BL O/0820/23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION No. 3742330
BY
PEE TRADING LIMITED

TO REGISTER THE TRADE MARK:

IN CLASS 25

-AND-

THE OPPOSITION THERETO UNDER No. 433549
BY
THE VINTAGE CLOTHING COMPANY LIMITED

Background and pleadings

1. PEE Trading Limited (**"the Applicant"**) applied to register the trade mark shown below in the UK on 12 January 2022:

2. It was accepted and published in the Trade Marks Journal on 18 February 2022 in respect of the following goods:

Class 25: *Clothing*.

3. On 17 May 2022 'The Vintage Clothing Company Limited' (**"the Opponent"**) opposed the trade mark application under section 5(2)(b) of the Trade Marks Act 1994 (**"the Act"**). The opposition is based on the Opponent's trade mark shown below, which is registered in respect of goods in Classes 18 and 25. For the purposes of this opposition, the Opponent relies solely on its Class 25 goods. Details of the registration are as follows:[1]

Representation of the Earlier Mark:	
Registration Number:	2330795
Filing date:	29 April 2003
Registration Date:	18 March 2005
Class 25 goods:	*Articles of clothing; t-shirts.*

4. The Opponent claims that the respective marks are highly similar and that its goods are identical and highly similar to the applied-for goods giving rise to a likelihood of confusion. In its particulars of claim, the Opponent submits that *"although both marks have a slight stylisation, they are almost identical in that they spell out the same word 'POP'. As such, both marks are conceptually, visually and phonetically highly similar."*

[1] The Opponent's mark is an earlier trade mark in accordance with section 6 of the Act.

5. As the Opponent's earlier mark had been registered for more than five years at the filing date of the application, the Opponent made a statement that it has used its mark in relation to the goods relied on.

6. The Applicant filed a notice of defence and counterstatement, stating that: *"the trademark I am defending is for a logo which shows the word POP which is a fairly broad term. I also sell fashion goods but for cyclists and nothing that competes with the other party so* [I pose] *no threat to them"*.

7. Both parties filed submissions and evidence during the evidence rounds. The Opponent's evidence goes to 'proof of use'. The Applicant's evidence goes to its claim that it *"has acquired a substantial reputation and goodwill associated with its trademark"* as a consequence of its use of its mark.[2] No hearing was requested, and only the Opponent chose to file submissions in lieu of a hearing. I make this decision following a careful consideration of the papers.

8. The Opponent is represented by Serjeants LLP. The Applicant has no professional legal representation in these proceedings.

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

Preliminary Issues

The Applicant's submissions

10. The Applicant's submissions dated 25 October 2022 contained what is considered evidence of fact (screenshots of web pages and photographs of products). The Applicant was notified by the Tribunal that this 'evidence' was not admissible as it was not in the proper format. I shall therefore disregard any material of evidential nature which is contained in the Applicant's submissions. The Applicant in any event subsequently chose to file evidence in these proceedings.

[2] See the Preliminary Issues section to this decision, my paragraphs 11 – 22.

The Applicant's Witness Statement and accompanying evidence

11. The Applicant's evidence comes in the form of the Witness Statement of Ben David Sumner, dated 19 December 2022. Mr Sumner is the director and majority shareholder of PEE Trading Limited (the Applicant). Mr Sumner states PEE Trading Limited, is the parent company of POP Cycling Co, the latter of which he founded on 8 March 2021. He states that his cycling company sells cycling accessories and that the customer demographic of the business are cyclists, and all its products are designed around cycling.

12. Mr Sumner provides the following information: *"the business began by selling cycling water bottles but it has since expanded its product offering. POP now supplies a range of cycling socks and saddlebags, with the goal to move into cycling clothing by the year end 2024."* He provides undated images of 'POP' branded saddlebags and undated images from the 'POP Cycling Co' social media page on 'Instagram' – the 'Instagram' screenshot shows images of socks, water bottles and saddlebags.

13. Website links form the subject of two separate exhibits attached to the witness statement. I note that evidence comprising of website links is not acceptable since the content of those links is not fixed at a particular point in time and what was at that link when the evidence was filed may not be what is there now – or what may have been there. Evidence from websites must be printed and shown to be from a particular date. The tribunal does not access web links, and I cannot take this evidence into consideration.[3]

14. With regard to the contested application, Mr Sumner states that *"at all material times I have been the registered proprietor of UK registered trade mark no. UK00003742330* […]*, which has been registered with effect from January 2022 in respect of Clothing* [in] *Class 25. Attached* […] *is an image of my trade mark registration filing, which is the only trade mark I have ever registered for and/or used in relation to POP."* As the trade mark is subject to an opposition it is not registered and is merely a trade mark application. The outcome of my decision in these opposition

[3] See the 'Manual of trade marks practice – Tribunal section' – paragraph 4.8.4 'Exhibits'.

proceedings will determine whether the trade mark application may or may not proceed to registration.[4]

15. Details about advertising spend incurred in January 2022 for a freelance photographer are provided; as well as two separate invoices from different suppliers (issued to the business) – one for the purchase of water bottles (dated 19 October 2022) and the other for the purchase of socks (dated 21 October 2022). I note these invoices are dated after the notice of opposition. Mr Sumner also provides turnover figures for the financial year 2021/22 and 2022/23.

16. Mr Sumner concludes that:

> *"9. As a consequence of such use, advertising and investment, POP has acquired a substantial reputation and goodwill associated with the trademark. In August 2022, POP was approached by established Australian cycling brand, Skingrowsback. POP has since collaborated with Skingrowsback to produce saddlebags. Attached* […] *is an image of said product. Our collaboration with Skingrowsback has been advertised extensively across our website and Instagram account* […]. *The inability of to sell under our trademark would inevitably cause damage to the future continuance of our relationship with Skingrowsback.*
>
> *10. Our trademark is clearly recognisable as being synonymous with cycling.* […]*"*

17. Evidence of reputation of the contested mark is not a requirement in these proceedings and the evidence is in any event insufficient to establish reputation if it were so required (I note that establishing reputation of a mark carries a high evidential burden and it concerns the factual extent to which a sign is recognised by a significant part of the public). It may only be relevant in exceptional circumstances which give rise to such a consideration[5] – the facts in the present case do not warrant such an exceptional consideration. In addition, evidence of use of the applied-for mark (from

[4] Subject to any appeal.

[5] In *EUIPO v Messi Cuccittini* and *J.M.-E.V. e hijos v Messi Cuccittini* (joined Cases C-449/18 P and C-474/18 P, EU:C:2020:722), the Court of Justice of the European Union ("CJEU") considered the reputation of the applicant for registration as being relevant for the conceptual meaning of a trade mark – the CJEU found that in an appropriate case, this could include the potential fame of the applicant. In this case, the fame and reputation of the footballer *Lionel Messi* (the applicant) was taken into consideration when assessing the likelihood of confusion. Although I note that reputation in a **trade mark sense** must not be equated with conceptual meaning as they are not the same thing (see words to that effect in *Retail Royalty Company v Harringtons Clothing Limited*, O/593/20, paragraphs 74 – 76).

the date of application to beyond the notice of opposition), even where that use may be significant, is not relevant for the comparison of the marks and the assessment of likelihood of confusion under section 5(2)(b).

18. In the decision before me, assessment with regard to the similarity of the marks and the respective goods at issue, is to be undertaken based on a notional and fair use of the contested application, which involves, inter alia, taking into consideration the goods applied for as they appear on the Register i.e. the broad category of 'clothing'. The Applicant contends that it uses the goods solely in relation to cycling gear, however, since my assessment involves taking into account the Applicant's notional use, as opposed to its actual use, the fact that the Applicant is currently limiting or intends to limit its use to a few goods that fall within the general category of 'clothing' is irrelevant. I note that the Opponent's specification is broad and could encompass socks and other clothing including cycling clothing.

19. Thirdly, I note that Mr Sumner has stated in his witness statement that *"any product sold under our trademark is done so with a view of taking advantage of our reputation in our target market. Any attempt to draw inference from, or "piggy back" off another brands reputation, not least one which has no affiliation with the cycling industry, would be detrimental to the distinctive character of our trademark."* Again, this is not a consideration which is apt to the current proceedings.

20. Finally, Mr Sumner states that *"since trading POP under our trademark, we have never been, to the best of my knowledge, mistaken by customers or otherwise for the business of the Opponent"*. Absence of evidence of actual confusion is not necessarily detrimental to an opposition under section 5(2)(b) and it would depend on the evidence.[6]

21. Having carefully reviewed the evidence, I can conclude that it merely brings to my attention that the Applicant has begun its use of the contested mark in relation to

[6] In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:
"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

‘socks’ which is covered by the broad indication of ‘clothing’. The Applicant’s evidence has no bearing on my decision for the reasons given above.

Opponent’s witness statement

22. The Opponent’s evidence comes in the form of the Witness Statement of Richard Free, dated 18 October 2022. In his witness statement Mr Free informs me of the Opponent’s website by providing a link to the website. As I have mentioned above, evidence comprising of website links is not acceptable therefore I cannot take this evidence into consideration.

PROOF OF USE

Legislation and case law

23. The relevant provisions of the Act 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.

[...]

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

Section 100

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.

24. The law relating to genuine use of a registered trade mark was summarised by Arnold J (as he then was), in *Walton International Ltd & Anor v Verweij Fashion BV.*[7] This summary includes, inter alia, that genuine use means actual use of the trade mark by the proprietor or a third party (with the authority to use the mark) and that such use must be by way of real commercial exploitation of the mark on the market, for the relevant goods or services, sufficient to create or maintain a market share for those goods or services.[8] The use must be more than merely token although there is no *de minimis* rule in relation to genuine use, and it is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use. The use must be consistent with the essential function of a trade mark which includes

[7] [2018] EWHC 1608 (Ch), paragraphs 114 and 115 detail the summary in full.
[8] 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.

for example, affixing the mark to the relevant goods in order to guarantee to the consumer that the goods come from a single undertaking which controls the manufacture of those goods, and which is responsible for their quality.

25. In determining whether there is real commercial exploitation of the mark, all the relevant facts and circumstances must be taken into account, which include:

(1) 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;
(2) the nature of the goods or services;
(3) the characteristics of the market concerned;
(4) the scale and frequency of use of the mark;
(5) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them;
(6) the evidence that the proprietor is able to provide; and
(7) the territorial extent of the use.

26. The genuine use provision is not there to assess economic success or large-scale commercial use;[9] rather, it is concerned with the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods and services.

27. The onus is on the Opponent to have filed evidence of genuine use of its mark. I must consider what the evidential picture as a whole shows me, not whether each piece of evidence shows use by itself.[10]

28. Whilst there is no requirement for the Opponent to produce any specific form of evidence, in *Awareness Limited v Plymouth City Council,*[11] the Appointed Person stated that:

> *22.* […] *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*

[9] *MFE Marienfelde GmbH v OHIM*, Case T-334/01.
[10] *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.
[11] Case BL O/236/13, paragraph 22 and 28.

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.

[…]

28. […] *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* […].*"*

29. I also note Mr Alexander's comments in *Guccio Gucci SPA v Gerry Weber International AG*.[12] He stated:

"The Registrar says that it is important that a party puts its best case up front – with the emphasis both on "best case" (properly backed up with credible exhibits, invoices, advertisements and so on) and "up front" (that is to say in the first round of evidence). […] *The rule is not just "use it or lose it" but (the less catchy, if more reliable) "use it – and file the best evidence first time round – or lose it"."*

Approach

30. Having carefully considered the Opponent's evidence, it is clear that it relates to a sign which differs from the form in which the earlier mark is registered. Since it is incumbent on me to assess whether, and to what extent, the Opponent's evidence supports its statement that it has made genuine use of the earlier mark, I shall first address the question as to whether the sign shown in evidence is an acceptable variant form of the earlier registered mark, particularly since the Opponent cannot rely on its earlier right in these opposition proceedings unless the use conditions are met.

[12] Case BL O/424/14. Although the case concerned revocation proceedings, the principle is the same for proof of use in opposition proceedings.

31. I note that the Opponent may rely on use of a mark *"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"*.[13] Put plainly, if the form in which a sign is used alters the distinctive character of the mark, then that form is not a 'variant form' and use of such sign cannot be relied on to establish genuine use of the registered trade mark. It therefore follows that the opposition would fail at that first hurdle.

Form of the mark

32. The table below shows the form of the earlier mark as registered and the form of the sign shown in evidence:

Earlier mark	Sign shown in evidence
POP	pop boutique

33. The presence of the sign on the left, can only be seen in the evidence in an image of one shop sign (for the opponent's store in Manchester); and the profile picture of one of the Opponent's social media accounts on 'Instagram' (see the images below).

[13] Section 6A(4)(a) of the Act.

34. It is clear from the photograph above on the left, that the 'POP Boutique' sign is also present (on the shop window).

35. Where the sign used in trade differs from the form in which it was registered only in negligible elements, so that the two signs can be regarded as broadly equivalent, the *"variant form"* provision envisages that the obligation to use the trade mark registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade.[14]

36. The Appointed Person in *Nirvana Trade Mark,* BL O/262/06 summarised the approach to the test in relation to whether a sign has been used in a 'variant form' as follows:

> *"33.* [...] *The first question is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period* [...]
>
> *34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."*

37. In *Colloseum Holdings AG v Levi Strauss & Co.,*[15] the CJEU stated:

> *"*[...] *as is apparent from paragraphs 27 to 30 of the judgment in Nestlé,* [Case C-353/03]*, the 'use' of a mark, in its literal sense, generally encompasses*

[14] See the General Court ruling in T-194/03 *Il Ponte Finanziaria* [2006] ECR II-445 at paragraph 50 (not overturned by the Court of Justice C-234/06 *Il Ponte Finanziaria* [2007] ECR I-7333).
[15] Case C-12/12

both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark."[16]

38. The mark for which genuine use must be shown *"need not necessarily have been used independently* [...] *it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark* [...]*, as originating from a given undertaking,"*[17] in other words, *"a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must* [nevertheless] *continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use'".*[18]

39. Although *Nirvana* was decided before *Colloseum*, *Nirvana* remains sound law so far as the question of whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment (in *Colloseum*) must also be taken into account where the mark is used as registered, but as part of a composite mark.

40. Indeed, in *Lactalis McLelland Limited v Arla Foods AMBA*,[19] Professor Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the 'variant form' test. 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]).*"

[16] Ibid., paragraph 32. It is noted that in the '*Nestlé*' case (referenced by the CJEU), the court was asked to express a view on the rules concerning the distinctive character of trade marks. In *Nestlé* the dispute turned on whether the advertising slogan 'HAVE A BREAK' was able to acquire distinctive character as a result of its use as a part of the registered trade mark 'HAVE A BREAK … HAVE A KIT KAT'. The nub of the legal dispute was the question whether this kind of use of a sign can result in distinctiveness for trade mark purposes or whether it precludes recognition as a trade mark.
[17] See *Nestlé,* Case C-353/03, paragraphs 27 to 30 – which are the paragraphs the CJEU makes reference to in *Colloseum* (Case C-12/12). Although *Nestlé* addresses 'use' through which a trade mark acquires distinctive character, as the CJEU pointed out in *Colloseum*, at paragraphs 33 – 34, the criterion of use is still the same i.e. the requirements that apply to verification of the genuine use of a mark, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration.
[18] *Colloseum,* Case C-12/12, paragraph 35.
[19] BL O/265/22

41. Therefore the correct approach in assessing whether a mark has been used in a 'variant form' requires a comparison of the marks to identify the differences between them and assess whether those differences alter the distinctive character of the registered mark. In *Lactalis,* Prof. Johnson considered various decisions of the courts, particularly the General Court, which he noted had developed certain principles which apply to assess whether a mark is an acceptable variant. He set out the following principles derived from such case law, which he stated were relevant to that particular case before him, namely:[20]

> *"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."*

42. In this regard Prof. Johnson cited *Hyphen GmbH v EUIPO,*[21] where the General Court held that that use of the sign shown on the left below, constituted use of the registered mark shown on the right – the addition of a circle around the registered mark was a banal, non-distinctive addition, that was not sufficient to alter the distinctive character of the registered mark. These findings indicate that the relative distinctiveness of the registered mark and the components added to (or omitted from) it in use are relevant factors to take into account in the required assessment.

43. Prof. Johnson continued as follows:

> *"15.* […] *Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive* […]*. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements."*

[20] Ibid., paragraphs 15 – 17.
[21] Case T-146/15

44. In this regard Prof. Johnson cited *M & K v EUIPO,*[22] in particular paragraph 41. In that case, the figurative sign used in the proof of genuine use of the earlier trade mark (the earlier trade mark being the word mark 'KAMIK') was as follows:

Paragraph 41 of that judgement states (my emphasis):

> *"In any event, it should also be noted that, where a trade mark is composed of word and figurative elements, the word element is, in principle, more distinctive than the figurative element, because the average consumer will refer to the goods in question by quoting their name rather than by describing the figurative element, particularly where that figurative element has been added for decorative effect and is not intended to be distinctive."*

45. In *Lactalis,* Prof. Johnson also noted the following points (my emphasis):

> *"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* […]
>
> *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).*

46. Taking all the above case law into account, it is self-evident that the answer to the first question is that the mark presented in the evidence is not the same as the mark registered.

[22] T-171/17

47. I now turn to the differences between the two. Putting aside for one moment, any difference with regard to stylisation of the word 'POP' in the 'POP Boutique' sign, I firstly address the issue with regard to the addition of the word 'boutique' in the sign, which is not present in the registered mark. This word describes a small fashion shop selling clothes, therefore, when used in relation to clothing goods, it is merely suggestive, and its addition is unlikely to change the distinctive character of the word 'POP' within the sign.

48. Moving on now to identify the other differences, namely, the fonts are completely different and bear no resemblance to one another. What's more, the earlier mark contains a device element comprising of concentric circles (which brings to mind a target), which is not present in the sign shown in use. Conversely, the sign shown in use contains a circular device that forms a background to the wording, which is not present in the registered mark (although this circle is just a banal addition). The earlier mark is registered in black and white, therefore the colour of the sign shown in use does not represent a point of difference.[23] Both signs contain the word 'POP'.

49. The real crux of the difference is between the representation of 'POP' in each sign. 'POP' is an ordinary word, that has an ordinary level of distinctive character. It has several meanings (e.g. to burst or explode; the word to describe a small explosive sound; a way of referring to one's father; an abbreviation of the word 'popular' to refer to a genre of music, or a form of modern culture; it is also another word for a carbonated sweet drink etc.) none of which are descriptive or allusive in relation to the goods.

50. That said, the stylisation of the earlier mark is such that the 'O' in the word 'POP' is replaced with a figurative device, therefore the inherent distinctive character of the earlier mark lies not only in the word 'POP' but also in that figurative device and the way the mark is represented as a whole – since the protection afforded to the registration of a figurative mark encompasses the way the mark is presented.

[23] Registration of a trade mark in black and white covers use of the mark in colour. Thus a black and white version of a mark should normally be considered on the basis that it could be used in any colour, although I note it is not appropriate to notionally apply complex colour arrangements to a mark registered in black and white. See the Court of Appeal decisions in *Specsavers* [2014] EWCA Civ 1294, at paragraph 5; and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47.

51. In contrast, the 'O' in the 'POP Boutique' sign is not a device, but is the same font as the rest of the wording, the distinctive character lies solely in that word in the way it is represented in that sign.

52. Taking all the above into account, it is my primary view that the sign below is not an acceptable variant of the earlier mark since it alters the distinctive character of the earlier mark. As a consequence, the Opponent cannot rely on its use of this sign to establish genuine use of the earlier mark.

53. Although my primary finding is that the 'POP Boutique' sign is not an acceptable variant form of the earlier mark, I will nonetheless proceed to consider the Opponent's evidence of use, in the event that I am wrong in my primary finding. My assessment of the evidence shall therefore be on the alternative basis that the above sign is an acceptable variant of the earlier mark.

PROOF OF USE

Relevant period

54. The Opponent relies on its Class 25 goods, namely *"articles of clothing; t-shirts."* The Applicant has put the Opponent to proof of use of those goods during the relevant period.

55. The relevant 'proof of use' period in these proceedings is **13 January 2017 to 12 January 2022**, being the period of five years ending on the filing date of the opposed application.

Evidence

56. The Opponent's evidence comes in the form of the Witness Statement of Richard Free, dated 18 October 2022, which has 22 supporting exhibits labelled 'Exhibit 1 –

Exhibit 22'. Mr Free is the Managing Director of 'The Vintage Clothing Company Limited' (the Opponent), a position he has held since 15 August 2001.

Background and history of the Opponent's business

57. Mr Free states that the products they sell *"are specifically centred around the fashion/clothing industry"*. He provides screenshots of the Opponent's website, 'pop-boutique.com'.[24] Although this evidence is undated, part of it nonetheless provides some details in relation to the background and history of the Opponent's business. Namely:

(1) The *"business"* was founded in the North West of England in 1983 by Richard Free, who is said to have sourced clothing stock for his business from flea markets and church sales, which he then sold on the London markets at Camden and Greenwich. The first *"permanent shop"* of the business was opened in 1985 in Manchester, with a second opening in Liverpool in 1989.

(2) The business is said to have expanded in the 1990's, and in 1991, it was *"approached by 'Topshop' to become the first company to sell vintage clothing in their flagship store in Oxford Circus. By this time,* [the business was] *importing vintage from the USA and all over Europe and exporting to clients around the globe. The expansion of the business and the success allowed* [them] *to open another shop in Manchester* […] *on Oldham Street in 1994."*

(3) Wayback Machine archived webpages of the Opponent's website, dated August 2011, state that the shop on Oldham Street in Manchester was the *"first Pop Boutique store"* and that *"we had been running vintage clothing shops since 1983 and wanted to create a shop that didn't just sell vintage clothing, but all manner of things your everyday vintage junkie might find interesting and even buy"*. According to the webpage evidence, the second 'Pop Boutique' was opened in 1997 on Monmouth Street in London and a further UK location was opened in 2008 in Leeds.

[24] Exhibit 12, pages 5 – 6.

Store fronts

58. Mr Free produced contact and address information of the five UK store locations (two in Manchester, one each in Liverpool, London and Leeds) stating that *"all our store names contain our trade mark and display the mark on our store fronts"*. Undated photographs (which are stated to be 'recent') are said to display the Opponent's store fronts in Manchester and Liverpool (stated in the witness statement to have been opened in 1983 and 1985 respectively) and that such *"shop fronts have not changed since they were opened in 1983 and 1985"*. These photographs are as follows (the image on the left is Manchester and the one on the right is Liverpool):[25]

Store bags

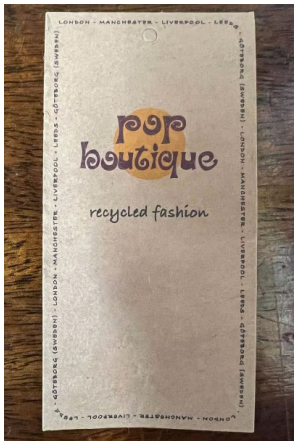
59. Three undated photographs (which are stated to be 'recent') of the Opponent's *"store bags"* are produced in evidence. Mr Free explains that they provide these bags to their customers with every purchase and that *"the bags have been the same since we opened our shops"*. An example is shown below:

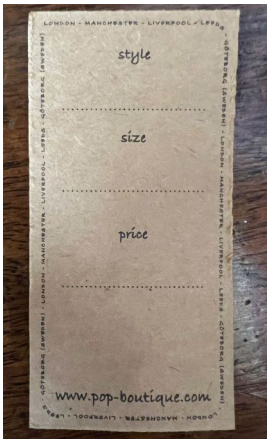
[25] Exhibit 2 and Exhibit 3.

60. An invoice dated 31 August 2022 (outside of the relevant period),[26] issued to the Opponent by a packaging company is described by Mr Free as follows: "[an invoice] *for the purchase of our internal store bags bearing our trade mark logo, purchased in large quantities for our business, for the total amount of £8760. The necessary advance payment of £4380 was paid on 6 September 2022. This clearly demonstrates the genuine use of our trademark in our stores and the potential growth of our business".* The invoice is for an order of 20,000 bags and the £8,760 total is inclusive of VAT (the total is £7,300 excluding VAT).

Swing tags

61. Undated images of the Opponent's 'swing tags/ labels' are provided as follows:





62. Mr Free states that these swing tags are on *"all our clothing sold within our stores"* and that they *"have been used on our products since we launched the brand"*.

63. Swing tags can be seen on an undated image of jeans displayed on the Opponent's social media evidence as follows:[27]

[26] Exhibit 22.
[27] Exhibit 19

‘POP’ clothing line

64. Mr Free makes reference to the Opponent’s own clothing line, stating that it includes a twice-yearly, 20 – 30 piece collection. Wayback Machine archived webpages of the Opponent’s website, dated August 2011 contain the following information: *“Pop Boutique’s aim is to bring you fantastic vintage products at great prices and ever changing fashion on the POP label”*.

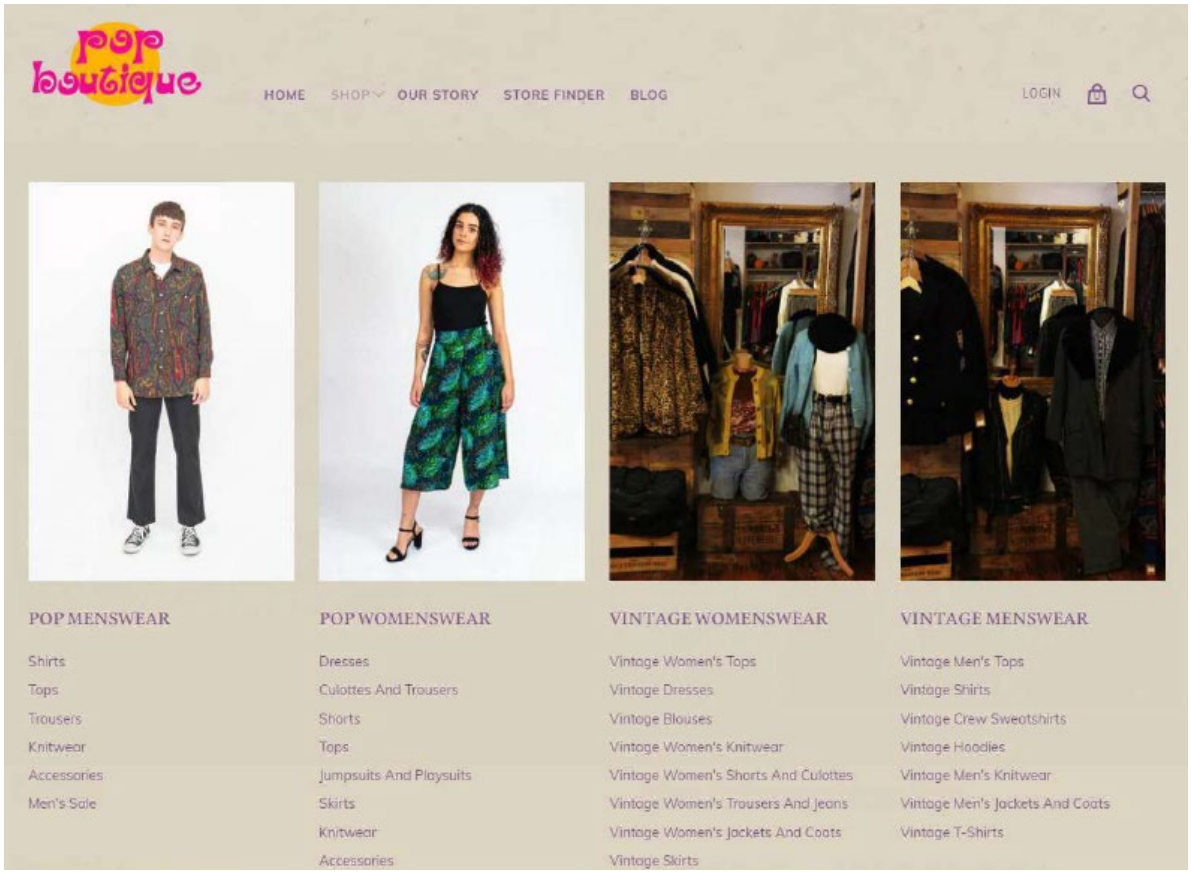
65. A screenshot of the Opponent’s website displaying a post, dated 17 October 2014, titled *“Celebrating 20 years of the Pop Boutique brand”*, states as follows:[28]

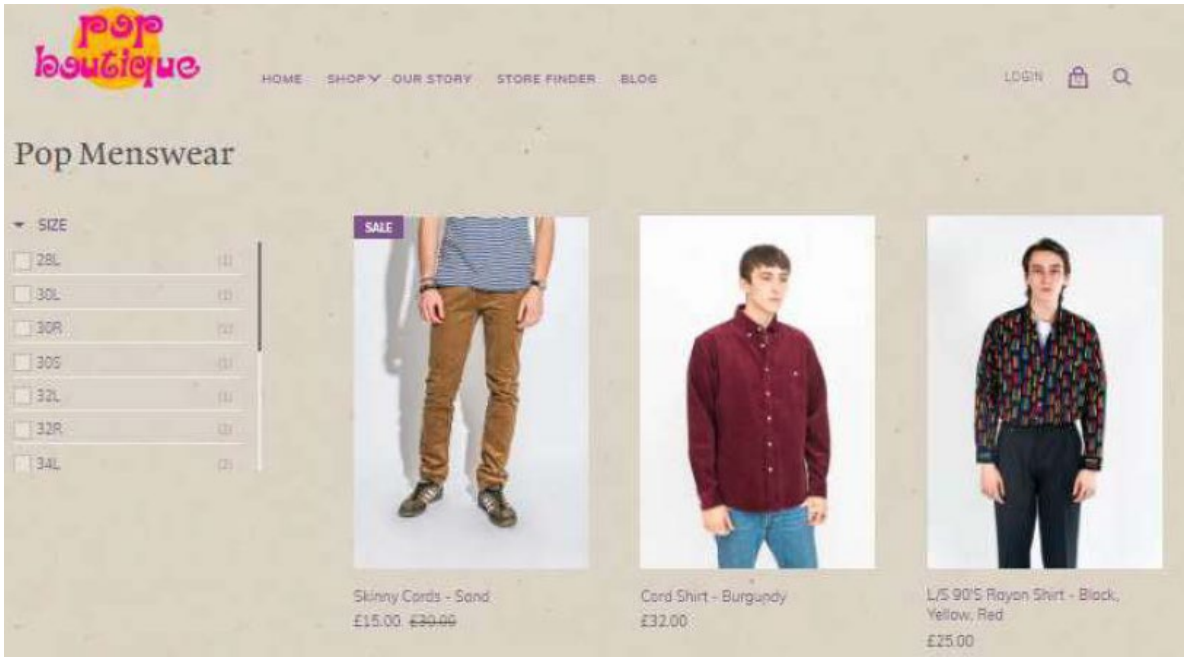
> *“The company started out selling vintage clothing and we started to struggle to keep up with the growing demand for certain items of the right quality and quantity. From this struggle, the Pop brand was born. We wanted to make items we knew our customers wanted but we just couldn’t get enough of. With the Pop brand we can provide various sizes and styles so that you can find a vintage style that is both sustainable and a perfect fit. 20 years later the brand still has this vision in mind! We take inspiration from the vintage clothing we sell and fill the gaps in demand for certain products.”*

66. Mr Free produces a single, undated image which shows a ‘Pop’ label sewn onto fabric.[29] He states: *“our label tags on some of the clothing sold in our stores, also bear our trade mark”*. I reproduce the image below exactly as it has been provided in evidence:

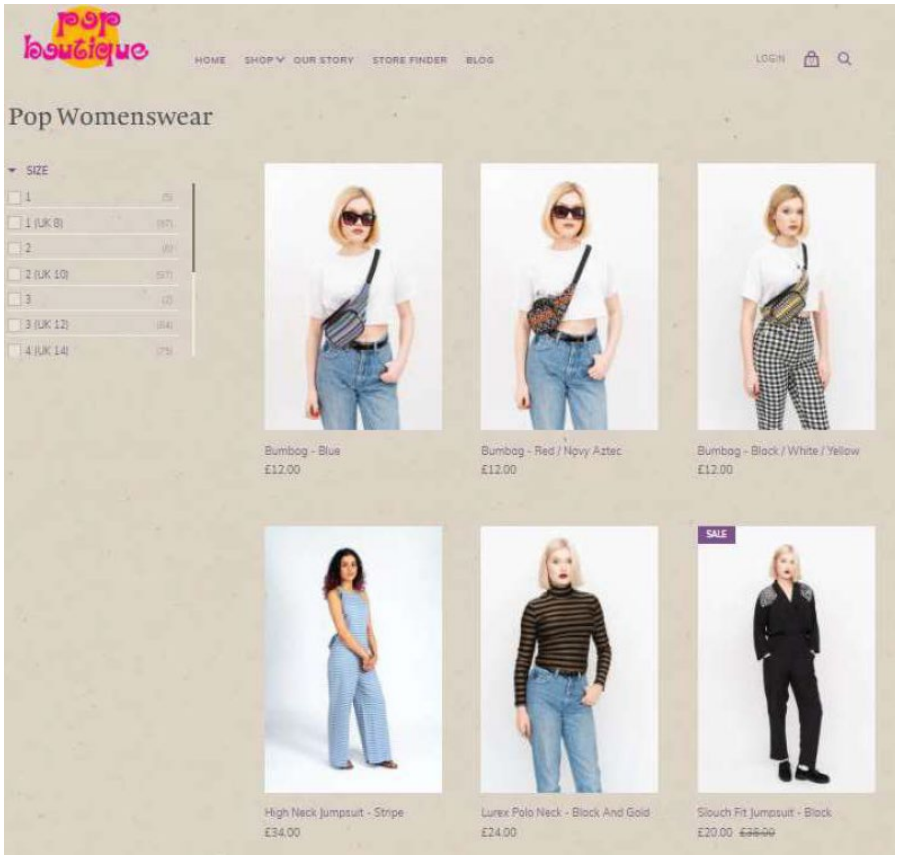
[28] Exhibit 13.
[29] Exhibit 7.

67. Mr Free provides undated screenshots of the Opponent's website. Below are some examples as follows:[30]





[30] Exhibit 12.

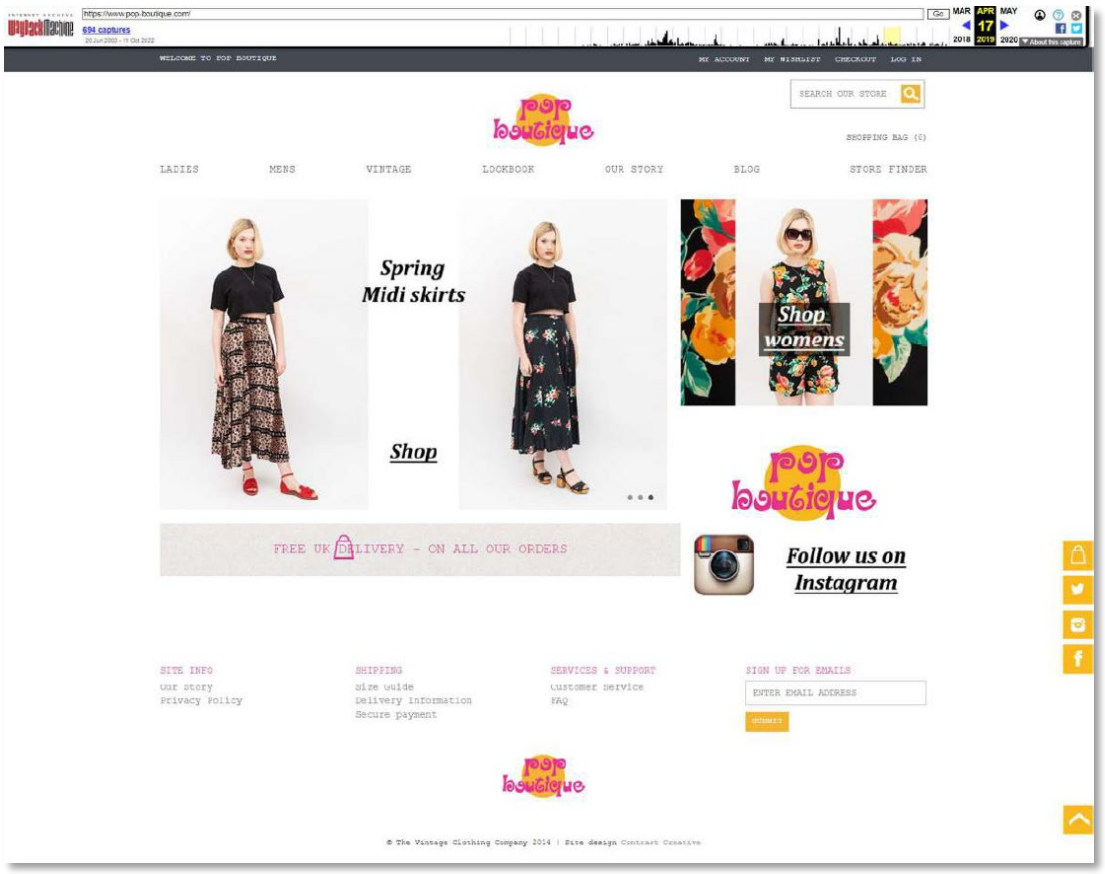


68. Referring to the above undated website evidence,[31] Mr Free states that *"as can be seen from the website, a range of clothing products are available for purchase. This mainly includes 'vintage clothing' of different brands, as well as our own clothing line […]. Although this evidence is not dated, the evidence in Exhibit 14 from the wayback machine clearly shows that the mark has been in use in this way for a number of years."*

69. The evidence contained in Exhibit 14, includes, inter alia, screenshots of the Opponent's website. There are four screenshots which fall within the relevant period, dated 10 August 2018, 17 April 2019, 17 August 2020 and 20 December 2021. These webpages display the following sign only in the website header, footer and the social media link for 'Instagram':

[31] Exhibit 12.

70. A representative example of these screenshots is as follows:



71. The screenshot dated 20 December 2021 displays the following information:

"Pop Womenswear: Shop from our Pop Womenswear range; everything from dresses, blouses, and jumpsuits to accessories. Inspired by every era from the 50s to the 90s, we've recreated vintage classics for a modern customer."

Social media

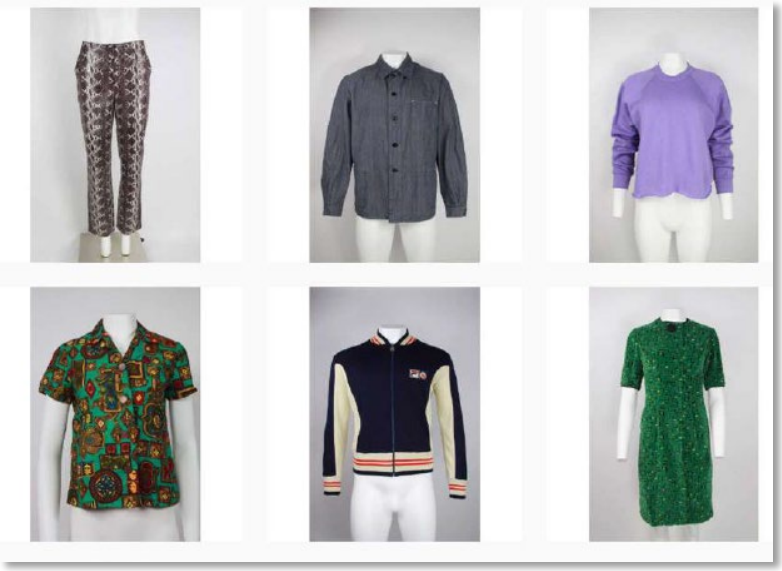
72. Mr Free provides undated screenshots of the Opponent's various social media accounts on 'Instagram' (including their *"official page"*; and separate accounts for its UK stores i.e. Manchester, Liverpool, Leeds and London).[32] The table below sets out the number of followers for each account (included in the table are also the profile images for these accounts):

[32] Exhibits 16 – 20.

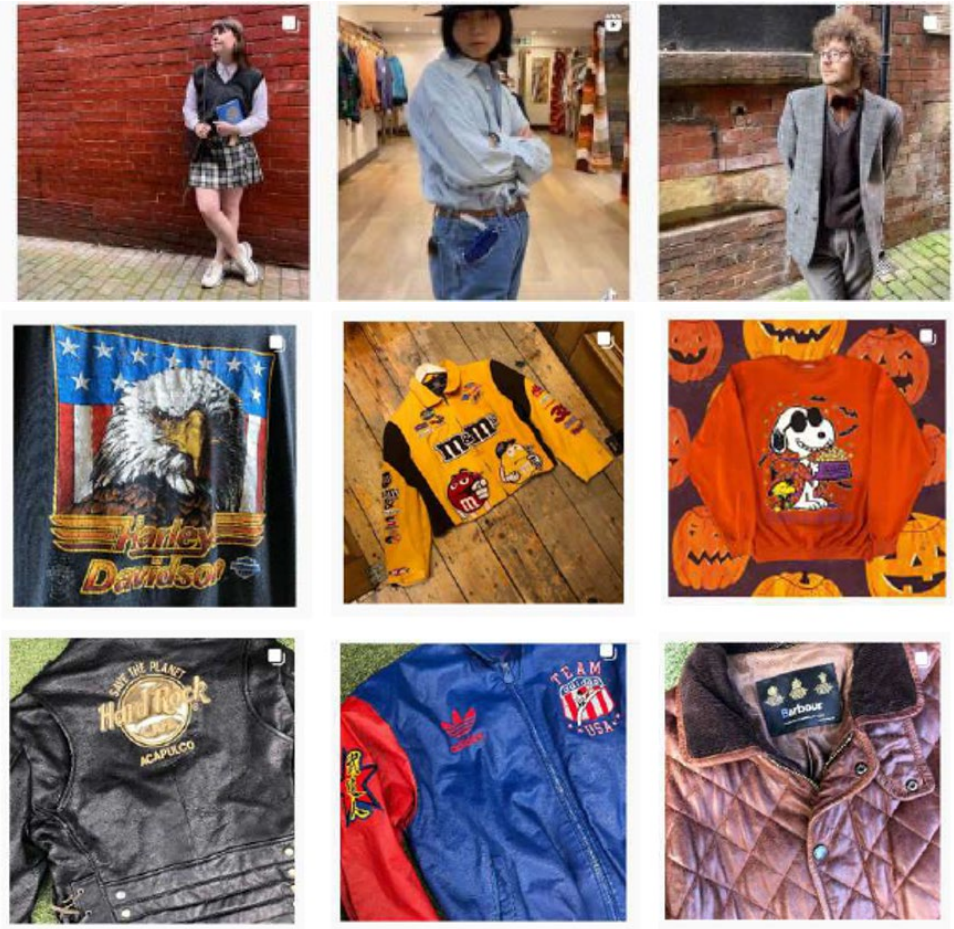
Official Page	Manchester Store	Liverpool Store	Leeds Store	London Store
4,552 followers	11,100 followers	4,183 followers	2,521 followers	1,187 followers
				

73. All the accounts are categorised as 'vintage store' with the *"official"* account details stating: *"The official Instagram for Pop Boutique. Selling vintage, restyled and Pop brand clothing in store and online"*.

74. The screenshots for all accounts show undated images of clothing or models modelling clothing with no descriptors. The example below is taken from the *"official"* page evidence:



75. Below are some other examples taken from the social media evidence:



Flyers

76. Undated copies of two flyers are provided.[33] They both display an image of models modelling clothing on the one page, and the other page includes contact details and addresses for the Opponent's stores / e-commerce store and places of business, including contact details for wholesale enquiries. The sign displayed on the flyers is as follows:

pop boutique

77. The following is the only information provided by Mr Free about the flyers: *"Exhibits 10 & 11 are copies of flyers used as promotional material for our stores, again clearly showing the trade mark in use. These were distributed in our stores and at trade shows".*

[33] Exhibits 10 and 11.

Conclusions on the evidence

78. Although my primary finding is that the 'POP Boutique' sign is not an acceptable variant of the earlier mark, and therefore any evidence of use in relation to that sign cannot be evidence of use of the earlier mark, I make the following conclusions on the alternative basis that the 'POP Boutique' sign is an acceptable variant of the earlier mark.

79. Genuine use of a trade mark relates to use of a mark in accordance with its essential function – namely to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services.

80. I remind myself that in determining whether there is real commercial exploitation of the earlier mark, some of the factors I must bear in mind include, inter alia, whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods in question; the scale and frequency of the use of the mark; the evidence that the Opponent is able to provide; and the territorial extent of the use. I also note that I am entitled to be sceptical of a case of use if the material actually provided by the Opponent is inconclusive; and that broad statements purporting to verify use should be critically considered.

81. The limited evidence shows that the Opponent's area of activity is predominantly in relation to vintage clothing. My understanding of the term 'vintage' in this context, is that it is a reference to clothing made in another time period and generally refers to pre-owned/second-hand clothing; and that the trade in vintage clothing involves the sale of items made by a plethora of different manufacturers. My understanding is reinforced by the images of clothing branded 'Barbour', 'Adidas' and 'Harley Davidson' shown in the Opponent's evidence for example.

82. From the outset, it is clear that the majority of the evidence is undated, and where it is dated, very little falls within the relevant period. Even where it falls within the relevant period, it does not show that the mark is used in relation to clothing.

83. I find that there are numerous other deficiencies within the Opponent's evidence provided which I have set out in the following paragraphs.

84. The evidence informs me that the Opponent expanded its business by creating its own line of clothing with a vintage style, to fill a gap in supply. The only evidence I have before me which shows images of clothing in relation to 'Pop Womenswear' and 'Pop Menswear' is contained in undated website screenshots, and in any event, there is no clear indication that the clothing is 'POP' branded.

85. Although the Opponent's 2014 website post informs me that the Opponent was, at that point, celebrating 20 years of its clothing line, there is no corroborating evidence, dated within the relevant period in relation to the clothing line, other than a reference to 'Pop Womenswear' on a screenshot of the Opponent's website dated 20 December 2021. What's more, there is no evidence of any sales of its clothing line (there being no evidence of revenue, turnover etc. being provided whatsoever); nor any evidence of it promoting the clothing line; no evidence of promotional spend; no evidence of manufacturing costs/ invoices for the clothing etc; nor any evidence that it sells its own branded clothing wholesale to other retailers.

86. There is no evidence dated within the relevant period of 'POP' branded clothing. Whilst I appreciate the Opponent has provided one single cropped image of a 'POP' label affixed to fabric, it is not clear what that 'fabric' actually is. Even supposing it is an item of clothing, the evidence is nonetheless undated, this is only one example, and there is no evidence to corroborate any sales of 'POP' branded clothing in any event during the relevant period.

87. The Opponent has asserted that its swing tags are attached to all the clothing it sells (although there is no evidence to corroborate this statement). A 'POP Boutique' swing tag attached to a vintage item of clothing bearing another manufacturer's branding for example, is only an indication that the vintage clothing has been retailed by 'POP Boutique' and nothing else.

88. It is my opinion that a consumer's primary perception on purchasing clothing items from a vintage clothing retailer, is that those clothing items are vintage and therefore would bear the mark of another manufacturer (and not that of the retailer).

89. The same applies to the evidence in relation to the Opponent's 'store bags'. Aside from the fact that this evidence is undated (or dated outside of the relevant period); and aside from the fact that the Opponent is only relying on its Class 25 'clothing'

goods (as opposed to its Class 18 goods) – the use on the store bags does not demonstrate that the goods put inside those bags are 'POP' clothing – this is particularly even more so when those goods could include vintage clothing (i.e. clothing bearing third-party marks). It merely demonstrates that the goods are being retailed by 'POP Boutique'.

90. To illustrate my point in relation to the swing tags and store bags, I note the following example provided by Jacob J. (as he then was) in *Euromarket Designs Inc. v Peters,*[34] in relation to the mark 'Crate & Barrel':

> *"Much may turn on the public conception of the use. For instance, if you buy Kodak film in Boots and it is put into a bag labelled "Boots", only a trade mark lawyer might say that that Boots is being used as a trade mark for film. Mere physical proximity between sign and goods may not make the use of the sign "in relation to" the goods. Perception matters too. That is yet another reason why, in this case, the fact that some goods were sent from the Crate & Barrel United States shops to the United Kingdom in Crate & Barrel packaging is at least arguably not use of the mark in relation to the goods inside the packaging. And all the more so if, as I expect, the actual goods bear their own trade mark. The perception as to the effect of use in this sort of ambiguous case may well call for evidence."*

91. The Opponent has provided an image of its store fronts in Manchester and Liverpool. I note that the purpose of a shop name is to designate a business which is being carried on, accordingly, it is not generally considered, in and of itself, as being use 'in relation to goods'.[35]

92. Although the Opponent's 'Instagram' followers are not insignificant, the number of social media followers does not equal number of sales and the social media evidence is not sufficient (alone) to clearly establish the extent to which the mark has been used commercially. Indeed, there is nothing in this evidence that shows that the mark has

[34] [2001] F.S.R. 20, at paragraph 57.
[35] See words to that effect in the General Court decision of *Strategi Group*, Case T-92/091, paragraph 23 [which itself references paragraph 21 of the European Court of Justice Case: *Céline SARL v. Céline SA*, Case C-17/06]. The *Strategi Group*, Case T-92/091, was referred to in the Appointed Person's decision in *Aegon UK Property Fund Limited v The Light Aparthotel LLP,* BL O/472/11.

been used in relation to clothing as opposed to retail services. It is also unclear where the followers are located or how active they are.

93. With regard to the Opponent's flyers, again, this evidence is not sufficient (alone) to clearly establish the extent to which the mark has been advertised – for example, there is no information about the distribution numbers of the leaflets; the cost of production of those leaflets; where (geographically) and to what extent they were distributed, and when. Neither is there any information as to the trade shows at which they were stated to be distributed such as dates, locations, number of attendees etc.

94. The evidence has various significant deficiencies which I have identified above. The Opponent has failed to show inter alia: examples of use of its mark in relation to the goods at hand; pertinent evidence that falls within the relevant period; the scale and frequency of its use of the mark in relation to the goods; and the revenue it derives from the sale of goods bearing the mark.

95. The nature and extent of use is likely to be particularly well known to the Opponent, therefore notwithstanding the ease with which the case of use could have been convincingly demonstrated, the material actually provided is inconclusive and I am not satisfied that it establishes genuine use of the mark during the relevant period. The onus is on the Opponent to have filed evidence of genuine use that is sufficiently solid and conclusive – in my view the Opponent has fallen short in this task.

Final remarks

96. Even by putting the Opponent's best case forward, and proceeding on the alternative basis that the 'POP Boutique' sign is an acceptable variant form of the earlier mark, I have nonetheless found that the Opponent has not proven genuine use of that sign.

97. There is no need to consider the claim under section 5(2)(b) as it is irrelevant to the outcome because, under section 6A of the Act, the registration of a trade mark shall not be refused on the ground that there is an earlier trade mark if the use conditions of the earlier trade mark are not met.

OUTCOME

98. The opposition fails. Subject to any appeal, the contested application, trade mark application number 3742330, shall proceed to registration.

COSTS

99. The Applicant has been successful and would ordinarily be entitled to an award of costs. However, as the Applicant had not instructed professional representatives, it was invited by the Tribunal to indicate whether it intended to make a request for an award of costs by returning a completed cost pro-forma setting out accurate estimates of the number of hours spent on a range of given activities relating to the proceedings. It was made clear by letter dated 21 April 2023, that if the pro-forma was not completed and returned, no costs would be awarded.

100. The Applicant did not return a completed pro-forma to the Tribunal, and I therefore make no award as to costs.

Dated this 30th day of August 2023

Daniela Ferrari

For the Registrar