

O/0635/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003714711

BY INDOOR SPORT SERVICES LIMITED

IN CLASSES 20, 27, 28 AND 35

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 431103

BY BLINDSIDE GROUP PTY LTD

AND IN THE MATTER OF REGISTRATION NO. UK00003677682

IN THE NAME OF BLINDSIDE GROUP PTY LTD

IN CLASSES 27 AND 28

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO. 504621

BY INDOOR SPORT SERVICES LIMITED

BACKGROUND AND PLEADINGS

1. On 27 October 2021, Indoor Sport Services Limited (“ISS”) applied to register the following trade marks, in the UK:



(UKTM(A) no. 3714711) (“the 711 Mark”)
(series of 2)

2. The 711 Mark was initially published for opposition purposes on 19 November 2021 and, following amendments, was re-published on 14 January 2022. Registration is sought for the goods and services shown in the Annex to this decision.

3. On 16 February 2022, the application to register the 711 Mark was opposed by Blindside Group Pty Ltd (“Blindside”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Blindside relies upon the following trade mark:



UKTM no. 3677682 (“the 682 Mark”)

Filing date 5 August 2021; registration date 21 January 2022

Relying on all goods and services for which the mark is registered, namely:

Class 27 Padded mats, crash mats; covers for mats.

Class 28 Gymnastic and sporting articles; machines for physical exercise;
exercise equipment (other than for medical rehabilitative

purposes); exercise equipment, namely, boxing machines; exercise bikes; rowing machines; fitness exercise cable machines; pin-loaded fitness machines; plate-loaded fitness machines; fitness exercise rigs, cages and freestanding cells adapted for use with barbells and weights, attachments and components thereof; grips and other attachments for use as part of machines for physical exercise; physical fitness equipment, namely, exercise bands, dumb bells, kettle bells, sandbags, medicine balls, wall balls, slam balls, throw bags, battle ropes, push sleds, pull sleds, portable cable trainers, suspension trainers, climbing ropes, weighted vests, plates to insert in weighted vests, training belts, chin up bars, gymnastic grips, gymnastic gloves, gymnastics rings and bars, gymnastics parallel bars, stall walls and parallettes; body training apparatus; exercise weights; exercise weight plates; exercise benches; exercise stands; squat racks and squat stands; barbells; training bars; collars for training bars; pads adapted to fit training bars; weightlifting equipment; weightlifting platforms; storage for weightlifting and exercise equipment; sport balls; jump ropes; skipping ropes; plyometric blocks and boxes; covers for foam blocks; chalk for weightlifting and exercise use.

4. ISS filed a counterstatement denying the grounds of opposition.

5. On 24 February 2022, ISS applied to invalidate the 682 Mark based upon section 47 of the Act. ISS relies upon section 5(4)(a) of the Act.¹ ISS relies upon the following signs:

#AFEUROPE

(“the First Earlier Sign”)

¹ Although section 3(6) was also originally pleaded, this ground was withdrawn on 3 October 2022.



("the Second Earlier Sign")



("the Third Earlier Sign")

6. ISS claims to have used the above signs throughout the UK since November 2014, February 2016 and 2017 respectively in relation to the same goods and services for which the 711 Mark is applied for. ISS claims that use of the 682 Mark would be contrary to the law of passing off.

7. Blindside filed a counterstatement denying the grounds of invalidation.

8. ISS is represented by Adamson Jones and Blindside is represented by Kilburn & Strode LLP.

9. ISS filed evidence in chief and Blindside filed written submissions. Blindside filed evidence in reply and ISS filed submissions in reply. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

10. ISS filed evidence in chief in the form of the witness statement of Max Wilson dated 28 September 2022, which is accompanied by 15 exhibits. Mr Wilson does not state what position he holds within ISS, but states that the evidence given comes from his own knowledge resulting from five years of experience within the company or the records of the company, and that he is duly authorised to give evidence on ISS's behalf.

11. Blindside filed submissions during the evidence rounds dated 3 October 2022.

12. Blindside filed evidence in reply in the form of the witness statement of Peter Georgiou dated 7 February 2023, which is accompanied by 6 exhibits. Mr Georgiou is the General Manager of Blindside, a position he has held since 15 November 2021.

13. ISS filed submissions in reply dated 7 February 2023.

14. Both parties filed submissions in lieu dated 13 March 2023.

RELEVANCE OF EU LAW

15. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

16. As the sole earlier right relied upon in the opposition is the subject of the invalidation action, I will begin by assessing the invalidation brought by ISS.

The Invalidation

17. Section 5(4)(a) has application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) [...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

18. Section 5(4)(a) states as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

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.”

19. Subsection (4A) of Section 5 states:

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

20. 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.

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).”

Relevant date

21. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander KC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

22. Although Blindsight claims to have used the 682 Mark in the UK since 2014 in relation to clothing, as those goods are not covered by its specification, this does not establish an earlier relevant date. It is clear from Blindsight’s evidence that it also produces sports equipment. However, as submitted by ISS, it is not clear that this use is in the UK (Blindsight is Australia-based and goods are offered for sale in dollars) and it is not clear to me that, if any of this use was in the UK, when it commenced. Consequently, the only relevant date for the purposes of the section 5(4)(a) is the date of application for the 682 Mark i.e. 5 August 2021.

Goodwill

23. In *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), goodwill was described in the following terms:

“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.”

24. Mr Wilson gives evidence of the following approximate sales figures for ISS’s goods in classes 20, 27 and 28:

Year	Sales (£)
2014	19,000.00
2015	11,700.00
2018	78,900.00
2019	83,000.00
2020	566,000.00
2021 (up to 04/08/21)	715,700.00

25. These figures are supported by invoices which show sales made by ISS (under its trading name AGAIN FASTER).² There have clearly been consistent sales of sporting goods to customers across the UK (in locations such as Northern Ireland and Surrey). In my view, the opponent has a small, but protectable, goodwill in relation to sports equipment. However, the question is whether the signs relied upon have become distinctive of that goodwill. The majority of the evidence refers to ISS trading under the sign AGAIN FASTER, which is not relied upon for the purposes of these proceedings. The use of the sign AF (in any form) is more limited. However, there is evidence of the signs being used on social media in relation to various types of sporting equipment.³ For example, as early as 2014, the Third Earlier Sign was being used on ISS's social media pages and the Second Earlier Mark was being used from as early as 2016.⁴ I note that Blindside submits that the social media posts are from an account called AGAIN FASTER EUROPE and so may not be directed at the UK. However, a number of them make reference to events taking place in the UK and a number of the hashtags also refer to the UK. There is also evidence of the letters AF being used in product descriptions of invoices for goods including ropes, balls, resistance bands, barbells, kettlebells and wooden rings. Whilst the word only AF is not relied upon, given that the dominant and distinctive elements of the Second and Third Earlier Marks are the letters AF, I consider this to be use upon which ISS can rely. Taking the evidence as a whole into account, I am satisfied that the Second and Third Earlier Signs had become distinctive of ISS's goodwill at the relevant date. Given that the First Earlier Sign is clearly less similar to the 682 Mark than the Second and Third Earlier signs, I need not consider it any further.

² Exhibit MW001

³ Exhibit MW008

⁴ Exhibit MW005 and Exhibit MW007

Misrepresentation

26. 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]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

27. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

28. Accordingly, once it has been established that the party relying on the existence of an earlier right under section 5(4)(a) had sufficient goodwill at the relevant date to found a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

29. ISS has a small, but protectable, goodwill in relation to sporting equipment. This is the same field of activity as the class 28 goods of the 682 Mark and will overlap with the class 27 goods, which are likely to be used alongside sporting equipment in gyms. The Second and Third Earlier Signs overlap with the 682 Mark on the basis that they all consist of the letters AF. They differ in their stylisation/font. In my view, they are highly similar. There is no suggestion that Blindside adopted the 682 Mark with the intention of deceiving the public. However, it is not necessary for the misrepresentation to be deliberate. The relevant public will be members of the general public and professional users (such as personal trainers) who will pay a medium (or average) degree of attention during the selection process. Taking all of these factors into account, I consider that there is a likelihood that a substantial number of ISS's customers and potential customers will be deceived into believing that the goods of Blindside originate from ISS.

Damage

30. In circumstances where the parties trade in the same or overlapping fields of activity, damage will be readily inferred where misrepresentation is established. In this

case, damage through diversion of sales and/or loss of control of reputation is easily foreseeable.

31. The application for invalidation against the 682 Mark succeeds in its entirety.

The Opposition

32. As the 682 Mark is the sole basis for the opposition, and that mark has been deemed invalid in its entirety, the opposition fails.

CONCLUSION

33. The application for invalidation against UKTM no. 3677682 succeeds in its entirety.

34. The opposition against UKTM(A) no. 3714711 is unsuccessful and the application may proceed to registration.

COSTS

35. ISS has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award ISS the sum of **£2,050**, calculated as follows:

Preparing a Notice of invalidation, considering Blindside's counterstatement, and preparing a counterstatement in the opposition	£500
Preparing and filing evidence and considering Blindside's evidence	£900
Written submissions	£450
Official fee for invalidation	£200

Total

£2,050

36. I therefore order Blindsight Group Pty Ltd to pay Indoor Sport Services Limited the sum of **£2,050**. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 4th day of July 2023

S WILSON

For the Registrar

ANNEX

Class 20

Storage racks; storage units (furniture); hanging storage racks; mobile storage racks; storage racks for physical fitness equipment; storage racks for exercise weights.

Class 27

Gymnasium exercise mats; Floor coverings [mats] for use in sporting activities; exercise mats.

Class 28

Sporting articles and equipment; gymnastic articles and equipment; sports training apparatus; body-training apparatus; pullup bar; kettlebells; barbells; exercise weights; resistance bands; climbing ropes for gymnastic purposes; jump ropes; bumper plates; plyo boxes; games and playthings; gymnastic and sporting articles not included in other classes; fitness apparatus; wrist and ankle weights for exercise; dumb-bells [for weight lifting]; weight plates; weight training apparatus [other than for medical use]; weight benches; belts for weightlifting; grip balls in the nature of rubber ball for hand exercise; skipping ropes; grips for the handles of sporting articles; benches for gymnastic use; rings for gymnastics; exercise balls, weightlifting plates, weightlifting bars, weightlifting benches, weightlifting stands and supports, gymnastic suspension straps, elastic resistance bands, medicine balls, step boxes, jump boxes, stability balls, weight vests, squat stands, weightlifting racks, cable racks, power racks; resistance training machines, paralettes, foam rollers, hurdles, agility ladders, exercise ropes, track sleds; sports training apparatus, namely, rowing machines, running machines, treadmills, stationary exercise bicycles; back support for weightlifters.

Class 35

Retail services and on-line retail services connected with storage racks, storage units (furniture), hanging storage racks, mobile storage racks, storage racks for physical fitness equipment, storage racks for exercise weights; Retail services and on-line retail services connected with sporting articles and equipment, gymnastic apparatus and equipment, body rehabilitation apparatus, body-training apparatus, body-building apparatus, body toner apparatus [exercise] and exercise apparatus and equipment.