**O/0347/26**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3628543**

**BY**

**SIMPLE TIRE LLC**

**TO REGISTER THE FOLLOWING TRADE MARK**

**IN CLASSES 12 AND 35**

# CONVERSE

**AND OPPOSITION THERETO UNDER NUMBER 427097**

**BY**

**ALL STAR C.V.**

## Background and Pleadings

1. On 19 April 2021, Simple Tire LLC ("the Applicant") applied to register the trade mark CONVERSE no. 3628543 in the UK. It was accepted and published in the Trade Marks Journal on 25 June 2021. Registration is sought for the following goods and services:

> Class 12: Tyres for Motor vehicles, namely, automobiles, trucks, vans, sport utility vehicles.
>
> Class 35: Online retail store services relating to tyres for Motor vehicles, namely, automobiles, trucks, vans, sport utility vehicles.

2. On 24 September 2021, All Star C.V. ("the Opponent") opposed the application originally relying on a broad range of trade marks under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act"). In its submissions in lieu of hearing the Opponent notified the Tribunal that it wished to amend its pleadings to rely solely on the section 5(3) ground of opposition and the following trade marks:

> UKTM no. 1520038
>
> CONVERSE
>
> Filed on 24 November 1992 and registered on 10 December 1993 for the following goods:
>
> Class 25: Articles of clothing; footwear; all included in Class 25.
>
> ("the first earlier mark")
>
> UKTM no. 914544837[1]
>
> CONVERSE
>
> Filed on 10 September 2015 and registered on 29 September 2017. Whilst it stands registered for a broad range of goods and services for the purposes of this opposition the Opponent relies solely on the following:
>
> Class 41: Entertainment; sporting and cultural activities; publication services; organising sporting, leisure and entertainment events; live entertainment;

[1] This mark was not originally relied upon for the purposes of section 5(3) in its original TM7, but for reasons that will become apparent this will not materially affect the outcome of the decision.

video, music, gaming and sports services; live entertainment services; arranging of competitions for entertainment purposes; photo sharing and video sharing services; arranging, conductions and organising competitions; information and advisory services relating to the aforesaid.

("the second earlier mark")

UKTM no. 1486511

CONVERSE

Filed on 2 January 1992 and registered on 14 May 1993.

Class 18: Leather and imitations of leather and goods made of these materials; bags; travelling bags; luggage; trunks; back packs; all included in Class 18.

("the third earlier mark")

(collectively "the earlier marks")

3. Under section 5(3) the Opponent claims a reputation "in respect of, but not limited to, footwear" claiming that use of the contested mark is likely to mislead and/or confuse the consumer into believing that the respective marks are connected or in some way associated. Further, it claims that use of the contested mark would, without due cause, take unfair advantage of, and/or be detrimental to, the repute and/or the distinctive character of the earlier marks.

4. The Applicant filed a defence and counterstatement denying the grounds of opposition putting the Opponent to strict proof of its claims including proof of use of the first and third earlier marks. Within its pleadings it admitted that the respective marks were similar but denied similarity between the respective goods/services. Further, it denied that there would be a likelihood of confusion between the respective marks given that the average consumer would exercise a higher degree of attention when selecting the Applicant's goods or services.

**Representation**

5. The Applicant is represented by Potter Clarkson LLP, and the Opponent is represented by Stobbs IP Ltd. Only the Opponent filed evidence. Other than filing its defence and counterstatement the Applicant did not file any additional evidence or

submissions during the proceedings. No hearing was requested, however, the Opponent filed submissions in lieu of a hearing. This decision is taken following a careful consideration of all papers filed.

**Evidence**

6. The Opponent's evidence in chief consists of the witness statement of Per J. Enfield dated 14 June 2023, together with 18 exhibits marked EXH 1-18 and the witness statement of Catherine Byfield dated 19 June 2023 together with 4 exhibits marked CB1-4.

7. Mr Enfield is the Assistant General Counsel for Nike Inc. and manager of the Opponent which is a Dutch Limited Partnership, and a wholly owned subsidiary of Nike, Inc. and a subsidiary of Converse Inc. The Opponent owns the Converse Inc. trade mark property rights outside the US. Ms Byfield is a trade mark attorney in the employ of the Opponent's representative's firm.

8. Whilst I have considered all the evidence and submissions in full in reaching my decision, I do not propose to summarise them in full but rather shall refer to the salient points to the extent that they are relevant at the appropriate stages of my decision.

**Relevance of EU Law**

9. 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.

**Proof of Use**

10. Due to their earlier filing dates, the marks upon which the Opponent relies qualify as earlier marks within the meaning of section 6 of the Act. The first and third earlier marks' registration processes were completed more than five years before the filing date of the contested mark and therefore they are subject to the proof of use provisions under section 6A of the Act. The Applicant has put the Opponent to proof of use of the same.

11. The relevant statutory provisions are as follows:

"6(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5) - (5A) [Repealed]

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

Section 100 of the Act is also relevant, which reads:

> "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."

12. The relevant period for assessing genuine use is the five-year period ending with the filing date of the application in issue i.e. 20 April 2016 to 19 April 2021.

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

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, 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]."

14. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

**Evidence**

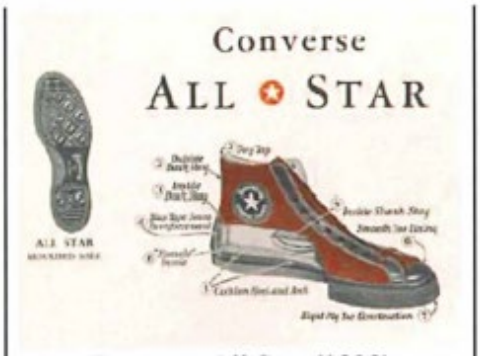
15. I have reviewed the Opponent's evidence in its entirety. I note the following:

(i) Mr Enfield provides details regarding the corporate background of the Opponent, and its subsidiaries Nike Inc. and Converse Inc.. He outlines the history of Converse Inc. which has been engaged in the manufacture and sale of footwear

for over 100 years. Converse Inc. is said to trace its origins back to the rubber industry and the Converse Rubber Co. when it opened its first factory in 1909. In 1916 Converse Inc. began manufacturing Triple Tread Tires for automobiles and in 1917 its "Converse canvas All Star shoe" was introduced, later rebranded as the "Converse Chuck Taylor[2] All Star" shoe in 1934, with a low-top version introduced in 1957. The 'outsole design' associated with the "Chuck Taylor All Star" shoe has been used since at least 1928. It is said that one of the most distinctive elements of the 'All Star' shoe is the rubber sole design which has been used as a feature of the shoe ever since, as per the images reproduced below:

Converse Non-Skid (1917)

Converse Chuck Taylor All Star High Top (2019)




Converse All Star (1929)

Converse Chuck Taylor All Star Outsole Design (2019)

(ii) In 1961 Converse Inc. expanded further with the purchase of the 'Tyer Rubber Company' which manufactured industrial sized rolls of rubber used in the leather, textile, steel, plastic, coating and converting industries. It is said to maintain its connection with the rubber industry to this day.

(iii) Converse products first entered the UK market in or around 1989, predominantly for footwear, with use of the CONVERSE trade marks in the UK on clothing and headgear dating from around 1990. Branded CONVERSE products are said to have been sold continuously in the UK since that time.

[2] A famous American basketball player.

(iv) Whilst largely associated with footwear, a diverse collection of products bearing the mark CONVERSE are available to UK consumers through major retailers including JD Sports, ASOS, John Lewis, Sports Direct, Schuh Limited and Zalando, as well as through the official www.converse.com/uk website. Products offered in the UK include footwear, clothing/apparel, headwear, bags and accessories, with catalogues displaying products branded with the CONVERSE mark circulated in the UK in 2011 and 2013 and evidence of window displays dating back to at least 2005.[3]

(v) In so far as sales, Mr Enfield estimates that over 750 million pairs of 'Converse Chuck Taylor All Star' shoes have been sold worldwide since 1917. Sample invoices of UK sales from some of its licensees (to include the UK retailers as aforementioned) are produced.[4] The UK sales revenue of CONVERSE products between 2015 and 2022 exceeded $1.22 billion. Specifically, annual UK sales revenues increased from approximately $1.98 million in 2002 to over $153 million in 2017. A table showing the number of pairs of shoes sold in the UK under the CONVERSE mark is produced between 2002 and 2014. In 2014, it is shown that over 14 million pairs of CONVERSE shoes were sold in the UK.

(vi) In so far as its market presence, Mr Enfield produces a Statista[5] report showing that an estimated 2.17 million people in the UK were wearing Converse shoes in 2021.[6] Extracts from UK fashion media articles are produced which have referred to Converse trainers as commonly seen footwear in the UK. Converse products have been endorsed by various high profile celebrities and featured in UK fashion and lifestyle publications and daily newspapers, including Vogue UK, Elle, Esquire, Glamour UK, GQ, The Times newspaper, Time Out and Shortlist, and have been referenced on UK television programmes such as *This Morning* which has estimated UK daily viewing figures of 1 million.[7] UK-specific collaborations have included the Damien Hirst (PRODUCT) RED Chuck Taylor All Star shoe, launched in the UK in 2010, as demonstrated in an extract taken from HYPEBEAST.[8]

[3] Exhibit 10 and Exhibit 11.
[4] Exhibit 13.
[5] A global data and business intelligence platform.
[6] Exhibit 5.
[7] Exhibits 7 and 8.
[8] A magazine and digital media platform. See Exhibit 6.

(vii) Mr Enfield states that Converse Inc. has advertised its products in the UK since at least the early 1990s through traditional print advertisements, billboards, London Underground campaigns, and marketing events. Advertisements appeared in UK magazines including Men's Health, Elle, Dazed and Confused, and GQ.[9] It has expended millions of pounds in advertising and promotional activity worldwide. Specifically for the UK, its annual advertising spend ranged from $661,000 in 1990 raising to over $5 million in 2013.

(viii) Converse Inc. is said to hold various global social media accounts with Instagram, YouTube and Facebook. Its Facebook page has received more than 46 million likes and is followed by more than 45 million users, whereas its Instagram and YouTube channels have 10.8 million followers and 149,000 subscribers respectively. In so far as marketing directly to UK consumers, its Instagram account is promoted under the handle @converse_london and has over 23,000 UK specific followers.[10]

(ix) Details of various decisions are produced in relation to disputes it has had with various entities over the name CONVERSE or similar names throughout the EU.[11] Whilst these are noted the outcome of these decisions are not binding on me since each case must be decided on its own facts and evidence.

16. I note that the Opponent's goods are not limited to footwear and include clothing, headgear and bags and services in class 41 (although in relation to the latter services it was not required to demonstrate use). However, given that the main focus of its evidence has been solely on footwear, it is reasonable to infer that a significant proportion of the above sales figures relate to footwear. In my view there can be little doubt, given the evidence summarised above, that the Opponent has put its first earlier mark to genuine use during the relevant period in relation to *casual trainers*. There is, however, limited evidence in relation to the other goods it relies upon, a good proportion of which is dated outside the relevant period and the generic global sales figures have not been broken down by product category. It is difficult, therefore, to ascertain the extent of sales in relation to these other products it relies upon. However, in so far as genuine use, I remind myself that I need to consider the evidence as a

[9] Exhibit 18.
[10] Various posts are produced at Exhibits 15 and 16.
[11] See paragraph 16 and 17 and Exhibit 9.

whole and not whether each individual piece of evidence shows use by itself. Further I note Mr Enfield's narrative evidence which was unchallenged. Consequently, when assessing the evidence, when taken as a whole, I note that it includes screenshots taken from various websites where the marks are displayed on bags, t shirts, sweatshirts, hoodies, shorts and baseball caps. Whilst some of these screenshots are dated in 2023, there is no reason to believe, given Mr Enfield's evidence, that the position was any different during the relevant period. The evidence shows these products being offered for sale by the Opponent and third parties which is sufficient for me to conclude that the earlier marks have been put to genuine use for clothing and headgear as well as footwear.

17. I have considered whether the Opponent should be entitled to rely upon the term "footwear" at large and or whether this should be limited to *casual trainers*. In my view, the Opponent should not able to rely on the broader term, given the extent of the use shown which has only been in relation to the narrow sub category. In so far as clothing, given the breadth of the use shown across more than one category of clothing, I am satisfied that it should be able to rely upon the broader term. In so far as bags and headgear it has only shown genuine use for baseball hats and back packs rather than any broader category.

18. Consequently, I consider a fair specification to be:

> Class 25: clothing; casual trainers; baseball hats and back packs.

**Decision**

19. Section 5(3) of the Act states:

> "5(3) A trade mark which-
>
> (a) 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 (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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.

20. Section 5(3A) of the Act states:

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

21. I bear in mind the relevant case law set out in the following judgments of the Court of Justice of the European Union ("CJEU"): Case C-375/97, *General Motors*, Case 252/07, *Intel,* Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The conditions of section 5(3) are cumulative. Firstly, the Opponent must show that the earlier marks and the contested mark are similar. Secondly, the Opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Fourthly, assuming that the first three conditions are met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) for the goods/services to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. For the purposes of section 5(3) the relevant date for the assessment is 19 April 2021.

**Similarity between the marks**

22. The marks are identical featuring the same word mark CONVERSE. Consequently, this requirement is satisfied.

**Reputation**

23. 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."

24. In assessing whether the earlier marks have a reputation to a significant number of consumers, I must assess the evidence in terms of the extent it demonstrates "the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it."[12]

**My Approach**

25. I remind myself that in its pleadings the Opponent phrased its claim to a reputation as "in respect of, but not limited to, footwear". In its submissions in lieu, I note that it expressly extended its claim to include apparel and bags/accessories. Given the wording of its original pleadings, I take from this that the Opponent considers 'footwear' to be its best case. Given my assessment of the evidence above that is plainly the case. The evidence is insufficient to justify a reputation for any wider range of goods/services. For the avoidance of doubt, if the Opponent does not succeed in relation to reliance on *casual trainers* it will not be in any better position in relation to clothing, baseball hats and back packs or the services it relies upon in class 41 either. I shall proceed therefore only on the basis of a reputation being held in relation to *casual trainers*.

26. In light of the evidence as summarised above and my approach, I have no hesitation in finding that the Opponent has a very strong reputation for *casual trainers.*

[12] *General Motors* para 27.

**Link**

27. Having found a very strong reputation for *casual trainers*, I must now go on to consider whether this reputation would give rise to the necessary mental link being made between the respective trade marks. The factors to be taken into account to establish as to whether a link would be made, are those as set out in *Intel.*[13] Taking each of the factors in turn

The degree of similarity between the conflicting marks

28. The marks are identical.

The nature of the goods for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services and the relevant section of the public.

29. The Applicant's goods and services are those in relation to tyres for motor vehicles and online retail services for the same. The Opponent's goods in which I found it to hold a reputation are *casual trainers* in class 25.

30. The goods/services differ in purpose, end user (other than on a very high level of generality), channels of trade, method of use and are neither complementary nor in competition.

31. In so far as the Opponent's submissions regarding the channels of trade overlapping these in my view will differ: the Applicant's goods are ones ordinarily sold through motor vehicle garages and specialist tyre outlets, whereas the Opponent's *casual trainers* are sold through more general clothing/fashion outlets. Further in so far as the nature of the goods, the Opponent has filed evidence outlining that its *casual trainers* are known for their rubber soles and that it was originally a rubber manufacturer. Consequently, there is a very limited overlap in the nature of the products in that the respective products each use rubber, which is a distinctive and key feature of the Opponent's *casual trainers*. However, in going through the *Treat*[14] factors this limited overlap in nature is insufficient in my view for a finding of overall similarity on this fact alone. After all, as stated by Mr Iain Purvis KC, sitting as a Deputy

[13] *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU).
[14] [1996] R.P.C. 281

High Court Judge in *Unicorn Studio Inc v Veronese (Société par Actions Simplifiée)*[15] the finding of similarity requires the exercise of common sense and standing back and considering the overall question and not asking how many of the factors identified in *Treat* or *Canon* could be said to have been satisfied.[16] Consequently, I cannot see any meaningful similarity between the respective goods/services within the parameters of the caselaw cited, other than to a very low degree in relation to the nature of the goods.

32. The relevant public is a member of the general public. The goods/services are unlikely to attract an exceptionally high cost and will be purchased relatively frequently although they would not be everyday purchases. The Opponent's goods' price point is much lower than those of the Applicant being fashion items with fit, style and aesthetics taken into account in the purchasing process. Consequently, the level of attention undertaken in the purchasing process will be average (medium). In so far as the Applicant's goods given that there is an element of safety involved and legal requirements regarding the tread, then the level of attention will be slightly higher to between a medium and high degree but not at the highest. The average consumer will consider factors such as the reputation, quality and ease of access and location of the provider in the selection of the services, which I consider would involve again no more than an average (medium) level of attention.

33. The goods will be selected by self-selection from the shelves of retail outlets or following perusal of the goods on websites or in catalogues. Similarly, the services will be selected following perusal of signage on physical premises, from websites or advertisements in conventional printed publications. Consequently, visual considerations will dominate the selection/purchasing process. Despite this, I do not discount aural considerations where advice may be sought from sales staff.

<u>The strength of the earlier marks' reputation</u>

34. I have found that based upon the evidence filed, as at the relevant date, the Opponent has a very strong (high) reputation in the UK for *casual trainers*.

[15] [2024] EWHC 1098 (Ch)
[16] Para 24.

The degree of the earlier marks' distinctive character, whether inherent or acquired through use

35. 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)."

36. 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 and services, 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 that has been made of it.

37. The earlier marks are all for the word CONVERSE which is an English dictionary word with no allusive or descriptive connection to the goods. It is therefore inherently distinctive to a medium degree. By virtue of the use made of the marks, the evidence

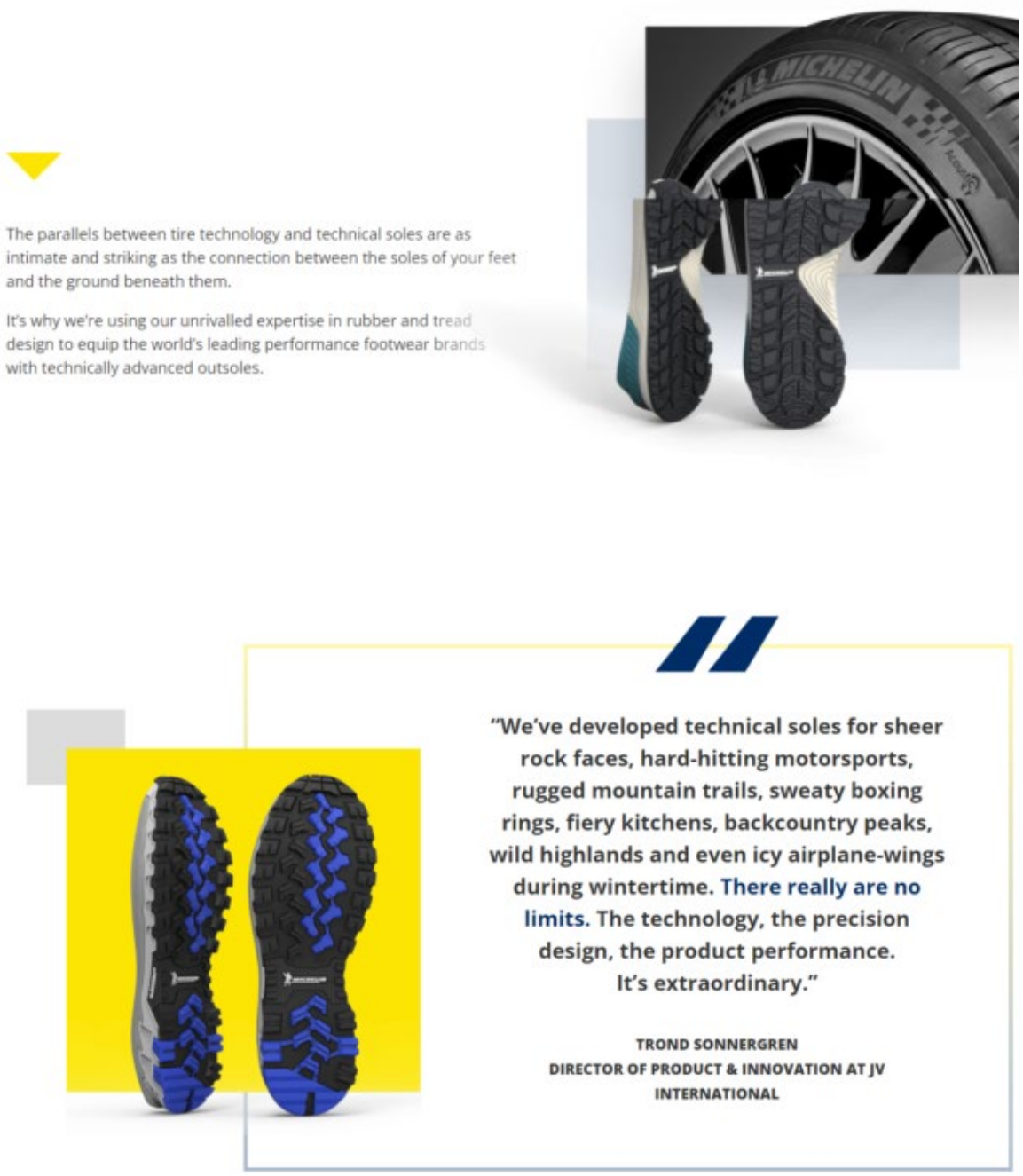
shows that its distinctive character has been enhanced further to a high degree for *casual trainers*.

Whether there is a likelihood of confusion

38. Notwithstanding the very low degree of similarity in the nature of the respective goods, overall, the respective goods and services are too distant and, therefore, I do not consider that there would be a likelihood of confusion.

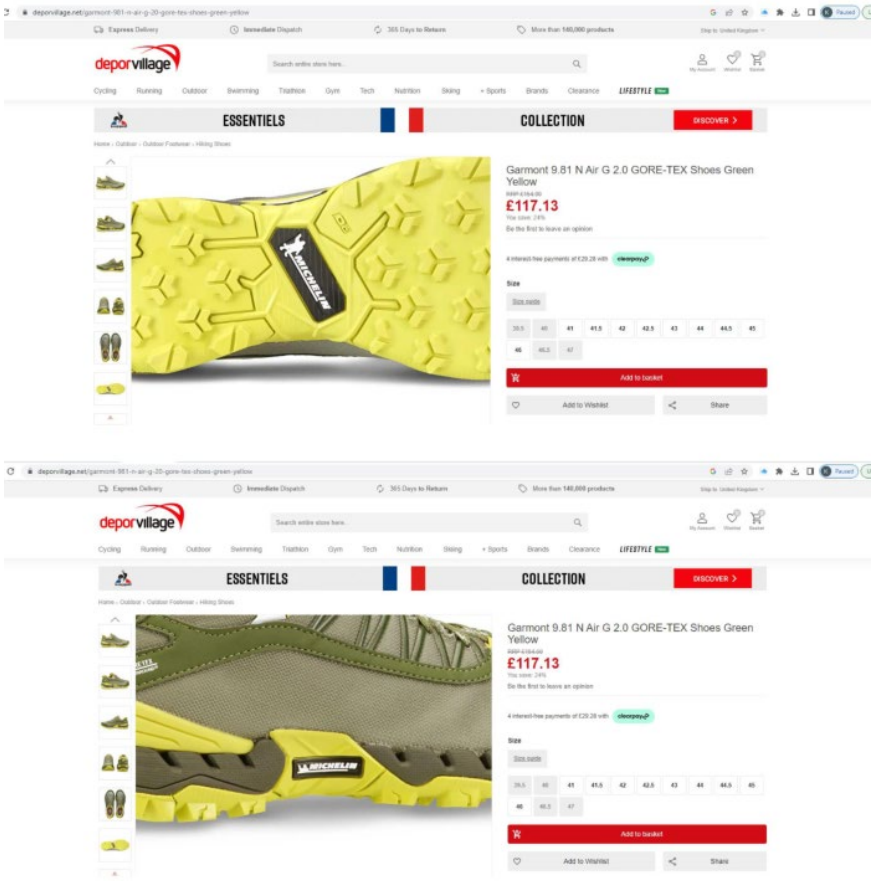
39. Despite the distance between the respective parties' fields of activity, this does not prevent a claim succeeding under section 5(3) as there is no requirement for the respective goods/services to be similar. I note that Ms Byfield filed a witness statement within which she sets out evidence of various entities that sell both tyres and clothing/shoes. Her evidence consists of the results of internet searches in relation to well known tyre manufacturing brands such as Continental, Pirelli, Bridgestone and Michelin who offer, amongst other goods, clothing, footwear and headwear as well as tyres. Some of these I acknowledge are more merchandise type goods such as keyrings and baseball caps (Bridgestone and Pirelli) but I note that Continental (a manufacturer of bicycle tyres) was shown to offer various cycling clothing for sale as of April 2021.

40. Ms Byfield also provides evidence to show that Michelin is predominantly known for being a manufacturer of tyres for automobiles, motorcycles, bicycles and scooters who additionally uses its "unrivalled expertise in rubber and tread design to equip the world's leading footwear brands with technically advanced outsoles" for chiefly trainers, with the word MICHELIN clearly displayed on the soles. Such brands include Mizuno, Babolat and Northwave. She produces various screenshots (as reproduced below) taken from Michelin's website setting out the parallels between "tire technology and technical soles".



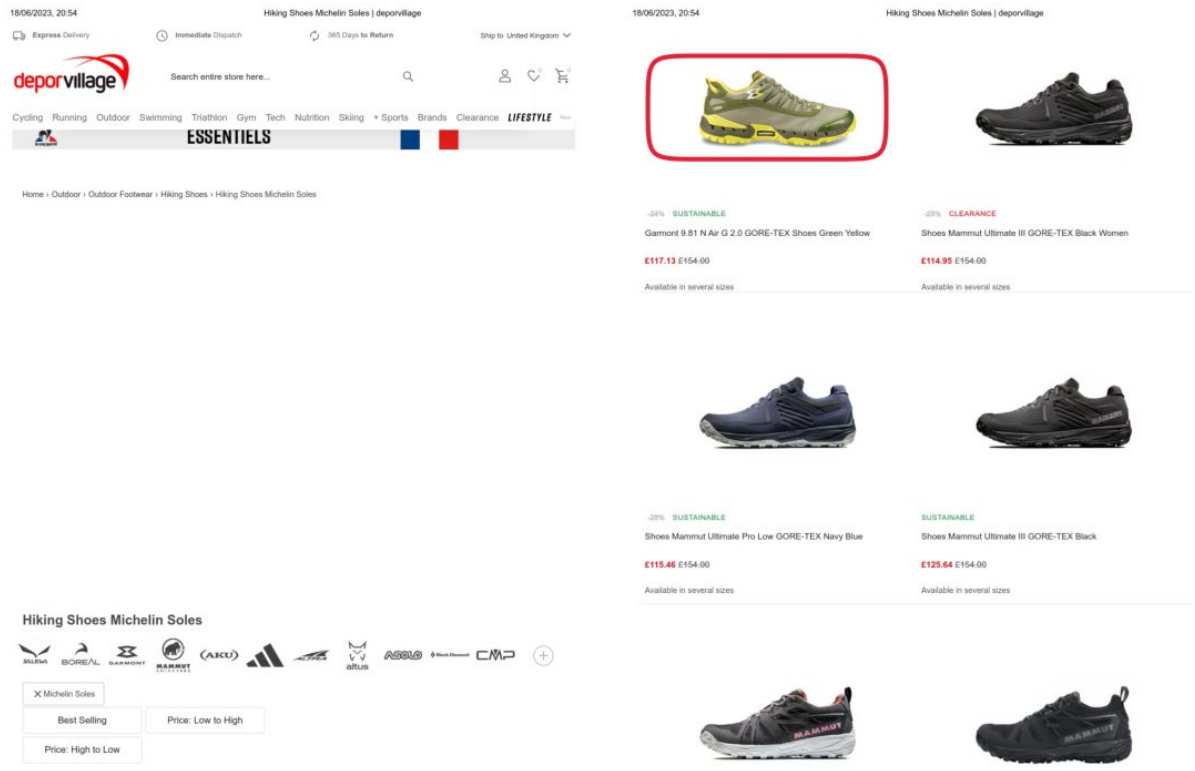

41. Further screenshots (dated June 2023) of the homepages of various brands' websites are produced displaying Michelin branded soles being used in conjunction with various footwear brands.[17]

[17] See Exhibit CB1.

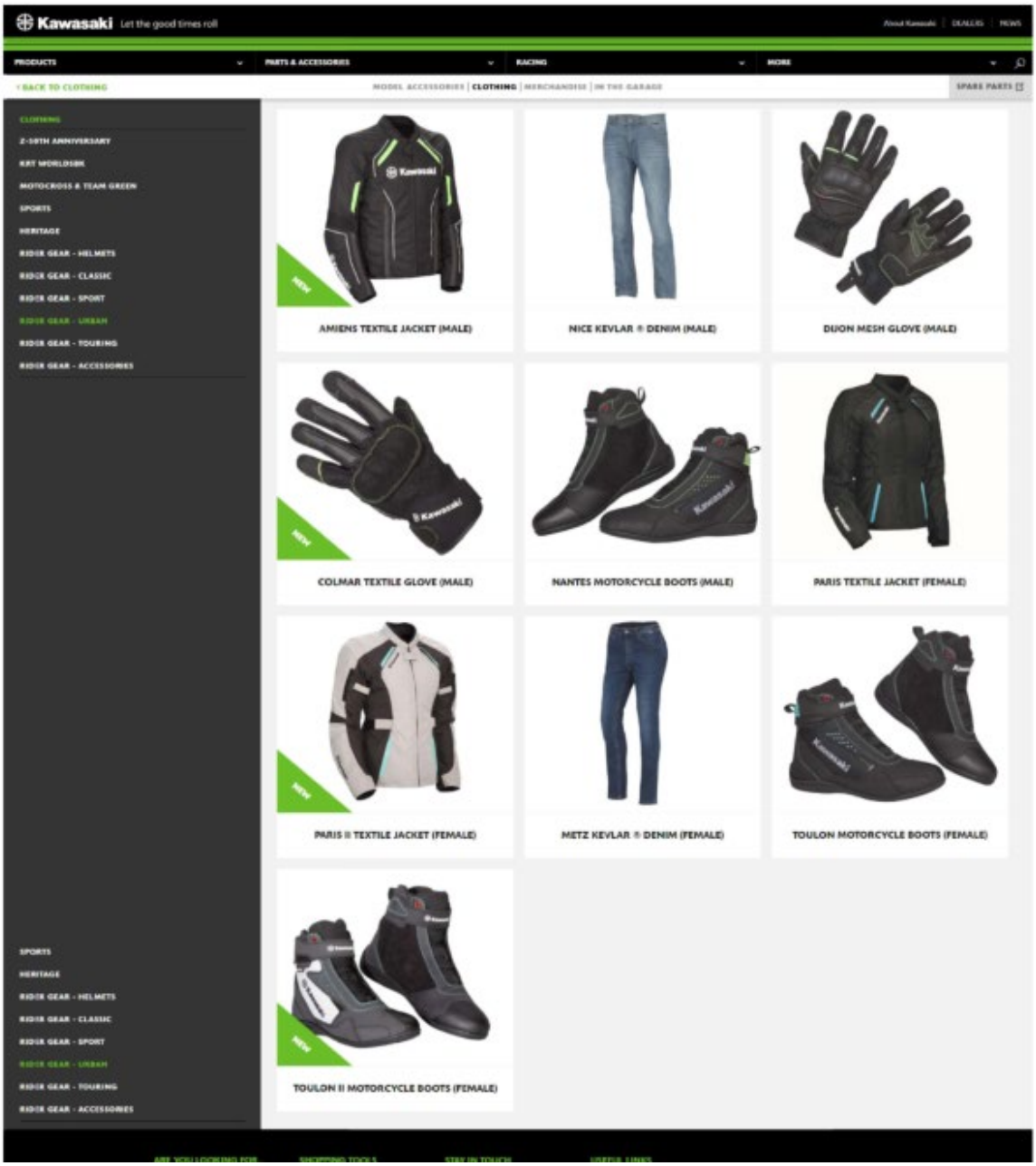



https://www.deporvillage.net/garmont-981-n-air-g-20-gore-tex-shoes-green-yellow

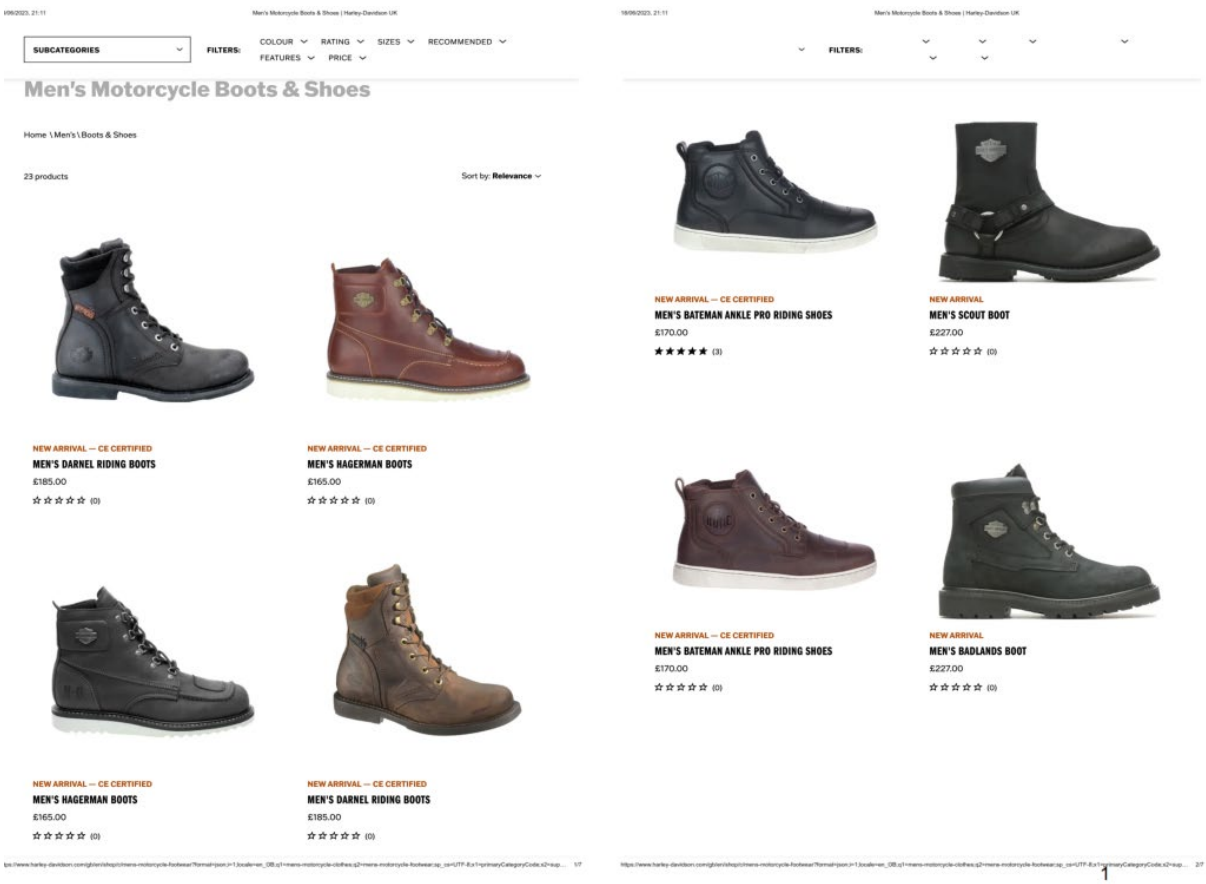
Date accessed 18 June 2023



42. The evidence also consists of examples of motorcycle and car manufacturers offering clothing, footwear and headgear to include Harley Davidson, Land Rover, Range Rover and Kawasaki.[18] It is said that Harley Davidson for example manufactures riding boots and shoes under the Harley Davidson brand. I note that the evidence shows that the Kawasaki motorcycling brand produces protective clothing and footwear specifically designed for motorcycle riding as opposed to the leisure/fashion clothing and shoe market generally.




[18] See Exhibit CB2.




43. Further brands are identified in evidence that offer both sporting goods such as bicycles and roller skates and clothing/footwear. For example, Reebok which is ordinarily known as a sport shoe and clothing manufacturer is shown to have also produced bicycles.[19]

44. Examples are also provided of collaborations between car manufacturers and clothing/ footwear brands, an example of which is between Land Rover, a British Car manufacturer and Paul Smith a British fashion brand.[20]

45. Many of the screenshots produced by Ms Byfield have been accessed as at June 2023 and some do not appear to be UK directed websites which, therefore, means that the evidence does not necessarily show whether this overlap in trading activities was indicative of the position of the UK as at the relevant date. However, the evidence is unchallenged and there does not appear to be any suggestion that the position was different in 2021 as opposed to 2023, particularly given the length of time it takes for

[19] See Exhibit CB3
[20] See Exhibit CB4.

collaborations to be formed and products to be designed, manufactured and placed on the market.

46. I place the greatest weight on the evidence showing that Michelin has used its technology to develop shoe soles, and on the fact that the Opponent itself has a historical origin in the tyre and rubber industry. Although not all of the evidence relating to collaborations is directly relevant, because much of it concerns car brands branching into, or collaborating on, merchandise type goods whereas the connection between tyres and clothing/footwear is one step further removed. Nevertheless, I am satisfied that the evidence supports the contention that there is a sufficient overlap between the tyre industry and the shoe sole industry for a link to be made in the mind of the relevant public. Given the very strong reputation enjoyed by the Opponent in relation to *casual trainers* where the particular distinctive design of its shoes features the use of rubber in their construction, I consider that the parties' respective fields of activities are closer than would ordinarily be perceived. Consequently, where the same identical mark is applied to the Applicant's goods (and retail services for the same) which are likewise made from the same material, it is my view that a substantial number of consumers will bring to mind the earlier marks and consider there to be a link between the respective undertakings. This is particularly so for those consumers who are familiar with Converse Inc.'s background as a rubber manufacturer.

47. This finding is reinforced by the Opponent's unchallenged evidence showing that Michelin for example uses its expertise and knowledge in the tyre industry to apply it and develop similar technology for trainers and sports shoes. The rubber technology used in tyres is malleable, durable, and provides grip, tread and strength, characteristics which are equally desirable in footwear.

48. Consequently, taking all the above into account, such is the very strong reputation held by the Opponent in relation to *casual trainers* together with the Applicant's choice of using an identical mark, I consider that a link would be made in the minds of a substantial number of UK consumers. Consumers will make the mental leap and believe that there is an economic connection between the two entities.

49. I am fortified in this finding given that the EUIPO reached the same conclusion.[21]

[21] Opposition number B 3152583 dated 16 January 2025 in relation to EUTM no.18455257.

**Damage**

50. Having found a link I shall now move over to consider whether any of the heads of damage would arise.

51. Given the identity between the marks I consider that this will create a familiarity with consumers when confronted with the contested mark such that there is an increased chance of consumers buying the later mark's products because of their perceived link to the Opponent. In my view this would take unfair advantage of the earlier marks' reputation and gain a foothold in the industry quickly, without having to make an equivalent investment or marketing effort themselves. The economic behaviour of customers would change leading to a commercial advantage being gained by the Applicant.

52. Since I have found damage resulting from an unfair advantage being gained by the Applicant this is sufficient for the opposition based upon section 5(3) to succeed and I need not therefore consider whether any of the other heads of damage has arisen.

**Conclusion**

53. The opposition based upon section 5(3) succeeds in its entirety, subject to appeal the application shall be refused registration.

**Costs**

54. The Opponent has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I note that originally the Opponent relied on wider grounds of opposition than ultimately it chose to pursue. However, it was still required to file evidence in support of its claim, given that the Applicant put it to strict proof of use and its reputation. I also note that it originally filed evidence exceeding the 300 page limit which required the intervention of the Tribunal in the manner in which the evidence was presented. The Applicant, however, did not advance any submissions on the matter and was not materially affected by the outcome given that it did not file any evidence or submissions in response. Taking these matters into account, I award costs on the following basis:

| | |
|---|---|
| Preparing an opposition and statement of grounds: | £400 |
| Preparing evidence: | £900 |
| Preparing Submission in lieu of hearing: | £600 |
| Official fee: | £200 |
| **Total** | **£2,100** |

55. I order Simple Tire LLC, to pay All Stars C.V the sum of £2,100 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

**Dated this 24th day of April 2026**

Leisa Davies

**Leisa Davies**

**For the Registrar**