

O-0413-24

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3716469

BY

AT INNOVATIONS (SCOTLAND) LLP

TO REGISTER THE FOLLOWING TRADE MARK:

PINK SODA

IN CLASSES 5, 29 & 30

AND

OPPOSITION THERETO (UNDER NO. 432192)

BY

JD SPORTS FASHION PLC

BACKGROUND

1) On 01 November 2021, AT Innovations (Scotland) LLP ('the applicant') applied to register 'PINK SODA', as a trade mark, in respect of the following goods:

Class 5: Dietary food supplements; nutritional supplement meal replacement bars; dietary supplement snack bars; dietary supplement protein bars.

Class 29: Nut and seed-based snack products; nut and seed-based snack bars; fruit and nut-based snack products; fruit and nut-based snack bars; organic nut and seed-based snack products; organic nut and seed-based snack bars; protein based, nutrient dense snack bars; tofu-based snacks; legume-based snacks; dried fruit-based snacks; plant-based snacks; plant-based snack bars; plant-based protein bars; snack bars containing nuts; snack bars containing dried fruit.

Class 30: Cereal bars and energy bars; high protein cereal bars and energy bars; cereal based snack bars; biscuits; breakfast biscuits; confectionery; snack bars containing grains; snack bars containing a mixture of grains; nuts and dried fruit (confectionery) fruit based snack bars; granola-based snack bars; breakfast bars; cereal bars; cereal based energy bars (not for use as a meal replacement); cereal based food bars; chocolate coated snack bars; chocolate coated whipped bars; chocolate coated wafer biscuits; chocolate coated bars; non-medicated confectionery for use as part of a calorie controlled diet; low-carbohydrate confectionery; snacks made from muesli.

2) The application was published in the Trade Marks Journal on 31 December 2021 and notice of opposition was later filed by JD Sports Fashion Plc ('the opponent'). The opponent claims that the application offends under sections 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act').

3) Under Section 5(3) of the Act, the opponent relies upon the following UK trade mark registration, in respect of some of the goods covered by that registration, as shown below:

UKTM No: 903924404

PINK SODA

Class 25: Clothing.

Priority date: 12 December 2002 (UK)

EU Filing date: 08 July 2004

Date of entry in the register: 08 November 2005

4) It is claimed that the respective marks are identical and that the earlier mark enjoys a reputation in the UK in respect of the goods relied upon and that use of the contested mark is likely, without due cause, to take unfair advantage of, or be detrimental to, the reputation and/or distinctive character of the earlier mark. The opponent states that it is well-known for operating the JD/JD Sports branded retail business which sells fashionable branded sports and casualwear¹. It is claimed that one such range of sportswear has been provided under the brand 'PINK SODA' since 2015. It further claims that the application in suit is a 'deliberate attempt to exploit the distinctive character and repute'² of its earlier mark.

5) The trade mark relied upon by the opponent under section 5(2)(b) of the Act is a comparable mark which is an earlier mark as per section 6 of the Act³. As the earlier mark completed its registration procedure more than five years prior to the application date of the contested mark, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in relation to the goods relied upon.

¹ Statement of Grounds, [7]

² Statement of Grounds, [9]

³ Following the end of the transition period of the UK's withdrawal from the EU, all EUTMs and IR (EU) TMs registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)/IR(EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM/EU(IR)TM from which it derives.

6) Under section 5(4)(a) of the Act, the opponent relies upon use of the sign 'PINK SODA' throughout the UK since December 2015 in relation to 'sportswear, sports apparel and gym wear'. It is claimed that use of the applicant's mark, in respect of the goods applied for, would lead the relevant public to believe that the contested goods are the goods of the opponent or that there is some trade connection between the two parties. It submits that this is particularly likely because both parties' goods are aimed at the sports or gym market. It therefore claims that there will be misrepresentation and damage to the opponent's goodwill.

7) The applicant filed a counterstatement. It puts the opponent to proof of use of its earlier mark and denies all of the opponent's claims.

8) The opponent is represented by Murgitroyd & Company. The applicant is represented by Keltie LLP. The opponent filed evidence-in-chief consisting of a witness statement in the name of Neil James Greenhalgh with 14 exhibits thereto. The applicant filed no evidence or submissions during the evidence rounds. A hearing took place before me, at which the opponent was represented by Mr Alan Fiddes of Murgitroyd & Company and the applicant was represented by Ms Lindsay Lane, of Counsel, instructed by Keltie LLP.

DECISION

Proof of use

9) Section 6A of the Act states:

“(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.”

10) As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

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

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

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

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

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

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

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

11) Section 100 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.”

Consequently, the onus is upon the opponent to prove that genuine use of the registered trade marks was made in the relevant period.

12) 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 Bunderversvereinigung 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].”

13) As regards assessing use within the EU (which is relevant due to the earlier mark being a ‘comparable mark’ and because the vast majority of the relevant period falls before ‘IP completion day’), I also bear in mind that in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union (‘CJEU’) noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for

genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

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

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

14) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. (as he then was) reviewed the case law since the *Leno* case and concluded as follows:

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

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as

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

15) The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

16) Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5-year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them

iv) The geographical extent of the use shown

17) The relevant period in which genuine use must be established is the five-year period ending on the date of filing of the contested mark. In the case before me, that period is **02 November 2016 to 01 November 2021**.

18) At the hearing, Ms Lane submitted that the use shown in the opponent's evidence is not of the mark as registered. She pointed out that the evidence shows use of the mark 'PINK SODA SPORT', sometimes in combination with a device element of a heart. Ms Lane drew my attention to the following examples of use shown in the opponent's evidence:

i)



ii)

PINKSODASPORT

19) In Ms Lane's submission, the addition of the word 'SPORT' and/or the device element of the heart alters the distinctive character of the mark, as registered. In support of this contention, Ms Lane urged me to take in to account the guidance from Mr Phillip Johnson in *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22. I note that in that decision, Mr Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

"13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is,

the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

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

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

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

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

20) Having considered this case law, I find that 'PINK SODA SPORT' and the examples set out at i) and ii) above, constitute acceptable use of the mark, as registered. As noted above by Mr Johnson, 'the addition of descriptive or suggestive words... is unlikely to change the distinctive character of the mark'. I find that to be the case here. The word 'SPORT' is entirely descriptive in the context of the use shown in the opponent's evidence (which all relates to sports clothing). The addition of that word to the mark 'PINK SODA' does nothing to alter its distinctive character. Furthermore, the use of 'PINK SODA'/'PINK SODA SPORT' with the device of a heart also does not alter the distinctiveness of 'PINK SODA' because the latter retains an independent distinctive role in such use⁴. I find that all the various forms of use of the mark shown in the opponent's evidence are use of the mark, as registered.

21) As for the scale and frequency of the use and the kinds of goods for which has been shown, Mr Greenhalgh's evidence shows the following:

- In December 2015, the opponent launched PINK SODA as a women's sports, fitness and gym wear brand and Mr Greenhalgh states that the mark has been used continuously, throughout the UK, since that time⁵.
- Between December 2015 and the filing date of the contested mark, it is said that the opponent has sold, in excess of, 2.6 million items of clothing in the UK bearing the mark PINK SODA which accounts for sales in excess of £43 million⁶. An extract from the opponent's management accounts sets out the kinds of goods which make up those sales. The vast majority of these are described as being women's clothing and include vests, shorts, swimwear, crew tees, leggings, hooded tops, light jackets, underwear, fleece bottoms, baseball caps and 'retro running' footwear⁷. It is said that in 2021, the opponent also introduced a range of similar clothing for girls. Examples of such goods, said to have been sold between 2016 and 2021 are provided⁸.

⁴ Colloseum Holdings AG v Levi Strauss & Co., Case C-12/12

⁵ Mr Greenhalgh's witness statement at [10]

⁶ Mr Greenhalgh's witness statement at [11]

⁷ Exhibit NJG4

⁸ Exhibit NJG5

- The opponent runs numerous retail stores throughout the UK under the mark ‘JD Sports’⁹. The following table is provided, which is said to show the number of those UK stores that have sold PINK SODA branded goods between 2016 and 2020¹⁰:

Year	Number of UK Stores
2016	200
2017	237
2018	244
2019	272
2020	208

- The opponent also sells its PINK SODA goods from its website at www.jdsports.co.uk. Prints are provided from that website from June 2017, March 2019 and February 2021¹¹, showing the sale of goods under the mark PINK SODA (or an acceptable variant of) in relation to women’s sports/fitness wear such as leggings, vests, hoodies, tights, jogging bottoms, sports bras, sweatshirts, shorts, jackets, t-shirts.
- In addition to sales through its own website and retail stores, the opponent began wholesaling its PINK SODA goods to other retailers in the third quarter of 2019, including ASOS, Next, SimplyBe, Very and Zalando. Details of the turnover generated through that wholesaling is provided¹², along with images of the product range wholesaled to those retailers between 2019 and 2021. All of the goods are of the same/similar kind as detailed in the preceding bullet point and bear the PINK SODA mark (or an acceptable variant of). Prints from the websites of those retailers are also provided showing the opponent’s PINK SODA goods for sale (albeit that those particular prints appear to come from after the relevant period)¹³.

⁹ Mr Greenhalgh’s witness statement at [8]

¹⁰ Mr Greenhalgh’s witness statement at [13]

¹¹ Exhibit NJG6

¹² Exhibit NJG8

¹³ Exhibit NJG9

- The opponent spends approximately £250,000 per annum on promoting the PINK SODA mark. However, more than this was spent in 2016 (being the first-year post-launch of the brand) due to spending on magazine advertisements and celebrity endorsements from the likes of Vicky Pattinson, Ferne McCann and Melanie Sykes¹⁴. Copies of the relevant magazine advertisements are provided along with a 'small selection' of those celebrity endorsements¹⁵. Both the advertisements and celebrity endorsements show use of PINK SODA (or an acceptable variant of) on women's sports/fitness clothing. The magazine advertisements are not dated but it seems that they must all emanate from 2016 given that Mr Greenhalgh's comments appear to suggest that such adverts were taken out in 2016 only (post-launch of the brand) as that is why the amount spent on promotion in that year was higher than other years.

22) It is clear to me, from my summary above, that the opponent has used its PINK SODA mark on a range of sports and fitness clothing for women in the UK during the relevant period. Although the opponent mentions that it also introduced a range for girls in 2021, the evidence relating to such goods is very limited. Whilst I am mindful that the relevant market is, no doubt, a substantial one, the nature of the use shown is clearly use that will have created and preserved a share in that market for the opponent's goods. There has been real commercial exploitation of the mark in the UK. The evidence shows that the opponent has a large number of stores throughout the UK and has sold its goods in a high number of those stores under the PINK SODA mark every year throughout the relevant period. It has also sold its goods through well-established third-party on-line retailers (I accept that the examples of use shown on the websites of those retailers which post-date the relevant date are likely to be representative of the use that was made prior to the relevant date). I find that the scale, frequency and geographical extent of the use in the UK is sufficient to show that the opponent's comparable mark has been put to genuine use.

¹⁴ Mr Greenhalgh's witness statement at [18]

¹⁵ Exhibit NJG11

23) I must now determine a fair specification for the opponent's earlier mark. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law on this matter as follows:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

24) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them;
Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46.”

25) In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 (Court of Appeal), a case which concerned pharmaceutical substances and preparations, Kitchen LJ held that it was well established that (1) a category of goods/services may contain numerous subcategories capable of being viewed independently and, (2) the purpose and intended use of a pharmaceutical product are of particular importance in identifying the subcategory to which it belongs.

26) In the instant case, the opponent relies upon ‘clothing’ at large. This is a broad term which would cover all kinds of clothing for women, men and children. The opponent has demonstrated genuine use on a wide selection of items of sports/fitness clothing for women. The use shown in relation to girls’ clothing is far more limited and not sufficient to show genuine use. I find that a fair specification is ‘Women’s sports and fitness clothing’.

Section 5(3)

27) Section 5(3) of the Act provides:

“(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 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.”

28) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 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 C383/12P, *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.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General 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) 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*.

(g) 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*.

(h) 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*.

(i) 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*).

Reputation

29) The relevant public is the general public. The sales figures, whilst not particularly vast, are far from insignificant. Furthermore, the relevant public includes potential consumers of the opponent's goods as well as consumers who have actually purchased those goods. In this connection, the opponent's evidence shows that, in addition to the turnover figures, the opponent's goods have been stocked in a large number of its own well-established retail stores throughout the UK since 2016 and on the websites of other well-established fashion retailers such as Next and ASOS since 2019. Therefore, the proportion of the relevant public who have been exposed to the opponent's mark (in those stores and on the websites of third-party retailers) is likely to be greater than the sales figures alone would suggest.

30) In terms of promotion, I note that all of the magazine articles appear to emanate from 2016. Although the opponent states that it has spent over £250,000 per annum since that time (which is not an insignificant annual sum), there is nothing to show the nature of that promotion, aside from use on the opponent's social media pages. Nevertheless, as I have said above, the fact that the opponent's goods have been stocked in numerous of its own well-established stores throughout the UK, and other well-established on-line fashion retailers, in the years leading up to the relevant date suggests that there has, since those magazine advertisements, been continuous exposure of the opponent's mark and goods to the relevant public further to the initial surge of magazine advertisements in 2016. Bearing all of this in mind, I find that the earlier mark is likely, on the balance of probabilities, to have had a reasonable reputation, at the relevant date, in relation to women's sports and fitness clothing.

Link

31) Whether the public will make the required mental 'link' between the opponent's mark and the contested must take account of all relevant factors. The relevant factors identified in Case C-252/07, *Intel* [2009] ETMR 13 are:

The degree of similarity between the conflicting marks

32) The respective marks are identical.

The nature of the goods or services 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

33) The opponent's goods obviously differ in nature, method of use and intended purpose to the applicant's goods and they are neither in competition nor complementary in the sense described in the case law. In terms of the respective trade channels, I do not consider that the opponent's evidence goes so far as establishing that the respective goods typically reach the consumer through the same trade channels. However, it does suggest that there are some online retailers/providers of sporting/outdoor clothing that also sell certain foodstuffs such as nutritional/sports supplements and protein/energy bars¹⁶ such that the respective trade channels of the goods are not entirely distinct. When all relevant factors are considered though, the goods are clearly dissimilar. The relevant public for the respective goods is the same, consisting of members of the general public.

The strength of the earlier mark's reputation

34) The earlier mark is likely to have had a reasonable reputation in relation to 'women's sports and fitness clothing' at the relevant date.

¹⁶ Exhibit NJG12 & NJG13

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

35) PINK SODA is neither descriptive nor allusive in relation to the relevant earlier goods. That said, it is not as distinctive as, say, an invented word with no meaning at all. I consider the mark to have a medium degree of inherent distinctiveness. I find that the inherent degree of distinctiveness is likely to have been elevated to an above-medium degree at the relevant date consequent upon the use made of it.

Whether there is a likelihood of confusion

36) The relevant factors are as follows:

- The respective marks are identical.
- The respective goods are dissimilar.
- Notwithstanding the dissimilarity between the goods, the average consumer of both parties' goods is members of the general public. I would expect at least a medium degree of attention to be paid during the purchase of the opponent's goods given that factors such as size, material, suitability for activity and/or aesthetic appeal is likely to be taken in to account during the purchase. The degree of attention paid to the purchase of the applicant's goods is likely to vary from low to medium given that, although factors such as nutritional value, flavour and ingredients may be factors which are taken into account when purchasing those goods, they are, for the most part, inexpensive and are likely to be purchased frequently and, on occasion, may be subject of an impulse purchase. All of the respective goods are likely to be sought out primarily by eye at retail stores (whether that be online or on the high street) but I do not discount the potential for aural use.
- The earlier mark had an above-medium degree of enhanced distinctiveness and a reasonable reputation in relation to 'women's sports and fitness clothing' at the relevant date.

Weighing all the above factors, and bearing in mind, in particular, the dissimilarity between the respective goods, I find that there is no likelihood of confusion.

Conclusion on link

37) I bear in mind that my finding of no likelihood of confusion does not mean that there can be no link made between the marks. Further, the opponent's pleadings and arguments, although partly based upon a likelihood of confusion, are not clearly limited to a claim of a link based upon confusion only¹⁷. Weighing all the above factors, I find that, when faced with the contested mark on all the contested goods, a significant proportion of the relevant public is likely to bring to mind the opponent's earlier mark. The necessary link is, therefore, established. In reaching this conclusion, I have borne in mind that, whilst the goods at issue are dissimilar, the earlier mark is likely to have had a reasonable reputation at the relevant date, the respective marks are identical and the respective goods will all be aimed at, and purchased by, the same consumer (members of the general public).

38) In reaching this finding, I have not overlooked Ms Lane's submission to the effect that the relevant public is merely likely to see the contested mark as allusive of the flavour or content of its goods rather than bringing to mind the opponent's mark. I accept that that may be the case for a some of the relevant public but I find that for a separate significant proportion of the relevant public (as referred to above), the mark is likely to bring to mind the opponent's identical mark.

Damage

Unfair advantage

39) In my view, the association made with the opponent's identical reputed earlier mark for women's sports and fitness clothing will make the contested mark appear instantly familiar despite the dissimilarity of the respective goods (which, although

¹⁷ See, for example, Statement of Grounds, [10] which makes no mention of a likelihood of confusion and refers to the earlier mark merely being 'brought to mind' and that 'the use of an identical trade mark in relation to [the] contested goods would create an association with the Opponent'.

dissimilar, will be purchased by the same relevant public). This sense of familiarity will draw consumers towards the applicant's goods more readily than if the mark had appeared completely new and unfamiliar which, in turn, is likely to make the relevant public more inclined to purchase the applicant's goods, thereby resulting in the applicant achieving more custom than it would have had if the association with the earlier reputed mark had not been made. As this will come off the back of the opponent's investment that it has made in building the reputation of its mark, and without the applicant expending any money itself in establishing that familiarity in the consumer's mind, I find that this constitutes unfair advantage.

40) Further, and in the alternative, the association made with the opponent's identical reputed earlier mark for women's sports and fitness clothing necessarily brings with it the idea/image of sport and fitness. That being so, the consumer may, for example, more readily believe that the contested foodstuffs are intended to be consumed as part of, or are compatible with, a sporty/fit lifestyle and/or are intended to be consumed before, during or after sporting/fitness activities. This is particularly so, in my view, for foodstuffs such as protein bars and energy bars and the nutritional/dietary supplement type goods in class 5 (which would include sports supplements) for obvious reasons, but the same can be said for all the contested goods. This is likely to make the applicant's various foodstuffs appear more attractive and desirable to the relevant public and, in turn, lead to the applicant gaining more custom than it otherwise would have enjoyed had that association not been made. As this would come without paying any compensation to the opponent, and without the applicant expending the money necessary to create that image itself, I find that this also constitutes unfair advantage.

Other heads of damage

41) I do not consider that either of the other heads of damage are made out. As regards detriment to the distinctive character of the earlier marks, it is difficult to see why that would occur in the absence of a likelihood of confusion. Further, as regards the claim of detriment to the reputation of the earlier marks, this is made on the basis that the applicant may provide poor quality goods, leading to detriment to the earlier marks reputation. This amounts to nothing more than conjecture. There is no

evidence to suggest that the applicant already has a negative reputation for providing poor quality goods or services and there is nothing inherent in the applicant's goods and services that would cause any form of negative reaction.¹⁸

Section 5(4)(a)

42) Section 5(4)(a) states:

“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, or

(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.”

43) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

¹⁸ See *Cristalino* case [2015] EWCH 2760 (Ch) [89-90]; *Unite The Union v The Unite Group Plc* (BL O/219/13) [46-47]

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

Goodwill

44) In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) the Court stated:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

As the applicant has filed no evidence of use of its mark, the relevant date for the assessment of the opponent's claimed goodwill is the filing date of the contested mark, 01 November 2021. I find that the opponent had the requisite goodwill in its business providing women's sports and fitness clothing at the relevant date and that the sign PINK SODA was distinctive of that goodwill.

Misrepresentation

45) In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

"There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

"is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the

public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]"

46) It is trite law that there is no requirement for a common "field of activity" for an action in passing off to succeed: *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. at p. 714. It is clear from the same case, however, that whilst the absence of a common field of activity is not fatal, it remains a relevant factor, though it may be less important where the claimant's sign is a household name. Millet L.J. went on to say:

"Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

'...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual

or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.”.

47) The relevant factors are:

- The respective marks are identical.
- The respective goods are dissimilar. The relevant public is, however, the same, being the members of the general public.
- At least a medium degree of attention is likely to be paid during the purchase of the opponent's goods given that factors such as size, material, suitability for activity and/or aesthetic appeal is likely to be taken into account during the purchase. The degree of attention paid to the purchase of the applicant's goods is likely to vary from low to medium given that, although factors such as nutritional value, flavour and ingredients may be factors which are taken into account when purchasing those goods, they are, for the most part, inexpensive and are likely to be purchased frequently and, on occasion, may be subject of an impulse purchase. All of the respective goods are likely to be sought out primarily by eye, but I do not discount the potential for aural use.
- The opponent had the requisite degree of goodwill at the relevant date in its business providing women's sports and fitness clothing and PINK SODA was distinctive of that goodwill.

I remind myself that it is not enough, under section 5(4)(a), for the contested mark to merely bring the earlier sign to mind or for consumers to merely wonder if there is a connection. There must be an assumption that there is a connection¹⁹. Taking all the above factors together, I do not consider that there would be such an assumption in this case. Although the opponent had the requisite level of goodwill at the relevant date, PINK SODA was distinctive of that goodwill and the marks are identical, the distance between the respective fields of activity is such that I do not consider that a substantial number of the opponent's customers, or potential customers, would be

¹⁹ See *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd* [2007] RPC 5 at paragraphs 16–17 of the judgment of Jacob L.J.

deceived into purchasing the applicant's goods in the belief that they are the responsibility of the opponent. Accordingly, misrepresentation is not made out and there can, therefore, be no damage.

48) In reaching this conclusion, I have, again, borne in mind the opponent's evidence which is intended to show that both parties' goods are sold through the same online retailers. However, as I stated earlier, this evidence does not go so far as establishing that such a practice is typical or that this is an established practice in the minds of the relevant public. The evidence does not satisfy me that the relevant public would be misled into believing that the opponent is responsible for the quality of the applicant's goods. **The opposition under section 5(4)(a) of the Act fails.**

OUTCOME

49) **The opposition has succeeded under section 5(3) of the Act.**

COSTS

50) The opponent has been successful and is entitled to an award of costs. Using the guidance in Tribunal Practice Notice 2/2016, I award the opponent costs on the following basis:

Preparing a statement and considering the other side's statement	£300
Official fee (Form TM7)	£200
Preparing, and filing, evidence	£600
Preparing for, and attending, the hearing	£500
Total:	£1600

51) I order AT Innovations (Scotland) LLP to pay JD Sports Fashion Plc the sum of **£1600**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of May 2024

**Beverley Hedley
For the Registrar,
the Comptroller-General**