

**O/0700/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION  
NO. WO0000001631210 IN THE NAME  
OF OSCULATI S.R.L.  
FOR THE FOLLOWING TRADE MARK:**



**IN CLASSES 6, 9, 11, 12 & 25**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 432252 BY  
OLYMP BEZNER KG**

## BACKGROUND AND PLEADINGS

1. OSCULATI S.R.L. (“the applicant”) is the holder of the International Registration shown on the cover page of this decision (“the IR”). The IR was registered on 16 August 2021 and, with effect from the same date, the applicant designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR is derived from the applicant’s Italian trade mark, being that numbered 302021000103424, and enjoys a priority date of 1 June 2021. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 31 December 2021 in respect of the goods set out in the **Annex** to this decision.
2. On 28 March 2022, OLYMP Bezner KG (“the opponent”) partially opposed the application. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is aimed at the class 25 goods of the application only and is reliant upon the following UK trade mark:



UK registration no: 904752101<sup>1</sup>

Filing date 27 October 2005; registration date 27 July 2007

Relying on all goods, namely:

Class 25:           Shirts, blouses, collars, pyjamas, night shirts, neckties, knitwear, in particular pullovers, cardigans; polo shirts, T-shirts, socks, belts.

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<sup>1</sup> The opponent’s marks is a comparable trade mark based on a pre-existing EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs.

3. The opponent claims that the IR is similar to its earlier mark and is to be registered for goods that are identical and/or similar to the goods of the earlier mark. As a result, the opponent claims that there exists a likelihood of confusion, including the likelihood of association.
4. The applicant filed a counterstatement wherein it accepted identity/similarity between some goods, however, it denied that the marks are similar and also denied there was a likelihood of confusion between the marks. The applicant also put the opponent to proof of use in relation to the goods relied upon.
5. The opponent is represented by Withers & Rogers LLP and the applicant is represented by Forresters IP LLP. Only the opponent filed evidence in chief. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
6. 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 on 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.

## **EVIDENCE**

7. The opponent's evidence came in the form of the witness statement of Mr Mark Bezner dated 2 December 2022. Mr Bezner is the managing director of the opponent, a position he has held for more than 15 years. Mr Bezner's statement is accompanied by three exhibits.
8. I do not intend to summarise the evidence or submissions of the parties at this stage but will, where necessary, address them below.

## DECISION

### Proof of use

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. The relevant statutory provisions are as follows:

“Section 6A

“(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.”

11. When comparable marks are put to proof of use, 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”.

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

“100. 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.”

13. Given its filing date, the opponent’s mark qualifies as an earlier trade mark under the above provisions. It was registered more than five years prior to the priority date of the IR meaning and, as set out above, the applicant made a request that the opponent provide proof of use for its mark. As such, the opponent’s mark is subject to the proof of use assessment in respect of the goods relied upon.

14. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), 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], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

15. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent's mark is the 5-year period ending with the priority date of the IR, being 1 June 2021. Therefore, the relevant period for this assessment is 2 June 2016 to 1 June 2021.

16. The opponent's mark is a comparable mark based upon an earlier EUTM, which means that use of the mark in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the present assessment.<sup>2</sup> Therefore, the relevant territory for this assessment between 31 May 2016 and 31 December 2020 is the EU, however, from 1 January 2021 to 1 June 2021, the relevant territory is the UK only. On this point, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union ("CJEU") noted that:

"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."

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<sup>2</sup> See paragraph 4 of Tribunal Practice Notice 2/2020

17. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”<sup>3</sup> because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

### Sufficient Use

18. The opponent’s evidence sets out that it has been using its mark for more than ten years in Germany and the UK for men’s shirts, amongst other things. Mr Bezner confirms in his evidence that the opponent uses the company’s ‘OLYMP’ logo as well as the mark relied upon on each of the shirt that it distributes.

19. Sales figures for both Germany and the UK are provided for the years 2011 to 2021. Mr Bezner states that these figures relate to men’s shirts sold under the mark relied upon. While the only years that are relevant to this assessment are 2016 to 2021, I will reproduce them all on the basis that the earlier years may still be relevant to this decision in the event that I am required to consider enhanced distinctiveness below.

20. The sales figures are as follows (with the turnover provided in pounds):

| <b>Year</b> | <b>Germany</b>                           | <b>UK (£)</b>                        |
|-------------|--|--------------------------------------|
| <b>2011</b> | Units: 3,900,000<br>Turnover: 59,000,000 | Units: 66,000<br>Turnover: 1,200,000 |
| <b>2012</b> | Units: 4,100,000<br>Turnover: 60,000,000 | Units: 67,000<br>Turnover: 1,400,000 |
| <b>2013</b> | Units: 4,400,000<br>Turnover: 68,000,000 | Units: 67,000<br>Turnover: 1,400,000 |
| <b>2014</b> | Units: 4,900,000<br>Turnover: 74,000,000 | Units: 87,000<br>Turnover: 1,800,000 |
| <b>2015</b> | Units: 5,000,000                         | Units: 92,000                        |

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<sup>3</sup> *Jumpman* BL O/222/16

|               |  |  |
|---------------|--|--|
|               | Turnover: 66,000,000                                     | Turnover: 2,000,000                                  |
| <b>2016</b>   | Units: 5,300,000<br>Turnover: 89,000,000                 | Units: 86,000<br>Turnover: 2,000,000                 |
| <b>2017</b>   | Units: 5,600,000<br>Turnover: 99,000,000                 | Units: 74,000<br>Turnover: 1,700,000                 |
| <b>2018</b>   | Units: 5,600,000<br>Turnover: 100,000,000                | Units: 69,000<br>Turnover: 1,700,000                 |
| <b>2019</b>   | Units: 6,000,000<br>Turnover: 106,000,000                | Units: 62,000<br>Turnover: 1,500,000                 |
| <b>2020</b>   | Units: 5,400,000<br>Turnover: 85,000,000                 | Units: 45,000<br>Turnover: 1,100,000                 |
| <b>2021</b>   | Units: 4,000,000<br>Turnover: 64,000,000                 | Units: 36,000<br>Turnover: 1,000,000                 |
| <b>Total:</b> | <b>Units: 52,200,000</b><br><b>Turnover: 870,000,000</b> | <b>Units: 751,000</b><br><b>Turnover: 16,800,000</b> |

21. In respect of the relevant period, I note that the turnover figures represent 31.9 million sales in Germany for a turnover of £543 million and 372,000 sales in the UK for a turnover of £9 million. On this point, I note that the relevant period begins in June 2016 and ends in June 2021 meaning that the sales and turnover for each of those years inevitably include turnover from outside of the relevant period. I have no way to determine the precise figures of those years relevant to this assessment but this is a point I shall bear in mind going forward.

22. In support of the turnover figures, I note that Mr Bezner has provided a range of sample invoices.<sup>4</sup> I note that there are approximately 280 pages worth of invoices with some relating to sales in Germany and the remainder relating to the UK. Of these invoices, I note that they cover a range of cities in Germany such as Berlin, Köln and Hamburg and a wide range of locations in the UK such as Preston, Carlisle, York, Elgin, Solihull, Sheffield, Isle of Man, Wolverhampton, Oxford, Surrey, Kent, Essex, Northampton, Dorset, Ipswich and Ruthin. I note that the

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<sup>4</sup> Exhibit 1

invoices covering sales in Germany are in German and have not been translated. On this point, I note that in its written submissions, the opponent has provided translations for some of the terms but this is not, in my view, acceptable. On this point, I refer to paragraph 4.8.4.2 of the Tribunal section of the Trade Marks manual which states that:

“Exhibits must similarly be translated if they are to be relied upon (Pollini BL O/146/02). The translator should prepare their own witness statement, statutory declaration or affidavit stating that they are (at least) familiar with English and the other language. As an exhibit to the declaration, the translator should file copies of the foreign declaration and its translation.”

23. As this has not been done in the present case, I am not willing to accept the translation provided in written submissions by the opponent's representative. As such, I am unable to determine what these invoices cover. Having said that, I note that the UK invoices show that a majority of the sales associated with them cover shirts. In addition, I note that there are invoices that include the sale of ties, pullover, cardigans and slipovers (being categorised as knitwear).

24. Examples of how the opponent's mark is displayed on the goods sold is provided via photographs showing the presence of the mark on the cuff or chest pocket of the shirt.<sup>5</sup> The examples provided are only limited in that they show examples on just two shirts but the narrative evidence of Mr Bezner confirms that these are just examples. Further, I note that the photographs are undated, however, Mr Bezner confirms that this practice was in place during the relevant period.

25. A number of the opponent's 'look books' are provided for the years 2011 to 2021.<sup>6</sup> Mr Bezner confirms that these are distributed in Germany and the UK. Of the images provided, I note that the opponent has sought to highlight the branding on the shirts and while this is noted, the images are not particularly clear as the mark appears to be included as a stitching or an embroidered embellishment. The look

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<sup>5</sup> Exhibit 2

<sup>6</sup> Exhibit 3

books appear to focus on shirts but includes some images of blazers and waistcoats.

26. I note that the applicant has filed submissions stating that the opponent's evidence of use is insufficient. In making its submissions, I note that the applicant points out that the opponent's invoices show the 'OLYMP' mark and not the mark as registered. Further, the applicant argues that the opponent has not explained what each item listed in the invoices mean and that it is not clear how the goods sold via the invoices show the mark as registered. While these criticisms are noted, I note that the UK based invoices include descriptions of the goods in English and, as I have explained above, these cover the sales of shirts, ties, pullovers, cardigans and slipovers. Further, the opponent's evidence explains that the goods sold during the relevant period included the mark as registered on either the cuff or the shirt pocket. While only limited examples have been shown demonstrating this, the evidence was not directly challenged during the evidence rounds and, as it was accompanied by a statement of truth, I have no reason to disbelieve the evidence before me. As for the prevalence of the mark at issue on the goods, I do appreciate that it is presented in a discreet manner, however, when selecting such goods, I consider that it will be still noticed by average consumers and will, therefore, be seen as an acceptable badge of origin. On this point, I am of the view that it is common in the trade for clothing items such as shirts to be embellished in this way (i.e. a small, embroidered logo) and, as a result, I consider that such an embellishment is capable of being an indicator of origin. In making this finding, I bear in mind that my knowledge of such an issue may not be more widespread than it is, however, I do not consider that this is a point that will be subject to any serious dispute.<sup>7</sup>

27. The applicant goes on to argue that the market at issue is about £80 to £100 billion and that the opponent has made no attempt to show that it has created or maintained a market share of the industry in relation to the goods at issue. While noted, I do not agree. There is no evidence before me regarding the size of the

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<sup>7</sup> *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08

market and while I appreciate that it is an enormous one across the EU at large and even in the UK alone, I do not consider this to be a particular issue for the opponent. The turnover figures for the relevant period are significant (£543 million in Germany and £9 million in the UK) and while this may not be large in comparison to the market at issue, I remind myself that for use to be genuine, it does not need to be quantitatively significant. On this point, I also remind myself that the use must be more than merely token and the evidence before me is, clearly, not token. Further, I bear in mind the nature of the market at issue in that, not only is it an enormous market, but a very competitive one. The scale and frequency of the use is clearly such that it demonstrates that the opponent operates a large business (especially in Germany) and the evidence covers the entirety of the relevant period. In terms of geographical spread, I note that the evidence covers a significant part of the relevant territory in that the invoices provided show sales across a broad part of both the UK at large and Germany at large.

28. Taking all of the above into account, I have no hesitation to find that the opponent has provided evidence that it has genuinely used its mark throughout the relevant territory in the relevant period. That being said, I agree with the applicant in that the evidence clearly does not cover use of all of the goods that are relied upon. I will, therefore, proceed to consider a fair specification of the mark at issue.

29. I remind myself that the opponent's goods are as follows:

Class 25:           Shirts, blouses, collars, pyjamas, night shirts, neckties, knitwear, in particular pullovers, cardigans; polo shirts, T-shirts, socks, belts.

30. Given the focus of the evidence on shirts, I am content to accept that the opponent has provided genuine use for "shirts". The opponent may, therefore, proceed to rely on these goods in this opposition. As for the remaining goods, it appears to me that the opponent does not specifically claim that it has provided sufficient evidence for any goods aside from "shirts". On this point, I note that, at paragraph 14 of its submissions, the opponent "submits that it has demonstrated use in respect of

shirts” and, further, at paragraph 16, the opponent “relies upon ‘shirts’ for which it has shown genuine use.” In light of this, I am content to proceed on the basis that this is an acceptable concession from the opponent that it hasn’t demonstrated use for the remaining goods and, as such, no longer seeks to rely on them. In the event that I am wrong to proceed on this basis, I will briefly discuss the remaining goods.

31. Firstly, I have nothing before in respect of the terms “blouses, collars, pyjamas, night shirts” and “polo shirts, T-shirts, socks, belts”. As a result, the opponent has not provided genuine use in respect of these goods and is, therefore, not permitted to rely on them for the purposes of this decision.

32. This leaves me with the remaining goods, being “neckties, knitwear, in particular pullovers, cardigans”. The turnover and sales that the opponent has provided expressly relate to shirts and, as such, I am not willing to accept that the turnover figures provided cover the sale of such goods. As a result, the only evidence I have before me relating to these goods are the invoices provided. In considering the opponent’s mark in relation to these goods, I note that the examples of how the opponent uses its mark on the goods at issue is only relevant to the shirts sold by the opponent. I have nothing before me to demonstrate how the opponent brands its ties or knitwear. On this point, I note that, as rightly pointed out by the applicant, the invoices show the opponent’s OLYMP’ mark only and, without any examples of the opponent’s use of the mark relied upon on these goods, I am not willing to infer that they are branded with the opponent’s mark in the same way that its shirts are. Even if I were, the opponent has not sought to provide any turnover in relation to these goods and I remind myself that there are approximately 280 pages worth of invoices. On this point, I refer to the case of *Awareness Limited v Plymouth City Council*, Case BL O/236/13, wherein Mr Daniel Alexander Q.C., sitting as the Appointed Person, stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the

more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

33. In light of the case law cited above and Section 100 of the Act, it is my view that it is for the opponent to provide sufficiently solid evidence of use. In the present case, I consider that the opponent could have provided turnover or sales figures for such goods and evidence as to how the mark at issue is used on the same with relative ease. Further, it is my view it would have been reasonable for the opponent to have done so. Without evidence to this effect, I do not consider it appropriate (or fair to the applicant) for me to simply take the invoice evidence as (1) covering goods

branded with the opponent's mark and (2) demonstrative of a level of use consistent with genuine use. As such, I do not accept that the evidence before me is sufficient to demonstrate genuine use of "neckties, knitwear, in particular pullovers, cardigans"

34. For the avoidance of doubt, in light of either (1) the submissions of the opponent or (2) my findings above, the opposition proceeds in reliance upon "shirts" in the opponent's mark's specification only.

### **Section 5(2)(b): legislation and case law**

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

"(2) A trade mark shall not be registered if because-

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood or association with the earlier trade mark."

36. Section 5A of the Act states as follows:

"Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

37. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*

*Inc, Case C-39/97, Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. Case C-342/97, Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM"), Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P:*

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

**Comparison of goods**

38.As a result of my genuine use assessment of the opponent’s mark, the competing goods are as follows:

| The opponent’s goods       | The applicant’s goods  |
|----------------------------|--|
| <u>Class 25</u><br>Shirts. | <u>Class 25</u><br>Jackets [clothing]; sports jackets; rainproof jackets; warm-up jackets; light-reflecting jackets; fishermen's jackets; combinations [clothing]; coveralls; wet suits for water-skiing; rain boots; waterproof boots for fishing; gloves [clothing]; fingerless gloves; jerseys [clothing]; maillots; sleeveless |

|  |  |
|--|--|
|  | jerseys; baselayer tops; berets; deck shoes. |
|--|--|

39. When making the comparison assessing the similarity of the goods, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“[...] Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

40. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

41. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods (though it equally applies to services) are not worded identically, they can still be considered identical if the goods specified in the contested trade mark application are included in a more general category covered by a term under the earlier mark (or vice versa).

42. I have submissions from both parties regarding the comparison of the goods at issue. I have taken these submissions into account and while I do not intend to reproduce those here, I do wish to discuss the applicant's position. I note that its counterstatement made admissions in respect of identity between some of the goods at issue, namely that "jerseys [clothing]" and "sleeveless jerseys" in the applicant's specification were identical to "pullovers" in the opponent's specification and that "jackets [clothing]" in the applicant's specification was similar to the goods covered by the opponent's mark. In light of the fair specification assessment above, the first admission falls away. However, given the broad nature of the second, it can be said that this admission includes a comparison of "shirts" in the opponent's specification so is still applicable. While noted, there is no indication as to what level of similarity exists and I must, therefore, conduct a comparison in the ordinary way.

43. In addition, I note that the applicant's submissions make no reference to the aforementioned admissions and set out that the goods are dissimilar. While the submissions go on to discuss the dissimilarity between some goods, they are silent in respect of others. For the avoidance of doubt, where the applicant is silent in respect of some goods, I do not consider this as an admission of similarity (save for the aforementioned admission). This is particularly the case given that the submissions are clear in that they argue dissimilarity of the goods at issue. As was the case above, I will proceed to consider the goods comparison in the ordinary way.

44. It is my understanding that "combinations [clothing]" in the applicant's specification covers a one-piece undergarment that combines both a top and a bottom in one piece. It is my view that such goods are similar to the opponent's on the basis that

they overlap in user and trade channels. This is because the goods will be selected by members of the general public and are likely to be sold via the same retailers (albeit not in close proximity to one another) and produced by the same undertakings. There is some overlap in method of use in that the goods are worn on the human body but I am of the view that any overlap here is superficial given the different nature and purposes of the goods at issue. Lastly, the goods are neither in competition nor are they complementary. Overall, I consider that these goods are similar to a low degree.

45. “Jerseys [clothing]”, “Sleeveless jerseys” and “baselayer tops” in the applicant’s specification are, in my view, similar to the opponent’s goods. This is on the basis that while the nature of the goods is likely to differ, they do overlap in method of use somewhat in that they are goods worn on the human body. Further, the purpose is also likely to overlap in that they are goods that will be worn for decorative or stylistic purposes (although I do appreciate that they will be worn to protect the user from the elements, however this is, in my view, a secondary purpose). Further, the users and trade channels are likely to overlap in that the goods are all likely to be bought by members of the general public at large and are likely to be produced by the same undertakings and made available via the same retailers. The goods are not in competition and neither are they complementary. Taking all of this into account, I consider that these goods are similar to an above medium degree.

46. “Jackets [clothing]”, “sports jackets”, “rainproof jackets” and “warm-up jackets” in the applicant’s specification are similar to the opponent’s goods in that they overlap in user and trade channels. This is on the basis that the goods will be selected by the same members of the general public and will likely to be produced by the same undertakings and sold via the same retailers where they are likely to be found near each other in the same sections. As for the remaining factors, I appreciate that the goods are worn on the user’s body meaning that there is a small degree of overlap in method of use and that, at their core, the purposes will overlap to some degree as both can be said to be worn to protect the user from the elements. That being said, the goods of the applicant are to protect the user from more extreme elements

(such as rain or cold weather) whereas the opponent's are not. As a result, I consider that any overlap in purpose is somewhat superficial. I find that the goods do not overlap in nature as, while clothing goods, they will commonly be made from different materials. Lastly, the goods are not competitive and neither are they complementary in nature. As a result, I consider that these goods are similar to a medium degree.

47. In my view, "light-reflecting jackets", "fishermen's jackets" and "coveralls" are specialist clothing goods that are worn by a specific user base for specific purposes, being to reflect light for safety reasons or to provide substantial waterproofing benefits. I do not consider that the purpose of these goods overlaps with the opponent's goods as, already stated, these goods have specific purposes that are different from the opponent's "shirts". I appreciate that users of the applicant's goods may also wear shirts and, as a result, there will inevitably be an overlap in user. However, I consider that any overlap in user is superficial given the broad nature of the user base for "shirts" and the limited user base of the applicant's goods. As for the nature of these goods, I consider that this differs as they will be made of different materials. In respect of method of use, I appreciate that the goods will be worn on the body but the applicant's goods will commonly be worn as outer layers on top of the user's actual clothing meaning that any overlap here is superficial. Lastly, I do not consider that the applicant's goods will be produced by the same producers as the opponent's goods and neither will the goods be available via the same retailers. On this point, I note that I have nothing before me to suggest otherwise. Taking all of this into account, I consider that these goods are dissimilar.

48. Save for being classified as clothing goods, I see no obvious reason why "wet suits for water-skiing" in the applicant's specification would share any overlap in nature, method of use, purpose or trade channels with the opponent's goods. As was the case in the preceding paragraph, there is some overlap in user but this alone is not sufficient to give rise to a finding that there is any degree of similarity between the goods. As a result, I consider that these goods are dissimilar.

49. “Waterproof boots for fishing” and “rain boots” in the applicant’s specification have distinct natures, methods of use and purpose when compared to the opponent’s goods. As for trade channels, I have nothing before me to suggest that a producer of shirts will also produce waterproof boots for fishing or general rain boots, or vice versa. Further, even if the goods are sold via the same retailers, they will not be in close proximity or found in the same sections as one another. As a result, I do not consider that these goods overlap in trade channels. While I appreciate that there may be some overlap in user for these goods, I do not consider that this alone is sufficient to warrant a finding of similarity between them. As a result, I find that these goods are dissimilar.

50. “Gloves [clothing]”, “fingerless gloves” and “deck shoes” in the applicant’s specification have different natures and methods of use when compared to the opponent’s goods. While there is an overlap in user, the purposes differ. Further, I am of the view that there is an overlap in trade channels as an undertaking that produces and sells shirts is also likely to produce and sell gloves and deck shoes, and vice versa. This is on the basis that these goods are general clothing items and I consider it common in the trade for producers of the opponent’s goods to also produce gloves and shoes. Further, these goods will be available via the same retailers and found in the same sections of larger retailers. That being said, I do appreciate that they are unlikely to be found within close proximity of one another.. Lastly, the goods are neither competitive in nature or complementary. Taking all of this into account, I am of the view that these goods are similar to a low degree.

51. It is my understanding that “maillots” in the applicant’s specification are female swimsuits and aside from being an item of clothing, I see no obvious reason as to why there will be any overlap in nature, method of use or purpose. As for trade channels, I appreciate that some undertakings may produce and sell both goods but I have nothing before me to suggest that it is common in the trade and without anything further, I am not willing to infer as such. There is likely to be an overlap in user but, as I have found throughout this decision, this alone is not enough to give rise to a finding that these goods are similar to any sufficient degree. As a result, I find that these goods are dissimilar.

52. “Berets” in the applicant’s specification covers a type of hat and aside from an overlap in user, I have nothing before me to suggest that any of the remaining factors overlap. As such, I find that these goods are dissimilar.

53. As some degree of similarity between goods is necessary to engage the test for likelihood of confusion, the opposition aimed against those goods that I have found to be dissimilar will fail.<sup>8</sup> However, the opposition against the remaining goods may proceed. For the avoidance of doubt, the dissimilar goods (being those against which the opposition now fails) are as follows:

Class 25: Light-reflecting jackets; fishermen’s jackets; coveralls; wet suits for water-skiing; rain boots; waterproof boots for fishing; maillots; berets.

### **The average consumer and the nature of the purchasing act**

54. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods . I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words

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<sup>8</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

55. While the opponent submits that the goods at issue will be purchased by the general public and that the purchasing act will be a visual one, the applicant has remained silent on this point. Given that the goods at issue at class 25 clothing goods, I agree with the opponent’s submissions that the average consumer for the goods at issue will be members of the general public at large. The goods at issue will be available via general retail stores and their online equivalents. In physical stores, the goods will be displayed on racks or shelves and self-selected by the consumer. A similar process will apply to selections made on websites in that the goods will be selected by the consumer after having viewed an image on a webpage. As such, I also agree with the opponent regarding the visual aspect being the dominant aspect of the selection process. That being said, I do not discount the aural component playing a role by way of word of mouth recommendations or after discussions with sales persons.

56. The opponent submits that because some of the goods are more specialist (fishermen’s jackets, for example) than others (jackets, for example) the level of frequency of purchase will differ. While noted, these submissions focus on those goods that are no longer at issue as I have found them to be dissimilar. As a result, the submissions in respect of those goods are not relevant here. Given that the goods that remain at issue are general clothing goods, I am of the view that they will be selected on a relevantly frequent basis. As for the price of the goods at issue, this may vary from cheap clothing items such as sleeveless jerseys to more expensive ones like jackets, for example. That being said, even where the goods are of a higher cost, they are not likely to be considerably more expensive. Regardless of the cost and frequency of the goods, I consider that a number of the same factors will be considered by the average consumer during the purchasing process. For example, the consumer may consider current fashion trends, material used, quality and suitability. With this in mind, I consider that the average consumer will pay a medium degree of attention during the purchasing process.

## Comparison of the marks



57. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

58. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

59. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

60. The respective trade marks are shown below:

| The opponent's mark   | The IR   |
|---|--|
|  |  |

61. I have submissions from both parties in respect of the similarity of the marks at issue. Before proceeding, I wish to point out one issue raised by the applicant in its submissions and that is, at paragraphs 14 and 16, the applicant states that:

“14. It is submitted that the marks have neither aural nor conceptual similarities.

15. Indeed, the opponent appears to make the same assertion in paragraph 26 of its written submissions dated 14 April 2023:

“Should the consumers perceive the marks as pure device marks, they have neither aural nor conceptual characteristics”.

16. We agree with the Opponent in that we consider that the marks are pure device marks and as such there is no aural or conceptual similarity.”

62. This submission is, put simply, not reflective of the opponent’s position. The opponent’s primary position appears to me that both marks consist of stylised letter ‘O’s’ and the submissions mentioned by the applicant above is, instead, a fallback position offered by the opponent in the event that the consumers do not perceive the marks as letter ‘O’s’. As for the remainder of the submissions from both parties, I do not intend to reproduce them here but, for the avoidance of doubt, confirm that I have given them due consideration in making the following assessment.

### Overall Impression

#### *The IR*

63. In its entry on the trade mark register, it is clear that the intention of the applicant is that the IR is meant to be a figurative letter ‘O’. While that may be the intention, I do not consider that it is necessarily the case that all average consumers will see it as such. That being said, I do accept that at least a significant proportion of consumers will see it this way. This is on the basis that average consumers, when confronted with the IR will notice that it looks like a letter ‘O’ and, in the absence of

any other element that points away from this impression, they will associate it as such. On this point, I remind myself of the case of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41. In that case, Kitchin LJ set out that if a court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court, then it may properly find infringement. While that case related to an infringement case, it applies equally to oppositions under section 5(2)(b) of the Act. In light of the comments of Kitchin LJ, I will proceed on the basis of this impression of the mark and base my assessment on this set of average consumers only. This is on the basis that if I find confusion for this group of consumers, then the position regarding the remaining consumers will be of no consequence.

64. In light of the above, I am of the view that the overall impression of the IR is that it is a figurative representation of the letter 'O' which is split vertically down the middle so that it appears in two equal parts. The first part is presented in blue (and, in accordance with the entry on the trade mark register, is limited to use in this colour only) and the second part is presented in red (again, in accordance with the entry on the trade mark register is limited to use in this colour only). Given that the mark will be viewed as a letter 'O', I do not consider that the impression of either half will outweigh the other and, therefore, find that the overall impression will lie in the IR as a whole.

#### *The opponent's mark*

65. As was the case with the IR, I am of the view that a significant proportion of average consumers will view the mark as a representation of the letter 'O'. While I appreciate that other consumers may not, I will proceed on the basis of the proportion of consumers that will, as I have set out above, if there is confusion for these consumers then that is sufficient to conclude that the opposition is successful. The opponent's mark is split horizontally towards the bottom of the letter 'O' so that it is made up of two unequal elements. Despite their difference in size, I am of the view that neither element will dominate the other as both will still

be seen as contributing to the overall impression of the letter 'O'. The mark is presented in black and, may therefore, be presented in any colour.

### Visual Comparison

66. Both marks will be viewed as a representation of the letter 'O'. The presentation of that letter across the marks shares further points of similarity in that overall shape of the letter is somewhat the same, so too are the thickness of the lines used in each letter. That being said, they differ in the fact that the representations of the letter are split either horizontally or vertically in each mark. Further, the opponent's mark is registered in black and capable of being presented in any colour such as the red or blue used by the applicant. However, while that may be the case, this does not extend to contrived colour splits like the one used by the applicant. Therefore, the marks may not be presented in the same colour combination. While the points of difference are noted, they are not significant enough so that they outweigh the points of similarity. Taking all of this into account, I am of the view that the marks are visually similar to an above medium degree.

### Aural Comparison

67. As both marks will be viewed as representations of the letter 'O', they will be pronounced as such and are, therefore, aurally identical.

### Conceptual Comparison

68. As above, both marks will be perceived as a representation of the letter 'O'. While the actual meaning of what the 'O' stands for may not be known (and there is nothing in either mark that informs such a meaning), the consumer will still immediately grasp a concept from them, i.e. they will both be viewed as the letter 'O'. As a result, I am of the view that the average consumer will attribute the same concept to both marks. Taking this into account, I am of the view that these marks are conceptually identical.

## **Distinctive character of the opponent's mark**

69. 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 I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

70. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. While the opponent has not claimed that its mark has acquired an enhanced degree of distinctiveness, it has filed evidence of use. As a result, it is incumbent on me to consider the opponent's

evidence in relation to enhanced distinctiveness. Before doing so, I will consider the inherent position.

71. The opponent's submissions set out that its mark is not descriptive and is of normal inherent distinctiveness. While the stylisation of the mark will not go unnoticed, the mark will be viewed as a single letter mark. On this point, I remind myself that single letter marks will still be viewed as signs irrespective of the nature of the goods at issue and that the consumers' perception of a mark consisting of a single letter will not be any different from that of a mark comprised of two or more letters.<sup>9</sup> As a result, I agree with the opponent's position in that while the mark may not necessarily be remarkable, it is not descriptive and, as a result, is inherently distinctive to a medium degree.

72. As for the position regarding enhanced distinctiveness, I remind myself that this test is based on the undertaking of the UK consumer. I also remind myself that, as per the evidence summarised at paragraphs 18 to 28 above, the entire sales figures for the UK between 2011 and 2021 stand at 751,000 sales for a total turnover of £16.8 million. On the face of it, over an 11 year period, this is a moderate level of sales but, when compared against the relevant market (being an enormous one), it is low. While I appreciate the geographical spread of use across the UK as a whole, there is nothing further before me regarding any advertising spend or publicity activities that could be said to point towards an enhanced degree of distinctive character. As such, I consider that the evidence before me is insufficient to warrant a finding that the opponent has enhanced the distinctiveness of its mark to a degree higher than that of its inherent position.

### **Likelihood of confusion**

73. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that

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<sup>9</sup> *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co. KG*, Case C-265/09 P

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

74. I have found the parties' goods range from being identical to similar to a low degree.

I have found the average consumer for the goods to be members of the general public who will select the goods at issue via primarily visual means, although I do not discount an aural component playing a part. I have concluded that the level of attention paid by the average consumer when selecting the goods at issue will be medium. I have found that the opponent's marks are inherently distinctive to a medium degree. In respect of the similarity of the marks at issue, I have found that the marks are visually similar to an above medium degree and aurally and conceptually identical.

75. Taking all of the above into account, I am of the view that the average consumer, upon being confronted by the parties' marks, will be unable to accurately recall or remember which mark was which. I find that this is particularly the case when bearing in mind the principle of imperfect recollection. This is on the basis that the impression that either mark will leave in the minds of average consumers is of a figurative representation of the letter 'O'. While there are slight differences in the presentation of the same across the marks, I am of the view that, when attempting to recall the marks, the consumer is likely to misremember which mark was divided by a vertical line and which was divided by a horizontal line. As such, they will be directly confused. As for the differences in colour, I am of the view that the

consumer will not pay sufficient enough attention to the use of colour in either mark to the point that it would result in them using it to recall or remember which mark was which. For example, I do not consider that the impact of the colours used is such that the average consumer will remember which one was presented in a contrived colour split and which one was not. Consequently, I find that there is a likelihood of direct confusion between the marks. Further, when taking into account the interdependency principle, the fact that the marks are sufficient similar on a visual basis but are also identical both aurally and conceptually is sufficient to find that the likelihood of confusion exists even when viewed on goods that are similar to a low degree.

76. For the sake of completeness, I will proceed to consider a likelihood of indirect confusion and am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
  
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
  
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

77. In the event that the differences between the marks are noticed, I consider it likely that the average consumer will believe that the marks are from the same or economically connected undertakings. For example, the average consumer will still consider that both marks are representations of the letter 'O' and, given the similarity in the styles of the letter (in that the lines used are the same thickness and the fact that they are divided in some way), they will consider that they are either alternate marks used by the same or economically linked undertakings or that they are logical indicators that are consistent with the undertaking responsible for the marks going through a re-branding process. Consequently, I consider that there is a likelihood of indirect confusion. Following the same reasoning set out when considering direct confusion above, this finding will apply even in circumstances where the marks are viewed on goods that are similar to a low degree.

## CONCLUSION

78. The opposition has partially succeeded and, subject to any appeal, the IR is refused for the following goods:

Class 25:           Jackets [clothing]; sports jackets; rainproof jackets; warm-up jackets; combinations [clothing]; gloves [clothing]; fingerless gloves; jerseys [clothing]; sleeveless jerseys; baselayer tops; deck shoes.

79. Given that some goods have survived the opposition and that it was only targeted against some goods, the IR may, subject to any appeal, proceed to registration in the UK for the following goods:

Class 6:           Anchor chains of metal; fastening chains in metal; steel chains; cable joints of metal, non-electric; cable connectors of metal, non-electric; cup swivel joints of metal structural joint connectors of metal; clips of metal for cables and pipes; ring-shaped fittings of metal; metal hardware; seals of metal for shock absorbers; boat anchors of metal; towing cables of metal; mooring cables of metal; metal cable tensioners for boats; signposts made of metal; signs, non-luminous and non-mechanical, of metal; mooring bollards of metal; mooring buoys of metal; mooring hooks of metal; trestles of metal, other than furniture; fixing plates of metal; fuel cans of metal; potable water reservoirs of metal; metalware; hooks [metal hardware]; couplings of metal for chains; couplings of metal for tubing; ferrules of metal; metal shackles; metal karabiners; manhole covers of metal; hand railings of metal metallic mountings; duckboards of metal; step stools of metal; flagpoles [structures] of metal.

Class 9:           Adaptors; plug adaptors; converters for electric plugs; socket outlets (electric -); electric connection plugs; connecting plugs

[electric-]; electric plugs; junctions; safety tarpaulins; fuel gauges; divers' masks; gloves for divers; air tanks for use in scuba diving; diving snorkels; loupes for coaxial connectors; navigational buoys; navigational buoys; signalling buoys; cables, electric; adapter cables (electric -); cable splices for electric cables; illuminated signposts for divers; batteries; lithium batteries; converters, electric; electric circuit closers; electrical terminal blocks; acoustic alarms; horns for loudspeakers; signal bells; lifejackets; life-saving rafts; waterproof cases for smart phones; waterproof camera cases; covers for tablet computers; cases for tablet computers; stands adapted for tablet computers; emergency flares; rescue flares; rescue laser signalling flares; transmitters for emitting distress signals; emergency warning lights; escape chutes; emergency signal transmitters; illuminated signposts; signal transmitters; fire extinguishing apparatus; radar apparatus; radar reflecting apparatus; optical finders; marine compasses; telescopes; nautical apparatus and instrument; nautical rescue apparatus and instruments; ampere-hour meters; revolution counters; engine counter; fuel consumption meters; gauges with digital readout; oil level indicators; quantity indicators; temperature indicators; load indicators; contents gauges; electricity indicators; compasses for measuring; satellite navigational apparatus; marine navigation apparatus; voltmeters; barometers; weather information apparatus; meteorological instruments; digital weather stations; radio apparatus and instruments; stereophonic apparatus; stereo amplifying apparatus; radar antennas; radio antennas; satellite aerials; dish aerials; walkie-talkies; satellite transceivers; antenna cables; monitoring instruments; steering apparatus, automatic, for vehicles; marine depth finders; sonars; sounding marine depth finders; sounding leads; sounds alarms; radar detectors; audible warning; electric alarms; burglar alarms; electric alarms for fire; security alarms; gas alarms; cartographic apparatus; navigation,

guidance, tracking, targeting and map making devices; anemometers; precision balances; beacons, luminous; radio buoys.

Class 11: Reflectors (vehicle -); taillights for vehicles; head torches; lamp posts; emergency lighting, trailer lights; electric lamps; running lights for land vehicles; boat trailer lights; dynamo lights for vehicles; humidifiers; portable showers; water purification tanks; electric torches; portable torches (electric torches); pocket electric torches; spotlights; diving lights; lamp shades; lights for vehicles; emergency lighting installations; emergency lighting installations; autoclaves (not for medical use); sanitary water conduit fittings; taps; filters for water purifiers; filters for air purifiers; filters for cleaning air; stainless steel sink tops; single-lever faucets for sinks; sink strainers [plumbing fittings]; electric cooktops; inset cooking tops; cooking hobs; kitchen ranges [ovens]; combinations of refrigerators and freezers; cool boxes, electric; toilet bowls; sewage purification apparatus; flushing tanks; sanitary drain armatures for showers; filters for wastewater; air reheaters; electrically-operated devices used in cooling; reverse osmosis elements for reducing the salt content of water; barbecues.

Class 12: Safety restraints for use in vehicles; seat cushions for the seats of boats; ship propellers; propeller spinners; trolleys; bumpers for trolleys; steering wheels; rudder gear; boat rudders; steering gears and rudders [for vessels]; casters for trolleys [vehicles]; stabilisers for reducing the motion of ships; petrol tanks for vehicles; bands for wheel hubs; general purpose trolleys; portholes; windshield wipers; glove boxes for automobiles; vehicle seats; covers (shaped -) for boats; boat launching trolleys; hoods for watercraft; boat tillers; hydrofoils for boats; steering stands for marine vessels; alarm systems for watercraft; trailers for towing boats; rudder gear; boat bumpers.

Class 25: Light-reflecting jackets; fishermen's jackets; coveralls; wet suits for water-skiing; rain boots; waterproof boots for fishing; maillots; berets.

## **COSTS**

80. In respect of the goods actually subject to this opposition, I am of the view that the parties have achieved a roughly equal degree of success. As such, I do not consider it appropriate to make any award of costs. Therefore, I order the parties to bear their own costs.

**Dated this 20th day of July 2023**

**A COOPER**  
**For the Registrar**

## ANNEX

### Class 6

Anchor chains of metal; fastening chains in metal; steel chains; cable joints of metal, non-electric; cable connectors of metal, non-electric; cup swivel joints of metal structural joint connectors of metal; clips of metal for cables and pipes; ring-shaped fittings of metal; metal hardware; seals of metal for shock absorbers; boat anchors of metal; towing cables of metal; mooring cables of metal; metal cable tensioners for boats; signposts made of metal; signs, non-luminous and non-mechanical, of metal; mooring bollards of metal; mooring buoys of metal; mooring hooks of metal; trestles of metal, other than furniture; fixing plates of metal; fuel cans of metal; potable water reservoirs of metal; metalware; hooks [metal hardware]; couplings of metal for chains; couplings of metal for tubing; ferrules of metal; metal shackles; metal karabiners; manhole covers of metal; hand railings of metal metallic mountings; duckboards of metal; step stools of metal; flagpoles [structures] of metal.

### Class 9

Adaptors; plug adaptors; converters for electric plugs; socket outlets (electric -); electric connection plugs; connecting plugs [electric-]; electric plugs; junctions; safety tarpaulins; fuel gauges; divers' masks; gloves for divers; air tanks for use in scuba diving; diving snorkels; loupes for coaxial connectors; navigational buoys; navigational buoys; signalling buoys; cables, electric; adapter cables (electric -); cable splices for electric cables; illuminated signposts for divers; batteries; lithium batteries; converters, electric; electric circuit closers; electrical terminal blocks; acoustic alarms; horns for loudspeakers; signal bells; lifejackets; life-saving rafts; waterproof cases for smart phones; waterproof camera cases; covers for tablet computers; cases for tablet computers; stands adapted for tablet computers; emergency flares; rescue flares; rescue laser signalling flares; transmitters for emitting distress signals; emergency warning lights; escape chutes; emergency signal transmitters; illuminated signposts; signal transmitters; fire extinguishing apparatus; radar apparatus; radar reflecting apparatus; optical finders; marine compasses; telescopes; nautical apparatus and instrument; nautical rescue apparatus and instruments; ampere-hour meters; revolution counters; engine counter; fuel consumption meters; gauges with digital

readout; oil level indicators; quantity indicators; temperature indicators; load indicators; contents gauges; electricity indicators; compasses for measuring; satellite navigational apparatus; marine navigation apparatus; voltmeters; barometers; weather information apparatus; meteorological instruments; digital weather stations; radio apparatus and instruments; stereophonic apparatus; stereo amplifying apparatus; radar antennas; radio antennas; satellite aerials; dish aerials; walkie-talkies; satellite transceivers; antenna cables; monitoring instruments; steering apparatus, automatic, for vehicles; marine depth finders; sonars; sounding marine depth finders; sounding leads; sounds alarms; radar detectors; audible warning; electric alarms; burglar alarms; electric alarms for fire; security alarms; gas alarms; cartographic apparatus; navigation, guidance, tracking, targeting and map making devices; anemometers; precision balances; beacons, luminous; radio buoys.

### Class 11

Reflectors (vehicle -); taillights for vehicles; head torches; lamp posts; emergency lighting, trailer lights; electric lamps; running lights for land vehicles; boat trailer lights; dynamo lights for vehicles; humidifiers; portable showers; water purification tanks; electric torches; portable torches (electric torches); pocket electric torches; spotlights; diving lights; lamp shades; lights for vehicles; emergency lighting installations; emergency lighting installations; autoclaves (not for medical use); sanitary water conduit fittings; taps; filters for water purifiers; filters for air purifiers; filters for cleaning air; stainless steel sink tops; single-lever faucets for sinks; sink strainers [plumbing fittings]; electric cooktops; inset cooking tops; cooking hobs; kitchen ranges [ovens]; combinations of refrigerators and freezers; cool boxes, electric; toilet bowls; sewage purification apparatus; flushing tanks; sanitary drain armatures for showers; filters for wastewater; air reheaters; electrically-operated devices used in cooling; reverse osmosis elements for reducing the salt content of water; barbecues.

### Class 12

Safety restraints for use in vehicles; seat cushions for the seats of boats; ship propellers; propeller spinners; trolleys; bumpers for trolleys; steering wheels; rudder gear; boat rudders; steering gears and rudders [for vessels]; casters for trolleys [vehicles]; stabilisers for reducing the motion of ships; petrol tanks for vehicles; bands

for wheel hubs; general purpose trolleys; portholes; windshield wipers; glove boxes for automobiles; vehicle seats; covers (shaped -) for boats; boat launching trolleys; hoods for watercraft; boat tillers; hydrofoils for boats; steering stands for marine vessels; alarm systems for watercraft; trailers for towing boats; rudder gear; boat bumpers.

### Class 25

Jackets [clothing]; sports jackets; rainproof jackets; warm-up jackets; light-reflecting jackets; fishermen's jackets; combinations [clothing]; coveralls; wet suits for water-skiing; rain boots; waterproof boots for fishing; gloves [clothing]; fingerless gloves; jerseys [clothing]; maillots; sleeveless jerseys; baselayer tops; berets; deck shoes.