehicle gearboxes; Struts (Non-metallic -) parts of vehicles; Differentials [land vehicle parts]; Drive gears [land vehicle parts]; Automobiles and structural parts therefor; Tire chains [land vehicle parts]; Reservoirs (metal -) [parts of vehicles]; Car body modification parts for sale in kit form; Wheels [land vehicle parts]; Sprockets [bicycle parts]; Cranks [parts of land vehicles]; Brake cables [parts of motorcycles]; Idler arms [vehicle parts]; Chains [bicycle parts]; Brake calipers [parts of motorcycles]; Parts and fittings for land vehicles; Clutch cables [parts of motorcycles]; Suspension struts [vehicle parts]; Ball joints [vehicle parts]; Consoles being parts of vehicle interiors; Carriage body parts; Brake pedals [parts of motorcycles]; Rearview mirrors [vehicle parts]; Structural parts for vans; Front spacers [parts of motorcycles]; Brake rotors [parts of motorcycles]; Parts and fittings for water vehicles; Steering wheels [vehicle parts]; Hood shields as structural parts of vehicles; Towing tractors, and structural parts therefor; Structural parts of bicycles; Drive belts [land vehicle parts]; Seat posts [parts of vehicles]; Change-speed gears [bicycle parts]; Seat pillars [parts of vehicles].

17. The specification of the earlier marks are more or less the same, the only difference being that the specification of the first earlier mark contains some additional terms (i.e. *valves, handle bar stems, handlebar tapes, handlebar grips, seatposts, power meters*). However, this is not going to make any difference in this case, because both specifications contain the terms *Vehicles; bicycles; and parts fittings and accessories for all the aforesaid goods* which are sufficiently broad to encompass of all of the contested goods in class 12. Accordingly, the competing goods are all identical on the principle outlined in *Meric.*

Average consumer

18. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

19. In *Iconix Luxembourg Holdings SARL v Dream Paris 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) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
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> (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.

20. The average consumer of the goods at issue will be a member of general public, or a professional in the vehicle industry, including garages, repairers and specialist suppliers.

21. The goods are likely to be selected from authorised car dealers, from sellers of vehicles and bicycles or from retail websites. The average consumer will encounter the marks on some of the goods themselves – such as cars and other vehicles and bicycles. For all the goods at issue the average consumer will also encounter the marks in advertising or promotional materials. Consequently, visual considerations will dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants.

22. Some of the contested goods (i.e. automobiles and tractors) entail considerable cost and will be carefully considered purchases, made infrequently, with a high degree of attention. However, most of the goods at issue are fitting, accessories and parts for vehicles and bicycles which, although not particularly expensive, will still entail a medium level of care to ensure compatibility.

Comparison of marks

23. 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."

24. 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. The respective marks are shown below:

The applied-for mark	**The opponent's earlier mark**
	PRIME 

Overall impression

25. The applied-for mark is a figurative mark consisting of the word 'PRIME' presented in black, in large and bold capital letters, and in a slightly stylised oblique typeface. This element of the mark is positioned centrally and is placed above the word 'PARTS' presented in the same font but in a smaller size. These words are presented against a figurative element depicting a stylised toothed wheel (which the opponent describes as a gear) with the bottom half in black (underneath the letters), and the top half in yellow (above the letters). I agree with the opponent that the word 'PRIME' is the dominant and most distinctive element of the mark as both the word 'PARTS' and the figurative element are wholly descriptive of the goods at issue, which are vehicles and

parts of vehicles and bicycles Admittedly, the word ‘PRIME’ is used to describes *“something that is of the best possible quality”* (Collins online dictionary) however, the word ‘PRIME’ has also several other meanings such as that of *“a number that cannot be divided by any other number except itself and the number 1”*, or *“the period in your life when you are most active or successful”* (in your prime) and of *“something that is most important in a situation”* (i.e. prime concern). In the context of the mark and the goods at issue, I therefore consider that whilst the word ‘PRIME’ may have a laudatory connotation, it is not so direct to make it descriptive, and it is still more distinctive than the other elements of the mark and contributes to the overall impression to a greater degree.

26. The opponent’s first earlier mark consists of the single word ‘PRIME’. As there are no other elements to contribute to the overall impression, it resides in the word itself.

27. The second earlier mark consists of the word ‘PRIME’ which is presented in a stylised oblique typeface, in larger low-case letters and is placed above the word ‘COMPONENTS’ which is presented in capital letters but in a smaller size. Although the first and last letter of the word ‘PRIME’ are more stylised, the stylisation does not prevent the word from being perceived as a form of ‘PRIME’; I am fortified in this conclusion by the fact that the mark has been taken to be such by the UKIPO in the registration classification process which shows the “mark text” as ‘PRIME COMPONENTS’. Further, in its counterstatement the applicant admits that the opponent’s earlier mark consists of the words ‘PRIME COMPONENTS’. As the word ‘COMPONENTS’ is descriptive of the goods at issues, which are vehicles, bicycles and components of vehicles and bicycles, and the stylisation is not striking, I consider that the dominant and most distinctive element of this mark is the word ‘PRIME’.

Visual similarity

The applicant’s mark and the opponent’s word mark

28. These marks coincide in the presence of the identical word ‘PRIME’, which is the only element of the opponent’s word mark and the dominant and distinctive element of the applied-for mark. Although the marks differ in the presence of the word ‘PARTS’

and the stylisation in the applied-for mark (which have no counterpart in the opponent's mark), I found these elements to be descriptive or weakly distinctive and to play a lesser role in the overall impression. I consider these marks to be similar to a medium to high degree.

The applicant's mark and the opponent's figurative mark

29. Admittedly, there are additional differences between the applicant's mark and the opponent's figurative mark, namely the stylisation of the word 'PRIME' and the presence of the word 'COMPONENTS' in the opponent's mark. However, the fact that the fonts used in both marks are oblique also contributes to create a similar overall impression. Further, I found the word 'COMPONENTS' to be descriptive and to play a lesser role in the overall impression. I consider these marks to be similar to a medium degree.

Aural similarity

30. If the descriptive verbal elements of the marks (i.e. the words 'PARTS' in the application and the word 'COMPONENTS' in the opponent's figurative mark) are omitted when the marks are spoken, the marks are aurally identical. If they are articulated, there is a high degree of similarity with the opponent's word mark, and a medium degree of similarity with the opponent's figurative mark.

Conceptual similarity

31. I have already listed the possible meaning of the word 'PRIME' at paragraph 25; given the identity of the goods at issue, whatever meaning the average consumer will attribute to the identical word 'PRIME', it will be the same across all marks. The marks are conceptually identical, the words 'PARTS' and 'COMPONENTS' in the respective marks being wholly descriptive and conveying no distinctive concept (but if they do convey a concept it is the same, 'parts' and 'components' meaning the same thing in the context of the goods at issue).

Distinctive character of the earlier mark

32. 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 *WindsurfingChiemsee* 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)."

33. 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 or services, to those with high inherent distinctive character, such as invented words, which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

34. The earlier marks consist of the word 'PRIME' and 'PRIME COMPONENTS'. As I have said, whilst one of the meanings of 'PRIME' is laudatory (i.e. *"something that is of the best possible quality*"), the word has several other meanings, and it is not wholly

descriptive. Further, registered marks must be assumed to have a minimum level of distinctiveness to be registrable,[3] and the validity of the opponent's marks is not at issue. Lastly, whilst in its counterstatement the applicant refers to the word 'PRIME' being commonly used in trade marks, no evidence was filed to support such claim; but, in any event, state of the register evidence is of no assistance.[4] Overall, I consider both earlier marks to be distinctive to a low to medium degree.

35. This is the inherent position. In addition, the opponent has filed evidence of use of the earlier marks, which I am going to review in order to establish whether the use made of these marks has enhanced their distinctiveness.

36. Mr Meenan provides a brief history of the opponent from which it can be readily concluded that the opponent's main business is that of retail of bicycles and parts, fittings & accessories for bicycles – this is not the same as the goods upon which the opponent relies in this opposition.

37. Mr Meenan in fact says that the opponent was founded in 1995 and launched in May 1999 and established itself as an online retailer, experiencing remarkable growth: by 2006, the company had achieved £11.8 million in turnover. The opponent subsequently expanded internationally, and by 2011, it was valued at £200 million. In December 2011, it was acquired by Bridgepoint Capital for £180 million, becoming a major player in UK and European online sports retail. In 2016, the opponent merged with Chain Reaction Cycles, creating one of the largest online retailers in cycling and tri-sports. The group continued to grow, acquiring the German competitor Bike 24 in 2017 and launching their 'PRIME' brand of bike components. I pause here for a moment to note the following. First, reputation (and enhanced distinctiveness) must be in goods/services covered by the earlier trade mark registration and in the earlier mark relied upon.[5] In the present case, the only evidence that can be relevant is that relating to the use of the trade mark 'PRIME' in relation to the registered goods being bicycles and bike components. Any reputation associated with the opponent's name Wiggle Limited or its online sports retail business is not relevant here – as such I do

[3] *Formula One Licensing BV v OHIM,* Case C-196/11P
[4] *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01
[5] *Tulliallan Burlington Ltd v EUIPO*, Case T-123/16

not need to reproduce that part of the evidence. The most relevant evidence produced by Mr Meenan in relation to the use of the mark 'PRIME' for the goods concerned is that relating to the sales figures for bicycle parts and accessories sold under the 'PRIME' Marks. However, this evidence is still not particularly helpful because (a) it gives sales figures for a period covering 11 months after the relevant date of 18 January 2024 (i.e. from October 2023 until October 2024) and (b) Mr Meenan does not say that the sales figures (which are said to amount to £4,000,000 in sales) relate specifically to the UK so they may include EU sales, which is plausible given the evidence of the international nature of the opponent's business. Likewise, there is no evidence of marketing spend in the UK as Mr Meenan says that no details of advertising spend were provided during the acquisition process. Lastly, whilst there is some evidence of online coverage and reviews which are UK specific, they are either undated or dated after the relevant date, and in any event cannot overcome the absence of UK specific turnover and marketing spent.

38. Bearing in mind all of the above, the evidence falls way short of demonstrating that the earlier marks have acquired a degree of enhanced distinctiveness through use in the UK.

Likelihood of confusion

39. 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, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

40. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, 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)."

41. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, 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."

42. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

43. Earlier in this decision I found that:

- The applicant's mark and the opponent's earlier marks are visually similar to a medium to high degree or medium degree, aurally identical or similar to a medium or high degree and conceptually identical.

- The parties' goods in class 12 are identical.

- The average consumer will select the goods mainly visually, largely with a medium degree of attention, though some of the contested goods will attract a high degree of attention.

- The earlier marks are inherently distinctive to a low to medium degree. The evidence filed by the opponent is insufficient to establish that the distinctiveness of the earlier marks has been enhanced to any material extent.

44. Admittedly, some of the opponent's goods (i.e. those in class 12) will be selected with a high degree of attention and some of the visual differences between the mark are likely to be retained by the average consumer, including the visual impact of the figurative element in the application. However, whilst that would be sufficient to avoid

direct confusion, it will not prevent indirect confusion. This is because the marks share the dominant and distinctive word 'PRIME' and the differentiating elements of the marks are either wholly descriptive or less distinctive than the shared element.[6] Accordingly, the case at issue I consider that the average consumer who is familiar with the opponent's 'PRIME' marks in seeing the applied-for 'PRIME' mark used on identical goods will assume that is a variant mark used by the opponent.

45. There is a likelihood of indirect confusion in relation to the contested goods in class 12.

Section 5(3)

46. Section 5(3) states:

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

47. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case C-252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

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

[6] BL-O/0368/23 Peninsula Face2Face

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

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

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

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

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

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

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV,* paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

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

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

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

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

49. In *Spirit Energy Limited* v *Spirit Solar Limited* - BL O/034/20 – Mr Phillip Johnson, as the Appointed Person, held that the opponent had not established a qualifying reputation for s.5(3) purposes. The opponent traded in solar energy equipment and installations and had used its mark in relation to such goods/services for 7 years prior to the relevant date in the proceedings. During the 5 years prior to the relevant date, it had installed solar energy generation equipment in over 1000 domestic homes and made over 700 installations for commercial customers. These sales had generated nearly £13m in income. However, there was limited evidence of advertising and promotion, and the amount spent promoting the mark had fallen in the years leading up to the relevant date. Additionally, the mark had only been used in South East England and the Midlands. Taking all the relevant factors into account, the Appointed Person therefore decided that such use of the mark was not sufficient to establish a reputation for the purposes of s.5(3).

50. In *GNAT and Company Ltd & Anor v West Lake East Ltd & Anor* [2022] EWHC 319, HHJ Hacon held that the claimants had not established a qualifying reputation for the purposes of s. 10(3). The claimants had operated a restaurant at the Dorchester Hotel in Park Lane for around four years prior to the relevant date. Turnover was between £5m and £6m each year, which equated to approximately 70,000 customers served per year; advertising spend had varied significantly, from around £5,000 at its lowest to over £47,000. The claimants had provided dining vouchers worth about £17,000 to charities and there had been some press coverage and awards but only 7

such articles appear to have been in evidence. The judge stated that, although it was likely that a spread of individuals across the UK would have read the articles or been made aware of the awards, the claimants' market share was tiny relative to the UK restaurant business as a whole. The advertising sums were also very small in that context and the business was in relation to a single restaurant. The judge concluded that the evidence satisfied the 'geographic' aspect of the test but not the 'economic' one, and that the use was not sufficient to establish that the claimants' mark had a reputation.

51. I have already commented on the evidence above. Whilst enhanced distinctiveness and reputation are not the same things, the same factors are born in mind when assessing them. In the present case, although there is some evidence of the opponent trading under the earlier marks in the UK in relation to the goods concerned, the absence of any UK specific turnover and marketing figures and the absence of any indication of market share means that the evidence fails to establish the fundamental factors for assessing the existence of a reputation in the UK at the relevant date.

52. As the opponent's evidence does not establish the necessary reputation, the claim under Section 5(3) fails at the first hurdle.

OUTCOME

53. The partial opposition has been successful under Section 5(2)(b) and the contested goods in class 12 will be refused registration. However, the application can proceed to registration for the remaining unobjected goods in classes 7 and 9.

COSTS

54. The opponent has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of £1,000 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a notice of opposition and considering the counterstatement: £300
Filing evidence: £500
Official Fees: £200
Total: £1,000

55. I therefore order UMAR & SONS TRADING CO. LTD to pay Wiggle Limited the sum of £1,000. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 5th day of March 2026

TERESA PINTO
For the Registrar