O/0220/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003946569

IN THE NAME OF SLAY REPUBLIC LTD

FOR THE TRADE MARK:

Slay Republic

IN CLASSES 4, 16, 18 AND 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 444777 BY

LOUISE HAZEL LTD

BACKGROUND AND PLEADINGS

1. On 17 August 2023, Slay Republic Ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 20 October 2023 and protection is sought for the following goods:

Class 4 Candles.

Class 16 Stickers; journals.

Class 18 Bags.

Class 25 Clothing.

2. On 18 December 2023, the application was opposed by Louise Hazel Ltd ("the opponent") based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under section 5(2)(b), the opponent relies upon (1) UKTM no. 3351999 which was filed on 8 November 2018 and registered on 29 March 2019 ("the First Earlier Mark"), (2) UKTM no. 3270013 which was filed on 12 November 2017 and registered on 16 February 2018 ("the Second Earlier Mark") and (3) UKTM no. 3581803 which was filed on 20 January 2021 and registered on 17 September 2021 ("the Third Earlier Mark") (together "the earlier marks"). The earlier marks all protect the same sign, which appears as follows:

SLAY

3. The earlier marks are registered for the goods and services set out in the Annex to this decision. Only those goods and services that are underlined are relied upon under this ground. The opponent relies upon the First and Second Earlier Marks to oppose

the goods in classes 16, 18 and 25 of the application. The opponent relies upon the Third Earlier Mark to oppose the goods in class 4 of the application. The opponent claims that the marks are similar, and the goods and services are identical or similar, with the result that there is a likelihood of confusion.

4. Under section 5(4)(a) of the Act, the opponent relies upon the sign **SLAY** which it claims to have used throughout the UK since at least 2018 in relation to "clothing, headgear, bags, sports bags, sports and fitness equipment". The opponent claims that use of the application would be contrary to the law of passing off.

5. The applicant filed a counterstatement denying the grounds of opposition.

6. Neither party requested a hearing and neither filed written submissions in lieu. This decision is taken following a careful consideration of the papers on file.

REPRESENTATION

7. The applicant is represented by Francis McEntegart.

8. The opponent is represented by Anjala Parveen Puthiyedath Ashraf.

EVIDENCE AND SUBMISSIONS

9. The opponent filed evidence in chief in the form of the first witness statement of Louise Hazel dated 5 July 2024, which is accompanied by 8 exhibits (A1 to A8). Ms Hazel is the CEO of the opponent.

10. The applicant filed evidence in the form of the witness statement of Danielle Hunt dated 10 October 2024, which is accompanied by 13 exhibits (DH1 to DH13). Ms Hunt is the Director of the applicant, a position she has held since 2020.

11. The opponent filed evidence in reply in the form of the second witness statement of Louise Hazel dated 20 December 2024, which is accompanied by 4 exhibits (A9 to A12).

12. The opponent's evidence in reply was accompanied by written submissions dated 23 December 2024.

RELEVANCE OF EU LAW

13. 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.

DECISION

Section 5(2)(b)

14. 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."

15. Section 5A of the Act is as follows:

> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only."

16. Given their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the First and Third Earlier Marks had not completed their registration processes more than 5 years prior to the filing date of the application in issue, they are not subject to the use provisions in section 6A of the Act. Whilst the Second Earlier Mark was registered more than 5 years before the filing date of the application, the applicant did not request that the opponent provide proof of use. Consequently, the opponent can rely upon all of the goods and services identified for all of the earlier marks.

17. 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 and services

18. The competing goods and services can be found in paragraph 1 and the Annex to this decision.

19. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

20. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, 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.

21. The applicant has filed evidence regarding the goods actually offered by the parties. However, the assessment that I must undertake is a notional one based upon

the parties' respective specifications. Consequently, differences arising from the actual goods offered by the parties in practice are irrelevant.

Class 4

22. The opponent relies upon the term "oils (medicinal)" in the specification of the Third Earlier Mark to oppose this class. Clearly, there will be an overlap in user as both the applicant's goods and the opponent's goods could be purchased by the general public. Similarly, the trade channels may overlap as the applicant's goods and the opponent's goods may be purchased from the same retailers (such as supermarkets or large pharmacies). However, they are likely to be sold in different sections of these retailers. In my view, these are very general points of overlap. The method of use, nature and purpose of the goods differ. There is no competition or complementarity.[1] Consequently, I find them to be dissimilar.

Class 16

23. The opponent relies upon the specifications of the First and Second Earlier Marks to oppose this class. However, for the same reasons given above, I do not consider there to be any more than a very general overlap in trade channels and user. There is no overlap in method of use, purpose or nature. The goods and services are not in competition or complementary. In my view, they are dissimilar.

Class 18

24. The opponent's best case in respect of these goods is, in my view, it's class 25 goods which appear in the specification of the Second Earlier Mark. These goods are likely to be sold through the same trade channels as the applicant's goods, with it being common for fashion retailers to sell both clothing and bags. The method of use will differ, as will the purpose (with the applicant's goods being to transport items from one place to another and the opponent's being to cover and adorn the body). There

[1] *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

may be some overlap in nature to the extent that the goods might be made from the same materials (cotton or leather, for example), although there will also be clear differences in nature. Given the differing purposes, the goods are not in competition. I consider the goods to be similar to a medium degree.

Class 25

25. The term "clothing" appears identically in both the applicant's specification and the specification of the Second Earlier Mark.

26. As some degree of similarity is required for a successful opposition under this ground, the opposition must fail in respect of those goods that I have found to be dissimilar.[2]

The average consumer and the nature of the purchasing act

27. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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,* Case C-342/97.

28. 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;

[2] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA

(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.

29. The average consumer for the goods will be a member of the general public. The average consumer will consider factors such as materials, aesthetics and size when purchasing the goods. The goods will not be everyday purchases and are likely to vary in price. Taking all of this into account, I find that the average consumer will pay a medium degree of attention when purchasing the goods.

30. The goods are likely to be self-selected from the shelves of a retail outlet or an online equivalent. Consequently, I find that the purchasing process will be predominantly visual. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants.

Comparison of trade marks

31. It is clear from *Sabel* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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."

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

33. The applicant has filed evidence regarding the way in which their mark is used in practice. However, the assessment that I must undertake is a comparison between the marks as applied-for/registered. Additional differences that might arise as a result of the way that the marks being used in practice are irrelevant. With that in mind, the respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
SLAY	Slay Republic

34. The opponent's marks consist of the word SLAY in a slightly stylised font. The word plays the greater role in the overall impression, with the stylisation playing a lesser role. The applicant's mark consists of the words SLAY REPUBLIC. For a significant proportion of average consumers these words will be seen as independent of each other and will each play an equal role in the overall impression. There will also be a significant proportion of average consumers who see the word SLAY as the name of the REPUBLIC, in which case the word SLAY will be the more distinctive element.

35. Visually, the marks coincide in the presence of the word SLAY. I bear in mind that the common element appears at the start of the applicant's mark, and consumers tend to pay more attention to the beginning of marks than the end.[3] I also bear in mind that the applicant's mark is a word only mark which could be used in any font. The word REPUBLIC in the applicant's mark is a point of visual difference. In my view, the marks are visually similar to a medium degree.

36. Aurally, the word SLAY will be pronounced identically in both marks. The word REPUBLIC in the applicant's mark is a point of aural difference. I consider the marks to be aurally similar to a medium degree.

37. Conceptually, the applicant claims that the word SLAY "has become common place in showing someone achieving success, completing something following adversity and is linked to females achieving such kind of success". The applicant filed evidence to support this in Exhibit DH10. This includes the following:

a. A Google AI result for the search "the origins of slay by year".

b. A print out from a website called The Daily Californian dated 22 August 2024 which talks about "the origins of 'slay'".

c. A print out from Wikipedia which is dated July 2024 and discusses the word "slay".

[3] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

d. The lyrics to a Beyonce song called Formation which references the word “slay” in the lyrics.

e. A copy of a promotional image for RuPaul’s drag race from 2018 for a TV Special called HOLI-SLAY.

f. An undated print out from a website called Planoly.com which says: “slay killing it” followed by the subheading “your outfit slays everytime”.

g. An undated print out from a website called Dictionary.com from October 2018 which discusses the meaning of the word “slay”.

h. A print out from a website called Larksuite.com, which has the letters “US” in the URL. This is dated 2024 and discusses the origin and meaning of the word “slay”.

38. There are further results of a Google search in Exhibit DH11. The issues with all of this evidence are that: 1) much of it is undated and so is not clear what the position was at the relevant date, 2) it is not clear that it comes from UK sources and in some cases it appears to come from US websites, 3) where it comes from Google AI/Google search results this is not reflective of the understanding of the average consumer, 4) Wikipedia is a notoriously unreliable source, as anyone can edit it, and 5) even though the word appears in a song by a popular artist or in the name of a TV special, this does not equate to the UK public understanding that it has a meaning which is connected in any way with the relevant goods.

39. In my view, the word SLAY is likely to be understood as the act of killing (whether literally or metaphorically). This will be the same in both marks. The word REPUBLIC is likely to be understood as referring to a country or place where the power is held by the people or the representatives that they elect. For a significant proportion of average consumers, the words in the applicant’s mark will not form any meaning in combination. They will, therefore, retain their ordinary dictionary meanings independent of each other. There will also be a significant proportion of average

consumers for whom the word SLAY will be viewed as the name of the REPUBLIC. In my view, the similarity arising from the common word SLAY results in at least a medium degree of conceptual similarity overall.

Distinctive character of the earlier marks

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, 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)."

41. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use made of it.

42. The earlier marks consist of the word SLAY, presented in a slightly stylised font. I have summarised the applicant's evidence in relation to the meaning of the word SLAY above; in my view, there is nothing in the evidence which demonstrates that the distinctiveness' of the word has been weakened in relation to the relevant goods. The word SLAY is an ordinary dictionary word which is neither descriptive, nor allusive of the relevant goods. I consider it to be distinctive to a medium (or average) degree. I do not consider that the stylisation, which is minimal, increases the distinctiveness of the mark overall to any material extent.

43. In her evidence, Ms Hunt states as follows:

> "12. It is appreciated that the Opponent herself, Louise Hazel, is a decorated, impressive Olympic athlete, having represented the UK, holds a strong personal brand on Instagram, with many followers. She is of influencer status, and with this influence, her online followers have helped to drive awareness to her company's popularity in "SLAY", as well as her investments in marketing. […]"

This appears to be an acknowledgement on the part of Mr Hunt, at least, that there is some awareness of the opponent's brand. However, it is not clear from this statement whether there is an acceptance on the part of the applicant that the opponent benefits from enhanced distinctiveness in the UK in relation to the relevant goods. In the absence of a clear admission in this regard, I consider the question of enhanced distinctiveness to still be in issue between the parties.

44. Ms Hazel states that the opponent has been using the goods in the US, UK, Canada, Australia and India. She also states that it has been used across a range of goods and services including, fitness articles, clothing, apps and podcasts, pharmaceutical preparations, meat extracts, coffee, fruit drinks, retail services, backpacks, food storage containers and kitchen towels. The relevant market when assessing enhanced distinctiveness is the UK market. Whilst Ms Hazel has provided turnover and advertising costs, no breakdown is given to clarify what proportion of

these relate to the UK market.[4] I have information regarding the opponent's social media activities, but it appears that only slightly higher than 10% of the opponent's audience is from the United Kingdom (against 62% being from the US).[5] Ms Hazel states that the UK is the second largest customer base of the opponent, which I take to be a reference to the position at the time of her witness statement. However, I have no way of knowing whether that was true as at the relevant date (which is almost a year previous). Even if I could take that to be reflective of the position at the relevant date, the percentage figures for the opponent's social media audience suggest that the UK is significantly behind the US.

45. Ms Hazel has provided figures for the percentage of the opponent's podcast audience which come from the UK.[6] This is 11.6%, with 63% coming from the US. In the period 1 December 2023 to 30 November 2024, there were 5,315 online store sessions of the opponent's website.[7] Ms Hazel states that a significant proportion of these are UK users. It is not clear what Ms Hazel means by "significant". However, the overall figures appear very low in the context of the market as a whole for the goods in issue. Ms Hazel has also provided figures for UK users to the opponent's website from Google Analytics from the period 17 October 2024 to 13 November 2024.[8] This is after the relevant date and is, therefore, of limited assistance; the position might have been different a year previously. In any event, whilst Ms Hazel states that there were 181 UK users during that time, the accompanying exhibit shows that this is actually the figure for the US (the figure Ms Hazel quotes as relating to the US is 245 which is actually the total active user number). The figure for the UK is 13. This seems to me to be an extremely small number.

46. The evidence is also unclear as to what proportion of the turnover/advertising figures provided relate to which goods/services. Mr Johnson, sitting as the Appointed Person in *W Sternoff LLC v Peter Kertels*, explained the problem with a failure to breakdown figures by product as follows:[9]

[4] Exhibit A3
[5] Exhibits A4 and paragraph 2 of Ms Hazel's second statement.
[6] Exhibit A11
[7] See paragraph 5 of Ms Hazel's second statement.
[8] Exhibit A10
[9] BL O/9084/25

> “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 goods is sold under trade mark A or trade mark B.”

47. Whilst Mr Johnson was making this statement in relation to genuine use, the same principle must apply to a claim for enhanced distinctiveness. In the absence of any breakdown, the figures provided are of no assistance against a backdrop where the opponent claims to have used its marks in relation to such a broad range of goods/services. In addition to this problem, I have no market share figures. Taking all of this into account, I find that there is no enhancement to the distinctiveness of the earlier marks.

Likelihood of confusion

48. Confusion can be direct or indirect. Direct confusion is where the average consumer mistakes 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 them and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

49. I have found as follows:

a. The goods are identical or similar to a medium degree (except where I have found them to be dissimilar).

b. The average consumer is a member of the general public, who will pay a medium degree of attention during the purchasing process.

c. The purchasing process is predominantly visual, although I do not discount an aural component.

d. The marks are visually, aurally and conceptually similar to a medium degree.

e. The earlier marks are inherently distinctive to a medium (or average) degree.

50. Bearing in mind the differences between the marks, I consider it unlikely that they will be mistaken one for the other. In my view, the average consumer is unlikely to overlook the presence of the word REPUBLIC in the applicant's mark, even where they are used on identical goods. Consequently, I do not consider there to be a likelihood of direct confusion.

51. I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case 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)".

52. I bear in mind that a finding of indirect confusion should not be made merely because two marks share a common element; it is not sufficient that one mark merely calls to mind another mark as this is mere association not indirect confusion.[10] However, in my view, the significant proportion of average consumers who view the word SLAY in the applicant's mark as retaining an independent distinctive role are likely to conclude that the marks originate from the same or economically linked undertakings when used in relation to identical goods or goods which are similar to a medium degree.[11] For example, the applicant's mark may be perceived as a co-branding with the opponent's mark or a collaboration between the two parties. For the

[10] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17
[11] *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

significant proportion of average consumers who view the word SLAY as the name of the REPUBLIC (meaning the word SLAY is the more distinctive element) they are likely to view the marks are consistent with a brand extension or variant (with the word REPUBLIC, which has connotations of equality and power being given to the people, being a reference to the ethos of the business). Alternatively, it may be seen as a reference to the overarching community connected with the brand. Consequently, I consider there to be a likelihood of indirect confusion.

53. The opposition based upon section 5(2)(b) of the Act is successful in relation to the class 18 and 25 goods only.

Final Remarks

54. For the avoidance of doubt, even if I had found a low degree of similarity (which, in my view, is the opponent's best case) in respect of the goods that I have found to be dissimilar, I would still have found no likelihood of confusion. This is because the distance between those goods and the opponent's goods and services would be sufficient to offset the similarity of the marks when taking account of the interdependency principle, particularly accounting for the only medium degree of distinctiveness of the earlier marks.

Section 5(4)(a)

55. Section 5(4)(a) of the Act states as follows:

> "5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -
>
> a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
>
> aa)…

b) …

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

56. Subsection (4A) of section 5 of the Act states:

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

57. I can deal with this ground relatively swiftly. In my view, this ground does not put the opponent in any stronger position. This is because in order for the opponent to be successful under this ground, the opponent must show more than a nominal goodwill; it must demonstrate a significant or substantial goodwill.[12] For the same reasons explained above, the opponent's evidence falls well short of demonstrating that it had a protectable goodwill in the UK at the relevant date in relation to the goods and services relied upon. Consequently, the opposition under this ground must fall at the first hurdle.

58. The opposition based upon section 5(4)(a) of the Act is dismissed.

CONCLUSION

59. The opposition is successful in relation to the following goods for which, subject to any appeal against this decision, the application is refused:

Class 18 Bags.

Class 25 Clothing.

[12] *Smart Planet Technologies, Inc. v Rajinda Sharma,* BL O/304/20

60. The opposition is unsuccessful in relation to the following goods for which, subject to any appeal against this decision, the application may proceed to registration:

Class 4 Candles.

Class 16 Stickers; journals.

COSTS

61. As both parties have enjoyed a roughly equal degree of success, I direct that each party bears their own costs.

Dated this 16th day of March 2026

S WILSON
For the Registrar

ANNEX

The First Earlier Mark

Class 28

Fitness articles and equipment; Sporting articles and equipment.

The Second Earlier Mark

Class 9

Mobile apps; Podcasts.

Class 25

Clothing, footwear, headgear; Sportswear.

Class 41

Physical fitness instruction; Yoga instruction; Pilates instruction; Education and instruction services; Sports and fitness services.

The Third Earlier Mark

Class 5

Pharmaceutical preparations; dietary supplements; food supplements; vitamin and mineral supplements; nutritional supplements; amino acids; protein supplements; whey protein supplements; carbohydrate supplements; creatine supplements; fat loss supplements; anti aging supplements; hormone supplements; fibre supplements; joint supplements; antioxidants; oils (medicinal); cod liver oil; protein supplements in the nature of protein shakes.

Class 29

Meat, fish, poultry and game; meat extracts; cured meat; preserved, dried and cooked fruits and vegetables; edible nuts; jellies, jams, compotes; prepared meals consisting primarily of meat, fish, poultry or vegetables; potato based snack food, fruit based snack food, vegetable based snack food, nut based snack food, soya based snack food; eggs; milk and milk products; liquid egg whites; soups; edible oils and fats; peanut butter; almond butter; Protein foodstuffs, namely, nut butters, seed butters, milk and whey based snack foods, protein yogurts; Protein drinks, namely milk based

protein drinks; Milk and yoghurt based drinks being protein drinks and milk, seed, nut and meat based foodstuffs for use during exercise, in the form of snack bars; Milk and yoghurt based drinks fortified with vitamins, and milk, seed, nut and meat based foodstuffs fortified with vitamins, in the forms of snack bars, milkshakes and protein drinks; Milk and yoghurt based drinks being milkshakes and protein drinks fortified with minerals, and milk, seed, nut and meat based foodstuffs fortified with minerals, in the form of snackbars; Milk and yoghurt based drinks fortified with carbohydrate and being protein drinks, and milk, seed, nut and meat based foodstuffs fortified with carbohydrate, in the form of snack bars; Milk and yoghurt based drinks fortified with fibre and milk, seed, nut and meat based foodstuffs fortified with fibre in the form of snack bars; seed based snack bars.

Class 30

Coffee, tea, cocoa, sugar, rice, preparations made from cereals; cereal bars; granola based snack bars containing grains; granola based snack bars containing nuts; granola based snack bars containing dried fruit; granola based snack bars containing chocolate; granola based snack bars containing protein supplements; energy bars; bread, pastry confectionery; food and drink flavourings; sandwiches; prepared meals consisting primarily of pasta or rice; pizzas, pies and pasta dishes; cookies and flapjacks.

Class 32

Mineral and carbonated drinks; non-alcoholic drinks; energy gels and drinks; sports gels and drinks; fruit drinks and fruit juices; preparations for making energy drinks and sports drinks; drinks fortified with protein; drinks fortified with vitamins; drinks fortified with minerals; drinks fortified with carbohydrate; drinks fortified with fibre; drinks fortified with dietary supplements; whey based protein drinks; smoothies.

Class 35

Retail services and on-line retail services connected with pharmaceutical preparations, dietary supplements, food supplements, vitamin and mineral supplements, nutritional supplements, amino acids, protein supplements, whey protein, carbohydrate supplements, creatine supplements, fat loss supplements, anti aging supplements, hormone supplements, fibre supplements, joint supplements,

antioxidants, oils (medicinal), cod liver oil, meat, fish, poultry and game, meat extracts, cured meat, preserved, dried and cooked fruits and vegetables, nuts, jellies, jams, compotes, prepared meals, snack food, eggs, milk and milk products, egg whites, soups, edible oils and fats, peanut butter, almond butter, protein shakes, energy bars, protein based drinks and foodstuffs, drinks and foodstuffs for use during exercise, drinks and foodstuffs fortified with vitamins, drinks and foodstuffs fortified with minerals, drinks and foodstuffs fortified with carbohydrate, drinks and foodstuffs fortified with fibre, coffee, tea, cocoa, sugar, rice, preparations made from cereals, cereal bars, snack bars, energy bars, bread, pastry confectionery, food and drink flavourings, sandwiches, prepared meals, pizzas, pies and pasta dishes, mineral and aerated drinks, non-alcoholic drinks, energy gels and drinks, sports gels and drinks, fruit drinks and fruit juices, preparations for making energy drinks and sports drinks, drinks fortified with protein, drinks fortified with vitamins, drinks fortified with minerals, drinks fortified with carbohydrate, drinks fortified with fibre, drinks fortified with dietary supplements.