TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. UK00003628912

ROLLING DICE

IN THE NAME OF ROLLING DICE LIMITED

AND

AN OPPOSITION UNDER NO. 427105

BY MB&L INVESTMENT HOLDINGS LIMITED

Background and pleadings

1. On 19 April 2021, Rolling Dice Ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 25 June 2021 for the following goods:

Class 25	Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing];Motorcyclists' clothing; Hoods [clothing];Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing];Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Knitwear [clothing];Cloth bibs; Cyclists' clothing; Playsuits [clothing];Slipovers [clothing];Jerseys [clothing];Weatherproof clothing; Casual clothing; Denims [clothing];Combinations [clothing];Furs [clothing];Shorts [clothing];Collars [clothing];Babies' clothing; Ties [clothing];Outer clothing; Cashmere clothing; Bandeaux [clothing];Women's clothing; Bodies [clothing];Embroidered clothing; Layettes [clothing];Jackets [clothing];Kerchiefs [clothing];Chaps (clothing);Maternity clothing; Thermal clothing; Belts [clothing];Muffs [clothing];Capes (clothing);Motorists' clothing; Boas [clothing];Slips [clothing];Veils [clothing];Wraps [clothing]; Athletic clothing.
Class 26	Cloth patches for clothing; Buckles for clothing [clothing buckles].

2. The MB&L Investment Holdings Limited ("the opponent") filed a notice of opposition on 24 September 2021 on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all the goods in the application. For its claim under section 5(2)(b), the opponent relies upon all the goods covered by the following United Kingdom ("UK") trade mark:
   Mark: DICE
   Registration No. 00904490901
   Filing date**:** 07 June 2005

Registration date: 14 June 2006

Goods:

Class 9	Sunglasses; spectacles; cords and cases for the aforesaid goods.
Class 14	Jewellery and imitation jewellery; watches; fashion accessories, including cuff links.
Class 18	Articles made of leather or of imitation leather, articles of luggage, suitcases, trolley cases, bags, casual bags, briefcases, handbags, backpacks, rucksacks, holdalls, travelling bags and trunks, belts, key fobs, card cases and holders, wallets and purses, umbrellas and parasols, parts and fittings for all the aforesaid goods.
Class 25	Articles of clothing, headwear, neckwear, swimwear, beachwear, footwear, nightwear, shoes, gloves, scarves, hats, hosiery and socks.

3. Given its filing date, the above mark is an earlier trade mark in accordance with section 6 of the Act.

4. The opponent claims that the marks are similar and the goods are identical or highly similar, with the result that there is a likelihood of confusion.

5. The applicant filed a counterstatement denying the grounds of opposition. As these are the only submissions from the applicant, they are reproduced in full below:

> "We disagree that our trade mark and those of our opponents are confusingly similar.
>
> As mentioned in our previous TM8 forms, we have been doing business under the name "ROLLING DICE" for the past two years. We have worked hard to establish the brand name to the point where, whenever you search for the name ROLLING DICE, we are the first result on

search engines. In addition, the brand name – for which we also control the domain name- plays a significant part in our brand narrative.

One of the reasons we can support our position in defending our trade mark against the arguments put forth by our opponents is due to the trade mark numbers below, which have been approved and have not faced opposition.

UK00002604145
UK000904490901"[1]

Finally, since the trademark name we have asked for is different from those of our opponents, we reject the similarity of goods and services. As mentioned above, the trademarks mentioned above are recognised and registered under class 25."

6. The applicant is unrepresented and the opponent is represented by Ansons. Only the opponent filed evidence. This decision is taken after careful reading of all the papers filed by the parties.

7. Although the UK has left the European Union ("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.

Evidence

8. The opponent's evidence consists of the witness statement of Mr Sean Mahon dated 9 January 2023 together with 7 exhibits. Mr Mahon is the Managing Director of the opponent company.

[1] The applicant's amended counterstatement dated 29 September 2022.

9. I will return to the evidence later in the decision.

Proof of use

10. As the opponent's mark has completed its registration process more than 5 years before the application date of the contested mark, it is subject to proof of use provisions contained in section 6A of the Act. The applicant has put the opponent to proof of all the goods covered by its registration.

11. The relevant statutory provisions are as follows:

"6A. Raising of relative grounds in opposition proceedings in case of non-use

(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 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 of 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.

[……]

(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."

12. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

(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[2]-

(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."

13. 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."

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*

[2] IP Completion Day is 31 December 2020.

Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky' [2008] ECR I9223, 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 Frottiesrweberei 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. In *Awareness Limited v Plymouth City Council*,[3] Mr Daniel Alexander Q.C. 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

[3] Case BL O/236/13

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."

16. Pursuant to section 6A of the Act, the relevant period for assessing whether there had been genuine use of the earlier mark is the 5-year period ending with the date of application of the contested mark, i.e., 20 April 2016 to 19 April 2021.

Sufficient use

17. Mr Mahon's evidence is that the trade mark is used by the subsidiaries of Brandwell Group Limited with the opponent's consent. Brandwell Group Limited and the opponent are related companies, with most of the shareholders and directors being the same.[4]

18. The opponent has provided copies of catalogues from 2017 – 2020 as Exhibit SM6. The catalogues show men's underwear, cuff links, shoes, ties, gloves, scarves, socks, hats, belts, wallets, umbrellas and travel bags. The opponent has provided sample invoices dated between 2016 – 2020, which are addressed to retailers based in several locations across the UK.[5] The invoices identify the products by code. The sale has been shown in relation to wallets and belts (Class 18) and shoes and ties (Class 25), which can be cross-referred to the products identified in the catalogues. The cost of the products varies. For example, the wallets are priced at £8 or £10, while the cost of the shoes ranges between £25 to £38.

19. In terms of promotion, the mark appears to have been predominantly promoted through catalogues and on social media. The Facebook pages from 2017 show the use of the word Dice in relation to wallets, ties, men's shoes and women's

[4] Witness statement, paragraph 4.
[5] Exhibit SM3

handbags.[6] Mr Mahon states that the mark was exhibited in several yearly shows, such as NEC Spring Fair, Harrogate Autumn Fair and AIS. The evidence in support of his statement comes in the form of pages from the NEC Spring Fair (2019), the Index Menswear show (in Solihull), seven invoices dated between 2016 – 2019 issued by Clarion Events Limited and pages of stands from the fairs where products were displayed. The invoices appear to have been issued by Clarion to Brandwell in respect of Harrogate Fairs. Mr Mahon, however, has not provided information on how many people might have attended those fairs. It would have helped me in assessing the extent of reach of the opponent's mark among the average consumers. Mr Mahon states that the marketing expenditure for each year during 2016 -2020 was more than 20,000 pounds. As the opponent's mark is a comparable mark, i.e. a UK mark created from a trade mark registered in the EU, for a period up to 31 December 2020, the EU is a relevant territory for assessing genuine use of the mark. It is not clear to me whether the marketing expenditure provided in Mahon's statement relates to the amount spent in promoting the mark in the EU or just in the UK. Having taken account of the fact that all of the evidence concerns the use of the mark in the UK and that the expenditure figures are provided in Pounds, I think it is reasonable to infer that the figures concern the amount spent in the UK. According to Mr Mahon's statement, the annual turnover in the UK was more than £2 million during 2016-2020.[7] Although I do not have the breakdown figures, taking account of the type and number of products identified in the catalogues, the sample invoices and marketing materials, I think a significant proportion of the revenue and marketing figures given above include those generated from the sale or spent on marketing of men's shoes, belts, wallets, ties, socks, scarves, umbrellas, hats, gloves, men's underwear and travel bags.

20. The opponent's sales and marketing expenditures appear to be modest. Nonetheless, I remind myself that there is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the

[6] Exhibit SM4
[7] Witness statement paragraph 10.

economic sector concerned for preserving or creating market share for the relevant goods. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union noted that:

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

> And

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

> And

> "55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine

whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider* v *OHIM*, paragraphs 72 and 77)."

21. Even though no use has been shown in respect of EU, in *Easygroup Ltd v Easy Live (Services) Ltd & Ors*[8], the Court stated that it was logical to allow use in the UK to preserve comparable marks and that the opponent can succeed under the comparable mark if the opponent can establish UK-only use and does not have to prove EU as well or instead. The evidence clearly reflects a genuine attempt on behalf of the opponent to generate a market for the mark relied upon during the relevant period in the UK and I am of the view that the use in the UK would be sufficient to show genuine use of the comparable mark.

22. The next step is to decide whether the extent of use entitles the opponent to rely upon all the goods in Classes 9, 14, 18 and 25 covered by the earlier mark.

Class 9: Sunglasses; spectacles; cords and cases for the aforesaid goods.

23. The evidence of the use of sunglasses is limited. I do not think that one page from the catalogue and a picture of a product tag is sufficient to corroborate a claim of genuine use in respect of spectacles. From the evidence before me, I cannot assess the extent of use of the mark in respect of sunglasses, nor am I convinced that the opponent has demonstrated that those goods were extensively marketed by way of advertisement. There is also no evidence of use in relation to any other goods listed in Class 9. I, therefore, conclude that no genuine use has been shown in respect of goods in Class 9.

Class 14: Jewellery and imitation jewellery; watches; fashion accessories, including cuff links.

[8] England and Wales High Court (Chancery Division), [2022] EWHC 3327 (Ch), December 21, 2022, paragraphs 44 and 45.

24. I am of the view that the evidence of use shown in respect of cuff links is very thin for me to assess the extent of use in respect of cufflinks. No use has been shown in relation to any other goods in Class 14. I, therefore, conclude that no genuine use has been shown in respect of goods in Class 14.

Class 18: Articles made of leather or of imitation leather, articles of luggage, suitcases, trolley cases, bags, casual bags, briefcases, handbags, backpacks, rucksacks, holdalls, travelling bags and trunks, belts, key fobs, card cases and holders, wallets and purses, umbrellas and parasols, parts and fittings for all the aforesaid goods.

25. The use has been shown mostly in respect of belts, wallets and purses. The use shown in respect of umbrellas has been consistent throughout the catalogues for various years. There is also evidence of the use of travel bags from the catalogues and marketing materials. The only use shown of women's handbags is limited to pages from Facebook from 2017. I do not consider that the extent of use shown in relation to women's handbags would entitle the opponent to claim genuine use in relation to women's handbags. I conclude that genuine use has been shown in respect of belts, wallets, travel bags and umbrellas.

Class 25: Articles of clothing, headwear, neckwear, swimwear, beachwear, footwear, nightwear, shoes, gloves, scarves, hats, hosiery and socks.

26. Following my findings noted earlier in the decision, I find that the genuine use has been shown in respect of men's underwear, men's shoes, scarves, socks, gloves, hats and ties.

Form of use

27. The catalogues show the use of the mark as registered, i.e. DICE on products, namely shoes, belts, wallets and men's underwear, as given below:

28. Exhibit SM3 appears to be pages from the catalogue, and the word mark ‘Dice’ is used as shown below:

> The ***Dice*** brand is a compelling range that covers all the Gents Accessories requirements, designed in Ireland and manufactured using high quality materials and components the range includes - Belts, Wallets, Underwear, Ties, Hats, Scarfs, Gloves, Gifts and Sunglasses, along with a strong range of Shoes. With both casual and formal products and a strong focus on leather material the range is both high quality and affordably priced. Stylish and trendy the range has something for everybody.

29. The catalogues also show the use of the styled version (“version 1”) of the word DICE as given below:

The use has also been shown in respect of the following sign ("version 2"):

30. Where the mark has been used as registered, this will clearly be use upon which the opponent can rely. As the use of the stylised versions is also seen in the pages of evidence, I will assess whether the use of those signs constitutes acceptable variants of the word mark DICE as per the decision in In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22. In that decision Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2), which is also applicable in assessments of genuine use. He said:

“13. […] While the law has developed since Nirvana [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 Grupo Textil Brownie v EU*IPO, EU:T:2020:22, [63 and 64]). 11 14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case. 15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 Hypen v EUIPO, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 M & K v EUIPO, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements. 16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 Fashioneast v AM.VI. Srl, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 Artkis, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 Alder, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient). 17. It is also worth highlighting the recent case of T-615/20 Mood Media v EUIPO, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in

combination weakly distinctive, and the word MOOD alone was less distinctive still".

31. The distinctive character of the opponent's mark lies in the word DICE as a whole. As the opponent's mark is a word mark, the use of the mark in different font sizes or typefaces is considered acceptable variants.[9] As the dots in the letter 'D' are to be viewed as analogous to a straight line and make a significant visual contribution, I am of the view that Version 1 is not an acceptable variant of the word mark DICE.[10] In respect of Version 2 of the mark, I believe it is no more the mark DICE represented in a different typeface. Moreover, the word 'Handbags' appearing along with the mark is descriptive of the goods. I, therefore, conclude that the use shown of Version 2 is also an acceptable variant of the word mark DICE.

Fair Specification

32. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

"64. [….] The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or

[9] See Appointed Person's decision in O/091/19
[10] See *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* BL O/404/13

more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories."

33. I also bear in mind the law summed up by Mr Geoffrey Hobbs Q.C. as Appointed Person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10:

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

34. I have already concluded that the opponent has not shown genuine use in relation to goods in Classes 9 and 14. I must now consider the fair description of the opponent's goods in Classes 18 and 25.

Class 18: Articles made of leather or of imitation leather, articles of luggage, suitcases, trolley cases, bags, casual bags, briefcases, handbags, backpacks, rucksacks, holdalls, travelling bags and trunks, belts, key fobs, card cases and holders, wallets and purses, umbrellas and parasols, parts and fittings for all the aforesaid goods.

35. In respect of the broad terms contained in the specification, such as articles made of leather or articles of luggage, I am of the view that the number of items for which the use has been shown is very thin, and as such, the opponent is not entitled to retain the broad terms. I find that the fair specification of goods in Class 18 to be belts, wallets, travel bags and umbrellas.

Class 25: Articles of clothing, headwear, neckwear, swimwear, beachwear, footwear, nightwear, shoes, gloves, scarves, hats, hosiery and socks.

36. Clothing is a broad term and encompasses a variety of clothing items. The genuine use has been shown in respect of men's underwear, men's shoes, gloves, scarves, socks, hats and ties does not entitle the opponent to retain the broad term articles of clothing. Similarly, headwear, neckwear and footwear are also broad terms, and the use shown across ties, hats, and men's shoes is not enough to retain those broad terms. I find that the fair specification of goods in Class 25 to be of men's underwear, men's shoes, gloves, hats and ties

37. To sum up, the fair specification of the opponent's earlier mark is:

Class 18: Belts, wallets, umbrellas, and travel bags.
Class 25: Ties, men's underwear, men's shoes, gloves, scarves, hats and socks.

Section 5(2)(b)

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

> "5(2) A trade mark shall not be registered if because –
>
> (a)…
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

39. Section 5A of the reads 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."

Section 5(2)(b) - Case law

40. The following principles are gleaned from the judgments of the European Union ("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 OHIM*, Case C3/03, *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.

The principles:

(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 the 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 greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

41. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In *Canon*, the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or

services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

42. Guidance on this issue has also come from Jacob J. (as he then was) in British Sugar Plc v James Robertson & Sons Ltd (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

> (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.

43. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "[…] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of

Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question".

44. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-325/06, the General Court ("GC") stated that 'complementary' means:

> "[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

45. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C., sitting as the Appointed Person, noted in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL O/255/13:

"It may well be the case that wine glasses are almost always used with wine and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes", whilst on the other hand:

"[…] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together".

46. In *Gérard Meric v OHIM*, the GC held that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application - and vice versa.[11]

Class 25

Clothing; Clothes

47. The terms clothing and clothes in the applicant's specification are broad terms and include various types of clothes including men's underwear covered by the opponent's specification. The competing goods are, therefore, identical under the *Meric* principle.

Ties

48. The term ties are contained in both specifications.

Bodies [clothing], Slips [clothing]

49. These are items of lingerie/underwear. They are aimed at covering or protecting a particular part of the body and are worn next to skin. It shares purpose with men's underwear in the opponent's specification. The nature and method of use of these goods are similar. The goods are likely to share channels of trade. However, they are neither complementary in the sense described by the case

[11] case T-133/05

law nor do they compete. Considering these factors, I find that the goods are similar to a high degree.

Tops [clothing]; Hoods [clothing]; Leisure clothing; Leather clothing; Plush clothing; Girls' clothing; Playsuits [clothing]; Slipovers [clothing]; Jerseys [clothing]; Capes (clothing); Infant clothing; Children's clothing; Childrens' clothing; Cloth bibs; Babies' clothing; weatherproof clothing; Casual clothing; Veils [clothing]; Denims [clothing]; Waterproof clothing; Swaddling clothes; Combinations [clothing]; Shorts [clothing]; Collars [clothing]; Outer clothing; Bandeaux [clothing]; Women's clothing; Embroidered clothing; Layettes [clothing]; Jackets [clothing]; Kerchiefs [clothing]; Chaps (clothing); Maternity clothing; Wraps [clothing]; Knitted clothing; Knitwear [clothing]; Furs [clothing]; Cashmere clothing; Thermal clothing; Wristbands [clothing]; Gloves [clothing]; Muffs [clothing]; Boas [clothing]; Belts [clothing].

50. The above-mentioned goods are different types of clothing. All of the applicant's goods share purpose and intended use with the opponent's men's underwear, as they all are used to cover the body. The goods are likely to be sold through the same distribution channels. The goods are neither complementary nor in competition. Considering these factors, I find that the goods are similar to a medium degree.

Motorcyclists' clothing; Sports clothing; Cyclists' clothing; Motorists' clothing; Athletic clothing.

51. The above-mentioned goods share a similarity in purpose with the opponent's men's underwear in the sense that both categories of goods are intended for wear by humans to cover body parts. The opponent's goods are specifically used for the purpose of sports and are likely to be sold through specialist channels of trade. So, the channels of distribution of the goods are different. The goods are not complementary in the sense described by law. The goods do not compete. Considering these factors, I find that the goods are similar to a low degree.

Oilskins [clothing]

52. The above-mentioned goods are usually worn in wet areas and their nature differ from the opponent's men's wear as they are likely to be made from different materials. They are, however, likely to share the intended use with the opponent's men's underwear, as they all are used to cover the body. The users are also likely to be the same. The goods are unlikely to be sold through the same distribution channels. The goods are neither complementary nor in competition. Considering these factors, I find that the goods are similar to a low degree.

Class 26

Buckles for clothing [clothing buckles]

53. The above-mentioned goods include buckles used to keep belts closed. These are likely to be sold through specialist outlets selling dressmaker's articles and bought by someone making clothing or belts. Although the opponent's specification cover belts in Class 18, the nature of these goods is different, so are the users and distribution channels. Buckles are important to fasten two ends of belts. However, in the absence of evidence, I do not think that the average consumer would expect an undertaking selling belts to be selling buckles separately. The goods are, therefore, not complementary in the sense described by the case law. In *Les Editions Albert René v Office for Harmonization in the Internal Market ("Mobilix") (Trade Marks and Designs) (OHIM)*[12] the GC at paragraph 61 of the judgment stated:

> "The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different."

[12] Case T-311/01

Considering all these factors, I find that the applicant's goods are dissimilar to the opponent's belts. I also cannot find any meaningful similarity between the applicant's buckles for clothing and any other goods the opponent can rely upon in this proceeding.

Cloth patches for clothing

54. Cloth patches are decorative items stitched to clothes to adorn them. These are likely to be sold through specialist outlets selling dressmaker's articles. They do not share nature, purpose, or method of use with the opponent's goods in Classes 18 or 25. The goods are not complementary, nor do they compete. Considering these factors, I find that the goods are dissimilar.

55. In *Waterford Wedgwood plc v OHIM*[13], it was held that some similarity of goods is essential to establish a likelihood of confusion. Having concluded that there is no degree of similarity between the opponent's goods and buckles for clothing [clothing buckles] and cloth patches for clothing in the application, the opposition against those goods fails.

Average consumer

56. I will proceed to determine who the average consumer is for the respective parties' goods discussed above.

57. 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 partiess

[13] C-398/07 P (CJEU)

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

58. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03, the GC commented upon the manner in which articles of clothing are selected. It stated:

> “50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally, in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

59. The average consumer of the competing goods is a member of the general public. The goods are likely to be purchased fairly frequently. The goods are most likely to be the subject of self-selection from retail outlets, websites or catalogues. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount an aural element to the purchase, particularly when advice is sought from a sales representative, or a purchase is made further to a word-of-mouth recommendation. When making a purchase, factors such as size, material, colour, cost (which will vary according to the item) may be considered. These factors suggest that the average consumer will pay a medium level of attention when making their selection.

Distinctive character of earlier mark

60. The distinctive character of the earlier mark must be considered. The more distinctive the mark is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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 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)."

61. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods have the lowest. Distinctiveness can also be enhanced through the use of the mark.

62. The opponent's mark consists of the word DICE which is a small cube that has spots or numbers on its sides and is used in games.[14] The word has no suggestive connotation in respect of the opponent's goods. The mark, therefore, possesses a medium degree of inherent distinctive character.

63. The opponent has provided evidence of use but has not claimed enhanced distinctiveness of its mark. I have already concluded that the evidence demonstrates the use of the marks in relation to belts, wallets, umbrellas and travel bags in Class 18 and ties, men's underwear, shoes, gloves, scarves, hats and socks in Class 25.

64. Given the size of the UK market for the goods in Classes 18 and 25, the use on the scale shown by the opponent is insufficient to establish an enhanced distinctiveness of the mark. Moreover, there is no information regarding the market share held or third-party evidence of recognition. Taking the evidence in round, I cannot conclude that the earlier mark's distinctiveness has been enhanced through its use.

Comparison of marks

65. It is clear from *Sabel BV 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the

[14] See https://www.collinsdictionary.com/dictionary/english/dice visited on 17 July 2023

light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

66. It would be wrong, therefore, artificially to 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.

Earlier mark	Contested mark
DICE	ROLLING DICE

67. The earlier mark consists of the word DICE. The overall impression of the mark lies in that word.

68. The contested mark consists of the words ROLLING and DICE presented as separate words. The overall impression of the mark lies in the combination of those words.

69. Visually, the opponent's mark is wholly contained in the contested mark. Although the notional use would entitle both parties to use their respective marks in upper, lower, title or sentence-case letters, I note that the presentation of the marks in capital letters creates a degree of visual similarity. In terms of differences, the word ROLLING is presented before the word DICE in the contested mark. Considering these factors, I find that the marks are visually similar to a medium degree.

70. Aurally, both word elements of the contested mark will be articulated. The marks coincide in the word "DICE", pronounced identically. The only aural difference between the marks is introduced by the word "ROLLING". Balancing all these factors, I consider that the marks are aurally similar to a medium degree.

71. Conceptually, the competing marks coincide in the word “DICE”, which, as I have already said, is a small cube that has spots or numbers on its sides and is used in games. The only conceptual difference between the marks is the presence of the additional word “ROLLING” in the contested mark, which would be understood as moving by turning over. When combined with the word DICE, the contested mark gives the concept of a dice that is turning over and over. Weighing up the similarities and differences, I consider that the marks are conceptually similar to a fairly high degree.

Likelihood of confusion

72. I note the applicant's argument that the applicant's details appear first when searching for the words ‘ROLLING DICE’ on the website. While there could be many reasons for an increased visibility of content on a website, such as search engine optimization, this line of argument does not assist me in assessing whether consumers are likely to get confused as to the origin of goods when encountered with the respective marks. To support the applicant's position, the applicant also advances an argument that two UK trade mark registrations (2604145 and 904490901) "have been approved and not faced opposition". I would like to clarify for the applicant's sake that 904490901 is registered in the opponent's name. I also note that the other registration, 2604145, cited by the applicant, has expired. It is not clear to me why the fact that some marks do not face opposition would support the applicant's case. Whether the opponent has taken action against any trade mark owner is of no relevance to the matter I must decide as the task before me is to assess whether there is a likelihood of confusion between the opponent's mark and the applicant's mark in respect to their respective goods.

73. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the trade marks and vice versa (Canon at [17]). It is also necessary for me to bear in mind the distinctive character of the opponent’s

trade mark, as the more distinctive the trade mark is, the greater the likelihood of confusion (Sabel at [24]). I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them he has retained in his mind (Lloyd Schuhfabrik at [26]).

74. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertaking being the same or related).

75. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he 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)."

76. I bear in mind that the examples given in *L.A. Sugar* decision are not exhaustive and there could be other instances of likelihood of indirect confusion.

77. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,19 Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in Cheeky Italian Ltd v Sutaria,20 where he said that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion." Arnold L.J. agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

78. Earlier in the decision, I have found the respective marks to be visually and aurally similar to a medium degree. I also found that the marks are conceptually similar to a fairly high degree. The goods will be selected primarily by visual means, with a medium degree of attention by the general public. The goods are either identical or similar to varying degrees. I also concluded that the inherent distinctiveness of the shared component DICE is medium and the distinctiveness of the earlier mark has not been enhanced through the use.

79. Applying these conclusions, I find that the word “ROLLING” in the applicant’s mark is sufficiently prominent to avoid direct confusion. That leaves only the indirect confusion to be considered. I am of the view that the visual, aural and conceptual similarity between the marks arising from the presence of a distinctive common word ‘DICE’ is enough to cause indirect confusion. Taking account of the common element in the context of the later mark as a whole, the average consumer is likely to think that it is another brand of the owner of the earlier mark. In the absence of a clear conceptual message to distinguish between the marks, the average consumer who pays a medium degree of attention would think, upon seeing the respective marks, that the marks are the responsibility of the same undertaking or economically linked undertakings to provide identical or similar goods. I, therefore, conclude that there is a likelihood of indirect confusion in respect of all of the goods, even those which are similar only to a low degree.

Conclusion

80. The opposition has been partially successful.

The application is refused in respect of the following goods:

Class 25	Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Oilskins [clothing];Motorcyclists' clothing; Hoods [clothing];Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing];Waterproof clothing; Plush clothing; Girls' clothing; Swaddling clothes; Knitwear [clothing];Cloth bibs; Cyclists' clothing; Playsuits [clothing];Slipovers [clothing];Jerseys [clothing];Weatherproof clothing; Casual clothing; Denims [clothing];Combinations [clothing];Furs [clothing];Shorts [clothing];Collars [clothing];Babies' clothing; Ties [clothing];Outer clothing; Cashmere clothing; Bandeaux [clothing];Women's clothing; Bodies [clothing];Embroidered clothing; Layettes [clothing];Jackets [clothing];Kerchiefs [clothing];Chaps

(clothing);Maternity clothing; Thermal clothing; Belts [clothing];Muffs [clothing];Capes (clothing);Motorists' clothing; Boas [clothing];Slips [clothing];Veils [clothing];Wraps [clothing]; Athletic clothing.

The application may proceed to registration for the following goods:

Class 26 Buckles for clothing [clothing buckles]; Cloth patches for clothing

Costs

81. The opponent has been more successful than the applicant and is entitled to a contribution towards its costs. Awards of costs are governed by Tribunal Practice Notice ("TPN") 2/2016. I award costs to the opponent on the following basis:

Official fee	£100
Preparing a statement of case and Considering other side's statement:	£200
Filing evidence:	£300
Total:	£600

82. I order Rolling Dice Ltd to pay MB&L Investment Holdings Limited the sum of £600. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd August 2023

Karol Thomas
For the Registrar
The Comptroller-General